

**O-341-16**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
APPLICATION NO 3056957  
BY MUHAMMAD BILAL FIRAZ  
TO REGISTER THE TRADE MARK**



**IN CLASSES 18, 25 & 28  
AND  
OPPOSITION THERETO (UNDER NO. 403003)  
BY  
S. OLIVER BERND FREIER GMBH & CO. KG**

## BACKGROUND

1) On 23 May 2014, Muhammad Bilal Firaz ('the applicant') applied to register the following trade mark in respect of the goods shown below:



**Class 18:** Bags, Sports bags, equipment bags, parts and fitting for all the aforesaid goods. Bag used in martial arts and boxing.

**Class 25:** Clothing, footwear and head gear for Boxing and Martial arts.

**Class 28:** Apparatus, articles and equipment for use in relation to boxing, martial-arts, body-building and weight training. Boxing gloves, sporting articles, protection wear for use in relation to boxing and martial arts; Leather and artificial leather Gloves and boxing gloves used for martial arts; Body Shaped/Moulded padding for protecting parts of the body (Specially made for use in Sporting activities); Punching bags; Shields for use in martial arts; Accessories and fittings for all the aforesaid; Miscellaneous sportswear.

2) The application was published on 11 July 2014 in the Trade Marks Journal and notice of opposition was subsequently filed by s. Oliver Bernd Freier GmbH & Co. KG ('the opponent').

3) The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). It relies upon the following European Union Trade Mark ('EUTM'):

EUTM details	Goods relied upon
<p><b>EUTM No: 181933</b></p> <p><b>KNOCK OUT</b></p> <p><b>Filing date: 01 April 1996</b></p> <p><b>Date of entry in the register: 23 June 2000</b></p>	<p><b>Class 25:</b> Clothing for men and women, including woven and knitted clothing and clothing of leather and imitation leather, in particular, blouses, shirts, T-shirts, sweat shirts, jackets, pullovers, tops, bustiers, trousers, skirts, sets, suits, coats, underclothing, swimwear, headgear, collar protectors, head bands, jogging and fitness clothing, gloves, belts for clothing, shoes.</p>

4) The trade mark relied upon by the opponent is an earlier mark in accordance with section 6 of the Act and, as it completed its registration procedure more than five years prior to the publication date of the contested mark, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all of the goods it relies upon.

5) The applicant filed a counterstatement denying that there is any similarity between the respective marks or the respective goods. It also requested that the opponent provide proof of use of its mark for the goods relied upon.

6) Both parties filed evidence. Neither party requested to be heard nor did they file submissions in lieu of a hearing. I now make this decision on the basis of the papers before me.

**Opponent's evidence**

7) This comes from Mr Armin Fichtel, the opponent's Chief Executive Officer, which can be summarised as follows:

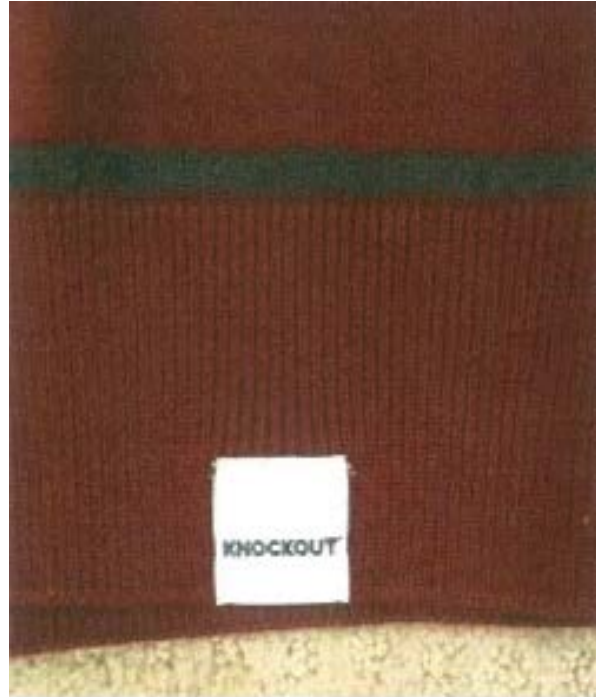
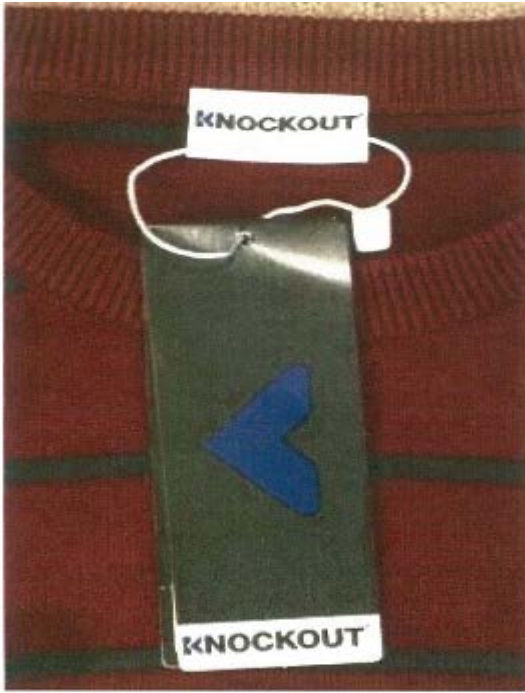
The opponent operates various outlet stores in Germany, specifically in the cities/towns of Niedernberg, Schwarzach, Brockhagen, Gremsdorf, Metzingen, Ratingen, Herzogenaurach, Parsdorf, Ahrensfelde, Mulheim, Bremen, Brunnthal, Augsburg and at the opponent's headquarters in Rottendorf as well as in Austria in Parndorf, and in the Netherlands in Vaals, Roermond and Roosendahl.

