O/0973/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3890434 BY HIGH SPORT, LLC TO REGISTER THE TRADE MARK:

HIGH SPORT

IN CLASSES 9, 18, 25 & 35

AND

OPPOSITION THERETO UNDER NO. 441644 BY HI-INT S.A.

BACKGROUND & PLEADINGS

1. High Sport, LLC ("**the applicant**") applied to register the trade mark shown on the front page of this decision in the United Kingdom on 17 March 2023. It was accepted and published in the Trade Marks Journal on 31 March 2023 for the goods and services in Classes 9, 18, 25, and 35 shown in Annex 1 at the end of the decision.

2. On 29 June 2023, HI-INT S.A. ("**the opponent**") partially opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act")[1]. The opposition is directed solely against the contested Class 18 and 25 goods (set out in full at paragraph 58 of this decision). The opponent is relying upon the following registered marks[2]:

Trade Mark no.	UK00800918526 ('526)
Trade Mark	
Goods for which the mark is registered	**Class 18:** Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery. **Class 25:** Clothing articles, footwear,

[1] The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

[2] On 31 January 2020, the UK left the EU. Under Article 56 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable trade marks (IR) for all right holders with an existing International Registration designating the EU ("IR(EU)"). As a result, the contested mark was originally protected in the UK as an IR(EU) and is now automatically converted into a comparable trade mark (IR). Comparable trade marks (IR), created under Schedule 2B of the 1994 Act, are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

	headwear.
Filing/designation date	19 February 2007
Date of entry in register	10 March 2008
Priority details	**Priority date:** 25 August 2006 **Priority country:** Benelux Office For Intellectual Property (BOIP) **TM from which priority claimed** 1117828

Trade Mark no.	UK00800926373 (‘373)
Trade Mark	HIGH USE
Goods for which the mark is registered	**Class 18:** Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery. **Class 25:** Clothing articles, footwear, headwear.
Filing/designation date	19 February 2007
Date of entry in register	26 May 2008
Priority details	**Priority date:** 25 August 2006 **Priority country:** Benelux Office For Intellectual Property (BOIP) **TM from which priority claimed** 1117826

3. For the purposes of this opposition, the opponent relies on all goods as covered by the earlier specifications.

4. In summary, the opponent in its notice of opposition claims that the competing marks share the identical first element “HIGH” and are aurally and conceptually similar to a high degree. Also, it claims that the competing goods are identical or highly similar, and there exists a likelihood of confusion.

5. The applicant filed a defence and counterstatement and put the opponent to proof of use of the earlier marks relied upon, denying the opponent's claims. Although the applicant made no admission or denial that the goods in the competing specifications are identical and or/similar, it claims that there is no real risk of likelihood of confusion because the applicant's mark is distinguishable from the opponent's mark.

Papers filed and Representation

The opponent's evidence in chief

6. The opponent's evidence consists of a witness statement dated 17 April 2024 from Mr Alessandro Cavalieri, the Director General of Interfashion SpA (the exclusive licensee of the opponent), a position which he has held since January 2018. Mr Cavalieri's evidence is accompanied by 9 Exhibits (AC1-AC9). Mr Cavalieri's evidence is directed to establishing genuine use of the earlier marks.

The applicant's evidence

7. The applicant's evidence consists of a witness statement dated 17 June 2024 from Ms Claire Lehr, the Partner at Edwin Coe LLP (the legal representative of the applicant). Ms Lehr's evidence is accompanied by 4 Exhibits (CL1-CL4). I note that the witness statement also contains submissions; however, I do not consider it too onerous a task to separate the opinions of Ms Lehr from her statements of fact. Therefore, I will adopt a pragmatic approach, treating the submissions as legal arguments and/or opinions rather than factual statements, even though they are nevertheless conveyed in a witness statement accompanied by a statement of truth. The evidence focuses on the use of the word "HIGH" in the fashion industry and the marketplace, including extracts from the state of the UK Trade Marks Register.

The opponent's evidence in reply

8. The opponent's evidence in reply consists of a witness statement dated 2 August 2024 from Mr Cavalieri. Mr Cavalieri's evidence is accompanied by 4 Exhibits (AC01-AC04). These contain screenshots that show the use of the term "SPORT" by various third-party fashion brands in relation to the contested goods.

9. Whilst I have read the evidence in full, I do not propose to reproduce or summarise it here but will refer to the salient points below, to the extent that it is considered appropriate.

10. The opponent filed written submissions on 19 August 2024.

11. The matter came to be heard by me via video conference on 25 June 2025. The applicant was represented by Ms Charlotte Blythe of Counsel, instructed by Edwin Coe LLP. The opponent, who is represented by Wynne-Jones IP Limited, did not attend the hearing but filed written submissions in lieu of attendance at a hearing. I shall not summarise these but will refer to them where appropriate during the course of my decision.

Preliminary Remarks

12. Throughout these proceedings, the applicant submitted that the word "HIGH" is a descriptive term, since it is not only a commonly used term in the fashion industry but also appears frequently in the Register. Further, at the hearing, Ms Blythe stated "*that consumers have been educated to understand that there are different operators using HIGH marks and therefore they are not confused between them, they know to rely upon the other elements of the marks to distinguish them*."[3] I note that in this context, Ms Blythe argued that the word "HIGH" has a very low to no distinctive character when used in relation to fashion goods, referring me to *Lifestyle Equities C.V. & Ors v Royal County of Berkshire Polo Club Ltd & Ors* [2023]

[3] See page 8 of the transcript.

EWHC 1839 (Ch). In support of this claim, the applicant's Exhibit CL1[4] illustrates the use of the term 'high' in various contexts within the fashion industry, such as high fashion, high waisted, and high visibility. I also note that the applicant has filed 'state of the Register' evidence with Exhibit CL2 and Exhibit CL4, and with Exhibit CL3 demonstrates use of registered marks, for example, as 'High Hope', 'HIGH DIVE' and 'Highsnobiety'.

13. First, the fact that there may be either a multitude of trade marks on the Register with Class 18 and 25 protection (125 results in total) that contain the word "HIGH" is not a relevant factor to the assessment of the present case. Although such evidence is admissible, the outcome of this opposition will be determined based on the merits of the case and the assessment of similarity between the marks at issue. Second, the mere presence of these trade marks on the Register cannot be said to demonstrate that there has (or has not been) confusion in the marketplace. Third, even for those registered marks for which evidence has been provided with CL3, it is not sufficient to establish actual use solely based on screenshots extracted from websites and social media posts. This does not show to what extent any of the marks have been used or, in some cases, in the form as registered, since many of the screenshots provided in Exhibit CL3 include highly stylised signs with added matter that do not appear to correspond to the registered word marks in CL2 (e.g. HIGH DIVE). Nothing else has been provided, which could indicate that there is a 'crowded market'[5] or that the average consumer is unable to rely on the word "HIGH" as reliably indicating trade origin. Thus, the state of the Register is "irrelevant"[6] to this assessment, and it is established that evidence of the state of the Register

[4] I note that the exhibit contains screenshots that post-date the relevant period.

[5] See *Lifestyle Equities C.V and Lifestyle Licensing B.V v Royal County Berkshire Polo Club Limited and others* [2023] EWHC 1839 (Ch).

[6] (*BREXIT* (O/262/18) at [10]; *British Sugar plc v James Robertson & Sons* Ltd [1996] RPC 281 at 305).

is of little assistance or even "worthless"[7] in the context of an opposition of this nature.

DECISION

Relevant Period

14. An "earlier trade mark" is defined in Section 6(1) of the Act:

> "(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark, international trade mark (UK) or European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> […]
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered. […]"

15. As the earlier marks relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

> "(1) This Section applies where–
>
> (a) an application for registration of a trade mark has been published,

[7] *Lifestyle Equities CV v Royal County of Berkshire Polo Club Ltd* [2022] EWHC 1244 (Ch).

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

16. In accordance with Section 6(1) of the Act, the opponent's trade marks clearly qualify as earlier marks. The relevant period for proof of use of the opponent's marks is from **18 March 2018 to 17 March 2023**. As the earlier marks are comparable marks (IR EU), use within the EU is relevant for the part of the relevant period which falls prior to IP Completion Day (i.e. 31 December 2020).[8] Therefore, for the portion of the relevant five year period between **18 March 2018 and 31 December 2020**, evidence of use of the marks in the EU may be taken into account. For completeness, for the remaining period (1 January 2021 to 31 August 2023), it is only the UK use that counts.

17. The relevant date for the assessment of likelihood of confusion as per Section 5(2)(b) is the date on which the contested application was filed, namely **17 March 2023**.

PROOF OF USE

Relevant Case Law

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

[8] See paragraph 7 of Part 1, Schedule 2A of the Act.

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish

the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

> ‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that

use during the period in question from a person properly qualified to know. […]

22. […] it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal […] comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

19. Proven use of a mark which fails to establish that "*the commercial exploitation of the marks is real*" because the use would not be "*viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark*" is, therefore, not genuine use.

