

**O-387-17**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 3166321  
BY NFL PROPERTIES (UK) LIMITED  
TO REGISTER THE TRADE MARK:**

**SKINS**

**IN CLASSES 25 AND 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 406996 BY HUBER HOLDING AG**

## **Background and pleadings**

1. On 24 May 2016, NFL Properties (UK) Limited (“the applicant”) applied to register the trade mark **SKINS**. The application was published for opposition purposes on 17 June 2016 for the following goods and services:

Class 25      Clothing; Footwear; Headgear; Fleece tops and bottoms; Caps; Knitted hats; T-shirts; Shirts; Turtlenecks; Sweatshirts; Shorts; Tank tops; Sweaters; Trousers; Jackets; Golf shirts; Jerseys; Wristbands; Scarves; Gloves; Ties; Cloth bibs; Sleepwear; Bathrobes; Pyjamas; Swimwear; Underwear; Socks; Sneakers and training shoes.

Class 41      Education and entertainment services in the nature of professional football games and exhibitions; Providing sports and entertainment information via a global computer network or a commercial on-line computer service or by cable, satellite, television and radio; Arranging and conducting athletic competitions, namely professional football games and exhibitions; Football fan club services; Entertainment services, namely, musical and dance performances provided during intervals at sports events; Educational services, namely, physical education programmes; Production of radio and television programmes; Live shows featuring football games, exhibitions, competitions, and musical and dance performances; Sporting, entertainment and cultural activities; Publication of texts other than publicity texts; Organisation of a professional association of sports teams; Operation of a league of football clubs; Scheduling games; Provision of information about football.

2. The application is opposed by Huber Holding AG (“the opponent”). The opposition was filed on 18 July 2016 and is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. The opponent relies upon two earlier trade marks. The first is International Registration 682040 for the trade mark shown below:

**SKINY**

However, the record indicates that “the applicant declares that he wishes the mark to be considered as a mark in standard characters”. The trade mark has an international registration date of 30 September 1997 and the UK was designated for protection on 2 November 2001. Protection was granted on 22 May 2003. Under both ss. 5(2)(b) and 5(3) the opponent relies upon all of the goods for which the mark is registered, namely “clothing, including underwear and stockings” in class 25. The opposition based upon this mark (under both grounds) is directed against all of the goods in class 25 of the specification applied for.

4. The second mark upon which the opponent relies is International Registration 1042842 for the following trade mark:

**SKINY**

The record for this trade mark also contains a declaration that the mark is to be considered as a mark in standard characters. The trade mark has an international registration date of 4 May 2010, with the UK being designated for protection on the same date. The International Registration was protected in the UK on 25 February 2011. The mark is registered for the following goods:

**Class 3:** Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

**Class 25:** Headgear, footwear, socks, stockings, bras, lingerie, underwear.

5. Under this mark, the opponent relies upon class 25 only for its opposition under s. 5(2)(b). The opposition under this ground is directed against the following goods:

Class 25      Clothing; Footwear; Headgear; Caps; Knitted hats; Sleepwear; Pyjamas; Underwear; Socks; Sneakers and training shoes.

6. The opposition under s. 5(3) based upon IR 1042842 is directed against all of the goods in class 25. The opponent relies upon all of the goods in its earlier registration.

7. Given their dates of filing, the opponent's trade marks qualify as earlier marks in accordance with s. 6 of the Act. The opponent states in its Notice of Opposition that it has used its trade marks in relation to all of the goods relied upon. This statement is made because the earlier marks are subject to the proof of use provisions contained in s. 6A of the Act.

8. The opponent claims that there is a likelihood of confusion because the marks are similar and because the goods are similar or identical. In particular, it claims that the trade marks are so similar that they are almost identical.

9. Further, the opponent claims that the earlier marks have a reputation for the registered goods and that use of the applicant's mark would, without due cause, take unfair advantage of the reputation of the earlier mark and/or be detrimental to its distinctive character. It claims that the near-identity between the marks will cause the relevant public to believe that the goods originate from the same undertaking.

