

O/1167/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 3703840 & 3704050

IN THE NAME OF PROMOSHIRT SM SA GMBH

IN CLASSES 6, 9, 11, 18, 20, 21, 24, 25, 27 & 34

AND

IN THE MATTER OF OPPOSITIONS THERETO

UNDER NOS. 434401 & 434576

BY SCHWEIZERISCHE EIDGENOSSENSCHAFT V.D. BUNDESAMT FÜR

RÜSTUNG ARMASUISSE EIDGENÖSSISCHES DEPARTEMENT FÜR

VERTEIDIGUNG, BEVÖLKERUNGSSCHUTZ UND SPORT

AND

IN THE MATTER OF INTERNATIONAL REGISTRATION

DESIGNATING THE UK NO. 1686195

IN THE NAME OF SCHWEIZERISCHE EIDGENOSSENSCHAFT V.D.

BUNDESAMT FÜR RÜSTUNG ARMASUISSE EIDGENÖSSISCHES

DEPARTEMENT FÜR VERTEIDIGUNG, BEVÖLKERUNGSSCHUTZ UND SPORT

IN CLASSES 3, 9, 18, 20, 21, 24 & 30

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 439706

BY PROMOSHIRT SM SA GMBH

## **BACKGROUND AND PLEADINGS**

1. These consolidated proceedings concern a dispute between Promoshirt SM SA GmbH (“Promoshirt”) and Schweizerische Eidgenossenschaft v.d. Bundesamt für Rüstung armasuisse Eidgenössisches Departement für Verteidigung, Bevölkerungsschutz und Sport (part of the Swiss Government; hereafter, “the Swiss Confederation”).

2. On 27 July 2017, a Swiss company, Promoshirt SM S.A., applied to register the trade marks **SWISS MILITARY** (“Promoshirt’s first mark”) and **SWISS MILITARY BY BTS** (“Promoshirt’s second mark”) in the UK, under nos. 3703840 and 3704050, respectively.<sup>1</sup> Registration is sought for various goods in classes 6, 9, 11, 18, 20, 21, 24, 25, 27 and 34, as set out in Annex A. Both applications were later assigned to Promoshirt.<sup>2</sup>

3. On 20 June 2022, the Swiss Confederation opposed Promoshirt’s first mark under sections 3(3)(b), 3(6) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). On 27 June 2022, the Swiss Confederation opposed Promoshirt’s second mark under sections 3(3)(b), 3(6) and 5(2)(b) of the Act.

4. Under section 3(3)(b), the Swiss Confederation contends that use of Promoshirt’s marks creates a serious risk that the public will be deceived on the basis that they will perceive that the goods are (i) manufactured in Switzerland, (ii) supplied or authorised by a public authority, and (iii) used by the Swiss military, when they are not. The Swiss Confederation adds that ‘SWISS MILITARY’ is an ‘official designation’; use of Promoshirt’s marks, it argues, implies an official approbation or connection with the Swiss Government, when there is none.

5. As for section 3(6), the Swiss Confederation argues that, since 31 January 2011, Promoshirt has been aware that the protection, maintenance and exploitation of

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<sup>1</sup> These marks were filed pursuant to Article 59 of the Withdrawal Agreement between the UK and EU, and applied for on 29 September 2021, i.e. within nine months of the end of the transition period. As such, they were given the same filing dates as Promoshirt’s EUTM nos. 17036146 and 17036187.

<sup>2</sup> By virtue of the filing of a Form TM16, with an effective date of 6 November 2023. Any references to Promoshirt relating to matters before that date should be taken as references to Promoshirt SM S.A..

'SWISS MILITARY' in Switzerland and abroad has been exclusively designated to the Swiss Confederation. The Swiss Confederation contends that Promoshirt would have been aware of this because of a Swiss court decision of that date, as well as meetings it held with a partner organisation regarding unauthorised use of the sign. In knowledge of this, the Swiss Confederation argues that the applications to register Promoshirt's marks were made as (i) a "land grab" to frustrate its objectives and (ii) an attempt to capitalise on the longstanding, international reputation of the Swiss military. On this basis, the Swiss Confederation submits that the applications were filed in bad faith.

6. Turning to the section 5(2) grounds, the Swiss Confederation relies upon the following trade marks:<sup>3</sup>

**(i) SWISS MILITARY**

UK registration no. 801163988

Filing date: 12 April 2013

Registration date: 16 February 2015

("the Swiss Confederation's first registration")

Goods relied upon

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith not included in other classes; jewellery, precious stones; timepieces and chronometric instruments; all of the aforesaid goods being Swiss.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; photographs; stationery; adhesives for

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<sup>3</sup> The Swiss Confederation's registrations are comparable trade marks based upon pre-existing International Registration designating the EU no. 1163988 and EU trade mark no. 13235973. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the EU, comparable UK trade marks were automatically created. The comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

stationery or household purposes; artists' materials; all of the aforesaid goods being Swiss.<sup>4</sup>

(ii) **SWISS MILITARY**

UK registration no. 913235973

Filing date: 8 August 2014

Registration date: 17 February 2015

("the Swiss Confederation's second registration")

Goods relied upon

Class 14: Alloys of precious metal; works of art of precious metal; jewellery, precious stones; horological and chronometric instruments; all the aforesaid goods made in Switzerland.

7. The Swiss Confederation's registrations qualify as earlier marks in accordance with section 6 of the Act. As they had not been registered for five years or more at the filing date of Promoshirt's marks, they are not subject to the use requirements in section 6A of the Act.

8. The Swiss Confederation contends that Promoshirt's first mark is identical to its registrations and Promoshirt's second mark is similar to its registrations. Moreover, the Swiss Confederation argues that the parties' goods are identical or similar. On this basis, it submits that there is a likelihood of confusion, including the likelihood of association. Accordingly, the Swiss Confederation requests that registration of Promoshirt's marks be refused under sections 5(2)(a) and 5(2)(b), respectively.

9. Promoshirt filed counterstatements, denying the grounds of opposition. Its pleaded position is summarised as follows:

(i) Promoshirt denies that 'SWISS MILITARY' is of such a nature as to deceive the public. It argues that none of the types of deception advanced by the Swiss

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<sup>4</sup> Whilst this limitation is not reproduced in the Swiss Confederation's Form TM7s, it forms part of the registered specification and cannot be disregarded.

Confederation relates to the inherent characteristics of the goods, but to the origin of the goods or the undertaking responsible for their quality. In any event, it denies that the public would perceive that its goods are endorsed or supplied by a public authority, or that they could be used by, or connected to, the Swiss military. It also denies that the public would perceive the goods to be manufactured in Switzerland. Further, Promoshirt disputes that the relevant public in the UK would be aware that 'SWISS MILITARY' is an official designation in Switzerland;

(ii) Promoshirt denies that its applications were filed in bad faith. It argues that they were filed to protect its own commercial interests. Promoshirt alleges to have been legitimately trading under its marks for many years; the applications are said to have been filed to ensure its marks have protection in the UK following the UK's exit from the EU. Promoshirt denies that the protection, maintenance and exploitation of 'SWISS MILITARY' has been exclusively delegated to the opponent outside Switzerland or that the Swiss Confederation has automatic rights in the UK;

(iii) Promoshirt admits that its first mark is identical to the Swiss Confederation's registrations. Whilst it does not explicitly deny that its second mark is similar to the Swiss Confederation's registrations, it submits that the additional elements create a significant difference between them. Moreover, it argues that there is no similarity between any of the respective goods. Promoshirt disputes that there is a likelihood of confusion.

10. On 24 June 2022, the Swiss Confederation registered the international trade mark displayed below, under no. 1686195 ("the IR"). With effect from the same date, the UK was designated as a territory in which it seeks to protect the mark under the terms of the Protocol to the Madrid Agreement. Protection is sought for various goods in classes 3, 9, 18, 20, 21, 24 and 30, as outlined in Annex B.



11. On 13 March 2023, Promoshirt partially opposed the protection of the IR in the UK under section 5(2)(b) of the Act, relying upon its first and second marks. Specifically, the goods in classes 21, 24 and 27 of the former are relied upon in respect of the goods in classes 21 and 24 of the IR, and all the goods of the latter are relied upon against the goods in classes 9, 18, 20 and 24 of the IR.

12. Providing they survive the Swiss Confederation's oppositions, Promoshirt's first and second marks will constitute earlier marks in accordance with section 6 of the Act. As they are not yet registered, they are not subject to the use requirements in section 6A of the Act.

13. Promoshirt also relies upon its UK registration no. 917036203, **SWISS MILITARY BY PSM** ("Promoshirt's third mark"). Promoshirt's third mark was filed by Promoshirt SM S.A. on 27 July 2017 and became registered on 20 July 2020.<sup>5</sup> It stands registered for goods in classes 9, 18 and 25, as set out in Annex A. All are relied upon to oppose the goods in classes 9 and 18 of the IR. Ownership of this mark has also since been assigned to Promoshirt.<sup>6</sup>

14. In principle, Promoshirt's third mark qualifies as an earlier mark in accordance with section 6 of the Act. It had not been registered for five years or more at the UK designation date of the IR and is not, therefore, subject to the use requirements. However, I note that this mark is currently subject to separate cancellation proceedings.<sup>7</sup>

15. Promoshirt originally sought to rely upon a fourth trade mark, namely UK registration no. 908323768. However, this registration was revoked with effect from 13 May 2020. As this predates the UK designation date of the IR, it cannot be relied upon

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<sup>5</sup> Promoshirt's third mark is a comparable trade mark based upon pre-existing EU trade mark no. 17036203. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the EU, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

<sup>6</sup> Again, the effective date of the assignment is 6 November 2023.

<sup>7</sup> Those being under cancellation no. 506749. To the extent that the outcome of Promoshirt's opposition against the IR is reliant upon this registration, the decision will be provisional, pending the outcome of the same.

for the purposes of the opposition. This was confirmed to the parties by official letter dated 15 May 2024.

16. In its statement of grounds, Promoshirt argues that the IR is similar to its marks and that the parties' goods are identical or similar. On this basis, it submits that there is a likelihood of confusion.

17. The Swiss Confederation filed a counterstatement, denying the ground of opposition. It denies the validity of Promoshirt's rights, highlighting that they are currently subject to ongoing opposition and cancellation proceedings. It submits that, if they prove successful, Promoshirt will have no valid earlier rights to substantiate the opposition.

18. On 20 June 2023, the proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.<sup>8</sup>

19. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 19 June 2024. Promoshirt was represented by Thomas St Quintin of counsel, instructed by Abel & Imray LLP. The Swiss Confederation was represented by Jacqueline Reid of counsel, instructed by Womble Bond Dickinson (UK) LLP.

### **RELEVANCE OF EU LAW**

20. 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.

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<sup>8</sup> The Swiss Confederation's two oppositions were previously consolidated on 1 December 2022.

## **EVIDENCE AND SUBMISSIONS**

21. The Swiss Confederation's evidence is given in three witness statements from Martin Schneider, dated 1 February 2023, 15 November 2023 and 15 January 2024, and 25 exhibits (1-25). Dr Schneider has held the role of external counsel for the Swiss Confederation since 1 January 1999.

22. The Swiss Confederation also filed written submissions dated 1 February 2023 and 15 November 2023.

23. Promoshirt filed evidence in the form of two witness statements from Ashok Sawhney, dated 31 March 2023 and 21 August 2023, and 17 exhibits (AS01-AS09 and AS01(2)-AS08(2)). Mr Sawhney is the President of Promoshirt, a position he has held since 30 September 2023.

24. I have taken all the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

## **PRELIMINARY REMARKS**

25. If the Swiss Confederation's oppositions are successful, Promoshirt's first and second marks will not be valid earlier marks for the purposes of its own opposition against the IR. As such, it is convenient to first deal with the Swiss Confederation's oppositions, returning to consider Promoshirt's opposition to the extent that it is necessary to do so.

## **THE SWISS CONFEDERATION'S OPPOSITIONS**

### **Sections 5(2)(a) and 5(2)(b)**

#### **Legislation and case law**

26. Sections 5(2) and 5A of the Act read as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.”

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

27. 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;

(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.

### **My approach**

28. I note that the Swiss Confederation's registrations are identical and neither is subject to the use requirements. Moreover, a narrower range of goods are relied upon from its second registration. Although there is a slight difference in the wording of the limitations, this will have no impact on how similar the goods are to Promoshirt's goods. For these reasons, I will proceed to determine these grounds of opposition on the basis of its first registration only. If they fail, Swiss Confederation's second registration will not improve its position.

### **Identity/comparison of the marks**

#### *Promoshirt's first mark*

29. Promoshirt has conceded that its mark is identical to the Swiss Confederation's registration. That is clearly correct: the competing marks both consist of the words 'SWISS MILITARY' with no other elements.

#### *Promoshirt's second mark*

30. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in

mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in *Bimbo* 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.”

31. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

32. The marks to be compared are as follows:

<b>Promoshirt’s mark</b>	<b>The Swiss Confederation’s registration</b>
SWISS MILITARY BY BTS	SWISS MILITARY

33. Promoshirt’s mark is in word-only format and consists of the words ‘SWISS MILITARY BY BTS’. The words ‘SWISS MILITARY’ combine to form a unitary phrase. This phrase appears at the beginning of the mark, a position which tends to have most impact.<sup>9</sup> Given the formulation of the words in the mark, however, the words ‘BY BTS’ are likely to be perceived as referring to the responsible undertaking. Therefore, they provide a significant contribution to the overall impression of the mark, albeit that they have less impact due to their position at the end.

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<sup>9</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

34. The Swiss Confederation's registration is in word-only format and comprises the words 'SWISS MILITARY' with no other elements. The words combine to form a unitary phrase and, in combination, dominate the overall impression of the mark.

35. Visually, the marks are similar because they share the identical words 'SWISS MILITARY'. These words appear at the beginning of Promoshirt's mark and comprise the entirety of the Swiss Confederation's registration. The competing marks differ in that Promoshirt's mark contains the additional verbal elements 'BY BTS'. Bearing in mind my assessment of the overall impressions, I find that there is between a medium and high degree of visual similarity between the competing marks.

36. Aurally, the competing marks are similar in that the five syllables of the Swiss Confederation's registration are identically reproduced at the beginning of Promoshirt's mark. The marks differ to the extent that Promoshirt's mark contains four additional syllables. Bearing in mind my assessment of the overall impressions, I find that there is between a medium and high degree of aural similarity between the competing marks.

37. Conceptually, the Swiss Confederation's registration is likely to be understood as referring to the armed forces of Switzerland. The words 'SWISS MILITARY' in Promoshirt's mark will be understood in the same way. However, the mark includes additional elements, namely the word 'BY' and the letters 'BTS'. The former would be understood as a common preposition which typically identifies the responsible entity. The combination of the letters 'BTS' does not have any clear and obvious meaning; in my view, this element would be perceived as a conceptually neutral combination of letters from the English language. Although the additional elements 'BY BTS' result in Promoshirt's mark conveying an additional concept associated with responsibility, overall, I find that there is between a medium and high degree of conceptual similarity between the competing marks.

