

O-458-22

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3445882
IN THE NAME OF DOMU BRANDS LIMITED
IN RESPECT OF THE TRADE MARK**

BTFY

**IN CLASSES 3, 4, 5, 6, 8, 9, 11, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 30, 31, 32,
33, 35, 36, 40 AND 45**

AND

**IN THE MATTER OF AN APPLICATION FOR INVALIDATION THERETO
UNDER NO. 503511
BY TAMASU BUTTERFLY EUROPA GMBH**

Background and pleadings

1. The contested registration 3445882, in respect of the mark “BTFY”, was applied for on 21 November 2019 and registered on 7 February 2020. It stands in the name of Domu Brands Limited (“the proprietor”). It is registered in respect of goods and services in various classes.

2. On 22 December 2020, Tamasu Butterfly Europa GmbH (“the applicant”) applied to partially invalidate the registration on the basis of section 47, sections 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. In respect of the section 5(2)(b) and section 5(3) grounds, the applicant relies upon the following earlier EU mark¹:

EU 017932135

Butterfly

Filing date: 18 July 2018

Registration date: 13 December 2018

4. The applicant relies upon all the goods listed in this registration, namely:

Class 1: *Adhesives for use in industry; Size for finishing and priming; Adhesives for sports equipment.*

Class 3: *Cleaning preparations; Foam detergents; Cleaning preparations in the form of foams; Cleaning agent for sports equipment; Care products; Care products for sports equipment.*

¹ EU trade marks are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – see Tribunal Practice Notice 2/2020 for further information.

Class 18: *Bags; Rucksacks; Valises; Travelling trunks; Leather suitcases; Luggage, bags, wallets and other carriers; Leather and imitations of leather; Leathercloth*

Class 21: *Sponges; Drinking bottles; Drinking bottles for sports; Sponges for cleaning sports equipment; Brushes*

Class 24: *Towels of textile*

Class 25: *Clothing; Headgear; Footwear*

Class 28: *Toys, games, playthings and novelties; Sporting articles and equipment*

5. This ground is raised only against the following of the proprietor's goods:

Class 18: *Trunks and travelling bags; weekend bags; bags; handbags; beach bags; luggage; vanity cases, not fitted; mirrored vanity cases, not fitted; vanity boxes, not fitted; mirrored vanity boxes, not fitted; vanity cases sold empty; mirrored vanity cases sold empty; vanity boxes sold empty; mirrored vanity boxes sold empty; beauty cases [not fitted]; mirrored beauty cases [not fitted]; beauty boxes [not fitted]; mirrored beauty boxes [not fitted]; make-up boxes; mirrored make-up boxes; make-up cases; mirrored make-up cases; make-up bags sold empty; mirrored make-up bags sold empty; make-up carry cases; mirrored make-up carry cases; cases of leather or imitation leather; boxes of leather or imitation leather; cosmetic cases sold empty; mirrored cosmetic cases sold empty; cosmetic boxes sold empty; mirrored cosmetic boxes sold empty; leather and imitations of leather, and goods made of these materials and not included in other classes namely bags, briefcases, card cases, suitcases, handbags, wallets, purses, credit card holders, diary cases, hat boxes, key fobs, key cases, straps, luggage labels, note pad holders, sport bags; parts and fittings for all of the aforesaid goods.*

Class 24: *Textiles and textile goods; household textile articles; textile wall hangings; curtains; shower curtains; sheets [textile]; bed linen; bath linen; bed sheets; throws; blanket throws; bed throws; throws (furniture coverings); covers for cushions; towels; beach towels; blankets; lap rugs; travelling rugs.*

Class 25: *Clothing, footwear, headgear; waterproof clothing; sweatshirts; sweatpants; jackets; coats; fleeces; shirts; t-shirts; polo shirts; vests; singlets; blouses; knitwear; jerseys; jumpers; pullovers; sweaters; hooded tops; cardigans; waistcoats; suits; trousers; jeans; pants; shorts; leggings; skirts; ties; cravats; underwear; boxer shorts; briefs; thongs; lingerie; nightwear; pyjamas; night shirts; dressing gowns; bathrobes; beach clothes; swimwear; swim suits; bathing trunks; bathing caps; socks; gloves; mittens; scarves; ear muffs; wristbands; belts [clothing]; braces; aprons (clothing); uniforms; ready-made clothes linings (parts of clothing); shoes; boots; sandals; slippers; hats; caps; visors; headbands; articles of clothing, footwear and headgear for babies and children; bodysuits; romper suits; sleep suits; bibs; baby boots.*

Class 28: *Toys; games; playthings; gymnastic and sporting articles; toy figures, hand puppets, plush toys; soft toys, soft sculpted toy figures; jigsaw puzzles, board games; balloons; balls; dolls, doll accessories, doll's prams; clothes for dolls or soft toys; infant rattles; infant crib toys; mobiles; ride on toys; battery operated toys; toy vehicles; model vehicles; tricycles (playthings); playing cards; toy building blocks; soap bubbles; bubble-making wand and solution sets; kites; Christmas tree ornaments and decorations; party favours in the nature of small toys; novelties for parties, paper party hats; masks; masquerade and Halloween masks; play costumes; action figures and action figure accessories; plastic toys and plastic character toys; pool rings, bath toys, pool toys, water wings; water squirting toys; toy bake ware, toy cookware; toy tools, toy tool belts, toy hard hats; computer game apparatus; electronic games; games adapted for use with television receivers; electronic board games; musical games; hand-held electronic games and computer games; hand-held units for playing electronic games and video games; electronic games, not adapted for use with television receivers; bags specially adapted for handheld video games; protective carrying cases*

specially adapted for handheld video games; controllers for game consoles; joysticks for video games; confetti.

