

O/1219/24

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3694283

BY TRANSPORT FOR LONDON

AND

OPPOSITION No. 431511

BY GAP (ITM) INC.

BACKGROUND AND PLEADINGS

1. This is an opposition by Gap (ITM) Inc. (“the opponent”) to an application filed on 14th September 2021 by Transport for London (“the applicant”). The application was made under paragraph 25 of Part 3 of schedule 2A to the Trade Marks Act 1994 (“the Act”). This means that it was filed to partially replace an application to register an EU trade mark that was still pending on the date the UK completed its exit from the EU. According to the domestic trade mark legislation made to implement the Withdrawal Agreement, the resulting UK trade mark application is entitled to the filing and priority date (if any) afforded to the earlier-filed EU application. In this case the relevant date is the 13th of July 2018.

2. The trade mark at issue consists of the words **MIND THE GAP**. The application covers the following goods:

Class 9: Contact lenses; spectacles, eyeglasses, eyewear and their frames, cases, chains, and lenses; helmets.

Class 18: Goods made of leather and imitations of leather, namely, shoulder belts and shoulder straps, suitcases, trunks, garment bags for travel, briefcases, card cases, canes, umbrellas and parasol covers; beach bags; sports bags; shopping bags and wheeled shopping bags; rucksacks; school bags; school satchels; portfolios; brief cases; document bags and cases; music cases; attaché cases; travel bags; trunks and travelling bags; suitcases; slings and pouches for carrying infants; hat boxes; key cases; purses and wallets; purses for travel cards and passes; purses for payment cards; wallets for travel cards and passes; wallets for payment cards; holders for payment cards, travel cards and travel passes; cases for toiletry or cosmetic articles; umbrellas, parasols and walking sticks; clothing for pets

3. The opponent claims that registration of the contested mark would be contrary to sections 3(6), 5(2), 5(3), 5(4)(a) and 5(4)(b) of the Act, which are as follows:

“3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

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

(a) –

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

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“5(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

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“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) –

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright, or the law relating to industrial property rights.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

5(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

4. The opponent’s case is conveniently summarised as per the following extracts from the opponent’s skeleton argument for the hearing mentioned below:

“5. The opposition is based on grounds that can be divided into two groups:

5.1. the grounds under ss.3(6) and 5(4)(b); and

5.2. the grounds under ss.5(2)(b), 5(3) and 5(4)(a). This group relies on Gap’s earlier registered trade marks and passing off right.

6. The first group set out above relies on a confidential settlement agreement (the “Contract”) agreed between the parties in 2004, and which Gap says is breached by the filing of the Application and would be further breached by the use of the Application.”

5. The relevance of the agreement referred to in this pleading is disputed. However, it is common ground that, if the agreement applies, it precludes the applicant from registering the words MIND THE GAP alone in relation to ‘clothing accessories’. The opponent contends that the goods covered by the application fall within this description.

6. The opponent’s case under sections 5(2), 5(3) and 5(4)(a) of the Act was summarised in the opponent’s skeleton argument as follows:

“7. In respect of the second group of grounds, Gap’s earlier registered trade marks relied on are the following:

7.1. UK 1555691 for the word mark “GAP” for “Sunglasses and goggles; bags and cases for the aforesaid goods; all included in Class 9.” It is

relied on under s.5(2)(b) against “contact lenses; spectacles, eyeglasses, eyewear and their frames, cases, chains and lenses” all in class 9.

7.2. UK 1265985 for the word mark “GAP” for (so far as relied on here), “Cases, bags and bandoliers, all included in Class 18; articles of luggage; articles included in Class 18 made from leather or from imitation leather”. It is relied on under s.5(2)(b) against “helmets” in class 9, and all the class 18 goods of the Application.

7.3. UK comparable mark (EU) 909608118 (the “118 Mark”) for the word mark “GAP” for (so far as relied on here), the contents of its class 18 specification It is relied on under s.5(2)(b) against “helmets” in class 9, and all the class 18 goods of the Application.

7.4. UK comparable mark (EU) 909689084 (the “Class 25 Mark”) for the word mark “GAP” for (so far as relied on here), “clothing, footwear, headgear”. It is relied on under s.5(2)(b) against “helmets” in class 9, and all the class 18 goods of the Application. It is relied on under s.5(3) against all the goods of the Application.

8. All those marks are subject to proof of use requirements. All were originally put to proof of use, but after receipt of Gap’s evidence in chief, TFL withdrew the requirement to prove use of the Class 25 Mark for the class 25 goods. However, TFL continues to deny the existence of a reputation of the Class 25 Mark for class 25 goods.

9. Gap also relies under s.5(4)(a) on its goodwill connected to the name or mark ‘GAP’ when used for clothing, footwear, and headgear.”

7. The applicant’s case is set out like this in its counterstatement:

“The history of the London Underground is very important to TfL, as is the heritage of the design around the London Underground. Key elements of this design include TfL’s famous



which has been used at the Underground stations for over a century, with the word UNDERGROUND appearing through the central bar. The ROUNDDEL also appears on the sides of trains, and inside London Underground stations, with the name of the station through the central bar.

An inherent and inseparable element of the London Underground identity is also the slogan MIND THE GAP, which is an audible or visual warning phrase issued to rail passengers to take caution while crossing the horizontal, and in some cases vertical, spatial gap between the train door and the station platform. The phrase was first introduced in 1968 on the London Underground in the United Kingdom (one year before the Opponent was founded in 1969).

'Mind the gap' is the most famous recorded announcement on the London Underground network. The necessity for the warning arises when inevitably straight-carriage trains arrive at stations with curving platforms. In addition, the words 'Mind the Gap' are often stencilled or mosaic tiled on to the platform.

As a result of TfL's extensive use of the MIND THE GAP slogan for over 50 years, TfL considers this slogan to be synonymous with the London Underground system, as well as its operations and activities, and is an important part of its corporate identity.

TfL's core service is, of course, the provision of transport services in London, funded by fares, but it also has other significant revenue streams, including a highly successful licensing business, which was developed to take advantage of TfL's distinctive design heritage. Given TfL's long association with the MIND THE GAP slogan, it also produces a range of merchandising featuring the MIND THE GAP slogan, including gifts/souvenirs. T-shirt's featuring the slogan MIND THE GAP in conjunction with the ROUNDDEL device have been sold in the London Transport Museum Shop from at least 1975.

The revenue generated from this licensing activity is substantial, and is all invested back into the transportation system. It is TfI's understanding that the Opponent entered the UK market in 1987. The Applicant will therefore contend that its use of 'Mind the Gap', and its associated connection with and reputation in the phrase, predates the Opponent's presence in the UK and any associated reputation it can claim in its mark."

8. The applicant claims that MIND THE GAP is a warning statement that resists dissection into its constituent words. It denies that the contested mark is similar to the earlier GAP marks, or that:

- (1) there is a likelihood of confusion;
- (2) the goods at issue are identical or similar;
- (3) use of the contested mark would, without due cause, take unfair advantage of, or be detrimental to, the reputation or distinctive character of earlier trade mark 909689084;
- (4) use of the contested mark would constitute passing off.

9. The counterstatement continues:

"In light of the above, the Applicant will contend that it is irrelevant what goods are covered and relied upon by the Opponent's prior rights relied upon."

10. The applicant denies the grounds under sections 3(6) and 5(4)(b) of the Act based on the alleged breach of the 2004 agreement. It disputes the relevancy of the agreement, particularly in relation to the goods covered by the application, which it characterises as 'eyewear and bags and luggage', rather than as 'clothing accessories'. In any event, the applicant denies that contractual rights fall within the earlier rights protected by section 5(4)(b) of the Act.

11. Both sides seek an award of costs.

REPRESENTATION

12. The applicant is represented by Cleveland Scott York. The opponent is represented by Stephenson Harwood LLP. A hearing took place (remotely) on 23rd September 2024 at which Ms Amanda Michaels appeared as the applicant's counsel. Mr Thomas St Quintin appeared as counsel for the opponent.

THE EVIDENCE

13. The opponent's evidence consists of a witness Statement by Patricia McMahon (with 44 exhibits) and three witness statements by Robert Matthew Jacob (with a total of 9 exhibits), the last of which was filed as evidence-in-reply to the applicant's evidence.

14. Ms McMahon is the opponent's Director of Global Brand Protection. The main purpose of her evidence is to show that the earlier trade marks relied on by the opponent meet the use requirements set out in section 6A of the Act, that GAP has a substantial reputation in the UK, and that GAP is entitled to protection under the law of passing off as a result of goodwill acquired from trading under that name in the UK since 1987 in relation to clothing, footwear and headgear.

15. Mr Jacob is a partner in the firm of Stephenson Harwood LLP. His evidence includes the 2004 agreement between the parties, the factual background to that agreement, and evidence of use of 'mind the gap' by the applicant, and by others, as a warning.

16. The applicant's evidence consists of a witness statement by Ellen Sankey (with 29 exhibits). Ms Sankey is the applicant's Brand Licensing Manager. The main purposes of Ms Sankey's evidence are (1) to show that the applicant has made extensive use of 'mind the gap' as a warning to passengers on the London Underground since 1968, and (2) that the applicant has used the phrase on merchandise, including bags, without creating confusion with the opponent's trade marks.

STATUS OF EU CASE LAW

17. 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.

PROOF OF USE

18. Section 6A of the Act states:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

19. Paragraph 25 of Part 3 of Schedule 2A to the Act applies. It states:

“25.—(1) This paragraph applies where a person who has filed an existing EUTM application or a successor in title of that person applies for registration of the same trade mark under this Act for some or all of the same goods or services.

(2) Where an application for registration referred to in sub-paragraph (1) is made within a period beginning with IP completion day and ending with the end of the relevant period—

(a) the relevant date for the purposes of establishing which rights take precedence is the earliest of—

(i) the filing date accorded pursuant to Article 32 to the existing EUTM application;

(ii) the date of priority (if any) accorded pursuant to a right of priority claimed pursuant to Article 35 in respect of the existing EUTM application; and

(b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom which commenced in the period between the date referred to in paragraph (a) and the date of the application under this Act.”