Evidence of Use

20. Mr Cavalieri in his first witness statement provides historical information in the following terms:

"1. I am the Director General of Interfashion SpA, a position I have held since March 2023, prior to which I was Commercial Director of Interfashion SpA ("Interfashion") since January 2018. Interfashion is the exclusive licensee of HI-INT S.A. ("the Opponent") in relation to both the HIGH and 'HIGH USE' brands.

[…]

4. The Opponent's fashion label, HIGH, or  , was founded in 2006 in Italy out of a passionate desire to create beautiful, useful clothes and accessories in combination with innovative design with timeless style, using artisanal, traditional, and ultra-modern techniques to produce clothing and accessories finished to a 'Made in Italy' standard.

5. The Opponent and Interfashion first started selling their fashion products under the Trade Marks  and HIGH USE in the UK via its official website since as early as 2007.

6. Since then, the Trade Marks  and HIGH USE have been continuously in use in the UK, amongst other brands of the Opponent, relation to various products, including goods such as *leather belts, leather wallets and purses, and bags* in Class 18, and for various items of clothing, footwear and headgear in Class 25 such as *jackets, coats, dresses, knitwear, tops, shirts, trousers, skirts, shoes, and hats*, to name a few."

Based on the above, I consider that use was made with the consent of the opponent as per Section 6A(3)(a) of the Act.

21. Mr Cavalieri states that the total UK sales revenue for clothing and accessories sold under the earlier marks amounted to €7.287.613 providing a breakdown shown in the following table:

Products	**Year**	**Revenue**	**Units Sold**
Clothing, footwear and headgear	2018	2.177.395 €	14.816
	2019	1.536.041 €	9.555
	2020	1.116.422 €	7.106
	2021	698.213 €	4.620
	2022	832.507 €	5.414
	2023	907.505 €	5.903

Bags	2018	6.292 €	29
	2019	3.468 €	12
	2020	148 €	1
	2021	1.027 €	6
	2022	619 €	2
	2023	2.795 €	14
Accessories (wallets, purses and belts)	2018	899 €	21
	2019	2.859 €	40
	2020	164 €	3
	2021	399 €	4
	2022	311 €	5
	2023	543 €	8

He also states that the total EU sales revenue amounted to €73.004.885 for clothing and accessories bearing both of the earlier marks providing break down figures as shown in the following table:

Products	**Year**	**Revenue**	**Units Sold**
Clothing, footwear and headgear	2018	25.157.926 €	223.132
	2019	25.880.286 €	187.264
	2020	21.670.174 €	163.320
Bags	2018	51.898 €	348
	2019	40.822 €	161
	2020	40.146 €	201
Accessories (wallets, purses and belts)	2018	46.808 €	1.022
	2019	63.886 €	998
	2020	52.939 €	985

22. Nevertheless, it is not specified in the witness statement to what extent the above figures concern the sales of goods under each of the earlier marks in both the EU and the UK.

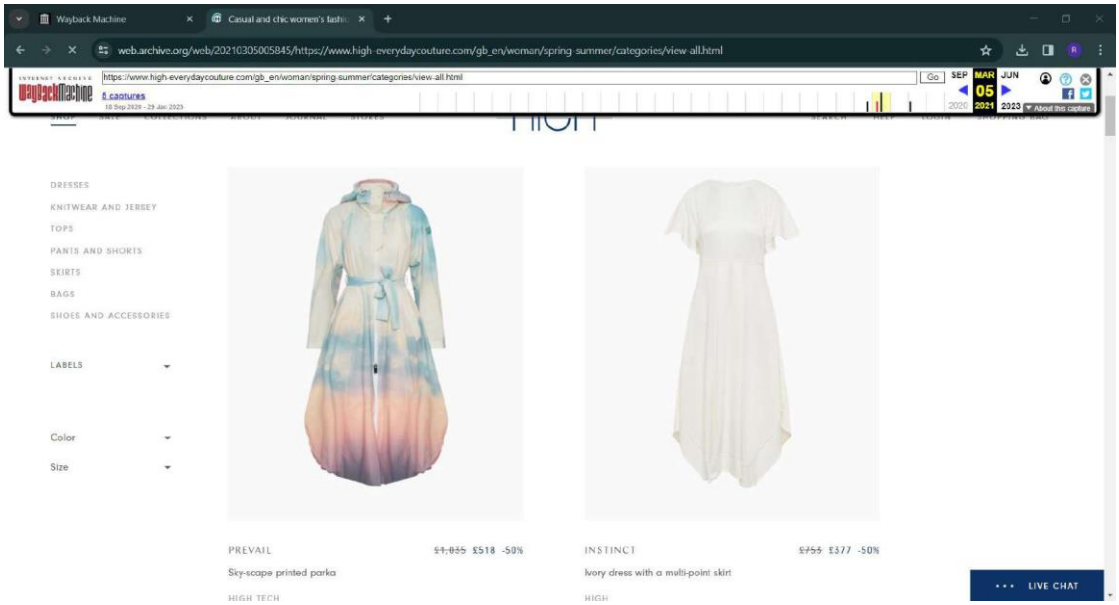
23. Mr Cavalieri also provided the opponent's spent on advertising between 2018 and 2022, which amounted to a total of €2.333.667, with the following breakdown:

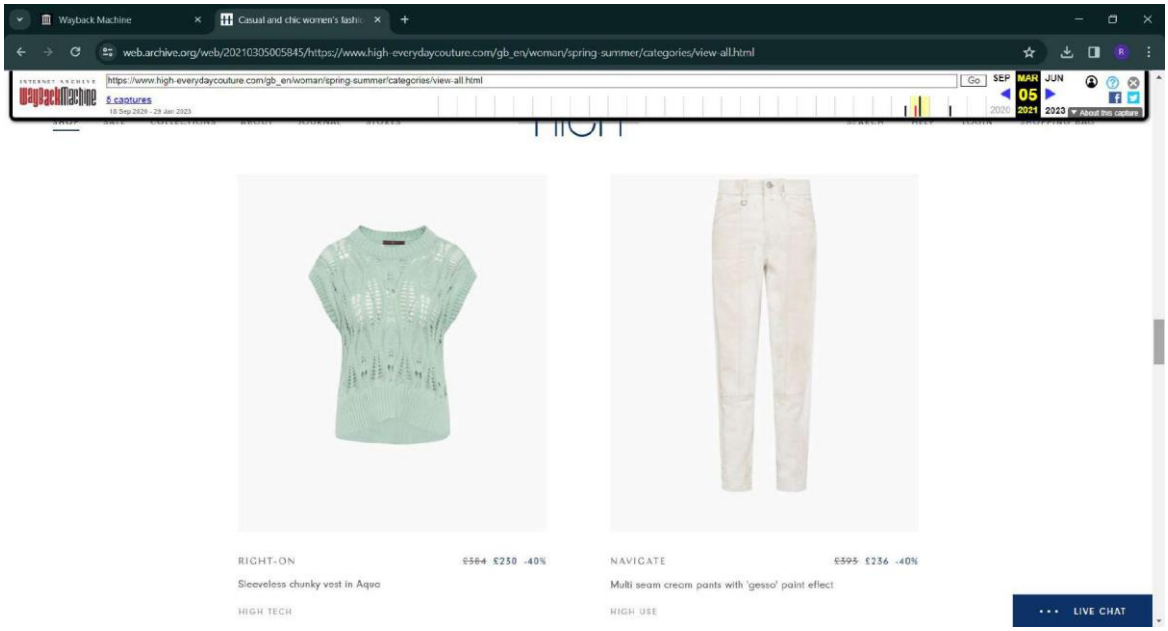
Year	Advertising Expenditure
2018 EU	1.194.206 €
2019 EU	749,737 €
2020 EU	249,404 €
2021 UK only	40,064 €
2022 UK only	100,256 €

Further, I note that the invoices list a number of promotional materials, such as catalogues, collection books, lookbooks, and shopping bags.

24. **Exhibit AC1** it is said to be a selection of screenshots from the opponent's website taken from the WayBack Machine Internet archive. These are dated between 9 April 2018 and 4 October 2023 demonstrating the landing and shipping pages of the opponent's website *high-everydaycouture.com/gb_en*. Mr Cavalieri states that the website "*includes listings in the British pound sterling directed at UK-based customers and provides worldwide shipping covering all of Europe, including the UK*." I note that the screenshots dated 4 October 2023 fall outside the relevant period and do not assist the opponent.

