

O-390-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3108415
BY AK RETAIL HOLDINGS LIMITED
TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS:**

BADRHINO

&

badrhino

IN CLASS 25

AND

**OPPOSITION THERETO (NO. 405200) BY
RHINO RUGBY LIMITED**

Background and pleadings

1. This dispute concerns whether the following series of two trade marks should be registered for the following goods:

BADRHINO & badrhino

Articles of clothing and headgear; articles of outer clothing; articles of under clothing; nightwear; leisurewear; sportswear; bathing costumes; swimwear; neck ties, scarves; leisure clothing; tee shirts, sweat tops, hooded tops, shorts, jogging bottoms, track suits, jackets, sports tops; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

The above specification is the result of a restriction made shortly after the opposition was filed.

2. The marks were filed on 13 May 2015 by AK Retail Holdings Limited (“the applicant”) and were published for opposition purposes on 3 July 2015.

3. Rhino Rugby Limited (“the opponent”) oppose the registration of the marks under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). A further ground under section 5(4)(a) was initially pleaded, but this was withdrawn during the course of the proceedings. The opponent relies on three earlier marks as follows:

UK trade mark registration 2471901 for the mark: **RHINO PURE RUGBY**

The mark was filed on 9 November 2007 and registered on 30 September 2011. It is registered for the following goods:

Class 18: Rugby products comprising goods of leather and imitation leather, luggage, bags, umbrellas, sports bags, kit bags, ball bags, wallets and purses intended to be sold or purchased for use in connection with the game of rugby.

Class 25: Rugby clothing (but not including footwear) and rugby headgear intended to be sold or purchased for use in connection with the game of rugby.

Class 28: Sporting articles and equipment; physical training equipment and apparatus; rugby training equipment including scrummage training machines, tackle bags, contact pads, body pads, rucking nets, training poles, grid markers, protective pads and body supports; rugby ground equipment including goal posts, post padding, flags and poles; kicking tees and rugby balls.

UK trade mark registration 2535347 for the mark: **RHINO**

The mark was filed on 24 December 2009 and registered on 27 July 2012. It is registered for the following goods:

Class 25: Rugby clothing (but not including footwear) and rugby headgear intended to be sold or purchased in connection with the game of rugby; none of the aforementioned relating to the rugby league football team known as Leeds Rhinos

European Union trade mark registration 4622155 for the mark:



The mark was filed on 11 October 2005 and registered on 14 June 2012. It is registered for the following goods:

Class 18: Goods of leather and imitation leather; luggage; bags; umbrellas; sports bags; kit bags; ball bags; wallets and purses; all these goods being rugby products.

Class 25: Clothing and headgear; all these goods being rugby products.

Class 28: Sporting articles and equipment; physical training equipment and apparatus; rugby training equipment including scrummage training machines, tackle bags, contact pads, body pads, rucking nets, training poles, grid markers, protective pads and body supports; rugby ground equipment including goal posts, post padding, flags and poles; kicking tees and rugby balls; all these goods being rugby products.

4. All three earlier marks are relied upon under section 5(2)(b). Only earlier mark 2535347 is relied upon under section 5(3). It should be noted that none of the earlier marks were registered more than five years prior to the date of publication of the applicant's mark. The consequence of this is that there is no requirement for the opponent to prove that its earlier marks have been used and it may, therefore, rely on them for their specifications as registered; section 6A of the Act refers.

5. The main points made by the opponent in its statement of case are that:

- i) The applicant's mark predominantly comprises the word RHINO which is conceptually and phonetically identical, and visually similar, to the main distinctive element in the earlier marks.
- ii) The addition of BAD does nothing to distinguish the competing marks.
- iii) Every phrase of the applied for specification is the same or similar to a phrase in one or more of the earlier marks.
- iv) At least one of the earlier marks was highlighted in the search report when the applied for mark was examined by the IPO.
- v) Taking into account imperfect recollection, and the fact that the goods could be competitive or complementary, and that they might be used/purchased alongside each other, confusion may arise. Reference to the interdependency principle is also made.
- vi) It claims that the mark has a reputation and that the applied for mark would gain an unfair advantage as it "will benefit from the power of the earlier

mark's attractiveness built up through the reputation and prestige of the earlier mark. It believes that consumers may well be attracted to the applicant's goods as a result of the positive association with the earlier mark. It also claims that the use of the applied for mark would lead to a dispersion of the identity and hold of the earlier mark in the public mind."