Class 35: *Retail services and online retail services all connected with the sale of ..., textiles and textile goods, clothing, footwear, headgear, ..., games and playthings, ...; information, advisory and consultancy services in relation to all of the aforesaid.*

6. The applicant claims that the signs are highly similar, stating that “BTFY” is a short form of “Butterfly”. It also claims that its mark benefits from an enhanced level of distinctive character and that the respective goods are identical and the services highly similar. It concludes that there is a likelihood of confusion.

7. In respect of the ground based upon section 5(3) the applicant claims a reputation in respect of *sporting articles and equipment* and that its mark is “very famous” and has an “extraordinary” reputation especially in table tennis. It also claims that “BTFY” is a short form of “Butterfly” that will often be used by customers leading to the public establishing a link between the respective signs. It asserts that:

- (i) use of the proprietor’s mark will take unfair advantage because “BTFY” will suggest a link with the applicant’s famous “Butterfly” mark. In the box relating to detriment to reputation, the applicant also makes a claim that there will be unfair advantage. It claims that because of the extent of its mark’s reputation, the relevant public will believe this is the applicant using a new sign and will result in the transfer of the high quality associated with the applicant. It also claims that the proprietor’s mark will benefit from the applicant’s investment in developing its reputation;
- (ii) Use of the proprietor’s mark will have a dilutive effect upon its mark.

7. The applicant also completed the box relating to “detriment to the reputation of the earlier mark” in the Form TM7 but the narrative provided all relates to a claim of unfair advantage and is detailed in paragraph 6(i) above. However, in respect to its narrative provided in response to Question 6 of the Form TM7 (regarding the basis for its claim relating detriment of distinctive character) the applicant claims that

“...the reputation ...will suffer ... especially since the quality of the goods ... is not the same”. This appears to relate to a claim to detriment to the reputation of its mark.

8. In respect of the ground based upon section 5(4)(a), the applicant relies upon the signs BTFY and BTY, claiming that they have been used throughout the UK since before 2010 in respect of sports equipment. Once again, it relies upon the claim that BTFY and BTY are short forms of “butterfly” and, therefore, claims that the signs are identical, leading to confusion. This ground is targeted against the following of the proprietor’s goods:

Class 18: Sports bags. This term is not included in the proprietor’s specification, and I proceed on the basis that it is targeted at broader terms that include “sports bags”, namely, *bags; ...; goods made of these materials [being leather and imitations of leather] and not included in other classes namely bags, ...*

Class 24: *towels*. The proprietor’s list of goods in this class also includes *textile goods; household textile articles* and *beach towels* but these terms have not been identified as being challenged under this ground.

Class 25: *Clothing, footwear, headgear; waterproof clothing; sweatshirts; sweatpants; jackets; coats; fleeces; shirts; t-shirts; polo shirts; vests; singlets; blouses; knitwear; jerseys; jumpers; pullovers; sweaters; hooded tops; cardigans; waistcoats; suits; trousers; jeans; pants; shorts; leggings; skirts; ties; cravats; underwear; boxer shorts; briefs; thongs; lingerie; nightwear; pyjamas; night shirts; dressing gowns; bathrobes; beach clothes; swimwear; swim suits; bathing trunks; bathing caps; socks; gloves; mittens; scarves; ear muffs; wristbands; belts [clothing]; braces; aprons (clothing); uniforms; ready-made clothes linings (parts of clothing); shoes; boots; sandals; slippers; hats; caps; visors; headbands; articles of clothing, footwear and headgear for babies and children; bodysuits; romper suits; sleep suits; bibs; baby boots*

Class 28: *Toys; games; playthings; gymnastic and sporting articles*. Similar to the claim against the proprietor’s Class 24 goods, other terms in the

specification fall under these broad terms but no claim is made against these specific goods.

9. The proprietor filed a counterstatement denying most of the applicant's claims and, in particular, it denies that BTFY and BTY are short forms of the word "butterfly" or that they will often be used by customers and puts the proprietor to proof of this. It admits the existence of the earlier mark and that some of the respective goods are identical or similar.

10. The parties did not request to be heard but they both filed written submissions that I will keep in mind, and I make my decision after careful consideration of the papers.

