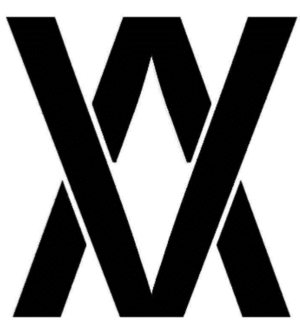
O/1046/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003903494
BY PAUL MULLEN AND ASHLEY VICKERS
TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 443558
BY MARKER DALBELLO VÖLKL (INTERNATIONAL) GMBH

BACKGROUND AND PLEADINGS

1. On 21 April 2023, Paul Mullen and Ashley Vickers ("the applicants") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 14 July 2023. The applicants seek registration for the following goods:

> **Class 25:** *Clothing.*

2. On 13 October 2023, the application was opposed in full by Marker Dalbello Völkl (International) GmbH ("the opponent") under Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. Under Section 5(2)(b), the opponent relies upon the following trade mark and the goods covered by the same as shown below:[1]

UK00915626807   Filing date: 08 July 2016 Registration date: 02 January 2017 Priority date: 11 January 2016[2] The mark is registered for goods and services in classes 9, 18, 25, 28 and 41, but the opponent relies upon the following goods only:

[1] 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 or International Registration designating the EU. As a result, the opponent's earlier mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in 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.
[2] Priority is claimed from US trade mark no. 86871845

Class 9: *Helmets for use in sports, Protective helmets for sports purposes; Spectacles for athletes, Snow goggles.*

Class 18: *Casual bags, Namely handbags, Luggage, Carrier bags, Bumbags, Duffel bags, Clutch bags, Drawstring bags, universal sports bags, Holdalls; Backpacks.*

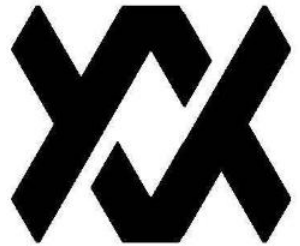
Class 25: *Wearing apparel, namely shirts, Athletic suits, Skirts, Sweat shirts, Tee-shirts, Shorts, Socks, Undershirts, Jackets, trousers, Chemises; Headgear, namely ski hats, snowboard hats, tennis caps, headbands and hats; Ski gloves and snowboarding gloves, Ski boots, Apres-ski shoes, Snowboarding boots and Tennis shoes.*

Class 28: *Sporting apparatus and articles, namely skis and snowboards, ski poles, ski bindings and snowboard bindings, tennis racquets, squash racquets, racquetball racquets, badminton racquets; Parts for these sporting apparatus and articles, fittings for these sporting apparatus and articles, namely containers specifically adapted to these sporting apparatus and articles, namely bags and covers; Climbing skins and crampons (climbing irons) for use with touring skis; back protectors, Namely back protectors for sports; Shin, knee and elbow protectors, namely kneepads for sports, Shin guards [sports articles], Elbow pads for sports; Grip tape and strings for racquets.*

4. The trade mark relied upon by the opponent qualifies as an “earlier trade mark” in accordance with Section 6 of the Act because it was applied for at an earlier date than the filing date of the applicants’ mark. Having been registered for more than five years at the date the applicants’ mark was filed for registration, the opponent’s earlier mark is subject to the use conditions contained in Section 6A(3) of the Act.

5. Under Section 5(2)(b), the opponent claims that the marks are visually similar and aurally and conceptually identical, and that the goods are identical or similar, leading to a likelihood of confusion.

6. Under Section 5(4)(a), the opponent relies upon the sign shown below which is self-evidently identical to the earlier mark:



7. The opponent claims to have used the sign throughout the UK since January 2016 in relation to the following goods:

> *Helmets for use in sports, protective helmets for sports purposes; spectacles for athletes, snow goggles; casual bags, namely handbags, luggage, carrier bags, bumbags, duffel bags, clutch bags, drawstring bags, universal sports bags, holdalls; backpacks; wearing apparel, namely shirts, athletic suits, skirts, sweat shirts, tee-shirts, shorts, socks, undershirts, jackets, trousers, chemises; headgear, namely ski hats, snowboard hats, tennis caps, headbands and hats; ski gloves and snowboarding gloves, ski boots, apres-ski shoes, snowboarding boots and tennis shoes; sporting apparatus and articles, namely skis and snowboards, ski poles, ski bindings and snowboard bindings, tennis racquets, squash racquets, racquetball racquets, badminton racquets; parts for these sporting apparatus and articles, fittings for these sporting apparatus and articles, namely containers specifically adapted to these sporting apparatus and articles, namely bags and covers; climbing skins and crampons (climbing irons) for use with touring skis; back protectors, namely back protectors for sports; shin, knee and elbow protectors, namely kneepads for sports, shin guards [sports articles], elbow pads for sports; grip tape and strings for racquets.*

