

O-087-15

**TRADE MARKS ACT 1994  
IN THE MATTER OF TRADE MARK APPLICATION NO. 3021324  
IN THE NAME OF PASQUALE LATTUNEDDU  
FOR THE TRADE MARK:**

**URBAN GORILLA**

**IN CLASSES 18 AND 25  
AND  
OPPOSITION THERETO  
UNDER NO. 401708 BY BARRY GERALD TEN VOORDE**

## BACKGROUND

1) On 09 September 2013, Pasquale Lattuneddu ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of "Clothing; footwear; headgear" in class 25 and "leather and imitation leather" in class 18.

2) The application was published on 22 November 2013 in the Trade Marks Journal and notice of opposition was subsequently filed by Barry Gerald ten Voorde ('the opponent').

3) For the benefit of the applicant who is without legal representation, I will explain that opposition proceedings before the Tribunal are governed by the Trade Marks Act 1994 ('the Act'). The Act implements, inter alia, Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks ('the Directive') (as it is now). Consequently, interpretation of the Act is made on the basis of judgments of the Court of Justice of the European Union ('CJEU') and the General Court ('GC'), both with their seats in Luxembourg, as well as those of the courts in the United Kingdom. All of the judgments of the GC (previously known as the Court of First Instance) and the CJEU can be found at the following url (judgments preceded by the letter C are from the CJEU and judgments preceded by the letter T are from the GC. The former is the higher court):

<http://curia.europa.eu/juris/recherche.jsf?language=en>

Decisions of the appointed persons, who are one of the two fora for appeal from decisions of the registrar, can be found on the website of the Intellectual Property Office at the following url:

<http://www.ipo.gov.uk/t-challenge-decision-results.htm>

The other fora of appeal are the High Court of England and Wales, the High Court of Northern Ireland and the Court of Session (in Scotland). Judgments of courts in the United Kingdom can be found at the following url:

<http://www.bailii.org/>

4) The opponent claims that the application offends under section 5(2)(b) of the Act; it directs its opposition against class 25 of the application only. The opponent relies upon two UK trade marks which are shown in the table below:

Mark details	Goods relied upon
<b>No: UK00002020699</b> <b>GORILLA WEAR</b>  <b>Filing date: 17 May 1995</b> <b>Date of entry in the register: 14 February 1997</b>	<b><i>Class 25: Shirts, T-shirts, shorts, trousers, jackets, hats, socks, gloves and footwear.</i></b>

No: UK00001451672



Filing date: 19 December 1990  
Date of entry in the register: 04  
December 1992

*Class 25: Shirts, shorts, trousers, jackets, headwear and gloves; all included in Class 25.*

5) The trade marks relied upon by the opponent are both earlier marks in accordance with section 6 of the Act and, as they both completed their registration procedure more than five years prior to the publication date of the contested mark, they are subject to the proof of use conditions, as per The Trade Marks (Proof of Use, etc) Regulations 2004. The opponent made a statement of use in respect of all of the goods relied upon for both earlier marks.

6) The applicant filed a counterstatement in which it denies that the respective marks are similar or that there is a likelihood of confusion. It also requested that the opponent provide proof of use of its marks in relation to “clothing, footwear and headgear”. In this connection, the official letter of 16 May 2014 pointed out to the applicant that “proof of use can be requested only in relation to those goods in Class 25 for which the opponent made a statement of use in the TM7”.

7) The opponent subsequently filed evidence of use. The applicant did not file evidence or submissions during the evidential rounds. Neither party requested to be heard on the substantive matters nor did they file submissions in lieu of a hearing. I now make this decision on the basis of the papers before me.

### **THE OPPONENT’S EVIDENCE**

8) The opponent’s evidence takes the form of a witness statement in the name of Barry Gerald ten Voorde (the opponent) dated 14 July 2014. Mr Voorde states that he is the owner and managing director of Gorilla Wear B.V. and Sportrader B.V. in Hengelo (OV), the Netherlands and that the facts in his statement come from his own knowledge or the records of his companies. Mr Voorde’s evidence can be summarised as follows:

- Mr Voorde states that the trade marks relied upon by the opponent were “latest used in the United Kingdom in 2009”, after both were acquired in 2008 from the previous owner, Gorilla Enterprises LLC, Tyrone United States of America. (It appears to me that Mr Voorde is not a native English speaker and therefore I assume, bearing in mind the nature of his subsequent statements, that Mr Voorde means to say “first used in 2009” or “earliest used in the UK in 2009” rather than “latest”.)
- He states that the goods on which the mark has been used, and the date of first use, are: “shirts, shorts, trousers, jackets, headwear and gloves, used not

later than 2009” (again, I assume Mr Voorde means to say “used not earlier than 2009”).