6. The applicant filed a counterstatement containing a set of basic denials of the pleaded grounds.

7. Both sides have been professionally represented throughout the proceedings, the applicant by Urquhart-Dykes & Lord LLP, the opponent by Sanderson & Co. Both sides filed evidence. A hearing took place before me on 5 August 2016 at which the applicant was represented by Mr Tim Austin, of counsel, instructed by Urquhart-Dykes & Lord. The opponent, despite it having legal representation, choose to represent itself at the hearing; Mr Reg Clark, the opponent's managing director, attended on its behalf.

The evidence

The opponent's evidence – witness statement of Mr James Sanderson

8. Mr Sanderson is an attorney at Sanderson & Co, the opponent's representatives in this matter. There is little by way of commentary in Mr Sanderson's witness statement. He exhibits various documents such as a catalogue which the opponent distributes, a print from the opponent's website, a print from the applicant's website and a print from an associated website of the opponent. I note that in relation to the goods shown on the opponent's website, Mr Sanderson states that "[t]he Opponent has made a significant volume of sales of such clothing". The exhibits show the following:

- Exhibit JLS1 (the catalogue): This makes prominent use of the figurative earlier mark, but also RHINO in plain text a number of times. The catalogue is headed "World class products for world class rugby". There is an emphasis on the sport of rugby throughout the catalogue. The products identified in the catalogue include tackle suits/jackets/vests, head guards, training bibs, drinks bottles/carriers, whistles, tag belts, kit bags, first aid kits, team kit and male

grooming products. The catalogue is headed as “2015/16”. There is a copyright date on the back but it is very unclear - it appears to be 2015.

- Exhibit JLS2 (the opponent’s website prints): On these prints there is less emphasis on the rugby aspect of the brand, although, I bear in mind that what has been provided may not represent every page from the website. The home page, for example, could have included a rugby emphasis. Most of the pages are headed: “Rhino sportswear, teamwear & clothing – Rhino Rugby”. The products shown include: t-shirts, polo shirts, tracksuit bottoms, rugby shorts, casual shirts, what appear to be casual jackets (featuring the Union Jack), chinos, hoodies, joggers, rugby shirts (although these do not appear to be items of teamwear), compression garments, gilets, fleece hats (of a beanie style), tracksuit tops and kits bags. The pages provided are not archive prints.
- Exhibit JLS3 (the applicant’s website prints): At the top of what appears to be the homepage, there is use of the words BADRHINO above which appears a figurative representation of a rhino. The goods being sold are casual shirts, t-shirts, jackets, chinos. There are categories for “footwear” (depicting casual and formal shoes), “denim” (depicting a denim shirt), “brands” (depicting jackets and trousers) and “holiday shop” (depicting casual shorts and trousers). There is also an area called “tall shop” depicting a (tall) male model wearing various items of casual clothing.
- Exhibit JLS4 (prints from the opponent’s associated teamwear website). This appears to show teamwear for two clubs (Cardiff & Met Hockey Club and Cardiff Met Archers Basketball) which can be purchased, presumably by members of those clubs. The goods include playing tops, shorts and socks, compression garments, polo shirts, t-shirts, hoodies, zip tops, jackets, training pants, skorts, warm-up t-shirts, tracksuits, joggers, socks, bags, rucksacks.

9. The evidence is accompanied by a set of written submissions which I will take into account, to the extent necessary, during the course of my decision.

The applicant's evidence – witness statement of Ms Christine Lund-Beck

10. Ms Lund-Beck is a trade mark attorney at Urquhart-Dykes & Lord LLP. There is very little commentary in Ms Lund-Beck's witness statement. The exhibits she provides are summarised below:

- Exhibit CLB1 contains prints from the website oxforddictionaries.com. In what appears to be a blog on the website, there is a discussion of inverted meanings of words. For examples, words such as "sick", "bad" and "wicked" are sometimes used in a positive manner.
- Exhibits CLB2-4 contains prints from the IPO's/EUIPO's websites showing case details for the various earlier marks, including information about various oppositions that were lodged against them. There are also letters about the proposed restrictions between the opponent and the EUIPO. I will touch on this in more detail later.