10. The applicant filed a counterstatement denying the claims. It argues that the marks are short words, where "small differences are noticeable and can have considerable distinguishing effect". It also claims that the marks are both aurally and conceptually different. The applicant does not accept that the opponent has a reputation in the UK and denies that the use of the application would take unfair advantage of or be detrimental to the earlier marks. The applicant also argues that it has due cause to use the mark because "*Skins* is the contracted nickname of the *Washington Redskins* team

which plays in the NFL”. The applicant put the opponent to proof of use of the two earlier trade marks.

11. According to section 6A 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 applied for mark. The relevant period is, therefore, 18 June 2011 to 17 June 2016.

12. The opponent is represented by Thurnher Wittwer Pfefferkorn, Rechtsanwälte GmbH; the applicant is represented by White & Case LLP. Both parties filed evidence and both filed written submissions during the evidence rounds. Neither party asked to be heard and neither filed written submissions in lieu of a hearing. I have read all of the papers carefully and I will bear both parties’ comments in mind, referring to them, as necessary, below.

## **The evidence**

### Opponent’s evidence

13. The opponent’s evidence in chief has been filed in the format of the tribunal’s statement of use form, along with eight exhibits. The form has been completed by Benedikt Nußbaumer, whose address is the opponent company but who gives his title as “Head of Marketing & PR Skiny Bodywear”. The evidence is verified by a statement of truth, signed by Mr Nußbaumer, on the form itself.

14. Four invoices are exhibited, to Noonos Limited and Mio Destino Ltd, which have addresses in the UK.<sup>1</sup> Only two, dated November 2013 and January 2014, are within the relevant period.<sup>2</sup> The amounts invoiced are £808.88 and £207.85. The goods described on the invoices are pants and bras. The remaining invoices are dated February 2011 (€1260.60) and November 2016 (£278.69) for the same goods, though

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<sup>1</sup> Exhibits 1-4.

<sup>2</sup> Exhibits 2 and 3, respectively.

the later invoice also specifies items such as tank tops, camisoles and bodies.<sup>3</sup> The mark is present on all of the invoices in the following form:



15. Website prints from zalando.co.uk and amazon.co.uk are shown at exhibits 5 and 6. The logo shown above is visible on the Zalando website;<sup>4</sup> the word “Skiny” is used to identify the goods offered for sale on both of the websites. Both websites show women’s underwear and pyjamas for sale; the goods on Amazon also include men’s underwear. Exhibit 6 is said to show sportswear for sale but I can see none. The goods are priced in sterling. Neither of these exhibits is dated, save for the printing date of 19 December 2016 (i.e. after the relevant period).

16. At exhibit 7 are what Mr Nußbaumer describes as “exemplary sales numbers of the products sold under the Opponent’s marks in the UK”. The figures relate to various companies, including Noonos Limited and Mio Destino Ltd, as well as Giggiberries.co.uk. The sales totals provided are as follows:

2013	€6,664
2014	€445
2015	€7,329
2016	€5,560

17. Mr Nußbaumer explains that “deliveries to multinational retailers (such as Zalando or Amazon) are usually invoiced to the respective headquarters and, therefore, the Opponent’s sales to these companies cannot be attributed to individual countries”.

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<sup>3</sup> Exhibits 1 and 4, respectively.

<sup>4</sup> Exhibit 5, p. 1.

18. Exhibit 8 consists of an article from [www.lingerieinsight.com](http://www.lingerieinsight.com) about the launch of “Skiny Bodywear” in the UK in the autumn/winter season 2012. The article is dated 4 January 2012.

19. The opponent also filed evidence in reply to the applicant’s evidence, along with submissions. I do not summarise the submissions here but will bear them in mind. The reply evidence consists of the witness statement of Christian Wirthensohn, an attorney and partner in the opponent’s firm of professional representatives. The statement is accompanied by five exhibits.