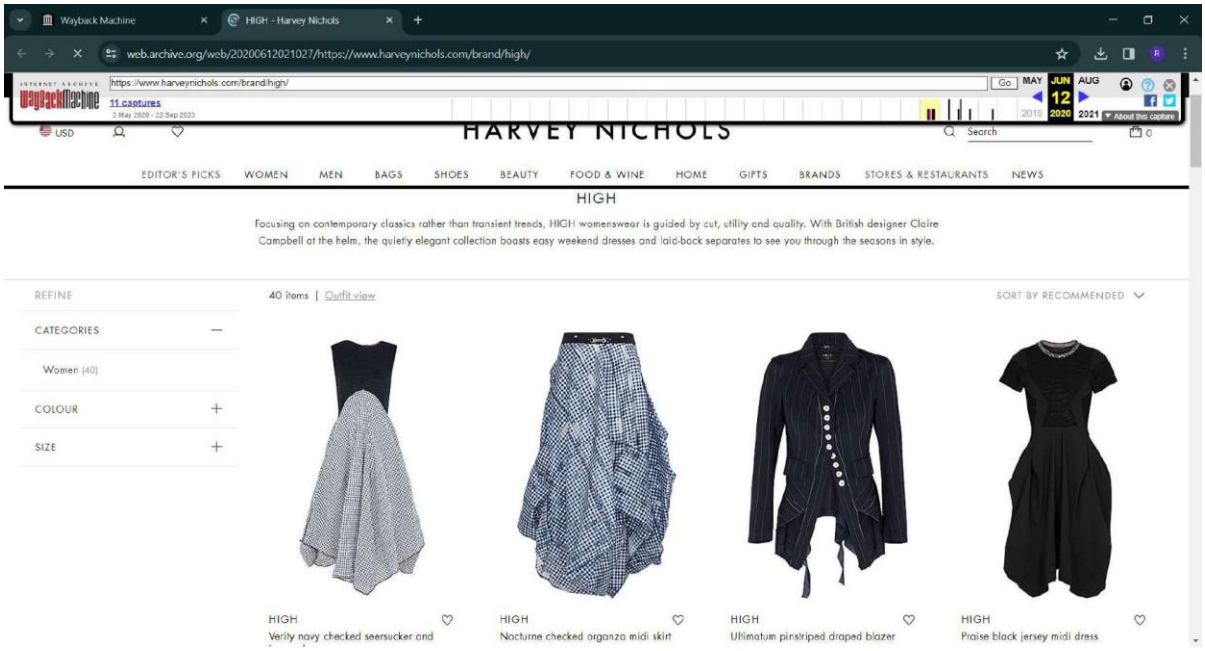
25. **Exhibit AC3** includes a selection of screenshots from the opponent's website which showcase the opponent's goods bearing the registered marks. Despite Mr Cavalieri's statement that "*a selection of dated screenshots obtained using Waybackmachine illustrating how the Trade Marks were used in connection with the Opponent's goods in the UK during the years of 2018 to 2023*", all the screenshots are dated 5 March 2021. Further, I note that the earlier mark '526 appears to be cropped at the top of the screenshot, while the earlier mark '373 appears below the product listings. Some examples are reproduced below.

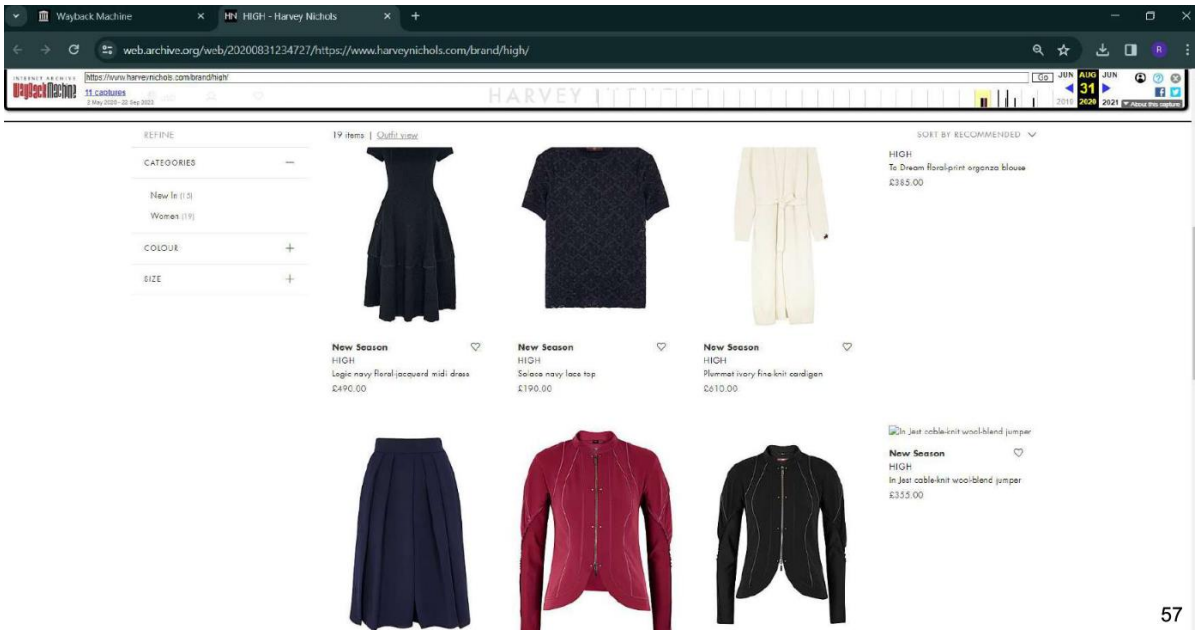




26. Further, Mr Cavalieri also provides that the registered goods have been sold through UK retailers Harvey Nichols' and Chattertons' online and physical stores. **Exhibit AC4** and **Exhibit AC5** contain a selection of screenshots obtained from the WayBack Machine Internet archive dated between June 2020 and September 2023. I note that pages 61 and 64 are undated, and page 60 is dated 22 September 2023, which falls outside the relevant period. The exhibits contain screenshots of products, accompanied by brief information, with prices only being visible in Exhibit AC4. I note that some product images appear to be missing from the

exhibits. On this point, I take into account Mr Cavalieri's comment regarding this matter: "*[s]ome screenshots are included taken from the Wayback Machine but unfortunately the Wayback Machine has not archived all of the contents of the website such as product images, but this still shows sales of the relevant products*."





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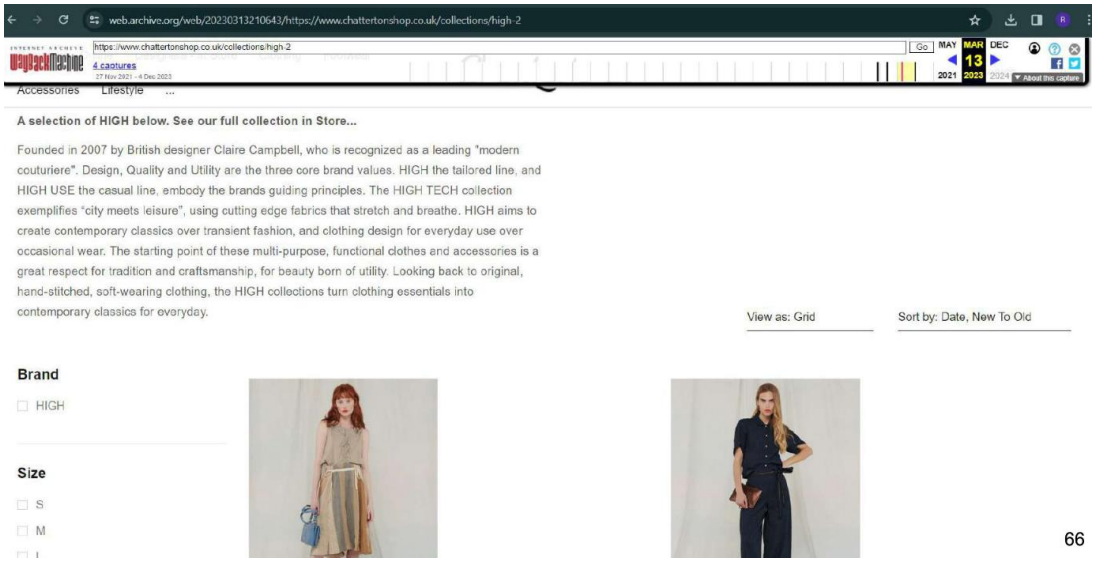
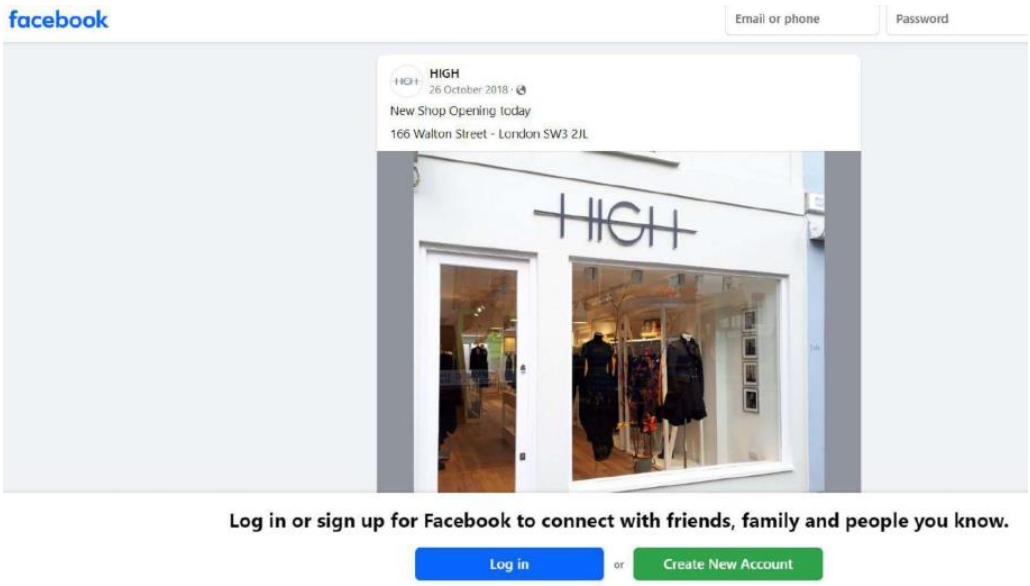


27. **Exhibit AC6** contains:

i. a screenshot from a Facebook post dated 26 October 2018, demonstrating an image of the front of the opponent's store with the earlier mark '526 (shown below), accompanied by the caption "*New Shop opening today – 166 Walton Street – London SW3 2JL*";



ii. an undated screenshot from the website *allinlond.co.uk*, which lists details about the store "HIGH" located on Albemarle Street in London.

