

O-377-14

**IN THE MATTER OF REGISTRATION NO. 3006585
OF THE TRADE MARK**



IN CLASSES 25, 28 AND 41

IN THE NAME OF TOP THRONE LTD

AND

**THE APPLICATION FOR A
DECLARATION OF INVALIDITY THERETO
UNDER NO. 500173**

BY BOI TRADING COMPANY LTD

Background and pleadings

1. Top Throne Ltd (“Throne”) is the proprietor of trade mark registration number 3006585 for the mark shown below:



2. The mark was applied for on 19 May 2013 and its registration process was completed on 6 September 2013. On 2 October 2013, Boi Trading Company (“Boi”) filed an application for a declaration of invalidity against the registration under section 47(2) of the Trade Marks Act 1994 (“the Act”) in respect of the goods registered in class 25. Boi claims that the registration should be declared invalid as it was registered in contravention of section 5(2)(b) of the Act. The goods attacked are:

Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing, footwear, headgear; Clothing for martial arts; Clothing made of leather; Body warmers [clothing]; Denims [clothing]; Clothing for martial arts; Martial arts uniforms.

3. Section 5(2)(b) of the Act states that:

“(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.”

4. Boi bases its claim upon its earlier trade mark registration (number 2332417) for the mark EKO, which completed its registration process on 31 October 2003. EKO is registered for clothing. Since it had been registered for more than five years on the date on which Boi applied to invalidate Throne’s registration, the earlier mark is subject to proof of genuine use, as per sub-sections 2A to 2E of section 47 of the Act. In its notice of defence, Throne requested that Boi prove use of its mark.

5. Boi claims that the registered mark is similar to the earlier mark and is registered for identical or highly similar goods, which would lead to a likelihood of confusion.

6. Throne filed a counterstatement which, in addition to putting Boi to proof of use, denies the ground brought against its registration. Throne, which represents itself in these proceedings, has not filed any evidence or submissions, and I reproduce here its counterstatement in full:

Counter Statement

Please allow me to address each of the applicants grounds for filing the opposition:

1. The Mark of the subject registration primarily consists of the phrase EIKO in a stylised form. The most prominent element within the composite Mark of the Registered Proprietor are these four letters. The earlier Mark of the Applicant for Invalidity consists solely of the letters EKO in plain script. The Mark of UK Trade Mark registration number 3006585 consists of a four letter phrase which contains all three of the letters in the Mark EKO of the Applicant for Invalidity.

Firstly the mark for registration number 3006585 consists of a stylised 4 letter word, EIKÖ. It is important to note that this is in-fact clearly a word, and is actually the phonetic translation of the Japanese word for Glory. As the applicant points out, the previous trademark (2332417) is not a word and is 3 letters in plain text. The applicant states that the most prominent element within the composite mark are the four letters. However, as the description of the mark notes, 3006585 is Styles+logo, and the most prominent element is the combination of all the elements in that particular set up. The important letter being the final Ö which includes an accent. In the case of the actual mark, the Ö is in fact heavily stylised in the shape of an Octagon, with the accents being represented by two Japanese characters (栄光). This gives the mark a clear distinct visual image that is clearly distinguishable from plain script letters of the previous mark.

2. The Mark EIKO and the Mark EKO are phonetically similar to one another as they are likely to be pronounced in a similar manner to one another given that all three of the letters "EKO" of the Applicant for Invalidity's Mark are in the Mark of the Registered Proprietor with only the letter "I" separating the "E" from the letters "KO".

We dispute the two being phonetically similar on the basis that the earlier mark consists of only three letters, EKO all in upper case and in plain script. Therefore, we believe it is actually more likely to be seen as three separate letters and pronounced as such - E,K,O. Due to EIKÖ's inclusion of the accented letter and it consisting of 4 letters and not 3 (3 being more commonly used for acronym type marks), people will not likely think that EIKÖ is an acronym and will know it is a word. And, as previously stated, 3006585 is the phonetic spelling of the word Glory in Japanese and in actual fact, its pronunciation is closer to "A-co" (<http://translate.google.com/#auto/ja/glory>). If you compare this to the three letters of EKO and its phonetic sound of "E-Kay-O" we see the marks as clearly distinguishable phonetically.