8. The opponent claims that as a result of the extensive use and marketing of the goods supplied under the opponent's sign, the latter enjoys a considerable goodwill in the UK. It further claims that any use by the applicants of the applied-for mark in relation to the goods concerned would be likely to deceive customers into believing that there is some form of connection with the opponent's goods and that this would be likely to cause damage to the opponent.

9. The applicants filed a counterstatement denying the claims and putting the opponent to proof of use. The only admission made by the applicants is that the goods are similar; having admitted such a similarity, the applicants state that they would offer to *"limit the application and carve out skiwear by way of a fall-back position".*

10. The opponent is represented by Mathys & Squire LLP, and the applicants are represented by Cloch Solicitors. Only the opponent filed evidence. No hearing was requested and both parties filed written submissions in lieu. This decision is taken after careful consideration of the papers.

EU Law

11. 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.

The evidence

12. The opponent's evidence came in the form of the witness statement of Sandra Holfelder dated 4 June 2024. Ms Holfelder is employed by Marker Deutschland GmbH, of which the opponent is the parent company; she is the IP Manager responsible for all intellectual property rights of the opponent, a role which she has held for almost 7 years. Her statement is accompanied by 5 exhibits, being those labelled SH1 – SH5, and the purpose of her statement is to prove use of the opponent's mark and goodwill in the corresponding sign.

13. I do not intend to summarise the evidence filed in full here (or the submissions in lieu of the parties, for that matter). However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

PROOF OF USE

14. 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.”

15. 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.”

16. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union".

17. 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 Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

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

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

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

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: 22 April 2018 to 21 April 2023.

19. As the opponent's earlier mark is a comparable mark based upon an earlier EUTM, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment. With regard to assessing use within the EU (for the purpose of the earlier comparable mark), I also bear in mind that in *Lenoerken BV*

v Hagelkruis Beheer BV, Case C-149/11, the Court of Justice of the European Union ("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.[3]

The evidence of use

20. Ms Holfelde's evidence is as follows:

21. The opponent belongs to the ELEVATE OUTDOOR COLLECTIVE Group, a group of companies based in the USA. The opponent is based in Switzerland and is responsible for the trade mark rights used in relation to the Völki business around the world. Since 1923, Völki has manufactured skis in Germany where high-end skis are produced by a sister company of the opponent, Völki Sports GmbH, although production also takes place in Asia.

22. Ms Holfelde says that Völki is also renowned in the sport of tennis and that Völki tennis rackets were used by players such as Boris Becker, Michael Stich, Sergi Bruguera, Petr Korda and Jana Novotna. The list of current players includes Stefanie Vögele, Liezel Huber, Laura Siegemund and many senior and junior players on tour. The opponent has licensed the trade mark Völki and the earlier mark to a US company which manufactures tennis rackets and other products, including clothing.

23. The earlier mark was first introduced in around 2016 and is still used and promoted in the UK and the EU today.

24. Ms Holfelde says that the earlier mark is one of the opponent's core brands and is prominently displayed alongside the brand Völki on Völki's websites. Screenshot from Völki's German website at www.volkiperformancewear.de are exhibited;[4] whilst some

