

O/1003/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003866533
BY DEQING FOX ARMOUR CO.,LTD
TO REGISTER THE FOLLOWING TRADE MARK:**

FOX ARMOUR

IN CLASSES 9 AND 28

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 440653
BY FOX HEAD INC.**

BACKGROUND AND PLEADINGS

1. On 11 January 2023, Deqing Fox Armour Co.,Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK (“the contested mark”). The application was accepted and published for opposition purposes on 03 February 2023 in respect of the following goods:

Class 9: *Protection devices for personal use against accidents; Reflective safety vests; Gloves for protection against accidents; Bullet-proof vests; Bullet-proof waistcoats; Bullet-proof clothing; Protective masks, not for medical purposes; Shoes for protection against accidents, irradiation and fire; Protective helmets; Riot shields; Goggles.*

Class 28: *Elbow guards [sports articles]; Knee guards [sports articles]; Shin guards [sports articles]; Arm guards for sports use; Wrist guards for athletic use; Leg guards for athletic use; Chest protectors for sports use; Palm protectors for athletic use; Machines for physical exercises; Exercise bands.*

2. On 03 May 2023, the application was opposed in full by Fox Head Inc. (“the opponent”) on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under Section 5(2)(b), the opponent relies on the two trade mark registrations shown below:¹

Trade mark number: UK00912872065 (“the word-only earlier mark”)
Trade Mark: FOX

¹ On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM and IR designating the EU for protection. As a result, the opponent’s earlier EUTM were automatically converted into a comparable UK trade marks. Comparable UK marks 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.

Filing date: 13 May 2014

Registration date: 22 October 2015

The mark is registered for a range of goods and services in classes 9, 16, 18, 25 and 35 as set out below, but the opponent relies upon the goods and services in classes 9, 25 and 35 only (highlighted in grey):

Class 9: *Sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities; protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories, namely replacement lenses, frames, earstems, and nose pieces; cases specially adapted for spectacles and sunglasses and their parts and accessories; protective articles for sporting purposes (other than sporting articles or parts of sports suits); headwear for sporting activities for protection against injury; protection apparatus for personal use against accidents (other than sports articles or part of sports suits); electronic publications (downloadable) featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services; publications in machine readable form featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services; all the aforesaid goods for use in relation to extreme sports activities.*

Class 16: *Paper, cardboard; printed matter; printed advertising materials; decals; stickers (decalcomanias); brochures; catalogues; pamphlets; leaflets; periodical magazines; newsletters; stationery; photographs; instructional and teaching material (except apparatus); all relating to clothing, apparel, protective gear, footwear, casualwear accessories, and moto-cross, motorcycle, bicycle and action sports activities, goods and services; all the aforesaid goods for use in relation to extreme sport activities.*

Class 18: *Luggage, backpacks, and travel bags; all the aforesaid goods for use in relation to extreme sports activities.*

Class 25: *Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts, shoes, boots, socks and swimwear; all the aforesaid goods for use in relation to extreme sports activities.*

Class 35: *Business management and administration; advertising; organization of exhibitions for commercial or advertising purposes; event management services (organization of exhibitions or trade fairs for commercial or advertising purposes); franchising services [group purchasing, group advertising]; management advisory services related to franchising; retail services in the field of sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities, protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories, namely replacement lenses, frames, earstems, and nose pieces, cases specially adapted for spectacles and sunglasses and their parts and accessories, protective articles for sporting purposes (other than sporting articles or parts of sports suits), headwear for sporting activities for protection against injury, protection apparatus for personal use against accidents (other than sports articles or part of sports suits), electronic publications (downloadable) featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services, publications in machine readable form featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services, paper, cardboard, printed matter, printed advertising materials, decals, stickers (decalcomanias), brochures, catalogues, pamphlets, leaflets, periodical magazines, newsletters, stationery, photographs, instructional and teaching material (except apparatus); all relating to clothing, apparel, protective gear, footwear, casualwear accessories, and moto-cross, motorcycle, bicycle and action sports activities, goods and services, luggage, backpacks, and travel bags, clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts, shoes, boots, socks and swimwear; electronic publication of publicity texts; all the aforesaid services for use in relation to extreme sport activities.*

Trade mark number: UK00913314984 (“the logo earlier mark”)

Trade Mark:



Filing date: 01 October 2014

Registration date: 23 February 2015²

The opponent relies upon all of the goods for which the mark is registered, as shown below:

Class 9: *Sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities; protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories, namely replacement lenses, frames, earstems, and nose pieces; cases specially adapted for spectacles and sunglasses and their parts and accessories; headwear for sporting activities for protection against injury; protection apparatus for personal use against accidents (other than sports articles or part of sports suits); electronic publications (downloadable) featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services; publications in machine readable form featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services.*

Class 28: *Protective articles for sporting purposes (other than sporting articles or parts of sports suits).*

4. The opponent claims that the marks are similar, that the goods and services are identical or similar, and that the opponent's marks have acquired an enhanced level of distinctiveness through use. These factors, the opponent claims, will lead to a likelihood of confusion and the application should be refused under Section 5(2)(b).

5. Under Section 5(3), the opponent relies on the same earlier marks set out above, which, it claims, have a reputation in relation to all of the registered goods and

² This trade mark expired on 1.10.24 but was validly registered at the filing date of the application, hence the opponent can continue to rely on it.

services. The opponent claims that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

6. The two trade marks relied upon by the opponent are considered earlier marks in accordance with Section 6(1)(a) of the Act given that they were filed for registration earlier than the date of application for the contested mark. As they had been registered for five years at the date the application was filed, in accordance with Section 6A of the Act, they are both subject to proof of use. Accordingly, the opponent made a statement that it has used the earlier marks in relation to the goods and services upon which it relies.

