BL O/1089/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

INTERNATIONAL REGISTRATION NO. 1713636

BY RICHARD CLEVELAND MHINA

TO REGITER THE TRADE MARK:

SOLID SOLD AFRICAN

AFRICAN Fashion and Lifestyle

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 443846

BY DK COMPANY VEJLE A/S

AND

IN THE MATTER OF

TRADE MARK REGISTRATION NO: 911529443

IN THE NAME OF DK COMPANY VEJLE A/S

FOR THE TRADE MARK:

!Solid

AND APPLICATIONS FOR REVOCATION FOR NON-USE

UNDER NO. 506783

BY RICHARD CLEVELAND MHINA

Background and pleadings

The opposition

1. Richard Cleveland Mhina ("Party B") is the holder of the international registration ("the IR") shown on the cover page of this decision. The holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement on 20 February 2023. The registration was published for opposition purposes on 28 July 2023 and registration is sought for *Clothing, footwear* and *headwear* in class 25.

2. On 27 October 2023, DK Company Vejle A/S ("Party A") opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act").[1] Party A relies upon the following trade mark:

UK Registration No. UK00911529443[2]
Filing Date: 30 January 2013
Registration Date: 20 August 2013
Relying upon the following goods:

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

[2] Party A's mark was initially registered at the European Union Intellectual Property Office (EUIPO). On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of Party A's mark being registered as a EUTM, at the end of the Implementation Period, it was automatically converted to a comparable UK trade mark. The comparable UK mark is now recorded on the UK trade mark register and has the same legal status as if it had been applied for and registered under UK law, and the original filing date remains.

Class 25: Clothing, footwear, headgear, belts

3. Under section 5(2)(b), Party A claims that there is a likelihood of confusion on the basis that the marks are similar, and the goods are identical or similar.

4. Party B filed a form TM8 and counterstatement denying the claims made.

Application for revocation

5. On 12 December 2023, Party B filed an application to revoke Party A's earlier mark (UK00911529443 as shown above) on grounds of non-use under sections 46(1)(a) and (b) of the Trade Marks Act 1994 ("the Act"). The application for revocation is directed against all the goods and services for which Party A's earlier mark is registered, namely:

> *Class 18: Leather and imitations of leather, and goods made of these materials (not included in other classes); trunks and bags, including valises, travelling bags, women's bags, handbags, shopping bags, school bags, vanity cases, bags of leather for packaging, umbrellas, parasols, purses and pocket wallets.*
>
> *Class 25: Clothing, footwear, headgear, belts.*
>
> *Class 35: Business management; business administration; retail services in relation to clothing, footwear and headgear; management and consultancy for retail stores.*

6. Revocation is sought under section 46(1)(a) on the basis of alleged non-use during the 5-year time period immediately following the date of completion of the registration procedure i.e. 21 August 2013 to 20 August 2018, with an effective date of revocation of 21 August 2018.

7. Revocation is also sought under section 46(1)(b) on the basis of alleged non-use for the 5-year period from 21 August 2018 to 20 August 2023, with an effective date of revocation of 21 August 2023.

8. Party A filed a counterstatement denying the claims made by Party B.

Consolidated proceedings

9. On 08 March 2024, the Tribunal wrote to the parties, directing that these cases be consolidated in accordance with Rule 62(1)(g) of the Trade mark Rules. From that point on, the two cases proceed as one consolidated set of proceedings.

10. Party A is represented by Patrade A/S and Party B is represented by Trade Mark Wizards Limited.

11. Both parties filed evidence and submissions. Neither party requested to be heard nor filed written submissions in lieu of a hearing, and so this decision is made following careful consideration of the papers.

Evidence

12. Party A filed evidence consisting of the witness statement of Charlotte Boddum Rask and exhibits 1-15. Ms Boddum Rask is a partner at Patrade A/S, the legal representative of Party A. The evidence filed seeks to demonstrate that the contested mark has been put to genuine use throughout both relevant 5-year periods.

