

O/1112/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION

NO. WO0000001644942

BY BIG HUG NUTRITION GMBH



IN CLASSES 5, 25, 29, 30 & 32

AND

AN APPLICATION FOR A DECLARATION OF

INVALIDITY

UNDER NO. 505015

BY FOX HEAD INC.

Background and pleadings

1. International trade mark 1644942 (“the IR”) consists of the sign shown on the cover page of this decision. The Holder is Big Hug Nutrition GmbH. The IR is registered with effect from 25 March 2021 but claims priority from the 30 September 2020¹. With effect from the same date, the Holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The date of protection of the IR in the UK is 07 June 2022.
2. On 21 June 2022, Fox Head Inc. (“the Applicant”) applied to have the IR declared partially invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b) of the Act, and the application is directed against the following goods:

Class 25: Clothing; headgear; footwear; hats; evening wear; evening coats; American football bibs; bowties; dress pants; suits; work clothes; arm warmers [clothing]; warm-up pants; leather belts [clothing]; sleeveless jerseys; trunks; bath robes; swim shorts; swimming trunks; bathwraps; bandanas [neckerchiefs]; bandeaux [clothing]; baseball uniforms; girls' clothing; clothing for martial arts; sportswear; bodies [clothing]; teddies [underclothing]; boleros; bomber jackets; boxer shorts; brassieres; bustiers; pea coats; capes; ladies' dresses; womens' outerclothing; knickers; down jackets; down vests; donkey jackets; fleece vests; leisure suits; slacks; leisurewear; waist belts; gloves [clothing]; gloves for cyclists; handwarmers [clothing]; men's underwear; trousers; trousers shorts; denims [clothing]; denim jeans; denim jackets; jogging sets [clothing]; shell suits; sweatpants; jogging tops; dresses made from skins; pockets for clothing; knee highs; short sets [clothing]; neckties; short-sleeved or long-sleeved t-shirts; short-sleeved t-shirts; short-sleeve shirts; body warmers; running suits; running vests; casual trousers; leggings [trousers]; light-reflecting jackets; outerclothing for girls; coats; nighties; combinations [clothing]; overshirts; parkas; crew neck sweaters; mock turtleneck sweaters; v-neck sweaters; slipovers; slipovers [clothing];

¹ This is claimed from Germany trade mark no. 302020113535.

bloomers; pajama bottoms; pyjamas; cyclists' clothing; cycling shorts; skirts; scarves; shawls and headscarves; sweatbands; sweat bands for the wrist; tennis sweatbands; anti-perspirant socks; boy shorts [underwear]; underpants; sports bras; sports clothing [other than golf gloves]; casual shirts; sports shirts with short sleeves; sports pants; sports jackets; sports caps and hats; gym suits; sports socks; sports jerseys; sports jerseys and breeches for sports; beach clothes; beach robes; stretch pants; knit shirts; cardigans; thongs; stockings; sweat-absorbent stockings; tank tops; camouflage shirts; camouflage pants; camouflage jackets; camouflage vests; sweat shorts; tracksuit tops; bib shorts; triathlon clothing; knitwear [clothing]; strapless bras; uniforms; ladies' underwear; sweat-absorbent underwear; undershirts; nappy pants [clothing]; waterproof capes; waterproof outerclothing; water socks; waterproof trousers; rainproof jackets; oilskins [clothing]; reversible jackets; waistcoats; thermally insulated clothing; wind vests; winter gloves; heavy coats; woollen socks; yoga shirts; yoga pants; gussets for leotards [parts of clothing]; gussets for underwear [parts of clothing].

3. Under section 5(2)(b), the Applicant relies upon the following trade mark:



Comparable trade mark (IR) registration no. UK00801493276²

Filing date 19 August 2019.

Registration date 19 March 2020.

Relying upon some of the goods for which the mark is registered, namely:

² Following the end of the transition period of the UK's withdrawal from the EU, all international (EU) trade mark designations registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (IR)' retains the same designation date (filing date), priority date (if applicable) and registration date of the international (EU) trade mark designation.

