

O-349-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3040345
BY MARIA BEANEY & GEMMA MACNEILL
TO REGISTER THE TRADE MARK:**



**IN CLASS 25
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 402599 BY
AMERICANA INTERNATIONAL LIMITED**

BACKGROUND

- 1) On 1 February 2014, Maria Beaney and Gemma MacNeill (hereinafter the applicants) applied to register the trade mark shown on the above page in respect of the following goods in Class 25: Clothing, footwear, headgear; Leather belts [clothing]; Athletic clothing; Casual clothing; Jogging bottoms [clothing].
- 2) The application was examined and accepted, and subsequently published for opposition purposes on 2 May 2014 in Trade Marks Journal No.2014/018.
- 3) On 1 August 2014 Americana International Limited (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Date of application / registration	Class	Specification relied upon
BENCH	2394838	22.06.05 02.12.05	25	Clothing, footwear, headgear.
BENCH	CTM 8624661	19.10.09 26.04.10	25	Articles of clothing, footwear, headgear.

b) The opponent states that it has used its trade mark BENCH in the UK since 1988 in relation to, *inter alia*, clothing footwear and headgear. It has developed a reputation and goodwill in its business such that members of the public associate the mark BENCH with the opponent. The opponent contends that the mark in suit is confusingly similar to its registered trade marks shown above. It states that the goods applied for in the mark in suit are similar or identical to those for which its marks are registered. The mark in suit would be confused with the opponent's marks and would, without due cause, take unfair advantage of or be detrimental to the distinctive character of the opponents' marks, in that it would cause tarnishing and/or loss of distinctiveness. The mark in suit would benefit from the opponent's power of attraction and ride on the coat tails of the opponent's reputation. The mark in suit therefore offends against sections 5(2)(b) and 5(3) of the Act.

c) The opponent contends that as a result of the goodwill and reputation it has developed in the UK by its use of the sign BENCH since 1988 use of the mark in suit will amount to misrepresentation and damage to its goodwill and also loss of sales. The mark in suit therefore offends against section 5(4)(a) of the Act.

4) On 13 October 2014, the applicants filed a counterstatement. They did not put the opponent to proof of use. The applicants state that they manufacture "CrossFit" apparel, explaining that CrossFit Inc. is a fitness company founded in 2000 which has approximately 10,000 affiliated gyms worldwide. The applicants do not comment on their relationship with this company nor do they state how many UK gyms are affiliated. The applicants provide definitions of the words "benchmark" and "bench". They state that they have significantly different meanings. They also contend that the class 25 goods of the two companies are different as they provide only "fitness specific t-shirts and vests; nothing more". They state:

“The term “BenchMark Girls” is a CrossFit phenomenon; these workouts (21 of them) serve to measure and benchmark your performance and improvements through repeated, irregular, appearances in the “workout of the day “ programme. The workouts intended as benchmarks will be readily distinguished from other Workouts of the Day by their being given, in each instance a female name.”

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard; only the opponent provided written submissions.

OPPONENT’S EVIDENCE

6) The opponent filed a witness statement, dated 11 February 2015, by Paul Stout the Chief Financial Officer of the opponent who he has worked for since 2009. He states that he has full access to the records of the opponent company and is authorised to make his statement. From his statement I take the following:

- The mark BENCH was first used in the UK in the mid 1980s by the predecessor in business. The opponent has used the mark since 1998 in the UK on clothing, footwear and headgear and various other sundry items such as sunglasses, bags, wallets, jewellery and toiletries. The mark has been used in the UK on sports and fitness apparel.
- During the period 2009-2103 inclusive, turnover in the UK in relation to clothing, footwear and headgear sold under the BENCH trade mark has averaged over £49 million per annum. During the same period advertising and promotion of BENCH clothing, footwear and headgear in the UK has averaged over £890,000 per annum. The advertising has been via fashion magazines and publications such as *Women’s Fitness*, *Sport & Street* and the *Sportswear International* website.
- In the UK Bench clothing, footwear and headgear is sold through retail outlets such as, inter alia, JD Sports, Littlewoods, ASOS, House of Fraser and John Lewis as well as the opponent’s own retail outlets. The opponent also sells online via its own website and those of the retail outlets mentioned previously as well as others such as Amazon.
- The opponent regularly attends trade exhibitions in the UK and elsewhere in Europe.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

8) The first ground of opposition is based on section 5(2)(b) which reads:

“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.”

9) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

10) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. Given the interplay between the dates that the opponent’s mark CTM 8624661 was registered (26 April 2010) and the date that the applicants’ mark was published (2 May 2014), section 6A of the Trade Marks Act does not come into play. Trade mark 2394838 was registered on 2 December 2005 and so would have required proof of use but the applicants did not request this of the opponent in their counterstatement. The opponent is therefore entitled to rely on each of the earlier marks and for each of the goods as registered.

11) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

The average consumer and the nature of the purchasing decision

12) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

13) Both parties' specifications are for clothing, footwear and headgear in class 25. The goods of both specifications can vary somewhat in their prices but neither would be considered to be complex. The items would be purchased by the average member of the public and businesses. Such items tend, for the most part, to be purchased in shops or online. In shops and online they will be self selected and the visual aspect will be the most important element. When purchasing in a shop or if ordering by telephone aural considerations must be considered but the initial choice will still be made visually. Retailers will also be customers but I believe that they will make their choices in a similar way, be it from the internet, a brochure or the shelves in a cash and carry. They may also order via the telephone or in person. Effectively they have the same issues as the general public and I regard them to be the same. I accept that more expensive items may be researched or discussed with a member of staff. In this respect I note that in *New Look Ltd v OHIM Cases- T-117/03 to T-119/03 and T-171/03*, the General Court (GC) said this about the selection of clothing:

“50. 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.”

14) In the same case the Court also commented upon the degree of care the average consumer will take when selecting clothing. It said:

“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 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.”

15) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing such as socks, the average consumer will pay attention to considerations such as size, colour, fabric and cost. Overall the average consumer is likely to pay a reasonable degree of attention to the selection of items of clothing, footwear, and headgear.

Comparison of goods

16) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

17) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18) For ease of reference the goods of the two parties are as follows:

Opponent's goods	Applicants' goods
2394838: Clothing, footwear, headgear.	Clothing, footwear, headgear; Leather belts [clothing]; Athletic clothing; Casual clothing; Jogging bottoms [clothing].
CTM 8624661: Articles of clothing, footwear, headgear.	

19) The applicants contended that their goods were different to those of the opponent as they only sold “fitness specific t-shirts and vests; nothing more”. However, I must consider the specification applied for not what the applicant has used the mark on to date. Clearly the words “clothing”, “footwear” and “headgear” appear in all of the specifications and so these are identical. The applicant’s specification also has the terms “Leather belts [clothing]; Athletic clothing; Casual clothing; Jogging bottoms [clothing]” all of which are identified as clothing and so would be encompassed by that term in the opponent’s specification. The goods of the two parties are identical.

Comparison of trade marks

20) 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 them, 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.”

21) It would be wrong, therefore, artificially to dissect the trade 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 them. The opponent’s marks are identical and so I will refer to it in the singular. The trade marks to be compared are:

Opponent's trade mark	Applicants' trade mark
BENCH	

22) In their counterstatement the applicants pointed out that the word “Bench” has a number of well known meanings. It can mean a long seat for several people such as that used by reserve players in sport or a seat occupied by an official such as a judge. They contrast this to the word “Benchmark” which is well known as referring to a standard of excellence; an achievement or a standard against which things are measured. I accept that in the applicants’ mark the letter “a” is replaced by an image of what appears to be a kettlebell weight, and that the second part of the mark begins with a capital letter “M”. However, I believe that the average consumer will view the sign as being the word