28. **Exhibit AC7** contains a selection of invoices covering the period from 2019 to 2023. However, I note that two invoices dated 12 July 2023 and 26 July 2023 fall outside the relevant period. The earlier mark ‘526 is visible at the top right corner of each page, while the earlier mark ‘373 appears within the listings of the invoices as a heading, namely “COLLECTION: HIGH USE”. The invoices are addressed to the opponent’s stores and other retailers, such as Chattertons, Doyles, Roz Clarke, in London, Leicestershire, Old Amersham, Windsor, Belfast, and Bucks. All the invoices are in both Italian and English, and I consider that there is sufficient English text for me to identify the goods that have been shipped. These are as follows:

Year	Goods	Units
2019	**Shirt**	107
	Dress	82
	Jersey T-Shirt	133
	Jacket	75
	Knitwear Sweater	166
	Scarf	37
	Pant	187
	Tunic	2
	Hat	12
	Coat	17
	Short Jacket	14
	Belt	11
	Cardigan Tricot	22
	Waistcoat	6
	Gloves	3
	Top	28
	Cardigan	16
	Skirt	22
	Accessory	2
	Shoes	16
	Promotional Mater	114
	Skirt Pant	4
	Knitwear Cardigan	10
	Short Jacket	5
2020	**Dress**	37
	Jersey T-Shirt	20
	Jacket	57
	Knitwear Sweater	4
	Scarf	17
	Pant	43

Year	Goods	Units
	Short Jacket	19
	Top	20
	Skirt	3
	Promotional Mater	15
	Knitwear Cardigan	15
	Short Jacket	2
	Overcoat	9
	Long Jacket	13
2021	**Shirt**	8
	Dress	3
	Jersey T-Shirt	25
	Jacket	9
	Knitwear Sweater	23
	Pant	19
	Short Jacket	10
	Top	7
	Promotional Mater	2
	Top Fabric	4
2022	**Shirt**	8
	Dress	3
	Jersey T-Shirt	25
	Jacket	9
	Knitwear Sweater	23
	Pant	19
	Short Jacket	10
	Top	7
	Promotional Mater	2
	Top Fabric	4
2023	**Shirt**	15
	Jersey T-Shirt	5
	Jacket	9
	Pant	3
	Top	13
	Cardigan	6

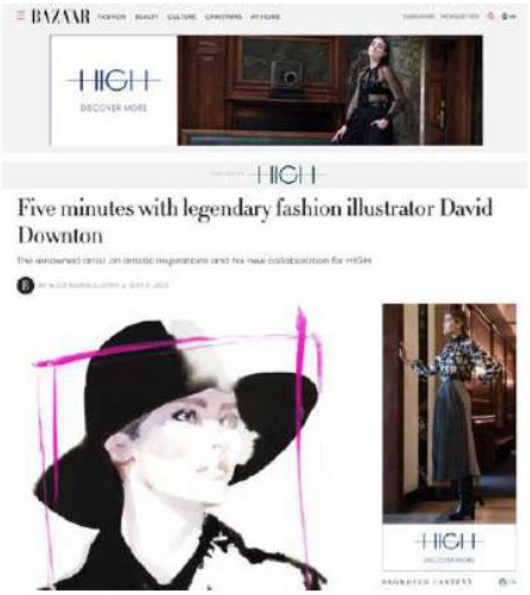
29. **Exhibit AC8** features printouts showcasing screenshots from online publications and social media posts as follows:

    i. Pages 269-270 of the evidence contain what it appears to be extracts from an online publication titled "*Five minutes with legendary fashion illustrator David Downton*". Although the witness statement does not provide specific details about the publication itself, the headings at the top of pages 269 and 270, reproduced below, reading "*NATIVE ADVERTISING – L'articolo e la campagna*

banner" and "*NATIVE ADVERTISING – La campagna social di sponsorizzazione*", respectively, suggest that the extracted screenshots in page 269 are advertising banners of the earlier mark '526 that appeared in the said online publication. Whilst I note that the publication link and the date (9 September 2020) are provided in typed text, this information is not visible within the screenshots themselves. In addition, page 270 features undated screenshots from what seems to be social media posts by "Harper's Bazaar UK" account mentioning "HIGH".

NATIVE ADVERTISING – L'articolo e la campagna banner

Data pubblicazione articolo 9/11/2020
https://www.harpersbazaar.com/uk/fashion/fashion-news/a34551882/five-minutes-with-legendary-fashion-illustrator-david-downton/



Campagna attiva dal 9/11 (ancora attiva)

269

NATIVE ADVERTISING – La campagna social di sponsorizzazione

Campagna attiva dal 9/11 (ancora attiva)

270

ii. Pages 271-280 consist of screenshots taken from the opponent's Instagram account. I note that the posts from 17 September 2023 and 27 August 2023 fall outside the relevant period and are not relevant to the assessment. However, there are three posts which are dated within the relevant period that demonstrate two women's bags and a belt bearing the earlier mark '526. Although the comments are not visible, the posts have gathered 57, 36, and 231 likes from users.

iii. Pages 281-284 consist of screenshots taken from the opponent's Facebook account. The first two posts are dated without a year, and thus it is not possible to infer whether these posts fall within the relevant period. In addition, the post from 27 October 2023 falls outside the relevant period. However, there are two posts from 16 June 2022 and 25 October 2021 demonstrating a dress and a padded jacket, respectively, bearing the earlier mark '526.

Nevertheless, Mr Cavalieri does not specify in his witness statement whether the above social media posts targeted the public in the UK, given that all of them post-date the IP completion date.

30. Further, Mr Cavalieri explains that the opponent has partnered with the Royal College of Art of London creating the "HIGH Prize for Creative Excellence" which would be awarded to a MA graduate student. In this regard, **Exhibit AC9** consists of:

    i. One printout dated July 2020 from the opponent's website detailing the launch of the prize.

    ii. Printouts of an online news article titled "*HIGH and the Royal College of Art Join Scoop London at the Saatchi Galleri*" dated 25 January 2023 from the website *luxferity.com*. The article contains images of fashion models wearing the opponent's goods. Although the marks are not visible on the items, I note that underneath the images, there is text with reference to HIGH (plain word) stating that "*HIGH - Everyday Couture, the Italian womenswear brand, produced and distributed by Interfashion S.p.A, will join Scoop London at the Saatchi Gallery in Chelsea, from 29 to 31 January 2023, to present the new Autumn Winter '23-24 collection.*"

31. I note that the rest of the evidence, i.e. Exhibit AC2, does not assist the opponent because it falls outside the relevant period. This also applies to the previously mentioned undated evidence.

Form of the Marks

32. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under Section 46(2). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

33. There are examples of use of both earlier marks as registered in the evidence, such as invoices. There is also use in the following forms:

    i. High/HIGH

    ii. HIGH TECH/High Tech

    iii. 

34. The parties disagree about whether the above form in 'i.', as used by the opponent, is an acceptable variant of the earlier mark '526 (HIGH). On the one hand, at the hearing, Ms Blythe submitted that the use of the plain word "high" would not amount to use of the earlier mark '526, claiming that the distinctiveness of the mark stems "*exclusively or at least very prominently*" from the high stylisation of the mark, and the lack of it alters the distinctive character of the mark. On the other, in its submissions in lieu of a hearing, the opponent submitted that:

> "12. […] It is common practice for word marks to be used synonymously with logo marks especially when a logo contains a verbal component, and especially where for technical reasons on a website or other material it is necessary to refer to a mark as a word mark instead of a logo mark (e.g. in the text of an article or product description it is not always possible to use logo marks). Use of the mark in this manner does not impact the distinctive character of the mark as registered.
>
> 20. […] Indeed, as can be seen in Exhibit AC4 and AC5 of Mr Alessandro Cavalieri's first witness statement, third parties refer to the Earlier Registration as the word 'HIGH'."

35. The use of “High/HIGH” in plain word format differs from the registered mark due to the absence of the stylisation, which I consider to be striking. As such, I do not consider that this is use of the earlier mark ‘526 as registered. It is my view that the absence of the stylisation will materially detract from the distinctiveness of the mark. As such, I find that the use of “High/HIGH” in plain word form is not an acceptable variant use of the mark as registered. For the avoidance of doubt, I have also considered the opponent’s argument that use of the plain word format of the figurative mark is necessary for technical reasons to refer to a mark instead of using the form of the mark as registered. While I recognise that in certain contexts or platforms it may not be possible or practical (for either the holder of a sign or third parties) to use a figurative mark, I do not consider this to be a premise that justifies a departure from the established principles set out in this decision.