Class 25: Clothing, namely, jackets, rain jackets, sweatshirts, jerseys, shirts, tanks, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, neck gaiters, swimwear, gloves, belts, tennis shoes, shoes, sandals, boots and socks; gloves for motorcyclists and cyclists; jerseys for motorcyclists and cyclists; pants for motorcyclists and cyclists; jackets for motorcyclists and cyclists.

4. The Applicant claims there is a likelihood of confusion because the goods are identical or similar and the marks are similar.
5. The Holder filed a counterstatement admitting that its class 25 goods are “at least similar” to those covered by the Applicant’s earlier right. However, it denies that there is a likelihood of confusion, as they claim the marks at issue are not visually, aurally or conceptually similar.
6. The Applicant is represented by Murgitroyd & Company and the Holder is represented by Reddie & Grose LLP. Neither party requested a hearing, nor filed evidence in these proceedings. This decision is taken following a careful perusal of the papers.
7. 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

8. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D) - (2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set

out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

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

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

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

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

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

Section 5(2)(b)

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

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

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

11. Due to its earlier filing date, the trade mark upon which the Applicant relies qualifies as an earlier trade mark pursuant to section 6 of the Act. The earlier mark has not completed its registration process more than five years before the relevant date (the filing date of the Holder’s IR). Accordingly, the use provisions at section

47(2A) of the Act do not apply. The Applicant may rely on all of the goods it has identified without demonstrating that it has used its mark.

Section 5(2)(b) - case law

12. 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 great degree of similarity between the marks, and vice versa; Page 8 of 20

(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

13. The goods for comparison are as follows:

Applicant's goods	Holder's goods
<u>Class 25</u> <i>Clothing, namely, jackets, rain jackets, sweatshirts, jerseys, shirts, tanks, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, neck gaiters,</i>	<u>Class 25</u> <i>Clothing; headgear; footwear; hats; evening wear; evening coats; american football bibs; bowties; dress pants; suits; work clothes; arm warmers [clothing];</i>

swimwear, gloves, belts, tennis shoes, shoes, sandals, boots and socks; gloves for motorcyclists and cyclists; jerseys for motorcyclists and cyclists; pants for motorcyclists and cyclists; jackets for motorcyclists and cyclists.

warm-up pants; leather belts [clothing]; sleeveless jerseys; trunks; bath robes; swim shorts; swimming trunks; bathwraps; bandanas [neckerchiefs]; bandeaux [clothing]; baseball uniforms; girls' clothing; clothing for martial arts; sportswear; bodies [clothing]; teddies [underclothing]; boleros; bomber jackets; boxer shorts; brassieres; bustiers; pea coats; capes; ladies' dresses; womens' outerclothing; knickers; down jackets; down vests; donkey jackets; fleece vests; leisure suits; slacks; leisurewear; waist belts; gloves [clothing]; gloves for cyclists; handwarmers [clothing]; men's underwear; trousers; trousers shorts; denims [clothing]; denim jeans; denim jackets; jogging sets [clothing]; shell suits; sweatpants; jogging tops; dresses made from skins; pockets for clothing; knee highs; short sets [clothing]; neckties; short-sleeved or long-sleeved t-shirts; short-sleeved t-shirts; short-sleeve shirts; body warmers; running suits; running vests; casual trousers; leggings [trousers]; light-reflecting jackets; outerclothing for girls; coats; nighties; combinations [clothing]; overshirts; parkas; crew neck sweaters; mock turtleneck sweaters; v-neck sweaters; slipovers; slipovers [clothing]; bloomers; pajama bottoms; pyjamas; cyclists' clothing; cycling shorts; skirts;

scarves; shawls and headscarves; sweatbands; sweat bands for the wrist; tennis sweatbands; anti-perspirant socks; boy shorts [underwear]; underpants; sports bras; sports clothing [other than golf gloves]; casual shirts; sports shirts with short sleeves; sports pants; sports jackets; sports caps and hats; gym suits; sports socks; sports jerseys; sports jerseys and breeches for sports; beach clothes; beach robes; stretch pants; knit shirts; cardigans; thongs; stockings; sweat-absorbent stockings; tank tops; camouflage shirts; camouflage pants; camouflage jackets; camouflage vests; sweat shorts; tracksuit tops; bib shorts; triathlon clothing; knitwear [clothing]; strapless bras; uniforms; ladies' underwear; sweat-absorbent underwear; undershirts; nappy pants [clothing]; waterproof capes; waterproof outerclothing; water socks; waterproof trousers; rainproof jackets; oilskins [clothing]; reversible jackets; waistcoats; thermally insulated clothing; wind vests; winter gloves; heavy coats; woollen socks; yoga shirts; yoga pants; gussets for leotards [parts of clothing]; gussets for underwear [parts of clothing].