- **Exhibit BV1** consists of a print out from “nominet” showing that the website [gorillawear.co.uk](http://gorillawear.co.uk) has been registered under Mr Voorde’s name since 2008.
- **Exhibit BV2** consists of a brochure dated 09/10 which Mr Voorde states shows the collection for those years. The brochure shows a selection of men’s casual clothing including sweatshirts, t-shirts, sweat-shorts, sweatpants and



baseball caps, a number of which bear the mark and/or stylised versions of the words ‘GORILLA WEAR’ alone. Prices for all of the goods are listed in Euros.

- **Exhibit BV3** consists of a similar brochure to that in exhibit BV2 but this is from Jan/Feb/Mar 2014 (which falls outside the relevant period). The back page of the brochure confirms that the prices shown in the brochure are “in Euros and USD”.
- **Exhibit BV4** consists of, what Mr Voorde states, are “samples of labels showing the trademarks”. The exhibit shows undated photographs of two t-



shirts and one sweat jacket, showing the mark on the neck labels. A fourth photograph shows two detached labels bearing the same mark.

- **Exhibit BV5** consists of, what Mr Voorde states, is a print out from Wayback Internet showing a snapshot dated 16/12/2010 of the Gorilla Wear website ([www.gorillawear.com](http://www.gorillawear.com)). The page shows, what Mr Voorde states, is the name and address of the Sales Distributor in the UK. A stylised representation of the words ‘GORILLA WEAR’ is also present at the top of the page. There are no goods mentioned or shown on the page.
- **Exhibit BV6** consists of a list of UK outlets, which Mr Voorde states have been “selling goods of Gorilla Wear through their websites in the UK since ending the relationship with the aforementioned UK distributor”. The first page of the exhibit lists the names, addresses and website addresses of ten different undertakings based in the UK. The remaining pages of the exhibit are a selection of print outs from eight of those websites. All of the websites show various items of men’s casual clothing for sale in GBP including, mainly, sweatshirts, t-shirts, sweatpants, sweat-shorts and baseball caps under the heading ‘Gorilla Wear’. Further, goods described as ‘Gorilla Wear Classic’ or



‘Classic logo’ all appear to bear the mark, either on the front/back of t-shirts, sweatshirts and baseball caps, or on the waist band of sweatpants and sweat-shorts (the brochure from 2009/2010 which contains much clearer pictures of ‘Gorilla Wear Classic’/ ‘Classic logo’ type goods, including baseball caps and sweat-shorts and sweatpants with the mark on the waistband appears to corroborate this). Four of the website prints appear to emanate from 2014 owing to them bearing copyright dates from that year (and therefore fall outside the relevant period). The website print at pages 11-12 of the exhibit, which I assume is from [www.phd-fitness.co.uk](http://www.phd-fitness.co.uk) (due to the abbreviation ‘PhD’ used on those pages), although bearing a copyright date of

2012, also appears to have been downloaded in 2014, as '14 July 2014' is just legible above the words 'Newsletter sign up' on the bottom left hand corner of the page. The other website prints do not appear to bear any dates (copyright or otherwise).

- **Exhibit BV7** consists of, what Mr Voorde states is, “invoice history for some outlets in the UK for the sales of Gorilla Wear goods in the years 2010 thru 2014”. This exhibit is in the Dutch language. It appears to show a history of transactions between five of the UK undertakings listed in exhibit BV6 and “SporttraderGorilla” on various dates spanning 2009- 2014. It shows, what appears to be invoice numbers, the name of the UK undertaking which the invoice was sent to, the date of the invoice and the balance of each invoice. There is no indication of what goods/services the invoices relate to, nor to any trade marks which may have been used on, or in relation to, any such goods.
- At paragraph 5 of his statement, Mr Voorde provides, what he states are, “Annual sales of the goods/services through some outlets in the UK before the date of opposition”; the figures are as follows (logic would suggest that the decimal point in these figures should be a comma):

<b>Date</b>	<b>Amount (£)</b>
2010	3.847
2011	5.012
2012	209
2013	39.383
2014 so far	12.301

- Mr Voorde states that annual amounts spent on promoting the goods/services in those years in the UK is unknown as this spending is done by the UK representative and each outlet themselves. However, he states that the costs of printing brochures, a portion of which are sent to the UK, together with the annual costs of maintaining the UK website [www.gorillawear.co.uk](http://www.gorillawear.co.uk) are borne by the opponent itself (he does not specify what those costs are).