13. Party B's evidence consists of the witness statement of Richard Cleveland Mhina and exhibit RM1. The evidence seeks to demonstrate that the word "solid" is commonly used in relation to clothing.

14. Party A filed evidence in reply consisting of the second witness statement of Charlotte Boddum Rask and exhibits 16-17. Exhibit 16 contains an earlier EUIPO decision between itself and Party B.[3] Whilst I note the contents and findings of that decision, I am not bound by it and will proceed to conduct a full comparison, having regard to the case law set out later in this decision and all the relevant factors.

15. I have given due consideration to all of the documents and will refer to the evidence to the extent it is necessary in my decision.

DECISION

The law in relation to revocation and genuine use

16. Section 46 of the Act states that:

"(1) The registration of a trade mark may be revoked on any of the following grounds–

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c)…

(d)...

[3] EUIPO opposition no. B 3 192 343

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) […]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from–

(a) the date of the application for revocation,
or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date."

17. 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."

18. Given that the contested mark is a comparable mark, pursuant to paragraph 8 of Part 1, Schedule 2A of the Act, the Party A may rely upon use of its mark in the EU (including the UK) for any part of the relevant periods which fall prior to IP Completion Day, being 31 December 2020. However, any genuine use after IP Completion Day must relate solely to use in the UK.

19. A finding of genuine use during the latter relevant periods will be sufficient to avoid revocation of the mark under section 46(1)(b), and, by virtue of section 46(3), under section 46(1)(a). Provided that such use is deemed to be genuine use, this will be the case even if the evidence in relation to the earliest period is deemed insufficient.

20. 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].”

21. As regards the territorial scope of the use of an EUTM, in *Walton International,*[4] Arnold J (as he then was), after setting out the eight applicable principles when assessing genuine use (which are the same as the eight principles he subsequently set out in *easyGroup Ltd*),[5] added the further three principles when assessing genuine use in the EU:

> "118.*The law with respect to genuine use in the Union*. Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark "in the Union". In this regard, the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:
>
> (9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].
>
> (10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]–[55].
>
> (11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50]."

[4] *Walton International Ltd & Anor v Verweij Fashion BV*, [2018] EWHC 1608 (Ch), (which is also a decision by Arnold LJ, or Arnold J as he then was, that predates his decision in *easyGroup Ltd*).

[5] Ibid., paragraphs 114 and 115.

Form of the mark

22. Before I move on to assess Party A's the evidence for genuine use, I shall begin by addressing the way in which the contested mark has been displayed in relation to the relevant goods and services in evidence.

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

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive,

but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

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

24. In *Dreamersclub Ltd v KTS Group Ltd,* BL O/091/19, Professor Phillip Johnson, sitting as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS.

This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

25. The mark as registered is show below:

26. The evidence also shows the mark displayed as follows:

Variant (i)

Variant (ii) 

27. In relation to the form of the mark, Party B submits that Party A has used a different font for the mark as registered in the evidence, and this has therefore fundamentally altered the distinctive character of the mark.[6]

28. In respect of both variants, I agree that those signs are displayed in a slightly different font to that of the registered mark however, this difference is minimal and does not alter the distinctive character of the mark as registered. Further, in relation to variant (ii) it is well-established that registration of a mark in black and white covers the use of the mark in different colours and I do not consider that such use as shown in variant (ii) alters the distinctive character of the mark. As such, these variants both constitute as acceptable variant use of the contested mark and use of those variants is use upon which Party A can rely.

[6] Paragraph 2 of Party B's submissions.