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

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

15. 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.

16. Guidance on this issue has 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.

17. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons.³

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

19. As noted at paragraph 4, the Holder has admitted that its class 25 goods are at least similar to the Applicant’s goods. I therefore must make an assessment on the goods at issue finding at least some level of similarity for all of the goods.

³ *Separode Trade Mark* (BL O/399/10), per Mr Geoffrey Hobbs QC, sitting as the Appointed Person; and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35, at paragraphs 30 to 38).

20. In making my assessment, I also note that the Tribunal Manual states that specifications which include the wording 'namely' should be interpreted as covering only the named goods within that specification. Therefore, the specification is limited to only those goods.

"Hats"

21. While expressed slightly differently, the Holder's "hats" are self-evidently identical to the Applicant's "clothing, namely, [...] hats [...]".

"Gloves [clothing]"

22. While expressed slightly differently, the Holder's "gloves [clothing]" are self-evidently identical to the Applicant's "clothing, namely, [...] gloves [...]".

"Sweatbands"

23. While expressed slightly differently, the Holder's "sweatbands" are self-evidently identical to the Applicant's "clothing, namely, [...] sweatbands [...]".

"Gloves for cyclists"

24. The Holder's above goods fall within the Applicant's broader category of "gloves for motorcyclists and cyclists". They are therefore identical on the principle outlined in *Meric*.

"Clothing"

25. The Applicant's "clothing, namely, jackets, rain jackets, sweatshirts, jerseys, shirts, tanks, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, neck gaiters, swimwear, gloves, belts, tennis shoes, shoes, sandals, boots and socks" fall within the Holder's above broader category of "clothing". They are therefore identical on the principle outlined in *Meric*.

“Footwear”

26. The Applicant’s “clothing, namely, [...] tennis shoes, shoes, sandals, boots” fall within the Holder’s above broader category of “footwear”. They are therefore identical on the principle outlined in *Meric*.

“Bomber jackets; down jackets; donkey jackets; denim jackets; light-reflecting jackets; reversible jackets; rainproof jackets; camouflage jackets; sports jackets”

27. The Holder’s above goods fall within the Applicant’s broader category “clothing, namely, jackets, rain jackets [...]”. They are identical on the principle outlined in *Meric*.

“Crew neck sweaters; mock turtleneck sweaters; v-neck sweaters”

28. The Holder’s above goods fall within the Applicant’s broader category “clothing, namely, [...] sweatshirts [...]”. They are identical on the principle outlined in *Meric*.

“Sleeveless jerseys; sports jerseys [...]; sports jerseys”

29. The Holder’s above goods all fall within the Applicant’s broader category, “clothing, namely, [...] jerseys [...]”. They are identical on the principle outlined in *Meric*.

“Sports shirts with short sleeves; yoga shirts; knit shirts; camouflage shirts; casual shirts; short-sleeve shirts”

30. The Holder’s above goods fall within the Applicant’s broader category “clothing, namely, [...] shirts, [...]”. They are identical on the principle outlined in *Meric*.

“Dress pants; warm-up pants; yoga pants; camouflage pants; stretch pants; sports pants”

31. The Holder's above goods fall within the Applicant's broader category "clothing, namely, [...] pants [...]". They are identical on the principle outlined in *Meric*.

"Sweat shorts; bib shorts; cycling shorts; trousers shorts; short sets [clothing]"

32. The Holder's above goods fall within the Applicant's broader category "clothing, namely, [...] shorts [...]". They are identical on the principle outlined in *Meric*.