3. The Marks EIKO and EKO are visually similar to one another to the extent that they both contain the identical letters EKO.

As previously stated, due to 3006585 being a Stylised+logo, although the two marks contain the characters, the combination of the accent made of Japanese characters and the use of the Octagon along with this character being in red - overall the marks are clearly distinguishable from each other.

4. The Marks EIKO and EKO are conceptually neutral having no obvious meaning in the context of goods in Class 25 for which both Marks are registered.

EKO is neutral however 3006585 is clearly not conceptually neutral. The mark as it is registered, contains both English and Japanese characters, an octagon and two colours. Although it may not be obvious what this actually means to someone on first glance, it will be clear that it does mean something, and is far from conceptually neutral. In truth the brand is focused on Mixed Martial Arts and the symbols mean Glory, the Octagon 'O' is representing the shape of the arena in which MMA takes place. The mark would therefore take this meaning into the sector for goods in Class 25, where EKO as a plain script mark takes no meaning, or inference of there being an unknown meaning what so ever.

The applicants final two marks are reliant on the above first 4 marks standing. As we disagree with the first 4 points as explained above, we do not see there being any risk of confusion between the two marks and certainly no risk of any association being made between a plain scrip 3 letter acronym and a 4 letter word in the form of a stylised logo.

James Hanson



Top Throne Ltd
Co-Owner

7. Neither side asked for a hearing. Boi filed evidence and written submissions in lieu of a hearing; Throne chose not to file evidence or submissions. I make this decision after a careful reading of all the papers before me.

Material dates

8. The relevant part of Section 47 of the Act states:

“47.—

.....

(2) 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.

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

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

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

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

.....

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

9. The earlier mark completed its registration procedure on 31 October 2003. The relevant dates for considering proof of use of Boi’s mark span the five year period ending on the date of the application for a declaration of invalidity: 3 October 2008 to 2 October 2013.

10. The date of Throne’s application for registration, 19 May 2013, is the relevant date for assessing the claim under section 5(2)(b) of the Act.

Evidence

11. Boi’s evidence comes from Diane Bellamy, its Managing Director. She has provided two witness statements with exhibits. Ms Bellamy states that the EKO brand was first developed in 2002 for a range of young male casual clothing. Boi sells wholesale to retailers, not directly to the public. She states that its customers are high street names such as Matalan, Officers Club and Blue Inc, although she makes this statement in relation to Boi’s customers, not specifically in relation to the mark EKO. Ms Bellamy states that the mark has been used “on clothing items such as T-shirts, sweatshirts, jackets, body warmers, gilets, shirts, sweatshirts, pants [trousers] and jeans”. Ms Bellamy attaches at exhibit DB1 design sheets from her company’s records which bear copyright dates. She points out that EKO is typically featured on the garments, such as on the front and the sleeves, as well as the inside neck tag. She states that the EKO logo was reproduced on swing tags. Design sheets for swing tags for the Spring/Summer 2013 collection are included in the exhibit.

12. Turnover figures are given, which Ms Bellamy states are for products sold under the EKO mark:

YEAR	TURNOVER BY CASH	TURNOVER BY UNITS
2009	£60,110	17,200
2010	£54,306	15,000
2011	£64,498	24,400
2012	£28,908	10,200
2013	£65,440	18,200

13. Exhibit DB2 contains copy invoices. Ms Bellamy states:

“My company’s trademarks and brand names are not featured on the invoices themselves, but the majority of the products sold in each batch of invoices can easily be cross-referenced back to the original design drawings, examples which have already been filed as Exhibit DB1 in these proceedings...”

Ms Bellamy provides a list of the items she states can be cross-referenced, which I have reproduced below, together with my comments in italics about the items:

Exhibit DB2

Exhibit DB1

- Page 2 – invoice for DJ YEAH vest

see design sheet on page 6 of Exhibit DB1

Invoice dated in 2009, with same reference number, B26771, as appears on the design sheet, which is for a long sleeved top. The word ‘eko’ can be seen on the sleeve. The sale was for 1200 tops at a cost of £2,772.