(3) In paragraph (2), the “relevant period” means the period of nine months beginning with the day after that on which IP completion day falls.”

20. It is common ground that one of the effects of the above paragraph is that the relevant period for the opponent to show genuine use of the earlier trade marks is 14th July 2013 to 13th July 2018 (i.e., 5 years ending on the date of filing the EU trade mark application from which the UK application takes priority).

21. As trade mark 909608118 is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

22. This means that use of trade mark 909608118 in the EU counts as use in the UK for the purpose of establishing the mark has been put to genuine use.

23. As noted above, the applicant accepts that there was genuine use of earlier comparable trade mark 909689084 (GAP) during the relevant period in relation to clothing, headgear, and footwear in class 25.

24. The applicant disputes the other three earlier marks were put to genuine use during the relevant period in relation to the goods in other classes relied on by the opponent.

25. In *easyGroup Ltd v Nuclei Ltd & Ors*,¹ Arnold LJ summarised the law relating to genuine use as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark.

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark.

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality.

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns. Internal use by the proprietor does not suffice. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter.

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with

¹ [2023] EWCA Civ 1247

the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark.

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use.

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus, there is no de minimis rule.

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

26. Ms McMahon filed a substantial volume of evidence (a 20-page witness statement and over 480 pages of exhibits) much of which is intended to show use of the earlier marks at issue. So far as they are relevant to this opposition, these registrations cover:

Sunglasses and goggles; bags and cases for the aforesaid goods in class 9 (UK 1555691),

Cases, bags and bandoliers, all included in Class 18; articles of luggage; articles included in Class 18 made from leather or from imitation leather" (UK 1265985),
and

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; attaché cases; backpacks; bags for sports; beach bags; briefcases; card cases [notecases]; chain mesh purses; clothing for pets; collars for animals; handbags; haversacks; net bags for shopping; pocket wallets; purses; school bags; shopping bags; umbrella covers; vanity cases (not fitted) (Comparable mark 909608118).

27. The applicant makes multiple criticisms of Ms McMahon's evidence. The most important are that:

(i) She demonstrates a tendency to make broad and vague claims, sometimes going beyond the pleaded case.

(ii) The sales figures provided are not broken down to specific products making it impossible to assess how many (say) bags were sold. This is particularly difficult in circumstances where the majority of goods sold by the opponent are clearly clothing items in class 25.

(iii) Evidence showing use of GAP on storefronts in the UK and Europe, shows use of the mark in relation to retail services rather than on goods in classes 9 and 18.

(iv) Much of the exhibited evidence is dated outside the relevant period or is undated.

(v) Most of the advertising figures provided are not specific to promotion of the GAP mark in the UK or even the EU, and the figures provided for the UK are not broken down by product.

28. The applicant accepts that the exhibits to Ms McMahon's statement show the opponent sells backpacks; beach bags; handbags; shopping bags and tote bags. However, it points out that there is no evidence of the scale of this trade, or (it says) the marks used in relation to those goods.

29. I note that exhibit PM20 consists of historical pages from the opponent's gap.co.uk website dating from June 2018. These pages show numerous bags for sale, particularly tote bags, handbags and backpacks, some of which show GAP applied to the products. No other marks are shown on these products.

30. There are examples of the opponent's handbags and tote bags, some visibly bearing the GAP mark, having been marketed during the relevant period on UK, Spanish and Italian websites belonging to third parties.²

31. There is also evidence of handbags being promoted on Gap UK's Instagram pages during the relevant period.³

32. As to the applicant's objection that the evidence does not show that the use of GAP for its UK⁴ and EU stores is use of the mark in relation to the goods marketed in the stores, I note Ms McMahon's evidence that:

"[The] range has for many years included a wide range of 'GAP'-branded clothing of all types, together with 'GAP'-branded headgear, footwear..., a wide variety of bags, including, but not limited to, rucksacks, tote bags, schoolbags... ."

33. Exhibit PM3 to Ms McMahon's statement consists of a history of the opponent's Gap business. It was written in 1994. It says that in 1991 it was announced that from the end of that year all merchandise would be sold under the company's own label.

34. It is true that this document is old and does not establish GAP remained an 'own-label-only' store during the relevant period. However, the applicant has not put forward any evidence to gainsay Ms McMahon's narrative evidence. And her evidence is consistent with what can be seen in some of the exhibits dating from the relevant period. I therefore accept her evidence on this point.

35. It is true that the opponent has not provided sales or marketing figures specific to GAP bags. However, taking the evidence as a whole, I find it establishes that during

² See exhibits PM28, 29 and PM33

³ See exhibit PM40

⁴ There were 104 UK GAP stores in 2018, down from 143 in 2013

the relevant period the opponent made sufficient use of GAP to create or preserve an outlet under that mark for (at least) backpacks, beach bags, handbags, shopping bags and tote bags.

36. For the reasons given below, it is unnecessary to reach findings on whether the opponent has shown genuine use of the earlier trade marks in relation to the other goods in classes 9 and 18 relied on.

THE SECTION 5(2)(b) GROUND

Similarity of goods

37. The respective goods are shown below.

Applicant's goods	Opponent's goods
<p>Class 9: Contact lenses; spectacles, eyeglasses, eyewear and their frames, cases, chains and lenses; helmets.</p> <p>Class 18: Goods made of leather and imitations of leather, namely, shoulder belts and shoulder straps, suitcases, trunks, garment bags for travel, briefcases, card cases, canes, umbrellas and parasol covers; <u>beach bags</u>; <u>sports bags</u>; <u>shopping bags</u> and <u>wheeled shopping bags</u>; <u>rucksacks</u>; school bags; school satchels; portfolios; brief cases; document bags and cases; music cases; attaché cases; travel bags; trunks and travelling bags; suitcases; slings and pouches for carrying infants; hat boxes; key cases; purses and wallets; purses for travel cards and passes; purses for payment cards; wallets for travel cards</p>	<p>UK1265985</p> <p>Class 18: Beach bags, backpacks, handbags, shopping bags and tote bags</p> <p>Comparable mark 909608118</p> <p>Class 18: Backpacks; beach bags; handbags; haversacks [backpacks]; shopping bags.</p> <p>Comparable mark 909689084</p> <p>Class 25: Clothing, headgear and footwear.</p>

and passes; wallets for payment cards; holders for payment cards, travel cards and travel passes; cases for toiletry or cosmetic articles; umbrellas, parasols and walking sticks; clothing for pets	
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38. The goods underlined in the applicant's class 18 specification are self-evidently identical to the class 18 goods for which I have found the earlier trade marks are entitled to protection.⁵ This the high point of the opponent's case based on the registration of two of the earlier marks in class 18. For the reasons given below, there is no need to compare the applicant's goods against the opponent's other goods in class 18, even if the mark has been put to genuine use in relation to more goods in that class.

39. The opponent claims that GAP has acquired a reputation in relation to class 25 goods and, as a result, has become highly factually distinctive for such goods. I will therefore examine the similarity between the opponent's class 25 goods and the applicant's goods in classes 9 and 18 because, in principle, this might represent the opponent's best case under section 5(2). I note the well-known case law set out by the CJEU in *Canon*,⁶ *Kurt Hesse v OHIM*,⁷ and *Boston Scientific Ltd v OHIM*.⁸ The opponent's skeleton argument explained why it contends that the applicant's *helmets* in class 9 are highly similar to *headgear* in class 25, as follows:⁹

“Headgear covers the head, and can protect it from abrasion and can keep it warm, so it has some of the same uses as a helmet. It also has the same users and the same mode of use as a helmet (i.e. is put on the head). Headgear and helmets are similar.”

⁵ Bearing in mind the inclusion principle set out in *Gérard Meric v OHIM*, Case T- 133/05

⁶ Case C-39/97

⁷ Case C-50/15 P

⁸ Case T-325/06

⁹ The opponent's skeleton argument included arguments about the similarity between clothing and other goods in class 9 of the application, e.g., sunglasses and lenses. However, this is outside the opponent's pleaded case and, therefore, does not require consideration.

40. Headgear, such as a hat, is used to keep the head warm, to protect it from the elements, i.e., sun or rain, and/or to improve the user's appearance. Some headgear in class 25 may also protect the head from abrasion in an accident, but that would be an incidental effect: all helmets and guards for protection against accidents are proper to class 9. Using those goods could also help to keep the head warm, as a hat would do, but again that would be an incidental effect not their real purpose. Therefore, I consider these goods have mainly different purposes. They are usually different in nature too. Protective headgear is usually made of hard outer materials, rather than the soft materials generally associated with headgear in class 25. I accept the method of use is the same: you put them on your head. And the users may overlap to some extent. This is the full extent of any similarity. If they are similar goods, any such similarity is low.

41. As regards the similarity between the opponent's class 25 goods and the applicant's class 18 goods, the opponent's skeleton argument explained why it contends that the applicant's *shoulder belts* are highly similar to clothing as follows:

“Shoulder belts (which are, or which include, belts with an additional strap across one shoulder, as sometimes seen in military-style clothing) are highly similar to clothing (non-leather belts fall within Class 25): they have the same users, they are chosen to coordinate with and to be used with clothing, have a complementarity with clothing (including in the sense that the consumer will expect them to come from the same undertaking), and will be sourced from the same outlets.”

42. However, as counsel for the applicant pointed out at the hearing, under the NICE classification system belts for clothing, including leather belts, are in class 25 not class 18. The shoulder belts in class 18 are for carrying purposes, e.g., for carrying a bag. Therefore, the opponent's submission is misconceived. It is possible that consumers might select a shoulder strap to co-ordinate with the bag they intend to attach to it, and they may select a handbag to co-ordinate with items of their clothing, but there would be no direct, complementary connection between the selection of the shoulder strap and the clothing.