That completes my summary of the opponent’s evidence.

## **DECISION**

### **Proof of use**

9) The relevant sections of the Act read as follows:

#### **“6A Raising of relative grounds in opposition proceedings in case of non use**

(1) This section applies where –

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form 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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Section 100 of the Act is also relevant and reads:

“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.”

Consequently, the onus is on the opponent to prove that it has made genuine use of its registered marks in the relevant period in relation to the goods it relies upon.

10) In approaching the matter of whether the opponent has shown genuine use of its earlier marks, I must apply the same factors I would as if determining an application for cancellation of a trade mark registration based on grounds of non-use. The relevant period, for present purposes, in which the opponent must prove use of its earlier marks is the five year period ending with the date of publication of the applicant's mark in the Trade Marks Journal, namely, 23 November 2008 to 22 November 2013.

### **The authorities on genuine use**

11) In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

"51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *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]”.

12) Although minimal use may qualify as genuine use, the Court of Justice of the European Union stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

13) In considering the opponent’s evidence, it is a matter of viewing 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 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 GC stated:

“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).”

14) In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Mr Geoffrey Hobbs Q.C., 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 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."

### **Is the evidence sufficient to prove genuine use?**

15) The opponent's evidence shows it owns the website [www.gorillawear.co.uk](http://www.gorillawear.co.uk) and Mr Voorde states that costs have been incurred in maintaining it. However, he does not specify what those costs are nor does he provide any corroborative evidence showing any use of the said website or the kind of goods which may have appeared on that website. There is also nothing in the rest of the evidence to shed light on this. Further, although exhibit BV5 is from within the relevant period (being a snap-shot from the opponent's website [www.gorillawear.com](http://www.gorillawear.com) from 16/12/2010) and appears to show the name and address of the opponent's UK distributor placed just below the stylised words 'GORILLA WEAR', it is not clear what goods, or how many, were actually distributed.

16) As regards the brochures, one is dated 2014 which is outside the relevant period and so does not assist me. However, the other brochure is dated within the relevant period (09/10) and contains goods bearing the earlier marks. Although the prices of the goods are listed in Euros rather than GBP, I note that the brochure is in the English language (as opposed to some other European language), suggesting that it may have been targeted at the UK and, indeed, Mr Voorde makes a sworn statement to the effect that "a portion of the brochures are sent to the UK" (a statement which has not been challenged).

17) Turning to the invoice history in exhibit BV6, Mr Voorde states that this shows “sales of Gorilla Wear goods in the years 2010-2014” (a further statement which has not been challenged). The history does not specify the goods to which those transactions related or make clear what trade marks were used on any such goods. However, the vast majority of the transactions fall within the relevant period and I note that the names of the undertakings to which those invoices were sent to are the same as the names of a number of the undertakings listed in exhibit BV6 which Mr Voorde confirms have been selling Gorilla Wear goods through their websites since ending the relationship with the distributor. Furthermore, the print outs from those websites all show various goods for sale in GBP bearing one or more of the earlier marks or listed under the heading ‘GORILLA WEAR’. These are mainly sweatshirts, t-shirts, sweatpants, sweat-shorts and baseball caps (all for men). While most of these website pages appear to emanate from 2014, I bear in mind that this is only a reasonably short period after the expiry of the relevant five year period and it is therefore not unreasonable to suppose that at least some of those websites will have contained the same kinds of goods during the relevant part of 2013, or, at least, that those undertakings are likely to have purchased the goods from the opponent during the relevant period. In this connection, I note that the invoice history does indeed show a number of invoices were issued to BodyBuilding Clothing UK (aka ‘GymKing’) on a monthly basis from Dec 2012 to June 2013 and to Extreme Nutrition Ltd between May and Oct 2013, for example.

18) I now come to the total sales figures provided by Mr Voorde. My first observation of these is that they are not broken down to indicate what proportion of them relates to what goods. Further, the figures for the period 2010-2012 are very small bearing in mind the enormity of the UK clothing market and the figure from 2014 falls outside the relevant period. As for the figure for 2013, although somewhat greater than the other figures, it is still modest. That said, I remind myself that “even minimal use may qualify as genuine use” and, in this connection, the figure from 2013 in particular, is not, in my view, so small so as to be deemed incapable of creating or maintaining a market in the UK clothing market or indicative of token use. It would also seem reasonable to conclude that a very large proportion of the figure from 2013 is likely to have related to sales made up to and including Nov 2013, and therefore to have fallen within the relevant period (given that November is at the tail end of 2013).