11. The evidence is accompanied by a set of written submissions which I will take into account, to the extent necessary, during the course of my decision.

Section 5(3)

12. Section 5(3) of the Act 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 Community trade mark, 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."

13. The first hurdle is for the opponent to establish that its mark(s) have a reputation. In *General Motors* the Court of Justice of the European Union (“CJEU”) stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

14. This above places an evidential burden upon the opponent. Whilst evidence has been filed, it is singularly lacking in objective detail. The website prints and catalogues do not demonstrate the mark in use before the relevant date. The catalogue is for 2015/16, so one cannot say whether it was distributed before the relevant date in May 2015. In any event, to whom it was distributed and on what scale is not set out. The web prints are not archive prints. Mr Sanderson makes a bare assertion that significant sales have been made. There is, though, no evidence as to the length of use, no evidence of sales figures and no evidence of advertising expenditure. Many of these problems were highlighted by Mr Austin at the hearing. What has been presented falls a long way short of establishing a pre-relevant date reputation. Although shortly stated, this ground is dismissed.

Section 5(2)(b)

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

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

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

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

16. The following principles are gleaned from the judgments 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 greater 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

17. When making a comparison, all relevant factors relating to the goods in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

18. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

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

19. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

20. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

21. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd (as he then was) in *YouView TV Limited v Total Limited* where he stated:

“..... 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) (IPTRANSLATOR)* [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

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

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.”

22. There is a dispute between the parties as to the scope of the opponent’s specifications, particularly those in class 25. At the hearing both parties focused on earlier mark 2535347, for the word mark RHINO. I will do the same. Its specification reads:

Rugby clothing (but not including footwear) and rugby headgear intended to be sold or purchased in connection with the game of rugby; none of the aforementioned relating to the rugby league football team known as Leeds Rhinos.

23. In her evidence, Ms Lund-Beck notes that two oppositions were lodged against the earlier mark (which was originally for clothing and headgear but not including footwear), oppositions that were withdrawn following an amendment to the specification as set out above. It is stated that the amendment was clearly intended not to cover clothing and headgear generally nor clothing and headgear not intended to be sold or purchased in connection with the game of rugby and, therefore, the above specification represents an admission that the goods relate to specialist rugby clothing and headgear for use in the game of rugby and sold for this purpose only. The specialist nature of the clothing was something that Mr Austin emphasised at the hearing. He submitted that the specification would cover only items of clothing that were specific to the game of rugby. He highlighted the type of goods sold in the opponent’s catalogues such as tackle suits/jackets/vests, head guards as falling within the specification. He accepted that the specification would cover rugby jerseys for playing rugby, although he was more reluctant to accept that rugby shorts would fall within the scope of the specification because he did not know whether there was a specific category of rugby shorts. He did not accept that items such as joggers would fall within the scope of the specification because such items could be used for any sport (or indeed for leisure) and it was unlikely that there were specific rugby joggers.

To further exemplify Mr Austin's submission, the following is taken from his skeleton argument:

"The Applicant submits that this must be interpreted as a separate class of products have [sp] a particular nature, function or purpose rather than simply being an intended use for or style of other goods more generally".

24. Mr Austin also highlighted what the opponent stated in response to the EUIPO (previously OHIM) when correspondence was exchanged as to how its specification should be limited, albeit the correspondence was in relation to earlier mark 4622155. The original proposal from the opponent was for "Clothing, footwear and headgear; all for use in connection with the sport of rugby". This was rejected by the EUIPO because the limitation merely limited the goods to a particular form of use, or marketing mechanism etc. EUIPO suggested "[a]ll these goods being rugby products only" which the opponent accepted save for the inclusion of the word "only"; the opponent stated in its letter:

"The Examiner has suggested "all these goods being rugby products only" as an acceptable limitation. However, the Applicant believes that "all these goods being rugby products" is clear and unambiguous, because it states that "all" of the products are rugby products. The term "only" at the end of the sentence introduces grammatical uncertainty into the scope of the specification of goods".