43. I accept that belts for bags and belts for use as clothing may be similar in nature (e.g., leather goods). The users of such goods would also be the general public, although not much weight can be attached to such a high-level overlap in users. The purpose of the goods is different: carrying things from the shoulder versus keeping trousers or skirts up and/or improving the user's 'look'. They are not in competition or complementary goods. If they are similar goods, then any such similarity is low.

44. The opponent submits that:

“The bags and luggage [covered by class 18 of the application] are similar to clothing to an average to high degree, depending upon the particular type of bag: handbags, for example, are highly similar to clothing because they share the same users, have the same outlets, can be chosen to coordinate with clothing (and/or footwear), and are goods that consumers know are often produced by the same undertakings. Sports bags have the same users as sports clothing, and are complementary to sports clothing.”

45. I accept the example of a bag cited by the opponent – a hand bag - is similar to clothing and footwear because they are 'complementary' goods within the meaning of the case law. However, although the applicant's specification includes bags that are carried by hand (e.g., shopping bags) it does not include hand bags of the kind that would normally be chosen to co-ordinate with clothing or footwear. The closest goods to hand bags of that kind appear to be wallets and purses. Ms Mahon provides some evidence of large retailers such as Zara, H&M and Mango, and luxury brands such as Chanel and Burberry, selling purses and wallets as well as clothing.¹⁰ Some of these goods appear to be designed to be carried by the user and be visible in normal use rather than placed inside a handbag or inside an item of clothing. Therefore, the reasons why hand bags are considered complementary goods to clothing appears to extend to some designs of wallets and purses. I find wallets and purses are similar to clothing to a medium degree.

46. The opponent further points out that money belts fall within Class 25. I accept that purses/wallets and money belts have a similar purpose, i.e., carrying money and

¹⁰ See exhibit PM44, particularly page 13

valuables. They may also be made of similar materials. The method of use is different: money belts are worn whereas purses and wallets are usually carried. They are not complementary goods, but they may be in competition, particularly wallets and money belts. I find wallets and purses are similar to money belts to a medium degree.

47. Finally, the opponent submits that hats in class 25 are highly similar to hat boxes in class 18. I disagree. The nature, purpose, and method of use of the goods is obviously different. They are not competitive goods. In my view, they are not complementary goods either. It is true that a hat box is selected to store a hat of a certain size. However, there is no evidence that consumers select hat boxes to match the appearance of their hats. There is no obvious reason why they would because hats are not visible when stored in hat boxes.

48. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with an economically connected undertaking. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*:¹¹

“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 glassware are similar goods for trade mark purposes.”

49. There is no evidence that the public are accustomed to undertakings responsible for the quality of the hats they sell also being responsible for associated hat boxes. In my view, these are dissimilar goods. I have focussed on the arguments put forward by the opponent as to why the applicant’s goods in class 18 are similar to the goods for which GAP is claimed to be highly distinctive in class 25. The case for claiming that the applicant’s other goods in class 18 (e.g., slings, umbrellas) are similar to clothing has not been developed to the same extent as the examples I have considered. I see no case for finding that any of them are any more similar to clothing than the ones I have already looked at.

¹¹ BL-0-255-13

Global assessment of likelihood of confusion

50. 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.

The principles

- (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.

Average consumer and the selection process

51. The relevant average consumer is a member of the general public. According to the opponent, the goods covered by the application will in some instances be selected by average consumers paying only a low degree of attention. I reject this submission. This is not a 'bag of sweets' case. I see no reason why average consumers of shopping bags etc., would pay a less-than-normal level of attention. In my view, the relevant consumer would pay an average level of attention when selecting the goods at issue.

52. The goods are likely to be selected from shelves and displays in stores, or from websites. Therefore, the selection process is likely to be primarily visual. However, word of mouth orders/recommendations may also play a part in the selection process, so the way the marks sound must also be considered.

Distinctive character of the earlier marks

53. In *Lloyd Schuhfabrik Meyer & Co.* 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).”*

54. The word GAP is not descriptive of clothing, footwear, headgear, or bags. On the other hand, it is a short, single, commonplace word. Therefore, it is not particularly striking or memorable *per se*. In my view, it is a mark with an average or ‘normal’ degree of inherent distinctive character when considered in relation to the goods at issue.

55. The opponent’s case at the hearing was that the earlier marks had acquired an enhanced level of distinctiveness from the extensive use of GAP in relation to clothing, “*but also for accessories such as bags.*”

56. The opponent's pleaded case under section 5(2) does not expressly rely on the earlier marks having acquired an enhanced distinctive character through use. On the other hand, the opponent's pleaded section 5(3) case is based on GAP having acquired a significant reputation in the UK in relation to clothing. It was therefore implicit that the opponent was contending that GAP had become more distinctive through extensive use in relation to clothing. In these circumstances I consider the opponent can ask for this to be considered as a factor in the assessment required under section 5(2), as well as under section 5(3). By contrast, the opponent's pleaded case does not include a claim that GAP has acquired a reputation or enhanced distinctiveness for bags. Therefore, it was not open to the opponent to make such a submission at the hearing. In any event, given the uncertain scale of the opponent's use of GAP in relation to bags, the opponent has not established the factual basis for this submission.

57. So far as clothing is concerned, the opponent operated over 100 GAP stores throughout the UK during each of the 5 years prior to the relevant date in 2018, all selling GAP-branded clothing. The opponent's UK annual turnover was around, or in excess of, £100m in each of the four years leading up to the relevant date. Although TV advertising of GAP appears to have ceased in 2013, the opponent spent at least \$1.2m promoting the mark in the UK in each of the years 2013 to 2018. Nearly 30m visitors visited the opponent's gap.co.uk website in 2018. It is clear GAP was highly distinctive of the opponent's clothing at the relevant date.

Comparison of marks

58. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
GAP	MIND THE GAP

59. The opponent contends that the respective marks are visually similar to at least an average degree because the word that constitutes the earlier mark is the focus of the term MIND THE GAP.

60. In addition, the opponent submits MIND THE GAP:

“... is capable of normal and fair presentations that draw particular attention to the “GAP” element – such as presenting the GAP element in a larger or more eye-catching font.”

61. The applicant disputes that this would constitute normal and fair use of the contested mark. I agree. Iain Purvis KC as the Appointed Person reviewed the relevant authorities in *Herno S.p.A. v Miss Sparrow Ltd*¹² and concluded that:

“...it is wrong to approach the required comparison by hypothesising a way of styling the word mark in a way which is extremely similar to the contested mark (whether by choice of font or the use of other forms of presentation), and asking whether confusion would be likely in such a case. This approach is contrary to Calvin Klein and Faber and Ontex. It is also contrary to the statutory test which is to ask whether confusion will arise ‘because of the similarity between mark and sign’ because the stylisation is not part of the mark.”

62. The applicant points out that the word GAP is but one of the three words making up the contested mark and is the last of those words. According to the applicant, the level of overall visual similarity is therefore minimal.

63. For the reasons given by the applicant, I find the marks are visually similar to a low-to-medium degree.

64. The same applies to aural similarity.

65. Conceptually, the opponent argues that

¹² BL O/954/22

“GAP means a space between things, and ‘MIND THE GAP’ is an instruction to be cautious because of that space. Conceptually the focus is on the ‘GAP’, and so a higher than average level of conceptual similarity results.”

66. The applicant submits that the marks are altogether different from a conceptual perspective because:

“The word GAP is simply a noun, meaning space, hole, pause etc., whether the gap is between two objects or, perhaps, a break in continuity. The vital conceptual, warning idea provided by MIND THE GAP is not found in GAP alone. Both parties’ marks have a conceptual meaning, but that meaning is different.”

67. Both sides appear to agree that MIND THE GAP would be perceived as a warning. I agree. ‘Mind the step’ is understood in a similar way. The warning meaning is not conveyed by the word GAP alone. As the applicant points out, the meaning of that word alone is much more general, it need not even relate to a space between two objects, let alone a warning not to fall into it. Therefore, in my view, the concept of the marks will appear dissimilar to average consumers of clothing and bags etc.

Likelihood of confusion

68. The opponent claims there is a likelihood of direct and indirect confusion. So far as the former is concerned, the opponent says this is made more likely by the enhanced distinctive character of the earlier GAP marks.

69. I accept this is a relevant factor so far as earlier comparable trade mark 909689084 in class 25 is concerned. I do not accept this is a relevant factor so far as the opponent’s other earlier trade marks in class 18 are concerned. This is because the opponent has not established that GAP has acquired an enhanced distinctive character for anything other than clothing, footwear, and headgear. Indeed, it has not pleaded any wider claim.

70. The goods covered by the application do not include clothing in class 25. And as explained in paragraphs 41 - 49 above, the applicant’s *helmets* in class 9 and all the goods in class 18 are, with one exception, dissimilar to clothing, or similar to only a

low degree. The exception is *wallets* and *purses* in class 18 which I have accepted are similar to *clothing* in class 25 (including money belts) to a medium (but not high) degree. By contrast, some of the respective goods in class 18 are identical. In my view, this means that the opponent's strongest case, at least when it comes to the likelihood of direct confusion, is based on the earlier marks registered in class 18.

71. I accept that GAP is the subject (or "focus") of the preceding words MIND THE... . This does not mean that GAP is the dominant and distinctive element of the mark. The average consumer normally perceives a trade mark as a whole. This is particularly likely where the consumer understands a combination of words to form a warning, i.e., to have a meaning that is distinct from the meaning of the words separately. The distinctive character of MIND THE GAP resides in the combination of these words. For the same reason, GAP will not be perceived as having an independent distinctive role within the composite term.

72. The above conclusion is based on the inherent meaning of the words MIND THE GAP. In this case the term has taken on a specific warning significance to, at least, users of the London Underground system. In that context, 'Mind the Gap' has been used for decades to warn travellers about the risk of falling into the gap between the train and the platform edge.