Evidence of use

29. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[7]

30. I remind myself that the first relevant period is **21 August 2013 to 20 August 2018** and the second relevant period is **21 August 2018 to 20 August 2023.**

31. I note the following from the evidence:

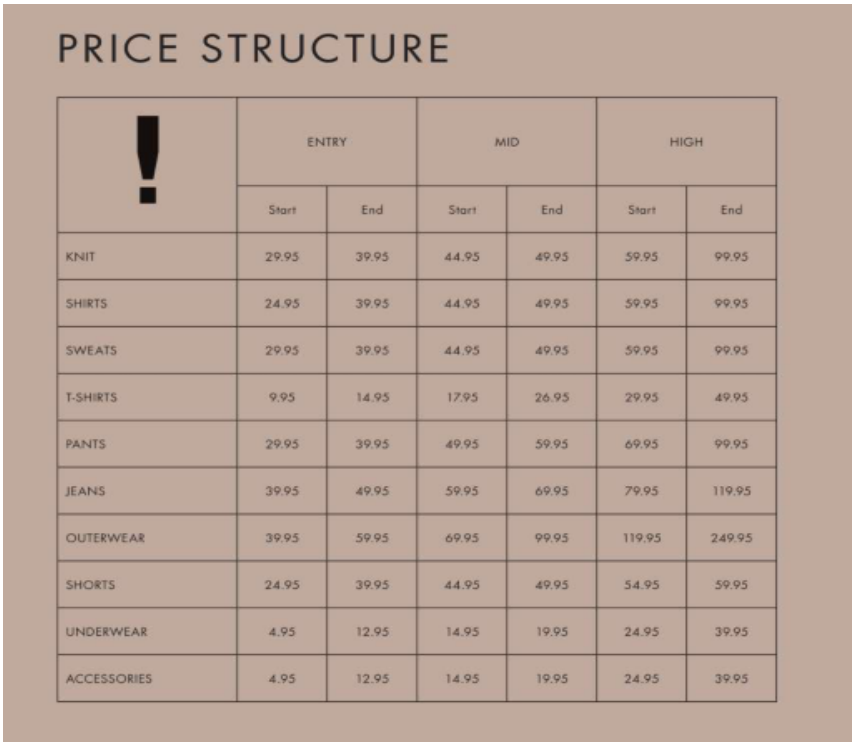
    a) Exhibit 1 contains a selection of invoices sent to businesses in the UK. Each invoice displays Party A's mark. I have summarised the contents in the following table:[8]

Invoice date	**Products sold**	**Invoice total**
29.11.2019	Jackets and pullovers	362 GBP
02.01.2020	Jackets	32,256 USD
21.02.2020	Polo shirts	66.10 GBP
25.09.2020	Shirts, T-shirts, jackets and hoodies	1871.24 GBP
08.04.2021	T-shirts and sweatshirts	1657.32 GBP
01.09.2021	Waistcoats and pullovers	673.14 GBP
09.05.2022	T-shirts	3150 GBP
24.10.2022	T-shirts and shirts	4179 USD

    b) Exhibits 2-19 include Party A's catalogues dated from 2019 to 2023 each displaying the "!Solid" mark alongside menswear goods such as t-shirts, jumpers, jackets, hoodies and trousers. It is not explained in the evidence how widely the catalogues were distributed or to whom

[7] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09
[8] I have not included one invoice on account of it being dated after both relevant periods. It is therefore not relevant in my assessment of use.

however, I can infer that they are not intended for end-consumers. I say this because the 2019 catalogue refers to its “B2B shop” which I take to mean “business to business”. This is further supported by the invoices provided in exhibit 1. Moreover, none of the catalogues display the price of any of the products. Instead, a suggested pricing structure is included:



PRICE STRUCTURE

!	ENTRY		MID		HIGH	
	Start	End	Start	End	Start	End
KNIT	29.95	39.95	44.95	49.95	59.95	99.95
SHIRTS	24.95	39.95	44.95	49.95	59.95	99.95
SWEATS	29.95	39.95	44.95	49.95	59.95	99.95
T-SHIRTS	9.95	14.95	17.95	26.95	29.95	49.95
PANTS	29.95	39.95	49.95	59.95	69.95	99.95
JEANS	39.95	49.95	59.95	69.95	79.95	119.95
OUTERWEAR	39.95	59.95	69.95	99.95	119.95	249.95
SHORTS	24.95	39.95	44.95	49.95	54.95	59.95
UNDERWEAR	4.95	12.95	14.95	19.95	24.95	39.95
ACCESSORIES	4.95	12.95	14.95	19.95	24.95	39.95

c) Exhibit 20 contains several invoices issued from China. Party A claims that this shows that clothing with the “Solid brand” has been sent to Denmark since 2013. There is no further information provided by way of narrative evidence. While I note the contents of these invoices, they appear to show Party A purchasing menswear goods from a company called *Wellingford Corporation Ltd.* I am of the view that this constitutes internal use, and I remind myself that internal use is not sufficient to demonstrate genuine use.