11. The applicant was represented in these proceedings by RDP Rohl Dehm & Partner mbB and the proprietor by Wilson Gunn.

Evidence

12. The applicant's evidence takes the form of a witness statement by Hans-Joachim Nolten, CFO at the applicant, and Attachments 1 - 14. Mr Nolten provides evidence relating to the background of the applicant, and the use of its earlier mark in the UK since at least 1979 in respect of goods in the field of the sport of table tennis. He also provides evidence to support the claim that "BTFY" and "BTY" are used as an abbreviation of "butterfly"

13. The proprietor's evidence is in the form of a witness statement (and exhibits KA-1 – KA-18) by Kerry Allen, trade mark attorney at Wilson Gunn Patent and Trade Mark Attorneys, the proprietor's representative in these proceedings. This addresses the claim that BTFY is short for "butterfly"

14. The applicant's reply evidence takes the form of a witness statement by Patrick Richnow (with Exhibits B1 – B5), trademark attorney at the applicant's representative, Rohl Dehm & Partner. The purpose of this evidence is to provide criticisms of the proprietor's evidence.

Statutory provision

15. Sections 5(2)(b), section 5(3) and section 5(4)(a) are all relevant in invalidation proceedings because of the following provisions set out in section 47 of the Act:

“47. (1) ...

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

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

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

16. Sections 47(2A) and 47(2G) relate to proof of use and, because the earlier mark in these proceedings has a filing date less than five years prior to the filing date of the contested mark, these do not apply here.

EU Case Law

17. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

Section 5(2)(b)

18. I find it convenient to firstly consider the grounds based upon section 5(2)(b) of the Act. This reads as follows:

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

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

19. Section 5A of the Act is as follows:

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

Comparison of goods

20. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

21. I do not intend to conduct a full comparison of the respective goods, but I proceed on the basis that at least some of the proprietor's Class 18, 24, 25 and 28 goods are self-evidently identical to some of the applicant's goods.

Comparison of marks

22. It is clear from *Sabel BV v Puma AG*, Case C-251/95 (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("the CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

23. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

24. The respective marks are shown below:

Applicant's earlier mark	Proprietor's mark
Butterfly	BTFY

25. The applicant's mark consists of a single word and there are no additional elements. Consequently, the word is the dominant and distinctive element of the mark. The proprietor's mark consists of the four letters BTFY. No one letter dominates and it is the combination of these letters that creates the distinctive component of the mark.

26. Visually, the applicant's mark presents as a single word. The proprietor's mark is presented in capital letters. The marks share some similarity in that all four letters that the proprietor's mark comprises all occur, in the same order, in the applicant's mark. The respective marks differ in that the applicant's mark presents as a single word and the proprietor's mark presents as four letters that do not obviously present as a word. Factoring these together, I conclude that the respective marks share a very low level of similarity.

27. The applicant's mark consists of the readily understood description of a winged insect and consists of the three syllables BUT-TER-FLY. The proprietor's mark consists of the four letters B, T, F and Y and forms the four syllables BEE-TEE-EFF-WHY. The applicant submits that the proprietor's mark is short for "butterfly". If this is correct, the respective marks will be aurally identical. In order to understand how the applicant's mark presents to the consumer in respect of its aural characteristics (and also its conceptual identity), it is necessary to consider both parties' evidence on these issues.

28. The applicant asserts that BTFY is a short version of butterfly and provides the following relevant evidence in support of this claim:

- Mr Nolten states that he knows that BTFY is an abbreviation of "Butterfly";²

² Mr Nolten's witness statement, para 11

- He exhibits the following Internet extracts:
 - An extract from an unknown website (but the copyright notice states “© 2005 – 2021 All Acronyms” and a statement that begins “Do you enjoy ALL Acronyms as much as we do?” and is undated. This extract includes the following:³

Butterfly Abbreviation

How to **abbreviate Butterfly**? 7 short forms of Butterfly. **Abbreviation for Butterfly**:

Q 14 Categories By Rating 🐦 🌐 ✉ 📄

👍 4 🗨️	Btrfly	Butterfly Insect
👍 3 🗨️	BTY	Butterfly Table Tennis, Ping-pong, Sports
👍 2 🗨️	BF	Butterfly Radiotherapy, Radiology, Medical
👍 2 🗨️	BUTFY	Butterfly Piping
👍 2 🗨️	FL	Butterfly Water Sports, Sport
👍 1 🗨️	BTFY	Butterfly Seafood
👍 0 🗨️	Fly	Butterfly Swimming

This appears to show a mixture of generic abbreviations (such as “Btrfly” as being an abbreviation for a type of “Insect”) and possible acronyms for proprietary names. It is possible that “BTY” reference is to an abbreviation for the applicant’s mark as indicated by the reference to “Table Tennis, Ping-pong, Sports”;

- A “Butterfly Jacket Kuma” offered for sale on www.tabletennis11.com where one of the customer reviews states “Very nice product. As with BFTY products, order a size bigger”. The extract is undated but was printed on “07.06.2021”;⁴

³ Attachment 10

⁴ Attachment 11, page 2

- An extract from MyTableTennis.NET consisting of a message board discussing “50% OFF BTFY XERO Tracksuit Brand New (L)”. The messages shown are dated in March 2018;⁵
- A discussion thread from www.tabletennisdaily.com, dated January 2015, discussing the merits of “butterfly alc blades” entitled “btfy alc: limba or koto?”;⁶
- Another discussion thread from the same website, dated in 2014, discussing the merits of “LF btfy innerforce AI or alc blade”;⁷
- A discussion about how to remove a “clear streak” from a “brand new BTFY table” that appeared on www.reddit.com. It is undated but printed on “07.06.2021”.⁸

29. In its written submissions, the applicant submits that BTFY is often used for its mark “Butterfly” and is an “official abbreviation” for “Butterfly”.