- Page 4 – invoice for Boys Full-Zip Sweat

see design on page 14 of Exhibit DB1

Reference number B26779. It is not possible to see the mark, other than heavily stylised, although I note that the design sheet specifies neck label JS001, which is shown below. This does show the mark EKO in ordinary script (along with other matter). The invoice is dated in 2009, to a customer at the same address as the applicant, for £4,752.

- Page 5 – invoice for Boys Pumpkin Spray Tatt

see design on Page 18 of Exhibit DB1

Reference number B26712. The word ‘eko’ can be seen on the sleeve of a long sleeved top for boys. Invoice dated in 2010 for £1764.

- Page 6 – invoice for Boys Ripstop Pant see design on Page 16 of Exhibit DB1

Reference number B23353. It is not possible to see the mark on the garment and there are no exhibits showing what the waist label looks like. Invoice to a customer in Lurgan, dated in 2010, for £5,364.

- Page 7 – invoice for hooded sweat with DJ YEAH see design on Page 24 of Exhibit DB1

Reference number B26716. The word 'eko' can be seen on the sleeve of a sweat top for boys. The invoice is dated in 2010, to a customer at the same address as the applicant, for £5,880.

- Page 8 – invoice for Boys tee with Skull & Cross see design on page 37 of Exhibit DB1

Reference number B27706. It is not possible to see the mark, although I note that the design sheet specifies neck label JS001, which is shown below. This does show the mark EKO in ordinary script (along with other matter). The invoice is dated in 2011 for £3,510.

- Page 9 – invoice for Boys full length Cargo Pants see design on page 30 of Exhibit DB1

Reference number B23356. The word 'eko' can be seen on the leg of the jeans. The invoice is dated in 2011, to a customer in Lurgan.

- Page 10 – invoice for Boys tee with Face Flat tatt see design on Page 43 of Exhibit DB1

Reference number B27712. 'Eko' can be seen on the front of the t-shirt and the design sheet specifies neck label JS001, which is shown below. This shows the mark EKO in ordinary script (along with other matter). The invoice is dated in 2011, to a customer at the same address as the applicant, for £2,340.

- Page 12 – invoice for Boys sweat – destroy see design on Page 51 of Exhibit DB1

Reference number B26013. EKO can be seen on the front of the garment. The invoice is dated in 2012, for £5,484, to a customer in Lurgan.

- Page 13 – invoice for Boys tee see design on Pages 53-58 of Exhibit DB1

Reference number B27098, which appears on page 58. EKO is heavily stylised, on the t-shirt and on the neck label.

- Page 15 – invoice for Men’s hoody – rolls

see designs on Pages
62-34 of Exhibit DB1

Reference RSE103214, which appears on page 64. EKO appears as part of a slogan beneath larger graphics: “EKO. NAILING IT SINCE WAY BACK WHEN”. The invoice is to a customer in Lurgan, for £4,608, dated 14 June 2013. Page 14 of the invoices also corresponds to a t-shirt with the same design. Unlike the rest of the evidence which all relates to clothing for boys, these items are for men (indicated by the nature of the graphics and sizing).

Neck label JS001:

Neck label JS583:



Proof of genuine use of EKO

14. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"

15. The onus is upon the applicant to prove use of its mark, because Section 100 of the Act states:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

16. The correct approach to assessing the applicant's collection of exhibits and the witness statements is to view the picture as a whole, including whether individual exhibits corroborate each other. In Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v Office for Harmonisation of the Internal Market (OHIM)*, in relation to the need to get a sense from the overall picture of the evidence, notwithstanding that individual pieces may not, of themselves, be compelling, the General Court ("GC") said:

"53 In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07 P *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36)."¹

17. I also bear in mind that the genuine use provision is not there to assess economic success or large-scale commercial use, as long as it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. An assessment as to whether there has been real commercial exploitation therefore includes consideration as to the nature of the goods and the characteristics of the market concerned.

18. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd* ('CATWALK'), BL O/404/13, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or

¹ See also the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person in *Brandconcern BV v Scooters India Limited* ("Lambretta") BL O/065/14, referring to this case from the GC.

her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

In that case, the evidence provided included design drawings for internal use, of the type also exhibited in the current proceedings. This was criticised for lack of corroboration with other exhibits; amongst the criticisms was that the invoices contained no product codes which could be matched to the design drawings. In the current proceedings, the codes in the invoices do match those in the drawings in exhibit DB1. An explanation is given for the business model, in that sales are made wholesale, not to the public. This may explain why there are few locations given in the invoices. I have pointed out that some of the invoices appear to be made out to a company at the same address as Boi, although others are not. There is no explanation for this, but it may be that the address, which is units 1-6, The Euro Centre, Bury New Road, Manchester, houses several businesses. In any case, this has not been challenged by Throne and I should not disbelieve it since it is not incredible.

19. In Boi's favour is the spread of dates of its invoices, indicating frequent and regular trade². Throughout the invoices, the product codes can be matched to the designs in exhibit DB1, which have copyright dates which correspond to the dates of the invoices. In the current proceedings, an officer of the company, who is in a position to know of the use which has been made of EKO, has given evidence. Her evidence is that EKO is typically featured on garments, such as on the front and on sleeves. I can see this from B26771, page 2 of the invoices, from B26712, page 5 of the invoices, from B26716, page 7 of the invoices, from B23356, page 9 of the invoices, from B27712, page 10 of the invoices, from B26013, page 12 of the invoices, and from RSE103214, page 15 of the invoices. Ms Bellamy also states that EKO features on neck tags. As highlighted in my analysis of her cross-references, sometimes the design of EKO on the garment is heavily stylised, beyond that which would be an acceptable variant under section 47(2C) of the Act. However, the design pages for these garments specify which neck labels are to be used. Neck labels are a common way to identify the trade origin of clothing. In the

² *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-234/06 P.

case of item B26779, page 4 of the invoices, B27706, page 8 of the invoices and B27712, page 10 of the invoices, the neck label specified is JS001:



20. This brings me to consider the configuration of the sign used. EKO, as it appears on the neck label shown immediately above, is represented in an ordinary font; certainly, it is within the bounds acceptable by registration of a mark in block capitals so as to cover representations which are clearly the same word, in ordinary fonts. It is true that the mark appears with other matter: the device and the word Industries. Section 47(2B) states that the use conditions are met if the earlier trade mark has been put to genuine use...in relation to the goods or services for which it is registered. The registered mark itself, as shown in the neck label is unaltered. There is no need to move on to consider whether the form used is an acceptable variant because the form used is the mark as registered, because it is in an ordinary font, notionally covered by registration in capital letters. The other matter with EKO is separate to EKO. This conclusion is supported by the CJEU's ruling³ in Case C-252/12, *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd, Specsavers Optical Superstores Ltd v Asda Stores Ltd*:

“22. For a trade mark to possess distinctive character for the purposes of Regulation No 207/2009, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (see, to that effect, Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* [2004] ECR I-5141, paragraph 32; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-311/11 P *Smart Technologies v OHIM* [2012] ECR I-0000, paragraph 23).

23. That distinctive character of a registered trade mark may be the result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service at issue as

³ See also the CJEU's ruling in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12.

originating from a given undertaking (see, by analogy, Case C-353/03 Nestlé [2005] ECR I-6135, paragraph 30).”

21. I accept that EKO has been used by Boi but I note that the amounts shown in the invoices and the turnover figures given by Ms Bellamy are small in the context of the enormous UK clothing market. In *Reber Holding GmbH & Co KG v Office for Harmonisation in the Internal Market (OHIM)*, Case C-141/13, the evidence showed use only on handmade chocolates, in one small town, in one café. The quantity sold each year amounted to between 40 and 50kg. The CJEU ruled that this amount, with the lack of geographical spread of sales, was too little for the purposes of preserving or creating a market share in chocolates, given that the size of the chocolate market in Germany is substantial. The way in which the chocolates were sold was only through visiting the café, not as a standalone product commensurate with creating or preserving a share in the chocolate market. I bear in mind that I need to consider all the circumstances of the case. Although the amounts of clothing sold is tiny viewed against the vast UK clothing market, there are all sizes of operation, a multitude of operators and an almost innumerable amount of brands and sub-brands in that market. I also bear in mind that the geographical spread of customers shown on the invoices is restricted (Manchester and Lurgan, Northern Ireland); however, the goods are sold wholesale for onward distribution, so this is not a factor which necessarily counts against Boi, unlike the German café selling chocolates from only one location.