73. At the hearing, counsel for the opponent contended that the effect of the use relied on by the applicant would not be apparent to those consumers who are not users of the London Underground. In this connection, my attention was drawn to the evidence that only one in seven UK consumers live in the area served by the London Underground, and not all of those use the system. According to the opponent, this means a majority of the UK public, or at least a significant proportion of it, are not familiar with the use of the words MIND THE GAP as a specific warning to avoid the gap between the train and the platform edge.

74. I do not accept that the proportion of consumers familiar with this use of MIND THE GAP is limited to a subset of those living in the area served by the London Underground. This is because (1) the London Underground is used by the many millions of UK consumers who visit London every year as well as those living there, and (2) the evidence of Mr Robert Jacob on behalf of the opponent is that:

“The Opponent does not dispute that MIND THE GAP is used by the Applicant as a warning to users of its transportation network..... .

Indeed, MIND THE GAP is used as a warning by transportation service providers other than the Applicant, in the London area, across the United Kingdom and around the world. I set out below images of such use taken either by me or one of my associates between August 2023 and May 2024, these stations and services from these stations are not operated by the Applicant.”
(emphasis added)

75. It is true that Mr Jacob’s evidence addresses the position in 2023/4 rather than 2018. However, given the longstanding use of the phrase on the London Underground, it would be surprising if the broader use described by Mr Jacob only started after 2018.

76. In *EUIPO v Messi Cuccittini and J.M.-E.V. e hijos v Messi Cuccittini*,¹³ the CJEU held that it was relevant to take account of the potential fame of the applicant on the average consumer’s perception of the contested trade mark in deciding whether there is a likelihood of confusion. The potential significance of words that have a clear conceptual meaning to consumers is not limited to marks consisting of the names of famous people.

77. It is important to note this is not about the applicant’s prior use of the contested mark as a trade mark. Rather, it goes to the conceptual meaning of the mark to average consumers. The fact that the three words at issue in this case form a composite term with a strong, specific, conceptual meaning to, at the very least, a significant proportion of the UK public is relevant because it reduces (in my view, to zero) the risk of that section of the public mistaking the contested mark for another trade mark comprised of just one those three words.

78. I accept that there may be some average consumers who are not familiar with the use of the words MIND THE GAP as the specific warning described above. However, I find that even among this group the inherent meaning of the words as a warning to avoid the gap between (any) two objects, combined with the obvious visual and aural difference between GAP and MIND THE GAP, is sufficient to exclude the likelihood of

¹³ Joined Cases C-449/18 P and C-474/18 P

direct confusion even where the goods are identical. It follows that there is even less likelihood of direct confusion where the goods are only similar.

79. According to the opponent, there is a likelihood of indirect confusion because “consumers will conclude that the goods offered under the “MIND THE GAP” name share a common source with the goods that are provided under the “GAP” name.” This is said to be because either:

“GAP” is highly distinctive of one origin and because “MIND THE...” merely adds a non-distinctive element when considered in the context of the goods of the Application. Consumers who are not directly confused are still likely to conclude that goods of the Application sold under “MIND THE GAP” are goods from the business responsible for e.g., bags or clothing under the “GAP” mark”

and/or

“Consumers think that “MIND THE GAP” is another instance of the family of marks of which “GAP”, “THE GAP”, “BABY GAP”, and “GAP KIDS” amongst others are members Further, Gap has used its distinctive name in slogans with similar format to the Application, for example “Fall into the Gap” (PM3 p.2, PM36 p.5) and “Meet me in the Gap” (PM39 p.1). Even for consumers not aware of those specific slogans, they show the likelihood of the use of “Gap” in the same format as the Application.”

80. I can deal with the first point briefly. For the reasons I have given to explain why there is no likelihood of direct confusion, I consider it very unlikely that average consumers will dissect MIND THE GAP into MIND THE and GAP, and disregard or downgrade the distinctive significance of MIND THE in the composite term.

81. As to the opponent’s second point, the opponent’s pleaded case does not include a claim to own a ‘family’ of GAP marks. Even if it did, I do not find this sufficient to provide a “proper basis” for the claimed likelihood of indirect confusion.¹⁴ THE GAP is simply GAP preceded by the definite article. BABY GAP and GAP KIDS are GAP with

¹⁴ See *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 at paragraph 13 of the judgment

descriptions identifying sub-categories of GAP clothing. There is only one example of use of 'Meet me in the Gap' in evidence and that dates from June 2018.¹⁵ In any event, this slogan seems likely to be understood as an invitation to meet up in a GAP store. This has a quite different construction and meaning to MIND THE GAP. Indeed, one of the opponent's stated concerns is that the latter term will be understood by "many" consumers as a warning to avoid the use of Gap's products. There is also very little evidence of use of 'Fall into the Gap.' It was accepted at the hearing that such evidence as there is shows only historical use of that term. There is nothing to suggest that consumers would have had such use in mind at the relevant date in 2018.

82. I therefore reject the opponent's case on indirect confusion and with it the section 5(2) ground of opposition.

THE SECTION 5(4)(a) GROUND

83. In *Discount Outlet v Feel Good UK*,¹⁶ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21)."

¹⁵ See exhibit PM39, page 1

¹⁶ [2017] EWHC 1400 IPEC

Relevant date

84. There is a dispute as to the relevant date for the opponent to establish a passing off right. The opponent says it is the date of the EU trade mark application in July 2018. The applicant says the activity complained about started in the early 1990s and this is the relevant date. This is before the opponent acquired goodwill in the UK under GAP. Therefore, the applicant submits the opponent's case is bound to fail.

85. In *Sworders TM*¹⁷ I said that:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

86. Where use of the contested mark commenced prior to the filing or priority date of the application, the reason for re-assessing the opponent's passing off right at the later date was explained by Mr Thomas Mitcheson QC as the Appointed Person in *Casablanca TM*,¹⁸ as follows:

“Clearly if the activity ceased or changed materially between the date of commencement and the date of application for the trade mark then this must be taken into account, as it may mean that the true date of commencement of the activity complained of is later or that the activity complained of cannot properly be said to have properly commenced at all (if it was later abandoned).”

87. According to Ms Sankey's evidence, the applicant has “for many years” produced a range of merchandise bearing the MIND THE GAP slogan, either solus, or in conjunction with the well-known London Underground roundel logo shown in paragraph 7 above. Ms Sankey provides current and historical examples of such

¹⁷ BL O/202/06

¹⁸ BL O/349/16 at paragraph 38

merchandise. However, very little of it relates to the goods covered by the opposed application. The highpoint of Ms Sankey's evidence on this matter is an example of a backpack bearing the words Mind the Gap having been on sale in the London Transport Museum's shop in 1999/2000.¹⁹ There is no evidence of any sales of such goods. And there is no evidence that such use continued between 1999/2000 and 2018. All the evidence shows is that the applicant offered Mind the Gap backpacks from one shop in London in 1999/2000. Unless the trade continued, such use would have been long forgotten by the date of the application in 2018. In my view, the applicant's evidence is too flimsy and vague to establish that it had an on-going trade in bags (or any other relevant goods) under MIND THE GAP prior to the date of the contested application. Consequently, the applicant cannot rely on the use in 1999/2000 to invoke the rule safeguarding the continuation of antecedent use. Therefore, the relevant date is 13th July 2018.

Goodwill

88. The opponent plainly had a substantial goodwill in the UK at the relevant date in relation to clothing. The word GAP was distinctive of that goodwill.

Misrepresentation

89. The opponent's passing off case fails because use of MIND THE GAP in relation to the goods covered by the application would not constitute a misrepresentation to the public that those goods are connected with the applicant. I recognise that it is not necessary for all, or even a majority, of the public to be deceived; a substantial number will do. However, for the reasons I have given for rejecting the opponent's case that there is a likelihood of confusion, I find that no substantial number of persons will be deceived by the applicant's use of the contested mark. Indeed, I doubt that anyone will be deceived.

Damage

¹⁹ See exhibit ES15

90. In the absence of misrepresentation there can be no relevant damage to the opponent's goodwill.

Outcome

91. The section 5(4)(a) ground of opposition fails.

THE SECTION 5(3) GROUND

92. The opponent's case is that use of the contested mark will cause the public to make a link with the earlier GAP mark with its reputation for clothing, headgear and footwear and the result will be:

- (1) The public will mistakenly believe that the user is economically connected to the opponent, and/or
- (2) Even if there is no confusion, the link will allow the applicant to unfairly benefit from the opponent's significant financial investment in its advertising and promotion of the GAP brand, and/or
- (3) The reputation of the GAP mark will be damaged because the opponent cannot control the quality of the goods the applicant markets under the contested mark, which could be of poor quality, and/or
- (4) The distinctive character of GAP and its capacity to signify the trade origin of goods will be weakened and its power of attraction reduced.

93. The first of these arguments is essentially that there is a likelihood of confusion. I have already considered and rejected this argument by dismissing the section 5(2) ground of opposition in relation to identical and similar goods. The case is even weaker when it comes to dissimilar goods. It follows that the section 5(3) ground must be rejected to the extent it is based on the proposition that there is a likelihood of the public wrongly assuming that the user of the contested mark is economically linked to the user of GAP for clothing etc. I next to turn to claims (2) to (4).

94. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*

and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a

change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

95. I accept that GAP has a reputation in the UK in relation to clothing, footwear, and headgear.

Link

96. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

97. In paragraphs 58 – 67 above I explained why I find the respective marks visually and aurally similar to a low-to-medium degree, and conceptually dissimilar.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

98. In paragraphs 37 – 49 above I explained why the goods covered by the application are dissimilar, or similar to a low degree or, in one instance, similar to a medium degree, to clothing, headgear and footwear in class 25. I have accepted the relevant public for the respective goods is largely the same (the general public) who will pay a 'normal' or average degree of attention when selecting the goods at issue. I further accept that even where the goods are dissimilar, some of them, such as eyewear and umbrellas, may be sold in the same kind of stores as clothing. Consequently, even where the goods are dissimilar, they are not wholly distant.

