O/1077/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003883442

IN THE NAME OF SIDNIE OLIVER JACE JOVAN RUDDER-MARKS AND MALAKI KALIM WELSH

FOR THE TRADE MARK:

IN CLASS 25

AND OPPOSITION THERETO UNDER NO. 442450

BY DECKERS OUTDOOR CORPORATION

BACKGROUND AND PLEADINGS

1. On 28 February 2023, Sidnie Oliver Jace Jovan Rudder-Marks and Malaki Kalim Welsh ("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 9 June 2023 and registration is sought for the following goods:

Class 25 Clothing; Clothes.

2. On 10 August 2023, the application was opposed by Deckers Outdoor Corporation ("the opponent") based upon sections 5(2)(b), 5(3), 5(4)(a) and 56(1) of the Trade Marks Act 1994 ("the Act"). Under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade marks:

UGG
UKTM no. 3060349
Filing date 18 June 2014; registration date 26 September 2014
("the First Earlier Mark")

UGG
UKTM no. 800902172[1]
Filing date 26 January 2006; registration date 22 October 2007
Priority date: 5 August 2005 (US)
("the Second Earlier Mark")

UKTM no. 801037027

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing International Registrations designating the EU ("IREU"). As a result of the opponent having IREUs being protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable trade marks shown here 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 retain their original filing dates.

Filing date 30 March 2010; registration date 1 April 2011
("the Third Earlier Mark")

UKTM no. 801304677
Filing date 9 May 2016; registration date 9 January 2017
Priority date: 5 May 2016 (US)
("the Fourth Earlier Mark")

3. These marks all qualify as earlier trade marks pursuant to section 6 of the Act.

4. Under section 5(2)(b) of the Act, the opponent relies upon the goods and services underlined in Annex 1 to this decision. The opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

5. Under section 5(3) of the Act, the opponent relies upon all goods and services for which the First, Third and Fourth Earlier Marks are registered. It relies upon the class 35 services for which the Second Earlier Mark is registered only. The opponent claims that use of the applicants' mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the earlier marks.

6. Under section 5(4)(a) of the Act, the opponent relies upon the sign UGG which it claims to have used throughout the UK since at least 2006 in relation to:

Leather and imitations of leather; bags; handbags; wallets, purses.

Clothing, footwear; headgear; articles of outer clothing; articles of casual clothing; leisurewear.

Retail store services, mail order catalog services and on-line retail store services featuring footwear, clothing, handbags and home accessories.

7. The opponent also relies upon a sign identical to the Third and Fourth Earlier Marks which it claims to have used throughout the UK since at least 2000 in relation to:

> Footwear; clothing, namely sweaters, shirts, pants, shorts, skirts, coats, jackets, vests, ponchos, snow suits, scarves, muffs, mittens and gloves; headwear; children's buntings.
>
> On-line retail store services relating to footwear, apparel, handbags and home accessories namely blankets, rugs and pillows; retail store services relating to footwear, apparel, handbags and home accessories namely blankets, rugs and pillows.

8. The opponent claims that use of the applicants' mark would be contrary to the law of passing off.

9. The opponent also sought to rely upon sections 5(2) and 5(3) based upon a well known trade mark as defined in section 56(1) of the Act. Suffice to say, the marks relied upon under this section are identical to those relied upon above. I will return to this ground, to the extent that it is necessary to do so, below.

10. The applicants filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use.

11. Neither party requested a hearing, and neither filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

REPRESENTATION

12. The applicants are unrepresented.

13. The opponent is represented by MW Trade Marks Limited.

EVIDENCE AND SUBMISSIONS

14. The opponent filed evidence in the form of the witness statement of Laurie Rose Lubiano dated 11 July 2024, which is accompanied by 10 exhibits (Exhibits A to J). Ms Lubiano is Intellectual Property and Commercial Counsel for the opponent; she has been an employee of the opponent since 2021.

15. The opponent's evidence was accompanied by written submissions dated 15 July 2024.

RELEVANCE OF EU LAW

16. 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

17. As the earlier marks had completed their registration process more than 5 years prior to the filing date of the mark in issue, they are subject to the use provisions of section 6A of the Act. As this is relevant to both the section 5(2)(b) and 5(3) grounds of opposition, I will deal with it first.

18. The relevant statutory provisions are as follows:

> "6(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."

19. Section 100 of the Act 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."

20. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application i.e. 29 February 2018 to 28 February 2023. As the Second, Third and Fourth Earlier Marks are comparable marks, use within the EU is relevant for the part of the relevant period which falls prior to IP Completion Day (i.e. 31 December 2020).[2] Only use in the UK will be relevant after that date. The First Earlier Mark is a UK trade mark and so only UK use will be relevant for the entirety of the relevant period.

21. 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*

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

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].”