## Comparison of goods

38. In *Canon*, the CJEU stated, at paragraph 23 of its judgment, that:

“In assessing the similarity of the goods or services concerned, [...] 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.”

39. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 for assessing similarity were:

- (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.

40. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity

between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“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.”

41. The goods to be compared can be found in Annex A and at paragraph 6 above.

42. I note that the descriptions of the goods in the Swiss Confederation’s first registration include the limitation [...] *all of the aforesaid goods being Swiss*. I must clarify that this will have no impact on the comparison which follows. Since Promoshirt’s goods are not limited in any way, they could include those of Swiss origin. Therefore, the limitation does not create any difference between the parties’ goods.

*Promoshirt’s first mark*

Class 6

*Common metals and their alloys*

43. In my view, these goods overlap in nature, intended purpose and method of use with *precious metals and their alloys* [...] in class 14 of the Swiss Confederation’s registration. This is because the respective goods are both unprocessed metals and alloys which are likely to be used to produce finished products, albeit that they consist of different types of metal. The respective goods may be produced by the same undertakings and reach the market through shared channels of trade. Similarly, the users of such goods may overlap; manufacturers of certain products may seek both common and precious metals to be used in the manufacturing process. In the absence of any evidence on the point, I do not consider the respective goods to be in competition; they comprise different metals which are likely to have different properties and, therefore, I am not satisfied that they are interchangeable. Given that the respective goods are not important or indispensable to one another, they are not

complementary in the sense outlined in the authorities. In light of all this, I find that there is a medium degree of similarity between the respective goods.

### *Ores*

44. It is my understanding that these goods are naturally occurring rocks containing metals and metal compounds. Whilst many of the same findings can be made as in paragraph 43 above, it is my view that these goods are further away from *precious metals and their alloys [...] in class 14 of the Swiss Confederation's registration* because the metals within the ores require an extra step of extraction prior to them being used to produce or manufacture other products. Taking this into account, I find that there is between a low and medium degree of similarity between the respective goods.

### Class 20

#### *Mirrors, picture frames*

45. The Swiss Confederation contends that these goods fall within the scope of its *jewellery; timepieces and chronometric instruments; precious metals and their alloys and goods in precious metals or coated therewith not included in other classes* of its registration. This is on the basis that (i) mirrors and picture frames may be made of precious metals, (ii) the purpose of the respective goods is to be aesthetically pleasing, (iii) they are often sold by the same undertakings and (iv) they are complementary since jewellery is often put on at dressing tables which feature mirrors. Arguments (ii) to (iv) appear to be more appropriate to a discussion of similarity, rather than identity, and are dealt with below. As for argument (i), I do not accept that the respective goods are identical merely because mirrors and picture frames may be made of precious metals. Whilst I do not dispute that they can be made of such materials, the Swiss Confederation's *[...] goods in precious metals or coated therewith [...]* are expressly limited to being those which are *[...] not in other classes*. Promoshirt's goods are in a different class, namely class 20. Plainly, mirrors and picture frames do not fall within the scope of the Swiss Confederation's term.

46. To my mind, jewellery, chronometric instruments, precious metals and goods made therefrom have a different nature to mirrors and picture frames. Although the latter could be made from the same materials as the former, this, in and of itself, is not sufficient to give rise to similarity between the goods.<sup>10</sup> There is an overlap in method of use between *chronometric instruments* (which includes household clocks) and Promoshirt's goods insofar as they are both hung on a wall. However, I consider this overlap to be extremely limited, given that the respective goods are actually used in different ways. In considering the purposes, trade channels and users of the respective goods, I bear in mind the following comments of Mr Iain Purvis KC, sitting as a deputy High Court judge, in *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée) ("Unicorn Studio")* [2024] EWHC 1098 (Ch):

"23. [...] the mere fact that goods might be found in some stores which sell a wide range of products, that they would be used by ordinary people and that they would be chosen in part on aesthetic grounds seems to me to be an extraordinarily thin basis for a finding of similarity. By the same reasoning, for example, glass vases would be held to be similar to ready-made curtains. As Mr Harbottle pointed out in argument, the overall purpose of considering similarity should not be forgotten. That purpose is to identify similarities which might be relevant to the question of likelihood of confusion. It seems to me the greater the level of generality at which some similarity under *Canon* factors can be found (ie both goods are '*sold in large department stores*' or both goods are '*used by ordinary people*') the less relevant could it be to any question of confusion, and any assessment of similarity of goods should take that into account."

47. In my view, the argument that the respective goods share a purpose because they are aesthetically pleasing is far too superficial to give rise to any meaningful degree of similarity between them; the same could be said for an extremely wide range of disparate goods. The typical use of a mirror is for viewing oneself in its reflection, whereas a picture frame is for displaying a picture; the Swiss Confederation's goods do not share either of these purposes. Whilst I agree with the Swiss Confederation

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<sup>10</sup> *Les Éditions Albert René v OHIM*, Case T-336/03

that the respective goods could be sold by the same undertakings, such as, for example, homeware or home décor stores, such outlets sell an extremely wide range of goods. As such, I do not consider it appropriate to conclude that the respective goods share trade channels on this basis. The evidence showing Chanel offering both beauty mirrors and jewellery for sale does not alter this view.<sup>11</sup> Chanel is an extremely large fashion house, which sells a wide variety of goods. This evidence does not establish that it is typical for such goods to be sold by the same undertakings. Moreover, the respective goods may all be purchased by the general public at large, but such a user base is far too broad to be meaningful. Given that the respective goods have different purposes, they are not in competition. Finally, I do not accept the Swiss Confederation's argument that the respective goods are complementary on the basis that jewellery is often put on at dressing tables which feature mirrors. Whilst a mirror could certainly be helpful in the process of applying jewellery, these goods are not important or indispensable to one another in such a way that consumers would believe that the responsibility for them lies with the same undertaking; the connection between them is far too tenuous. Taking all of this into account, I find that there is no similarity between the respective goods.

## Class 21

*Brush-making materials; steelwool; unworked or semi-worked glass (except glass used in building)*

48. The Swiss Confederation contends that these goods are similar to all of its goods in classes 14 and 16 because they (i) fall under broad definitions of goods, (ii) can be marketed to the same target group, (iii) can serve the same nature or purpose, (iv) can have the same commercial origin, stem from the same manufacturers and distributed through the same channels, and (v) can be complementary and/or in competition, since they are typically purchased by tourists as gifts. I disagree. Firstly, the mere fact that certain terms may be broad in scope does not mean that they are automatically similar to other broad terms. As for the relevant factors, there is no obvious overlap in nature, method of use or purpose. Contrary to the Swiss Confederation's argument, I

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<sup>11</sup> Exhibit 14

do not consider that Promoshirt's goods are typically produced by the same undertakings as its goods; to my mind, the goods are actually likely to reach the market through distinct trade channels. Even if some are found in the same outlets, they are likely to be extremely large retail stores, and the goods are likely to be located in discrete sections of the same. There is no basis for finding that the respective goods are complementary; they are not important or indispensable to one another. I also disagree that the respective goods are in competition; they are not interchangeable. Further, Promoshirt's goods generally do not strike me as those which would typically be purchased as gifts by tourists. Even if some are, that alone is not a sufficient basis for concluding that they are in competition; the same could be said of anything. I accept that users may overlap, though only at far too general a level to engage any similarity. Overall, I find that there is no similarity between the respective goods.

*Glassware, porcelain and earthenware not included in other classes*

49. The Swiss Confederation argues that these goods are similar to its *precious metals and their alloys and goods in precious metals or coated therewith not included in other classes* because they may be purchased for decorative purposes and are, therefore, in competition or complementary. It also contends that they are likely to be distributed through the same trade channels. Promoshirt's goods include works of art made from the specified materials. Consequently, there is an overlap in nature, method of use and purpose, albeit that the respective goods are made from different materials. Whilst I still have Mr Purvis' comments in *Unicorn Studios* firmly in mind, the aesthetic qualities of works of art clearly form a core purpose of those goods rather than an incidental or secondary one. In this connection, I agree that there is a degree of competition between the respective goods, since a consumer could reasonably choose, for example, a work of art made from silver over one made from porcelain, or vice versa. Insofar as works of art are concerned, the respective goods are likely to reach the market through the same trade channels and be offered by the same undertakings. I do not agree that they are complementary; they are not important or indispensable to one another. Overall, I find that there is a medium degree of similarity between the respective goods.

## Class 24

### *Table covers*

50. The Swiss Confederation contends that these goods are similar, if not identical, to its *paper, cardboard and goods made from these materials, not included in other classes and artists' materials*. This is because they include products which are used to cover/protect tables. The Swiss Confederation's *paper [...] and goods made from these materials, not included in other classes* includes paper table covers. As such, although they are made from different materials, these goods and Promoshirt's *table covers* overlap in nature, method of use and purpose; they both comprise, or include, covers which are used to protect tables. The respective goods are likely to reach the market through shared trade channels and may be provided by the same undertakings. Users also overlap. There is a competitive relationship between the respective goods, since a consumer could reasonably choose a textile table cover over a paper one, or vice versa. The respective goods are not important or indispensable to one another and, therefore, they are not complementary. In light of the above, I find that there is between a medium and high degree of similarity between the respective goods.

## Class 27

### *Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile)*

51. The Swiss Confederation makes the same arguments in respect of these goods as discussed at paragraph 48 above. In my view, all my findings discussed therein apply equally here. There is no similarity between the respective goods.

## Class 34

### *Tobacco; smokers' articles*

52. The same arguments are made by the Swiss Confederation in respect of these goods as discussed at paragraph 48 above. I adopt my previous findings. There is no similarity between these goods and any of those relied upon by the Swiss Confederation.

### *Promoshirt's second mark*

## Class 9

### *Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life saving and teaching apparatus and instruments*

53. The Swiss Confederation argues that Promoshirt's [...] *measuring* [...] *apparatus and instruments* are similar to its *horological and chronometric instruments* on the basis that its goods are instruments which measure time. Whilst I accept that watches and the like display the time and must have certain functions which ensure accuracy, it is my view that any similarity in purpose this creates is too superficial to engage any similarity between the respective goods. I understand Promoshirt's goods to comprise specialist devices, such as, for example, devices for measuring electric currents or pressure gauges. They differ in nature and method of use when compared with the Swiss Confederation's goods. There is no evidence that the respective goods reach the market through shared trade channels. In the absence of any such evidence, it seems more likely that they will be sold in different outlets. Notwithstanding any broad overlap in purpose, I do not consider the respective goods to be in competition; they are not interchangeable. The respective goods are not important or indispensable to one another and, as such, they are not complementary. Taking all of the above into account and exercising the common-sense approach advocated by Mr Purvis in *Unicorn Studio*, I find that there is no similarity between the respective goods.

54. The Swiss Confederation grouped *scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, [...] signalling, checking (supervision), life saving and teaching apparatus and instruments* together with Promoshirt's *[...] measuring [...] apparatus and instruments*. It offered no other basis for these goods being similar to its *horological and chronometric instruments*, and I do not consider its point about the measurement of time applies here. There being no material overlaps in any of the relevant factors, I find that there is no similarity between the respective goods.

### *Sunglasses*

55. The Swiss Confederation submits that these are similar to its *jewellery and horological and chronometric instruments* (specifically, watches) on the basis that they are complementary and are often sold under the same brand and by the same retailers. Although it does not mention nature, method of use or intended purpose, I record here for completeness that I do not consider there to be any overlaps in these factors. Similarly, I do not consider there to be any competition between the respective goods. As for complementarity, in *Compagnie des montres Longines, Francillon SA v OHIM ("Compagnie")*, Case T-505/12, the GC rejected the argument that sunglasses, jewellery and watches were similar to clothing, stating that:

"59. Furthermore, according to the case-law, aesthetic complementarity between goods may give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 207/2009. Such aesthetic complementarity must involve a genuine aesthetic necessity, in the sense that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use those products together. That aesthetic complementarity is subjective and is determined by the habits and preferences of consumers, to which producers' marketing strategies or even simple fashion trends may give rise (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 51 and the case-law cited).

60. However, it is important to point out that the mere existence of aesthetic complementarity between the goods is not sufficient to conclude that there is a

similarity between them. For that, the consumers must consider it usual that the goods are sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 52 and the case-law cited).

56. The GC had previously found that there was no similarity between such goods in *Oakley Inc. v OHIM ("Oakley")*, Case T-116/06, stating that:

"86. The intervener's argument that eyewear, jewellery and watches could be similar or complementary to items of clothing cannot succeed, since, as correctly pointed out by OHIM, the relationship between those goods is too indirect to be regarded as conclusive. It must be borne in mind that the search for a certain aesthetic harmony in clothing is a common feature in the entire fashion and clothing sector and is too general a factor to justify, by itself, a finding that all the goods concerned are complementary and, thus, similar."

57. Particularly considering the GC's guidance in these judgements, there is, in my view, no complementarity between the respective goods; the relationship between them is not sufficiently proximate. In addition, whilst Mr Schneider has provided evidence that Selfridges and Luis Vuitton offer sunglasses, jewellery and watches,<sup>12</sup> this does nothing more than confirm my own impression that the respective goods may both be sold by very large retailers or luxury fashion brands. This evidence does not establish that it is typical for these goods to reach the market through shared trade channels. The respective goods share users, but this is based on an extremely large user base, i.e. the general public. Overall, I find that there is no similarity between the respective goods.

### *Batteries*

58. In respect of these goods, the Swiss Confederation submits that its watches (as part of *horological and chronometric instruments*) are often powered by batteries,

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<sup>12</sup> Exhibit 14

rendering them complementary. It adds that these goods are also often sold in the same shops to the same users. For the avoidance of doubt, I consider that the respective goods differ in nature, method of use and intended purpose. There is no competition between them. To my mind, the Swiss Confederation's argument regarding complementarity is reminiscent of the following example given by Mr Daniel Alexander QC, sitting as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

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

59. Although batteries are very often used to power watches, I do not consider this to be sufficient for the purposes of establishing that they are complementary goods. The purpose of examining whether there is a complementary relationship between goods is to assess whether the relevant public are liable to believe that responsibility for those goods lies with the same undertaking or economically connected undertakings. In respect of batteries and watches, I am of the view that this is unlikely. Furthermore, whilst there may be instances of watches and batteries being sold in the same shops, I do not consider this to be typical in trade. Although Mr Schneider has provided evidence of Argos selling both watches and watch batteries,<sup>13</sup> Argos is a very large retailer which sells an extremely wide range of different goods. I do not consider this single instance to be sufficient for supporting a finding that the respecting goods share trade channels. I acknowledge that the respective goods share users, though only at a level too general to engage any similarity, overall. Taking all of this into account, I find that there is no similarity between the respective goods.