19) Having borne in mind all of the above, and keeping in mind that the evidence has not been challenged by the applicant, I come to the view that, while the opponent’s evidence is far from perfect and the scale of use is certainly not overwhelming, when standing back and viewing the evidence as a collective whole it is sufficient to paint a picture that the opponent has put both of its earlier marks to genuine use within the relevant period in the UK in respect of sweatshirts, t-shirts, sweatpants, sweat-shorts and baseball caps, all being for men.

### **What would constitute a fair specification?**

20) Having reached the above conclusion, I must now go on to consider what would constitute a fair specification. Mr Justice Arnold (as he now is) sitting as the Appointed Person in *Nirvana Trade Mark BL O-262-06* and *Extreme Trade Mark BL O-161-07* comprehensively examined the case law in this area. His conclusion in *Nirvana* was that:

“(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].”

21) The GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* held that:

“43. Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44. With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

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 subcategories relating to which the goods or services for which the trade mark has actually been used actually 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.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

22) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

23) I remind myself that the specifications for the two earlier marks, as registered, read as follows:

**TM No: UK00002020699:**

*Class 25: Shirts, shorts, trousers, jackets, headwear and gloves; all included in class 25.*

**TM No: UK00001451672:**

*Class 25: Shirts, T-shirts, shorts, trousers, jackets, hats, socks, gloves and footwear.*

24) Bearing in mind the specifications in their current registered form, together with all of the above case law and, having taken into account that genuine use has been shown only in respect of certain kinds of men's clothing, namely, only one kind of trouser (i.e. sweatpants), only one kind of hat/headgear (i.e. baseball caps), only two types of shirts (i.e. t-shirts and sweatshirts) and one kind of shorts (i.e. sweat-shorts), I come to the conclusion that a fair specification for both earlier registrations, which reflects the use which the opponent has made of its marks, and how the average consumer would fairly describe that use, is:

“Class 25: Sweatshirts, t-shirts, sweatpants, sweat-shorts and baseball caps, all being for men”.

It is this specification upon which I will base my assessment under section 5(2)(b) of the Act, in respect of both earlier marks.

**DECISION**

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

24) This section of the Act states:

‘5. (2) A trade mark shall not be registered if because –

(a) .....

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.’

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

## **The principles**

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

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

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

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

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

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

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

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

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

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

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

## **Comparison of goods**

26) The respective goods to be compared are:

Applicant's goods	Opponent's goods
<b>Class 25: Clothing, footwear, headgear.</b>	<b>Class 25: Sweatshirts, t-shirts, sweatpants, sweat-shorts and baseball caps, all being for men.</b>

27) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 ('*Treat*') and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117. In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive.

28) Further, in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) case T-133/05 ('*Merica*'), the GC held:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

29) The opponent's "Sweatshirts, t-shirts, sweatpants, sweat-shorts, all being for men" are encapsulated by the applications term "clothing". The respective goods are identical in accordance with *Merica*.

30) The opponent's "baseball caps, all being for men" fall within the applicant's term "headgear". These goods are also identical in accordance with *Meric*.

31) Turning to the applicant's "footwear", these goods and all of the opponent's goods share similarities in nature and purpose since they are all items intended to be worn on the person, they may sometimes be made of similar materials, they are all aimed at the same consumers and the trade channels may converge significantly. There is a very good degree of similarity between the respective goods.

### **Average consumer and the purchasing process**

32) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"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."

33) The average consumer for the goods at issue in this case is the general public. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03 the GC stated:

"43 It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

...

53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to

purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

34) As stated by the GC, items of clothing will vary greatly in price and therefore the purchase may not always be particularly considered. The same can be said of items of footwear and headgear. Nevertheless, as the consumer may wish try on the goods or to ensure that they are of a certain colour, size or material (for example) it is likely that at least a reasonable degree of attention is still likely to be afforded, even for those goods which bear a more inexpensive price tag. The purchasing act will be primarily visual as the goods in question are commonly bought based on their appearance; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. However, I do not discount aural considerations.

### Comparison of marks

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

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

36) The respective marks are set out in the table below:

Applicant's mark	Opponent's marks
<p><b>URBAN GORILLA</b></p>	<p><b>GORILLA WEAR</b></p> <p>and</p> 

37) The applicant's mark consists of the two words URBAN GORILLA in plain block capitals. The overall impression conveyed by the mark is of those two words working together to form a complete phrase, in which neither word strongly dominates the other. Turning to the opponent's marks, the first ('the word-only mark') consists solely of the words GORILLA WEAR in plain block capitals. The word WEAR is merely a description of the goods; it is the distinctive word GORILLA which strongly dominates the overall impression of the mark as a whole. The same words appear in the opponent's second mark together with the image of a gorilla ('the word and image mark'). The element consisting of the image of the gorilla is clearly distinctive and is far from negligible but, given its position at the end of the mark and that it simply serves to reinforce the message portrayed by the word element, it carries slightly less relative weight in the overall impression than the words when viewing the mark as a whole. As regards those words, it is the word GORILLA which strongly dominates the word WEAR, for the reasons already mentioned.