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

23. Ms Lubiano explains that the UGG brand was founded in 1973 and was acquired by the opponent in 1995. Ms Lubiano states that the earlier marks were first used in the UK in 2003 in relation to footwear. The opponent now uses it in relation to footwear, apparel, accessories and homewares.

24. Ms Lubiano's evidence is that the opponent has three UGG stores in the UK: in Regent Street, Westfield and Knightsbridge. There is evidence that the Knightsbridge store was opened on 17 June 2024.[3] It is not clear to me exactly when the Westfield store opened, although there is a document with a copyright date of 2020 which refers to the Westfield store, so it must have been opened by then.[4] I also note that there is press coverage suggesting that the Regent Street store opened in 2023.[5]

25. Turnover figures for the opponent have been provided; they are significant, with the high point being £112million in 2022. However, these turnover figures are not particularly helpful as they are not broken down by either trade mark or category of goods/services. Mr Phillip Johnson, sitting as the Appointed Person in *EROS BODYGLIDE Trade Mark* described the issue as follows:[6]

> "26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or split between the two. This is why particularisation is so important as without it the figures provide no evidence of use for either good A or good B. The same applies where the same good is sold under trade mark A or trade mark B."

[3] Exhibit A
[4] Exhibit A
[5] Exhibit D
[6] BL O/0984/25

26. I must, therefore, examine the invoices provided by the opponent to assess the extent of the use.[7] The invoices are dated between 5 March 2018 and 30 January 2023. The customers are located around the UK including Scotland, Derbyshire, Middlesborough, Essex and London. However, there are issues with these invoices. It is, again, not clear to what products all of these invoices relate. Most of the product descriptions appear as follows (being some examples):

1122553	1122553-TAZZ Code: 6403.9998.90 BLACK
1119832K	1119832K-CLASSIC MINI BLOSSOM Code: 6403.9111.90 SEASHELL PINK

27. Given the evidence from Ms Lubiano that the opponent sells a whole range of products (shoes, clothing and homeware) these product descriptions could relate to any number of goods. I note that there are some product descriptions which contain more information. For example:

1117730	1117730-ASALA HOODIE Code: 6110.3099.00 GRANITE
1117731	1117731-NOREEN SHORT Code: 6104.6300.00 CREAM

These appear to be fairly self-explanatory in that they relate to shorts and hoodies. I also note the following product description:

[7] Exhibit B

1135092	1135092-CLASSIC ULTRA MINI PLATFORM Code: 6403.9118.90 BLACK	Origin: China				
		06	**07**	**08**	**09**	**10**
		10	20	25	2	5

28. Again, this is not absolutely clear. However, the reference to "platform" is most likely to be a reference to a type of shoe. I note that there is other evidence which suggests that the opponent does sell a platform shoe under the earlier marks. For example, the mark UGG is used in reference to a platform shoe in an article in *Elle* magazine dated September 2020.[8] The stylised version of the mark is used throughout the opponent's physical retail premises.[9] Bearing this in mind, as well as Ms Lubiano's narrative evidence that the earlier marks are renowned for footwear, I am prepared to infer that these sales relate to platform shoes sold under the earlier marks. Taking all of this into account, the following sales can be gleaned from the invoices:

Platform shoes	£46,853.32
Hoodies	£777.84
Shorts	£814.88

29. In terms of the marketing figures, they suffer from the same issues as the turnover figures; they are not broken down by product or mark. There is some evidence regarding advertising campaigns. For example, a campaign in Autumn 2020 reached "33.5million prospects in Germany and 26.2million prospects in the UK" and related to footwear.[10] As noted above, I have borne in mind that only UK use is relevant for the First Earlier Mark.

30. Given the amount of sales shown in the invoices, there has clearly been genuine use in relation to platform shoes. There is also evidence of other types of shoes being advertised by the opponent under the earlier marks. In my view, based on the evidence provided, the opponent should be entitled to rely upon "footwear" in the specifications of the First and Third Earlier Marks.[11] Whilst there is some, very limited evidence of retail outlets provided, I am not prepared to find genuine use in relation to the retail

[8] Exhibit D, page 83
[9] Exhibit A
[10] Exhibit G
[11] *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834

services in the absence of any further detail. I am also not prepared to find genuine use for any broader range of goods given the very small level of sales in evidence and the fact that the vast majority of the corroborating evidence focuses on footwear only. The opponent cannot, therefore, rely upon the Second and Fourth Earlier Marks under section 5(2)(b) or 5(3) of the Act.

Section 5(2)(b)

31. 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."

32. 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."

33. 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 wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

34. The competing goods are as follows:

Opponent's goods	**Applicants' goods**
Class 25 Footwear.	Class 25 Clothing; Clothes.

35. When making the comparison, all relevant factors relating to the goods 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."

36. 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.