20. Mr Wirthensohn clarifies the relationship between the opponent company and Skiny bodywear GmbH & Co KG, explaining that the latter is “a fully owned group company of Huber Holding AG and is authorized to use the “SKINY” trademark [sic] registered by Huber Holding AG”.<sup>5</sup> This statement answers the queries raised by the applicant regarding ownership and use of the marks, and the applicant has not pursued the point. That being the case, I see no need to dwell further on the matter.

21. Exhibit CW1 consists of web prints from [www.zalando.co.uk](http://www.zalando.co.uk) dated 18 May 2017 (i.e. after the relevant period). The goods offered for sale are broadly underwear (briefs, bras, “undershirts” (vests), bodies, long johns) and nightwear. There is one bikini for sale (p. 8).

22. Exhibit CW2 is a print from [amazon.co.uk](http://amazon.co.uk), showing a range of the opponent’s women’s clothing for sale. The prints are also dated 18 May 2017. The goods are mainly underwear items, though I note that some of the vests are also described as tank tops (p. 1). One of the items at p. 4 may be a nightdress or underwear but it bears no description, so it is impossible to be certain.

23. Exhibit CW3 consists of prints from [amazon.co.uk](http://amazon.co.uk), this time showing the opponent’s men’s clothing. The items are mainly underwear and nightwear, though I note that there

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<sup>5</sup> Paragraph 4.

are also some swimming trunks. There are also t-shirts and tank tops which are not specifically identified as underwear. One item is described as “Skinny Men’s Plain Sports ...” (p. 3): as the item appears to be leggings of some description, it is not clear whether these are also a base layer/underwear. The exhibit is also dated May 2017, which is after the relevant period.

24. Exhibit CW4 contains web prints from [www.fashiola.co.uk](http://www.fashiola.co.uk), again dated May 2017. The goods are mainly men’s, women’s and children’s underwear and nightwear. I note, however, that there is some men’s swimwear, women’s vests/tank tops (pp. 2-3; p. 7) and men’s t-shirts (pp. 8-9)

25. Exhibit CW5 is a “company presentation video” used by the opponent, showing the way in which the opponent pronounces its mark. No information is provided to assist in determining how or how widely this video may have influenced the average consumer’s perception of the mark.

#### Applicant’s evidence

26. This consists of the witness statement of Marcus Collins, senior associate solicitor at White & Case LLP, the applicant’s professional representatives. Two exhibits accompany Mr Collins’s witness statement. The applicant also filed written submissions with its evidence, which I have read and bear in mind but will not summarise here.

27. Exhibit MLC1 consists of screen prints from a number of websites. At p. 1, the web print is dated 4 October 2015 and refers to an American football game in London, though not one featuring the Washington Redskins. There is a reference to the author being a “Skins fan”. There are images from [www.fanatics.com](http://www.fanatics.com) and [www.store.redskins.com](http://www.store.redskins.com) showing Washington Redskins clothing (pp. 2-4). None of the prints is dated, nor is there anything (such as prices in sterling) to indicate that these items are directed at consumers in the UK. The contact telephone number at p. 3 is a US telephone number. I note that Mr Collins highlights that the number ends with digits



corresponding to the word “SKINS” on a telephone keypad. There is also an article from the *Evening Standard* about an American football game involving the Washington Redskins at Wembley. In excess of 84,000 people are said to have been in attendance (pp. 5-6). However, the article is dated 30 October 2016 (i.e. after the relevant period). The date of the game is not given but it is reasonable to assume that it was on or just prior to the date of the article. The final article is concerned with dates for fixtures for American football games being held at Wembley in 2015 (pp. 7-8). The Washington Redskins are not mentioned.

28. Exhibit MLC2 is a print from the Register regarding another of the applicant’s trade marks, for the word REDSKINS. Evidence that the applicant owns another, different, trade mark, does nothing to assist.