22. Taking all the evidence in the round, together with the nature of the market and the goods, I consider that Boi’s sales are on a small scale but they are real. Genuine use has been made of EKO. The next step is to decide whether the extent of that use entitles Boi to rely upon its registered specification of clothing, which encompasses all types of clothing. I am clear that Boi is not entitled to rely upon such a wide term and that I need to frame a fair specification.

23. Mr Justice Arnold, in *Stichting*, reviewed the law in relation to framing fair specifications:

53 Partial revocation: substantive aspects. It is often the case that the trade mark proprietor has made genuine use of the trade mark in relation to some goods or services covered by the specification, but not others. In these circumstances art.51(2) of the Regulation (corresponding to art.13 of the Directive) requires the competent authority only to revoke the trade mark to the extent that it has not been genuinely used. This can lead to difficulties where the trade mark is registered in respect of a broad class of goods or services, but the proprietor has only established use of a narrower sub-class within that broad class.

54 As the Court of First Instance (now the General Court) held in *Reckitt Benckiser (España) SL v OHIM (ALADIN) (T-126/03) [2005] E.C.R. II-2861; [2006] E.T.M.R. 50:*

“45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently

broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

55 In *NIRVANA Trade Mark* (BL O/262/06), when sitting as the Appointed Person, I reviewed the decisions of the English courts in *MINERVA Trade Mark* [2000] F.S.R. 734; [2001] E.T.M.R. 92 ; *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] R.P.C. 17; [2001] E.T.M.R. 46 ; *DaimlerChrysler AG v Alavi* [2001] R.P.C. 42; [2001] E.T.M.R. 98 ; *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2002] EWCA Civ 1828; [2003] R.P.C. 32 ; *West (t/a Eastenders) v Fuller Smith & Turner Plc* [2003] EWCA Civ 48; [2003] F.S.R. 44 ; *Associated Newspapers Ltd v Express Newspapers* [2003] EWHC 1322 (Ch); [2003] F.S.R. 51 and *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] F.S.R. 19 . I concluded at [57] that these were broadly consistent with *ALADIN* , but that to the extent there was a difference I was bounded by the English authorities. I went on:

I derive the following propositions from the case law reviewed above:

- (1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

- (2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].
- (3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].
- (4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].
- (5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].
- (6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].
- (7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].
- (8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

59. I would add a point which in my judgment is implicit in most of the decisions, although not explicit, which is that it is for the tribunal to frame a fair specification and not the parties. This is not to say, however, that the tribunal is either obliged or entitled to ignore considerations of procedural justice and efficiency: see the observations of Advocate General Sharpston in *BVBA Management, Training en Consultancy v Benelux-Merkenbureau (C-239/05) [2006] E.C.R. I-1458* at [62]–[68] ...”

56 In *Pan World Brands Ltd v Tripp Ltd (EXTREME Trade Mark) [2008] R.P.C. 2* , again sitting as the Appointed Person, I considered the decision of the CFI in *Mundipharma AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (T-256/04) [2007] E.C.R. II-449* and continued as follows:

“54. Although at first blush this suggests an approach which is somewhat different to that laid down by the English authorities considered in *NIRVANA* , I consider that the difference is smaller than might appear. The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used. Likewise, paragraph [29] of *Mundipharma* indicates that the matter is to be approached from the consumer’s perspective.