25. In its evidence and accompanying submissions the opponent accepts that the restriction to the applicant's specification "diminishes identity", but adds that the goods are highly similar. By way of example, it submits that jogging bottoms or tracksuits bought by a rugby player will be identical to those bought by other sports people or, indeed, by a person who wears them as leisure wear or fashion clothing. This is, essentially, a submission that the goods are not necessarily specialist rugby clothing, clothing which would only be worn for playing rugby, but would also cover other items which are merely sold in connection with the sport of rugby. The use of the words "in connection with" was something picked up on by Mr Clark. He said that the opponent offered a rugby brand, but that rugby clothing should be interpreted more widely than Mr Austin suggests. He submitted that the goods could be anything bought by

someone who supports or plays rugby. In its written submissions the opponent also highlights its evidence showing that it sells leisure clothing and clothing for other sports. It submits that whilst its brand may be derived from rugby, it is not confined to that sport. It states that the average consumer understands and accepts the wider offering of goods which may be provided by undertakings of sports derived brands (such as Canterbury and Henri Lloyd).

26. The opponent's specification covers rugby clothing and rugby headwear which is intended to be sold or purchased in connection with the game of rugby. I am not sure that the ("in connection with") qualification adds a terrific amount. More focus should be placed on what is meant by rugby clothing as a term in its own right. Although, what it does not do is to expressly limit the rugby clothing/headgear to goods for playing rugby. Much depends, therefore, on the term itself, rugby clothing/headgear.

27. Simply because the term clothing is used as part of the specification does not mean that the term is a broad one covering all items of clothing. The use of the word rugby before the words clothing/headgear must be taken to have some form of impact. By way of example, denim jeans would not fall within the specification because such garments have nothing to do with rugby. That is so regardless of the opponent's evidence that it now sells leisure clothing (including items such as chinos). It matters not that what the opponent may have actually sold, what matters is what the specification as registered covers.

28. In terms of what the specification does cover, it would, for obvious reasons, cover rugby shirts and (despite Mr Austin's reluctance) rugby shorts. It should also be noted that rugby shirts would include both professional items that a rugby player may wear whilst playing the game, but also more casual types of rugby shirt and replica fan shirts. I also consider that the specification would cover items which one may wear whilst rugby training such as tracksuits, hoodies/fleeces and even jackets for cold weather training. Other items would include training t-shirts and even undergarments such as compression/support trunks. In terms of headgear, this would not include items such as scrum caps because such items fall in class 9 not in class 25. However, the terms would cover items that might be used for training, such as beanie style hats. The above may be significantly wider than Mr Austin submitted, but having regard to

the case-law, including the comments of Mr Justice Floyd (as he then was) as to fuzziness and imprecision, I consider that this represents a reasonable scope of goods that would be taken by the average consumer encountering such a term. I add that the comments made in the opponent's letter to the EUIPO does not make me doubt this view. That it considered rugby products to be clear and unambiguous does not equate to an acceptance that the goods are as limited as Mr Austin submitted.

29. It should be noted that I made similar findings to this in an earlier decision of mine (BL O-337-16). I should clarify that despite the similar findings made, I have, of course, fully considered the parties' submissions and evidence in these proceedings in reaching my conclusion, including the well put submissions made by counsel on behalf of the applicant at the hearing.

30. Having set the scope of the earlier registration, one would ordinarily turn to making a comparison with the applied for specification. However, Mr Austin made two related submissions based on the permissibility of the opponent to oppose another trade mark that was sought to be registered for goods which did not include the goods covered by the earlier mark. Before coming to the points raised, I will take one step backwards. The owner of a trade mark registration in the UK is, all other things being equal, entitled to oppose under section 5(2)(b) a similar trade mark that is sought to be registered in respect of identical or similar goods (or services). Thus, the fact that the goods of the proposed registration do not include the goods of the earlier mark does not matter, so long as the goods are similar. Of course, the combination of mark similarity and goods similarity must be balanced (along with other factors) in deciding whether there exists a likelihood of confusion – that is something I return to later.

31. The reason why Mr Austin submits that all things are not equal relates to the limitation the opponent made to its specification in order to dispose of the oppositions that had been lodged against it. He submitted that i) that action results in the opponent having limited the rights conferred by the registration and, ii) the applicant having limited its specification away from rugby products means that the opponent is estopped from opposing its application. I firstly observe that these arguments were made for the first time at the hearing before me (albeit foreshadowed in Mr Austin's skeleton argument). A defence on such a basis should have been pleaded upfront as

opposed to ambushing the opponent at the hearing. This is reason enough to dismiss the submission. However, even if it were considered, there are further problems. Section 13 of the Act reads:

“13. - (1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may;

(a) disclaim any right to the exclusive use of any specified element of the trade mark, or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly.