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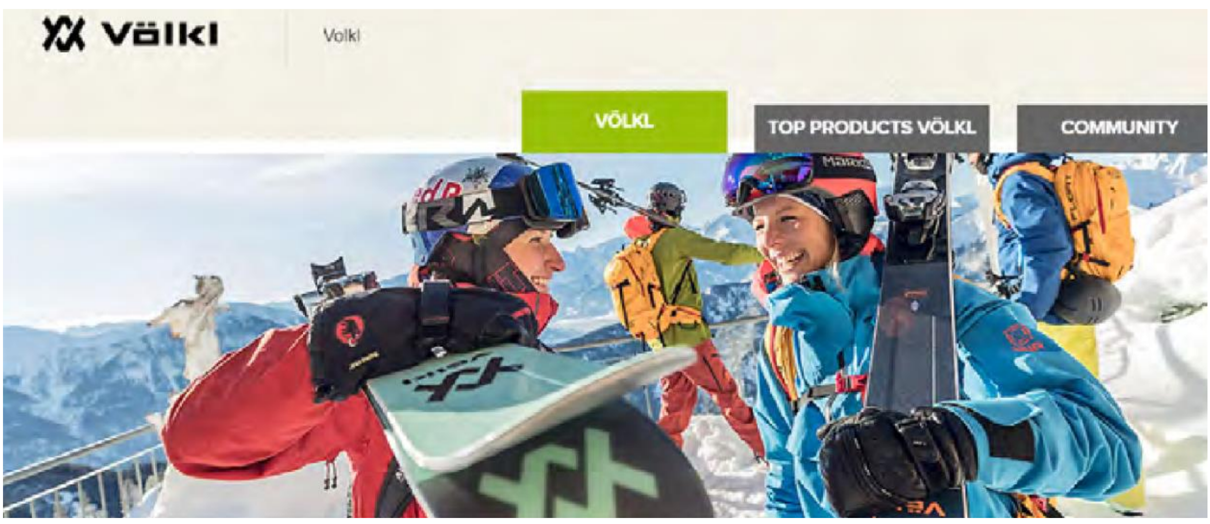
[3] See also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (paragraphs 228-230) and Case T-398/13, TVR Automotive Ltd v OHIM (paragraph 57)

[4] SH1

of the copies produced are undated, others are dated on various dates in 2018 (within the part of the relevant period preceding IP completion day); nevertheless, they all display the earlier mark used in conjunction with the brand name Völki as shown below:

25. The goods available to be purchased from the website include various items of skiwear, as well as ski goggles, gloves and hats; however, the earlier mark is not visible on the items of clothing, although it is visible on the website.

26. Ms Holfelde says that the opponent has spent significant time, money and effort in developing the earlier mark which is used in relation to a wide range of products, including clothing, bags and sports equipment such as skis, ski poles and accessories. Ms Holfelde exhibits extracts from various retailers' websites which show the earlier mark as well as products for sale bearing or referencing the earlier mark, examples of which are shown below:



27. Most of this evidence is relevant because it is from UK websites, and it is dated within the relevant period.

28. In terms of distribution, Ms Holfelde says that from 21 April 2018 to 20 April 2023, a total of approximately more than 10,200 products bearing the earlier mark were exported for sale in the UK, whilst approximately 1.1 million were distributed to retailers in the EU (excluding the UK) from 21 April 2018 to 31 December 2020. Sample invoices dated from 2018 relating to products bearing the earlier mark sold to distributors in the UK are exhibited; they show sales of various goods including sport bags, t-shirts, shorts, hoodies, and socks.

29. In terms of turnover, Ms Holfelde says that from 21 April 2018 to 20 April 2023, the total revenue for the products sold under or by reference to earlier mark was

approximately EUR 1.51 million in the UK and EUR 100.6 million in the EU (excluding the UK) as shown by the table below:

Time period	Total revenue for the Products (EUR)	
	United Kingdom	European Union
2018-2019	450,950	32.9 million
2019-2020	409,645	39.0 million
2020-2021	161,151	28.7 million
2021-2022	130,584	N/A
2022-2023	292,168	N/A

30. Lastly, although Ms Holfelde produces examples of the earlier mark being promoted in marketing material, including product catalogues for the years 2017-2018, 2021-2022 and 2023-2024, as well as social media pages, no marketing figures have been provided.[5]

Genuine use

31. The opponent's evidence is clear and concise. It shows that the opponent has used the earlier mark on websites, catalogues, social media and on the products themselves either alone or next to the brand name Völki. The use shown is relevant because it is within the relevant period, and within the relevant (UK and EU) territories. It is also acceptable, because use in conjunction with another mark (in this case in conjunction with the brand name Völki) is use of the mark as registered, as long as it continues to be perceived as indicative of the origin of the product[6] – which, in this case, it does. It is also sufficient, because although there is no indication of marketing figures or market share, the use has been continuous, the geographical spread is both in the UK and the EU, and the turnover figures are sufficiently solid (particularly in the EU) to establish that there is quantitative justification for genuine use to be found.

Fair specification

[5] SH4 and SH5
[6] *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

32. 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."

33. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

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

a fair specification of goods or services having regard to the use which has been made of the mark.

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

34. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that 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.