30. The proprietor submits that “a mere Google search with the term “BTFY” alone cannot have any significance for this cancellation process” because “trademark protection must always be linked to certain goods and services”.⁹ This is not strictly true, because evidence that the average consumer is likely to see “BTFY” as an abbreviation for “butterfly” may influence the level of conceptual similarity perceived by the average consumer (and also possibly aural similarity if, because, BTFY is perceived as “butterfly” it may also be referred to as “butterfly”). The proprietor also submits that the website www.allacronyms.com appears to be a community-driven database¹⁰ and points to its “About Us” section that indicates that visitors submit acronym definition suggestions to the editors and that “most” of these are published on the website.¹¹ Further, an Internet search for the company behind the website shows that it is based in Russia¹² and the website’s “Terms and Conditions” state that the terms of use of the website are governed by the laws of the State of

⁵ Ditto, pages 3 - 4

⁶ Ditto, pages 5 - 7

⁷ Ditto, pages 12 - 14

⁸ Ditto, page 15

⁹ Mr Richnow’s witness statement, para 4

¹⁰ Ms Allen’s, para 8

¹¹ See Exhibit KA-6

¹² Ms Allen’s witness statement, para 9 and Exhibit KA-7

Illinois.¹³ It is submitted that these two points suggest that the website is not UK based and cannot be relied upon.

31. The applicant submits that the website is the largest and most important community of acronyms, and it illustrates that the targeted public will inevitably fill in the missing letters. It also states that the links with Russia and Illinois are unproven, and the website can be relied upon. Regardless of the existence or otherwise of the Russian and Illinois links, it is not clear to me that the website is used by, or aimed at, consumers in the UK and, therefore, to what degree its content reflects the understanding of the UK consumer. Further, the fact that the website is community-driven adds further doubt as to the weight of this evidence.

32. Further, even if I accept that www.allacronyms.com is authoritative, it does not necessarily follow that an acronym that appears on the website will be known to the UK average consumer. The principle was considered by Ms Anna Carboni, sitting as the Appointed Person in *CHORKEE Trade Mark*¹⁴ when she commented that merely because a word appears in a dictionary does not mean that the average consumer is familiar with the word. I consider that this approach applies equally to acronyms. There are a small number of forum messages where “BTFY” is used to refer to the applicant’s “Butterfly” branded goods. This is informal use by just a few consumers and such evidence is too thin and lacking in information regarding how it may impact upon the UK consumer to be of any assistance to the applicant. In summary, I find that it fails to demonstrate that the UK average consumer will perceive the letters “BTFY” as a short version of “butterfly”.

33. I also reject the applicant’s claim that it is obvious that “BTFY” is an abbreviation of “butterfly” because of the similarity between the marks. If it were the case, any combination of letters that appeared in a dictionary word would be considered to “obviously” be a short version of the word itself. Notionally, the applicant’s argument cannot be correct and based on the evidence before me, it is also not correct in respect of the actual position of the perception of the UK consumer.

¹³ Ditto, para 10 and Exhibit KA-8

¹⁴ BL O/048/08

34. With the above finding in mind, the applicant's submissions that "BFTY" is a mere abbreviation of the term "butterfly" is rejected. As a consequence, I find that the letters "BTFY" will be seen merely as the four letters "B", "T", "F" and "Y" and will be expressed in that way. Further, beyond these four letters of the alphabet, there is no obvious concept conveyed to the consumer. I conclude that there is no, or an extremely low, level of aural similarity with the proprietor's mark and no conceptual similarity.

Average consumer and the purchasing act

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

36. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

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

37. The respective goods and services are wide ranging and include adhesives, cleaning preparations, bags, drinking bottles and sponges, towels, clothing, toys, games and sports articles and equipment and retail services of many of these goods. As submitted by the applicant, such goods and services are commonly purchased by

the general public but I also keep in mind that some goods may be targeted at business customers e.g. some sports equipment. They may be reasonably frequent purchases that will generally be selected from displays or shelves or the online equivalent. The purchasing act is likely to be visual in nature with the average consumer viewing the goods on display in shops or on online retail sites, however, I do not ignore that aural considerations may play a part in circumstances where, for example, enquiries are made to a sales assistant. The level of care and attention will be average.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

39. The applicant's mark consists of the readily understood dictionary word "Butterfly" and, consequently, it is not endowed with the highest level of distinctive character that an invented word may be endowed with. However, it has no obvious meaning in respect of the relevant goods and services and, as a result, is endowed with an average degree of inherent distinctive character.