## **Decision**

### **Proof of use**

29. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where -

(a) an application for registration of a trade mark has been published,  
(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

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

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

30. Section 100 of the Act is also relevant, which reads:

“100. 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”.

31. 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 said:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch); [2013] F.S.R. 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G&D Restaurant Associates Ltd (SANT AMBROEUS Trade Mark)* [2010] R.P.C. 28 at [42] of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV (C-40/01)* [EU:C:2003:145]; [2003] E.T.M.R. 85, *La Mer Technology Inc v Laboratories Goemar SA (C-259/02)* [EU:C:2004:50]; [2004] E.T.M.R. 47 and *Silberquelle GmbH v Maselli-Strickmode GmbH (C-495/07)* [EU:C:2009:10]; [2009] E.T.M.R. 28 (to which I added references to *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-416/04 P)* [EU:C:2006:310]). I also referred at [52] to the judgment of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV (C-149/11)* EU:C:2012:816; [2013] E.T.M.R. 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-141/13 P)* EU:C:2014:2089 and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd (O/528/15)* [2016] E.T.M.R. 8.

218. [...]

219. 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 Bunderversvereinigung 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]”.

32. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public”

and further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable

only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted”.

33. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

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

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can

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

34. In *Laboratoire de la Mer Trade Mark* [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Mummery L.J. stated that:

"31. After some hesitation I have reached a different conclusion from Blackburne J. on the application of the Directive, as interpreted in *Ansul* and *La Mer* , to the rather slender facts found by Dr Trott.

32. Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of *consumers and end users* of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.

33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions. The modest amount of the quantities involved and the more restricted nature



of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on *that* market. That was sufficient use for it to be genuine use on the market and in *that* market the mark was being used in accordance with its essential function. The use was real, though modest, and did not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users”.

35. Neuberger L.J. (as he then was) stated that:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to

be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler”.

#### Sufficiency of use

36. The opponent’s evidence can be criticised on a number of fronts. The vast majority of the evidence is dated outside the relevant period: only two of the invoices are between the material dates. The only evidence of sales under the mark is contained in those two invoices and a statement of overall sales figures for 2013-2016, the highest of which is €7,329 for the whole of 2015. There is only one press article (which is within the relevant period), with no supporting evidence of distribution or market influence, and no evidence of advertising spend.

37. Having said that, the opponent describes the invoices in evidence as “exemplary”. The two invoices within the relevant period are to UK companies and those companies

are reflected in the global sales figures provided in Mr Nußbaumer's evidence. The evidence also shows small but consistent sales over the relevant period. None of this evidence has been challenged. As the case law above confirms, minimal use can still qualify as genuine use if it is deemed sufficient for creating market share in the sector concerned. I bear in mind that, although no figures have been provided, the sector in question is likely to be very large. However, taking the evidence as a whole, as I must,<sup>6</sup> I come to the view that the opponent has provided evidence of sales which, while far from overwhelming, is sufficient to constitute genuine use in the relevant period.

### Form of the mark

38. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person 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”.

39. Although this case was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the

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<sup>6</sup> See the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Brandconcern BV v Scooters India Limited* (“*Lambretta*”) BL O/065/14.

mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered but as part of a composite mark.

40. The evidence shows that the mark has been used in the following form:



41. I note that the opponent's marks are not figurative marks but marks to be considered as marks in standard characters. The form in which the mark has been used differs in that a reasonably stylised typeface has been used and that the word appears on a dark background. I do not consider that the use of a different typeface with moderate stylisation has a material effect on the distinctive character of the mark, which remains dominated by the word "Skinny". Nor do I consider that the use of the word in white on a dark background makes any material difference to the mark, the effect being merely that the dark background provides a contrast against which the word may be read. I find that the use shown is use of the mark as registered, or at least use of the marks in a form which does not alter the distinctive character of the marks as registered, upon which the opponent is entitled to rely.<sup>7</sup>

#### Fair specification

42. The next step is to decide whether the opponent's use entitles it to rely on all of the goods upon which it relies. 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

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<sup>7</sup> Section 6A(4)(a) of the Act refers.