35. The best case for the opponent relates to use of the earlier mark for items of clothing (in class 25) and in relation to the various types of bags (in class 18) listed in the opponent's specification. I say this because these goods represent the closest clash I can identify with the applied-for goods. I will therefore focus on this aspect of the opponent's case.

36. Admittedly, the turnover is not broken down by product, which means that it is not possible to establish what proportion of the sales figures relate to items of clothing and/or bags. Making the best of what has been filed, the total value of the goods sold as shown by a spreadsheet introducing the invoices is over 13,000 Euros for bags and nearly 1,000 Euros for clothing including shorts, t-shirts, hoodies and socks. In addition, the invoices themselves - which Ms Holfeder says relate to products bearing the earlier mark sold to UK distributors - show (a) sales of other items of clothing

including (mostly) jackets and pants, for the following amounts (in Euros): 6,053; 8,0912; 13,167; 9,350; 17,024; 20,453[7] for a total of over 70,000 Euros and (b) sales of bags including (mostly) ski bags and sport bags for the following amounts (in pound sterling): 664; 286; 1,101; 277; 769; 209; 464; 289; 143; 12,665; 535; 713; 1,035; 89; 440 for a total of over £19,000.

37. Indeed, the invoices exhibited are only sample invoices. However, they are sufficient, in combination with the evidence of clothing and bags being marketed under the earlier mark, to indicate that a decent proportion of the total turnover relate to the sale of items of clothing and/or bags. Likewise, insofar as the description of the goods on the invoices does not show that the goods sold bear the earlier mark, this is not fatal because first, Ms Holfeder says that the invoices relate to the sale of goods bearing the earlier mark (and such evidence is not challenged), and second, the earlier mark is displayed on the invoices themselves, which I consider to amount to use of the mark in relation to the goods listed on the invoices.

38. Turning to the question of what a fair specification would be, I consider that the use shown relates to the following subcategories of goods: skiwear, casualwear, casual bags and sport bags. I therefore consider that the opponent can rely on the following goods in the specification which reflect the main categories of goods marketed by the opponent as shown by the invoices and the catalogues:

Class 25: *Wearing apparel, namely Tee-shirts, Jackets, trousers.*

Class 18: *Casual bags, namely universal sports bags, backpacks.*

39. For the sake of completeness, given the width of the applied-for specification which covers clothing at large, whether the fair specification I have devised is too restrictive or not, it is not going to make any difference to the outcome of the case.

[7] I have selected only the invoices which clearly relate to clothing or bags

Section 5(2)(b) of the Act

40. Section 5(2)(b) states:

> "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."

41. Section 5A states:

> "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."[8]

The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the CJEU 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.

[8] This section also applies to the ground raised under section 5(34.

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

42. In *Gérard Meric v OHIM,* Case T- 133/05, the 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 fur 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."

43. The competing goods are as follows:

The applied-for goods	The earlier goods
Class 25: *clothing*	**Class 25:** *Wearing apparel, namely Tee-shirts, Jackets, trousers.* **Class 18:** *Casual bags, namely universal sports bags, backpacks.*

44. The applied-for term *clothing* is sufficiently close to encompass all of the earlier class 25 goods, which are various types of clothing. These goods are identical on the principle outlined in *Meric.*

Average consumer

45. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' 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."

46. The average consumer of the goods at issue is likely to be a member of the general public. The cost of the purchase is likely to vary, depending on the item of clothing, but, overall, they will be relatively inexpensive. On average, consumers are likely to purchase these goods rather frequently. I find that consideration will be given to the materials used, the fit, the aesthetic appearance and the durability of the goods. Taking the above factors into account, I find that the average consumer will demonstrate a medium level of attention in respect of these goods.

47. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, online or through a catalogue equivalent. Overall, I am of the view that visual considerations would dominate the purchasing process.[9] However, I do not discount aural considerations entirely as it is possible that the purchasing of these kinds of goods would involve discussions with sales assistants or word of mouth recommendations.

[9] *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50

Comparison of marks

48. 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."

49. 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. The respective marks are shown below:

The application	**The opponent's mark**

Overall impression

50. Both marks are device only marks. The applied-for device comprises two overlapping ‘V’ shapes, with one ‘V’ shape being presented upside down; due to the overlapping position of the two ‘V’ shapes, part of the arms of the turned ‘V’ disappear behind the upright ‘V’ and is not visible. The overall impression is derived from this presentation.