55. To the extent that there is a difference between them, I remain of the view expressed in *NIRVANA* that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI's interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts. Nevertheless I consider that English tribunals should endeavour to follow the latter so far as it is open to them to do so. *Mundipharma* suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J. in *ANIMAL Trade Mark* [2004] F.S.R. 19 is to be preferred to the slightly less generous approach of Pumfrey J. in *Daimler Chrysler AG v Alavi* [2001] R.P.C. 42 .”

57 In *Daimler AG v Sany Group Co Ltd* [2009] EWHC 1003 (Ch); [2009] E.T.M.R. 58 Geoffrey Hobbs QC sitting as a Deputy High Court Judge summarised the correct approach at [10] as follows:

“... the aim should be to arrive at a fair specification by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify. ...”

58 As Mr Hobbs added when sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Ltd v Gima (UK) Ltd* (BL O/345/10) at 11:

“For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.””

24. Mr Justice Birss, in *Thomas Pink Limited v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) considered whether ‘clothing’ was a fair term to describe the claimant's use on casual and formal trousers, dresses, skirts, jackets, pyjamas, underwear, ties, scarves, handkerchiefs, belts and gloves. Birss J decided that the range of goods, both casual and formal, justified the description as clothing and that a narrower specification based on individual items would not be fair.

25. Clothing is a collective term and the range of goods in *Thomas Pink* covered formal and casual clothing for the top and lower part of the body, for men and women, and included underwear, nightwear and clothing accessories. This is a broad range for which a collective term is fair. However, the range of goods for which Ms Bellamy has provided evidence is more limited than in *Thomas Pink*. With the exception of the men's hoody and t-shirt described as ‘rolls’ on pages 14 and 15 of the invoices, the clothes are described as being for boys, and the designs on them are juvenile. The goods aimed at boys in the invoices are limited to tops, hoodies and trousers/jeans. The design sheets in exhibit DB1 also show EKO and or specify JS001 as the neck label on t-shirts, shirts, jackets and gilets. These items do not appear in the invoices. Although it is desirable for proprietors to provide invoices demonstrating the range of goods sold in relation to the mark, it is not fatal that there are not invoices for every single item in the design pages. I conclude that there has

been use of EKO in the relevant period on t-shirts, tops, shirts, trousers, jeans, sweatshirts, hoodies, body warmers, gilets and jackets. These are the goods referred to in Ms Bellamy's witness statement. In the case of men's clothing, the only use has been on hoodies/sweatshirts and t-shirts. Unlike in *Thomas Pink*, since there are no goods such as underwear, sleepwear or accessories and the goods are all casual, I consider clothing at large, as a collective term, to be unduly wide. A fair specification is *casual tops, t-shirts, shirts, trousers, jeans and outer clothing, all for boys; casual tops and sweatshirts, all for men*.

Proof of use outcome

26. Boi may rely upon its earlier mark in respect of *casual tops, t-shirts, shirts and outer clothing, all for boys; casual tops and sweatshirts, all for men*.

Section 5(2)(b)

27. The leading authorities which guide me in relation to this section are from the CJEU ("Court of Justice of the European Union"): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Comparison of goods

28. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*. where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use

of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

29. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“Treat”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

30. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

31. The competing specifications are shown in the table below.

Boi	Throne
<i>Casual tops, t-shirts, shirts, trousers, jeans and outer clothing, all for boys; casual tops and sweatshirts, all for men</i>	<i>Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing, footwear, headgear; Clothing for martial arts; Clothing made of leather; Body warmers [clothing]; Denims [clothing]; Clothing for martial arts; Martial arts uniforms.</i>

32. As per the judgment of the GC in *Gérard Meric v OHIM* Case T-133/05, goods can be considered as identical when the goods of the earlier mark are included in a more general category, included in the specification of the trade mark application. Vice versa, if the goods of the application are included in a more general category included in the specification of the earlier mark, they must be identical. For this reason, Throne’s ‘clothing’ and ‘clothing made of leather’ are identical to Boi’s goods, as Throne’s ‘clothing’ and ‘clothing made of leather’ cover Boi’s goods. Boi’s term ‘outer clothing’ covers Throne’s ‘body warmers [clothing]’ and ‘denims [clothing]’. These goods are also identical.