40. The applicant submits that the distinctiveness of its mark is enhanced "especially in the context to table tennis the most important and famous brand in UK".¹⁵ The evidence relevant to this claim can be summarised as follows:

- The applicant was the sponsor of the Commonwealth Games and is the market leader in the sport of table tennis in the UK;
- It is also the official clothing supplier of the Table Tennis Teams of England, Wales and Scotland and also sponsors school championships such as the Butterfly National School Team Championship 2019 as illustrated on the tabletennisengland.co.uk website;¹⁶
- The tabletennisengland.co.uk website also lists under its "News" section, a number of articles in respect of events linked with Butterfly from as far back as 2012. There are 13 news items between 2012 and the relevant date in these proceedings, such as:¹⁷
 - "Butterfly Schools Individual Championships Review", dated 18 April 2012;
 - "Butterfly National Schools Team Finals results", dated 25 March 2013;
 - "Butterfly Schools Individual Championships results", dated 24 April 2013;
 - "Butterfly Cardiff GP entry extended", dated 2 December 2013;
 - "Butterfly Schools Individual Championships", dated 30 April 2014;
 - "New England kit revealed as Butterfly deal is signed", dated 5 February 2018;

¹⁵ The applicant's final written submissions, para 6

¹⁶ Mr Nolten's witness statement, para 1 and 14 and Attachment 13

¹⁷ Attachment 15, pages 3 - 6

- In 2020, the applicant’s turnover in the UK is stated as being €2,693 million;¹⁸
- The applicant was registered in the German commercial register in 1972;¹⁹
- An English language catalogue for the year 2020 is provided²⁰. The mark “Butterfly” appears prominently throughout. The categories of goods covered by this catalogue include blades (i.e. table tennis bats), apparel (sports wear), shoes (sports shoes) and socks, bags, suitcases, towels, table tennis equipment and accessories such as drinking bottles and cleaning products;
- The applicant has operated an online shop since 2011 under the domain name butterfly.tt.²¹ Goods are offered through this website “also to customers in UK” and it is stated that “it is possible and it happens that people from UK order goods at Butterfly.tt”.²² The language is English but the prices are shown in Euros;
- Information is provided about “Butterfly” on the websites Tee Sport and RSG Sport (partners of the applicant in the UK since 1979²³) and includes the following:²⁴

¹⁸ Ditto and para 10. No currency is indicated in the witness statement but it is in the applicant’s cover letter of 7 June 2021 received with its evidence

¹⁹ Ditto, para 4 and Attachment 3

²⁰ At Attachment 2 to Mr Nolten’s witness statement

²¹ Mr Nolten’s witness statement, para 6

²² Ditto

²³ Mr Nolten’s witness statement, para 7

²⁴ At Attachment 6

BUTTERFLY

The Butterfly brand was created by Tamasu Company of Tokyo in 1954. For the last 60 years Butterfly have been at the forefront of the development of top performance table tennis equipment and evidence of this is the vast list of Olympic, World, European and Commonwealth champions who have used and have recommend Butterfly products over that period.

The current World and Olympic Champion, Zhang Jike, uses Butterfly equipment.

In Britain too, Butterfly has been the leading brand for more than 30 years. Currently most of England's leading players use Butterfly equipment including England's No 1 and twice National Champion, Liam Pitchford and English Women's Champion, Jo Drinkhall. Most of the leading players from Scotland, Wales and Ireland also use Butterfly equipment as well as the vast majority of the top youngsters.

Butterfly table tennis tables are used for most of the leading events in the UK including the World Championships, European Championships, Commonwealth Championships and in 2014 for the Commonwealth Games in Glasgow. Both the English and Scottish National Championships were also played on Butterfly tables and with Butterfly balls in March 2014.

Butterfly are the official clothing suppliers to the English, Scottish, Welsh and Irish National Associations and to many of their top players. Butterfly provides the equipment for many events and competitions throughout Britain, including all the main events organised by the English Schools' Table Tennis Association and the British Table Tennis Association for People with a Disability. Butterfly is the main supplier for several major programmes, including the Greenhouse Schools Project and the iconic Bounce Club, both in London.

RSG have been the Butterfly distributors for the United Kingdom and Ireland since 1979

- A number of online shops sell, in the UK, Butterfly products such as table tennis equipment, bags, towels, flasks, footwear and clothing.²⁵ Extracts from the following websites (again, printed on "07.06.2021):²⁶
 - www.table-tennis-tables.co.uk selling "Butterfly Indoor Table Tennis Tables"²⁷ and priced in pounds;
 - www.ebay.co.uk offering for sale "Butterfly" branded table tennis bats;²⁸
 - www.amazon.co.uk also offering for sale "Butterfly" branded table tennis bats;²⁹
 - www.teessport.com selling "Butterfly" branded sports bags and table tennis bat cases,³⁰ table tennis shirts,³¹ table tennis shorts,³² table tennis skirts,³³ drinks bottles,³⁴ table tennis table covers,³⁵ table tennis towels,³⁶ and wristbands.³⁷ These are all priced in pounds

²⁵ Mr Nolten's witness statement, para 9

²⁶ At Attachment 8

²⁷ Ditto, pages 2 - 7

²⁸ Ditto, pages 9 - 10

²⁹ Ditto, pages 12 - 13

³⁰ Ditto, pages 15 – 19, 31

³¹ Ditto, pages 21 - 23

³² Ditto, page 22

³³ Ditto, page 23

³⁴ Ditto, pages 25 - 26

³⁵ Ditto, page 26

³⁶ Ditto, pages 29 - 31

³⁷ Ditto, page 31

41. There are a number of deficiencies in the evidence. Firstly, the only sales figure provided relates to 2020. The relevant date in these proceedings is the filing date of the contested registration, namely, 21 November 2019. Therefore, the turnover figure relates to a period after the relevant date. The same can be said for many of the exhibits, with the majority of the internet extracts being undated and obtained on 7 June 2021. In addition, the applicant's website, whilst it may have some UK customers is clearly not targeted at the UK as illustrated by the fact that prices are given in euros and not pounds.