36. As to the use of the form in ‘ii.’, this is also in plain word format and differs from the registered mark ‘526 due to the absence of the stylisation and the presence of the additional word element “TECH”. The absence of the stylisation clearly alters the distinctive character of the mark ‘526 as registered. Such use does not qualify as an acceptable variant use.

37. For completeness, I would have arrived at the same findings regarding the forms in ‘i.-ii.’, even if I took the earlier mark ‘373 into account for my assessment. This is due to the absence of the word “USE” in ‘i.’ and its replacement by the word “TECH” in ‘ii.’. For reasons that I will come to explain later in this decision, these differences significantly alter the distinctive character of the mark as registered. As a result, these forms cannot be considered acceptable variants.

38. There is also use in the form in ‘iii.’. In this form the letters are arranged along a circular line that forms a full circle, creating a curved presentation of the mark. It is my view that the distinctiveness of the mark ‘526 is not affected, and, thus, I find that the mark shown in ‘iii.’ is an acceptable variant.

Sufficient use

Preliminary points

39. Ms Blythe argued in her submissions that the opponent did not address the use of the earlier mark '373 in its written submissions. Even though the opponent did not explicitly refer individually to the earlier mark '373, it made a blanket statement from the outset of its written submissions in lieu of a hearing, stating that "*all evidence of use provided in Exhibits AC1-AC9 should be considered to be use of the Earlier Registrations by a third party with consent to use the mark*." I consider this to be sufficient that the opponent has not changed its position in relation to the use of its earlier mark '373.

40. In addition, Ms Blythe raised that the opponent did not explain what the earlier mark '373 is and how it was used. While I recognise that the opponent could have provided clearer and more direct information regarding the earlier mark '373, the evidence sheds some light around the "HIGH USE" brand. With Exhibit AC5,[9] HIGH USE is described as "*the casual line*", and the invoices consistently show the word "COLLECTION" preceding "HIGH USE". Therefore, I can safely infer that the earlier mark '373 concerns the opponent's brand that signifies a casual line collection.

Assessment

41. In making my assessment, I am required to consider all relevant factors, including (i) the scale and frequency of the use shown; (ii) the nature of the use shown; (iii) the goods for which use has been shown; (iv) the nature of those goods, and the market(s) for them; and (v) the geographical extent of the use shown. I also bear in mind the comments of the General Court ("GC") in *New Yorker SHK Jeans GmbH KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09:

[9] See for example pages 65-67.

"53. In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07, *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36)."

42. At the hearing, Ms Blythe submitted that the opponent has only shown use of the earlier mark '526 in relation to some of the goods in the specification. Ms Blythe provided a list of terms from the opponent's specification proposing a fair specification. In more detail, the applicant accepts that a more appropriate specification would be as follows:

Class 18: leather belts, leather wallets and bags.

Class 25: clothing.

43. I shall structure my assessment of genuine use for both earlier marks according to the registered goods under each Class, while keeping in mind Ms Blythe's proposal when I conduct my assessment for a fair specification.

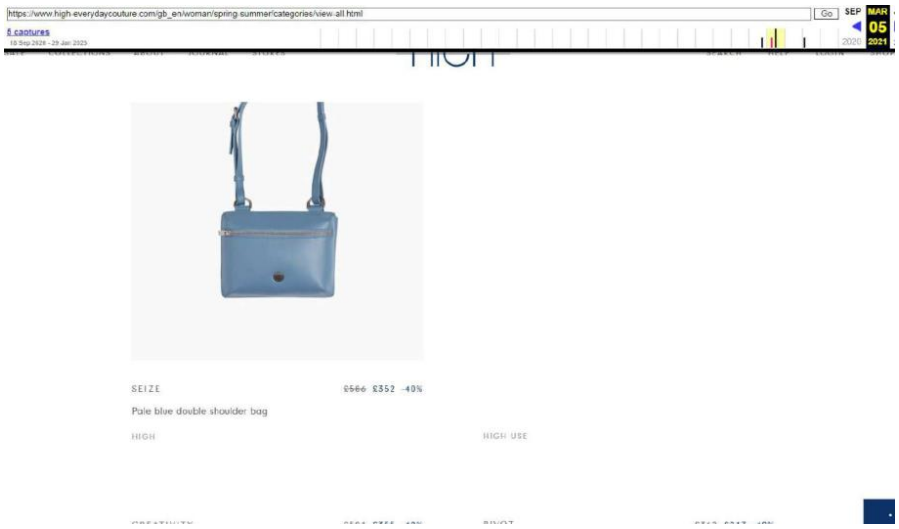
Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

44. Mr Cavalieri states that the UK and EU sales under both earlier marks for bags and accessories (i.e. wallets, purses and belts) in the relevant period were the following:

UK sales			
Products	**Year**	**Revenue**	**Units Sold**
Bags	2018	6,292 €	29
	2019	3,468 €	12
	2020	148 €	1
	2021	1,027 €	6
	2022	619 €	2
	2023	2,795 €	14
	Total	**14,349 €**	**64**
Accessories (wallets, purses and belts)	2018	899 €	21
	2019	2,859 €	40
	2020	164 €	3
	2021	399 €	4
	2022	311 €	5
	2023	543 €	8
	Total	**5,175 €**	**81**
EU Sales			
Products	**Year**	**Revenue**	**Units Sold**
Bags	2018	51,898 €	348
	2019	40,822 €	161
	2020	40,146 €	201
	Total	**132,866 €**	**710**
Accessories (wallets, purses and belts)	2018	46,808 €	1,022
	2019	63,886 €	998
	2020	52,939 €	985
	Total	**296,499 €**	**3715**

45. Although Exhibit AC3 features an online listing of a blue shoulder bag (shown below) from the opponent's UK website, I am unable to distinguish if it bears either of the earlier marks due to the low quality of the

screenshot. That said, I note that the earlier mark ‘526 appears at the top of the page, albeit it is partially cut off.



Further, even though Exhibit AC8 contains two social media posts showcasing bags with the earlier mark ‘526 on the front side of the goods, there are no corresponding listings for those goods on the invoices. As noted earlier in this decision, these social media posts postdate the IP Completion date, and there is no indication that they targeted the UK public. Nonetheless, the total sales figures for bags in both the UK and the EU during the relevant period have exceeded €147K for over 770 units. I consider that the evidence as a whole shows a genuine attempt by the opponent to use its mark ‘526 on such goods. As a result, I find that the opponent has shown that the earlier mark ‘526 has been genuinely used for “*bags*”.

46. In terms of “*belts”*, the above sales figures listed as “Accessories (wallets, purses and belts)”, exceeding €332K in total, are not broken down per item or per mark in order for me to identify what proportion of the sales can be accounted for by belts and by other accessories, namely wallets and purses. Further, the invoices show sales of 11 belts under the “HIGH USE” collection at a value of €70,84 (net amount) within the relevant period. In addition, Exhibit AC8 contains an Instagram post advertising a women’s

belt bearing the earlier mark '526. Again, in this instance, it is not indicated whether this Instagram post targeted the UK public.

I appreciate that I have no evidence on the market share the opponent possesses in the relevant market, which is likely to be significant. I also keep in mind that the case law cited above sets out that use need not be quantitatively significant in order for it to be deemed genuine. However, aside from the invoices, which show the sale of 11 belts, the opponent has provided very little evidence to support a genuine attempt to create or preserve a market share for its goods in the EU and the UK under both marks. On this point, the only evidence I have that could even remotely point to advertising activity is one Instagram post which, even taken at its best, is of very limited assistance, as it is not specified whether it was targeting the UK public. Therefore, I consider that the level of use is just too low to warrant a finding of use to create or preserve a market share in the UK (or the wider EU territory prior to IP Completion Day) for '*belts'*.

Class 25: Clothing articles, footwear, headwear

47. The sales figures that Mr Cavalieri provided in relation to "*clothing, footwear and headgear"* goods are very significant, exceeding €79 million in total within the relevant period in the EU and the UK. However, these figures do not differentiate between the earlier marks and between the goods themselves. While keeping in mind the significance of these figures, I will also consider below what use the evidence as a whole shows.

48. In relation to '*clothing'* items, I note that the opponent has provided evidence that demonstrates a wide range of clothing goods with corresponding invoices showing the sale of such items under the "HIGH USE" collection. In addition, Exhibits AC3, AC8 and AC9 show several

different styles and types of clothing items under both marks. I also note that it is safe to infer that HIGH USE branded goods, as described in Exhibit AC5, were sold via the third party retailer Chattertons, with two invoices dated 6 February 2020 and 24 June 2021 specifically addressed to them in Old Amersham. I've also taken into account Ms Blythe's comments on the use of "HIGH USE" next to or under the product listings on the opponent's and third-party retailers' websites, arguing that this would be perceived as purely descriptive, thereby not qualifying as use of the mark. In the absence of evidence, I am not ready to accept that this would be seen as descriptive. Rather, it is my view that consumers will understand this would be the brand associated with the respective product listings. Taking all of the evidence into account, I am satisfied that the opponent has shown use in the EU for the period up to 2020 and in the UK thereafter for '*clothing*' under both earlier marks.