"Headgear"

33. The Applicant's "clothing, namely, [...] hats, caps, headbands [...]" fall within the Holder's above broader category. They are therefore identical on the principle outlined in *Meric*.

"Sports caps and hats"

34. The Holder's above goods fall within the Applicant's broader category "clothing, namely, [...] hats, caps [...]". They are identical on the principle outlined in *Meric*.

"Trunks; swim shorts; swimming trunks"

35. The Holder's "above goods are all types of swimwear, and therefore fall within the Applicant's broader category "clothing, namely, [...] swimwear [...]". They are identical on the principle outlined in *Meric*.

"Winter gloves"

36. The Holder's above goods fall within the Applicant's broader category "clothing, namely, [...] gloves [...]". The goods are identical on the principle outlined in *Meric*.

"Leather belts [clothing]; waist belts"

37. "The Holder's above goods fall within the Applicant's broader category "clothing, namely, [...] belts [...]". They are identical on the principle outlined in *Meric*.

“Woollen socks; anti-perspirant socks; sports socks; water socks”

38. The Holder’s above goods fall within the Applicant’s broader term “clothing, namely, [...] socks”. They are identical on the principle outlined in *Meric*.

“Cyclists' clothing”

39. The Applicant’s “jerseys for [...] cyclists”, “pants for [...] cyclists” and “jackets for [...] cyclists” fall within the Holder’s above broader category. The goods are therefore identical on the principle set out in *Meric*.

“Evening wear; work clothes; leisurewear; girls' clothing; beach clothes; denims [clothing]; thermally insulated clothing; knitwear [clothing]”

40. The Holder’s above goods are all types of clothing and therefore encompass the Applicant’s “clothing, namely, jackets, rain jackets, sweatshirts, jerseys, shirts, tanks, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, neck gaiters, swimwear, gloves, belts, tennis shoes, shoes, sandals, boots and socks”. They are therefore identical under the principles set out in *Meric*.

“Oilskins [clothing]”

41. Oilskins “are a coat and pair of trousers made from thick waterproof cotton cloth”.⁴ Therefore, I consider that these goods fall within the Applicant’s broader category of “clothing, namely, jackets, rain jackets, [...] pants [...]”. I consider them identical on the principle outlined in *Meric*.

“Sweat bands for the wrist; tennis sweatbands”

42. The Holder’s above goods fall within the Applicant’s broader category “clothing, namely, [...] sweatbands [...]”. They are therefore identical on the principle outlined in *Meric*.

⁴ <https://www.collinsdictionary.com/dictionary/english/oilskins> accessed 05 November 2024.

“Outerclothing for girls; coats; parkas; heavy coats; waterproof outerclothing; evening coats; pea coats; womens' outerclothing; waterproof capes; capes; body warmers; wind vests”

43. The Holder's above goods are similar to the Applicant's "clothing, namely, jackets, rain jackets [...]". I consider that the parties' goods overlap in method of use, user, nature and overall purpose as they are all types of outer clothing which are to be worn over other items of clothing and are used to keep the user warm or dry. There will also be an overlap in trade channels as clothing undertakings and retail stores would sell all the goods, which would be located in close proximity. The goods could also be in competition with one another, with the average consumer picking one of the goods over the other. Taking the above into account, I consider that the goods are similar to a high degree.

“Stockings; sweat-absorbent stockings; knee highs”

44. The Holder's above goods are similar to the Applicant's "clothing, namely, [...] tights [...]". I consider that the parties' goods overlap in method of use, user, nature and overall purpose as they are all types of underwear which cover the legs. I also consider that these goods would be provided by the same undertakings, which are likely to be clothing retailers, and thus overlap in trade channels. The goods could also be in competition, with the average consumer picking one of the goods over the other. Taking the above into account, I consider that the goods are similar to a high degree.