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<sup>13</sup> Exhibit 14

*Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment and computers; fire extinguishing apparatus*

60. The Swiss Confederation submits that the above goods are similar to its goods in classes 14 and 16 because they can (i) be marketed to the same target group, (ii) serve the same nature or purpose, (iii) have the same commercial origin, stem from the same manufacturers and be distributed through the same channels, and (iv) be complementary and/or in competition. However, it has offered no explanation as to why that is the case. To my mind, Promoshirt's goods differ in nature, method of use and intended purpose when compared with the Swiss Confederation's goods. They do not typically reach the market through the same trade channels. Given their different purposes, I cannot see any reason for concluding that there is a competitive relationship between them. Moreover, they do not appear to be complementary in the sense outlined in the authorities. Users may overlap; however, this is likely to be at a level far too general to engage any similarity, overall. In light of all this, I find that there is no similarity between the respective goods.

#### Class 11

*Apparatus for lighting; torches; lanterns; lamps*

61. The Swiss Confederation argues that these goods are similar to its *precious metals and their alloys and goods in precious metals or coated therewith not included in other classes* (including works of art) on the basis that Promoshirt's goods include ornate and decorative lighting installations, which are used for both lighting and decoration, and include products made from precious metals and their alloys and fulfil the purpose of being decorative. I disagree. Again, considering Mr Purvis' guidance in *Unicorn Studio*, the argument that the respective goods share a purpose because they are decorative is far too superficial. The same argument could be made for an extremely wide range of goods. Whilst lamps and other lighting installations can be aesthetically pleasing, their core purpose is to provide light. The Swiss Confederation's goods do not. Moreover, whilst these goods can be made from metals, the mere fact that a good

is used as a part or component of another good is not sufficient, in and of itself, to establish that they are similar, since their nature, purpose and users may be different. I consider that to be the case here. Furthermore, I accept that the respective goods could be sold by the same undertakings, such as, for example, homeware or home décor stores. Nevertheless, as these outlets sell an extremely wide range of different goods, I do not consider that sufficient for a finding that the respective goods share trade channels. Users of the respective goods overlap to the extent that they are purchased by the general public. However, that is an extremely large user base. The respective goods are not in competition as, notwithstanding any overlapping aesthetic qualities, they are not interchangeable. Neither do I consider them to be complementary; even where the lighting products are made from metals, consumers would not expect responsibility for the respective goods to lie with the same undertakings. Overall, I find that there is no similarity between the respective goods.

*Apparatus for heating; apparatus for cooking; apparatus for refrigerating; apparatus for drying; apparatus for sanitary purposes*

62. The Swiss Confederation submits that the above goods are similar to its goods in classes 14 and 16 because (i) they can be marketed to the same target group, (ii) they can serve the same nature or purpose, (iii) they can have the same commercial origin, stem from the same manufacturers and be distributed through the same channels, and (iv) they can be complementary and/or in competition. However, it has offered no explanation as to why that is the case. To my mind, there are no obvious points of similarity between the respective goods. I cannot see how the respective goods can be said to share a nature or purpose. Moreover, they do not typically share trade channels and are not ordinarily produced by the same undertakings. Given that the respective goods have entirely different purposes, there is no competition between them. They are neither important nor indispensable to the use of one another and, as such, are not complementary. Users may overlap, though only at a level far too general to engage any meaningful similarity between them. I find that the respective goods are dissimilar.

## Class 18

63. In its written submissions, the Swiss Confederation argues that Promoshirt's goods in this class and its *jewellery* and *watches* in class 14 are similar because they are complementary and are often sold under the same brand by the same retailers. The nature, purpose and method of use of the respective goods differ. Moreover, whilst the GC's guidance in *Compagnie* and *Oakley* was in respect of sunglasses, jewellery, watches and clothing, I consider the same principles can be applied to bags in class 18. The respective goods are not complementary, since the relationship between them is insufficiently proximate. In addition, the respective goods may both be sold by large retailers or luxury fashion brands, as is shown by Mr Schneider's evidence from the Louis Vuitton website.<sup>14</sup> However, there is no evidence that it is typical for them to reach the market through shared trade channels. The respective goods share users, though only at a level too general to engage any similarity, overall. Considering all the above, I find that the respective goods are dissimilar.

## Class 20

### *Furniture; mirrors; picture frames*

64. In relation to the above, the Swiss Confederation has made the same arguments as considered against *mirrors; picture frames* of Promoshirt's first mark. For the same reasons as given at paragraphs 45 to 47, I find that there is no similarity between the respective goods. For the avoidance of doubt, I have also considered the additional term *furniture* but have concluded that the same findings are applicable. In particular, I have also considered Mr Schneider's evidence of Louis Vuitton and Dolce & Gabbana producing furniture as well as jewellery and watches.<sup>15</sup> However, these are large retailers and luxury fashion brands. This evidence does not, in my view, establish that these goods typically share trade channels. The respective goods are dissimilar.

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<sup>14</sup> Exhibit 14

<sup>15</sup> Exhibit 14

*Camping furniture, camping mats, camping chairs, sleeping bag pads*

65. The Swiss Confederation contends that these goods are similar to its goods in classes 14 and 16 for the same reasons as discussed at paragraph 62. Whilst I acknowledge that the applied-for goods under consideration are different, it is my view that the same findings are applicable here. There is no similarity between the respective goods.

Class 25

66. The Swiss Confederation submits that the applied-for goods in this class are similar to its *jewellery* and *horological and chronometric instruments* (specifically, watches) on the basis that they are aesthetically complementary and are often sold under the same brand and by the same retailers. Although nothing is said about nature, method of use or intended purpose, I consider these to be different. I have already discussed the GC's judgements in *Compagnie* and *Oakley* above. For the same reasons, I find that the respective goods are not complementary. I agree with the Swiss Confederation to the extent that the respective goods may both be sold by large retailers or luxury fashion brands. I also accept the evidence showing that Louis Vuitton sells clothing, jewellery and watches.<sup>16</sup> However, there is no evidence that it is typical for these goods to reach the market through shared trade channels. The respective goods share users, but this is based on an extremely large user base, i.e. the general public. Overall, I find that there is no similarity between the respective goods.

67. For the sake of completeness, I note that, within its written submissions, the Swiss Confederation refers to previous decisions of this Tribunal (BL O/501/13 and BL O/082/13). The Swiss Confederation argues that these decisions support the notion that goods in classes 14 and 25 are similar because they are often worn together and are used as part of an outfit to create an overall look. Whilst I have reviewed these decisions, I am unable to find support for this argument within the same. In any event, it is well-established that previous decisions of this Tribunal are not binding. The Swiss

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<sup>16</sup> Exhibit 14

Confederation also refers to a decision from Amanda Michaels, sitting as the Appointed Person (BL O/357/14). However, that was an appeal from a decision of this Tribunal which did not consider any goods relevant to the present assessment (BL O/501/13).

#### Conclusions on the goods comparison

68. Some degree of similarity between goods is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered.<sup>17</sup> My findings above mean that the opposition against Promoshirt's second mark under section 5(2)(b) of the Act must fail in its entirety. My findings also mean that the opposition against Promoshirt's first mark under section 5(2)(a) of the Act must fail in relation to the following goods:

Class 20: Mirrors, picture frames.

Class 21: Brush-making materials; steelwool; unworked or semi-worked glass (except glass used in building).

Class 27: Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

Class 34: Tobacco; smokers' articles.

69. For the avoidance of doubt, the remainder of my assessment of the Swiss Confederation's opposition under section 5(2)(a) will focus only on those goods for which I have found at least some similarity, namely:

Class 6: Common metals and their alloys; ores.

Class 21: Glassware, porcelain and earthenware not included in other classes.

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<sup>17</sup> *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA, paragraph 49

### **Average consumer**

70. As the authorities indicate, I must determine who the average consumer is for the parties' goods and how they are likely to select those goods. The average consumer has been described in the following terms:<sup>18</sup>

“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 [...] 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.”

71. Given the nature of the goods at issue in these proceedings, it is my view that the average consumer may be a member of the general public or a business/professional user. The attentiveness shown during the purchasing process is likely to vary depending on the product in question. For instance, paper or cloth table covers are likely to be relatively casual and inexpensive purchases, whereas precious metals or works of art are likely to be more considered purchases which attract a higher cost. Business and professional users will also be alive to the impact of their selection on their own business and the potentially negative consequences of selecting the wrong product. Whilst I accept that it may be lower for some goods and higher for others, overall, it is my view that the average consumer will demonstrate a medium level of attention. The goods are likely to be purchased in retail outlets and their online equivalents, as well as direct from manufacturers and suppliers. They will be selected after viewing the goods on shelves or displays, or after viewing images and information on the internet or in brochures. Consequently, I find that the purchasing process will be predominantly visual in nature. However, I do not exclude aural considerations

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<sup>18</sup> *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), paragraph 60

entirely, as the average consumer may receive word-of-mouth recommendations or wish to discuss the products with the manufacturer or supplier.

### **Distinctive character of the earlier mark**

72. In *Lloyd Schuhfabrik Meyer*, 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).”

73. Registered trade marks possess varying degrees of inherent distinctive character. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

74. The Swiss Confederation’s registration is in word-only format and consists of the words ‘SWISS MILITARY’. As there are no other elements, the distinctiveness of the

mark lies in the words themselves. In combination, the words will be understood as referring to the armed forces of Switzerland. The mark could be perceived as an indication that the goods originate from, or are intended for use by, the armed forces of Switzerland. However, there does not appear to be any obvious connection with the goods relied upon, rendering its use in relation to those goods somewhat fanciful. Overall, I find that the mark possesses a medium level of inherent distinctive character.

75. Evidence has been filed by the Swiss Confederation and I am now required to determine whether it has demonstrated that its registration had an enhanced level of distinctive character at the relevant date, that being 27 July 2017 (the filing date of Promoshirt's marks).

76. In his first witness statement, Mr Schneider gives evidence of the Swiss Confederation's use of 'SWISS MILITARY'. He says that the Swiss Confederation forms part of the Swiss Government and licenses the manufacture and sale of 'SWISS MILITARY' branded goods through approved licensees. At the date of his statement (1 February 2023), the Swiss Confederation was said to have three authorised licensees of the brand. In support of this, Mr Schneider provides a printout of a press release on the Swiss Confederation's website, dated 29 March 2022, regarding a Swiss company being contracted as a new licensee for the 'SWISS MILITARY' brand; it also mentions existing licensees in the watch sector.<sup>19</sup> Mr Schneider says that royalties generated from such licensing agreements are paid into the Swiss Federal Treasury and fund the operation of the Swiss Government. However, no details have been provided as to any royalties received from licensing agreements. Moreover, no information has been provided regarding any sales, including, for instance, how many products have been sold bearing the 'SWISS MILITARY' mark or where any customers were based. There is no evidence of any promotional activities conducted in the UK or any amounts spent on the same. There is also no evidence of actual use of the mark in the UK. The press release was on a Swiss website; there is nothing which indicates how widely this would have been seen in the UK, if at all. It was also several years after the relevant date. Finally, Mr Schneider has provided Google

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<sup>19</sup> Exhibit 10

search results for the term “swiss military”.<sup>20</sup> This search was conducted on 30 January 2023, so cannot be relied upon as showing the position at the relevant date. Further, it is my understanding that internet searches use algorithms which become tailored to a user based upon their search history; search results will also vary over time and are dependent upon who is doing the search. Whilst the Swiss Confederation filed other evidence in these proceedings, none of it goes to its use of ‘SWISS MILITARY’. In my view, the evidence falls a long way short of supporting a finding that the distinctiveness of the mark had been enhanced at the relevant date.

### **Likelihood of confusion**

77. 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. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the Swiss Confederation’s mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

78. 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.

79. Earlier in this decision, I concluded as follows:

- The Swiss Confederation’s first registration and Promoshirt’s first mark are identical;

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<sup>20</sup> Exhibit 11

- The parties' goods are similar to between a low and medium degree (at least);
- The average consumer may be a member of the general public or a business/professional user, who will demonstrate a medium level of attention, overall;
- The purchasing process is likely to be predominantly visual in nature, though aural considerations have not been excluded;
- The Swiss Confederation's first registration enjoys a medium level of inherent distinctive character.

80. In consideration of all the above factors, I find that there is a likelihood of direct confusion. I acknowledge that there is a relatively low degree of similarity between some of the goods at issue. Moreover, I accept that there may be circumstances where the average consumer exhibits a slightly higher level of attention when selecting the goods. Nevertheless, accounting for the principles of interdependency and imperfect recollection, it is my view that the identity of the competing marks and the distinctive character of the Swiss Confederation's first registration will result in the average consumer mistaking one mark for the other.

## **Conclusion**

81. The Swiss Confederation's claim against Promoshirt's first mark under section 5(2)(a) succeeds in relation to the following goods:

Class 6: Common metals and their alloys; ores.

Class 21: Glassware, porcelain and earthenware not included in other classes.

Class 24: Table covers.

82. The Swiss Confederation's claim against Promoshirt's first mark under section 5(2)(a) is dismissed in respect of the remaining goods.

83. The Swiss Confederation's claim against Promoshirt's second mark under section 5(2)(b) is dismissed in its entirety.

### **Section 3(3)(b)**

84. Section 3(3)(b) of the Act states:

“3(3) A trade mark shall not be registered if it is—

[...]

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

85. In *TWG Tea Company Pte Ltd v Mariage Frères SA*, BL O/358/17, Professor Phillip Johnson, sitting as the Appointed Person, provided the following summary of the case law (at paragraph 84 of his decision):

“(a) it is necessary to establish that the mark will create actual deceit or a sufficiently serious risk that the consumer will be deceived: *C-87/97 Consorzio per la tutela del formaggio Gorgonzola*, ECLI:EU:C:1999:115, paragraph 41; *C259/04 Emanuel*, ECLI:EU:C:2006:2015, paragraph 47; *C-689/15 W.F. Gözze Frottierweberei*, EU:C:2017:434, paragraph 54;

(b) the deception must arise from the use of the mark itself (i.e. the use per se will deceive the consumer); *Gorgonzola*, paragraph 43; *Emanuel*, paragraph 49; *Gözze Frottierweberei*, paragraph 56;

(c) the assessment of whether a mark is deceptive should be made at the date of filing or priority date and so cannot be remedied by subsequent corrective

statements: *Axle Associates v Gloucestershire Old Spots Pig Breeder's Club* [2010] ETMR 12, paragraph 25 and 26;

(d) the decision must have some material effect on consumer behaviour: *CFA Institute's Application* [2007] ETMR, paragraph 40;

(e) where the use of a mark, in particular a collective mark, suggests certain quality requirements apply to goods sold under the mark, the failure to meet such requirements does not make use of the mark deceptive: *Gözze Frottierweberei*, paragraphs 57 and 58;

(f) only where the targeted consumer is made to believe that the goods and services possess certain characteristics which they do not in fact possess will the consumer be deceived by the trade mark: T-248/05, *HUP Usługi Polska v OHIM*, ECLI:EU:T:2008:396, paragraph 65;

(g) where a mark does not convey a sufficient specific and clear message concerning the protected goods and services or their characteristics but, at the very most, hints at them, there can be no deception in relation to those goods and services: *HUP*, paragraph 67 and 68; T-327/16; *Aldi v EUIPO* ECLI:EU:T:2017:439, paragraph 51;

(h) once the existence of actual deceit, or a sufficiently serious risk that the consumer will be deceived, has been established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading: T29/16 *Caffé Nero Group v EUIPO*, ECLI:EU:T:2016:635, paragraph 48;

(i) where a trade mark contains information which is likely to deceive the public it is unable to perform its function of indicating the origin of goods: T-41/05 *SIMS – École de ski internationale v OHIM*, EU:T:991:200, paragraph 50, *Caffé Nero*, paragraph 47."