49. In terms of '*footwear*' and '*headwear*', although Exhibit AC2 contains an example of leather sandals (pages 48-49) and a baseball cap (pages 44-45) under the earlier mark '526, these screenshots are undated. However, the invoices provided with Exhibit AC7 show that a total of 16 shoes and 12 hats were sold under the "HIGH USE" collection during the relevant period. Ms Blythe submitted that this is not sufficient to maintain or create a market share for the earlier mark '526. I agree that the evidence is notably more limited than for clothing. Although I acknowledge that there is no *de minimis* level of sales, it is clear that the sales of the given goods, based on the invoices, are very low. Therefore, I find that the marks have not been genuinely used for '*footwear*' and '*headwear*' during the relevant period.

50. For completeness, even when considering the advertising expenditure figures the opponent has provided, these are not particularised per item or per mark. As a result, it is impossible for me to identify what amount was invested for the advertising of the above goods.

Fair Specification

51. I must now determine a fair specification for the opponent's marks. In doing so, I acknowledge that fair protection is not to be achieved by identifying and defining particular examples of goods for which there has been genuine use but, rather, the particular categories of goods they should realistically be taken to exemplify.[10] I must consider how the average consumer would fairly describe the goods shown in evidence.[11]

52. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to be followed:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended

[10] *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10.

[11] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

53. This approach was endorsed by the Supreme Court in *Skykick UK Ltd & Anor v Sky Ltd & Ors* (Rev1) [2024] UKSC 36, with the following comment:

"261. … so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use."

54. The opponent has submitted that the earlier marks have been used in relation to all the goods relied upon in this opposition as follows:

Earlier mark ‘526

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25: Clothing articles, footwear, headwear.

Earlier mark ‘323

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25: Clothing articles, footwear, headwear.

55. I have found use for ‘*bags*’ and ‘*clothing*’ under the earlier ‘526 mark and ‘*clothing*’ for the earlier ‘373 mark. No use has been shown in evidence for any other goods. The range of items of clothing shown in evidence is sufficient to maintain use for the term ‘*clothing’* at large, in respect of both the earlier marks relied on by the opponent. The evidence is also sufficient for the opponent to rely on ‘*bags*’ in Class 18 of the earlier ‘526 specification. These terms are a fair specification in light of the evidence filed, being neither too narrow or too broad. I will proceed on this basis.

SECTION 5(2)(b)

56. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

[…]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

57. The principles considered in this opposition stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and Bimbo SA v OHIM (Case C-519/12 P):

a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods

58. Taking into account the fair specification as set out earlier in this decision, the competing goods to be compared are shown in the following table:

Opponent's goods	Applicant's goods
Class 18: Bags. **Class 25:** Clothing articles.	**Class 18:** Bags; sportbags; backpacks; computer and phone cases made of leather or imitation

	thereof; wallets; handbags; clutches; purses; luggage. **Class 25:** Clothing, footwear, headgear; t-shirts; shirts; tank tops; sweatshirts; sweaters; jerseys; jumpers; trousers; tracksuits; shorts; skirts; dresses; jackets; coats; vests; underwear; socks; warm-upsuits; bodysuits; leotards; tights; leggings; leg warmers; jeans; cardigans; swimming costumes; shawls; blazers; belts.

59. At the hearing, Ms Blythe admitted that the competing goods are identical or similar. However, when I asked if there would be any similarity between "*computer and phone cases made of leather or imitation thereof*" in Class 18 and the narrower specification of the earlier marks Ms Blythe provided me with her submissions, Ms Blythe responded that this would be a term that would be dissimilar if I were to adopt the proposed narrower specification.

60. I agree with Ms Blythe's admission that the competing terms "*clothing*" in Class 25 are self-evidently identical. I also consider that the opponent's broad term "*clothing*" will encompass the contested terms "*t-shirts; shirts; tank tops; sweatshirts; sweaters; jerseys; jumpers; trousers; tracksuits; shorts; skirts; dresses; jackets; coats; vests; underwear; socks; warm-upsuits; bodysuits; leotards; tights; leggings; leg warmers; jeans;*

cardigans; swimming costumes; shawls; blazers". Thus, these terms will be identical as per *Meric*[12].

61. The parties' goods in Class 25 are identical. I will proceed on the basis of Class 25 and will return to Class 18, if it proves necessary to do so.

Average Consumer and the Purchasing Act

62. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

> "The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

63. The goods at issue will be purchased by members of the general public. Such goods are usually offered for sale in stores, such as retail outlets, brochures and catalogues, and online. In retail premises, the goods will be displayed on shelves and racks, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant web pages. This

[12] The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

means that the marks will be seen, and so the visual element of the marks will be the most significant.[13] Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment, as advice may be sought from a sales assistant or representative. Even for those goods at the inexpensive end of the scale, the average consumer will examine them to ensure that they select the correct type, size, material, quality, and aesthetic appearance of, for example, clothing. Thus, the average consumer will pay a medium degree of attention.

Comparison of Trade Marks

64. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "[…] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

65. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features

[13] See *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50.

which are not negligible and therefore contribute to the overall impressions created by the marks.

66. The marks to be compared are:

Earlier Marks	Contested Mark
Earlier mark '526  Earlier mark '373 HIGH USE	HIGH SPORT

Overall Impression

67. The parties disagree on the overall impression and the dominance of the words in the competing marks.

68. The primary position of the applicant is that the earlier mark '526 would not be perceived as the word "HIGH" but rather as a figurative design consisting of vertical lines dissected by a horizontal line with a three-quarter circle. Alternatively, the applicant posits that if the mark is seen as the word "HIGH", this is a descriptive everyday word and will be of very low distinctiveness, and the stylisation is protectable under the mark, not the word. As to the earlier mark '373, Ms Blythe submitted that neither word would be more distinctive or dominant over the other.

69. In relation to the contested mark, the opponent claims that the word "HIGH" is the dominant word, while the second word "SPORT" is negligible because it is descriptive and devoid of distinctiveness. The opponent pointed out a contradiction in the applicant's argument, noting that the applicant claimed "SPORT" could either be the focal point or a co-dominant element in the contested mark, but it cannot be both at the same time. In light of this, I asked Ms Blythe to clarify the applicant's position. She

submitted that the words "HIGH SPORT" are co-dominant and none of these is more distinctive or dominant as "*they are both everyday English words and it is the combination of the two that renders the mark distinctive*."[14] Ms Blythe concluded that the words sit side by side, playing the same role in the mark, but the consumers will focus on the second element due to the nature of the marketplace wherein multiple "HIGH" brands exist.

70. The earlier mark '526 is a figurative mark which is highly stylised. In particular, the stylisation of the mark is not a decorative feature but instead will be regarded as a part of the mark. This is because the horizontal line serves as a crossbar, making it an integral component of the mark. Therefore, it is my view that the mark will ultimately be seen by the average consumer as the word "HIGH". In light of this, the stylisation of the mark has a significant impact on the overall impression, and as a result, I consider that the overall impression of the mark lies in the mark as a whole.

71. The earlier mark '373 consists of the words "HIGH USE". Registration of a word mark protects the words themselves.[15] I consider that the earlier mark will be seen as a unit conveying the notion of a phrase which appears incomplete, as it invites the question 'high use of what?'. Therefore, I consider that the overall impression conveyed by the mark rests in the unit created by the combination of the words it comprises.

72. The contested mark consists of the words "HIGH SPORT". Again, in this instance, registration of a word mark protects the words themselves.[16] I have taken into account Ms Blythe's submissions that the word elements of the contested mark are co-dominant and that it conveys as a whole the concept of "*classy or high level sport*"[17]. However, in the absence of

[14] See page 14 of the transcript.

[15] See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

[16] ibid.

[17] See paragraph 32 of Ms Blythe's skeleton argument.

evidence, it is my view that the words do not form a unit in this case. This is because the average consumer will be unable to clearly extract a unified concept from the mark as a whole. I also consider that the second word element "SPORT" will be seen as being at least highly allusive for some of the goods in Class 25. Therefore, the word element "HIGH" will play a greater role in the overall impression as opposed to the word "SPORT", which will have a lesser role.

Earlier mark '527 and contested mark

Visual Comparison

73. The competing marks have different lengths, with the earlier mark's verbal element, which will ultimately be seen as the word "HIGH", consisting of four letters, as opposed to the contested mark, which has nine. The competing marks share the four letters "HIGH" while differing in the rest, namely "SPORT". I note that the opponent claimed that, due to notional and fair use, the contested mark could be presented in the specific stylisation of the earlier mark. However, I consider that the stylisation of the earlier mark in this present case is not only striking but also functions as a part of the mark and goes beyond the use of a stylised typeface or font.[18] Therefore, the high stylisation of the earlier mark would act as another point of difference between the marks. Consequently, weighing the various points of similarity and difference, I find them to be visually similar to a low degree.