7. Under Section 5(4)(a) the opponent relies upon the unregistered sign 'FOX'. The opponent claims to have used the sign throughout the UK since 2011 in relation to the following goods:

Goggles; protective goggles; protective helmets; protective clothing; protective clothing including chest guards, elbow pads, knee pads, reinforced shorts and tights; chest guard jackets; protective kidney belts; protective knee and shin guards; protective body vests; protective body frame armour; protective gloves; protective boots and shoes; protective helmets; clothing, footwear and headgear of all types; clothing, including base layers, pants and leggings, shirts, jackets, shorts, hoodies and pullovers, t-shirts, jerseys, outerwear, reinforced clothing and socks; protective guards in the form of inserts for clothing; sports guards; sports gloves; protective guards and inserts for sporting purposes, including motocross, mountain biking, cycling, outdoor activities and extreme sports activities, such as paintballing, surfing, skiing and winter sports; bags and backpacks.

8. The opponent claims that its business was set up in the USA in the 1970s and it has been actively selling 'FOX' branded goods in the UK for at least 15 years. The opponent claims to be a market leader in the outdoor and extreme sports fields, and to have a particularly strong reputation for mountain-biking and motocross, as well as many other activities where protective gear might be needed, ranging from

wakeboarding and surfing to winter and other sports. Further, the opponent claims that use of the applicant's mark is likely to mislead the public into thinking that the applicant's goods are those of the opponent, resulting in damage to the opponent.

9. The applicant filed a counterstatement on 10 July 2023. Aside from conceding that the applied-for goods in class 28 (excluding *machines for physical exercise* and *exercise bands*) are similar to the goods covered by the earlier marks, the applicant denied the claims made, and put the opponent to proof of use in relation to all of the goods and services relied upon.

10. The opponent has been professionally represented throughout these proceedings by Murgitroyd & Company. The applicant is represented by Pawel Wowra. Only the opponent filed evidence. No hearing was requested and only the opponent filed written submissions in lieu of attendance. This decision is taken following careful consideration of all the papers before me.

THE EVIDENCE

11. The opponent's evidence is given in the witness statements of Robert Robinson and Sharon Kirby.

12. Mr Robinson is the UK and Ireland Country Manager for the opponent. His statement is dated 15 November 2015 and is accompanied by 10 exhibits being those labelled RR1 to RR10. Mr Robinson's evidence is aimed at supporting the opponent's claims that it has put the earlier marks to genuine use and that it enjoys reputation and goodwill under those marks.

13. Ms Kirby is a trade mark attorney at Murgitroyd & Company, the opponent's representatives in these proceedings. Her statement is dated 15 November 2023 and is accompanied by three exhibits being those labelled SK1-SK3. Ms Kirby's evidence relates to some Internet searches she had conducted in relation to the applicant's website.

14. I do not intend to summarise the evidence and submissions at this stage, but I confirm that I have given due consideration to all of the documents filed by both parties.

RELEVANCE OF EU LAW

15. 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.

DECISION

Proof of use

16. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (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.”

17. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18. The relevant period in which genuine use must be established is the five-year period ending with the filing date of the application for registration: 12 January 2018 to 11 January 2023. As the earlier marks subject to proof of use are both comparable marks, use within the EU (including the UK) is relevant for the period ending with IP Completion Day, i.e. 12 January 2018 to 31 December 2020.³ From 1 January 2021 onwards, however, the relevant territory is the UK only.

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

“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 Bunderversammlung 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].

³ See paragraph 7 of Part 1, Schedule 2A of the Act.

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].”

20. With regards to assessing use within the EU (which is relevant due to the earlier marks being ‘comparable marks’), I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU found that while use of a Community trade mark in one member state could suffice to establish genuine use in the Community, “*all facts and circumstances*” should be considered including the characteristics of the market concerned, the nature of the goods or services protected

by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.⁴

The evidence

21. Mr Robinson, who gave the main evidence for the opponent, says that he has worked for the opponent for ten years and is responsible for the opponent's sales and marketing across the UK, including of mountain bike and motocross product lines, clothing (including casual, sports and protective clothing), and protective products (including goggles, helmets, guards and armour).

22. Mr Robinson explains that the opponent's company was purchased in 2022 by Vista Outdoor for \$540 million and asserts that this reflects that the brand 'FOX' is a market leader. He explains that Vista Outdoor is a US-based business which holds various brands in the outdoors and sporting fields including cycling, motorcycling, motocross, and mountain biking as well as golf and hunting. A webpage (undated) from Vista Outdoors's website (www.vistaoutdoor.com) states: "*Our two operating segments, Outdoor Products and Sporting Products, include a diverse portfolio of renowned brands that provides outdoor consumers with a wide range of performance-driven, high-quality and innovative products*" and lists 'FOX' as an outdoor product brand, along with other 29 different brands.

23. A copy of an online article from "Outside Business Journal" dated 30 August 2022 supports the narrative evidence provided by Mr Robinson about the purchase and the opponent's position as a market leader in protective gear and apparel for motocross and mountain biking.⁵ It states:

"Vista Outdoor to Purchase Fox Racing for \$540 Million.

The motocross and mountain biking gear company is to become the 40th brand under the Vista Outdoor banner"

⁴ See also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (paragraphs 228-230) and Case T-398/13, *TVR Automotive Ltd v OHIM* (paragraph 57)

⁵ RR1

“[...] Fox Racing is an ideal fit for our portfolio with a reputation for high quality helmets, protective gear and apparel for motocross and mountain biking,” said Chris Metz, Vista Outdoor CEO, in a press release. “Motocross and mountain biking are growing and familiar categories for Vista Outdoor. Fox Racing is synergistic to our existing action sports business unit, which includes Bell Helmets, Giro, Blackburn, Krash, Copilot, and Raskullz. The addition of Fox Racing to our portfolio will allow us to target multiple consumer demographics across mountain and road biking, skiing/snowboarding, and powersports.

[...] Fox Racing was started by Santa Clara University physicist Dr. Geoff Fox in 1974 and is known as an industry leader in protective gear, apparel and accessories for motocross and mountain biking. Fox Racing grew its net sales by a compound annual growth rate of approximately 20 percent from 2019 to 2021, and is expected to top that growth for 2022 [...]

24. Although the article refers to ‘FOX RACING’, Mr Robinson states that the opponent is often known in the trade and to customers as ‘FOX RACING’, or simply ‘FOX’.