86. The Swiss Confederation's pleaded case under this ground is that the use and registration of Promoshirt's marks creates a serious risk that the public will be deceived on the basis that the goods will be perceived as being:

(i) Manufactured in Switzerland, due to the inclusion of the word 'SWISS', when they are not;

(ii) Supplied or authorised by a public authority, i.e. the Swiss military, which is controlled by the Swiss Confederation, not Promoshirt; and/or

(iii) Used by the Swiss military, when they are not.

87. The Swiss Confederation's pleaded case also states that 'SWISS MILITARY' is an 'official designation'. It argues that the relevant public would assume that Promoshirt's marks relate to the Swiss military, which they would understand as being part of the Swiss Government, such that the marks imply an official approbation and/or connection with the Swiss Government, where there is none. In respect of Promoshirt's second mark, it contends that the additional elements 'BY BTS' do not remove the risk of deception and would be given very little attention, if any. The Swiss Confederation submits that, as a company registered in Switzerland, Promoshirt's predecessor in title knew that 'SWISS MILITARY' was an official designation. In this connection, it points to a decision of the Swiss Federal Administrative Court, dated 31 January 2011, which held that 'SWISS MILITARY' was an official designation; the proceedings allegedly involved a company related to Promoshirt's predecessor in title.

88. I first deal with the Swiss Confederation's argument that Promoshirt's marks are deceptive as to the geographical origin of the applied-for goods. It is not in dispute that the word 'SWISS' in Promoshirt's marks describes something relating to Switzerland. In my view, the average consumer would immediately understand the word in this way. I note that the applied-for goods are not limited to being manufactured in any particular territory. Therefore, registration of the marks would provide Promoshirt protection for such goods manufactured inside and outside of Switzerland. If the goods were manufactured in Switzerland, there can plainly be no deception. There being no evidence of actual deception, the issue to be determined is whether there is a

sufficiently serious risk that the public will be deceived if goods under the marks are not manufactured in Switzerland. There is no evidence that Switzerland has a reputation or association with any of the applied-for goods. There is also no evidence as to the sorts of goods or services that Switzerland is known for producing. It is my own impression that there is an association between Switzerland and knives, watches, chocolate and cheese, and that the average consumer would recognise this. However, Promoshirt does not seek registration of its marks in respect of any of these products. Neither would they fall within the scope of any of the broader terms used in its specifications. As such, there does not appear to be any real potential for deception. There is no basis upon which the average consumer would genuinely expect the applied-for goods to originate from Switzerland; the link between the marks and Switzerland is unlikely to influence the average consumer's decision-making during the selection process.

89. Similarly, I am not convinced that there is a sufficiently serious risk that the average consumer would be deceived into believing that Promoshirt's goods are used by the Swiss military. I accept that Promoshirt's marks consist of, or include, the words 'SWISS MILITARY'. However, none of Promoshirt's goods strikes me as being specifically apt for use by the armed forces. In respect of some of the applied-for goods, such as, for example, *picture frames*, *carpets* and *cosmetic cases*, I consider it extremely unlikely that the average consumer would expect them to be used by the Swiss military; there is no real connection between the armed forces and these goods. In respect of others, such as, for example, *torches*, *clothing*, *bags*, and *camping mats*, there is a more tangible connection with use by the armed forces. However, I am not convinced that the average consumer, being reasonably well-informed, observant and circumspect, would genuinely believe that these general consumer products, offered in a commercial context, would be apt for use by the armed forces of Switzerland on the basis of Promoshirt's marks. Whilst I am aware of 'army surplus' stores, I have no knowledge of whether the average consumer would typically expect such outlets to stock equipment used by particular armed forces. There is also no evidence to that effect. Moreover, there is no evidence that the equipment used by the Swiss military (as opposed to any other armed forces) has desirable qualities that would influence the average consumer's decision-making during the selection process.

90. I now turn to consider the final part of the Swiss Confederation's pleaded case, namely, that Promoshirt's goods will be perceived as being supplied or authorised by the Swiss military. In *Cormeton Fire Protection Ltd v Cormeton Electronics Ltd & Anor* [2021] EWHC 11 (IPEC), it was alleged that the use of a mark was deceptive because there had been at least a partial separation of the goodwill, meaning that the mark was no longer distinctive of a single undertaking and had therefore become misleading. Dismissing the argument, David Stone, sitting as a Deputy High Court Judge, said:

"85. First, in relation to the law, as I have already noted, section 3(3)(b) is in the part of the TMA which deals with absolute grounds of refusal. Absolute grounds are those that pertain to the mark itself – for example, marks devoid of distinctive character, marks which denote kind or quality, certain types of shape marks, and marks contrary to public policy. That is already a clear guide to the interpretation of section 3(3)(b) – it is clearly not aimed at preventing registration of marks in which a third party may own rights.

86. Next, the section itself lists, albeit non-exclusively, examples of types of mark which may deceive the public – "for instance as to the nature, quality or geographical origin of the goods or services". Counsel for the Defendants submitted that this list is not closed, and I accept that submission. But the examples given are all absolute grounds examples, concerned with deception about the nature of the goods or services on offer. None of the examples given relates to the message that may be conveyed about the business origins of the goods or services provided under the mark.

87. Third, this position is entirely consistent with the limited case law on section 3(3)(b) and its equivalents in the EU instruments I have referred to above [...]."

91. After summarising the findings in *Emanuel, Melly's Trade Mark Application* [2008] ETMR 41, *Sworders Trade Mark*, BL O/212/06, and Case C-689/15, *WF Gözze Frottierweberei v Verein Bremer Baumwollbörse*, he said:

"87. [...] These four decisions speak with one voice – section 3(3)(b) of the TMA refers to *per se* or absolute grounds.

88. Fourth, if the Defendants are right, their interpretation would drive a coach and horses through the relative grounds provisions in section 5 of the TMA. All an earlier right owner would need to do would be to allege public deception, without first having to comply with the requirements for identical or similar marks, identical or similar goods/services, or ownership of a mark with reputation. This cannot be what the legislature intended.

89. Therefore, in my judgment, section 3(3)(b) of the TMA is not engaged where the only "deception" is as to who is using the mark to provide goods or services. That sort of deception is remediable under the relative grounds for refusal of registration to be found in section 5 of the TMA. The Defendants' application for invalidity under section 3(3)(b) fails."

92. The Swiss Confederation's case is predicated on the average consumer mistakenly believing that Promoshirt's goods are supplied or authorised by the Swiss military. The only deception possible in circumstances where the goods are believed to be supplied by the Swiss military is who is providing the goods or using the mark. In my view, this is also the case if the goods were seen as being authorised, rather than supplied, by the Swiss military. This is because, ultimately, it still relates to what undertakings are responsible for the provision of the goods. The Swiss Confederation's argument does not engage this ground.

93. The Swiss Confederation's claims under section 3(3)(b) of the Act are dismissed.

### **Section 3(6)**

94. Section 3(6) of the Act states:

"(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

95. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin SCJ considered the question of what amounts to bad faith. He underlined that the

categories of bad faith and the circumstances which may constitute bad faith are not closed, and continued:

“152. In seeking to identify the relevant principles, it is necessary to have in mind two fundamental aspects of trade mark law to which I have already referred: first, it is concerned with the use of marks in trade to denote the origin of goods and services. Secondly, the aim of the trade mark regime is to contribute to a system of undistorted competition in which businesses are able to attract and retain customers by the quality of their goods and services, and for that purpose are able to have registered signs which enable consumers to distinguish the goods and services of one undertaking from those of another. Such a system must also provide an incentive and protection for the investment by a brand owner in the quality and other beneficial aspects of its goods and services, and so allow it to develop a goodwill in its business relating to their sale and supply.

153. Against this background, the essence of the objection that an application to register a mark was made in bad faith may be understood: it is that the motive or intention of the applicant was to engage in conduct that departed from accepted principles of ethical behaviour or honest commercial practices having regard to the purposes of the trade mark system which I have described. Whether the conduct was undertaken with that motive or intention and did indeed depart from such ethical behaviour or honest commercial practices must be assessed having regard to all the objective circumstances of the case: see, for example, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 ("*Koton*"), paras 46 and 47 [...].”

96. Later in his judgement (at paragraph 240), Lord Kitchin summarised the general principles applicable to bad faith as follows:

“(i) [...]”

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”), para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes

other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([*Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of

undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a bona fide intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

97. It is necessary to ascertain what Promoshirt knew at the relevant date.<sup>21</sup> Evidence about subsequent events may be relevant if it casts light backwards on the position at the relevant date.<sup>22</sup>

98. Promoshirt's marks were filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the EU. This provision allowed those who had pending EU trade marks at the end of the transition period to file a UK application and claim the filing/priority date of the former for that of the latter for the purpose of establishing "which rights take precedence", in accordance with section 6(A) and paragraph 25 of Schedule 2A of the Act. The filing date of Promoshirt's EU trade marks was 27 July 2017, whereas the filing date of the UK applications was 29 September 2021. Unlike for relative grounds objections, for which the EU filing date is claimed, the relevant date for determining the absolute grounds contained in section 3 of the Act is the actual filing date of the application in the UK. Therefore, the relevant date for determining this ground of opposition is 29 September 2021.

99. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

- (i) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
- (ii) Was that an objective for the purposes of which the contested application could not be properly filed?
- (iii) Was it established that the contested application was filed in pursuit of that objective?

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<sup>21</sup> *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)

<sup>22</sup> *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

100. The Swiss Confederation's pleaded case on bad faith in respect of Promoshirt's first mark is as follows:

“31. The Applicant is a Swiss registered company and since at least 31 January 2011, following the decision of the Swiss Federal Administrative Court [...], it has been expressly aware that the protection, maintenance and exploitation of the Sign in Switzerland and abroad has been exclusively delegated to the Opponent.

32. Pursuant to Swiss parliamentary instructions which came into force on 1 February 2014 and were renewed on 19 December 2018, the Opponent was delegated the right to expand, protect, manage and exploit Swiss Military trade marks which include, but are not limited to, the Sign in Switzerland and abroad. As a Swiss registered company, it is averred that the Applicant would be aware of this remit – in particular due to:

32.1 the relevance of the decision of the Swiss Federal Administrative Court; and

32.2 the Opponent has held several meetings with a partner organisation of the Applicant, Bögli Trading & Selling AG, regarding unauthorised use of the Sign, in Switzerland and internationally.

33. Given the Applicant's knowledge of the Opponent's exclusive remit to protect and commercialise the Sign and the Opponent's efforts to do so, the Application is nothing more than a “land grab” to frustrate the Opponent's objectives.

34. It is averred that the Sign has a long standing, clear and obvious connection to the military and armed forces of Switzerland. The military of Switzerland has international recognition and reputation as being efficient and is very well

regarded. The Applicant, being a Swiss registered company, has an enhanced understanding and recognition of the reputation of the military of Switzerland. Its decision to apply to register the Sign as a trade mark is a cynical attempt to capitalise on this long standing reputation associated with the Opponent.

35. As mentioned above, the Opponent had already engaged in correspondence (and meetings) with the Applicant's partner, Bögli Trading & Selling AG, regarding the unauthorised use of marks containing the Sign. Prior to its bankruptcy, the Swiss trade marks Office had also contacted Bögli Trading & Selling AG in regard to the unlawful use of marks containing the Sign. It is submitted that the Applicant will have been aware of such communications.

36. The Opponent has filed a number of challenges to trade marks for the Sign in a number of jurisdictions; many of the challenges are against applications and registrations owned by the Applicant, or its partner companies.

37. At the date of filing the Application, the Applicant knew or had reason to believe that the Sign was connected to, referred to and was in the exclusive remit of the Opponent. The filing of the Application with such knowledge, falls well short acceptable commercial behaviour observed by reasonable and experienced people in the relevant industry and as such constituted a dishonest act.”

101. Its pleaded case in respect of Promoshirt's second mark is identical, save for an additional argument that the 'BY BTS' element of the mark does not impact the assessment since it will be given very little attention, if any.

102. In concrete terms, Promoshirt (or its predecessor in title) has been accused of applying to register its marks with the intention of frustrating the Swiss Confederation's objectives and taking advantage of the reputation associated with the military of Switzerland, for which the Swiss Confederation is ultimately responsible. The applications are alleged to have been made by Promoshirt (or its predecessor in title) in the knowledge that it was not the rightful owner of the marks.

Was that an objective for the purposes of which the contested application could not be properly filed?

103. It is my view that, if so proven, applying for the marks in order to take unfair advantage of the Swiss Confederation's reputation and to frustrate its activities with respect to the 'SWISS MILITARY' mark are objectives for which Promoshirt's marks could not be properly filed.

Was it established that the contested application was filed in pursuit of that objective?

104. Mr Schneider gives evidence that the Swiss Confederation is one of the seven federal executive departments which make up the executive body of the Swiss Government. It is responsible for matters of defence, civil protection and sport. This is confirmed in printouts from the Swiss Government's website, obtained on 30 January 2023.<sup>23</sup> The Swiss Confederation is said to be actively involved in protecting any designations or geographical indications of Swiss origin in relation to the Swiss armed forces within Switzerland and abroad. On 1 February 2014, the Swiss Confederation enacted revised administrative instructions regarding trade mark policy.<sup>24</sup> These stated, *inter alia*:

**"Section 2: Basic information about VBS trademark policy"<sup>25</sup>**

**Item 4** Special position of military trademarks, in particular the trademark "Swiss Army"

[...]

4 According to motion SIK SR (12.3667) concerning the registration of "Swiss Army", "Swiss Military" and "Swiss Air Force" trademarks, Armasuisse is charged with expanding the previous scope of trademark protection. With the

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<sup>23</sup> Exhibit 1

<sup>24</sup> Exhibit 3

<sup>25</sup> 'VBS' is an abbreviation for the Swiss Federal Department of Defense, Civil Protection and Sports.

enactment of Swissness legislation, licensees must also observe the corresponding parameters and requirements.