The strength of the earlier mark's reputation

99. I accept that GAP has a strong reputation in the UK in relation to clothing, footwear, and headgear.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

100. I accept that GAP is highly distinctive in the UK through extensive use in relation to clothing, footwear, and headgear.

Whether there is a likelihood of confusion

101. I have rejected the opponent's claim that there is a likelihood of confusion.

Conclusion

102. Considering all relevant factors, I find that no significant proportion of UK consumers will make a link (of any kind) between MIND THE GAP used in relation to the goods in classes 9 and 18 covered by the application, and GAP with its reputation for clothing etc. in class 25.

103. Even if I am wrong about that, I am satisfied that any link that might be made between the marks would be so weak as to be unlikely to give rise to any of the conditions covered by section 5(3) of the Act. In other words, any such link would be inoperative.

104. This finding is consistent with the case law summarised in paragraph 94(f) above, where it is noted that:

“..the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark.”

105. The converse is also true. The less immediately and more weakly the earlier mark is brought to mind, the less the likelihood that use of the later mark will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark.

106. In the light of these findings there is no need to go into the opponent's specific complaints about the unfair advantage/detriment which it says would result from the suggested linkage between the marks.

107. My attention has been drawn to a decision of the EUIPO's Opposition Division made in May 2014 in Case B3 073 970. The EUIPO accepted (as I have) that GAP has a reputation for clothing. It found that the use of MIND THE GAP in relation to the same goods as the present application would, without due cause, take unfair advantage of the reputation and distinctive character of GAP.

108. I am not bound by the decision of the EUIPO. I do not find it persuasive either. I note the Opposition Division made it clear that the ‘warning’ meaning associated with the term MIND THE GAP was not considered as a material factor because it had the German-speaking public in mind. The position is obviously different in these proceedings.

Outcome

109. The opposition under section 5(3) also fails.

THE SECTION 5(4)(b) GROUND

110. There is a dispute as to whether the contractual rights relied on by the opponent constitute an ‘earlier right’ for the purposes of section 5(4)(b) of the Act. The relevant provision covers:

“...an earlier right other than those referred to [elsewhere in section 5 of the Act] in particular by virtue of the law of copyright, or the law relating to industrial property rights.”

111. The opponent correctly points out the words “*in particular*” leave open the possibility that section 5(4)(b) covers more than just the two legal rights mentioned in the section, i.e., copyright, and industrial property rights (such as designs). The possible applicability of contractual rights is discussed in Kerly, 17th Edition, at 11-153. It is noted that:

“The earlier identified rights are not exhaustively defined and it is arguable that they could include other rights, such as a contractual restriction on registration of a mark as part of a broader licensing agreement.”

112. The applicant points out that Kerly goes no further than to suggest that a contractual restriction is arguably within the scope of the provision. No authority is cited for this proposition. Further, despite the law at issue being 30 years old the opponent has been unable to identify a single case at UK or EU level where contractual rights have been asserted as an earlier right under this provision.

113. The optional provision in Article 4(3)(c) of the EU Trade Marks Directive that was implemented in the UK by section 5(4)(b) of the Act is as follows:²⁰

“(c) the use of the trade mark may be prohibited by virtue of an earlier right other than [registered and unregistered trade mark] rights referred to in paragraphs 2 and 4 (b) and in particular:

(i) a right to a name;

(ii) a right of personal portrayal:

(iii) a copyright;

(iv) an industrial property right;”

114. The Directive exhaustively lists the mandatory and optional legal protections that must, or may, be afforded to earlier registered and unregistered trade marks. The wording of the relevant Article (and that of section 5(4)(b) of the Act) makes it clear that this covers earlier legal rights “*other than*” trade mark rights. This accords with the examples of earlier rights cited in the provision itself, each of which protect signs under other types of IP or pseudo-IP law.

115. The contract at issue is a settlement agreement reached following a trade mark dispute. The subject matter of the agreement is the trade marks GAP and MIND THE GAP. The contract creates no rights protecting any other kind of sign. Therefore, the contractual rights created by the agreement do not constitute an earlier right of the kind covered by section 5(4)(b) of the Act, i.e., an earlier right protecting signs “*other than*” earlier trade marks.

116. Further, each example of potentially relevant earlier rights cited in the Act and Directive is, in principle, exercisable against any third party using a trade mark that infringes the right concerned. By contrast, the contractual rights relied on by the opponent are only capable of being exercised against the applicant (and, possibly, its privies and assigns). If the opponent is right about section 5(4)(b) protecting pre-

²⁰ Article 4(3)(c) of Directive 104/89

existing contractual rights, this would be the only relative ground of refusal the very existence of which depended, in part, on the identity of the applicant. This is unlikely.

117. I conclude that section 5(4)(b) of the Act does not protect private contractual rights relating to trade marks. The opposition under this section fails accordingly.

THE SECTION 3(6) GROUND

118. Before I examine whether the settlement agreement prohibits the applicant from applying to register MIND THE GAP in relation to the goods covered by the application and, if so, whether the application was made in bad faith, it is necessary to determine the relevant date for assessing these matters.

The relevant date for assessing the bad faith claim

119. The applicant submits that it is the date it filed the UK trade mark application, i.e., 14th September 2021. The opponent says it is the date of filing of the EU trade mark application from which the current application claims priority, i.e., 13th July 2018. In this connection, the opponent relies on Article 59 of the Withdrawal Agreement between the UK and the EU. The text of the provision is as follows:

“1. Where a person has filed an application for a European Union trade mark or a Community design in accordance with Union law before the end of the transition period and where that application was accorded a date of filing, that person shall have, for the same trade mark in respect of goods or services which are identical with or contained within those for which the application has been filed in the Union or for the same design, the right to file an application in the United Kingdom within 9 months from the end of the transition period. An application made pursuant to this Article shall be deemed to have the same filing date and date of priority as the corresponding application filed in the Union and, where appropriate, the seniority of a trade mark of the United Kingdom claimed under Article 39 or 40 of Regulation (EU) 2017/1001.”

120. Counsel for the opponent pointed out that the Agreement requires UK applications filed during the relevant period to be “*deemed to have the same filing date and date of priority as the corresponding application filed in the Union,*” and this

requirement is not qualified as being only for establishing a right of priority vis-à-vis third-party rights. Further, section 7A of the European Union (Withdrawal) Act 2018 provides:

“7A General implementation of remainder of withdrawal agreement

(1) Subsection (2) applies to—

(a) all such rights, powers, liabilities, obligations and restrictions from time to time created or arising by or under the withdrawal agreement, and

(b) all such remedies and procedures from time to time provided for by or under the withdrawal agreement,

as in accordance with the withdrawal agreement are without further enactment to be given legal effect or used in the United Kingdom.

(2) The rights, powers, liabilities, obligations, restrictions, remedies and procedures concerned are to be—

(a) recognised and available in domestic law, and

(b) enforced, allowed and followed accordingly.

(3) Every enactment (including an enactment contained in this Act) is to be read and has effect subject to subsection (2).”

121. This means that UK legislation such as Paragraph 25 of Part 3 of Schedule 2A to the Act, must be interpreted in accordance with the requirements of the Withdrawal Agreement.

122. Counsel for the applicant submitted that Parliament had interpreted Article 59 of the Agreement as requiring the rights set out in Schedule 2A of the Act. The relevant part of which states that:

“(a) the relevant date for the purposes of establishing which rights take precedence is the earliest of—

(i) the filing date accorded pursuant to Article 32 to the existing EUTM application;

(ii) the date of priority (if any) accorded pursuant to a right of priority claimed pursuant to Article 35 in respect of the existing EUTM application; and

(b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom which commenced in the period between the date referred to in paragraph (a) and the date of the application under this Act. (emphasis added)

123. The words in emphasis in paragraph (a) above indicate that the filing or priority date of the EU trade mark application can only be relied on for the purpose of establishing “*which rights take precedence.*” In the context of trade mark law, this means as a priority right for relative grounds purposes. The words in emphasis in paragraph (b) above indicate that the filing date of the application “*under this Act*” must be later than the date specified in paragraph (a). This can only mean it is the actual date the application was filed in the UK.

124. In examining whether this provision is consistent with the Withdrawal Agreement, I note the heading of Article 59 of the Agreement is as follows:

“Right of priority with respect to pending applications for European Union trade marks, Community designs and Community plant variety rights”

125. This suggests that the purpose of Article 59 is to give re-filed UK trade mark applications a right of priority. This appears to be consistent with the UK legislation shown at paragraph 122 above.

126. Mr St Quintin submitted that the heading of Article 59 should not be construed as limiting the scope of the provision. This accords with the approach taken to interpreting the effect of headings to sections of Acts of Parliament. The Withdrawal Agreement has been given legal effect in the UK, but it is not an Act of Parliament. It is a political agreement. In construing such an agreement all relevant indications of the parties’ intentions should be considered, including the headings of

the various provisions. Therefore, although not decisive, I will attach some weight to the heading of Article 59 in construing the intended purpose of this provision.

127. As to the parties' intentions, I note that Article 54 of the Withdrawal Agreement makes analogous provision for comparable UK trade marks to "*enjoy the date of filing or the date of priority of the European Union trade mark and, where appropriate, the seniority..*" Article 54 is about the "*Continued protection in the United Kingdom of registered or granted rights.*" In accordance with Article 54, comparable UK trade marks were created and registered automatically when the UK left the EU and "*without any re-examination.*" They were given the same renewal date as the EU trade mark from which they were cloned, and their continued existence was tied to the outcome of any outstanding EU cancellation proceedings. It is clear, therefore, that comparable marks are, in essence, EU registered trade marks simply re-registered in the UK.