25. Mr Robinson provides the opponent’s net sales figures for the UK for ‘FOX’ branded goods sold between 2015 and 2021.⁶ The figures relate to sales of motorbike-related goods (MTX), motocross-related goods (MX) and lifestyle goods. The total value of the sales fluctuated from over £6million in 2015, to £7million in 2016, to £7.8million in 2017, to £5.9 in 2018, to £9.7million in 2019, to £11.8million in 2020, to nearly £14million in 2021, for a total of over £62million, with the sales of motorbike and motocross goods representing over 80% of the total sales.

26. Mr Robinson also says that UK sales of mountain bike and motocross products in 2022 are close to £11 million (without Lifestyle sales).

27. Global figures have also increased steadily between 2015 and 2022, going up from nearly €40million in 2015, to nearly €48million in 2016, to €51.3million in 2017, to €50million in 2018, to €53.1million in 2019, to €58.2million in 2020, to €87.6million in

⁶ RR2

2021, to €103.5million in 2022, for a total of over €491million. Mr Robinson says that the vast majority of these sales relate to the brand 'FOX', explaining that the opponent sells both 'FOX' and 'SHIFT' branded goods, but 'SHIFT' represents only around 5% of the sales.

28. Mr Robinson provides extracts of UK sales for 2017 and 2021 giving breakdowns of sales by reference to products. They show that the sale of mountain bike and motocross goods include helmets, pants, jerseys, outerwear, guards, shorts, gloves, bags, socks, base layers, spare parts, boots and goggles, whereas the sale of lifestyle goods include headwear, outerwear, shorts, pants, tops, fleeces, socks, swim, bags, stickers, wallets, dresses, eyewear and footwear. Mr Robinson states that he would estimate, very roughly, that 40% of the mountain bike and motocross sales relate to protective wear such as pads, guards, helmets, goggles and the like, and provides a table showing that between January and November 2022 and in 2023 the sales of helmets, guards and goggles represented 39% and 38% of the UK sales respectively.⁷

29. Mr Robinson states that all the opponent's products bear the marks 'FOX' and/or 'FOX RACING' on the product itself and provides examples of use of the Fox word-only mark and FOX logo-mark on printed labels and on goods, as shown below:⁸



⁷ RR2

⁸ RR3 and RR6



30. Copies of 'FOX' mountain bike and motocross catalogues from 2017, 2019 and 2021 are provided.⁹ They show examples of a variety of goods ranging from protective goods, including items of racewear, such as racer one piece suits, helmets, guards, goggles, gloves, body armours, to items of sport and casual clothing, including leggings, fleeces, hats, jackets, hoodies, t-shirts, long sleeves tops, shirts, socks and bags.

31. Mr Robinson states that the opponent's products are sold in the UK via third-party stores or via the opponent's UK website foxracing.co.uk with a 50/50 split between online sales and sales via physical stores. The opponent also owns foxracing.com as its global site. Mr Robinson further states that, at the date of witness statement, the opponent's motorbike and lifestyle goods were sold in the UK in around 400 third-party stores (with some third parties holding multiple stores) and that between 2018 and 2023 the number of stores had increased from closer to 300 to around 400. Similarly, the motocross goods were sold in the UK in around 60 stores between 2018 and 2023.

32. Copies of invoices for the UK are also supplied. They are addressed to business customers in various UK locations, including Cardiff, Swansea, Bristol and other locations in England, are dated within the relevant period (covering the years 2018, 2019, 2020 and 2022), and are for various amounts, ranging from over £7K to over £200K. All of the invoices exhibited are for sports and protective goods of the kind mentioned above and feature the mark shown below:

⁹ RR5-6



Form of the marks and genuine use

33. There are plenty of examples of use of the word-only mark on goods, catalogues and invoices. Whilst the word 'FOX' is also used in conjunction with a fox head device, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark insofar as it continues to be perceived as indicative of the origin of the product at issue.¹⁰ In this case, I consider that use of the word FOX in conjunction with a fox head device does not alter the ability of the trade mark FOX to serve as an indication of the commercial origin of the goods and counts towards genuine use.

34. Admittedly, the FOX logo mark shown in evidence is slightly different from the registered version. Further, the majority of the goods shown in evidence do not display the FOX logo mark but feature a fox head device and the word FOX separately. I will deal with these issues in turn.

35. First, the differences between the registered mark and the mark that has been used are minimal, amounting to the presence, in the registered version, of a white outline around the letters and the fox head device which is absent in the mark shown in evidence:



¹⁰ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

36. In my view, the distinctiveness of the FOX logo mark lies in the letters F and X and their combination with the fox head device; the change in the outline amounts to an alteration or omission of a non-distinctive element which does not alter the distinctive character of the mark as a whole and the version used is an acceptable variant of the mark as registered.¹¹

37. Second, although the majority of the goods shown do not display the FOX logo mark, the latter appears on internal pages of catalogues as shown below and Mr Robinson says that the FOX logo mark is the original brand:



¹¹ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22



38. In any event, use of a mark does not have to be shown on every single label, product or catalogue page to be deemed to have been used in relation to the relevant goods. It is clear that the opponent has used its original FOX logo mark during the relevant period along with other variations of the same mark resulting from the deconstruction of the mark into its two components, namely the fox head device and word FOX separately.

39. Taking into account the nature of the goods concerned, the significant turnover generated under the marks, the number of stores in which the opponent's goods are available in the UK, and the continuity of use of the marks on the market, I have no hesitation in concluding that the opponent has made genuine use of both earlier marks during the relevant period in the relevant territory (being the EU including the UK, or the UK alone) for goods relating to protective clothing, casual clothing and protective gear for sports.