51. The earlier device also comprises two intersecting ‘V’ shapes, with the left-hand side arm of the upright ‘V’ being cut by the overlapping turned ‘V’ and the right hand-side of the turned ‘V’ being cut by the overlapping upright ‘V’. The overall impression is derived from this presentation.

Visual similarity

52. In a visual comparison, the respective devices contain the same arrangement of shapes, namely one upright ‘V’ shape and one turned ‘V’ shape presented as overlapping, although the way the two ‘V’ shapes intersect is slightly different (the two ‘V’ shapes are placed one above the other in the applied-for mark, whereas they cross in the opponent’s mark); further, the way the arms of the two ‘V’ shapes open is slightly larger in the opponent’s device than in the applicant’s device.

53. The applicant states that “*the marks are “AV” (i.e. the initials of the applicant Ashley Vickers) vs “XX” – and thus visually, aurally, and conceptually different.”* The opponent states that the respective marks will either be understood as (i) two letter X’s side-by-side, (ii) a combination of the letter “A” with the letter “V”, or (iii) a caret (^) combined with a letter “V”. I accept that it is possible that a significant proportion of the relevant public will understand the shapes in the marks either as two conjoined letters ‘XX’, or two letters ‘V’ one of which is turned. I am not really convinced that the average consumer will understand the device in the application as a combination of a letter ‘A’ and a letter ‘V’; I say this because the letter ‘A’ contains a crossbar (i.e. the horizontal stroke that connect the two legs of the letter ‘A’) which is not present in the turned ‘V’ shape, and the applied-for mark does not contain any reference to the applicant’s name ‘Ashley Vickers’ which would support a reading of the device as the initials ‘AV’. Overall, I consider that whatever is the perception of the average consumer (as two

letters ‘X’ or as one upright ‘V’ and one turned ‘V’), it is the same in both marks and the marks are visually similar to a medium to high degree.

Aural similarity

54. Depending on how the average consumer will perceive the figurative elements of the marks, they will pronounce the marks as (i) ‘XX’, or (ii) ‘VV’ . In such scenario, the marks are aurally identical. Alternatively, the average consumer will not attempt to verbalise the marks as they will see them not as letters but as geometrical shapes resembling letters, in which case an aural comparison is not possible.

Conceptual similarity

55. The opponent states that the marks are conceptually identical because the average consumer *“will understand the respective marks as having the concept of either (i) two letter X’s, (ii) the letters AV (which would be commonly understood as an abbreviation of “audio-visual”, which has no descriptive meaning as regards the applicants’ goods or the opponent’s goods) or VA (for which the average consumer would not attribute a meaning, save for possibly as an abbreviation of “virtual assistant”) or (iii) a caret combine with the letter “V”, which has no conceptual meaning”*. In the alternative, the opponent states, the respective marks have identical conceptual meanings.

56. I disagree with the opponent insofar as I do not think the average consumer will attribute any meaning to the letters (if the shapes are perceived as letters) in the marks, because (a) there is no evidence that ‘AV’ or ‘VA’ are common abbreviations for “audio-visual” or “virtual assistant” and (b) I have also rejected the submissions that one of the shapes will be seen as a letter ‘A’.

57. In my view, if the marks are perceived as letters, they will both convey the concept of the same two letters, however, that is not a particularly distinctive concept. If they are perceived as geometrical shapes, they will convey no concept, and the conceptual position is neutral.

Distinctive character of earlier mark

58. 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 *WindsurfingChiemsee* 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)."

59. 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.

60. The earlier mark consists of an abstract device incorporating (or resembling) two letters, which has no meaning in relation to the goods for which it has been registered. Therefore, the earlier right is inherently distinctive to a medium degree.

61. Although the opponent claims that the earlier mark enjoys an enhanced degree of distinctiveness, it does not state that the enhanced distinctiveness results from the use that has been made of the mark; rather, the opponent's argument is that since the earlier mark will not be immediately understood by consumers, it enjoys enhanced distinctiveness; in this connection, the opponent says that because "*there are multiple possible interpretations of the opponent's mark, the average consumer will need to undertake a mental leap in order to understand one of the three possible conceptual meanings of the mark".* I reject the opponent's argument. The concept of enhanced distinctiveness relates to use of the mark and enhanced distinctiveness can only be acquired through use. Hence, whilst from an inherent perspective a mark can be more or less distinctive, the conceptual meaning of the mark cannot determine or generate enhanced distinctiveness (only distinctiveness).