128. By contrast, Article 59 of the Withdrawal Agreement only provides a right to re-file a pending EU trade mark application in the UK. Such re-filed applications are subject to examination on absolute grounds, and to opposition on absolute and relative grounds. There is no presumption in favour of registration. It would clearly be inequitable for such applications to be blocked by third party trade mark rights acquired in the UK whilst the EU trade mark application was pending before the EUIPO, and the UK was a member of the EU. Therefore, it makes perfect sense for re-filed UK applications to be given a right of priority over such intervening rights. There is no obvious policy reason why examination or opposition on absolute grounds should assess the position at any date other than the actual filing date of the UK application. Take, for example, a mark that is generic at that date. The fact that it may not have been generic when the EU trade mark application was filed is not a compelling reason to accept a re-filed application for registration in the UK. This is because granting an exclusive right to a generic term is anti-competitive and against the public interest. Further, the approach advocated by the applicant could lead to absurd results. Suppose a party with a pending EU trade mark application at the date of Brexit subsequently assigns its interest in the mark or makes an agreement not to exercise its right to apply to register the mark in the UK, but then goes on to apply to register the mark in the UK in its own name claiming priority from the EU

filing. On the applicant's interpretation of the legislation, the party to whom the applicant had assigned its interest in the mark, or with whom it had reached an agreement not to apply for registration in the UK, would have no entitlement to oppose the application on bad faith grounds despite the applicant's manifest bad faith action, because the matter relied on post-dates the relevant date.

129. For the reasons given above, I find that the Withdrawal Agreement and paragraph 25 of Part 3 of Schedule 2A to the Act only require the original EU filing date to be taken as the filing date of the UK application for the purpose of establishing a right of priority on relative grounds. This means that the relevant date for the purpose of assessing the opponent's bad faith allegation is 14th September 2021.

Was the Agreement Terminated before the Relevant Date?

130. Ms Sankey's evidence on behalf of the applicant is that:

"...the [2004 Settlement] Agreement was determined by [the applicant] in 2019 due to the Opponent's repudiatory breach of it. There was an exchange of correspondence between the parties following [the applicant's] allegation of breach and its notice of termination of the Agreement, but the issue remained unresolved between them. The Opponent threatened to apply for a declaration that the Agreement was still in force, but it never did so..... Despite termination of the Agreement, [the applicant] has until now maintained the approach of using the MIND THE GAP slogan on clothing in the manner required by the Agreement, so as to avoid unnecessary conflict with the Opponent."

131. The correspondence exhibited to Ms Sankey's evidence shows that the applicant wrote to the opponent in June 2019 after it discovered that the opponent was selling 'jeggings' bearing the London Underground Roundel and the words MIND THE GAP. From subsequent correspondence it appears the opponent was selling decorative patches for clothing, one of which was the roundel and words complained about by the applicant. It seems the offending patches were not applied to the opponent's clothing by the opponent itself, but by some of the opponent's

customers. The applicant maintained that this was a breach of the 2004 agreement because even if the patches were not 'clothing', they were clothing accessories, and the agreement prohibited the opponent from using the signs complained about in relation to goods falling within either description.

132. The opponent denied breaching the agreement but nevertheless took action to remove the offending patches from sale. It appears they had only been placed on sale in 3 of the opponent's 100+ UK stores. Further, they had only been stocked and sold on a small scale (300 patches). The opponent also indicated that the offending products would not be placed on sale again.

133. Counsel for the applicant submitted that the alleged breach resulted in the termination of the 2004 agreement in 2019. Consequently, the provisions of the agreement placing restrictions on the applicant's use of MIND THE GAP were not binding at the relevant date in 2021. Consequently, the applicant did not act in breach of the agreement by applying to register MIND THE GAP and the bad faith claim was bound to fail accordingly.

134. According to Chitty on Contracts,²¹ not every breach of a contract justifies its termination or relieves the non-breaching party from its obligations under the contract. A right to terminate arises where the term breached is of a 'condition' of the contract. There is nothing in the 2004 agreement that identifies the clause claimed to have been breached as a condition of the contract or which indicates that the innocent party may treat himself as discharged from the contract, or terminate the contract, if the term in question is breached.

135. In *Telford Homes (Creekside) Ltd v Ampurius Nu Homes Holdings Ltd*,²² the Court of Appeal stated that, in assessing whether or not an intermediate term has been breached in a way that entitles termination, one may consider a) the financial loss the breach has caused, b) the amount of the intended benefit under the contract that the injured party has already received, c) whether the injury can be adequately compensated in damages, d) whether the breach is likely to be repeated, e) whether

²¹ 35th Edition at chapter 28

²² [2013] EWCA Civ 577

the party in breach will resume compliance with their obligations, and f) whether or not the breach has fundamentally changed the value of future performance.

136. Applying the above criteria, it seems very unlikely the opponent's alleged breach was sufficient to justify the applicant's termination of the 2004 agreement. The financial loss caused would have been small. The applicant had already had the benefits of the agreement for 15 years before the alleged breach occurred. Any injury could easily be compensated for in damages. The opponent had stopped selling the clothing patches complained about and stated that it did not intend to offer such goods again. Therefore, if there was a breach, the opponent had resumed compliance with its obligations. The effect of the alleged breach on the value of the applicant's rights under the agreement was relatively small. It was not such as to fundamentally change the value of future performance under the agreement.

137. If the parties wish to conclusively establish whether their agreement has been lawfully terminated, the proper course is to apply to the court for an appropriate declaration. In the absence of a determination by the courts, I am not satisfied from the papers before me that the agreement was lawfully terminated in 2019. Therefore, I will proceed on the basis that the parties were bound by the terms of the 2004 agreement at the relevant date.

Did the 2004 Agreement apply to the UK at the relevant date?

138. The applicant contends that the 2004 agreement did not apply to the UK at the relevant date. The opponent disputes this. Assessing the matter requires examination of the terms of the 2004 Agreement, which is subject to an order prohibiting public access or inspection. This is why some of the following parts of this decision will be redacted in the publicly accessible version of this decision.

139. It is evident from the fourth recital to the 2004 agreement, and clauses 2.1 and 2.2, that the catalyst for the settlement agreement was the applicant's UK trade mark application No.2153485 to register MIND THE GAP in classes 16, 25 and 42. The opponent had opposed the application relying on its earlier rights in GAP. The agreement contains restrictions on the applicant's use of MIND THE GAP in relation to clothing, clothing accessories and personal care items. In return, the opponent agreed to withdraw its opposition to trade mark application No.2153485 and not to challenge the registration of that mark in the future.

140. The agreement also made provision for future trade mark applications. Broadly speaking, it permitted the applicant to register further marks with the words MIND THE GAP in relation to clothing (with certain specific exceptions), clothing accessories and personal care items provided the words were contained within the well-known London Underground logo shown at paragraph 7 above.

141. Clause 4 of the agreement states that:

4.1 This Agreement applies to all countries of the European Union as constituted from time to time.

142. The UK was no longer a member of the EU at the relevant date. This is why the applicant contends that it does not apply to the current application.

143. The opponent submits that the words "*from time to time*" are wide enough to cover countries that have been members of the EU at one time or another. The opponent says this interpretation reflects the parties' intentions at the time of the agreement. The EU had just been significantly enlarged and two further countries were scheduled to join. By contrast, no country had ever left the EU and Brexit was not contemplated. The fact that the catalyst for the agreement was a UK national trade mark application provides further support for the argument that, viewed objectively, the agreement was intended to cover the UK going forward, as well as the rest of the EU as it continued to expand.

144. The case law on interpretation of contracts is well established. The following basic points are uncontroversial. The Supreme Court re-stated them most recently in *Wood v Capita Insurance*:²³

- It is necessary to ascertain the objective meaning of the language the parties have chosen to express their agreement.
- The factual background at the date of the agreement, and the agreement's purpose, can be taken into account to determine the meaning of disputed words.
- Where there are rival meanings, weight can be given to the one most consistent with business common sense.

145. In *Arnold v Britton*²⁴ Lord Neuberger provided more specific guidance about the role business or commercial common sense can legitimately play in the interpretation of contracts. He pointed out that:

- Commercial common sense/surrounding factual circumstances should not undervalue the importance of the language of the clauses because the parties control the language they use.
- The less clear the words to be interpreted, the more the court can properly depart from their natural meaning.
- A court should be slow to reject the natural meaning of a provision simply because it appears imprudent for one of the parties to have agreed to it.
- Commercial common sense is relevant only to how matters would have been perceived when the agreement was made.
- The court may only take account of background facts that were known, or reasonably available, to both parties at the time of the agreement.

146. The teaching of these Supreme Court judgments, and that of more recent cases before the lower courts, is that the meaning of the words used by the parties are of primary importance when it comes to interpretation. However, where the chosen words are disputed because there is some ambiguity about what they mean, one can look at the surrounding circumstances at the time of the agreement and apply

²³ [2017] UKSC 24

²⁴ [2015] UKSC 36

commercial common sense to work out what the disputed words were intended to mean. The overriding objective is to give effect to the parties' intentions at the time of the agreement.

147. In my view, there is some ambiguity about the meaning of the words "*countries of the European Union as constituted from time to time*." Firstly, as counsel for the opponent pointed out, the territory of the agreement is defined as "*countries of the European Union*" rather than directly by reference to the territory of the EU. The focus is on countries. Secondly, the words "*...the European Union as constituted from time to time*" (emphasis added) are ambiguous as to whether a country that was in the EU at the time of the agreement, but is no longer so, is included.

148. Looking at the surrounding circumstances at the time of the agreement and applying commercial common sense to resolve the ambiguity leads to only one plausible answer: the agreement was intended to cover the countries who were members of the EU at the time of the agreement and any countries that joined the EU in the future. This is consistent with the agreement being partly intended to resolve outstanding opposition proceedings between the parties in relation to a UK trade mark application. The alternative meaning, that the parties intended to exclude the UK from the scope of the agreement if it left the EU, is inconsistent with one of the specific purposes of the agreement. It also seems unlikely because of the UK-centric nature of the applicant's business. The fact that in 2004 virtually no one was expecting the UK to leave the EU makes it even less likely that the parties intended clause 4.1 to have the effect of excluding the UK from the scope of the agreement in the event of Brexit.