40. However, I must now decide on a fair specification.

Fair specification

41. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

42. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

43. In its submissions in lieu, the opponent states that its evidence of use demonstrates that the word-only earlier mark has been used in relation to the following goods:

Class 9: *Sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities; protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses; protective articles for sporting purposes (other than sporting articles or parts of sports suits); headwear for sporting activities for protection against injury; protection apparatus for personal use against accidents (other than sports articles or part of sports suits)*

Class 25: *Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts, shoes, boots, socks; all the aforesaid goods for use in relation to extreme sports activities.*

44. Further, it states that the logo mark has been used in relation to the following goods:

Class 9: *Sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities; protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories; headwear for sporting activities for protection against injury; protection apparatus for personal use against accidents (other than sports articles or part of sports suits)*

Class 28: *Protective articles for sporting purposes (other than sporting articles or parts of sports suits).*

45. The applicant did not comment on the opponent's evidence.

46. I shall start with class 9. Although I note that the extracts of UK sales for 2017 show the sales of £3,608 worth of eyewear under the lifestyle product line, these sales are outside the relevant period and are very small. Further, none of the catalogues or invoices exhibited in evidence include items of eyewear. Lastly, I do not consider that these types of goods belong to the same group or category as those for which the mark has been used, in particular sport goggles. Consequently, I find that the opponent cannot rely on the terms "*protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses*" (as covered by the earlier word-only mark) and "*protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories*" (as covered by the earlier logo mark).

74. The opponent's specification in class 9 also covers *Sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities*. Whilst the article from "Outside Business Journal" refers to the acquisition of the opponent as an opportunity to expand the business by gaining customers across mountain and road biking, skiing/snowboarding, and powersports, the only sport goggles shown in evidence are those from catalogues relating to motocross and mountain biking and there is nothing to suggest that these are the same as those used for snowmobiling, snowboarding, skiing and other snow-related activities.

Consequently, I find that the opponent can rely only on the term *Sports goggles for use in motorcycling and bicycling* under both earlier marks.

48. The opponent has also made genuine use of the earlier marks in relation to the registered term *headwear for sporting activities for protection against injury* and can rely on it under both earlier marks.

49. The registered goods in class 9 and class 28 also include *protective articles for sporting purposes (other than sporting articles or parts of sports suits)* (class 9 of the word-only mark), *protection apparatus for personal use against accidents (other than sports articles or part of sports suits)* (class 9 of both earlier marks) and *Protective articles for sporting purposes (other than sporting articles or parts of sports suits)* (class 28 of the logo mark).

50. Clearly, the exclusion “(other than sporting articles or parts of sports suits)” within the class 28 term “**Protective articles for sporting purposes (other than sporting articles or parts of sports suits)**” does not make sense. This is because if a protective article is designed for sport purposes it is necessarily a sport article. In this connection, the explanatory note to class 28 states:

“This Class does not include, in particular: certain gymnastic and sporting articles, for example, protective helmets, goggles and mouthguards for sports (Cl. 9), sporting firearms (Cl. 13), gymnasium mats (Cl. 27), as well as certain fishing and hunting equipment, for example, hunting knives, harpoons (Cl. 8), hunting firearms (Cl. 13), commercial fishing nets (Cl. 22), that are classified according to other functions or purposes”.

51. Notably, protective helmets, goggles and mouthguards for sports (all of which are protective articles for sport purposes falling in class 9) are also described as sporting articles. This confirms my understanding that protective articles for sporting purposes in class 28 are also sport articles and the restriction does not make sense within the context of the specification. Further, the UK classification tools lists various protective articles for sports as “sports articles” or “sporting articles” in class 28, including for example, *Protectors for elbows for use when riding bicycles [sports articles]; Protective*

supports for shoulders and elbows [sports articles]; Shin protectors [sports articles]; Fist protectors [sporting articles]. Those are the primary type of goods in relation to which the earlier marks have been used; if the restriction had priority over the existing term “*Protective articles for sporting purposes*” it would exclude the main goods in relation to which the earlier marks have been use. Consequently, since the restriction “*other than sporting articles*” within the term *Protective articles for sporting purposes (other than sporting articles or parts of sports suits)*” contradicts the first term “*Protective articles for sporting purposes*”, it should be ignored, and the opponent can rely on the term “*Protective articles for sporting purposes*”.

52. The opponent’s specifications in class 9 contains a similar restriction within the term “*protective articles for sporting purposes (other than sporting articles or parts of sports suits)*” (as covered by the word-only mark). Hence, for similar reasons to those I set out above, I conclude that the restriction contradicts the first term ““*protective articles for sporting purposes*” and should be ignored with the result that the opponent can rely on the term ““*protective articles for sporting purposes; all the aforesaid goods for use in relation to extreme sport activities*”.

53. Lastly, both earlier marks cover the term “*protection apparatus for personal use against accidents (other than sports articles or part of sports suits)*” in class 9. The evidence shows that the opponent uses the earlier marks in relation to a race subframe which is meant to provide protection in a motocross accident, as shown below:



WHITE
13558-008

PROFRAME LC CE

S/M | L/XL |

- Low profile neck brace compatible roost deflector
- Adjustable shoulder straps for a precise fit with or without neck brace
- Easy to use buckle system integrated into chest plate
- Removable back plate allows rider to wear chest plate only
- 2 position adjustable back plate for a precise fit
- Soft Biofoam chassis against body for a comfortable fit
- CE certified 1621-2

54. The subframe is essentially a chest and back protector that is intended to prevent injuries in motocross accidents. My understanding is that the subframe is designed to be worn by riders in the context of a motocross sport race, however, there is nothing in the evidence to suggest that it is also for wear by motorcyclists on the road. Hence, I consider that this use is not sufficient for the opponent to rely on the term *protection apparatus for personal use against accidents (other than sports articles or part of sports suits)* because the restriction excludes goods that are sport articles.

55. Turning to the specification in class 25, there is no evidence of the opponent selling tights or blouses under its lifestyle products line. Further although the extracts of sales from 2017 shows sales of £15k worth of footwear, that is outside the relevant period; the only evidence of sale of footwear which falls within the relevant period is that relating to boots. However, between the extract of sales for 2020, the catalogues and the invoices, there is enough evidence to support the conclusion that the earlier marks have been used in relation to the remaining goods in class 25.