d) Exhibit 24 contains two articles from Danish news outlets which describe how the Danish football player Daniel Agger was a model for

the “!Solid” brand. These articles are dated 5 August 2013 and 7 August 2013 respectively which falls before the first relevant period.

e) Exhibit 25 contains several images from Party A’s Facebook page. From the images provided, I note the following:

- “!Solid” opened a store in Copenhagen on 9 September 2014. The mark is clearly visible via signage on the front of the store.
- On 11 July 2016, Party A attended a fashion fair in Amsterdam. The mark is displayed next to rails of men’s clothing.
- On 9 February 2017, Party A attended a fair in Madrid. The mark is visible alongside items of men’s clothing.
- On 6 July 2017, Party A attended a fair in Berlin. The mark is visible alongside items of men’s clothing.

Assessment of genuine use

32. In making my assessment, I am required to consider all relevant factors, including (i) the scale and frequency of the use shown; (ii) the nature of the use shown; (iii) the goods and services for which use has been shown; (iv) the nature of those goods and services, and the market(s) for them; and (v) the geographical extent of the use shown.

33. The evidence clearly has its shortcomings. The exhibits are supported with very little in the way of narrative evidence and no turnover figures, sales volumes, marketing expenses, or promotional materials were provided. Moreover, some of the evidence falls outside of both relevant periods. However, the test is not whether the use has been quantitatively significant, but whether there has been real commercial exploitation of the mark intended to create and preserve an outlet for the goods which are sold under or in relation to that mark.[9] I also remind myself that the assessment of genuine use is not simply about sales figures, and I must consider them alongside

[9] *Ansul* at [43].

other evidence of use.[10] The invoices provided in exhibit 1 show consistent use of the mark for clothing goods throughout the second relevant period. Further, I note the attendance at several fairs shown in exhibit 25 along with the catalogues provided fall within the first relevant period.

34. I find that the use made by Party A is more than merely token and is clearly an attempt to create or maintain a market for the goods relied upon in the UK (or a member state of the EU prior to IP Completion Day). Accordingly, I conclude that the evidence before me establishes that there has been genuine use of the mark at issue during the relevant periods. That being said, I do not consider that Party A has demonstrated use for all goods and services for which its mark is registered, and I will now consider a fair specification.

Fair specification

35. 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."

36. 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:

[10] Case T-467/20 *Industria de Diseño Textil, SA (Inditex) v EUIPO*, EU:T:2021:842.

“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."

37. Having reviewed the evidence, I am of the view that the average consumer would view Party A's use as use in relation to *clothing.* This is because the invoices, catalogues and images of the use at fairs show the mark alongside clothing items such as jackets, jumpers, t-shirts, shirts and trousers. Notwithstanding the evidence exclusively shows use in relation to menswear, menswear is an appropriate sub-category of the broad term *clothing*, therefore, bearing in mind the proper approach to partial revocation set out above, I find that Party A should be able to retain this term.

38. As for the remaining goods and services, there is nothing before me to demonstrate that Party A has sought to create or preserve a market share for the provision of these goods and services. As such, I find that Party A has failed to show use for the following goods and services:

> Class 18: Leather and imitations of leather, and goods made of these materials (not included in other classes); trunks and bags, including valises, travelling bags, women's bags, handbags, shopping bags, school bags, vanity cases, bags of leather for packaging, umbrellas, parasols, purses and pocket wallets.
>
> Class 25: footwear, headgear, belts.
>
> Class 35: Business management; business administration; retail services in relation to clothing, footwear and headgear; management and consultancy for retail stores.