[...]

### **Section 3: Organization of trademark protection and legal trademark agreements**

#### **Item 6 Method for registering VBS trademarks**

1 The Armasuisse group is responsible for trademark protection and military trademark registration at home and abroad as described in Item 4. Trademark protection by Armasuisse takes place in cooperation with external trademark attorneys and contractual partners of Armasuisse within the framework of trademark license agreements.”

105. Mr Schneider explains in his statement that Armasuisse is the federal body responsible for the procurement of complex technology. He confirms that it sits within the Swiss Confederation, representing one of its key tasks.

106. On 19 December 2018, the administrative instructions regarding trade mark policy were renewed and were to remain in force until 31 December 2023.<sup>26</sup>

107. In addition to these instructions, the Federal Act on the Protection of the Swiss Coat of Arms and Other Public Signs 2013 (“CAPA”) states as follows:<sup>27</sup>

#### **“Art.6 Official designations**

The following terms are considered official designations:

[...]

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<sup>26</sup> Exhibit 5

<sup>27</sup> Exhibit 6

g. any other terms that imply a Swiss authority of an official or semi-official activity.

[...]

**Art. 9 Official designations**

1 Official designations and terms with which they could be confused may only be used on their own by the public body to which they belong.

2 The use of designations under paragraph 1 by persons other than the public body entitled to use them is only permissible when such persons are carrying out an official or semi-official activity.

3 Designations under paragraph 1 may be used in conjunction with other word or figurative elements to the extent that such use is neither misleading nor contrary to public policy, morality or applicable law.”

108. Mr Schneider says that, in the exercise of its authority under the administrative instructions and CAPA, the Swiss Confederation has applied to register trade marks in a number of territories around the world. A list is provided,<sup>28</sup> which includes multiple ‘SWISS MILITARY’ marks in, *inter alia*, Switzerland, the UK and the EU, which predate the filing of Promoshirt’s marks.

109. As mentioned previously, the Swiss Confederation licenses the manufacture and sale of branded goods through approved licensees. It currently has three such licensees and publishes details of its authorised licensees on its website. Royalties from these arrangements fund the operation of the Swiss Government.

110. Mr Schneider says that the Swiss Federal Administrative Court has confirmed that both ‘SWISS MILITARY’ and ‘SWISS MILITARY BY BTS’ are official designations. In this connection, he provides copies of decisions from the same dated 31 January

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<sup>28</sup> Exhibit 9

2011 and 22 January 2018.<sup>29</sup> The first concerns an appeal against a decision of the Swiss Federal Institute for Intellectual Property to refuse registration for ‘SWISS MILITARY BY BTS’; it agreed that registration of the mark in Switzerland would be unlawful on the basis that the mark would have a deceptive effect where the goods have a connection to the Swiss military or are suitable as military equipment. It said that “the term ‘SWISS MILITARY’ refers to the Swiss military or to the Swiss Confederacy – in short: the federation”. The appellant’s identity is not visible in the decision, but Mr Schneider says that it was Bögil Trading & Selling AG (“BTS”). The second decision concerned opposition proceedings between Armasuisse and Montres Charmex SA. The Federal Administrative Tribunal found that the term ‘Swiss Military’ could not be used by parties other than the Swiss Government (in respect of watches) and that it fell within the definition of an official designation or could be confused with one. Mr Schneider also refers to a decision of the Federal Administrative Court in which it held that use of ‘SWISS MILITARY’ by BTS was not permitted but has not provided a copy of the same.

111. Mr Schneider says that the Swiss Confederation and BTS met in 2019 to discuss its unauthorised use of, and applications to register, ‘SWISS MILITARY’ and ‘SWISS MILITARY BY BTS’. He continues to explain that Promoshirt’s predecessor in title, a Swiss registered company,<sup>30</sup> and BTS were closely connected. He says that BTS no longer trades and is dissolved.<sup>31</sup> Promoshirt is said to have taken over the business. According to Mr Schneider, Promoshirt would have been aware of BTS’ disputes with the Swiss Confederation and has, itself, been involved in disputes with the Swiss Confederation regarding the marks at issue.

112. In response to the Swiss Confederation’s case, Mr Sawhney gives evidence that Promoshirt has a legitimate interest in protecting its marks in the UK, merely being a continuation of its filing programme throughout a number of territories outside Switzerland. Whilst he confirms that Promoshirt’s predecessor is a Swiss company, he also says that it adopted the ‘SWISS MILITARY’ marks in good faith long before

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<sup>29</sup> Exhibit 8

<sup>30</sup> As the printouts from the Swiss commercial register at Exhibit 12 confirm.

<sup>31</sup> The printouts from the Swiss commercial register at Exhibit 13 show that the company was in liquidation as of 1 February 2023.

any of the Swiss legislation came into force. He says that there was no intention to create any association with the Swiss Confederation.

113. Mr Sawhney provides printouts from the [swissmilitaryworldwide.com](http://swissmilitaryworldwide.com) website.<sup>32</sup> The printouts are not dated but the copyright information is given as 2015. The words 'SWISS MILITARY' are visible. Bags, pens, clothing and watches are shown in the product profile. The history section says that the brand began with Jacques Bögil making Swiss-made watches in 1984, and grew with his son, Jean-Luc Bögil. The website also says that the brand has a market presence in 26 countries, including the UK, Italy, Malaysia and the Philippines. Partners are listed for these countries, as well as others. BTS is listed as the partner in Switzerland. The brand is said to have over 600 retail stores/points of sale in Europe.

114. More information about business activities in Switzerland under 'SWISS MILITARY' is provided. Mr Sawhney says that, from 2000 onwards, Mr Bögil Jnr opened seven stores at major airports and train stations in Switzerland under the name 'Edelweiss Shops'. Photographs of Edelweiss stores have been provided.<sup>33</sup> 'SWISS MILITARY' products can be seen within, but the photographs are not dated. Mr Sawhney says that he was Mr Bögil's main sourcing partner for 'SWISS MILITARY' products. He then took over as CEO of the brand in 2006. Mr Sawhney says that, thereafter, 'SWISS MILITARY' products appeared in the Zurich Shopping Guide (2007) and at the Basel Fair (2009).

115. Mr Sawhney says that Mr Bögil and other group concerns assigned their trade mark registrations and applications for, *inter alia*, the marks at issue to Promoshirt's predecessor in title in 2014.

116. Mr Sawhney gives annual turnover figures for Promoshirt from 2010 to 2022, totalling 2723.56 crores.<sup>34</sup>

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<sup>32</sup> Exhibit AS1

<sup>33</sup> Exhibit AS2

<sup>34</sup> Mr Sawhney indicates that a crore is 10million rupees, approximately equivalent to £100,000.

117. Mr Sawhney says that the 'SWISS MILITARY' marks were registered by Promoshirt (or its predecessors in title) in more than 40 countries around the world. A list of registrations, said to predate the Swiss Confederation's registrations, has been provided. They cover several countries in Asia, as well as the UK and EU. Mr Sawhney has exhibited printouts from the trade mark register, showing the details of three comparable UK marks; they were filed at the EUIPO in May 2009, February 2014 and July 2017.<sup>35</sup>

118. According to Mr Sawhney, Promoshirt has sold a wide range of products bearing the 'SWISS MILITARY' marks. He provides printouts from the [swissmilitaryuk.com](http://swissmilitaryuk.com) website, most of which were obtained via the Wayback Machine.<sup>36</sup> They are from November 2016, April 2017, August 2017, August 2018, October 2019 and September 2020, and show 'SWISS MILITARY' branded keychains, multitools, chargers, torches, travel adaptors, travel clocks, pens and flasks. Mr Sawhney also exhibits 'SWISS MILITARY' product catalogues, showing camping equipment, kitchen appliances, men's clothing, face masks and heaters.<sup>37</sup> Only the catalogues containing the camping equipment and kitchen appliances are dated (2022).

119. Mr Sawhney says that, in addition to the website, 'SWISS MILITARY' products have been sold in the UK via B&M. As of 5 March 2021, B&M had over 600 stores in the UK.<sup>38</sup> Invoices showing the sale of 'SWISS MILITARY' and 'SWISS MILITARY BY BTS' products to B&M by Multi Lines International Co., Ltd on 13 March 2018 and 20 March 2018 have been provided.<sup>39</sup> The goods comprise kettles, lighters, water containers, camping pillows, cutlery sets and tents, and the sales total around \$85,000. Mr Sawhney gives narrative evidence that Multi Lines is a supplier of B&M. He also provides evidence showing that it is a sub-licensee of 'SWISS MILITARY' and 'SWISS MILITARY BY BTS' under the terms of an agreement signed between, *inter alia*, Promoshirt and Ample Bloom International Limited on 5 July 2017.<sup>40</sup> There are also printouts from other online trade channels for 'SWISS MILITARY' products.<sup>41</sup>

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<sup>35</sup> Exhibit AS3

<sup>36</sup> Exhibits AS4 and AS8(2)

<sup>37</sup> Exhibit AS5

<sup>38</sup> Exhibit AS6

<sup>39</sup> Exhibit AS2(2)

<sup>40</sup> AS7(2)

<sup>41</sup> Exhibit AS8

None is clearly dated, though the printouts from Eleven Street and Gmarket (both South Korea) are likely to be from 2018 and 2022, respectively.<sup>42</sup>

120. Mr Sawhney says that Promoshirt and Victorinox AG entered into a settlement agreement in 2010 following an opposition to its 'SWISS MILITARY' marks. In this connection, he evidences three agreements.<sup>43</sup> The first is between Swiss Army Brands, Inc and the Swiss Confederation, dated 18 December 1996. The second is a licence agreement between Victorinox and the Swiss Confederation, dated 14 February 2004. These two agreements concern 'SWISS ARMY' trade marks. The third is between, *inter alia*, Mr Sawhney and BTS and, *inter alia*, Victorinox and Swiss Army Brands, dated 23 March 2010. It was an agreement not to sue or otherwise object to the use and sale of the 'SWISS MILITARY' and 'SWISS MILITARY BY BTS' marks provided certain conditions were met. These broadly included (i) products could not be sold under the mark in the Americas, (ii) sales could not be made in a way which would result in products being introduced in the excluded territories, and (iii) the marks could not be used in relation to pocket knives/tools anywhere.

121. At the time of filing the EU marks upon which the marks at issue are based, Mr Sawhney says that Promoshirt's predecessors in title had been using the marks in relation to a broad range of goods for a number of years. The EU marks were said to be filed with the intention of providing Promoshirt protection in the UK and to protect its commercial interests in all the EU member states. However, due to opposition proceedings, the marks were not registered until after the transition period (following the UK's exit from the EU). This meant that Promoshirt's marks needed to be refiled in the UK.

122. In respect of CAPA and the administrative instructions referred to by Mr Schneider, Mr Sawhney gives evidence that Promoshirt understood that these applied in Switzerland only. However, he also states that this was not the position when its predecessors in title adopted 'SWISS MILITARY'; there was apparently no reason to

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<sup>42</sup> There is a reference to "SMTOWN-2022 Winter" in the former, whilst the copyright information for the latter states 2018.

<sup>43</sup> Exhibit AS9

believe that the mark belonged exclusively to the Swiss Confederation outside of Switzerland, or at all, in relation to all goods and services.

123. Mr Schneider responds to Mr Sawhney's evidence on these matters in his third statement. In addition to making specific criticisms of Mr Sawhney's evidence, Mr Schneider provides a chain of email correspondence.<sup>44</sup> This begins on 25 March 2015 with an email from Mr Sawhney to an individual at Armasuisse, in which he expresses an interest in obtaining a license for 'SWISS MILITARY' timepieces. Mr Schneider declined Mr Sawhney's offer on behalf of Armasuisse,, stating that it negotiates directly with the owners of Swiss manufacturing firms and that Promoshirt did not meet this requirement. On 31 March 2014, Mr Sawhney explained why he felt Promoshirt met the "Swissness" criteria and requested a meeting to discuss the matter. On 11 April 2014, Mr Schneider again referred to the "Swissness" criteria but offered a meeting in June or August that year. Mr Sawhney responded on 12 April 2014 confirming his desire for an appointment. No further correspondence is provided, though Mr Schneider states that Mr Sawhney's attempts were ultimately unsuccessful.

124. I acknowledge that the armed forces in Switzerland are within the Swiss Confederation's remit. Moreover, I accept that instructions regarding the protection of certain military trade marks were in force at the relevant date and that the definitions of official designations in CAPA appear to cover the term 'SWISS MILITARY', meaning that it can only be used by the public body to which it belongs. I also note the decisions of the Swiss courts from before the relevant date which held this to be the case. Finally, Mr Sawhney does not deny that BTS met with the Swiss Confederation in 2019 to discuss its unauthorised use of and applications for 'SWISS MILITARY' marks, as claimed by Mr Schneider. However, it is my view that these matters do not concern the position in the UK. For instance, the administrative instructions appear to have been internal guidance for internal administrative purposes, i.e. they appear to have applied to the registration and/or maintenance of marks by the Swiss Confederation, not third parties (aside from licensees, which Promoshirt was not). Furthermore, CAPA is legislation which applies in Switzerland; it is not applicable in the UK. The court

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<sup>44</sup> Exhibit 25

decisions also concerned the position in Switzerland, including the application of that legislation and the registrability of marks in that territory.

125. It seems to me that the height of these matters is that, being a Swiss company and having been involved (either directly or indirectly) in court proceedings in Switzerland, Promoshirt's predecessor (and, therefore, Promoshirt) would have, or reasonably should have, been aware of the position in respect of the term 'SWISS MILITARY' in that territory. There is no real evidence of use by the Swiss Confederation in the traditional sense, but I am of the view that there is likely to have been an awareness that the 'SWISS MILITARY' mark 'belonged' to it in Switzerland. I am fortified in this view by the email correspondence between Messrs Sawhney and Schneider regarding the former's request to become a licensee of 'SWISS MILITARY' timepieces; this shows that there was an acknowledgement on the part of Promoshirt that they required authorisation from the Swiss Confederation to use the mark.

126. Nevertheless, the mere fact that a trade mark applicant knew that another party was using the trade mark in another territory does not establish bad faith.<sup>45</sup> In addition, given the territorial nature of intellectual property rights, the mere appropriation of a name registered or used abroad is not enough under UK law; there must be something more before this can justify a finding of bad faith.<sup>46</sup> For instance, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment or another form of consideration from the third party.<sup>47</sup> To my mind, there is no evidence of use in the UK by the Swiss Confederation before the relevant date and no clear indication that it would look to use the 'SWISS MILITARY' mark in the UK in the future, notwithstanding it being considered an official designation in Switzerland and its registrations for the mark in the EU. There is no evidence of any use of the mark in the UK by licensees either.