56. Lastly, although the evidence about protective goods in class 9 and 28 is limited to goods relating to motocross and mountain bike riding, I do not consider that a fair specification needs to reflect that all of goods are limited to motocross and mountain bike riding. This is because it does not seem to me that helmets, guards, and other items of protective gear for use in sports are divided in subcategories of goods capable of being viewed independently according to the type of sport in which they are used and there is no evidence which indicates otherwise.

57. Accordingly, I consider that a fair specification for the word-only mark is as follows:

Class 9: *Sports goggles for use in motorcycling and bicycling; protective articles for sporting purposes; headwear for sporting activities for protection against injury; all the aforesaid goods for use in relation to extreme sport activities.*

Class 25: *Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, pants, shorts, hats, caps, sweatbands, headbands, gloves, belts, boots, socks; all the aforesaid goods for use in relation to extreme sports activities.*

58. I consider that a fair specification for the logo mark is as follows:

Class 9: *Sports goggles for use in motorcycling and bicycling; headwear for sporting activities for protection against injury.*

Class 28: *Protective articles for sporting purposes.*

Section 5(2)(b)

59. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(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.”

60. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

61. The following principles are gleaned from the decisions of the EU 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 B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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 greater 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 to mind the earlier mark, 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

62. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

63. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

64. In *Gérard Meric v OHIM* Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

65. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

66. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

67. Whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

68. In light of my previous finding, the competing goods are as follows:

The applicant's goods	The opponent's goods
<p>Class 9: <i>Protection devices for personal use against accidents; Reflective safety vests; Gloves for protection against accidents; Bullet-proof vests; Bullet-proof waistcoats; Bullet-proof clothing; Protective masks, not for medical purposes; Shoes for protection against accidents, irradiation and fire; Protective helmets; Riot shields; Goggles.</i></p>	<p>Earlier word-only mark</p> <p>Class 9: <i>Sports goggles for use in motorcycling and bicycling; protective articles for sporting purposes; headwear for sporting activities for protection against injury; all the aforesaid goods for use in relation to extreme sport activities.</i></p> <p>Earlier logo mark</p> <p>Class 9: <i>Sports goggles for use in motorcycling and bicycling; headwear for sporting activities for protection against injury.</i></p>
	<p>Earlier word-only mark</p> <p>Class 25: <i>Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, pants, shorts, hats, caps, sweatbands, headbands, gloves, belts, boots, socks; all the aforesaid goods for use in relation to extreme sports activities.</i></p>
<p>Class 28: <i>Elbow guards [sports articles]; Knee guards [sports articles]; Shin guards [sports articles]; Arm guards for sports use; Wrist guards for athletic use; Leg guards for athletic use; Chest protectors for sports use; Palm</i></p>	<p>Earlier Logo mark</p> <p>Class 28: <i>Protective articles for sporting purposes.</i></p>

<i>protectors for athletic use; Machines for physical exercises; Exercise bands.</i>	
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Class 9

69. In the counterstatement, which is the only document filed by the applicant, the applicant argues that the parties' goods in class 9 are dissimilar because the applied-for goods are primarily safety equipment and protective gear designed to prevent accidents and provide personal protection in various settings, including bullet-proof vests and clothing, protective masks, safety shoes, and riot shields, whereas the opponent's goods pertain to sporting gear. The opponent disagrees contending that there is no limitation to the goods within the applicant's specification to conclude that the contested goods cannot be used for sporting activities.

70. I agree that the applied-for terms Protective helmets and Goggles are not limited in any way and encompass (or are encompassed by) the opponent's terms *protective articles for sporting purposes; headwear for sporting activities for protection against injury; all the aforesaid goods for use in relation to extreme sport activities* (of the word-only mark) and *Sports goggles for use in motorcycling and bicycling; headwear for sporting activities for protection against injury* (of the logo-only mark). These goods are **identical** (*Meric*). The same goes for the applied-for term Protection devices for personal use against accidents, which includes protective helmets and protective goggles for extreme sports.

71. However, I do not consider that the natural meaning of the remaining terms Reflective safety vests; Gloves for protection against accidents; Bullet-proof vests; Bullet-proof waistcoats; Bullet-proof clothing; Protective masks, not for medical purposes; Shoes for protection against accidents, irradiation and fire; Riot shields cover protective goods for sporting purposes, as protective gloves and protective masks for sport are in class 28, not in class 9. The closest clash I can see here is with the earlier term *protective articles for sporting purposes* in class 28 which covers goods such as body armours, chest, back and abdomen protectors that are designed to protect the rider against injury in motocross accidents, as well as protective gloves and face masks for sport purposes, and protective shoes for sport purposes. Although

the opponent's goods are for use in sport or sport races, and the applied-for goods are for use in other settings, including the military or the industry, at a general level, the goods have the same nature, all being personal protective equipment, and purpose, all being used to offer protection to the user and prevent injuries against accidents. Although the uses are different, the method of use is the same, as the goods are worn on the body (with the exception of riot shields). However, the goods are neither complementary nor in competition, and there is no evidence that they share distribution channels. Overall, I consider these goods to be similar to a **very low degree** (i.e. *Riot shields*) or a **low degree** (i.e. *Reflective safety vests; Gloves for protection against accidents; Bullet-proof vests; Bullet-proof waistcoats; Bullet-proof clothing; Protective masks, not for medical purposes; Shoes for protection against accidents, irradiation and fire*).

Class 28

72. In its counterstatement the applicant admitted that the goods of Class 28 (excluding machines for physical exercises and exercise bands) are similar to the goods of the opponent's marks. I find that the opponent's *protective articles for sporting purposes* in the class 28 specification of the earlier logo-mark encompass the applicant's *elbow guards [sports articles]; knee guards [sports articles]; shin guards [sports articles]; arm guards for sports use; wrist guards for athletic use; leg guards for athletic use; chest protectors for sports use; palm protectors for athletic use*. These goods are **identical** on the principle outlined in Meric.