“Knickers; teddies [underclothing]; boxer shorts; brassieres; bustiers; down vests; fleece vests; men's underwear; boy shorts [underwear]; underpants; sports bras; thongs; strapless bras; ladies' underwear; sweat-absorbent underwear; nappy pants [clothing]; bodies [clothing]”

45. The Holder's above goods are similar to the Applicant's "clothing, namely, [...] tights [...]". I consider that the parties' goods overlap in user and overall purpose as they are all types of underwear. However, they differ in method of use as they

are worn on different parts of the body and in nature as they are made from different materials. I consider that the goods would be provided by the same undertakings, which are likely to be clothing retailers, and thus overlap in trade channels. However, the goods are not complementary, nor in competition with one another. Taking the above into account, I consider that the goods are similar to a medium degree.

“Bandanas [neckerchiefs]; scarves; neckties; bowties”

46. The Holder’s above goods are similar to the Applicant’s “clothing, namely, [...] neck gaiters [...]”. I consider that the parties’ goods overlap in method of use, user and nature and overall purpose as they are all clothing items worn around the neck to either keep the neck warm, or for fashionable purposes. I also consider that these goods would be provided by the same undertakings, which are likely to be clothing retailers, and thus overlap in trade channels. However, I do not consider that the items will be in competition, as a consumer is unlikely to pick one item over another. Taking the above into account, I consider that the goods are similar to a medium degree.

“Shawls [...]”

47. I consider the Holder’s above goods are similar to the Applicant’s “clothing, namely, jackets [...]” as they are both types of outerwear that will be worn by the user to keep warm, and/or for fashionable purposes. While the goods overlap in purpose, I do not consider that they overlap in nature or method of use as a shawl is a piece of fabric worn over the shoulders, while a jacket is comprised of a body and sleeves which fit to the body and is fastened with either a zip or buttons. I consider that the goods will be selected by the same consumer and are likely to be offered through the same trade channels and sold in the same retail establishments in close proximity to each other. I do not consider the goods will be complementary, however they may be in competition because a user may choose either goods as outerwear to keep themselves warm. I therefore find the goods to be similar to a medium degree.

“[...] headscarves”

48. I consider the Holder’s above goods are similar to the Applicant’s “clothing, namely, [...] hats [...]” as they are both types of headwear that will be worn by the user to keep warm, and/or for fashionable purposes. While the goods overlap in method of use, I do not consider that they overlap in nature as a headscarf is a piece of fabric worn over the head and may be fastened into place, while a hat is a type of head covering which fits to the wearer’s head. I consider that the goods will be selected by the same consumer and are likely to be offered through the same trade channels and sold in the same retail establishments in close proximity to each other. I do not consider the goods will be complementary, nor will they be in competition. I therefore find the goods to be similar to a medium degree.

“Suits”

49. The Holder’s above goods are similar to the Applicant’s “clothing, namely, jackets, [...] shirts, [...] blouses, pants, [...]” as they are types of clothing which could form parts of a suit. The items are all worn on the users body and therefore overlap in nature and purpose as a suit is a set of clothing worn together. The goods will also overlap in user and trade channels, as the same clothing retails stores will sell the goods in the same place or within close proximity. Consequently, the goods are similar to a medium degree.

“Baseball uniforms”

50. The Holder’s above goods could encompass the Applicant’s “clothing, namely, jackets, [...] jerseys, shirts, tanks, [...] shorts, [...] caps, [...]” as they are types of clothing that could form part of a baseball uniform. In this instance they would overlap in nature, purpose and use. They will also overlap in trade channels as the same sports clothes undertakings and clothing retailers will sell the goods. The goods are therefore similar to between a medium and high degree.

“Uniforms”

51. The Holder's above goods could encompass the Applicant's "clothing, namely, jackets, [...] sweatshirts, [...] shirts, [...] blouses, pants, [...], shorts [...]" as they are types of clothing that could form part of a uniform. In this instance they would overlap in nature, purpose and use. They will also overlap in trade channels as the same clothing retailers will sell the goods. The goods are therefore similar to between a medium and high degree.

"Combinations [clothing]"

52. I note that combinations are defined as a "one-piece woollen undergarment with long sleeves and legs".⁵ I consider that this clothing would be worn under other pieces of clothing to keep the user warm. Therefore, I consider the above goods are similar to the Applicant's "clothing, namely, [...] sweatshirts, jerseys, shirts, tanks, blouses, pants, tights, shorts, [...]". All of the goods are types of clothing, which will be worn by the average consumer. Therefore, they overlap in method of use and user. However, the specific purpose of combinations is that they are to be worn under clothing. I also consider that there may be an overlap in distribution channels as all of the goods would be sold in clothing retail stores. However, I do not consider that the goods are complementary nor in competition. Consequently, I consider that that the goods are similar to a medium degree.