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<sup>45</sup> Case C-320/12, *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker*

<sup>46</sup> *Wright v Dell Enterprises Inc.*, BL O/580/16

<sup>47</sup> *Daawat Trade Mark* [2003] RPC 11

127. It is also the case that there appears to have been some use of the mark by Promoshirt in the UK before the relevant date. The printouts from its global website stated that the brand had a market presence in the UK in 2015. There are also printouts from its UK-facing website from 2017, 2018 and 2019 which show use of the mark at those times. It is also considered that, before the relevant date, Promoshirt had filed applications to register the mark in multiple other jurisdictions. As Professor Johnson, sitting as the Appointed Person, stated in *Simpson Performance Products, Inc v Andreas Freundlieb*, BL O/0197/23, “[...] where a trader uses a mark in the United Kingdom for a long period before filing its application to register the mark this suggests good faith”. Although the evidence of use is rather limited, it at least adds weight to Mr Sawhney’s explanation that the applications were made to protect its existing business under the marks and as a continuation of its filing programme outside of Switzerland.

128. There are matters which give me pause for thought, namely the use of the Swiss flag alongside the ‘SWISS MILITARY’ mark on Promoshirt’s website and Mr Sawhney’s unsuccessful attempt to obtain a licence from Swiss Confederation before the relevant date. These matters could indicate that there was an intention to create an association with the Swiss Confederation and an awareness that Promoshirt needed authorisation from the Swiss Confederation to use the mark, at least in relation to pens and watches. However, an allegation of bad faith is a serious allegation which must be distinctly proved, and good faith is presumed until the contrary is proved. It is also not enough to prove facts which are as consistent with good faith as bad faith. As stated by Mr Simon Thorley QC, sitting as the Appointed Person, in *David Matthew Scott Holder T/A Velocette Motorcycle Company v Eicher Limited - Royal Enfield Motor Units*, BL O/363/01:

“31. An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning M.R. in *Associated Leisure v. Associated Newspapers* (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v. Garrett* (1878) 7 Ch. D. 473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of bad faith made under section 3(6). It should not be made unless it can be fully

and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference. Further I do not believe that it is right that an attack based upon section 3(6) should be relied on as an adjunct to a case raised under another section of the Act. If bad faith is being alleged, it should be alleged up front as a primary argument or not at all.”

129. Whilst I acknowledge that the usual civil evidence standard applies, i.e. balance of probability, and that it is wrong to expect a party to provide direct evidence of the motivation of another,<sup>48</sup> I do not consider that the Swiss Confederation has established that, by filing the marks in the UK, Promoshirt (or its predecessor in title) departed from the accepted standards of ethical behaviour or honest commercial and business practices. I am not satisfied, on the balance of the evidence, that the Swiss Confederation has established that there was any dishonest intention or other sinister motive at play.

130. The Swiss Confederation’s claims under section 3(6) of the Act are dismissed.

### **Outcomes of the Swiss Confederation’s oppositions**

131. The Swiss Confederation’s claims against Promoshirt’s first mark have succeeded in relation to some goods in classes 6, 21 and 24. In respect of the surviving goods, Promoshirt’s first mark will proceed to registration and may be relied upon for the purposes of its opposition against the IR.

132. The Swiss Confederation’s claims against Promoshirt’s second mark have failed in their entirety. Consequently, Promoshirt’s second mark will proceed to registration and may be relied upon in full for the purposes of its opposition against the IR.

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<sup>48</sup> *Maya Appliances Pvt. Ltd v Prapaharan Sivaratnam*, BL O/0052/25

## **PROMOSHIRT'S OPPOSITION**

### **Section 5(2)(b)**

133. The legislation and case law principles outlined at paragraphs 26 and 27 are equally applicable here.

### **Comparison of goods**

134. The goods to be compared are outlined in Annex C. The table produced therein accounts for the outcome of the Swiss Confederation's oppositions, i.e. only the surviving goods of Promoshirt's first mark are included along with all the goods of its second mark.

135. In conducting the following comparison, I keep in mind the case law principles outlined at paragraphs 38 to 40.

136. I note that the descriptions of the goods in the IR include the limitation [...] *all the aforesaid goods of Swiss origin*. This will have no impact on the following comparison because Promoshirt's goods are not limited in any way. As Promoshirt's goods could include those of Swiss origin, the limitation does not create any difference between the parties' goods.

### **Class 9**

*External batteries; batteries (cells); electric cells (batteries); accumulator boxes; dry cells; electric cells and batteries; anode batteries; batteries for mobile telephones; solar batteries*

137. It is my understanding that these goods all describe types of batteries and, therefore, fall within the scope of *batteries* of Promoshirt's second and third marks. These goods are identical in accordance with *Gérard Meric v OHIM ("Meric")*, Case T-133/05, in which the GC stated:

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

#### *Cell and battery chargers*

138. The above goods are not batteries per se. Rather, they are used to restore the charge of a battery. As such, they differ in nature, method of use and core purpose when compared with *batteries* of Promoshirt’s second and third marks. There is also no competition between them. However, the respective goods are likely to reach the market through shared trade channels and may be produced by the same undertakings. In my experience, it is also not uncommon for them to be sold together (particularly in the case of rechargeable batteries). There is a degree of complementarity between them since battery chargers are important to the use of chargeable batteries and consumers are likely to believe that responsibility for both lies with the same undertakings. Users are also shared. Taking all of this into account, I find that there is between a medium and high degree of similarity between the respective goods.

#### *Electric sockets; plug connectors; jack cables; converters for electric plugs*

139. To my mind, the above goods all fall within the scope of [...] *electric [...] apparatus and instruments* of Promoshirt’s second and third marks. These goods are identical under the principle in *Meric*.

#### *USB flash drives*

140. Whilst the above goods differ in nature to *recording discs* of Promoshirt’s second and third marks, the respective goods overlap in method of use and intended purpose in that they are both portable data storage devices. They are likely to reach the market through shared trade channels and may be located in the same sections of retail

outlets. Users are shared. The goods are not complementary because they are neither important nor indispensable to one another. However, given they could both be used to store data, they are in competition. Overall, I find that there is a medium degree of similarity between the respective goods.

*Cases for mobile telephones; leather cases for portable telephones; bags for laptop computers; bags adapted for tablet computers; holders for mobile telephones*

141. These goods have a similar nature, method of use and intended purpose when compared with *bags* [...] and *cases* [...] of Promoshirt's second and third marks in that they are all bags or cases in which items are placed for transport or protection.<sup>49</sup> They may sometimes reach the market through shared trade channels. In my experience, it is not uncommon for retail outlets which offer bags and luggage to also offer cases and bags for electronic devices. The respective goods also share users. There is no material competition between the goods. This is because they are not truly interchangeable; a consumer is unlikely to purchase, for example, a specially adapted bag for a laptop over a general-purpose bag. Although, in theory, a consumer could carry their belongings in a laptop bag, or a laptop in a general-purpose rucksack, those are not the typical uses of those goods. As the respective goods are not important or indispensable to the use of one another, they are not complementary. In light of all this, I find that there is a low degree of similarity between them.

*Fuel cells*

142. It is my understanding that the above goods differ from *batteries* of Promoshirt's second and third marks in that they are devices which generate electricity from a fuel source, rather than using stored energy. However, they overlap in nature, method of use and intended purpose in that the respective goods are both used as sources of electricity. I have no evidence as to how the respective goods reach the market or

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<sup>49</sup> Whilst I note that the specifications of Promoshirt's second and third marks both specifically include [...] *laptop bags* [...], the explanatory notes of the Nice Classification clearly state that class 18 does not include bags and cases adapted to the product they are intended to contain, such as bags adapted for laptops. This term is proper to class 9. In light of this, and since nothing in this decision turns on it, I decline to make a finding on the basis of these goods and instead compare the Swiss Confederation's goods with *bags*.

whether they are ordinarily produced by the same undertakings. However, the respective goods are both power sources and the term *batteries* does not only include batteries for everyday consumer goods, but for a wide range of applications. To my mind, there may be circumstances in which they are manufactured by the same undertakings and offered through the same trade channels. It also stands to reason that there may be circumstances where the respective goods are in competition; for particular applications, it may be possible to choose between a battery and a fuel cell. The respective goods may also have overlapping users. Taking all of this into account, I find that there is between a low and medium degree of similarity between them.

### *Safety helmets*

143. The above goods include many different types of safety helmets, including fire safety helmets. As such, although they differ in nature and method of use when compared with *fire extinguishing apparatus* of Promoshirts second and third marks, they may be produced by the same undertakings, reach the market through shared trade channels and target the same users. There is also a broad overlap in purpose. The respective goods are not complementary because they are neither important nor indispensable to the use of one another, albeit that they may be used at the same time. Moreover, there is no competition between them since they are not interchangeable. Overall, I find that there is a low degree of similarity between the respective goods.

### *Binoculars*

144. This term describes an optical instrument with two lenses. The goods fall within the scope of [...] *optical [...] apparatus and instruments* of Promoshirt's second and third marks. They are identical in accordance with *Meric*.

## Class 18

### *Empty toiletry sets*

145. Although worded slightly differently, it is my view that the above goods are identical to *bags including [...] cosmetic bags sold empty, shaving bags sold empty* of Promoshirt's second and third marks. They describe the same goods.

### *Business card cases; cases for keys*

146. These goods fall within the scope of *cases [...]* of Promoshirt's second and third marks.<sup>50</sup> They are identical in accordance with *Meric*.

### *Bags for carrying animals*

147. The above goods are included within the broader category of *bags [...]* of Promoshirt's second and third marks.<sup>51</sup> They are to be regarded as identical under the principle outlined in *Meric*.

### *Collars, leashes and clothing for animals; clothing for pets; electronic pet collars*

148. In my view, *bags [...]* of Promoshirt's second and third marks is a broad category of goods which, as noted above, includes bags for carrying pets. Therefore, although the respective goods have different natures, methods of use and intended purposes, they are likely to reach the market through shared trade channels, such as pet stores, and are likely to be produced by the same undertakings. They also share users, i.e. pet owners. They are neither complementary nor in competition. Overall, I find that there is a low degree of similarity between the respective goods.

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<sup>50</sup> Although this term is followed by a list of more specific cases, this forms a non-exclusive list of examples as to the kinds of cases that are covered by the broader term, i.e. the word "including" does not limit the scope of protection to only the goods which follow.

<sup>51</sup> Again, this term is not limited by the inclusion of the word "including" followed by a list of more specific bags.

## Class 20

*Beds and cots for household pets; portable beds for pets; pet cushions; transport boxes for pets; game houses for pets; nesting boxes for household pets; kennels for household pets; pet grooming tables*

149. The above goods consist of housing, transport and products for pets. They have a different nature, method of use and intended purpose to *bags [...] of Promoshirt's* second mark. However, Promoshirt's broad category includes bags for carrying pets, which are likely to reach the market through the same trade channels as the Swiss Confederation's goods. The respective goods may also be produced by the same undertakings. Since they will both be purchased by pet owners, the respective goods share users. There is no complementarity between them. They are not interchangeable and, therefore, there is no competition between them. Taking all of this into account, I find that there is a low degree of similarity between the respective goods.

## Class 21

*Drinking bottles for sports (of plastic materials or of metal); drinking bottles for sporting activities; non-electric kettles; glassware, porcelain and earthenware; cups; heat-insulated containers; feeding bowls for pets; animal grooming gloves; cages for household pets*

150. These goods are opposed on the basis of Promoshirt's first mark. The surviving goods of that mark are those in classes 21 and 27. Having considered all of these, I do not consider there to be any similarity between the respective goods. Many of the goods differ in nature, method of use and intended purpose. They do not typically reach the market through the same trade channels and are ordinarily produced by different undertakings. They may overlap in user, though only on a level too general to engage any similarity, overall. They are neither complementary nor in competition. I acknowledge that some of the goods, such as *glassware* and *cups* are (or may be) made from glass and, as such, there is a degree of overlap in nature with Promoshirt's *unworked or semi-worked glass (except glass used in building)*. However, the former

comprise finished products, whereas the latter is glass as a manufacturing material. They have different purposes, methods of use and target different users. They are likely to reach the market through different trade channels. Whilst glass is clearly important to glassware, I do not consider them complementary. This is because consumers would not believe that responsibility for both lies with the same undertakings. They are not in competition, since unworked or semi-worked glass and finished glassware products are not interchangeable. Even factoring any limited overlaps in user and nature, I find that there is no similarity between the respective goods.

#### Class 24

*Blankets for outdoor use, picnic blankets; bed covers, lap robes, bed blankets, duvets of textile materials; bed throws, terry-cloth bedspreads; tablecloths of textile; felt and non-woven textile fabrics; woolen cloths; cotton fabrics; bed throws; blankets for household pets*

151. In respect of these goods, I first consider Promoshirt's reliance on its first mark. Having considered all the surviving goods in classes 21 and 27, I do not consider there to be any similarity between them. Many of the goods have different natures, methods of use and purposes. They typically reach the market through different trade channels. Users are likely to overlap. However, given that this is based upon the general public at large, I do not consider this to be significant. They are neither complementary nor in competition. I accept that some of Promoshirt's goods, such as, for example, *rugs and [...] other materials for covering existing floors* may be made from some of the IR's fabrics. This may give rise to a degree of overlap in nature. Nonetheless, these goods have different purposes, methods of use and target different users. They are likely to reach the market through different trade channels. Whilst fabrics may be important to rugs and the like, I do not consider them complementary. This is because consumers would not believe that responsibility for both lies with the same undertakings. They are not in competition, since fabrics and finished products like rugs are not interchangeable. Notwithstanding the overlaps in user and nature outlined above, I find that the respective goods are dissimilar.

152. In respect of Promoshirt's second mark, I have considered all the goods relied upon in classes 9, 11, 18, 20 and 25. I consider there to be a low degree of similarity between *blankets for household pets* of the IR and Promoshirt's *bags [...]*. This is because Promoshirt's broad category includes bags for carrying pets, which are likely to reach the market through the same trade channels as the Swiss Confederation's goods. The respective goods may also be produced by the same undertakings. Since they will both be purchased by pet owners, the respective goods share users.

153. I also consider there to be a low degree of similarity between *blankets for outdoor use, picnic blankets* of the IR and Promoshirt's *camping furniture, camping mats, camping chairs, sleeping bag pads*. Although the respective goods differ in nature, method of use and core purpose, it is my view that they are all likely to be sold in the same outdoor retail stores and manufactured by the same undertakings. They also share users.

154. As for the remaining goods, namely *bed covers, lap robes, bed blankets, duvets of textile materials; bed throws, terry-cloth bedspreads; tablecloths of textile; felt and non-woven textile fabrics; woolen cloths; cotton fabrics; bed throws*, I do not consider there to be any similarity with any of the goods of Promoshirt's second mark. They differ in nature, method of use and intended purpose. Whilst some, such as *furniture, mirrors, picture frames* may be sold in the same retail environments as bedding and the like, I do not consider this to be sufficient for establishing that the respective goods share trade channels. This is because such outlets sell an extremely wide range of different goods. The respective goods are neither complementary nor in competition.