In the past five years, products sold under the "KNOCKOUT" brand have included shorts, belts, trousers, jackets, sweat jackets, sweatshirts, T-shirts, polo shirts, shirts, jeans and jumpers for both men and women.

The image of the following hang tag is provided which Mr Armin states is attached to each garment, showing the "KNOCKOUT" brand logo (this can be seen on the far right of the hang tag).



Mr Armin further explains that all garments also feature sewn in neck labels which show the "KNOCKOUT" brand logo and that garments such as belts feature a similar sewn in label. The following images are provided of jumpers bearing a hang tag, neck label and an additional sewn in label on the hem:



Between 2010 and 2014, the opponent achieved a turnover of at least €2,019,263.00 with the sale of “knockout” garments through the outlets referred to above. During that period, a total of 150,255 garments labelled “KNOCKOUT” were sold.

The following table is provided showing annual turnover and the quantity of goods sold under the “KNOCKOUT” brand:

Year	Quantity	Turnover in EUR
<b>2010</b> (Germany only)	50,409	533,773.00
<b>2011</b> (Germany only)	13,724	136,810.00
<b>2012*</b>	41,893	573,658.00
<b>2013*</b>	22,425	438,688.00
<b>2014*</b>	21,804	336,307.00
<b>Total</b>	<b>150,255</b>	<b>2,019,236.00</b>

\* Germany, Austria, the Netherlands

Mr Armin goes on to provide some specific examples of goods sold by the opponent under the “KNOCKOUT” brand, which fall within the figures provided in the table above, as follows:

- In 2010, 1,090 of the following sweatshirts were sold in Germany, achieving a turnover of €18,883.00. In 2011, 1,153 of the same were sold achieving a turnover of €15,657.00.



- In 2010, 15,125 of the following T-shirts were sold in Germany, achieving a turnover of €95,378.00 and in 2011 the same product achieved a turnover of €411.00 (Mr Armin states that the t-shirt bore a neck label and hang tag, as described above).



- In 2010, 3,286 of the following women's belts were sold in Germany, achieving a turnover of €44,362.00 and 451 in 2011 with a turnover of €5,545.00



- In 2010, 10,660 of the following ladies' t-shirts were sold in Germany with a turnover of €68,643.00.



- In 2010, 5,021 of the following polo type t-shirts were sold with a turnover of €62,884.00 and in 2011, 91 were sold with a turnover of €789.00.



- In 2011, 6,870 of the following t-shirts were sold in outlets in Germany, with a turnover of €42,244.00. Mr Fichtel states that, in addition to the neck label, the t-shirt also featured the “KNOCKOUT” print.



- In 2013, the following t-shirt was sold 3,090 times in Germany (turnover €36,587.00) and 157 times in Austria (turnover €1,971.00). 320 were also sold in the Netherlands throughout 2013 and 2014 (turnover €4,363.00). Mr Armin states that the t-shirt bears the “KNOCKOUT” neck label.





- In 2014, 1,424 of the following women’s long sleeve tops (offered in teal and yellow) were sold in Germany, Austria and the Netherlands (turnover €11,364.00).