"Sportswear; sports clothing [other than golf gloves]; clothing for martial arts; triathlon clothing; jogging sets [clothing]; shell suits; leisure suits; gym suits; running suits; tracksuit tops; running vests; jogging tops; American football bibs; [...] breeches for sports"

53. The Holder's above goods could encompass the Applicant's "clothing, namely, jackets, [...] jerseys, shirts, tanks, [...] shorts, [...] caps, [...]" as they are types of clothing that can be worn for sports. The goods overlap in nature, purpose and use. They will also overlap in trade channels as the same sports clothes undertakings and clothing retailers will sell the goods. The goods are therefore similar to between a medium and high degree.

⁵ <https://www.collinsdictionary.com/dictionary/english/combinations> Accessed 06 November 2024.

“Camouflage vests; tank tops; undershirts; short-sleeved or long-sleeved t-shirts; short-sleeved t-shirts; bandeaux [clothing]”

54. The Holder’s above goods overlap in nature and purpose with the Applicant’s “clothing, namely, [...] shirts, tanks, blouses [...]” as they are all types of clothing worn on the upper part of the body. The goods will also overlap in user and trade channels, as the same clothing retail stores will sell the goods in the same place or within close proximity. I do not consider the goods are complementary, however they will be in competition, with a consumer picking one item over another. Consequently, I consider the goods are similar to a high degree.

“Waistcoats; cardigans; boleros; overshirts; slipovers; slipovers [clothing]”

55. The Holder’s above goods overlap with the Applicant’s “clothing, namely, jackets, [...] sweatshirts, jerseys” as they are all types of clothing worn on the upper part of the body over other items of clothing to keep the user warm, and/or for fashionable purposes. The goods will also overlap in user and trade channels, as the same clothing retail stores will sell the goods in the same place or within close proximity. I do not consider the goods are complementary, however they could be in competition. Consequently, I consider the goods are similar to a high degree.

“Ladies’ dresses; dresses made from skins”

56. The Holder’s above goods are similar to the Applicant’s “clothing, namely, shirts, tanks, blouses, pants, [...] shorts, [...]” as they are types of clothing that will be worn by the user, for both practical and fashionable purposes. The goods to some extent will overlap in nature as the Applicant’s goods either cover the top half or the bottom half of the person, whereas the Holder’s goods cover both halves of the body. The goods will be selected by the same consumer and are likely to be offered through the same trade channels and sold in the same retail establishments in close proximity to each other. I do not consider the goods are complementary; however I do consider the goods could be in competition with one another, with the

consumer picking a dress over another item of clothing. I therefore find the goods to be similar to a high degree.

“Skirts”

57. The Holder’s above goods are similar to the Applicant’s “clothing, namely, [...] pants, [...] shorts, [...]” as they are all items of clothing that the user will wear on the lower part of their body. The goods will be selected by the same consumer and are likely to be offered through the same trade channels and sold in the same retail establishments in close proximity to each other. Although they differ in nature, the goods could be in competition with one another, with the consumer picking a skirt over a pair of shorts or pants. I therefore find the goods to be similar to a medium degree.

“Casual trousers; leggings [trousers]; denim jeans; sweatpants; waterproof trousers; trousers; slacks; bloomers”

58. The Holder’s above goods overlap in nature and purpose to the Applicant’s “clothing, namely [...] pants [...]” as they are all items of clothing to be worn on the lower part of the body. The goods will also overlap in user and trade channels, as the same clothing retail stores will sell the goods in the same place or within close proximity. The goods could also be in competition, with a consumer picking one item of clothing over another. Consequently, I consider the goods are similar to a high degree.