“benchmark”. The opponent contends that there is visual similarity in that both marks have the word “Bench” as the first part of the mark. I do not agree with this contention as the word “benchmark” is well known and the average consumer will not artificially divide the mark. They will view it as a single word. In addition the applicants’ mark has two words “Girls apparel” which are clearly descriptive of the applicants’ goods, and will be largely ignored by the average consumer. It also has a weightlifting bar and a kettle bell wearing a crown. These suggest a sporting intent but to my mind maintain a degree of independent distinctiveness. The main part of the applicants’ mark is undoubtedly the well known English word “benchmark”. The only visual and aural similarity comes from the fact that the word “benchmark” has as its first five letters the word “bench”. Overall the visual and aural differences far outweigh any similarity from the artificial division of the applicants’ mark. Conceptually, the word “girls apparel” simply point to the obvious that the goods are clothing for women. The exercise bar and kettlebell weights indicate that the clothing is “sporting” in nature. The distinctive and dominant part of the applicants’ mark is undoubtedly the word “BenchMark”. This alludes to the quality of the goods but is not directly descriptive of them. Conceptually the marks of the two parties will provide very different images to the average consumer.

Distinctive character of the earlier trade mark

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

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

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

24) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out".

25) However the independent and distinctive element does not need to be identical. In *Bimbo SA v OHIM*, Case T-569/10, the General Court held that:

"96. According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60)."

26) In *Aveda Corp v Dabur India Ltd* [2013] EWHC 589 (Ch), Arnold J. stated that:

"47. In my view the principle which I have attempted to articulate in [45] above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to that significance. Thus in *Bulova Accutron* the earlier trade mark was ACCURIST and the composite sign was BULOVA ACCUTRON. Stamp J. held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive ACCUTRON to have significance independently of the whole and would confuse it with ACCURIST.

48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion."

27) The opponent's mark is a well known English word whose distinctive character lies within its whole and which is not directly or indirectly descriptive of the goods and so has at least a moderate level of inherent distinctiveness. The opponent has filed evidence of use of its mark in the UK on clothing, footwear and headgear. The evidence is unchallenged and is sufficient for the opponent to benefit from enhanced distinctiveness.

Likelihood of confusion

28) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the

likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods and services by predominantly visual means and who will pay only a reasonable degree of care when doing so;
- The respective specifications in Class 25 are clearly identical.
- In comparing the mark in suit to the opponent's mark, overall the visual and aural differences far outweigh any similarity from the artificial division of the applicants' mark. Conceptually the marks of the two parties will provide very different images to the average consumer.
- the opponents' earlier trade mark has a moderate level of inherent distinctiveness and it also benefits from an enhanced distinctiveness as evidence of use in relation to clothing, footwear and headgear in the United Kingdom was filed, and was not challenged.

29) In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

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

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

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

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

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

30) Taking all of the above into account and even allowing for the concept of imperfect recollection, there is no likelihood of consumers being confused into believing that the goods provided by the

applicants are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails.**

31) I next turn to the ground of opposition under section 5(3) which reads:

“5. (3) A trade mark which-

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

32) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel, paragraphs 76 and 77*.

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later

mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

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

33) Under this ground the opponent relies upon both its trade marks shown earlier. The onus is upon the opponent to prove that its earlier trade marks enjoys a reputation or public recognition and it needs to furnish the evidence to support this claim. To my mind, the opponent has provided the evidence, see paragraph 6 above, that its marks do enjoy such a reputation in respect of clothing, footwear and headgear and so it clears the first hurdle.

34) Once the matter of reputation is settled an opponent must then show that the relevant customers would make a link between the two trade marks and how its trade mark would be affected by the registration of the later trade mark. In Case C-408/01, *Addidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

35) There is some debate as to whether the judgment of the CJEU in *L'Oreal v Bellure* means that an advantage gained by the user of a junior mark is only unfair if there is an intention to take advantage of the senior mark, or some other factor is present which makes the advantage unfair. The English Court of Appeal has considered this matter three times. Firstly, in *L'Oreal v Bellure* [2010] RPC 23 when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood* [2010] RPC 2: see paragraph 136. Thirdly, in *Specsavers v Asda Stores Limited*¹ [2012] EWCA Civ 24: see paragraph 127. On each occasion the court appears to have interpreted *L'Oreal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause. However, the absence of due cause appears to be closely linked to the existence of unfair advantage. See paragraph 36 of the opinion of Advocate General Kokott in Case C-65/12 *Leidseplein Beheer and Vries v Red Bull*.