#### Conclusions on the goods comparison

155. As outlined previously, some degree of similarity between goods is necessary to engage the test for likelihood of confusion. My findings above mean that Promoshirt's opposition must fail in respect of the following goods of the IR:

Class 21: Drinking bottles for sports (of plastic materials or of metal); drinking bottles for sporting activities; non-electric kettles; glassware, porcelain and earthenware; cups; heat-insulated

containers; feeding bowls for pets; animal grooming gloves; cages for household pets; all the aforesaid goods of Swiss origin.

Class 24: Bed covers, lap robes, bed blankets, duvets of textile materials; bed throws, terry-cloth bedspreads; tablecloths of textile; felt and non-woven textile fabrics; woolen cloths; cotton fabrics; bed throws; all the aforesaid goods of Swiss origin.

156. The remainder of my assessment of Promoshirt's opposition will focus only on those goods for which I have found at least some similarity, namely:

Class 9: Binoculars; safety helmets; cell and battery chargers; external batteries; batteries (cells); electric cells (batteries); accumulator boxes; dry cells; electric cells and batteries; anode batteries; batteries for mobile telephones; fuel cells; solar batteries; cases for mobile telephones; leather cases for portable telephones; bags for laptop computers; bags adapted for tablet computers; electric sockets; USB flash drives; plug connectors; jack cables; converters for electric plugs; holders for mobile telephones; all the aforesaid goods of Swiss origin.

Class 18: Cases for keys; empty toiletry sets; business card cases; collars, leashes and clothing for animals; bags for carrying animals; clothing for pets; electronic pet collars; all the aforesaid goods of Swiss origin.

Class 20: Beds and cots for household pets; portable beds for pets; pet cushions; transport boxes for pets; game houses for pets; nesting boxes for household pets; kennels for household pets; pet grooming tables; all the aforesaid goods of Swiss origin.

Class 24: Blankets for outdoor use, picnic blankets; blankets for household pets; all the aforesaid goods of Swiss origin.

157. I note that none of those findings of similarity was based upon Promoshirt's first mark; there is no similarity between any of the goods relied upon under that mark and the goods of the IR. As such, Promoshirt's opposition based on that mark must fail in its entirety. Moreover, whilst my findings of similarity against the goods in classes 9 and 18 of the IR were based upon Promoshirt's second and third marks, additional findings of similarity were made on the basis of Promoshirt's second mark, namely some of the goods in classes 20 and 24. Due to this, and my view that Promoshirt's third mark is no more similar to the IR than its second mark, I will proceed to determine Promoshirt's opposition on the basis of its second mark only.

### **Average consumer**

158. The case law principles outlined at paragraph 70 are equally applicable here.

159. The goods at issue are generally available to the general public, but some may also be purchased by business users or professionals. For example, the electrical goods in class 9 may be purchased by members of the general public for completing home improvements, but they are also likely to be purchased by professional electricians in the course of their trade. The cost associated with the goods is likely to vary, with inexpensive items such as everyday batteries at one end of the spectrum and more expensive items such as solar batteries and kennels for large pets at the other. Likewise, the frequency with which the goods are purchased is likely to vary; some are everyday consumer goods which may be purchased relatively frequently, whilst others constitute more occasional purchases. The level of attention paid during the selection process will vary accordingly, with some goods being more casual purchases and others requiring a more considered thought process. Nevertheless, it is my view that, overall, the average consumer will demonstrate a medium level of attention.

160. The goods are likely to be purchased in physical retail establishments, or their online equivalents, where they will be self-selected from shelves and displays, or after viewing images and information on the internet. Consequently, I find that the purchasing process will be predominantly visual in nature. However, I do not exclude aural considerations entirely, as the average consumer may receive word-of-mouth

recommendations or wish to discuss the goods with staff. This is particularly the case with business/professional users who may purchase the goods directly from the provider after discussions with a sales representative.

### Comparison of trade marks

161. The marks to be compared are as follows:

Promoshirt's mark	The IR
SWISS MILITARY BY BTS	

162. In conducting the following comparison, I bear in mind the case law principles outlined at paragraphs 30 and 31.

163. Promoshirt's mark is in word-only format and consists of the words 'SWISS MILITARY' BY BTS'. The words 'SWISS MILITARY' combine to form a unitary phrase. This phrase appears at the beginning of the mark, a position which tends to have most impact. Given the formulation of the words in the mark, however, the words 'BY BTS' are likely to be perceived as referring to the responsible undertaking; therefore, they provide a significant contribution to the overall impression of the mark, albeit that they have less impact due to their position at its end.

164. The IR is figurative and consists of the words 'SWISS MILITARY' in a basic typeface, alongside a hexagonal representation of the national flag of Switzerland. The words combine to form a unitary phrase. As the eye is naturally drawn to elements of marks that can be read, and the Swiss flag device reinforces the meaning of the words, it is my view that the words 'SWISS MILITARY', in combination, dominate the overall impression of the mark. The device, whilst still contributing, plays a lesser role.

165. Visually, the competing marks are similar because they share the identical words 'SWISS MILITARY'. These words appear at the beginning of Promoshirt's mark and

dominate the overall impression of the IR. The marks are visually different in that Promoshirt's mark contains the additional verbal elements 'BY BTS' and the IR contains the Swiss flag device. Bearing in mind my assessment of the overall impressions, I find that there is at least a medium degree of visual similarity between the competing marks.

166. The competing marks are aurally similar in that the only verbal element of the IR, i.e. the words 'SWISS MILITARY', appears at the beginning of Promoshirt's mark. The competing marks are aurally different to the extent that Promoshirt's mark contains additional verbal elements at its end, i.e. 'BY BTS'. Overall, I find that there is between a medium and high degree of aural similarity between the competing marks.

167. Conceptually, the words 'SWISS MILITARY' in the competing marks will be understood as referring to the armed forces of Switzerland. The Swiss flag device in the IR reinforces this meaning; as a symbol of Switzerland, it offers no new concept of its own. The word 'BY' in Promoshirt's mark is a common proposition used to identify, for instance, who has done or created something. 'BTS' appears to be a combination of letters from the English language with no obvious meaning. Together, the words 'BY BTS' are likely to be understood as identifying the entity responsible for the 'SWISS MILITARY' mark, namely 'BTS'. Whilst these additional words convey a concept which is not replicated by the IR, overall, I find that there is between a medium and high degree of conceptual similarity between the competing marks.

### **Distinctive character of the earlier mark**

168. In conducting the following assessment, I keep in mind the principles outlined at paragraphs 72 and 73.

169. Promoshirt's mark is in word-only format and consists of the words 'SWISS MILITARY BY BTS'. Together, the words 'SWISS MILITARY' will be understood as referring to the armed forces of Switzerland. There being no real connection between the goods relied upon and the Swiss armed forces, the words are somewhat fanciful. The word 'BY' is a common proposition and 'BTS' is a seemingly arbitrary combination of letters which, in and of itself, is not particularly distinctive. However, given the

formulation of the words in the mark, the 'BTS' element presents as the name of the undertaking with ultimate responsibility. It is my view that the 'SWISS MILITARY' and 'BTS' elements contribute a roughly equal amount of distinctiveness. The word 'BY' provides a lesser contribution. Overall, I find that the mark possesses a medium level of inherent distinctive character.

170. Evidence has been filed by Promoshirt and I am now required to determine whether it has demonstrated that its mark had an enhanced level of distinctive character at the relevant date, that being 24 June 2022 (the UK designation date of the IR).

171. I have already summarised the evidence of use provided by Mr Sawhney. Whilst I acknowledge that this shows that there has been some use of the mark in the UK, I do not consider it to be sufficient for the purposes of establishing that its distinctiveness had been enhanced above its inherent characteristics. Firstly, the turnover information provided is global in nature, i.e. it relates to the whole of Promoshirt's business; no indication has been given as to what proportion of it specifically relates to the UK. Similarly, it has not been broken down by reference to the goods relied upon, any of the particular goods shown in the evidence, or the specific mark in question. I appreciate that goods bearing 'SWISS MILITARY' marks have been sold to B&M, an undertaking with a large number of stores across the UK, but the invoices only show sales totalling \$85,000 across various types of goods. These figures do not strike me as indicative of intensive use of the marks. Moreover, the printouts from the UK website only date back to 2016, so the use shown has not been particularly longstanding. There is also no indication as to how many internet users in the UK accessed the websites at any time before the relevant date. There is no information about how many of the catalogues have been distributed, where or to whom. In addition, there is no indication of the share of the relevant markets held by Promoshirt's goods or any evidence of advertising or marketing activities being conducted in relation to 'SWISS MILITARY BY BTS'.

## Likelihood of confusion

172. The principles outlined at paragraphs 77 and 78 are equally applicable here. As previously outlined, confusion can be direct or indirect. As explained by Mr Purvis, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

173. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>52</sup> I recognise that there must be a proper basis for finding indirect confusion.<sup>53</sup> I also acknowledge that such a finding should not be made merely because the competing marks share a common element. It is not sufficient that a mark merely calls to mind another mark.<sup>54</sup>

174. Earlier in this decision, I concluded as follows:

- The parties’ goods are identical or similar to at least a low degree;
- The average consumer may be a member of the general public or a business/professional user, who will demonstrate a medium level of attention, overall;
- The purchasing process is predominantly visual in nature, though aural considerations have not been discounted;
- The words ‘SWISS MILITARY’ have the most impact in Promoshirt’s mark, although the words ‘BY BTS’ also provide a significant contribution to the overall impression;
- The words ‘SWISS MILITARY’ dominate the overall impression of the IR, whilst the Swiss flag device plays a lesser role;
- The competing marks are visually similar to a medium degree, and aurally and conceptually similar to between a medium and high degree;

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<sup>52</sup> As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

<sup>53</sup> See the Court of Appeal’s comments in *Liverpool Gin Distillery*, paragraph 13.

<sup>54</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

- Promoshirt's first mark has a medium level of inherent distinctive character.

175. I acknowledge that the competing marks share the dominant words 'SWISS MILITARY'. Nevertheless, taking all the above factors into account, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer, even when paying a lower level of attention, to distinguish between them and avoid mistaking one for the other. Although the additional Swiss flag device in the IR may not be accurately recalled by the average consumer, Promoshirt's mark contains the additional verbal elements 'BY BTS', which play an important role in its overall impression. To my mind, these verbal elements are unlikely to be overlooked or misremembered. Accordingly, even taking into account the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion, even in relation to identical goods.

176. Whilst I have found that the average consumer is likely to recognise that there are differences between the marks, they will also recognise the identical words 'SWISS MILITARY'. These words dominate the overall impression of the IR and have the most impact in Promoshirt's mark. To my mind, the differences between the competing marks are likely to lead the average consumer to believe that they are variant brands used by the same (or an economically connected) undertaking. The verbal elements 'BY BTS' in Promoshirt's mark are likely to be perceived as denoting the entity with ultimate responsibility of the 'SWISS MILITARY' brand, or a collaboration between 'BTS' and 'SWISS MILITARY', whereas the Swiss flag device in the IR is likely to be perceived as a variation of the 'SWISS MILITARY' brand with an additional decorative element which reinforces the meaning of the words. Consequently, I am satisfied that the average consumer, even if paying a higher level of attention, is likely to assume a commercial association between the parties due to the presence of the shared words 'SWISS MILITARY'. Accordingly, I find that there is a likelihood of indirect confusion, even in relation to goods which are only similar to a low degree.

## **Conclusion**

177. Promoshirt's claim against the IR under section 5(2)(b) of the Act is partially successful.

178. As this outcome is not dependent on Promoshirt's third mark, it is not necessary to await the outcome of the separate cancellation proceedings against that mark; my decision is final.

## **OVERALL OUTCOMES**

179. Subject to any appeal against this decision, Promoshirt's first mark (application no. 3703840) will be refused in respect of the following goods:

Class 6: Common metals and their alloys; ores.

Class 21: Glassware, porcelain and earthenware not included in other classes.

Class 24: Table covers.

180. The mark will proceed to registration in the UK for the following goods, against which the Swiss Confederation's opposition has failed:

Class 20: Mirrors, picture frames.

Class 21: Brush-making materials; steelwool; unworked or semi-worked glass (except glass used in building).

Class 27: Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

Class 34: Tobacco; smokers' articles.

181. Promoshirt's second mark (application no. 3704050) will proceed to registration in the UK for all the applied-for goods.

182. Protection of the IR (international registration no. 1686195) in the UK will be refused in relation to the following goods:

Class 9: Binoculars; safety helmets; cell and battery chargers; external batteries; batteries (cells); electric cells (batteries); accumulator boxes; dry cells; electric cells and batteries; anode batteries; batteries for mobile telephones; fuel cells; solar batteries; cases for mobile telephones; leather cases for portable telephones; bags for laptop computers; bags adapted for tablet computers; electric sockets; USB flash drives; plug connectors; jack cables; converters for electric plugs; holders for mobile telephones; all the aforesaid goods of Swiss origin.

Class 18: Cases for keys; empty toiletry sets; business card cases; collars, leashes and clothing for animals; bags for carrying animals; clothing for pets; electronic pet collars; all the aforesaid goods of Swiss origin.

Class 20: Beds and cots for household pets; portable beds for pets; pet cushions; transport boxes for pets; game houses for pets; nesting boxes for household pets; kennels for household pets; pet grooming tables; all the aforesaid goods of Swiss origin.

Class 24: Blankets for outdoor use, picnic blankets; blankets for household pets; all the aforesaid goods of Swiss origin.

183. The IR will become protected in the UK in respect of the following goods, which were not opposed or against which Promoshirt's opposition has failed:

Class 3: Cosmetics and toiletries; skin care preparations; sunscreen preparations; shampoos and conditioners for pets (non-

medicated grooming preparations, other than for veterinary use); deodorants for pets; all the aforesaid goods of Swiss origin.

Class 21: Drinking bottles for sports (of plastic materials or of metal); drinking bottles for sporting activities; non-electric kettles; glassware, porcelain and earthenware; cups; heat-insulated containers; feeding bowls for pets; animal grooming gloves; cages for household pets; all the aforesaid goods of Swiss origin.

Class 24: Bed covers, lap robes, bed blankets, duvets of textile materials; bed throws, terry-cloth bedspreads; tablecloths of textile; felt and non-woven textile fabrics; woolen cloths; cotton fabrics; bed throws; all the aforesaid goods of Swiss origin.

Class 30: Chocolate, chocolate bars, chocolate-based beverages; cereal bars; muesli bars; all the aforesaid goods of Swiss origin.

## **COSTS**

184. Both parties have succeeded in part. However, Promoshirt has enjoyed the greater measure of success. As such, it is entitled to a contribution towards its costs, with an appropriate reduction to reflect the Swiss Confederation's degree of success. At the hearing, it was common ground that costs in these proceedings should be awarded by reference to the published scale.