33. Boi’s specification does not cover footwear and headgear, which appear in Throne’s list of goods. They are not, therefore, identical. However, there are similarities between Boi’s goods and footwear and headgear on account of the facts

that apart from being worn, they frequently share channels of trade and they may contribute aesthetically to an overall 'look' (aesthetic complementarity). I find that there is a reasonable level of similarity between Boi's goods and Throne's footwear and headgear.

34. This leaves Throne's *Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing for martial arts; Clothing for martial arts; Martial arts uniforms*. Boi's goods are all casual wear. I do not accept Boi's submissions that Throne's goods could be t-shirts and tracksuits; this is not the natural meaning of martial arts/judo clothing and uniforms. The trade channels will be different. They are not in competition with one another and are not complementary. The only point of similarity between these goods and Boi's casual wear is that the goods are worn, which is a very general point. Nobody would go out wearing judo or martial arts kit as a substitute for casual clothing, and nobody taking part in judo and martial arts would do so wearing casual clothing. There is no similarity between Boi's goods and Throne's *Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing for martial arts; Clothing for martial arts; Martial arts uniforms*.

Average consumer


35. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. The average consumer is the general public. Although I bear in mind that there may be an aural aspect to the purchasing process, the goods will be purchased primarily visually after examination of sales information, such as catalogues or websites, and the goods themselves. Items of ordinary cost will cause some degree of care to be used, but not the highest level of care. The more expensive the goods are, the closer will be the attention paid to the purchase. In addition, factors such as size, comfort and construction play a part in attentiveness. In relation to Throne's martial arts clothing, these are specialist garments and so a heightened level of attention is more likely.

Comparison of marks

36. The authorities cited earlier in this decision direct that, in making a comparison between the marks, I must compare each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details, as per *Sabel BV v Puma AG*, paragraph 23:

"That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their dominant and distinctive components."

37. The respective marks are:

Boi's	Throne's
EKO	

38. I note that the O in Throne's mark is octagonal and that Oriental characters appear above it. These are points of visual difference between the marks. In relation to the colour aspect of Throne's mark, I note that Kitchin LJ stated in *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96]:

"A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours."

This means that Boi's mark, registered in black block capitals, is registered in respect of all colours and could be used in any colour, including red. However, although registration in block capitals entitles Boi to use its mark in any ordinary font and in any colour, notional and fair use would not extend to contrived colour splits, such as EKO (with the O in red) and an octagonal O. I note the presence of the Oriental characters which, though small, put a point of distance between the marks, visually. I do not think the octagonal O would greatly influence a consumer's perception of the mark; it will still be seen primarily as an O. Overall, there is a reasonable level of visual similarity between the marks as they both begin and end in E and O, and have a K in the middle, the only difference in the letters being the additional I within Throne's mark.

39. Boi claims that the marks are likely to be pronounced in a similar manner. This is disputed by Throne, which states that EKO is more likely to be seen as three separate letters because three letters are common for acronyms. Conversely, Throne states that its own mark, being four letters and containing an accented Ö is more likely to be pronounced as a word. Throne also bases its claim that the marks are phonetically different on the fact that its mark is the phonetic spelling of the word 'glory' in Japanese, which would be pronounced 'A-co'.

40. I will say more about EIKO being Japanese below, but I do not agree that EKO would be pronounced as separate letters. As for the point about acronyms, a true acronym is pronounced as a word⁴. If Throne means that three letters would be seen as an abbreviation, and that this is the reason why it they would be pronounced individually, I would observe that the natural inclination is to say letters as a word unless there are insufficient vowels amongst the consonants to make that likely. In

⁴ Collins English Dictionary 2000 Edition: "A pronounceable name made up of a series of initial letters or parts of words; for example, *UNESCO* for the *United Nations Educational, Scientific, and Cultural Organization*."

the case of EKO, it naturally lends itself to articulation, either as EE-KO (as in the word ECO) or as the same sound as the word ECHO.