73. I accept that the nature and specific purpose of the applicant's *machines for physical exercises* and *exercise bands* in class 28 and the opponent's *protective articles for sporting purposes* in the same class is not the same because the applicant's goods are fitness machines and exercise bands constituting normal gym equipment and apparatus, whilst the opponent's goods are safety equipment used in sports and exercise. However, all of the contested goods belong to one homogeneous sector of the market and have a similar nature insofar as they are sport-related equipment and gear. In addition, a consumer might buy the opponent's equipment to prevent sport-related injury and the applicant's equipment (which includes exercise machines for home use) in order to exercise and increase strength and fitness, so the

goods target the same users. Further, the goods can be used together and are complementary to a certain degree, I think for example, to the opponent's goods including wrist wrap for weightlifting and the applicant's goods including machines with built-in weight stack. Finally, the goods are likely to be distributed through the same trade channels, for example, retailers or manufacturers of fitness and sport equipment. These goods are similar to a **low to medium degree**.

74. Alternatively, the applicant's elbow guards [sports articles]; knee guards [sports articles]; shin guards [sports articles]; arm guards for sports use; wrist guards for athletic use; leg guards for athletic use; chest protectors for sports use; palm protectors for athletic use are similar to a **medium degree** to the opponent's *protective goods for sports; all the aforesaid goods for use in relation to extreme sport activities* in the class 9 specification of the earlier word-only mark (which include helmets and goggles for sport activities) as the goods target the same users, have a similar nature and purpose, all being protective goods for sport activities, are distributed through the same trade channels and are complementary. Lastly, the same applies to the applicant's machines for physical exercises and exercise bands, although these goods are similar to a slightly lesser degree, i.e. a **low degree**, because the goods are not indispensable or important for the use of the other and cannot be said to be complementary.

Average consumer

75. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

76. The average consumer for the parties’ goods in class 9 and 28 will be a member of the general public purchasing protective equipment for sport purposes or for personal use, a business user purchasing protective equipment for work purposes, or those responsible for the procurement of supplies for the police force or the military. When selecting the goods and services, consumers will take a number of factors into account such price, quality, functionality and safety. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process by members of the general public whilst business users are likely to pay an above medium degree of attention.

77. The goods are likely to be selected from the shelves of retail outlets (or their online equivalents) or following the perusal of catalogues and marketing material. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that aural components may play a part as word-of-mouth recommendations may be made.

Comparison of marks


78. 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.”

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

80. The respective marks are shown below:

The applicant's mark	The opponent's marks
FOX ARMOUR	FOX 

81. The parties have made submissions on the similarities and differences between the marks.

82. The applicant states that while both marks share the common word 'FOX', the presence of the word 'ARMOUR' in the application creates a longer and more complex mark. It also states that the word 'ARMOUR' could be considered the most distinctive element of the mark, given that 'FOX' is a common English word and could be less memorable. Lastly, the applicant states that conceptually, the marks communicate different ideas because the word 'FOX' alone may convey images or associations related to the animal itself, whereas 'FOX ARMOUR' could suggest protection or strength, “given the association of 'ARMOUR' with defense and security.” (my emphasis)

83. The opponent submits that the distinctive element of the application is the word 'FOX', as the word 'ARMOUR' refers to an item that is worn on the body to protect the user from harm and is a descriptive reference to the nature of the applied-for goods.

84. The opponent also submits that in the earlier logo mark the fox head image reinforces the word 'FOX' and that the average consumer will perceive and read the logo mark as the word 'FOX'.

Overall impression

85. The opponent's word-only mark consists of the three-letter word 'FOX'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

86. The opponent's logo mark consists of the letter 'F', the device of a fox head, and the letter 'X'. I agree with the opponent that a significant part of the relevant public will verbalise the logo mark as the word 'FOX' because the device of a fox head will reinforce the concept conveyed by the word 'FOX', and the letters 'F' and 'X' will assist the perception of the device as a fox head, with both elements contributing equally to the overall impression.

87. The application is also a word-only mark consisting of two words, being the three-letter word 'FOX' and the six-letter word 'ARMOUR'. The word 'FOX' will be understood as a reference to a wild animal which looks like a dog and has reddish-brown fur, a pointed face and ears, and a thick tail (Collins online dictionary). When it is viewed in relation to goods that relate to protective equipment, the word 'ARMOUR' meaning "*strong covering that protects something, especially the body*" (Cambridge online dictionary) will be seen as descriptive, and the applicant conceded the relevance of that meaning although in the context of the mark rather than the goods. Further, the principle that the beginnings of marks tend to be more focused upon is fully applicable in this case as the second element of the application is descriptive. Consequently, I consider that 'FOX' will be viewed as the primary indicator of origin of the applied-for goods and will dominate the overall impression of the application, with 'ARMOUR' playing a lesser role.

The opponent's word-only mark and the application

88. Visually, the marks coincide in the distinctive verbal element 'FOX' which is the sole element of the earlier word-only mark and the first element of the application. They differ in the second verbal element of the application, namely the word 'ARMOUR', which has no counterpart in the opponent's mark and is descriptive. Overall, I consider the marks to be visually similar to a high degree.

89. Aurally, the earlier mark will be pronounced as FOCS, whereas the application will be pronounced as FOCS ARMA. Overall, I consider the marks to be aurally similar to a high degree.

90. Conceptually both marks will convey the concept of fox being a wild animal – this is the only concept conveyed by the earlier mark and the dominant and most distinctive concept conveyed by the application. The word 'ARMOUR' in application will convey the descriptive concept of a strong covering that protects something, especially the body and will be seen as having little or no trade mark significance in the context of the goods concerned. Overall, I consider the marks to be conceptually similar to a very high degree.

The opponent's logo mark and the application

91. Visually, the marks coincide in the letters 'F' and 'X'. They differ in the presence of a fox head device (in the earlier logo mark), and the letter 'O' and the descriptive word 'ARMOUR' (in the application). Overall, I consider the marks to be visually similar to a low degree.

92. Aurally, a significant proportion of the average consumers will pronounce the earlier logo mark as the word 'FOX', i.e. 'FOCS', whereas the application will be pronounced as 'FOCS ARMA'. Overall, I consider the marks to be aurally similar to a high degree.