- In 2014, 2,497 of the following men’s T-shirts were sold in Germany, Austria and the Netherlands (turnover €22,056.00).



### **Applicant’s evidence**

8) This comes from the applicant himself, Mohammad Bilal Firaz. I do not consider it necessary to summarise this evidence in any detail. Much of it goes to the extent to which the applicant has used its mark and annual turnover figures etc. This information is not pertinent to the matter before me. However, I consider it appropriate to record here, for reasons which will become apparent, that Mr Firaz’s evidence indicates that the sorts of goods he has used his mark on include the following:

- karate and judo uniforms (Exhibit 'PROOF 2')
- karate and judo grading belts (Exhibit 'PROOF 5')
- Boxing shorts (Exhibit 'PROOF 5').

That completes my summary of the parties' evidence.

**DECISION**

**Proof of use**

9) Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c).....  
 .....

(d).....

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

10) Section 100 is also relevant, which 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 upon the opponent to prove that genuine use of the registered trade mark was made in the relevant period.

11) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes *Case C-442/07 Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and *Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to

secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

12) As the earlier mark is an EUTM, in accordance with section 6A(5) of the Act, it must have been put to genuine use in the EU. In its judgment in *Leno Merken BV v Hagelkruis Beheer BV* C-49/11 (ONEL) the Court of Justice of the European Union (‘CJEU’) stated:

“28 The Court has already - in the judgments in *Ansul* and *Sunrider v OHIM* and the order in *La Mer Technology* - interpreted the concept of 'genuine use' in the context of the assessment of whether national trade marks had been put to genuine use, considering it to be an autonomous concept of European Union law which must be given a uniform interpretation.

29 It follows from that line of authority that there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether there is real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see *Ansul*, paragraph 43, *Sunrider v OHIM*, paragraph 70, and the order in *La Mer Technology*, paragraph 27).

30 The Court has also stated that the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not (see *Sunrider v OHIM*, paragraph 76).

31 That interpretation may be applied by analogy to Community trade marks since, in requiring that the trade mark be put to genuine use, Directive 2008/95 and Regulation No 207/2009 pursue the same objective.”

13) Regarding the territorial scope of the use, the CJEU went on to state:

“52 Some of the interested persons to have submitted observations to the Court also maintain that, even if the borders of the Member States within the internal market are disregarded, the condition of genuine use of a Community trade mark requires that the trade mark should be used in a substantial part of the Community, which may correspond to the territory of a Member State. They argue that such a condition follows, by analogy, from Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 28, Case C-328/06 *Nieto Nuño* [2007] ECR I-10093, paragraph 17, and Case C-301/07 *PAGO International* [2009] ECR I-9429, paragraph 27).

53 That argument cannot be accepted. First, the cases in question concern the interpretation of provisions relating to the extended protection conferred on trade marks that have a reputation or are well known in the Community or in the Member State in which they have been registered. However, the requirement for genuine use, which could result in an opposition being rejected or even in the trade mark being revoked, as provided for in particular in Article 51 of Regulation No 207/2009, pursues a different objective from those provisions.

54 Second, whilst it is reasonable to expect that a Community trade mark should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market (see, by analogy, with regard to the scale of the use, *Ansul*, paragraph 39).

55 Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create

or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

14) In *Reber Holding GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-355/09, the General Court (‘GC’) found that the sale of 40-60Kg per annum of specialist chocolate under a mark was insufficient to constitute genuine use of the national trade mark, which was registered in Germany. On further appeal in Case C-141/13 P, the CJEU stated, at 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 CJEU found that:

“the General Court conducted an overall assessment of that trade mark, taking into account the volume of sales of the goods protected by the trade mark, the nature and characteristics of those goods, the geographical coverage of the use of the trade mark, the advertising on the website of Paul Reber GmbH & Co. KG and the continuity of the trade mark’s use. It thus established a certain degree of interdependence between the factors capable of proving genuine use. The General Court therefore correctly applied the concept of ‘genuine use’ and did not err in law in its assessment of that use.”

15) Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark” is therefore not genuine use.



## The relevant period

16) In accordance with section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five year period ending on the date of publication of the contested mark. In the case before me, that period is 12 July 2009 to 11 July 2014.

## Use in a differing form

17) The applicant draws my attention to the form in which the earlier mark has been used. It states:

"I also like to bring Tribunal's notice the Opposition attempt of modifying the word trademark...from **KNOCK OUT** to **I<NOCKOUT** throughout the pictorial evidence Opposition have submitted.