41. EIKO could be said either as AY-KO or EYE-KO. The beginnings of the marks therefore sound different, but they both have both two syllables and the second of these, KO, sounds the same. If Throne's mark is said as AY-KO, the marks sound similar if Boi's mark is said as EEKO and very similar if it is said as ECHO. If Throne's mark is said as EYE-KO, there is still a reasonable level of similarity as the second syllable sounds the same.

42. Throne states that its mark is not conceptually neutral because it contains both English and Japanese characters and an octagon. Throne acknowledges that the meaning of the combination may not be obvious at first glance but that it is clear that it means something, so the mark cannot be conceptually neutral. This is not what is meant by conceptually neutral in terms of comparing trade marks; what needs to be determined is whether the mark, or aspects of it, has meanings or connotations. To the average Anglophone consumer, Throne's mark will appear as an invented word with an Oriental concept provided by the characters. I doubt that the O would be seen as representing an arena for martial arts, as contended by Throne. I also doubt very much that the average UK consumer taking part in martial arts would be sufficiently versed either in Japanese or in the transliteration of Japanese characters to recognise that the word means glory.

43. Boi's mark, EKO, is an invented word, without meaning. As both words EKO and EIKO would be seen by the average UK consumer as invented, there is no conceptual similarity or dissimilarity, because they are conceptually neutral, neither having a meaning. There is the added concept of something related to the Orient provided by the characters in Throne's mark, but this does not put any greater distance between the marks conceptually than already exists.

44. EKO is the dominant distinctive element of Boi's mark. EIKO is by far the most dominant and distinctive element in Throne's mark.

Distinctive character of the earlier mark

45. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁵ 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).

⁵ Case C-342/97

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).”

46. The extent of Boi’s use does not entitle it to claim an enhanced level of distinctive character acquired through use. That said, as an invented word, it has an already high level of inherent distinctive character because it in no way describes or alludes to the goods for which it is registered.

Likelihood of confusion

47. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the judicial principles set out earlier in this decision.

48. One of those principles states that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). The marks are visually similar to a reasonable degree and phonetically similar at least to a reasonable degree, if not higher, depending on the variables surrounding likely pronunciation. There is no conceptual hook for the average consumer to grasp. This is important because where there is visual and/or phonetic similarity, this can sometimes be offset by a difference in meaning between marks. Such an offset cannot operate here because neither mark has a meaning.

49. I have found that the goods range from being identical to not similar. Where there is no similarity between the goods, neither identity between the marks nor a good degree of distinctive character in the earlier mark will help Boi’s case, as per the CJEU in *Waterford Wedgwood plc v OHIM* Case C-398/07:

“35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect,

Canon, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

50. Therefore, there is no likelihood of confusion in relation to *Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing for martial arts; Clothing for martial arts; Martial arts uniforms*. **The application for a declaration of invalidity fails in respect of these goods.**

51. In relation to all the other goods of the registration, there is a likelihood of confusion because the marks are reasonably similar visually and phonetically; the earlier mark is highly distinctive and the goods are subject to no more than an average level of attention, making imperfect recollection likely when the proximity of goods is factored in to the global comparison. There is no conceptual hook for consumers to remember and differentiate between the marks. Instead, a recollection of an invented word with similar letter patterns will lead to the marks being imperfectly recalled. There is a likelihood of confusion in respect of *Clothing, footwear, headgear; Clothing made of leather; Body warmers [clothing]; Denims [clothing]*.

Outcome

52. **The application for a declaration of invalidity partially succeeds under section 47(2)/section 5(2)(b) of the Act. Accordingly, under section 47(6) of the Act, the registration is deemed never to have been made in respect of:**

***Clothing, footwear, headgear; Clothing made of leather; Body warmers [clothing]; Denims [clothing]*.**

53. **The registration may remain intact in class 25 (and the goods in other classes for which it is registered) for:**

***Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing for martial arts; Clothing for martial arts; Martial arts uniforms*.**

Costs

54. As each party has achieved a roughly equal measure of success, I direct that each party shall bear its own costs.

Dated this 27th day of August 2014

**Judi Pike
For the Registrar,
the Comptroller-General**