37. These goods are often sold through the same trade channels, with retail businesses offering a range of clothing, footwear and accessories to their customers. The goods will clearly be purchased by the same users. The method of use and purpose of the goods will overlap in that they are all worn on the body with the intention of protecting the body and keeping the wearer warm, albeit they are likely to be worn on different parts of the body. The nature of the goods may overlap in some cases (where the same materials, such as leather, are used). However, I recognise that there will also be differences in the nature of the goods. In my view, the goods are similar to a medium degree.

The average consumer and the nature of the purchasing act

38. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

39. 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."

40. The average consumer for the goods will be a member of the general public. The average consumer is likely to consider factors such as aesthetics, comfort, materials and fit when purchasing the goods. The cost and frequency of purchase is likely to vary. In my view, the average consumer will pay a medium degree of attention during the purchasing process.

41. The goods are likely to be self-selected from the shelves of a retail outlet or online equivalent. Consequently, visual considerations are likely to dominate the purchasing process. However, I do not discount an aural component given that advice may be sought from retail assistants.

Comparison of trade marks

42. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impression created by the trade 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."

43. It would be wrong, therefore, to dissect the trade marks artificially, 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.

44. The respective trade marks are shown below:

Opponent's trade marks	Applicants' trade mark
UGG (the First Earlier Mark) UGG (the Third Earlier Mark)	

Overall Impression

45. The First Earlier Mark consists of the letters UGG. There are no other elements to contribute to the overall impression of the mark, which lies in these letters.

46. The Third Earlier Mark consists of the same three letters, presented in a stylised, overlapping font. The first letter G is slightly larger than the other two letters. In my view, the letters themselves play the greater role in the overall impression, with the stylisation playing a lesser role.

47. The applicants' mark consists of the letters UG, presented in a stylised font which creates the impression of the U being in front of the G, or of the letters being intertwined. In my view, the letters themselves play the greatest role in the overall impression, with the stylisation playing a lesser role.

Visual Comparison

48. The First Earlier Mark and the applicants' mark overlap in that they both contain the letters UG. They differ in that the First Earlier Mark includes an additional letter G. I bear in mind that the First Earlier Mark is a word only mark, which could be used in any typeface. In my view, the marks are visually similar to between a medium and high degree.

49. The applicants' mark and the Third Earlier Mark also include the letters UG, but differ in the additional letter G in the Third Earlier Mark. However, the Third Earlier Mark is presented in a font of its own, rather than being word only. This font is different to that in the applicants' mark, but they share some similarities; in particular, the intertwined/overlapping nature of the letters. In my view, the marks are visually similar to between a medium and high degree.

Aural Comparison

50. In my view, both earlier marks will either be pronounced as a word – UHHG – or as an acronym, with each letter being pronounced individually. The same is also true

of the applicants' mark. If the marks were pronounced as words then they would be aurally identical. If they are pronounced as acronyms then they will differ in that the earlier marks have an additional letter, which is absent from the applicants' mark. In that case, I find them to be aurally similar to between a medium and high degree.

Conceptual Comparison

51. I note the applicants' claim that its mark will be understood as an acronym for "Unknown Gallery". I have no evidence that this is the case and I can see no reason why the average consumer would attribute this meaning to the applicants' mark. I do not consider that any meaning will be conveyed by any of the marks. Consequently, the conceptual position is neutral.

Distinctive character of the earlier trade marks

52. 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 1-2779, 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)."

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

54. If the First Earlier Mark is viewed as an acronym, then it will not be particularly distinctive; it would be distinctive to a medium (or average) degree inherently. If it is viewed as an invented word, it would be considered highly distinctive. I do not consider that the stylisation in the Third Earlier Mark materially increases the distinctiveness of the mark as a whole. Consequently, the same finding applies.

55. Whilst there is evidence of use before me (as summarised above), it lacks specificity. I also note that whilst in its written submissions the opponent has made reference to various facts (such as awards won by the opponent and references on famous television shows), it is not clear to me that this is actually in evidence. The opponent has made no attempt to refer to any parts of the evidence which are relied upon for these purposes, nor have I been able to identify where this information can be found in the opponent's evidence. In the absence of evidence in this regard, as opposed to submission, I cannot take it into account. In my view, the evidence before me falls well short of establishing enhanced distinctiveness.

Likelihood of confusion

56. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods/services down to the responsible undertakings being the same or related. 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 goods/services may be offset by a greater degree of similarity between the marks, 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/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 trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

57. I have found as follows:

a. The goods are similar to a medium degree.

b. The average consumer is a member of the general public who will pay a medium degree of attention during the purchasing process.

c. The purchasing process is predominantly visual, although I do not discount an aural component.

d. The marks are visually similar to between a medium and high degree. They are aurally identical or similar to between a medium and high degree, depending upon whether they are perceived as invented words or an acronym. The conceptual position is neutral.

e. The earlier marks will be inherently distinctive to either a medium (or average) degree or to a high degree (depending on how they are perceived).