39. With effect from 21 August 2018, Party A's mark is partially revoked. It shall remain registered for *clothing* in class 25.

The Opposition

Section 5(2)(b): legislation and case law

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

"(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 or association with the earlier trade mark."

Proof of use

41. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of Party A's mark is the five years ending on the designation date of Party B's IR, i.e. 19 February 2018 to 20 February 2023.

42. I note that for the revocation under section 46(1)(b), the period of 21 August 2018 to 20 August 2023 was assessed. As most of this period overlaps with the relevant proof of use period under the opposition, I consider that the same considerations and conclusions apply. Proof of use is shown for Party A's *clothing* in class 25 only and is therefore the only term which Party A can rely upon.

Section 5(2)(b)- case law

43. In making this decision, I bear in mind the following principles 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 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

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

"23. 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."

45. 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.

46. The goods in question are as follows:

Party A's goods	**Party B's goods**
Class 25: Clothing	Class 25: Clothing, footwear, headwear.

47. Party A's *clothing* is identical to Party B's clothing.

48. In respect of Party B's *footwear* and Party A's *clothing,* I consider these goods would overlap in terms of purpose, user and trade channels. I also consider that they are likely to be produced by the same undertaking. There is no degree of competition, nor is there any complementary relationship to be found. On balance, I find these goods to be similar to a medium degree.

49. Party B's *headwear* would be sold in the same outlets as Party A's *clothing* and users would also overlap. The respective goods may be made from the same materials such as wool or cotton. The purpose of the partes' goods overlap as they will both be worn in order to protect or cover the body, and sometimes also as an adornment. The goods are not complementary and there is no competition between the same. In my view, the goods are similar to a medium degree.

The average consumer and the nature of the purchasing act

50. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services 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 was then) 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."

51. The average consumer of the goods at issue will primarily comprise members of the general public. The cost of the goods in issue is likely to vary and the goods will be purchased relatively frequently. Various factors are likely to be taken into consideration during the purchasing process, such as materials used, available sizes, cut, aesthetic appearance and durability for the goods. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods. In my view, the average consumer for these goods will pay a medium degree of attention.

52. The goods will be purchased either from a clothing or department store, either vising a physical shop or ordering from the internet or a printed catalogue. This means that the mark will be seen and so the visual element of the mark will be the most significant.[11] Although I do not discount an aural element, as the consumer may in some cases be assisted by a member of staff, even in those circumstances, the consumer will view the mark before making a purchase, therefore visual considerations will dominate.

Comparison of the marks

53. It is clear from *Sabel v Puma AG* (particularly paragraph 23) 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 impressions created by the trade marks, bearing in mind their distinctive and dominant components.

54. 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

[11] *New Look limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, at [50].

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."

55. 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.

Party A's Mark	Party B's Mark
	

Overall impression

56. Party A's mark consists of the word "Solid" preceded by an exclamation mark. The mark is presented in a standard bold typeface. Although the word "Solid" is preceded by an exclamation mark, I find that the word "Solid" is the most dominant and distinctive part of the mark on account of it being the only verbal element. The exclamation mark will simply be perceived as a punctuation mark to provide emphasis and as such, plays a secondary role. The stylisation of the mark is not remarkable and plays only a minor role.

57. Party B's mark comprises several elements. The most prominent element is the wording "SOLID SOLID AFRICAN". The first iteration of the word "SOLID" and the word "AFRICAN" are both presented in standard upper-case lettering whereas the second iteration of the word "Solid" is significantly stylised but

not to the point that the word ‘Solid’ is unintelligible. This wording is presented on a thin black horizontal line. Below this are the words “AFRICAN Fashion and Lifestyle” in a smaller standard back font.