(2) Provision shall be made by rules as to the publication and entry in the register of a disclaimer or limitation.”

32. The opponent has clearly not entered a disclaimer in relation to its earlier mark. In relation to whether it has “agree[d] that the rights conferred by [its] registration shall be subject to a specified territorial or other limitation”, it has clearly not. Put simply, the opponent has simply narrowed the scope of its goods in negotiation with a third party in order to amicably settle an opposition. It has in no way agreed to limited the rights that are conferred upon its now registered mark, rights which include the ability to take action against marks with similar (as opposed to identical) goods. Neither can this create any form of estoppel with the world as whole. Whether any form of estoppel arises with the third party with whom an agreement was reached is not a matter for these proceedings. The submissions³ made by Mr Austin in this regard are rejected.

³ It should be noted that I did suggest at the hearing that I would consider allowing the opponent time to make reply submissions in writing given the lateness of the arguments now being made, however, given my finding, it is unnecessary to do so.

33. I turn now to a comparison of the goods, a comparison I make with reference to the applicant's goods, albeit grouping them when it is reasonable to do so.

Articles of under clothing; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

34. Items such as compression vests and undershorts are, effectively, articles of under clothing. Thus, such items for playing rugby (which would be covered by the earlier mark) are highly similar to such items for playing other sports. They will also be sold through the same trade channels such as sports shops. In this respect, I reject Mr Austin's submission that the opponent's goods will be sold only by specialist rugby shops. Whilst specialist rugby shops may exist, the opponent's goods will also be sold in sports shops more generally. In comparison to other items of under clothing (such as boxer shorts, pants and vests) the nature of the goods are still similar and, also, there is partial overlap in purpose given that whilst under clothing for playing rugby may have a particular technical characteristic, it is also an item intended to act as an additional layer between outer clothing and the body. Although the similarity in the channels of trade may be less significant, I still consider there to be a medium degree of similarity with articles of under clothing for non-sporting purposes.

Nightwear; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

35. Nightwear is not something that has any form of connection with rugby or any other sport. Whilst they are all items of clothing, the purpose is different. The opponent's goods will ordinarily be sold in a sports shop, whereas nightwear will be sold in a specific department of a general clothing retailer. Whilst I do not rule out the possibility that rugby clothing/headgear could be sold by a general clothing retailer (or more likely a department store), such sales would be in a specific area, unlikely to be in close proximity to nightwear. The goods do not compete nor are they complementary. Any similarity is, therefore, very low.

Sportswear; sports tops; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

36. Whilst the applied for sportswear does not cover rugby sportswear, the inherent nature and purpose of the goods may be extremely similar. The sportswear itself may have little or no material difference as between sports. The goods will all be sold in sports shops and may be in close proximity to each other. Garments for one sport could be used in another so creating some competition. The goods are highly similar.

Neck ties, none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

37. A neck tie has little connection with rugby other than that they can be embroidered with a rugby club logo for the purpose of, for example, wearing at club events. Ties are, instead, generally sold as an item of formalwear and, thus, are quite different in nature and purpose to rugby clothing/headgear. The channels of trade differ and there is no complementarity or competitive relationship. I consider the goods not to be similar, but if I am wrong on that then any similarity must be low.

Scarves; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

38. I doubt that scarves would ordinarily be considered as an item of rugby clothing/headgear. The nature and purpose is quite different. They could, though, be sold in a sports shop along with other articles that might be purchased as a sign of team affiliation. I consider, though, that any similarity is still of only a moderate (between low and medium) level.

Shorts, none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

39. The scope of the earlier mark would cover rugby shorts. Despite the limitation, the applied for shorts could still be used for playing sports. Thus, they may have a very similar nature and purpose. The channels of trade would overlap in that both sets of

goods could certainly be sold through sports shops. The goods may be competitive in that a pair of shorts for one sport may be suitable for use in another. Due to the contact nature of rugby, not all shorts will be suitable, but some no doubt will. I consider the goods to be highly similar. Even if the specification was limited to casual shorts, the nature may still be very similar. The channels of trade could overlap as a general clothing retailer and/or a sports retailer could still sell both, albeit perhaps in different areas. Thus, despite the fact that the exact purpose may be different, I still consider there to be a medium level of similarity with casual shorts.