Aural Comparison

74. The verbal element of the earlier mark is monosyllabic, whereas the contested mark consists of two syllables. Both marks will be pronounced in the ordinary way. The marks aurally overlap in the pronunciation of the word "HIGH". The second syllable of the contested mark, "SPORT", introduces a phonetic difference between the competing marks. Taking

[18] On this point, I remind myself of the rationale in *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22.

into account the above factors and the overall impressions, I consider the marks to be aurally similar to a medium degree.

Conceptual Comparison

75. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

76. As outlined earlier in this decision, the average consumer will ultimately extract the word "HIGH" from the earlier mark '526. In her skeleton argument, Ms Blythe submitted that the earlier mark will be understood as "*high in altitude, in pitch, in behaviour and so on*".[19] I agree that the earlier mark is an ordinary word and will be understood according to its standard definition. As previously explained in this decision, and in the absence of evidence, I do not consider that the average consumer will perceive the contested mark, "HIGH SPORT", as forming a unit that conveys a single concept derived from the mark as a whole. This is due to the disjointed grammatical structure of the words, which prevents them from naturally coming together to convey a coherent meaning that the average consumer would grasp immediately. As a result, the average consumer will interpret each of the words individually in accordance with their ordinary meaning. Despite its allusiveness for some of the goods, the word "SPORT" will introduce a conceptual distinction. Therefore, taking into account the overall impression of the marks, I find that they are conceptually similar to between a medium and high degree.

[19] See page 12 of the skeleton argument.

Earlier mark '373 and contested mark

Visual Comparison

77. The earlier word mark consists of seven letters as opposed to the contested, which has nine. Bearing in mind, as a rule of thumb, that the beginnings of marks tend to have more impact than the ends,[20] the marks share the same first word element "HIGH". However, they differ in the second word element "USE"/"SPORT". Therefore, weighing the various points of similarity and difference, I find them to be visually similar to a medium degree.

Aural Comparison

78. The marks overlap in the verbal element "HIGH" while differing in the second verbal element "USE"/"SPORT", which will be pronounced in the standard way. Taking into account the above factors and the overall impressions, I consider that the marks are aurally similar to a medium degree.

Conceptual Comparison

79. The earlier mark '373 as a whole will naturally form a cohesive unit, creating the impression of an incomplete phrase ('high use of what?'). In the absence of evidence, I do not consider that the mark will be allusive to the registered goods. Further, each of the words in the contested mark, namely "HIGH" and "SPORT", will be construed separately without forming a cohesive whole. Again, in this case, the words will be understood based on their ordinary meaning, and the word "SPORT" will be highly allusive for some of the relevant goods. Taking into account all of the above, including the overall impressions, I find that the degree of conceptual similarity is low based on the use of the common element "HIGH".

[20] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court observed that the attention of the consumer is usually directed to the beginning of a mark.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARKS

80. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

> "In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

81. The opponent submitted that:

> "One of the factors to be considered in the assessment of the likelihood of confusion is the degree of distinctive character of the earlier mark. The Opponent has not claimed that the Earlier Registrations possess an enhanced distinctive character through use. Nevertheless, because both 'HIGH USE' and [earlier mark '526] are

very unique, the Hearing Officer should treat the Opponent's Marks as having a normal to high degree of distinctiveness per se."

82. I agree the opponent's evidence does not tell me how great a market share was held by the earlier marks, nor does it shed light on the extent of the media coverage or the intensity of advertising or promotional activities in the UK. While it was sufficient to prove use of the earlier marks for some of the goods in the specification, it falls short of what would be required to demonstrate enhanced distinctiveness. In light of this and based on the opponent's admission that the registered marks do not possess enhanced distinctiveness, I will proceed to the assessment of the inherent distinctive character of the earlier marks.

83. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

Earlier mark '526

84. As detailed in the previous section, the opponent's earlier mark '526 will be understood to be the ordinary word "HIGH", which does not strike me as descriptive or suggestive of the registered goods. Whilst I consider that the word "HIGH" itself will be inherently distinctive to no more than a medium degree, the high stylisation, which forms an integral part of the registered mark, contributes significantly to the inherent distinctive character of the mark. Therefore, I find that the earlier mark as a whole is inherently distinctive to a slightly higher than a medium degree (but not high).

Earlier mark '373

85. The mark "HIGH USE" will be perceived as a unit and will be attributed with the meaning delineated previously in this decision. As noted above, the incomplete phrase formed by the combination of these words adds to the

distinctiveness of the mark. Thus, I consider that the mark as a whole will be inherently distinctive to a medium degree.

LIKELIHOOD OF CONFUSION

86. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.[21] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater may be the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[22]

87. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

88. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC, (as he then was) sitting as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where

[21] See *Canon Kabushiki Kaisha*, paragraph 17.

[22] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.[23]

[23] See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

89. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC (as he then was) as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

90. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in Bimbo, on the court's earlier judgment in *Medion v Thomson*. He stated:

> "18 The judgment in Bimbo confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and

subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER)."

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

Arnold J. (as he then was) found that there was no likelihood of confusion between the marks 'ORIGIN' and 'JURA ORIGIN' (both of which were for alcoholic beverages). Despite the similarity in the use of the word ORIGIN, it was found that that word was inherently descriptive and had low distinctiveness for wine and whisky. Consequently, the case law set out in *Medion v Thomson* did not apply.

91. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC (as he then was), sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two

marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

92. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign “American Eagle”. In his decision, Lord Justice Arnold stated that:

> “13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

93. Earlier in this decision I have concluded that:

- the competing goods at issue are identical;
- the average consumer of the goods will be members of the public. The selection process is predominantly visual without discounting aural considerations, and the degree of attention will be medium;
- the contested mark and the earlier mark ‘526 are visually similar to a low degree, aurally similar to a medium degree, and conceptually similar to between a medium and high degree;
- the contested mark and the earlier mark ‘373 are visually and aurally similar to a medium degree, and conceptually to a low degree;

- the earlier mark ‘526 has a slightly higher than a medium degree (but not high) of inherent distinctive character; the earlier mark ‘373 has a medium degree of inherent distinctive character; and the use is not sufficient to establish enhanced distinctiveness of the marks.

Earlier mark ‘526 and contested mark

94. Taking into account my findings earlier in this decision, there is no likelihood of direct confusion for identical goods. While considering the principle of interdependency in this case, I consider that the differences are sufficient to distinguish the marks. I remind myself of the case of *New Look Limited v OHIM*,[24] which sets out that where the visual component dominates the selection process of the goods at issue, it will be given more weight. Despite the shared common concept emanating from the common word element “HIGH” in the competing marks, the average consumer will not misremember the marks as one another. This is due to the striking stylisation of the earlier mark that plays an important and distinctive role in the overall impression. In this respect, and according to the rationale in *Kurt Geiger* as quoted above, the likelihood of confusion in this case is reduced. I make this finding even by taking into account the fact that “HIGH” plays a greater role in the contested mark and also the fact that the different word element “SPORT” plays a lesser role. Thus, the various differences between the competing trade marks previously identified are, in my view, sufficient, and, as a result, the marks will not be directly confused.

95. Turning now to indirect confusion, I bear in mind that there should be a proper basis for a finding of a likelihood of indirect confusion. I see no reasonable basis on which the consumer would be induced to believe that the competing marks are variants or sub-brands of each other, nor that the goods in question are from the same or economically linked undertakings. Even if the average consumer recalls the points of similarity between the

[24] Joined cases T-117/03 to T-119/03 and T-171/03, at paragraph 50.

marks, such as that they share common verbal element "HIGH", I still consider the marks would not be indirectly confused. Sitting as the Appointed Person in *Eden Chocolat,*[25] James Mellor QC (as he then was) stated:

> "81.4 […] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining[26] in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: 'Taking account of the common element in the context of the later mark as a whole.'" (Emphasis added)

In light of this rationale, despite the common verbal element in the marks, the average consumer will recall the marks as a whole. In this case, the strong contrast created by the striking stylisation of the earlier mark and the absence of it from the contested mark amounts to a difference which, in the context of the marks as a whole, will preclude an instinctive impression by the consumer that the respective marks are variants or sub-brands. If the opponent's mark is brought to mind, this will be a mere association, not confusion.[27] I see no other reason why a common origin or an economic connection would be assumed, and so I find that, even where the goods are identical, there is no likelihood of indirect confusion.

Earlier mark '373 and contested mark

96. Taking into account the above factors and even considering the identical goods in play, there is no likelihood of direct confusion. The earlier mark, "HIGH USE", in this instance, has a strong and immediate concept, which will be understood as an incomplete phrase ("high use of what?"). In contrast, the words "HIGH SPORT" in the contested mark are unconnected

[25] Case BL O/547/17 *Duebros Limited v Heirler Cenovis GmbH* (27 October 2017).

[26] In *L.A. Sugar*.

[27] See *Duebros Limited v Heirler Cenovis GmbH*.

and do not form a cohesive whole. Although the marks have common beginnings, they differ visually, aurally, and conceptually. Notwithstanding the principle of imperfect recollection, I consider the words in the earlier mark will be seen as a unit that carries its own conceptual "hook" in the minds of the consumers, thereby aiding them in distinguishing the marks. Given that direct confusion involves no process of reasoning, I consider that the average consumer will not overlook the differences between the competing marks, and, thus, it is unlikely to mistake one mark for the other.