“Handwarmers [clothing]; arm warmers [clothing]”

59. The Holder’s above goods will likely overlap in purpose with the Applicant’s “clothing, namely [...] gloves [...]” as they are accessories which are worn on the hands or arms for warmth. The goods are likely to be made of the same materials, however they vary in nature, as they cover slightly different parts of the body. I consider that they will be selected by the same consumer and are likely to be offered through the same trade channels and sold in the same retail establishments in close proximity to each other. I do not consider the goods will be complementary,

nor will they be in competition. I therefore find the goods to be similar to a medium degree.

“Pajama bottoms; pyjamas; nighties; bath robes”

60. The Holder’s above goods are all items of clothing worn in the evening or in bed. I also note that “bath robes” are worn over pyjamas for warmth or modesty. I therefore consider that these goods will overlap in user and method of use with the Applicant’s “clothing, namely, [...] sweatshirts, jerseys, shirts, tanks, [...] pants, [...] shorts, [...]”. I appreciate that the goods could be made out of different materials as the Holder’s goods are nightwear, whereas the Applicant’s goods are day wear. However, they are likely to be offered through the same trade channels and sold in the same retail establishments. The goods will not be in competition with each other, nor are they complementary. I therefore find the goods to be similar to a medium degree.

“Beach robes”

61. The Holder’s above goods will likely overlap in user and purpose with the Applicant’s “clothing, namely, [...] swimwear [...]” as they will be worn by the user at the beach. Although the physical nature of the goods will differ, they are likely to be offered through the same trade channels and are likely to be purchased from the same retail establishments in close proximity to one another. However, the goods will not be in competition with each other, nor are they complimentary. I therefore find the goods to be similar to a medium degree.

“Bathwraps”

62. A bathwrap is type of towel which can be fastened around the body. I consider the Holder’s above goods will overlap in user with the Applicant’s “clothing, namely, [...] swimwear [...]”. However, they differ in nature and purpose, as a bathwrap is made from towel material and is used to dry the body. The goods both may be sold in general retail stores, however I do not consider that they will be in competition with each other, nor will they be complementary. Bearing in mind that the Holder

has admitted its goods are similar to the Applicant's, I consider that the goods are similar to a low degree.

“Pockets for clothing; gussets for leotards [parts of clothing]; gussets for underwear [parts of clothing]”

63. As set out in *Les Éditions Albert René v OHIM*,⁶ it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in Treat.

64. In this instance, I consider that the Holder's above goods overlap in nature with the Applicant's "Clothing, namely, jackets, rain jackets, sweatshirts, jerseys, shirts, tanks, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, neck gaiters, swimwear, gloves, belts, tennis shoes, shoes, sandals, boots and socks" as they are all made of fabric. However, they will differ in purpose as the Holder's goods are parts of clothing, where the Applicant's goods will be worn by the consumer to adorn or cover the body. I consider the goods do not overlap in trade channels, as parts of clothing are likely to be purchased through craft or wholesale suppliers for use in the manufacture of clothing; they are less likely to be sold by fashion retailers. For this reason, I also consider that the goods are not in competition, as a consumer would not decide to buy a pocket or gusset instead of a finished item of clothing. Bearing in mind that the Holder has admitted its goods are similar to the Applicant's, I consider that the goods are similar to a low degree.

Average consumer and the purchasing act

65. It is necessary for me to determine who the average consumer is for the goods in question; I must then determine the manner in which the goods are likely to be selected by the average consumer in the course of trade.

⁶ Case T-336/03

66. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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. described the average consumer in these terms:

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

67. The average consumer for the goods is members of the general public with the goods self-selected from the shelves of traditional high street retail outlets or their online equivalents. The goods may vary in price, but none are likely to be prohibitively expensive and will be purchased reasonably frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability. Given the process of selection, the marks' visual impact is likely to play the greater role⁷, though I do not discount the opportunity for aural recommendations made by salespeople, for example. Weighing all factors, I find that the average consumer will apply a medium degree of attention to the purchase.

Comparison of marks

68. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse



⁷ *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50

its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

69. 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.