Most obvious changes made to the mark...in evidence submitted are:

1. The [opponent's earlier registration, which] reads as the words **KNOCK** (space) **OUT** are now written together as **KNOCKOUT**. Clearly altering the meaning of this word mark and this is not the trade mark registered by the opponent.
2. The letter **K** is changed to **I<**..."

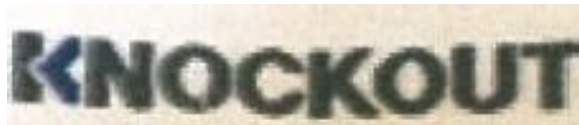
18) In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) summarised the test under s. 46(2) of the Act as follows:

"33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the

sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

In answer to the first question, the opponent's evidence shows use of the following mark:



Turning to the second question, the registered mark is KNOCK OUT presented in plain block capitals; its distinctive character lies in the mark as a whole. The difference between the mark, as used, and the mark, as registered, is, as the applicant points out, that the letter 'K' is stylised (as shown above) and the mark is presented as a single word, without the space between 'KNOCK' and 'OUT'. I do not agree with the applicant that the effect of removing the space alters the meaning of the mark; whether KNOCK OUT or KNOCKOUT the meaning is the same i.e. the act of striking a person such as to render them unconscious. I also do not consider that the stylisation of the letter 'k' alters the distinctive character; it is very slight. I find that the use of the variant mark shown above is "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" (my emphasis).

### **Genuine Use**

19) Mr Fichtel's evidence shows that between 2010 and 2014 the opponent sold a total of 150,255 "KNOCKOUT" garments, achieving a total turnover of €2,019,236. Those figures are broken down to show the number of garments and turnover for each year within that period and the location of those sales (i.e. 50,409 garments in Germany in 2010 with a turnover of €533,773.00; 12,724 garments in Germany in 2011 with a turnover of €136.810.00; 41,893 in Germany, Austria and the

Netherlands ('GAN') in 2012 with a turnover of €573,658.00; 22,425 in GAN in 2013 with a turnover of €438,688.00; 21,804 in GAN in 2014 with a turnover of €336,307.00), however, it is not broken down to indicate exactly how many different garments of different types were sold. That said, Mr Fichtel does provide specific examples of "some" of the products which were sold during the relevant period and photographs of the same.

20) The examples provided by Mr Fichtel mainly consist of t-shirts, all of which appear to bear the mark shown in paragraph 18 above, on the neck-label and hang-tag. There are numerous specific examples of t-shirts, for both men and women, sold in 2010 and 2011 in Germany and in 2013 and 2014 in Germany, Austria and the Netherlands. The volume of t-shirts sold is far from huge (adding up the figures from the examples amounts to just over 43,500 t-shirts). That said, sales appear to have been fairly frequent and consistent over the relevant five year period (with examples having been provided for 2010, 2011, 2013 and 2014) and over a reasonably sized geographical area in the EU (in Germany, Austria and the Netherlands). Turning to other kinds of clothing, there are photographs of a jumper bearing the mark (paragraphs 10 and 11 of Mr Fichtel's statement) but there is nothing beyond this to indicate how many were sold or where and how frequently they were sold. As to sweatshirts and belts, there is just one example of each item provided in the evidence (the photographs at paragraphs 11 and 14 of Mr Fichtel's statement appear to be of the same sweatshirt). Both are said to have been sold in 2010 and 2011 in Germany but there is no indication that any, at all, were sold in any other year of the relevant period, suggesting that use on those goods has lacked frequency and continuity. The volume of sweatshirts (2,243 in total) and belts (4,063 in total) sold also appears to me to be miniscule in the context of what is undoubtedly an enormous EU consumer market. As regards the women's long sleeve top, it is stated that this was sold in 2014 in Germany, Austria and the Netherlands, however, the number sold appears to be tiny (only 1,424) and, as the relevant period ends on 11 July 2014, it seems likely that the proportion of that figure which relates to the period of time prior to that date is even smaller. Further, there is no other evidence of any sales of women's long sleeve tops in any other year in the relevant period. As to other types of clothing, Mr Fichtel states that the mark was also used on products

such as shorts, trousers, jackets, sweat jackets and jeans but there is a complete absence of any corroborative evidence to support this.