97. Turning to indirect confusion, I bear in mind that there should be a proper basis for a finding of a likelihood of indirect confusion. I consider the marks would not be indirectly confused. In particular, while the average consumer will identify the difference in the competing marks emanating from the words "USE" and "SPORT", the coincidence of the word element "HIGH" in the competing marks is not likely to lead the consumer to believe there is a trade connection. In accordance with the rationale set out in *BARKERS BREW*,[28] the word elements of the earlier mark, "HIGH USE", form a cohesive whole. That blend of meaning emanating from the combination of the said words will convey the concept outlined throughout this decision that goes beyond the meaning of the shared word "HIGH" alone. I note here that the overall impression lies within the unit of the words in the earlier mark. Such differences between the competing marks are not consistent with a sub-brand, brand extension or variant. I find that the average consumer, when coming across the respective marks will view the shared common elements as a coincidence, rather than indicating that those undertakings are economically linked. I do not, therefore, consider there to be a likelihood of indirect confusion.

98. Based on my findings above, the opponent's case will not be helped by a full comparison of the goods, and my findings would have been extended to the goods having any degree of similarity.

[28] O/476/14, at paragraphs 26-27.

OUTCOME

99. The opposition has been unsuccessful. **The opposition on the basis of the claim under Section 5(2)(b) fails.** Therefore, subject to any successful appeal, the application can proceed to registration.

COSTS

100. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Considering the other side's statement and preparing a counterstatement	**£300**
Preparing evidence and considering and commenting on the other side's evidence	**£800**
Preparing for and attending the hearing	**£900**
Total	**£2,000**

101. I, therefore, order HI-INT S.A. to pay to High Sport, LLC the sum of £2,000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 17th day of October 2025

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General

Annex 1

Class 9: Eyewear; spectacles (optical); sunglasses; sunglass cases; sunglass frames; downloadable virtual goods namely computer programs connected with clothing, footwear, headgear, belts, bags, sportbags, backpacks, computer and phone cases made of leather or imitation thereof, wallets, handbags, clutches, purses, luggage, eyewear, fragrances, cosmetics, make-up, toiletries, perfumed products, soaps, face and body lotions, all of the aforesaid being for use in online virtual environments and authenticated by non fungible tokens (NFTs); downloadable multimedia files containing artwork, text, audio, and video relating to fashion, all of the aforesaid authenticated by non fungible tokens (NFTs); downloadable image files and video recordings containing clothing, footwear, headgear, belts, bags, sportbags, backpacks, computer and phone cases made of leather or imitation thereof, wallets, handbags, clutches, purses, luggage, eyewear, fragrances, cosmetics, make-up, toiletries, perfumed products, soaps, face and body lotions, all of them also authenticated by non fungible tokens (NFTs); downloadable virtual goods authenticated by non fungible tokens (NFTs) or other digital tokens used in blockchain technology, connected with virtual clothing, virtual footwear, virtual headgear, virtual belts, virtual bags, virtual sport bags, virtual backpacks, virtual computer and phone cases made of leather or imitation thereof, virtual wallets, virtual handbags, virtual clutches, virtual purses, virtual luggage; downloadable virtual goods authenticated by non fungible tokens (NFTs) or other digital tokens used in blockchain technology, connected with virtual eyewear, virtual fragrances, virtual cosmetics, virtual make-up, virtual toiletries, virtual perfumed products, virtual soaps, virtual face and body lotions; downloadable virtual goods authenticated by non fungible tokens (NFTs) or other digital tokens used in blockchain technology, connected with virtual artworks, virtual audio files, virtual video files, virtual moving images, virtual animated images, virtual sound files, virtual artwork files; downloadable digital media, containing audio files, video files, moving images, animated images, sound files, artwork files; downloadable digital media, containing digital collectibles connected with digital clothing, digital footwear, digital headgear, digital belts, digital bags, digital sport bags, digital backpacks, digital computer and phone cases made of

leather or imitation thereof, digital wallets, digital handbags, digital clutches, digital purses, digital luggage; downloadable digital media, containing digital collectibles connected with digital eyewear, digital fragrances, digital cosmetics, digital make-up, digital toiletries, digital perfumed products, digital soaps, digital face and body lotions; downloadable digital media, authenticated by digital tokens and non fungible tokens (NFTs), containing audio files, video files, moving images, animated images, sound files, artwork files; downloadable digital media, authenticated by digital tokens and non fungible tokens (NFTs), containing digital collectibles connected with digital clothing, digital footwear, digital headgear, digital belts, digital bags, digital sport bags, digital backpacks, digital computer and phone cases made of leather or imitation thereof, digital wallets, digital handbags, digital clutches, digital purses, digital luggage; downloadable digital media, authenticated by digital tokens and non fungible tokens (NFTs), containing digital collectibles connected with digital eyewear, digital fragrances, digital cosmetics, digital make-up, digital toiletries, digital perfumed products, digital soaps, digital face and body lotions.

Class 18: Bags; sportbags; backpacks; computer and phone cases made of leather or imitation thereof; wallets; handbags; clutches; purses; luggage.

Class 25: Clothing, footwear, headgear; t-shirts; shirts; tank tops; sweatshirts; sweaters; jerseys; jumpers; trousers; tracksuits; shorts; skirts; dresses; jackets; coats; vests; underwear; socks; warm-upsuits; bodysuits; leotards; tights; leggings; leg warmers; jeans; cardigans; swimming costumes; shawls; blazers; belts.

Class 35: Advertising; distribution of advertising material; business management; online retail services and retail services relating to clothing, footwear, headgear, belts, bags, sportbags, backpacks, computer and phone cases made of leather or imitation thereof, wallets, handbags, clutches, purses, luggage, eyewear, fragrances, cosmetics, make-up, toiletries, perfumed products, soaps, face and body lotions; online retail store services in connected with virtual goods, namely clothing, footwear, headgear, belts, bags, sportbags, backpacks, computer and

phone cases made of leather or imitation thereof, wallets, handbags, clutches, purses, luggage, hair accessories, eyewear, fragrances, cosmetics, make-up, toiletries, perfumed products, soaps, face and body lotions; providing online market place for the purchase and sale of virtual goods and virtual assets also authenticated by non fungible tokens (NFTs), connected with clothing, footwear, belts, headgear, bags, sportbags, backpacks, computer and phone cases made of leather or imitation thereof, wallets, handbags, clutches, purses, luggage, hair accessories, eyewear, fragrances, cosmetics, make-up, toiletries, perfumed products, soaps, face and body lotions; conducting virtual fashion shows online for commercial purposes; providing online marketplaces for the purchase and sale of non fungible tokens (NFTs), virtual artworks, crypto-collectibles, all authenticated by non-fungible tokens (NFT) or other blockchain based non-fungible valuables, connected with virtual clothing, virtual footwear, virtual headgear, virtual belts; providing online marketplaces for the purchase and sale of non fungible tokens (NFTs), virtual artworks, crypto-collectibles, all authenticated by non-fungible tokens (NFT) or other blockchain based non-fungible valuables, connected with virtual bags, virtual sport bags, virtual backpacks, virtual computer and phone cases made of leather or imitation thereof, virtual wallets, virtual handbags, virtual clutches, virtual purses, virtual suitcases, virtual briefcases; providing online marketplaces for the purchase and sale of non fungible tokens (NFTs), virtual artworks, crypto-collectibles, all authenticated by non-fungible tokens (NFT) or other blockchain based non-fungible valuables, connected with virtual eyewear, virtual fragrances, virtual cosmetics, virtual make-up, virtual toiletries, virtual perfumed products, virtual soaps, virtual face and body lotions, virtual artworks, virtual audio files, virtual video files, virtual moving images, virtual animated images, virtual sound files, virtual artwork files; online retail services relating to digital assets containing audio files, video files, moving images, animated images, sound files, artwork files, digital collectibles connected with digital clothing, digital footwear, digital headgear, digital belts, digital bags, digital sport bags, digital backpacks, digital computer and phone cases made of leather or imitation thereof, digital wallets, digital handbags, digital clutches, digital purses, digital suitcases, digital briefcases; online retail services relating to digital assets containing digital collectibles connected with digital eyewear, digital fragrances, digital cosmetics,

digital make-up, digital toiletries, digital perfumed products, digital soaps, digital face and body lotions; online retail services relating to downloadable virtual goods authenticated by non-fungible tokens (NFTs) or other digital tokens connected with virtual clothing, virtual footwear, virtual headgear, virtual belts, virtual bags, virtual sport bags, virtual backpacks, virtual computer and phone cases made of leather or imitation thereof, virtual wallets, virtual handbags, virtual clutches, virtual purses, virtual suitcases, virtual briefcases; online retail services relating to downloadable virtual goods authenticated by non-fungible tokens (NFTs) or other digital tokens connected with virtual eyewear, virtual fragrances, virtual cosmetics, virtual make-up, virtual toiletries, virtual perfumed products, virtual soaps, virtual face and body lotions, virtual artworks, virtual audio files, virtual video files, virtual moving images, virtual animated images, virtual sound files, virtual artwork files.