58. In my view, the differences between the marks are likely to be overlooked and the marks are likely to be mistakenly recalled or misremembered as each other when used on goods that are similar to a medium degree. Consequently, I find there to be a likelihood of direct confusion. Even if the differing stylisation between the applicant's mark and the Third Earlier Mark is recalled, this will simply be put down to an alternative mark being used by the same or economically linked undertaking.

59. The opposition based upon section 5(2)(b) succeeds in its entirety.

Final Remarks

60. For the avoidance of doubt, even if I had narrowed the use upon which the opponent could rely to “platform shoes” only, this would not have changed the outcome. This is because I would still have found the goods to be similar to a medium degree for the same reasons given above, and a likelihood of confusion would still have resulted.

Section 5(3)

61. 52. 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.”

62. I can deal with this ground relatively swiftly. I have summarised the opponent’s evidence of use above. It lacks the specificity required for me to properly be able to assess the amount of sales made under the marks prior to the relevant date, and in relation to which goods/services. Whilst I recognise that there has clearly been investment in advertising in the UK, the absence of other key information is, in my view, fatal to the opponent’s opposition under this ground. Consequently, the opposition falls at the first hurdle and I find that there is no reputation.

63. The opposition based upon section 5(3) of the Act is dismissed.

Section 5(4)(a)

64. Section 5(4)(a) of the Act states as follows:

> "5(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."

65. I can deal with this ground relatively swiftly. I find that the opponent had a modest (but protectable) goodwill for footwear at the relevant date. The signs relied upon were distinctive of that goodwill. 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] I find that to be the case here. The opposition under this ground will stand or fall with the section 5(2)(b) ground, for the same reasons.

66. The opposition based upon section 5(4)(a) of the Act succeeds in its entirety.

Section 56(1)

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

67. Section 56 of the Act is relevant to opposition proceedings by virtue of section 6(1)(c) of the Act, which states:

> "6(1) In this Act an "earlier trade mark" means –
>
> > (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark."

68. Section 56(1) of the Act states:

> "(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who –
>
> > (a) is a national of the United Kingdom or a Convention country, or
> >
> > (b) is domiciled in, or has a real and effective industrial or commercial establishment in, the United Kingdom or a Convention country,
>
> whether or not that person carries on business, or has any goodwill, in the United Kingdom.
>
> References to the proprietor of such a mark shall be construed accordingly."

69. The effect of these provisions is that a trade mark that is well known in the UK can be relied upon as an earlier mark for the purposes of opposition proceedings, even if it is not registered in the UK. It is not a ground of opposition in itself, but provides an additional avenue for demonstrating that the party bringing the opposition has an earlier right. It is intended to be used by parties who do not have an equivalent registered trade mark in the UK, but whose trade mark would nonetheless be well known amongst the UK relevant public. In this case, the opponent has trade marks

registered in the UK for the same marks relied upon under section 56(1). To the extent that the goods/services relied upon under section 56(1) are any broader than those discussed above, the evidence falls well short of establishing that the marks are well known for those goods/services in any event. Consequently, the provisions of section 56(1) do not take the opponent any further forward and I need not consider this any further.

CONCLUSION

70. The opposition is successful and, subject to any appeal, the application is refused.

COSTS

71. 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 **£1,150**, calculated as follows:

Preparing a Notice of opposition and considering the counterstatement	£350
Preparing and filing evidence	£600
Official fee	£200
Total	**£1,150**

72. I therefore order Sidnie Oliver Jace Jovan Rudder-Marks and Malaki Kalim Walsh to pay Deckers Outdoor Corporation the sum of **£1,150**. 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 19th day of November 2025

S WILSON

For the Registrar

ANNEX 1

The First Earlier Mark

Class 18

Leather and imitations of leather; bags; handbags; wallets, purses.

Class 25

Clothing, footwear; headgear; articles of outer clothing; articles of casual clothing; leisurewear.

The Second Earlier Mark

Class 1

Water and stain repellant for use on sheepskin and leather.

Class 3

Cleaner and conditioner for use on sheepskin and leather.

Class 24

Throws.

Class 27

Rugs.

Class 35

Retail store services, mail order catalog services and on-line retail store services featuring footwear, clothing, handbags and home accessories.

The Third Earlier Mark

Class 25

Footwear; clothing, namely sweaters, shirts, pants, shorts, skirts, coats, jackets, vests, ponchos, snow suits, scarves, muffs, mittens and gloves; headwear; children's buntings.

The Fourth Earlier Mark

Class 35

On-line retail store services relating to footwear, apparel, handbags and home accessories namely blankets, rugs and pillows; retail store services relating to footwear, apparel, handbags and home accessories namely blankets, rugs and pillows.