21) Bearing in mind all of the aforesaid, I do not consider that the evidence is sufficient to show genuine use on sweatshirts, belts, jumpers or long sleeve tops on account of, in particular, the miniscule sales and the infrequency of those sales over the relevant period. There is no evidence whatsoever in relation to any other item of clothing except t-shirts. Bearing in mind the enormity of the EU market for t-shirts, the opponent's figures are undoubtedly modest in relation to those goods. However, I come to the view that they are not so small so as to be deemed token or incapable of creating or maintaining a share in the market, particularly when one factors in the continuity of use and the geographical extent of that use over the relevant period. The picture that emerges from the evidence is that the opponent has used its mark on t-shirts on a small but frequent basis in a number of EU countries i.e. Germany, Austria and the Netherlands. I find that there has been genuine use of the earlier mark in the EU on t-shirts.

### **Framing a fair specification**

22) I now need to consider what constitutes a fair specification. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. 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) In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be

adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

24) I remind myself that the opponent’s specification, as registered, reads:

**Class 25:** Clothing for men and women, including woven and knitted clothing and clothing of leather and imitation leather, in particular, blouses, shirts, T-shirts, sweat shirts, jackets, pullovers, tops, bustiers, trousers, skirts, sets,

suits, coats, underclothing, swimwear, headgear, collar protectors, head bands, jogging and fitness clothing, gloves, belts for clothing, shoes

The specification above is very broad, consisting essentially of 'clothing for men and women' at large. In order to retain such a wide specification, I would expect genuine use to have been shown on a much wider range of clothing beyond t-shirts. In my view, the specification should be limited to that one item, as that is how the average consumer would fairly describe the use. Accordingly, a fair specification is:

**Class 25: T-shirts.**

It is this specification upon which I will base my assessment under section 5(2)(b) of the Act.

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

25) Section 5(2)(b) 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.”

26) The leading authorities which guide me are from the CJEU: *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

27) The goods to be compared are:

Opponent's goods	Applicant's goods
<b>Class 25:</b> T-shirts.	<b>Class 18:</b> Bags, Sports bags, equipment bags, parts and fitting for all the aforesaid goods. Bag used in martial arts and boxing.  <b>Class 25:</b> Clothing, footwear and head gear for Boxing and Martial arts.  <b>Class 28:</b> Apparatus, articles and equipment for use in relation to boxing, martial-arts, body-building and weight training. Boxing gloves, sporting articles, protection wear for use in relation to

	boxing and martial arts; Leather and artificial leather Gloves and boxing gloves used for martial arts; Body Shaped/Moulded padding for protecting parts of the body (Specially made for use in Sporting activities); Punching bags; Shields for use in martial arts; Accessories and fittings for all the aforesaid; Miscellaneous sportswear.
--	---

28) 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”.

29) 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.

30) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267, Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

31) In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

32) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 ('*Meric*'), the GC stated that:

“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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

33) Finally, I also bear in mind that, where it is not obvious to me that there is similarity between any of the respective goods, the onus is on the opponent to present evidence in support of its contentions that there is similarity (see, for example, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97, paragraph 22).

34) I will make the comparison by addressing each class covered by the application in turn and, where appropriate, and for the sake of expediency, group certain terms together (*Separode Trade Mark* BL O-399-10).

#### Class 18

*Bags, Sports bags, equipment bags, parts and fitting for all the aforesaid goods. Bag used in martial arts and boxing.*

35) In *Gitana SA, v OHIM*, Case T-569/11, the GC stated that:

“45. Moreover, in respect of the relationship between the ‘goods in leather and imitations of leather’ in Class 18 covered by the trade mark sought and the goods in Class 25 covered by the earlier mark, it is apparent also from settled case-law that the ‘goods in leather and imitations of leather’ include clothing accessories such as ‘bags or wallets’ made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image (‘look’) of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the impression that the

same undertaking is responsible for the production of those goods. It follows that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of 'goods made of these materials [leather and imitations of leather] and not included in other classes' in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; *exē*, paragraph 42 above, paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27)." (my emphasis)

The intended purpose of the opponent's 't-shirts' and the applicant's goods is different for obvious reasons, however, the users may be the same, they may be distributed by the same or linked manufacturers and they may sometimes share the same trade channels. In terms of a complementary relationship, whilst the opponent's 't-shirts' and the applicant's goods may, on occasion, be used together as part of a coordinated 'look', I would not expect this to be to the same extent as, for example, the coordination of dresses (and such like) with handbags/purses. It is more likely that the majority of the applicant's bags will be purchased primarily for their functional purpose (e.g. to carry sports equipment) rather than as an aesthetic accessory to t-shirts. Taking into account all these factors, I find that, whilst there is some similarity between the respective goods, it is only of a very low degree.