42. However, I also note that there are third party websites selling "Butterfly" branded table tennis goods that are targeted at the UK consumer. Further, there is evidence that the "Butterfly" mark has been used in the UK since 1979 and that it has had a presence in the field of table tennis for a number of years. There is evidence of marketing activities, in the form of sponsorship of table tennis teams and events in the UK, dating back to 2012. The UK turnover figure for 2020 is very impressive if not further supported by invoices etc. Clearly, the applicant's mark has a presence in the UK as indicated by a number of sponsorship arrangements including providing clothing to the home nations table tennis teams and with its table tennis tables being used in a number of major international tournaments and games. The proprietor criticises the evidence for these reasons and concludes that there is no explanation how the "profit earned in the UK" is linked to the use of the earlier mark and, therefore, no conclusion can be drawn regarding enhanced distinctive character.

43. Taking all of the evidence into account, there is some lack of clarity as to the depth and extent of the applicant's mark's use in the UK. However, the extremely high turnover for the year 2020 suggests that there must have been a reasonable turnover in the years preceding and it is not likely that such high turnover occurred with no earlier build up and presence in the UK. This is borne out by the narrative evidence that makes reference to the mark's presence in the field of table tennis of many years in the UK. Therefore, despite not knowing turnover for the years prior to the relevant date, nor the breakdown of that turnover by goods, I conclude that the applicant's mark is endowed with a reasonably enhanced level of distinctive character in respect of at least some of the table tennis related goods shown in its 2020 catalogue. However, the evidence is too imprecise for me to conclude precisely

the level of enhancement or how such enhancement may be distributed amongst the applicant's goods.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

44. The following principles are obtained from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

45. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

46. I have found that:

- At least some of the respective goods are identical;
- The distinctive character of the applicant's mark resides in the single word "butterfly";
- The distinctive character of the proprietor's mark resides in the letters "BFTY";
- The respective marks share a very low level of visual similarity, no or a very low level of aural similarity and no conceptual similarity;
- The average consumer is the general public, and an average level of care and attention is involved in the purchasing process that is primarily visual in nature. However, I do not ignore that aural considerations may play a part in some instances;
- The inherent distinctive character of the earlier mark is average and although there appears to be some enhancement of this through use, it is not possible to ascertain the precise level of distribution of this.

47. There is also some limited evidence that appears to indicate that the applicant's own mark³⁸ is referred to by third parties as "BTFY" on a few online forums, namely:

- www.tabletennis11.com: a listing for a "Butterfly Jacket Kuma", that is marked as being discontinued and no longer available includes the following customer review, dated "14/03/2016": "Very nice product. As with BFTY products, order a size bigger";
- www.mytabletennis.net: an extract shows a sellers advert entitled "FS: 50% OFF BTFY XERO Tracksuit Brand New (L)". It is undated but the seller is recorded as having "joined" on "04/10/2017". The price is in euros;
- www.tabletennisdaily.com: an undated discussion as to preferences between two products is entitled: "btfy alc: limba or koto";
- www.tabletennisdaily.com: an undated discussion entitled "LF btfy Innerforce Al or alc blade". There appears to be a date that the poster joined the forum, namely, Nov 2018. This is after the relevant date;

³⁸ Attachment 11

- www.reddit.com: a photograph of a table tennis table is accompanied by the heading “Clear Streak on Brand New BTFY Table Advice. What Is It? How to Clean?”

48. As I noted at paragraph 32, this is informal use by a very small number of consumers and such evidence is too thin and lacking in information regarding how it may impact upon the UK consumer to be of any assistance to the applicant.

49. In its written submissions, the applicant submits that BTFY will be “ultimately pronounced BUTTERFLY” and points to the use of “DKNY” being used as short for “Donna Karan New York” or “YSL” being short for “Yves Saint Laurant”. I have already addressed the claim regarding the aural characteristics of “BTFY”. In respect of the reliance upon the abbreviations DKNY and YSL, these do not take the applicant’s case any further forward. There is nothing in the evidence regarding these abbreviations and how the average consumer perceives them. Secondly, there is nothing before me to show the status, as trade marks, of “DKNY” or “YSL”. Thirdly, they appear to be acronyms of multi word marks and are, therefore, different to the current circumstances where the applicant claims that “BTFY” is the shortened version of the single word “BUTTERFLY”.

50. Taking all of the above into account and also that I must keep in mind imperfect recollection because the consumer rarely encounters marks side by side, when the respective marks are used in respect of identical goods, the similarities between them are such that the average consumer is not likely to be confused. The evidence is insufficient to indicate that the UK consumer understands the letters “BTFY” to be a short version of the word “BUTTERFLY” and in the absence of such a conceptual link, the aural and visual similarities are insufficient for one mark to be confused for the other. I conclude that there is no likelihood of direct confusion.