149. I therefore find that clause 4.1 has the meaning contended for by the opponent. I reject the applicant's submission that the agreement did not cover the UK at the relevant date.

Does the agreement prevent the applicant from applying to register MIND THE GAP in relation to the goods covered by the application?

150. The provisions of the agreement in dispute are shown below.

“1.3 For personal care items and Clothing Accessories (“Clothing Accessories” at a minimum shall include jewellery and handbags), [the applicant] agrees that it will only use MIND THE GAP within the Roundel or in close proximity to the Roundel. In the event MIND THE GAP is used in close proximity to the Roundel, [the applicant] agrees that the Roundel shall have equal prominence to the words MIND THE GAP.

2.3 In relation to any further applications by [the applicant] in any jurisdiction which concerns products governed by clauses 1. 2 or 1. 3 herein, [the applicant] agrees that it will only apply to register marks consisting of or containing MIND THE GAP if those words appear within the Roundel.”

151. According to the opponent:

“The reasonable reader of the contract would have understood the parties’ use of “Clothing Accessory” to mean an item other than clothing that is used with clothing, to make it more useful, versatile, or attractive. For example, any item worn or carried to contribute an individual’s overall appearance would fall within that meaning.”

152. In my experience, ‘clothing accessories’ is usually understood to mean an item commonly bought to be worn or carried with matching or co-ordinating clothing to enhance the user’s overall aesthetic appeal.

153. The opponent submits that apart from *contact lenses* and *lenses* in class 9, and *trunks* and *hat boxes* in class 18, all the goods covered by the application are clothing accessories. Therefore, the application to register the words MIND THE GAP alone for most of the goods covered by the application is contrary to clause 2.3 of the agreement.

154. The applicant disputes that any of the goods covered by the application are 'clothing accessories' according to the natural meaning of that term at the time of the agreement.

155. It is convenient to examine the opponent's claims against the sub-groups of the goods to which it objects.

Clothing for pets in class 18

156. I do not accept that clothing for pets is an accessory to the clothing worn by the pet's owner. I accept the owner might carry the pet when dressed, but that does not make the pet's clothing (or the pet) an 'accessory' to the owner's clothing. I reject the opponent's submission.

Garment bags in class 18

157. I accept that garment bags are carried by a person wearing clothing. However, there is no evidence that garment bags are commonly bought to match or co-ordinate with the clothing the person wears whilst carrying the bag. I reject the opponent's submission.

Spectacles, eyeglasses, eyewear and frames, and cases and chains for the same, in class 9

158. The opponent claims these goods are clothing accessories *because "they can be chosen on the basis of e.g., their colour to complement an outfit."* In support of this submission the opponent relies on Mr Jacob's evidence to show that third party retailers and the applicant itself classify some of the goods at issue as clothing accessories.²⁵ The evidence about the applicant's public position on the matter comes from extracts from the online store of the London Transport Museum, which is connected to the applicant. According to Mr Jacob:

"These extracts show that the London Transport Museum considers at least the following goods to fall within the wider category of "clothing accessories": glasses cases, bags (including tote bags, backpacks, travel bags, folding

²⁵ See exhibits RMJ6 and 7

bags, and pouches) travel card wallets and holders, purses, umbrellas, laptop cases, toiletry bags, scarves, socks, ties, caps and knitted hats.”

159. The extracts from the online store of the London Transport Museum show that it has a section for ‘Clothing Accessories’ with five sub-categories; ‘Scarves’, ‘Socks’, ‘Accessories’, ‘Bags’ and ‘Travel Card Wallets and Essentials’. Scarves, socks, ties, caps, and knitted hats are clothing items. They are not included in the trade mark application. The few glasses cases shown on the website carry a map of the London Underground or colours associated with the Underground’s lines or London buses. None of the individual product descriptions describes them as clothing accessories and they are not shown in conjunction with matching items of clothing. Therefore, although I can attach some weight to the fact that the museum shop’s website groups the goods under clothing accessories, I do not find this evidence particularly convincing or decisive as to the objective meaning of ‘clothing accessories.’

160. The evidence from the websites of third-party retailers’ dates from 2024 and shows that:

- (i) Marks and Spencer classify sunglasses as ‘accessories’, but not specifically as clothing accessories.
- (ii) Mango classifies sunglasses as ‘accessories’, but not specifically as clothing accessories.
- (iii) New Look classify sunglasses as ‘men’s accessories’, but not specifically as clothing accessories.
- (iv) Next classify sunglasses as ‘men’s accessories’, but not specifically as clothing accessories.

I do not consider this evidence clearly shows that UK retailers consider sunglasses to be clothing accessories.

161. Looking at the factual background to the 2004 agreement, I note that recital A records that GAP had been selling, inter alia, jewellery, bags, and sunglasses. The description of clothing accessories in the agreement states that clothing accessories

shall include, as a minimum, jewellery and handbags. Whilst this is clearly not an exhaustive list, it would have been easy for the parties to have named sunglasses as another example of clothing accessories if this is what they intended.

162. Looking at the matter in the round, I am not satisfied that the parties intended sunglasses or glasses cases to be included in the term 'clothing accessories'. The argument for including spectacles, eyeglasses, and eyewear other than sunglasses, as well as frames and chains for such goods, is manifestly weaker and unsupported by any evidence. I therefore reject the opponent's submission that any of these goods are covered by clauses 1.3 and 2.3 of the agreement.

Rucksacks, shopping bags and wheeled shopping bags, in class 18

163. The extracts from the online store of the London Transport Museum show that the 'Bags' sub-category of the section for 'Clothing Accessories' includes backpacks and tote bags. A rucksack is a kind of backpack, and a tote bag can be used for shopping. The items in question bear decoration associated with the London Underground or London buses. None of the individual product descriptions describe them as clothing accessories and they are not shown in conjunction with matching items of clothing.

164. I note that the evidence from third party websites at exhibit RMJ7 also includes a couple of examples of retailers offering backpacks (The Range, Lululemon) and one instance of a retailer (Next) offering a shopping bag in the 'accessories' section of their websites.

165. I am not satisfied this establishes that rucksacks, shopping bags and wheeled shopping bags are commonly bought and sold as clothing accessories, or that the parties intended such goods to be covered by that term in the agreement. I therefore reject the opponent's submission that such goods are covered by clauses 1.3 and 2.3 of the agreement.

Helmets in class 9

166 The opponent submits that helmets can be chosen to complement e.g., sports clothing, for example cycling helmets and cycling clothing. However, there is no

evidence to this effect, and this is not a notorious fact. It is not clear the opponent even sold cycling clothing in 2004 or that it went on to do so. Therefore, the factual background does not support the opponent's interpretation of this term. I am not satisfied that the parties intended the term 'clothing accessories' to be construed so widely as to cover cycling helmets. I therefore reject the opponent's submission that such goods are covered by clauses 1.3 and 2.3 of the agreement.

Suitcases and travelling bags, document bags and cases, portfolios, briefcases, attaché cases, and music cases, in class 18

167. The opponent submits that suitcases include items such as small overnight suitcases chosen by a business traveller to complement their business attire. According to the opponent, portfolios, briefcases, attaché cases, and music cases (i.e., small document bags with one purpose of carrying sheet music) are also chosen to complement business attire. Therefore, these are all clothing accessories.

168. I reject this submission. There is no evidence that any of these items were commonly marketed or bought to complement business clothing in 2004, or that they are commonly bought on this basis today. I am not satisfied that the parties intended the term 'clothing accessories' to be construed so widely as to include suitcases, garment bags, and travelling bags, document bags and cases, portfolios, briefcases, or attaché cases. I therefore reject the opponent's submission that such goods are covered by clauses 1.3 and 2.3 of the agreement.

Canes, umbrellas, parasol covers, and walking sticks, in class 18

169. The opponent submits these are 'clothing accessories because "*they are chosen to match or complement the overall appearance of an outfit, for example because of their colour, pattern, ornamentation, or style.*"

170. The few umbrellas shown on the website of the London Transport Museum carry a map of the London Underground or colours associated with the London Underground's lines or London buses. None of the individual product descriptions describe them as clothing accessories and they are not shown in conjunction with matching items of clothing. Therefore, although I can attach some weight to the fact

that the applicant's museum shop appears to arrange the goods on its website under clothing accessories, I do not find this evidence particularly convincing or decisive as to the parties' intended meaning of 'clothing accessories.'

171. There is no evidence that canes, umbrellas, parasol covers, and walking sticks are commonly marketed or bought to match or co-ordinate with the user's clothing to enhance the user's overall aesthetic appeal. And this is not a notorious fact. I am not satisfied that the parties intended the term 'clothing accessories' to be construed so widely as to include these goods either. I therefore reject the opponent's submission that any of these goods are covered by clauses 1.3 and 2.3 of the agreement.

Cases for toiletry or cosmetic items, in class 18

172. The opponent submits that this description includes, for example, small clutch bags to complement evening wear. I disagree. The natural meaning of the description covers toiletry bags and/or vanity cases of the kind that usually go in a suitcase. Therefore, this submission is mis-conceived. I reject it.

Shoulder belts and shoulder straps, beach bags; sports bags; school bags; school satchels; slings and pouches for carrying infants, in class 18

173. There is no evidence that beach bags, sports bags, school bags, school satchels or slings and pouches for carrying infants, are commonly bought and sold as clothing accessories.

174. Shoulder belts and shoulder straps in class 18 are not items of clothing. They are not clothing accessories because they are not commonly bought and sold to enhance matching or co-ordinating clothing.

175. None of these goods are clothing accessories.

Card cases, key cases; purses and wallets; purses for travel cards and passes; purses for payment cards; wallets for travel cards and passes; wallets for payment cards; holders for payment cards, travel cards and travel passes, in class 18

176. There was some discussion at the hearing about whether the meaning of ‘clothing accessories’ should be assessed as at the date of the agreement in 2004 or the date of the application in 2021. The key issue is what the parties intended these words to mean in the 2004 agreement. The parties clearly recognised that the term ‘clothing accessories’ was ambiguous because they specified that “as a *minimum*” it covered jewellery and handbags. They left open the question of what else it covered. The agreement addresses the parties’ obligations going forward. Therefore, it is likely they meant the term to cover items that were, or would come to be, generally recognised as clothing accessories.