### Class 25

*Clothing, footwear and head gear for Boxing and Martial arts.*

36) It seems to me that the applicant's specification is a reasonably broad one such that it may include 't-shirts'. If that is right, the respective goods are identical in accordance with *Meric*. However, even if the applicant's goods do not include 't-shirts', it appears obvious to me that the respective goods would still be highly similar since the applicant's goods would include items such as boxing vests and boxing shorts. Such goods are likely to be made of the same or similar materials as 't-shirts'

and so are similar in nature, they are likely to have the same channels of trade and be sold in close proximity. The users are also likely to be the same and the goods can be considered complementary in the sense that they may be put together to create an outfit (co-ordinating a t-shirt with boxing shorts, for example). There may also be a degree of competition between the goods with a consumer choosing between purchasing a vest or a t-shirt for wear during boxing training, for example.

37) Notwithstanding the above conclusion, the broadness of the applicant's specification means that it may cover certain goods which have no similarity to the opponent's 't-shirts'. The applicant's evidence highlights, for instance, that the term 'clothing, footwear and headgear for Boxing and Martial Arts' would include specialised clothing in the form of karate and judo uniforms and karate and judo belts. In the circumstances, it is appropriate to consider whether there is any similarity between those goods and the opponent's 't-shirts'. Clearly, both types of goods are intended to be worn on the person and may be made of similar materials. However, these are very general points. There are a number of other factors which tend to point away from the goods being similar. It is not obvious to me, for instance, that the trade channels would be the same or converge significantly (and I have no evidence to the contrary), the goods do not appear to be in competition with one another (a person is unlikely to substitute a karate uniform for a t-shirt or vice versa, for example) and I cannot see that there is any meaningful complementary relationship in play. I find that there is no real similarity between the opponent's 't-shirts' and the applicant's goods insofar as the term covers karate and judo uniforms and karate and judo belts. There may also be other specialized clothing falling within the applicant's specification which is not similar to the opponent's 't-shirts'. I will return to these points later when I consider the likelihood of confusion.

#### Class 28

*Apparatus, articles and equipment for use in relation to boxing, martial-arts, body-building and weight training. Boxing gloves, sporting articles, protection wear for use in relation to boxing and martial arts; Leather and artificial leather Gloves and boxing gloves used for martial arts; Body Shaped/Moulded padding for protecting parts of the body (Specially made for use in Sporting activities); Punching bags; Shields for*

*use in martial arts; Accessories and fittings for all the aforesaid; Miscellaneous sportswear.*

38) The opponent argues that its goods are similar to the applicant's class 28 goods on the basis that they are "complementary, have common usual origin and share the same distribution channels". It provides no evidence to support these assertions. It is not obvious to me that the opponent's 't-shirts' are similar to the applicant's class 28 goods on the basis contended by the opponent. The nature of the goods is not the same. The respective purpose is different. The opponent's 't-shirts' are intended to clothe the body whereas the applicant's goods are for the specific purpose of enabling participation in sport (e.g. sporting apparatus and equipment) or protecting the body from injury (e.g. padding, shields and boxing gloves). Whilst the trade channels may sometimes converge, I would not expect this to be to a significant degree (and I have no evidence to the contrary). I also cannot see that there is any meaningful complementary relationship. I find no similarity between the applicant's goods in class 28 and the opponent's 't-shirts'.

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

39) 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."

40) The average consumer for the goods at issue is the general public. The goods will be purchased mainly by the eye from retail premises or websites. That is not to say though that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with retail staff, for example. The cost of the goods is likely to vary but given that factors such as size, colour, pattern or suitability for purpose and functionality are likely to be taken into account by the consumer, I would expect at least a reasonable degree of attention to be paid during the purchase for all of the goods and, in the case of specialised items of clothing for martial arts, the degree of attention is likely to be somewhat higher given that these are purchased for a very specific purpose.

### **Comparison of marks**


41) 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.

42) For ease of reference, the marks to be compared are:



Opponent's mark	Applicant's mark
<p><b>KNOCK OUT</b></p>	

43) The opponent's mark consists of the words KNOCK OUT presented in plain block capitals. The mark forms a unified whole upon which the overall impression is based.