51. In respect of imperfect recollection, I keep in mind *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

52. As I found that “BTFY” is not likely to be recognised as a short form of the “BUTTERFLY” it follows that the consumer will not assume that there is a link between the two marks such as they will assume that they originate from the same or linked undertaking. I conclude that there is no indirect confusion.

53. I add that, even in circumstances where I had found that the applicant’s mark benefitted from a good level of enhanced distinctive character, this would not have impacted upon this finding.

Section 5(3)

54. Section 5(3) states:

(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark,

(b) *Repealed*

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.

55. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *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) 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*.

(g) 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*.

(h) 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*.

(i) 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

56. The requirements under section 5(3), namely, that the earlier mark has a reputation, that there is a link between the respective marks such that use of the applicant's mark leads to an unfair advantage or detriment, are cumulative and the applicant can only succeed under this ground if its first demonstrates that it has the requisite reputation. The applicant claims that its mark's reputation is in respect of sporting articles and equipment. I have summarised the applicant's evidence at paragraph 40, above and the following evidence, detailed there, is also relevant to the question of reputation:

- The applicant was the sponsor of the Commonwealth Games and states that it is the market leader in the sport of table tennis in the UK;
- It is also the official clothing supplier of the Table Tennis Teams of England, Wales and Scotland and also sponsors school championships such as the Butterfly National School Team Championship 2019 as illustrated on the tabletennisengland.co.uk website;
- The applicant has sponsored a number of table tennis competitions in the UK between 2012 and 2018;
- In the first year after the relevant date, the applicant's turnover in the UK was €2,693 million;
- An English language catalogue for the year 2020 is provided showing use of the mark "Butterfly" in respect of blades (i.e. table tennis bats), apparel (sportswear), shoes (sports shoes) and socks, bags, suitcases, towels, table tennis equipment and accessories such as drinking bottles and cleaning products;
- Information is provided about "Butterfly" on the websites Tee Sport and RSG Sport (partners of the applicant in the UK since 1979³⁹), includes the following:

³⁹ Mr Nolten's witness statement, para 7

BUTTERFLY

The Butterfly brand was created by Tamasu Company of Tokyo in 1954. For the last 60 years Butterfly have been at the forefront of the development of top performance table tennis equipment and evidence of this is the vast list of Olympic, World, European and Commonwealth champions who have used and have recommend Butterfly products over that period.

The current World and Olympic Champion, Zhang Jike, uses Butterfly equipment.

In Britain too, Butterfly has been the leading brand for more than 30 years. Currently most of England's leading players use Butterfly equipment including England's No 1 and twice National Champion, Liam Pitchford and English Women's Champion, Jo Drinkhall. Most of the leading players from Scotland, Wales and Ireland also use Butterfly equipment as well as the vast majority of the top youngsters.

Butterfly table tennis tables are used for most of the leading events in the UK including the World Championships, European Championships, Commonwealth Championships and in 2014 for the Commonwealth Games in Glasgow. Both the English and Scottish National Championships were also played on Butterfly tables and with Butterfly balls in March 2014.

Butterfly are the official clothing suppliers to the English, Scottish, Welsh and Irish National Associations and to many of their top players. Butterfly provides the equipment for many events and competitions throughout Britain, including all the main events organised by the English Schools' Table Tennis Association and the British Table Tennis Association for People with a Disability. Butterfly is the main supplier for several major programmes, including the Greenhouse Schools Project and the iconic Bounce Club, both in London.

RSG have been the Butterfly distributors for the United Kingdom and Ireland since 1979

- A number of online shops sell, in the UK, Butterfly products such as table tennis equipment, bags, towels, flasks, footwear and clothing.

57. The earlier mark relied upon is an EU mark and reputation in the EU is required. There is a brochure where the applicant's goods are priced in euros, but this is insufficient on its own to illustrate the requisite reputation of its mark in the EU. The requisite reputation of an EU mark must be established in a substantial part of the EU, however, when assessing such a reputation (up to the UK's departure on 31 December 2020), the UK is a substantial part.⁴⁰

58. I keep in mind my analysis of the evidence at paragraphs 41 – 43, above and the deficiencies I identified there. However, the evidence does illustrate that the applicant's mark has been used for a long period of time in the UK. This use has been wholly in respect of goods linked to the sport of table tennis and has been promoted through sponsorship of top-level competitions including the Commonwealth Games and as kit provider for four of the home nation's table tennis teams. Further, whilst likely to be of a lower impact, it has also sponsored various school competitions. Its 2020 catalogue shows that it provides a range of goods (see fifth bullet point in paragraph 56 above) roughly equating to the applicant's claims. Whilst this catalogue is from the year AFTER the relevant date, when considered

⁴⁰ *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), para 76

together with the rest of the evidence, it indicates that there was use prior to the relevant date.

59. Whilst the numerical scale of the business is not indicated for any period prior to the relevant date, the high level of UK sales declared for 2020, the extent of the goods listed in the 2020 catalogue, the sponsorship of high-visibility events such as the Commonwealth Games all point to a strong UK presence in the field of table tennis prior to the relevant date. I conclude that the use is sufficient to demonstrate that the applicant has the requisite reputation in the UK at least in respect of the goods listed in the fifth bullet point, above. The scope of the applicant's mark's reputation in the EU is less clear with only a brochure priced in Euros. It is difficult to ascertain the scale of use in that territory but the use in the UK is sufficient to demonstrate a reputation in a substantial part of the EU.