177. In paragraph 45 above I noted Ms Mahon’s evidence showing that large retailers and luxury brands sell purses and wallets, some of which appear to be designed to be seen when carried or worn by the user and are finished in such a way they could be used to match or co-ordinate with their clothing.²⁶ They are similar in nature and purpose (and, in some cases, appearance) to small ‘hand bags’, which are expressly identified as examples of ‘clothing accessories’ in the agreement. I therefore accept that purses and wallets are ‘clothing accessories’ for the purposes of the agreement. I find that applying to register the mark in relation to purses and wallets, including purses for travel cards and passes, purses for payment cards, wallets for travel cards and passes, and wallets for payment cards in the application, was contrary to clause 2.3.

178. What about card cases, key cases, holders for payment cards, travel cards and travel passes? The difference between, on the one hand, wallets, and purses and, on the other hand, card cases and holders for cards and passes, is elusive.²⁷ Therefore, including these goods in the application was also contrary to clause 2.3.

179. By contrast, key cases appear to be a different category of products. There is no evidence key cases are bought and sold as clothing accessories. Therefore, including such goods in the application did not contravene clause 2.3 of the agreement.

²⁶ See exhibit PM44, particularly page 13

²⁷ See exhibit RM7 at page 20

Was the application filed in bad faith to the extent it covered goods covered by clause 2.3 of the agreement?

180. There is no dispute as to the law on bad faith as it applies to this application. The case law has been summarised most recently by the Supreme Court in *Sky v Skykick*.²⁸ The relevant points are as follows:

(i) 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.

(ii) 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.

(iii) 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 with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties.

(iv) 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.

(v) 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.

(vi) 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.

²⁸ [2024] UKSC 36

181. There can be no doubt that making an application the applicant knows, or has reason to know, is in breach of an agreement with a third party is inconsistent with honest practices and potentially renders the application subject to refusal or invalidation on grounds of bad faith.²⁹

182. The applicant submits that even if it is “*wrong about being in breach of the agreement, it cannot possibly be said that its behaviour was not within the bounds of acceptable commercial behaviour. [The applicant] has (and had) multiple reasons... to believe that its application was legitimate and not a breach of the agreement.*”

183. One of the reasons advanced is that the applicant believed it had terminated the agreement in 2019. I do not consider the applicant had reasonable grounds for such a belief (if this is what it really believed). Firstly, the opponent’s lawyers had brought the relevant case law on termination of contracts to the applicant’s attention. It was tolerably clear from this case law that the opponent’s breach was not sufficient to justify termination. Secondly, the applicant obviously had its doubts as to whether it was free to use MIND THE GAP alone in relation to clothing because Ms Sankey’s evidence is that it continued to observe the terms of the agreement in this respect, even after it purported to terminate the agreement. Thirdly, the last communication between the parties about the purported termination was from the opponent explaining why the termination was ineffective. The applicant did nothing further to reject that argument. The applicant points out that the opponent did not apply to the court for a declaration that the termination was ineffective, but neither did the applicant apply for a declaration that it was.

184. Another reason put forward is that the applicant believed the agreement no longer covered the UK at the relevant date in 2021 because of Brexit. I do not consider the applicant had reasonable grounds for such a belief. I accept that wording of the agreement created some ambiguity in this respect post-Brexit. However, even if the wording has the effect contended for by the applicant it was, at the least, trying to exploit this technical exclusion of the UK to avoid the obligations it freely accepted in 2004 at a time when neither party could possibly have contemplated the future effect of Brexit. Therefore, if this was the reason the applicant thought the application was

²⁹ See paragraph 158 of the judgment of the Supreme Court in *Sky v Skykick*

not covered by the agreement, it was clearly acting against the spirit and purpose of the agreement, if not the letter.

185. In reality, I doubt the effect of Brexit on the geographical scope of the 2004 agreement was in the applicant's mind at all when the trade mark application was filed in 2021. Although Ms Sankey states this was the applicant's position at the date of her statement in 2024, she does not say this was a factor that affected the applicant's thinking in 2021. If it had been a factor, one would have expected it to have identified as such in the applicant's counterstatement filed in 2022. It was not mentioned at that time. Further, the 2021 UK application is a partial replacement for the EU trade mark application the applicant filed in 2018 when the UK was still a member of the EU. This makes it even less likely the UK's final exit from the EU at the end of 2020 motivated the applicant to make the current application.

186. Turning to the goods listed in the application, and specifically purses, wallets etc., the applicant makes the following points:

(i) Recital A records that the applicant was selling bags in 2004 and yet the wording of clause 1.3 shows the parties were making a distinction between bags and handbags, and deliberately limiting the effect of Clause 1.3 just to handbags.

(ii) The words "at a minimum" are so vague as to be useless in construing the agreement. Had the parties wished to cover all (or more kinds of) class 18 goods, they could easily have done so. Instead, it appears from the words of clause 1.3 they identified only the goods of interest to the opponent at the time.

(iii) Neither hand bags nor jewellery are found in the specification.

(iv) It is not possible to rely upon examples of how 'clothing accessories' may be used in 2024 to construe the agreement from 2004. There is no evidence of how the term might have been used in 2004 or to support an argument that there has been no change in the term's meaning since 2004.

187. I can take points (i) to (iii) together. I agree the words "*Clothing Accessories at a minimum shall include jewellery and handbags*" are vague. I do not accept this means

the words “*at a minimum*” should be disregarded. On the contrary, they indicate the clause covers more than jewellery and handbags. The applicant should have known this. The similarity between hand bags and purses and wallets should also have been apparent to the applicant. Further, although I do not regard the grouping of goods on the website of the London Transport Museum as in any way decisive of whether particular items are, or are not, generally understood as clothing accessories, the fact that the applicant’s museum shop arranges purses under the heading of clothing accessories makes it harder to accept the argument that it was entitled to believe that such goods were not covered by that term.

188. I dealt with point (iv) a paragraph 176 above. I accept that the words ‘clothing accessories’ has the same meaning it had in 2004 because there is no evidence the meaning of those words has changed. However, the date of the agreement does not mean the scope of the words was fixed at that point in time. The forward-looking aspects of the agreement indicate otherwise. This means the applicant was not permitted to register MIND THE GAP alone in relation to items that fell within the excluded term at the time of the trade mark application.

189. Ms Sankey also seeks to justify the applicant’s actions on the basis that it continued to grant licences for MIND THE GAP merchandise after the 2004 agreement, and the opponent has not complained about it. She also points to the long history and fame of the mark in relation to the London Underground and says MIND THE GAP works well as a brand in relation to all kinds of merchandise, including purses, wallets, and travel card holders. I note what Ms Sankey says, but there is no evidence showing MIND THE GAP in use in relation to these goods after the date of the 2004 agreement or at all. In these circumstances, no weight can be attached to the absence of complaints from the opponent about the applicant’s use of MIND THE GAP in relation to purses, wallets, and travel cards.

190. I note, once again, that the agreement does not prevent the applicant from using or registering the words at issue provided they are used or registered in conjunction with, or as part of, the London Underground roundel. I find the application to register the words alone was made in bad faith in relation to:

Purses and wallets, including purses for travel cards and passes, purses for payment cards; wallets for travel cards and passes, and wallets for payment cards; card cases and holders for cards and passes.

191. The bad faith ground fails in relation to the remaining goods covered by the application.

OVERALL RESULT

192. The opposition succeeds in relation to the goods specified in paragraph 190 above.

193. The mark will be registered in relation to:

Class 9: Contact lenses; spectacles, eyeglasses, eyewear and their frames, cases, chains, and lenses; helmets.

Class 18: Goods made of leather and imitations of leather, namely, shoulder belts and shoulder straps, suitcases, trunks, garment bags for travel, briefcases, card cases, canes, umbrellas and parasol covers; beach bags; sports bags; shopping bags and wheeled shopping bags; rucksacks; school bags; school satchels; portfolios; brief cases; document bags and cases; music cases; attaché cases; travel bags; trunks and travelling bags; suitcases; slings and pouches for carrying infants; hat boxes; key cases; cases for toiletry or cosmetic articles; umbrellas, parasols and walking sticks; clothing for pets

COSTS

194. The opponent submits it is entitled to off-scale costs for the work involved in filing evidence and making submissions to establish the use, reputation, and goodwill of GAP in relation to clothing. According to the opponent, such matters are common knowledge. It was, therefore, unreasonable for the applicant to require proof of these self-evident facts.

195. I note the applicant persisted in its request for proof of the reputation of GAP for clothing even after via a letter from the caseworker dated 7th October 2022, I asked it to reconsider whether its requests for proof of such use and reputation were justified.

196. Unreasonable behaviour can, in principle, justify an award of off-scale costs even where the party responsible is ultimately successful on the grounds concerned. My decision to reject the section 5(2), 5(3) and 5(4)(a) grounds does not, therefore, preclude the opponent from pursuing its request for off-scale costs.

197. The applicant also asks for its costs if the opposition fails.

198. Due to constraints on time, the issue of costs was not properly explored at the hearing. I therefore invite the parties to provide written submissions on the appropriate basis for an award of costs in the light of the above findings and the opponent's claim for off-scale costs in respect of the matters described in paragraph 194. If I am satisfied that either side is entitled to off-scale costs, I will request an appropriate breakdown of the relevant costs.

STATUS OF THIS DECISION

199. This is a final decision so far as the substantive matters are concerned. The period for appeal runs from the date shown below.

200. The parties have 28 days from the date shown below to provide written submissions on costs. I will issue a further decision on that matter in due course.

Dated this 6th day of January 2025

Allan James

Allan James
For the Registrar