Jogging bottoms, track suits, none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

40. The scope of the earlier mark would cover rugby jogging bottoms and rugby tracksuits. What I have said in relation to shorts applies in equal measure here in terms of such goods for use with other sports. In terms of jogging bottoms/tracksuits for casual wear, the distinction between such garments and those for use in sports is slim. I consider that even if the goods were limited to being casualwear, the goods are still similar to a reasonably high degree.

Tee shirts, sweat tops, hooded tops, none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

41. I come to the same conclusions, for the same reasons, as per my assessment in relation to jogging bottoms. Rugby clothing would include the more technical t-shirts that have some impact upon performance, but in reality they may have very little difference to normal t-shirts. The position is even closer when one considers sweat tops and hooded tops. Even if the goods were limited to casualwear, they are still similar to a reasonably high degree.

Bathing costumes; swimwear; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

42. A bathing costume is not something that has any real connection with rugby. Whilst they are all items of clothing, the purpose is different. Whilst it is possible that

rugby clothing could be sold in a sports shop (as can bathing costumes), or, indeed, a general clothing retailer, they are unlikely to be in close proximity to each other. The goods do not compete nor are they complementary. I consider the goods not to be similar, but if I am wrong on that then any similarity must be low

43. In terms of swimwear, I accept that this term may cover items such as Bermuda shorts which could be worn for casual purposes as well as for swimming. Whilst the assessment I made with regard to shorts is partially applicable, the fact remains that as an article of swimwear there is an even greater difference in channels of trade. I consider that any similarity is of only a moderate level (between low and medium).

Jackets; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

44. I consider that rugby clothing would include clothing in the nature of jackets perhaps for cold weather training etc. The applied for jackets would include very similar items for use in other sports and, as such, are highly similar in nature, purpose and channels of trade. Even if the goods were limited to casual jackets, the jacket in question could still be of a sort which shares many of the characteristics of a jacket worn for rugby or other sporting purposes. The goods would still be similar to a reasonably high degree despite the channels of trade being less similar.

Leisure clothing; leisurewear; articles of clothing and headgear; articles of outer clothing; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

45. All of these terms would include within their ambit goods which I have already considered and which I have found to be similar to at least a reasonably high degree.

46. I have considered whether the earlier marks' specifications beyond class 25 assist the opponent further. They do not and no argument was put forward by the opponent at the hearing that its position was improved.

47. The final point to note is that the applicant has not put forward any form of revised specification beyond the restriction that has already been applied to the specification. Nevertheless, what is clear from the applicant's website is that it sells predominantly casual clothing. The articles depicted include casual shirts, t-shirts, jackets and chinos. They also offer categories of clothing highlighted as being denim (depicting a denim shirt) brands (depicting jackets and trousers) and "holiday shop" (depicting casual shorts and trousers). I consider it appropriate to make an assessment in relation to these type of goods also, although, in respect of t-shirts, jackets and shorts, I have already done so.

48. In relation to chinos, these are long trousers worn for causal purposes. There is no obvious connection with rugby (or any other sports). Thus, the purpose and nature is different from rugby clothing/headgear and there is no meaningful overlap in channels of trade. Any similarity is low. I consider the same finding to apply in relation trousers and, also, denim jeans.

49. Casual shirts (be it denim or otherwise) are items of clothing for the upper part of the torso. I consider that rugby clothing would include rugby shirts of a more casual nature. These are similar to casual shirts to at least a medium degree.

Average consumer and the purchasing act

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

51. The average consumer will be a member of the general public, or, in the case of sportswear, members of the general public who wish to play sports and professional sports people. The goods are not overly expensive and purchased fairly frequently suggesting a purchasing process that is no higher or lower than the norm. The goods are likely to be selected from websites, brochures or physical premises. This suggests that the visual impact of the marks will take on more importance.

52. In terms of the earlier mark, the goods comprise rugby clothing/headgear. Such goods will mainly be sold through sports shops or the sportswear area of a larger store (such as a department store). However, some rugby clothing/headgear, casual rugby shirts for example, may be sold in a general clothing area as, effectively, an item of casual wear. I consider that an average level of care and consideration will be adopted during the purchasing process, again, via primarily visual means.