44) The applicant's mark consists of more than one element. The first element is the stylised letters 'KO' with the 'K' presented in red and the 'O' in white. The second element is the words KNOCKOUT SPORTS presented in a stylised font with 'KNOCK' and 'SPORTS' presented in white and 'OUT' in black. The third element is the black rectangle upon which the other two elements are presented. Both the first and second elements are distinctive. The black rectangle serve as little more than a backdrop for the other two elements; it has the least weight in the overall impression. It is the words KNOCKOUT SPORTS which, to my mind, stand out the most and carry the greatest weight in the overall impression of the mark and, of those two words, it is the word KNOCKOUT which is the more dominant, given the obvious descriptive nature of the word SPORTS in relation to the relevant goods . The stylised letters 'KO' also make a significant contribution to the overall impression given their size and positioning but to a slightly lesser extent than the word element.

45) I now turn to consider the visual similarities between the marks, reminding myself, firstly, that the colour in the applicant's mark is not a distinguishing feature because the opponent's mark, although presented in black and white, could be used in the same colours. <sup>1</sup> Clearly there are a number of visual differences between the marks owing to the stylised letters 'KO', the word 'SPORTS' and the rectangular

---

<sup>1</sup> *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96] Kitchin LJ stated: "A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours."

background which are present in the applicant's mark but absent from the opponent's mark. The point of similarity lies in both marks containing the word(s) KNOCKOUT/KNOCK OUT. The applicant draws my attention to the KNOCKOUT part of its mark being presented as a single word whereas in the opponent's mark it is presented with a space to form two words i.e. KNOCK OUT. That is true, however, that minor difference does not overcome the striking visual similarity between those aspects of the marks notwithstanding the different fonts in which they are presented. Overall, the marks are visually similar to a moderate degree.

46) From an aural perspective, I consider it unlikely that the stylised 'KO' element will be vocalised by the average consumer. Much more likely is that the mark will be referred to solely by the word element, KNOCKOUT SPORTS or simply as KNOCKOUT. In the latter scenario, the marks would clearly sound identical; in the former, there would still be a good degree of aural similarity.

47) On the matter of how the marks will be perceived by the consumer, I note that the applicant again makes much of the presence of the space in the opponent's mark which is absent from the KNOCKOUT part of its mark. It states:

"It is submitted that Oxford Dictionary defines Knockout (noun) as 1) 'an act of knocking someone out, especially in boxing or 2) 'A tournament in which the loser in each round is eliminated'...

Please be advised that the oxford dictionary describes the word 'KNOCK' as Strike a surface noisily to attract attention...

Please also be advised that Oxford Dictionary described the word "OUT" as moving or appearing to move away from a particular place..."

I am far from persuaded that the consumer will perceive the opponent's mark as the two separate words KNOCK and OUT with the meanings put forward by the applicant. The mark will be perceived in the same manner as the KNOCKOUT part of the applicant's mark i.e. as the act of striking a person such as to render them unconscious. This will be the only concept portrayed by the opponent's mark and the

main concept portrayed by the applicant's mark (given that the stylised 'KO' part of the applicant's mark, whilst consisting of two letters, does not evoke any immediately graspable concept as such and the word SPORTS is merely descriptive of the goods). The marks are conceptually similar to a very high degree.

### **Distinctive character of the earlier mark**

48) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

The distinctiveness of the earlier mark must be assessed from the perspective of the average consumer in the UK. As the opponent's evidence shows no use of the

earlier mark in the UK, I can only take into account the mark's inherent qualities. I have already addressed how the mark will be perceived i.e. as the act of striking a person such as to render them unconscious. That is not a concept which is descriptive or allusive in relation to 't-shirts'. I find the mark to be possessed of an average degree of distinctive character.

### **Likelihood of confusion**

49) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: 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 principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) 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.*).

50) Earlier in this decision, I found the following:

- The opponent's goods are not similar to the applicant's goods in class 28.
- The opponent's goods are similar to a very low degree to the applicant's goods in class 18.
- The opponent's goods are identical, or at least highly similar, to the applicant's goods in class 25 with the exception of karate and judo uniforms and karate and judo belts and, potentially, other specialized clothing which would fall within the applicant's specification.
- The average consumer is the general public who will select the goods mainly by eye and pay at least a reasonable degree of attention. However, for specialized clothing for martial arts, the degree of attention is likely to be somewhat higher.
- The earlier mark is possessed of an average degree of distinctive character.

- The respective marks share a moderate degree of visual similarity and may be pronounced identically or, if not, there will nevertheless be a good degree of aural similarity. As to concept, the marks are similar to a very high degree.