38) In terms of visual similarity, clearly all of the respective marks contain the word GORILLA. Whilst this is the only point of visual coincidence between the marks, with all elements being visually different, it nevertheless results in a reasonable degree of visual similarity between the applicant's mark and opponent's word-only mark and a moderate degree of visual similarity between the applicant's mark and the opponent's word and image mark. Aurally, the applicant's mark will be pronounced URR-BUN-GUR-ILL-AH and both of the opponent's marks will be pronounced GUR-ILL-AH-WAIR. Three out of five syllables of the respective marks are clearly identical but the other two syllables differ. Overall, I consider there to be a good degree of aural similarity. Turning to the conceptual aspect, the overriding concept portrayed by both of the opponent's marks is of a gorilla (the well known animal). The applicant's mark is likely to be perceived as meaning a city/town gorilla ('urban' being well known as meaning city or town). The common gorilla concept results in a good degree of conceptual similarity between the respective marks.

### **Distinctive character of the earlier marks**

39) I must consider the distinctive character of the earlier marks. This must be assessed by reference to the goods for which the marks are registered and by reference to the way they are perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00 [2002] ETMR 91*).

40) Although I have found that the opponent's evidence of use is sufficient to satisfy the proof of use requirements, it is not sufficient, bearing in mind, in particular, the small scale of use, to satisfy me that either of the earlier marks have been used to such an extent in the UK that they have acquired an enhanced distinctive character. Consequently, I can only take into account the inherent level of distinctiveness of the earlier marks. Neither of the opponent's marks describe or allude to the goods covered by the opponent's registrations in any way and I find them both to be possessed of a reasonably good degree of inherent distinctive character.

## Likelihood of confusion

41) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion and, when conducting that assessment, I must also keep in mind the following established principles:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*), and;
- iii) the principle that the more distinctive the earlier mark is, the greater is the likelihood of confusion (*Sabel BV v Puma AG*).

42) I have found the respective goods to be either identical or similar to a very good degree. The average consumer will be the general public who are likely to pay a reasonable degree of attention during the mainly visual purchase (although aural considerations are not disregarded) for all of the goods at issue. I must therefore keep in mind that the visual similarity between the marks is a particularly important factor in the global assessment.<sup>1</sup> As regards the marks themselves, I have found that the applicant's mark shares a good degree of aural and conceptual similarity with both of the opponent's marks. Visually, there is a reasonable degree of visual similarity between the applicant's mark and the opponent's word only mark and a moderate degree of similarity between the applicant's mark and the opponent's word and image mark. I have also found that both earlier marks have a reasonably good degree of inherent distinctive character.

43) Having carefully considered all of the above factors and weighed them against each other, I come to the view that the visual similarities between the marks (bearing in mind the importance of the visual aspect in this particular case) are not great enough for the average consumer to mistake either of the opponent's earlier marks for the applicant's mark or vice versa. However, bearing in mind, in particular, the identity and very good degree of similarity of the respective goods, together with the good degree of conceptual similarity that exists between both of the opponent's marks and the applicant's mark, there is, in my view, a likelihood of indirect confusion in respect of both i.e. that the average consumer will believe, in light of the similarities that do exist between the marks, that the respective goods are different

---

<sup>1</sup> In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated: "49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."

ranges from the same or economically linked undertaking(s). **The opposition against class 25 of the trade mark application succeeds.**

## **SUMMARY**

- **The trade mark application is refused in respect of the goods in class 25.**
- **The trade mark application will proceed to registration in respect of the goods in class 18 (since this class was not subject to opposition).**

## **COSTS**

44) As the opponent has been successful, it is entitled to an award of costs. Taking account of the guidance provided in Tribunal Practice Notice 4/2007, I award costs to the same on the following basis:

Preparing the notice of opposition and considering the counterstatement	£200
Official opposition fee	£200
Preparing and filing evidence:	£500
<b>Total:</b>	<b>£900</b>

45) I order Pasquale Lattuneddu to pay Barry Gerald ten Voorde the sum of **£900**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24th day of February 2015**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**