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”.

43. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of

the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, 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 to 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; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46".

44. The only evidence which specifies the goods upon which the mark was used in the relevant period is two invoices. I have indicated, above, that the invoices are for various items of underwear. I note that there are goods which are identified as "bikini briefs" in exhibit 2 and that it could be argued that these items constitute swimwear. However, "bikini briefs" are also, in my understanding, a particular type of ordinary brief. There are no bikini or tankini tops itemised on the invoice to suggest that the "bikini briefs" in this context ought to be read as items of swimwear. In the remaining evidence (from outside the relevant period), there is only one example of a bikini top being sold as a separate item (exhibit CW4, p.7) and one potential example of bikini bras and briefs being sold separately (CW2, p. 2). That is, in my view, insufficient to support a finding that the mark has been used on swimwear in the relevant period. Although the opponent has claimed that its mark was used on a range of types of clothing in the relevant period, it has furnished no evidence to support that claim. Accordingly, I consider that the opponent may rely upon "underwear" in class 25, for each of its earlier marks.

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

45. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

“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”.

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

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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



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

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

### **The average consumer and the nature of the purchasing act**

47. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 in question: *Lloyd Schuhfabrik*.

48. 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”.

49. The consumer of the goods in class 25, who is a member of the public, will be attentive to ensure that the goods are suitable for their purpose and that they are, for

example, the desired fit, colour or style. I am of the view that the average consumer will pay an average degree of attention in the selection of these goods. It is my experience that the goods at issue are generally sold through bricks and mortar retail premises on the high street and their online equivalents. The goods will normally be chosen via self-selection from a shelf or the online equivalent. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court (“GC”) stated that:

“50. [...] Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion”.

50. Consequently, while I do not rule out that there may be an aural component (advice may, for example, be sought from a shop assistant), when considered overall, the selection process will be mainly visual.

### **Comparison of goods**

51. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, 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”.

52. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- 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.

53. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, 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”.

54. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

55. In *Kurt Hesse v OHIM*, Case C-50/15 P, the Court of Justice of the European Union (“CJEU”) stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“[...] 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”.

56. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes,”

whilst on the other hand:

“[...] 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”.

57. In addition, I bear in mind the guidance given by Mr Alexander in the same case, where he warned against applying too rigid a test when considering complementarity:

“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”.

#### *Clothing; underwear*

58. Both specifications include the term “underwear”. These goods are self-evidently identical. The term “clothing” encompasses the opponent’s “underwear”. These goods are identical, based on the principle identified in *Meric*.

#### *T-shirts; turtlenecks; tank tops*

59. These goods may be identical in nature to goods such as vests, whether sleeveless, long- or short-sleeved. Their purpose of covering, keeping warm or protecting a particular part of the body is the same, even if one is intended to be worn underneath other clothing. They are likely to be sold in the same clothing shops though in large retailers or department stores they may be in separate areas. They are in competition,

as one may be worn as an alternative to the other, but they are not complementary. If not identical, the goods are similar to a high degree.

#### *Sleepwear; pyjamas*

60. The opponent's "underwear" includes goods such as camisoles and boxer shorts. As the applicant's "sleepwear" and "pyjamas" are also broad terms which would cover, for example, pyjamas in the same style and fabrics, the goods may overlap in nature. There is some difference in purpose, though only to the extent that the opponent's goods are intended to be worn under other clothing. There are likely to be shared channels of trade, as the goods are commonly sold in the same retail shops or in the same sections of department stores. Whilst not complementary, the goods may be in competition, with one being purchased as an alternative to the other. The goods are similar to a high degree.