60. In summary, I consider that the evidence demonstrates that it has reputation sufficient for the purposes of basing an action under section 5(3) of the Act in respect of a range of goods that cannot be completed isolated from the complete list relied upon (see my comments at paragraph 43).

61. Having found that the evidence establishes the requisite reputation, I consider whether the whether a link is established between the respective marks.

Link

62. It is necessary for the relevant public, when confronted with the later mark, to make a link with the earlier reputed mark and this includes the bringing to mind the earlier mark. Whether such a link exists must be assessed globally taking account of all relevant factors. These factors include:

Degree of similarity between the respective marks

63. Earlier, I found that the applicant's mark shares a very low level of visual similarity, no or only a very low level of aural similarity and no conceptual similarity.

Degree of similarity between the goods/services

64. I have found at least some of the respective goods to be identical.

The extent of the overlap between the relevant consumers for those goods/services

66. Having acknowledged that some goods/services are identical, it follows that the relevant consumers will be the same.

The strength of the earlier mark's reputation and distinctiveness

67. I have concluded that the applicant's earlier mark has an average level of distinctive character and that this has been enhanced through use. I have also concluded that the applicant's mark has a reputation. In both cases, the deficiencies in the evidence impact upon the ability to assess the full extent of reputation/enhancement to distinctiveness because of the absence of numerical information for the period prior to the relevant date.

68. Taking all of the above into account, including that some of the respective goods are identical, the differences between the respective marks far outweigh the similarities and, as a consequence, not only will the relevant consumer not be confused but neither will they perceive any link between the respective marks. The evidence falls a long way short of demonstrating that the letters "BTFY" will be perceived as a short version of "Butterfly" and, in the circumstances, I conclude that the requisite link will not be established.

69. In the absence of the requisite link, the section 5(3) ground fails, and it is not necessary to consider the claims regarding detriment and unfair advantage.

70. I add that, even in circumstances where the evidence illustrated, with more certainty, the precise level of reputation, this would not have impacted upon this finding.

Section 5(4)(a)

71. Section 5(4)(a) states:

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

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

(aa) [...]

(b) [...]

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

72. Subsection (4A) of Section 5 states:

“(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.”

73. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, 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)."

74. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

75. The applicant relies upon the signs “BFTY” and “BTY”. Firstly, it must demonstrate that it has the requisite goodwill at the filing date of the contested registration, namely, 21 November 2019.

76. It relies upon the use of the term “BFTY” by consumers of the applicant’s goods in several online forums. I have already discussed this evidence in the context of enhanced distinctive character and the deficiencies identified there apply equally to the assessment of goodwill. There is no evidence illustrating the scale, if any, of use by the applicant of the sign “BFTY”. The evidence from the online forums is clearly very thin and wholly inadequate to demonstrate that the applicant has the requisite goodwill identified by the sign “BTFY”.

77. In respect of the sign “BTY”, the evidence in support of this indicating the goodwill of the applicant is confined to the following:

- an extract from the forum on the website www.tabletennisdaily.com where a message appears entitled “BTY Viscaria with Tenergy 05 – best price UK”. The messenger is seeking what retailer offers the best price in the UK for these items. The extract is undated but there is a date of “Apr 2021” that appears to be the date the messenger joined the forum;
- an extract from www.amazon.co.uk that lists a “Butterfly BTY CS 1000 Table Tennis Racket – Chinese Penfold Ping Pong Paddle – ITTF Approved”. Under the heading “About this Item” the text includes “The BTY CS series from

Butterfly is designed for the developing recreational player preferring a pen hold grip”.

78. The first of these shows informal use by an individual and not use by the applicant. Further, the only date visible appears to show that the messenger joined the forum after the relevant date in these proceedings. It is not evidence that the applicant’s goodwill is under the sign “BTY”. The second extract appears to show BTY being used as a secondary sign to identify a specific model of table tennis bat, however, this one example falls far short of demonstrating that the applicant’s goodwill, to whatever extent that that may exist, is identified by the sign “BTY”. I conclude that the applicant does not have the requisite goodwill identified by the sign “BTY”.

79. In the absence of the requisite goodwill, it is not necessary that I consider the issue of misrepresentation and damage. The ground based upon section 5(4)(a)

Summary

80. The invalidation application has failed in respect of all three ground and the proprietor’s mark remains validly registered.

COSTS

81. The applicant has been successful and is entitled to a contribution towards its costs in accordance with the scale of costs published in Tribunal Practice Notice 2/2016. In the circumstances I award the applicant the sum of £2050 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the Form TM26(l) and preparing the counterstatement:	£450
Considering other side’s evidence and preparing evidence:	£1200
Preparing and filing submissions in lieu of a hearing:	£400

Total:

£2050

82. I therefore order Tamasu Butterfly Europa GmbH to pay Domu Brands Limited the sum of £2050. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of May 2022

**Mark Bryant
For the Registrar**