51) As I have found that there is no similarity between the opponent's goods and the goods in class 28 of the application, the opponent has no prospect of success in that respect. In *Waterford Wedgwood plc v OHIM – C-398/07 P*, the CJEU stated:

“35....Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

Accordingly, the opposition fails in relation to all of the goods in class 28 of the application.

52) In respect of the other goods of the application, whilst I have found that the marks may be pronounced identically or will, at least, sound similar to a good degree and that there is a high degree of conceptual similarity, these factors are outweighed by my finding that the visual similarity is of only a moderate level. This is because I have found that the purchase is likely to be mainly visual and therefore the visual aspect takes on more importance.<sup>2</sup> Bearing this in mind, together with my finding that the consumer is likely to pay at least a reasonable degree of attention I do not consider that the marks will be mistaken for each other, regardless of the degree of similarity between the goods. There is no likelihood of direct confusion in respect of any of the goods.

53) Having concluded that there will be no likelihood of direct confusion I must also consider whether there is, nevertheless, a likelihood of indirect confusion (this occurs when the consumer realises that the marks are different but nevertheless puts the similarities that do exist between them down to the goods emanating from the same or

---

<sup>2</sup> *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03.

linked undertaking(s)). Weighing all of the relevant factors against each other and bearing in mind, in particular, the common presence of the KNOCKOUT/KNOCK OUT aspects (which is the sole element of the opponent's mark and the element which carries the greatest weight in the overall impression of the applicant's mark) which give rise to a very high degree of conceptual similarity, I find that, despite the additional elements and stylisation of the applicant's mark, use of those marks on identical or highly similar goods in class 25 will cause the consumer to believe that those goods come from the same or linked undertaking(s). However, in respect of the goods in class 18, I find that the very low degree of similarity between the goods, when balanced against all other factors, means there is no likelihood of indirect confusion.

54) The opposition fails in respect of:

**Class 18:** Bags, Sports bags, equipment bags, parts and fitting for all the aforesaid goods. Bag used in martial arts and boxing.

**Class 28:** Apparatus, articles and equipment for use in relation to boxing, martial-arts, body-building and weight training. Boxing gloves, sporting articles, protection wear for use in relation to boxing and martial arts; Leather and artificial leather Gloves and boxing gloves used for martial arts; Body Shaped/Moulded padding for protecting parts of the body (Specially made for use in Sporting activities); Punching bags; Shields for use in martial arts; Accessories and fittings for all the aforesaid; Miscellaneous sportswear.

55) The opposition succeeds in respect of:

**Class 25:** Clothing, footwear and head gear for Boxing and Martial arts.

## REVISED SPECIFICATION

56) In my conclusions, I have upheld the opposition against "Clothing, footwear and headgear for Boxing and Martial arts" on the basis that this term would either include the opponent's 't-shirts' or would cover highly similar goods such as, for example,

boxing shorts and boxing vests. However, if the applicant's specification were to be limited then it may be possible to register the mark for other forms of clothing, footwear and headgear for Boxing and Martial Arts. For example, earlier in this decision I concluded that specialised items such as karate and judo uniforms and karate and judo belts would not be similar to the opponent's goods. Tribunal Practice Notice 1/2012 entitled "Partial Refusal" states:

### **"3.2.2. Defended Proceedings**

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered "men's and boys' clothing", thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the "blue pencilling" approach or the "save for" type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will



simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal. “

I do not consider that my conclusions in this case can easily be reflected by “blue pencilling” or adding a “save-for” type exclusion. As such, I consider it appropriate to allow the applicant 14 days from the date of this decision to provide me with a precise list of goods it wishes to register which would fall within the term “Clothing, footwear and headgear for Boxing and Martial Arts” but which would not be similar to the opponent’s ‘t-shirts’. The applicant’s proposed list of goods should be copied to the opponent who will be allowed 14 days, from receipt by it, to comment. I will then issue a supplementary decision in which I will decide whether any proposed terms put forward by the applicant are free from objection and will also deal with the matter of costs.

57) If the applicant puts forward no revised terms in the period allowed then my supplementary decision will confirm the outcome as it stands in paragraphs 54 & 55 above i.e. the application will be refused in respect of all goods in class 25 and will proceed to registration solely in respect of the goods in classes 18 and 28.

58) The appeal period for the substantive and supplementary decisions will run from the date of the latter decision.

**Dated this 18th day of July 2016**

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