70. The respective trade marks are shown below:

Applicant's trade mark	Holder's IR
	

71. The Applicant's mark consists of two elements, one of which is presented above the other. Each element is a black composite shape made up of a parallelogram and triangle merged together. The upper shape is a rectangle with slanted edges, tilting slightly upwards, with a triangular shape protruding from the left-hand side, which creates the impression of a small triangular cut out on the lower left side of the shape. The lower element is presented parallel to the upper shape and is reminiscent of an arrow, being a composite shape made up of a marginally longer

and thicker rectangle with slanted edges, with a triangular shape pointing to the right. I consider that the overall impression of the mark lies in the representation of the device as a whole.

72. The Holder's IR consists of two elements, one of which is presented above the other. The upper shape is a rectangle with slanted edges, tilting slightly upwards. The lower element is presented parallel to the upper shape and is reminiscent of an arrow, being a composite shape made up of a shorter trapezium, with a triangular shape pointing to the left. Both elements are presented in grey, with black lines on lower and right-hand sides which gives the appearance of a shadow. I consider that the overall impression of the mark lies in the representation of the device as a whole.

73. Visually, the marks both consist of two elements presented one above the other; the top element being a rectangle shape, with slanted edges, that tilts upwards, and the bottom element being reminiscent of an arrow. These act as visual points of similarity. However, the left hand-side of the top rectangular element in the Applicant's mark has the extra triangular element, and the bottom arrow like-elements of the parties' marks face different ways (in the IR this element is pointing to the left, while in the earlier right this element points to the right). I also note that the Applicant's mark is all presented in black, whereas the Holder's IR is presented in grey, with black shadow elements. These act as visual points of difference. Taking all of the above into account, I consider that the marks are visually similar to between a medium to high degree.

74. I note that in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, T- 424/10, the GC stated:

"46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative

mark lacking word elements and to compare it with the phonetic perception of other marks.”

Therefore, as the marks cannot be articulated, there is no aural comparison to be made.

75. Neither party have provided submissions regarding the conceptual nature of the marks. Conceptually, the marks consist of an abstract figurative device which is not an identifiable shape or image, and therefore would not be attributed any meaning. Consequently, there is no conceptual comparison to be made.

Distinctive character of the earlier trade mark

76. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the CJEU stated that:

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

undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

77. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

78. The Applicant has not filed any evidence to support that its mark’s distinctive character has been enhanced through use. Consequently, I have only the inherent position to consider.

79. The mark is an abstract figurative device, which conveys no particular meaning. In the absence of any conceptual significance, the mark cannot have a relationship with the goods relied upon, directly or allusively. Consequently, I consider that the mark is inherently distinctive to a high degree.

Likelihood of Confusion

80. 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 the marks and the goods 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 respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods 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.

81. I have found the marks to be visually similar to between a medium to high degree, and that due to the marks being figurative, no aural or conceptual comparison can be made. I have found the Applicant's mark to have a high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public, who will select goods primarily by visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the parties' goods to range from being identical to being similar to a low degree.

82. Taking all of the above into account, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times will, to my mind, lead the average consumer to mistake one mark for the other, even for those who are paying a medium degree of attention during the purchasing process. This is particularly the case given the relatively high visual similarity (being between a medium and high degree) between the marks and the predominantly visual purchasing process. I consider the average consumer could easily overlook or imperfectly recall the differences (that being the direction of the bottom arrow elements, the triangular shape protruding from the left-hand side of the rectangular element in the Applicant's mark and the shadow device in the Holder's IR) between the figurative marks. I consider that there is a likelihood of direct confusion for all goods, even on the goods that are similar to a low degree, due to the effect of the interdependency principle.

CONCLUSION

83. The application for partial invalidation is successful and the Contested Mark is hereby declared invalid in respect of all goods in class 25.

84. Under section 47(6) of the Act, the registration is deemed never to have been Made for those class 25 goods.

COSTS

85. The Applicant has been successful and is entitled to a contribution towards its costs based upon the scale set out in Tribunal Practice Notice 2/2016. In the circumstances, I award the Applicant the sum of £400, calculated as follows:

Preparing the application for invalidity and considering the Counterstatement	£200
Official fee	£200
Total	£400

86. I therefore order Big Hug Nutrition GmbH to pay Fox Head Inc. the sum of £400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 21st day of November 2024

E REES
For the Registrar