62. As regards the evidence of use, whilst I have found it to be sufficient to establish genuine use, the threshold for enhanced distinctiveness is much higher. Given the gaps in the evidence, including the absence of marketing figures and market share, the relatively low UK turnover, and the fact that the turnover is not broken down by product, it is not possible to establish that the distinctiveness of the earlier mark has been enhanced through use to any material extent.

Likelihood of confusion

63. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. 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.

64. 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)."

65. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.

66. 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."

67. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17. This is mere association not indirect confusion.

68. Earlier in this decision I found that:

- The goods are identical. They will be purchased mainly visually (although aural considerations cannot be discounted) with a medium degree of attention.

- The marks are visually similar to a medium to high degree. Conceptually, they will either convey the weakly distinctive concept of two letters, or a conceptual comparison is not possible. Likewise, aurally they will either be pronounced as the same two letters (in which case they are aurally identical) or an aural comparison is not possible (as they will not be articulated).

- The earlier mark is inherently distinctive to a medium degree and the use made of it has not enhanced its distinctiveness to a material extent.

69. Bearing in mind all of the above, I consider that as a result of the medium to high degree of visual similarity between the marks, even if the aural and conceptual position is neutral, the identity of the goods, and the medium degree of distinctive character of the earlier mark, are likely to tip the balance in favour of the opponent. The respective marks both contain a device consisting of the same basic two shape configuration. In the absence of any conceptual or aural difference between the marks, bearing in mind the potential for imperfect recollection, it seems to me that the respective marks as a whole possess sufficient visual similarity that direct confusion through imperfect recollection is a real likelihood.

70. Lastly, for the sake of completeness, I consider that the applicant's proposed fall-back specification is not acceptable. This is because even if I were to exclude skiwear, the applied-for specification "*clothing, not including skiwear*", would cover other types of clothing which would still be identical to the goods relied upon by the opponent in class 25 and class 18 (which are not restricted to skiwear). Further, that would be the case even if I had restricted the opponent's fair specification to jackets and trousers being items of skiwear - in such case the opponent's *jackets and trousers being items of skiwear* would still be similar to the applicant's *clothing, not including skiwear,* because the latter would include, for example, padded trousers or winter jackets which although not suitable for skiing, are nonetheless highly similar to skiwear.

71. There is a likelihood of confusion. The opposition under Section 5(2)(b) is successful.

Section 5(4)(a)

72. 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."

73. Subsection (4A) of Section 5 states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

74. 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)."

75. 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 for Section 5(4)(a)

76. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:
>
> > 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

77. The *prima facie* relevant date is the date the contested mark was filed, that is to say 21 April 2023. As there is no evidence of the applicant having used the applied-for mark that is the only relevant date.

Goodwill

78. The requirement for a finding of goodwill is considerably less onerous than that of enhanced distinctiveness. Having found that there has been genuine use of the earlier mark, I also find that at the relevant date the opponent had a protectable goodwill in

the sign (which is identical to the registered mark) in relation to some of the goods relied upon which are items of clothing, namely tee-shirts, jackets, trousers.

Misrepresentation

79. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341* at page 407 the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."
>
> And later in the same judgment:
>
> ".... for my part, I think that references, in this context, to "more than *de minimis* " and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

80. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

> "64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the "substantial number" of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small."

81. Accordingly, once it has been established that the party relying on the existence of an earlier right under Section 5(4)(a) had sufficient goodwill at the relevant date to find a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

82. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

> "… if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement."

83. Although this was an infringement case, the principles apply equally under Section 5(2): see *Soulcycle Inc v Matalan Ltd,* [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora,* [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that *"a substantial number"* of the relevant public

are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises,* it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

84. In the present case, the sign and goods relied upon under Section 5(4)(a) are the same as those relied upon under Section 5(2)(a) and I find that the outcome is the same - there will be misrepresentation and damage will inevitably follow. The opposition based on Section 5(4)(a) also succeeds.

CONCLUSIONS

85. The opposition has been successful.

86. The application will be refused registration.

COSTS

87. 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 opponent the sum of £1,600 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement: £400
Filing evidence: £700
Submissions in lieu: £300
Official Fees: £200
Total: £1,600

88. I therefore order Paul Mullen and Ashley Vickers jointly and severally to pay Marker Dalbello Völkl (International) GmbH the sum of £1,600. 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 12th day of November 2025

TERESA PINTO
For the Registrar