93. Conceptually both marks will convey the concept of fox being a wild animal. The word 'ARMOUR' in application will convey the descriptive concept of a strong covering

that protects something, especially the body and will be seen as having little or no trade mark significance in the context of the goods concerned. Overall, I consider the marks to be conceptually similar to a very high degree.

Distinctive character of earlier mark

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

“22. 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).

23. 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).”

95. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

96. The opponent's earlier marks consist of the word 'FOX' and a logo version of the same word. I consider that neither the word fox nor the fox logo is suggestive or allusive of the goods covered by the specifications. I therefore consider the level of inherent distinctive character of the word-only mark to be medium. I consider that the device of a fox head replacing the letter 'O' in the logo mark is fanciful and increases the distinctiveness of the mark to an above medium degree. However, I also bear in mind that this increased distinctiveness does not assist the opponent because it is the distinctiveness of the common element that is the key.

97. I will now consider whether the distinctiveness of the earlier marks has been enhanced through use.

98. I have already discussed the evidence of use above. By the relevant date of 11 January 2023, the opponent had sold over £73million worth of goods in the UK. That is, by any means, a large amount of goods sold, indicating that the opponent has a significant presence on the UK market in relation to protective gear for sport, in particular gear for motocross and mountain bike. Further, Mr Robinson says that the opponent's goods are sold in over 400 stores in the UK which, again is, by any means, a significant number, especially when considering the nature of the goods concerned which represent only niche markets on account of, inter alia, their nature, as they relate to extreme sports and target only a certain type of consumer demographics.

99. Admittedly, there is limited evidence of marketing and advertising and no indication of market share. However, the article from "Outside Business Journal" says that the opponent is known as an industry leader in protective gear, apparel and accessories for motocross and mountain biking; whilst that article is not clearly targeted at the UK, the level of turnover generated under the earlier marks in the UK and the number of stores where the goods are sold in the UK, suggest in my view, that the opponent has achieved a significant level of market penetration in the UK especially having regard to the nature of the market for protective gear for motocross and motorbike riding. Hence, I conclude that the distinctiveness of the earlier marks has been enhanced through use to a degree between medium and high (for the word-only mark) and high (for the logo-earlier mark) for protective gear for motocross and motorbike riding.

Likelihood of confusion

100. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

101. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. (as he then was) 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 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).”

102. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added:

“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.”

103. Earlier in this decision I found that:

- The goods vary from identical to similar to a very low degree.
- The average consumer for the goods is a member of the general public purchasing protective equipment for sport purposes or for personal use, or a

business user who will pay a medium or above medium degree of attention during the purchasing process.

- Visual considerations are likely to dominate the selection of the goods, although I do not discount aural considerations completely.
- The application and the earlier word-only mark are visually and aurally similar to a high degree and conceptually similar to a very high degree.
- The application and the earlier logo mark are visually similar to a low degree, aurally similar to a high degree and conceptually similar to a very high degree.
- Inherently, the earlier word-only mark is distinctive to a medium degree and the earlier logo-mark is distinctive to a degree between medium and high. The distinctiveness of both marks has been enhanced through use to a medium to high degree (for the word-only mark) and high degree (for the logo mark).

104. The opponent's primary position is that there is a likelihood of direct confusion between the marks. In the alternative, in relation to the possibility of indirect confusion, the opponent states that "*where the consumer does readily perceive the subtle difference between the marks, the average consumer may conclude the differing element, i.e. ARMOUR, to be a sub brand or brand extension*", though it does not address the differences with the earlier logo mark.

105. I shall start with the word-only mark.

106. In relation to the applied-for goods which I found to be identical or similar to the specification of the word-only mark, I conclude that given the high level of visual and aural similarity and the very high level of conceptual similarity between the marks, and taking into account the descriptiveness of the differentiating element 'ARMOUR' in the application, it is likely that the relevant public will overlook the word 'ARMOUR' in the later mark, and give it little or no trade mark significance, focusing on the identical and dominant element 'FOX' and directly confusing the trade marks themselves. In those

circumstances, I find that the conclusion that there is a likelihood of direct confusion cannot be overcome by the fact that some of the goods are similar to a lesser degree or are selected with an above medium degree of attention as the only differentiating element between the marks is descriptive and the earlier mark is more the averagely distinctive.

107. Turning to the earlier logo-mark, admittedly the level of visual similarity is low and the goods are selected visually. Nevertheless, the earlier mark will still be verbalised, conceptualised and memorised by the relevant public as a fox mark, so the marks are aurally similar to a high degree and conceptually similar to a very high degree. Taking into account the high level of distinctiveness of the opponent's mark and the descriptiveness of the differentiating element 'ARMOUR' in the application, I consider that there is a likelihood of indirect confusion arising from the average consumer perceiving the application as a mark incorporating the opponent's brand 'FOX' in plain letter with the addition of a descriptive word. There is a likelihood of indirect confusion, even in relation to the goods which I found to be similar to a lesser degree.

108. The opposition under Section 5(2)(b) is successful.

Other grounds

109. As I have said previously, the only document filed by the applicant is its Form TM8 and counterstatement. In its defence, the applicant makes a general statement that it denies all of the opponent's claims with regards to Section 5(2)(b), Section 5(3) and Section 5(4); however, the only reasons the applicant provided for its denials are in relation to the grounds under Section 5(2)(b), namely that the goods are not similar, that the marks are not similar and that there is no likelihood of confusion; the applicant was completely silent as to why the claims under Section 5(3) and 5(4)(a) should not succeed. This means that there are no counter arguments to the opponent's claims under Section 5(3) and 5(4)(a).

Section 5(3)

110. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

111. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

112. The conditions of Section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applicant's mark are similar. Secondly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier marks being brought to mind by the later mark. Finally, assuming the first three conditions have been met, Section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of Section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

113. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 11 January 2023.

Reputation

114. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

115. Whilst enhanced distinctiveness and reputation are different, the factors relevant to both assessments are the same. For the same reasons given above, I consider that the opponent has demonstrated a strong reputation in the UK for protective gear for motocross and motorbike riding, the goods for which the opponent has a reputation falling within the registered terms in classes 9 and 28.