36) In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (CH) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the

wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

37) In *Aktieselskabet af 21. November 2001 v OHIM*, Case C-197/07P, the CJEU stated that:

“22. With regard to the appellant’s argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded *prima facie* that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38).

23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgment under appeal, properly established the existence of an unfair advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude *prima facie* that there was a risk, which was not hypothetical, of unfair advantage in the future.”

38) I must consider the similarity of the goods of the two parties. The specifications of both parties are identical (see paragraph 19 above). The applicants also contended that they only produce “fitness specific t-shirts and vests; nothing more”. However, these goods would also be considered identical to the term “clothing” in the opponent’s specification. Although similarity of goods is not required under section 5(3) it is one of the factors which I have to take into account in determining whether the average consumer will make a link between the marks of the two parties. The term BENCH means a long seat and so it has a moderate degree of inherent distinctiveness when used on clothing, footwear and headgear. I also found earlier that the opponent’s marks have an enhanced reputation through use in respect of clothing, footwear and headgear. Earlier in this decision, when comparing the marks of the two parties I determined that overall the visual and aural differences far outweigh any similarity from the artificial division of the applicants’ mark and that conceptually the marks of the two parties will provide very different images to the average consumer.

39)The applicants have provided their reason for adopting the mark in suit, as set out in paragraph 4 above. Broadly, although they appear to have no connection to CrossFit Inc. it states that it is deliberately seeking to associate its mark to the workouts supplied by CrossFit Inc. known as “BenchMark Girls”. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that the average consumer will not make the link between the marks in respect of the applicants’ goods, and that there is not an advantage for the applicants to derive, from both the reputation of the opponent and the promotional activity it carries out. **The opposition under Section 5(3) therefore fails.**

40) I now turn to the final ground of opposition which is under section 5(4)(a) which reads:

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

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

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

41) In deciding whether the marks in question offend against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

42) First I must determine the date at which the opponent’s claim is to be assessed; this is known as the material date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.'

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd O-393-10 [2011] ETMR 36* it was argued that Last Minute had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of Last Minute and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of Last Minute, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the prima facie date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of *Floyd J in Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM [2005] RPC 2* at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd. [1975] FSR 367*; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd [1981] RPC 429 (PC)*; *Barnsley Brewery Company Ltd. v. RBNB [1997] FSR 462*; *Inter Lotto (UK) Ltd. v. Camelot Group plc [2003] EWCA Civ 1132 [2004] 1 WLR 955*: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06 Mr Alan James acting for the Registrar* well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date

of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

43) The filing date of the application is, therefore, the material date. However, if the applicants have used their trade mark prior to this then this use must also be taken into account. It could, for example, establish that the applicants are the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed; any of which could mean that the applicant’s use would not be liable to be prevented by the law of passing-off – the comments in Croom’s Trade Mark Application [2005] RPC 2 and Daimlerchrysler AG v Javid Alavi (T/A Merc) [2001] RPC 42 refer.

44) There is no evidence of use of the applicants’ mark; I shall therefore regard the relevant date as 1 February 2014. The opponent states that it began selling its clothing, footwear and headgear goods in the UK in 1988. The opponent has provided sales figures for its activities in the UK and details of how and where its goods are sold. I accept that the opponent had goodwill in respect of clothing , footwear and headgear at the relevant date, and so overcomes the first obstacle.

45) Earlier in this decision I found that use of the mark in suit, actual or on a fair and notional basis would not result in confusion with the opponent’s mark. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act therefore fails.

CONCLUSION

46) The opposition under Sections 5(2)(b), 5(3) and 5(4)(a) have all failed.

COSTS

47) As the applicants have been successful they are entitled to a contribution towards their costs.

Preparing a statement and considering the other side’s statement	£300
Considering the opponent’s evidence	£200
TOTAL	£500

48) I order Americana International Limited to pay Maria Beaney and Gemma MacNeill jointly the sum of £500. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of July 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**