58. Notwithstanding that as a general rule, greater attention is paid to the beginning of marks, I am of the view that the stylised iteration of the word “SOLID” plays the greatest role in the overall impression is it appears in the centre in a slightly larger, stylised font and immediately catches the eye. The preceding iteration of “SOLID” plays a secondary role. Whilst I accept that the word “AFRICAN” also appears in a large font alongside the wording “SOLID SOLID”, the word “AFRICAN” will be perceived as indicative of the style or origin of the clothing goods that are sold and therefore this word holds less weight in the overall impression. This is further reinforced by the smaller wording “African Fashion and Lifestyle” which will be perceived as an informational slogan and will also play a lesser role in the overall impression.

Visual comparison

59. The marks overlap visually through use of the word “Solid”. I note that this word is reproduced twice in Party B’s mark. Moreover, I remind myself that I have found this word to be the dominant element of both marks. The marks differ by way of the exclamation mark in Party A’s mark which is not present in Party B’s mark. The additional wording in Party B’s mark along with the stylisation of the second iteration of the word “Solid” also has no counterpart in Party A’s mark. Balancing the similarities and differences and keeping in mind my findings on the overall impressions, I consider the marks to be similar to no more than a medium degree.

Aural comparison

60. Party A’s mark comprises the word “Solid” which is a dictionary defined word. It will be pronounced in the usual way. I do not consider that the exclamation mark will be articulated by consumers.

61. In considering the aural impact of Party B's mark, it is my view that the words "AFRICAN Fashion and Lifestyle" will not be articulated by the average consumer. In making this finding, I have borne in mind the decision of Mr Philip Harris, sitting as the Appointed Person, in *Purity Hemp Company Improving Life as Nature Intended*.[12] At paragraph 31, he said that the descriptiveness of an element does not in itself render that element negligible or *"aurally invisible".* In the present case, the descriptive wording in Party B's mark is smaller than "SOLID SOLID AFRICAN", and the articulation of the smaller wording would add a further eight syllables. I consider that these factors would lead to the consumer articulating the mark as "SOLID SOLID AFRICAN".

62. The marks therefore share the identical word "Solid" although this word is repeated in Party B's mark. Party B's mark also contains the word "African" which creates a point of difference. On balance, I consider there to be a medium degree of aural similarity.

Conceptual comparison

63. Conceptually, the marks coincide through their use of the word "Solid". This word has several dictionary definitions including a solid substance consisting of matter all through, to be firm, strong or compact, or to be reliable or of having a single uniform colour or tone.[13] However it is perceived by consumers, this word will share the identical conceptual message.

64. The word "African" in Party B's mark will be understood by consumers as a geographical indication of the origin of the goods. This concept will be further reinforced by the wording "African Lifestyle and Clothing". This concept has no counterpart in the earlier mark.

[12] BL O/115/22
[13] https://www.collinsdictionary.com/dictionary/english/solid

65. Party A's mark also includes an exclamation mark however, I do not consider that this would convey a conceptual message to the consumer.

66. On balance, I consider the marks share a medium degree of conceptual similarity overall.

Distinctive character of the earlier mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

68. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

69. I will begin by considering the inherent position. Party A's mark is a figurative mark consisting of the word "Solid" preceded by an exclamation mark. Party B claims that the word "solid" is descriptive in relation to clothing and has filed evidence displaying the word "solid" used alongside items of clothing.[14] The evidence shows the word "solid" is used to describe fabric that has a single uniform colour.

70. I accept that the word "solid" may be seen by some consumers as describing the way in which colour is used in the context of fabric i.e. a solid (single) colour fabric as opposed to a patterned fabric, however, I do not consider that this renders the word as being directly descriptive in relation to clothing. Further, the word "solid" has many known definitions to the UK consumer and there is nothing before me in the evidence to show that the relevant UK consumer would immediately grasp the concept that the clothing is made with fabric consisting of one uniform colour – it is in any way a rather unusual concept if that is indeed the case. On balance, I consider Party A's mark to have a medium degree of inherent distinctiveness.