The Link

116. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

117. The application and the earlier word-only mark are visually and aurally similar to a high degree and conceptually similar to a very high degree. The application and the earlier logo mark are visually similar to a low degree, aurally similar to a high degree and conceptually similar to a very high degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

118. I have found that the goods vary from identical to similar to a very low degree. I apply the same findings in relation to the relevant public and purchasing process as set out above.

The strength of the earlier mark's reputation

119. The earlier marks have a strong reputation in the UK for protective gear for motocross and motorbike riding.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

120. The word-only mark is inherently distinctive to a medium degree and the logo mark is inherently distinctive to a medium to high degree. This has been enhanced through use in relation to protective gear for motocross and motorbike riding to a medium to high (where the starting point was medium) and high degree (where the starting point was medium to high).

Whether there is a likelihood of confusion

121. I have found there to be a likelihood of both direct and indirect confusion.

122. Taking into account all of these factors, in particular the high level of visual and aural similarity and very high level of conceptual similarity between the earlier word-only mark and the application, the enhanced distinctiveness and reputation of the earlier mark, the descriptiveness of the differentiating element of the application, and the nature and various degrees of closeness of the goods concerned, all of which are safety equipment and protective gear designed to prevent accidents and provide personal protection, I consider that even if I was wrong in that some of the goods are dissimilar based on the *Canon* criteria, they would still be sufficiently close to the core products for which the earlier mark has been used (and has acquired a reputation), that the application would create an association or link in the mind of the relevant public.

123. I reach the same conclusion in relation to the logo-mark. Admittedly, the degree of visual similarity is less pronounced here. However, I am of the view that the high degree of aural similarity and very high degree of conceptual similarity between the marks, combined with the enhanced degree of distinctiveness and reputation of the earlier mark and the nature and closeness of the goods concerned, are likely to result

in the familiarity of the average consumer with the earlier mark triggering the necessary link in the similar context of the applied-for goods.

Damage

124. The opponent's pleaded claim seems to be focused on the claim that many customers will confuse the two business as being the same. Indeed, to the extent that the relevant public believe that the goods of the applicant are the goods of the opponent, there will plainly be an unfair advantage.

125. It does not seem to me that the opponent has clearly pleaded a case based on reputation in circumstances where the goods are dissimilar since it has based its Section 5(3) claim on the assertion that the goods are either identical or similar. However, since the opponent's pleadings were based on the registered terms (rather than on the fair specification I have devised) and since I have found that some of the goods are less similar than the level of similarity pleaded by the opponent, I should make clear that (1) the fact that the opponent did not plead the existence of a link and damage for dissimilar goods would not prevent me from considering it and 2) even if I was wrong in that some of the goods are dissimilar based on the *Canon* criteria, there is no requirement for goods to be similar in order to cause confusion for reputable marks with extended protection under Section 5(3), and I consider that the average consumer would still be confused into thinking that the goods originate from the same undertaking, the opponent's reputation and the relatedness of the goods in terms of all being protective equipment for personal use bridging the gap between the goods. Consequently, I consider that in those circumstances there would unfair advantage on the basis of the average consumer being confused about the origin of the goods in relation to dissimilar goods. Damage is made out.

126. The opposition under Section 5(3) is also successful.

Section 5(4)(a)

127. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

128. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

129. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

130. Since the applicant did not file evidence of use, the relevant date is the filing date of the application, namely 11 January 2023.

Goodwill

131. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

132. For the same reasons given above, I am satisfied that the opponent had sufficient goodwill to sustain a passing-off claim at the relevant date for protective gear for motocross and motorbike riding.

Misrepresentation

133. Whilst the test for misrepresentation is different from that for likelihood of confusion in that it entails “*deception of a substantial number of members of the public*” rather than “*confusion of the average consumer*”, it has been acknowledged that they are unlikely to produce different outcomes in practice.¹² Certainly, I believe that to be the case here. For the same reasons set out above, I consider that there would be

¹² *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

deception of a substantial number of members of the public where the applicant's mark is used on goods which are in the same or similar field to those for which the opponent has goodwill; in this connection I reiterate that even if I am wrong and some of the goods are dissimilar under Section 5(2)(b), they are still in a similar field to those for which the opponent has goodwill, which would be sufficient to cause misrepresentation and damage.

134. For the sake of completeness, I should mention that the opponent filed evidence aimed at showing that the applicant is currently operating a website at www.foxarmour.com bearing the mark of the application in which it sells protective gear for motocross. Ms Kirby points out in her narrative evidence that this website is stated to be provided by Fox Armour Co., Ltd (the applicant's name being Deqing Fox Armour Co.,Ltd), with an address in China which corresponds to the address of the applicant in these proceedings. The purpose of this evidence is to show proof of damage as the opponent states:

“The Applicant is currently operating a website bearing the mark of the Application - see the Witness Statement of Sharon Kirby and the accompanying exhibits SK1 - SK3.

Accordingly, damage can be inferred where the risk of a deception misrepresentation is found. Jacob J (as he then was) explained in *Mecklermedia Corp - v-DC Congress GmbH* that in some cases the matter requires separate proof of damage, especially in the case where the fields of activity are wildly different. However, in other cases, the court is entitled to infer damage. It would be extremely damaging to the Opponent's business for the Applicant to be trading under a highly similar name in respect of identical and highly similar goods.”

135. I am not sure that this evidence adds anything to the opponent's case as it relates the goods which are identical to the core products in relation to which the opponent's earlier sign FOX has been used. Hence, I do not consider that it is necessary for me to comment any further.

136. The opposition under Section 5(4)(a) is also successful.

OUTCOME

137. The opposition succeeds in its entirety and the application will be refused registration.

COSTS

138. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the sum of £2,000, calculated as follows:

Preparing a notice of opposition:	£400
Filing evidence:	£1,000
Written submissions:	£400
Official fees:	£200
Total	£2,000

139. I therefore order Deqing Fox Armour Co.,Ltd to pay Fox Head Inc. the sum of £2,000. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 21st day of October 2024

TERESA PERKS

For the Registrar