Comparison of marks

53. 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.”

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

55. In terms of the earlier marks, I will, again, focus on the earlier mark for the word mark: **RHINO**. In terms of overall impression, the word RHINO is its only component which, consequently, is the only thing that contributes to its overall impression.

56. The opponent's mark is to be compared with:

BADRHINO

and

badrhino

57. In terms of the overall impression of these marks, Mr Austin submitted that some consumers may not break the marks down as BAD/bad and RHINO/rhino and, further, that the word BAD/bad does not qualify RHINO/rhino. Despite these submissions, I agree with Mr Clark that it is more likely that the marks will be broken down as BAD/bad and RHINO/rhino and that, consequently, the average consumer will appreciate that the marks comprise those two words, albeit that they have been conjoined. I also consider it likely that the average consumer will construe the totalities as a meaningful combination of words i.e. that the rhino being referred to is bad. However, that does not mean that RHINO/rhino has more impact in the overall impression as, in my view, those elements make a roughly equal impact, at least visually and aurally. However, given that the word BAD/bad does qualify the RHINO/rhino in question, it may be that the RHINO/rhino aspect is the more memorable element from a conceptual point of view.

58. Conceptually, the meaning of the earlier mark is based upon the word RHINO, the name of a well-known animal. This forms the primary hook of the mark. The same can be said of the applied for marks as they too will be conceptualised upon the basis of

the same animal. However, the RHINO/rhino in question is referred to in the applied for mark as being BAD/bad. Whether this relates to a negative or positive association does not matter. Even though the RHINO in the earlier mark is not being identified as bad, the shared RHINO message provides some conceptual similarity, which I assess as reasonably high.

59. Aurally, the applicant's mark will be articulated as BAD-RHI-NO, the earlier mark as RHI-NO. Bearing in mind the overall impressions of the marks, and the similarities and differences in the articulations, I consider that there is a medium degree of aural similarity.

60. Visually, despite the addition of BAD/bad at the beginning of the applied for marks, the sharing of the word RHINO/rhino results in there being some similarity. However, given the visual differences, coupled with my assessment with regard to overall impression, this equates, in my view, to there being a medium degree of visual similarity with the earlier mark.

Distinctive character of the earlier mark

61. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *WindsurfingChiemsee 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).”

62. The comments I made earlier with regard to the opponent’s evidence applies in equal measure here. The evidence does not assist, therefore, I have only the inherent characteristics of the earlier mark to consider. The mark comprises the word RHINO. Whilst this word may give rise to some very mild suggestive connotations of strength etc., a characteristic for which rhinos are well-known, I still consider that the earlier mark has a medium degree of inherent distinctive character.

Likelihood of confusion

63. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of direct confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he 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).”

64. Mr Clark highlighted the use by the applicant of the applied for marks in conjunction with a picture of a rhino. Whilst this may represent a form of use used by the applicant, this is not relevant to my decision because, as rightly pointed out by Mr Austin, I must consider the marks before me which comprise just words. Further his

reference at the hearing to instances of confusion is likewise not pertinent given that i) there is no evidence of this and, ii) instances of confusion are rarely significant – in *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

65. Mr Clark also submitted that the use of the applied for marks could, due to the use of the word BAD/bad, be detrimental as well as confusing. Whether it is detrimental or nor is not a pertinent issue under section 5(2)(b). The simple question is whether there is a likelihood of confusion.

66. Given the interdependency principle, in that a lesser degree of similarity between the goods may offset a greater degree of similarity between the marks, it is important to consider the goods carefully, particularly given that I have assessed them as having varying degrees of similarity with the goods of the earlier mark. I start with:

Sportswear; sports tops; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

67. I found the goods to be highly similar. Although the addition of the word BAD/bad gives the applied for marks an additional concept (qualifying the rhino), and also creates a point of visual and aural difference, I consider that the average consumer has the potential to miss-remember/miss-recall the marks. Thus, when the principle of imperfect recollection is taken into account, I find that there is a likelihood of direct confusion. However, even if the average consumer did recall the difference, the shared use of the word RHINO/rhino within badrhino/BADRHINO would nevertheless indicate to the average consumer that the goods are the responsibility of the same or a related undertaking, with the use of the applicant’s marks being regarded as some form of sub-brand or brand extension. Either way, there is a likelihood of confusion. I extend this finding to:

- i) Jogging bottoms, track suits, none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.
- ii) Tee shirts, sweat tops, hooded tops, none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.
- iii) Jackets; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

68. I have assessed all of the above goods to be similar to a reasonably high degree and that the goods, even if sold for casual purposes, could still be intrinsically very similar to the equivalent rugby clothing. In such a scenario, and even bearing in mind the potential for goods such as casual clothing to cause less of an overlap in terms of channels of trade, there is still a likelihood of confusion.

69. I further extend this finding to:

- i) Articles of under clothing; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.
- ii) Shorts, none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

70. Here the goods could be highly similar to the extent that they could all be used for sporting (albeit non-rugby) related purposes. My reasoning, therefore, follows that made in relation to sportswear. If taken from the perspective of casualwear, I found the goods to still have a medium degree of similarity. I consider the intrinsic relationship between non-specialist under clothing and shorts to be sufficiently similar to rugby clothing (which will cover under clothing and shorts) that there will be either direct confusion (as explained earlier) or indirect confusion (the sub-brand or variant brand finding).

71. Finally, the finding is also extended to:

Leisure clothing; leisurewear; articles of clothing and headgear; articles of outer clothing; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

72. As all these terms cover goods for which I have found a likelihood of confusion, therefore, they must similarly be refused.

73. For the following goods, I consider that there is no likelihood of confusion:

Nightwear; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

74. I come to this view given that any similarity with rugby clothing is very low. I consider that the relationship between the goods is insufficient, even bearing in mind the level of similarity in the marks assessed earlier, and even taking into account the medium degree of inherent distinctiveness, for the average consumer to believe that the respective goods come from the same or an economically related undertaking. The common use of the word RHINO/rhino will be put down to co-incidence not economic connection.

75. I extend this finding to neckties (none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby) which I similarly held to have, at best, a low degree of similarity, and, also, bathing costumes. In relation to swimwear, even though the goods cover Bermuda shorts, such goods will be sold in the swimwear area and have a specific and differing purpose to rugby clothing, as such, there is no likelihood of confusion, when all things are borne in mind.

76. In relation to: scarves; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby, I assessed the degree of similarity as moderate (between low and medium). Whilst the goods could be sold in a sports shop, they may not be in particularly close proximity to rugby

clothing/headgear and the combination of the similarity in the marks/goods is insufficient to cause a likelihood of confusion.

77. In terms of the specification as it currently stands, the opposition fails, and the application may proceed to registration, for the following goods:

Nightwear; bathing costumes; swimwear; neck ties, scarves; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

78. The opposition succeeds, and the application is to be refused, for the following goods:

Articles of clothing and headgear; articles of outer clothing; articles of under clothing; leisurewear; sportswear; leisure clothing; tee shirts, sweat tops, hooded tops, shorts, jogging bottoms, track suits, jackets, sports tops; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

79. Before concluding, there is one final point to make. Although no revised specification was put forward prior to the hearing, I have commented above on the similarity between the types of goods shown to be sold on the applicant's website. For the record, I would place chinos, denim jeans and trousers in the same camp as the goods for which I found no likelihood of confusion. However, for casual shirts, I would place them in the same camp as the goods for which I have found a likelihood of confusion. I therefore issue the following direction:

80. The applicant for registration may, within fourteen days of the date of this decision, put forward a revised specification that:

- i) Specifically and positively identifies any further goods (that fall within the ambit of the goods of the current specification) it wishes to include in the final specification.

- ii) Such goods should be of the type, based on the rationale of my decision, which have no more than a low or moderate degree of similarity with those of the opponent.
- iii) Broad terms will not be accepted, even if they are qualified as being casual etc.
- iv) Any revised specification offered should be copied to the opponent who will be allowed fourteen days from the receipt of the same to comment.
- v) I will then issue a final decision stating which goods will be accepted and which will be refused.
- vi) That final decision will also deal with the matter of costs and will trigger the appeal period.

Dated this 12th day of August 2016

**Oliver Morris
For the Registrar
The Comptroller-General**