71. I will now consider whether the evidence filed by Party A demonstrates that the distinctiveness of the earlier mark has been enhanced through use. I rely on the summary of the evidence that I provided in paragraph 31 earlier in this decision. The relevant date for this assessment is the filing date of Party B's mark being 20 February 2023 and the relevant market for assessing enhanced distinctiveness is the UK market (notwithstanding the mark is a comparable mark).

[14] Witness statement of Richard Cleveland Mhina and exhibit RH1

72. Party A has clearly made sales in the UK market. However, they are not particularly extensive when considering the likely size of the UK market in relation to clothing. I have no turnover figures or any information about the advertising expenditure in the UK or any activities taken to promote Party A's goods in this jurisdiction. Whilst I found the evidence sufficient to show genuine use, I remind myself that the bar for proving enhanced distinctiveness is considerably higher. This is because it requires a level of knowledge of the mark amongst average consumers leading to the mark having a greater capacity to identify the goods as coming from a particular undertaking, not simply that there has been an attempt to create or maintain a market for goods under the mark. Taking into account all the evidence, I am not satisfied that the distinctiveness of the earlier mark has been enhanced through use.

Likelihood of confusion

73. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

74. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

75. Earlier in this decision I concluded that the parties' goods are partly identical with the remainder similar to a medium degree. I concluded that the average

consumer would be members of the general public who will pay a medium degree of attention during the purchasing process. I found that the goods would be selected primarily by visual means, although I did not discount an aural aspect to the purchasing process. I found the respective marks to be aurally and conceptually similar to a medium degree and visually similar to no more than a medium degree. I found the earlier mark to hold a medium degree of inherent distinctiveness, though the level of distinctiveness has not been enhanced through the use made of it.

76. Taking all the relevant factors into account and even bearing in mind the principle of imperfect recollection, I consider it unlikely that the marks will be mistakenly recalled or misremembered as each other, even when paying a medium degree of attention for identical goods. This is on the basis that I do not consider the average consumer would overlook the repetition of the word "Solid" and the addition of the word "African" in party B's mark. Further, I do not consider that the differences in the stylistic elements will be overlooked, notwithstanding the lesser roles they play in the marks' overall impressions. As such, there is no likelihood of direct confusion.

77. It now falls for me to consider indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc:*[15]

> "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 recognised 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

[15] BL O/375/10

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)."

78. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

79. I also bear in mind the decision of the *CJEU in L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.

80. In the present case, the marks both share the identical word "Solid" which will carry the same concept whichever way it is perceived by the average consumer. It is my view that if consumers had previously come across the "!Solid" mark and subsequently came across Party B's mark (or vice versa) and noticed the differences between these marks by way of the additional wording and the different stylistic elements, they will regard these differences as a logical brand extension or indicative of rebranding. For example, the addition of the wording "African Lifestyle and Fashion" in the later mark could be indicative of the "Solid" brand offering a fashion line that is from Africa or adopts the aesthetic of African culture. Further, I consider that it is not uncommon for undertakings to re-brand themselves from time to time to accommodate changes in marketing considerations. Consequently, I consider there to be a likelihood of indirect confusion.

CONCLUSION

81. The application for revocation on grounds of non-use against Party A's registration, has been partially successful and its earlier mark shall remain registered for *clothing* in class 25 and is revoked with effect from 21 August 2018 for the following goods and services:

> Class 18: Leather and imitations of leather, and goods made of these materials (not included in other classes); trunks and bags, including valises, travelling bags, women's bags, handbags, shopping bags, school bags, vanity cases, bags of leather for packaging, umbrellas, parasols, purses and pocket wallets.
>
> Class 25: Footwear, headgear, belts.

Class 35: Business management; business administration; retail services in relation to clothing, footwear and headgear; management and consultancy for retail stores.

82. The opposition has been successful, and IR No. 1713636 is refused registration.

COSTS

83. Both parties have enjoyed a roughly equal share of success in these proceedings and therefore I order each side to bear its own costs.

Dated this 19th day of November 2025

Catrin Williams
For the Registrar