185. Based upon the guidance in Tribunal Practice Notices 2/2016 and 1/2023, I award Promoshirt the sum of **£2950**, which is calculated as follows:<sup>55</sup>

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<sup>55</sup> I note that, although the proceedings were consolidated, the Swiss Confederation's oppositions commenced before 1 February 2023, whereas Promoshirt's commenced after. This means that the scale published in TPN 2/2016 applies to the former and that published in TPN 1/2023 applies to the latter. I have taken this into account in making the costs award but confirm that it has not made any material difference as I have not awarded the scale minimum or maximum for any of the various activities listed.

Considering the Swiss Confederation's statements and preparing counterstatements	£1000
Preparing a statement and considering the Swiss Confederation's counterstatement	£400
Preparing evidence and considering the Swiss Confederation's evidence	£1200
Preparing for and attending a hearing	£1200
Subtotal	£3800
<i>Reduction of 25%</i>	<i>- £950</i>
Subtotal	£2850
Official fees <sup>56</sup>	£100
<b>Total</b>	<b>£2950</b>

186. I order Schweizerische Eidgenossenschaft v.d. Bundesamt für Rüstung armasuisse Eidgenössisches Departement für Verteidigung, Bevölkerungsschutz und Sport to pay Promoshirt SM SA GmbH the sum of **£2950**. This sum is to be paid within 21 days of the expiry of the appeal period, or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

**Dated this 15<sup>th</sup> day of December 2025**

**James Hopkins**  
**For the Registrar**

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<sup>56</sup> Official fees connected with the filing of Promoshirt's Form TM7 are not subject to a reduction.

## **Annex A**

### **Goods of Promoshirt's first mark (application no. 3703840)**

Class 6: Common metals and their alloys; ores.

Class 20: Mirrors, picture frames.

Class 21: Brush-making materials; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class 24: Table covers.

Class 27: Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

Class 34: Tobacco; smokers' articles.

### **Goods of Promoshirt's second mark (application no. 3704050)**

Class 9: Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment and computers; fire extinguishing apparatus; sunglasses; batteries.

Class 11: Apparatus for lighting; apparatus for heating; apparatus for cooking; apparatus for refrigerating; apparatus for drying; apparatus for sanitary purposes; torches; lanterns; lamps.

Class 18: Bags including beach bags, sports bags, athletics bags, leather bags, handbags, belt bags, clutch bags, camping bags, school bags, laptop bags, satchels,

cosmetic bags sold empty, shaving bags sold empty, shoe bags, wash bags and wheeled bags; packs including backpacks and waistpacks; wallets; purses; travel bags, trunks, luggage, carry-on bags, garment bags for travel; luggage tags, luggage labels, luggage label holders and luggage straps of leather or imitation leather; cases including travel cases, overnight cases, briefcases, document cases, credit card cases, cosmetic cases, vanity cases, cases for sporting articles (not being fitted or shaped), cases for travel kits (not being fitted or shaped); pouches in this class; key cases, key holders, all being of leather, animal hides or imitations thereof; chamois leather (other than for cleaning purposes); covers, not being shaped, for sporting articles; portable sunshades including umbrellas and parasols and umbrella covers.

Class 20: Furniture, mirrors, picture frames; camping furniture, camping mats, camping chairs, sleeping bag pads.

Class 25: Clothing including shirts; T-shirts; polo shirts; singlets; blouses; tops; sweaters; cardigans; jackets; pullovers; coats; jumpers; knitwear; parkas; bodysuits; dresses; skirts; sarongs; trousers; pants; denim clothing; jeans; overalls; shorts; board shorts; sportswear; swimwear; exercise wear; tracksuits; tracksuit tops; tracksuit trousers; beachwear; suits; casual wear; outerwear; underwear; underclothing; lingerie; sleepwear; bathrobes; thermal clothing; water proof clothing; raincoats; belts; wristbands; armbands; headbands; bandanas; legwarmers; gloves; mittens; scarves; shawls; neckties; socks; decorative straps and money belts; headgear including hats; caps; beanies; visors; berets; sunshades; footwear (boots, shoes, slippers, socks, sandals, stockings).

### **Goods of Promoshirt's third mark (registration no. 917036203)**

Class 9: Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment and computers; fire extinguishing apparatus; sunglasses; batteries.

Class 18: Bags including beach bags, sports bags, athletics bags, leather bags, handbags, belt bags, clutch bags, camping bags, school bags, laptop bags, satchels, cosmetic bags sold empty, shaving bags sold empty, shoe bags, wash bags and wheeled bags; packs including backpacks and waistpacks; wallets; purses; travel bags, trunks, luggage, carry-on bags, garment bags for travel; luggage tags, luggage labels, luggage label holders and luggage straps of leather or imitation leather; cases including travel cases, overnight cases, briefcases, document cases, credit card cases, cosmetic cases, vanity cases, cases for sporting articles (not being fitted or shaped), cases for travel kits (not being fitted or shaped); pouches in this class; key cases, key holders, all being of leather, animal hides or imitations thereof; chamois leather (other than for cleaning purposes); covers, not being shaped, for sporting articles; portable sunshades including umbrellas and parasols and umbrella covers.

Class 25: Clothing including shirts; T-shirts; polo shirts; singlets; blouses; tops; sweaters; cardigans; jackets; pullovers; coats; jumpers; knitwear; parkas; bodysuits; dresses; skirts; sarongs; trousers; pants; denim clothing; jeans; overalls; shorts; board shorts; sportswear; swimwear; exercise wear; tracksuits; tracksuit tops; tracksuit trousers; beachwear; suits; casual wear; outerwear; underwear; underclothing; lingerie; sleepwear; bathrobes; thermal clothing; water proof clothing; raincoats; belts; wristbands; armbands; headbands; bandanas; legwarmers; gloves; mittens; scarves; shawls; neckties; socks; decorative straps and money belts; headgear including hats; caps; beanies; visors; berets; sunshades; footwear (boots, shoes, slippers, socks, sandals, stockings).

## **Annex B**

### **Goods of the IR (international registration no. 1686195)**

Class 3: Cosmetics and toiletries; skin care preparations; sunscreen preparations; shampoos and conditioners for pets (non-medicated grooming preparations, other than for veterinary use); deodorants for pets; all the aforesaid goods of Swiss origin.

Class 9: Binoculars; safety helmets; cell and battery chargers; external batteries; batteries (cells); electric cells (batteries); accumulator boxes; dry cells; electric cells and batteries; anode batteries; batteries for mobile telephones; fuel cells; solar batteries; cases for mobile telephones; leather cases for portable telephones; bags for laptop computers; bags adapted for tablet computers; electric sockets; USB flash drives; plug connectors; jack cables; converters for electric plugs; holders for mobile telephones; all the aforesaid goods of Swiss origin.

Class 18: Cases for keys; empty toiletry sets; business card cases; collars, leashes and clothing for animals; bags for carrying animals; clothing for pets; electronic pet collars; all the aforesaid goods of Swiss origin.

Class 20: Beds and cots for household pets; portable beds for pets; pet cushions; transport boxes for pets; game houses for pets; nesting boxes for household pets; kennels for household pets; pet grooming tables; all the aforesaid goods of Swiss origin.

Class 21: Drinking bottles for sports (of plastic materials or of metal); drinking bottles for sporting activities; non-electric kettles; glassware, porcelain and earthenware; cups; heat-insulated containers; feeding bowls for pets; animal grooming gloves; cages for household pets; all the aforesaid goods of Swiss origin.

Class 24: Blankets for outdoor use, picnic blankets; bed covers, lap robes, bed blankets, duvets of textile materials; bed throws, terry-cloth bedspreads; tablecloths of textile; felt and non-woven textile fabrics; woolen cloths; cotton fabrics; bed throws; blankets for household pets; all the aforesaid goods of Swiss origin.

Class 30: Chocolate, chocolate bars, chocolate-based beverages; cereal bars; muesli bars; all the aforesaid goods of Swiss origin.

## Annex C

<b>Promoshirt's first mark</b>	<b>The IR</b>
<p>Class 21: Brush-making materials; steelwool; unworked or semi-worked glass (except glass used in building).</p> <p>Class 27: Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).</p>	<p>Class 21: Drinking bottles for sports (of plastic materials or of metal); drinking bottles for sporting activities; non-electric kettles; glassware, porcelain and earthenware; cups; heat-insulated containers; feeding bowls for pets; animal grooming gloves; cages for household pets; all the aforesaid goods of Swiss origin.</p> <p>Class 24: Blankets for outdoor use, picnic blankets; bed covers, lap robes, bed blankets, duvets of textile materials; bed throws, terry-cloth bedspreads; tablecloths of textile; felt and non-woven textile fabrics; woolen cloths; cotton fabrics; bed throws; blankets for household pets; all the aforesaid goods of Swiss origin.</p>
<b>Promoshirt's second mark</b>	<b>The IR</b>
<p>Class 9: Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; mechanisms for coin-operated apparatus; cash registers; calculating</p>	<p>Class 9: Binoculars; safety helmets; cell and battery chargers; external batteries; batteries (cells); electric cells (batteries); accumulator boxes; dry cells; electric cells and batteries; anode batteries; batteries for mobile telephones; fuel cells; solar batteries; cases for mobile telephones; leather cases for portable telephones; bags for laptop computers; bags adapted for tablet computers;</p>

<p>machines; data processing equipment and computers; fire extinguishing apparatus; sunglasses; batteries.</p> <p>Class 11: Apparatus for lighting; apparatus for heating; apparatus for cooking; apparatus for refrigerating; apparatus for drying; apparatus for sanitary purposes; torches; lanterns; lamps.</p> <p>Class 18: Bags including beach bags, sports bags, athletics bags, leather bags, handbags, belt bags, clutch bags, camping bags, school bags, laptop bags, satchels, cosmetic bags sold empty, shaving bags sold empty, shoe bags, wash bags and wheeled bags; packs including backpacks and waistpacks; wallets; purses; travel bags, trunks, luggage, carry-on bags, garment bags for travel; luggage tags, luggage labels, luggage label holders and luggage straps of leather or imitation leather; cases including travel cases, overnight cases, briefcases, document cases, credit card cases, cosmetic cases, vanity cases, cases for sporting articles (not being fitted or shaped), cases for travel kits (not being fitted or shaped); pouches in this class; key cases, key holders, all being of leather, animal hides or imitations thereof; chamois leather (other</p>	<p>electric sockets; USB flash drives; plug connectors; jack cables; converters for electric plugs; holders for mobile telephones; all the aforesaid goods of Swiss origin.</p> <p>Class 18: Cases for keys; empty toiletry sets; business card cases; collars, leashes and clothing for animals; bags for carrying animals; clothing for pets; electronic pet collars; all the aforesaid goods of Swiss origin.</p> <p>Class 20: Beds and cots for household pets; portable beds for pets; pet cushions; transport boxes for pets; game houses for pets; nesting boxes for household pets; kennels for household pets; pet grooming tables; all the aforesaid goods of Swiss origin.</p> <p>Class 24: Blankets for outdoor use, picnic blankets; bed covers, lap robes, bed blankets, duvets of textile materials; bed throws, terry-cloth bedspreads; tablecloths of textile; felt and non-woven textile fabrics; woolen cloths; cotton fabrics; bed throws; blankets for household pets; all the aforesaid goods of Swiss origin.</p>
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than for cleaning purposes); covers, not being shaped, for sporting articles; portable sunshades including umbrellas and parasols and umbrella covers.

Class 20: Furniture, mirrors, picture frames; camping furniture, camping mats, camping chairs, sleeping bag pads.

Class 25: Clothing including shirts; T-shirts; polo shirts; singlets; blouses; tops; sweaters; cardigans; jackets; pullovers; coats; jumpers; knitwear; parkas; bodysuits; dresses; skirts; sarongs; trousers; pants; denim clothing; jeans; overalls; shorts; board shorts; sportswear; swimwear; exercise wear; tracksuits; tracksuit tops; tracksuit trousers; beachwear; suits; casual wear; outerwear; underwear; underclothing; lingerie; sleepwear; bathrobes; thermal clothing; water proof clothing; raincoats; belts; wristbands; armbands; headbands; bandanas; legwarmers; gloves; mittens; scarves; shawls; neckties; socks; decorative straps and money belts; headgear including hats; caps; beanies; visors; berets; sunshades; footwear (boots, shoes, slippers, socks, sandals, stockings).

**Promoshirt's third mark**

**The IR**

Class 9: Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment and computers; fire extinguishing apparatus; sunglasses; batteries.

Class 18: Bags including beach bags, sports bags, athletics bags, leather bags, handbags, belt bags, clutch bags, camping bags, school bags, laptop bags, satchels, cosmetic bags sold empty, shaving bags sold empty, shoe bags, wash bags and wheeled bags; packs including backpacks and waistpacks; wallets; purses; travel bags, trunks, luggage, carry-on bags, garment bags for travel; luggage tags, luggage labels, luggage label holders and luggage straps of leather or imitation leather; cases including travel cases, overnight cases, briefcases, document cases, credit card cases, cosmetic cases, vanity cases, cases for sporting articles (not being fitted or shaped), cases for travel kits (not being fitted or shaped); pouches

Class 9: Binoculars; safety helmets; cell and battery chargers; external batteries; batteries (cells); electric cells (batteries); accumulator boxes; dry cells; electric cells and batteries; anode batteries; batteries for mobile telephones; fuel cells; solar batteries; cases for mobile telephones; leather cases for portable telephones; bags for laptop computers; bags adapted for tablet computers; electric sockets; USB flash drives; plug connectors; jack cables; converters for electric plugs; holders for mobile telephones; all the aforesaid goods of Swiss origin.

Class 18: Cases for keys; empty toiletry sets; business card cases; collars, leashes and clothing for animals; bags for carrying animals; clothing for pets; electronic pet collars; all the aforesaid goods of Swiss origin.

in this class; key cases, key holders, all being of leather, animal hides or imitations thereof; chamois leather (other than for cleaning purposes); covers, not being shaped, for sporting articles; portable sunshades including umbrellas and parasols and umbrella covers.

Class 25: Clothing including shirts; T-shirts; polo shirts; singlets; blouses; tops; sweaters; cardigans; jackets; pullovers; coats; jumpers; knitwear; parkas; bodysuits; dresses; skirts; sarongs; trousers; pants; denim clothing; jeans; overalls; shorts; board shorts; sportswear; swimwear; exercise wear; tracksuits; tracksuit tops; tracksuit trousers; beachwear; suits; casual wear; outerwear; underwear; underclothing; lingerie; sleepwear; bathrobes; thermal clothing; water proof clothing; raincoats; belts; wristbands; armbands; headbands; bandanas; legwarmers; gloves; mittens; scarves; shawls; neckties; socks; decorative straps and money belts; headgear including hats; caps; beanies; visors; berets; sunshades; footwear (boots, shoes, slippers, socks, sandals, stockings).