#### *Swimwear*

61. There is a good degree of overlap between the nature of these goods and that of underwear; their purpose varies in that swimwear is not intended to be worn underneath other garments but the goods' functions of coverage and support are otherwise the same. They are not only likely to be sold in the same shops as underwear but also in close proximity to one another. They are not complementary or in competition. They are similar to a high degree.

#### *Trousers*

62. I see no reason why the opponent's "underwear" would not reasonably include goods such as thermal leggings. The parties' goods are therefore similar in nature and purpose, again with the proviso that one is meant to be worn under other garments. Their channels of trade may coincide and there may be competition, with, for example, thermal underwear being sold as an alternative to thermal trousers. There may also be

a complementary relationship between the goods. These goods are similar to a reasonably high degree.

### *Shorts*

63. The nature of these goods is very similar to, for example, boxer shorts, which are covered by the opponent's "underwear". As with t-shirts, there is some similarity of purpose and a likely overlap in channels of trade. There is less likelihood that the goods will be used interchangeably and they are not complementary. The goods are similar to a medium degree.

### *Bathrobes*

64. These goods have a different purpose from underwear. They are not in competition. However, they are likely to be sold in the same retail environments, whether in the same specialist shops or in the same sections of department stores. It would not be unusual for a manufacturer of underwear to produce matching dressing gowns, all to be worn together as a set. I therefore consider that there is both some overlap in nature and that there is a complementary relationship between the goods. They are similar to a medium degree.

### *Socks*

65. It does not seem to me that "socks" would ordinarily be considered as items of underwear per se. There is, however, some similarity of purpose, to the extent that they are worn on the body underneath, for example, shoes. The nature of the goods is not the same but they are likely to share trade channels, typically being sold in the same shops or, in larger retailers or department stores, in close proximity to one another. The goods do not compete and are not complementary. Overall, they are similar to a medium degree.

*Shirts; jackets; sweatshirts; sweaters; jerseys*

66. Whilst these goods, like underwear, fall within the broad category of clothing, their purpose differs to the extent that they are outerwear rather than underwear. Their nature is different and there is neither competition nor complementarity between the goods. However, the channels of trade may overlap. The goods are similar to a low degree.

*Golf shirts*

67. Golf shirts are, in my understanding, a type of short-sleeved shirt, similar to a t-shirt but generally more formal, with a collar and buttons at the neckline. They therefore bear some resemblance in nature to underwear such as men's undershirts and, as with shirts at large, there is some similarity of purpose. They may share channels of trade but the goods are neither complementary nor in competition. They are similar to underwear to a medium degree.

*Fleece tops and bottoms*

68. "Fleece tops and bottoms" include fleece clothing sold as loungewear or nightwear. All of these goods are likely to be sold in the same retail stores, or in the same area of a department store, as underwear. There is, therefore, an overlap in channels of trade. However, the nature and purpose of the goods are different. The goods do not compete and they are not complementary. The goods are similar to a fairly low (between low and medium) degree.

*Headgear; caps; knitted hats*

69. I can see no meaningful similarity between these goods and the opponent's "underwear". The nature, purpose and method of use are all different, there is neither a



competitive nor a complementary relationship between them and they are unlikely to share channels of trade. The goods are not similar.

#### *Wristbands*

70. There is no similarity in nature, purpose or method of use between these goods and those of the opponent. They are unlikely to share channels of trade to any material extent. Whilst I accept that they may be on sale in the same department stores or large clothing stores, they are not likely to be offered for sale in the same section or in close proximity to one another. They are neither in competition nor complementary. The goods are not similar.

#### *Scarves; gloves; ties*

71. These goods are different in nature and purpose to underwear. As with wristbands, any potential overlap in channels of trade is too superficial to engage overall similarity. The goods do not compete and are not complementary. There is no meaningful similarity between these goods.

#### *Cloth bibs*

72. In the absence of evidence or submissions to the contrary, I proceed on the basis that cloth bibs are items worn by very young children over clothing to protect it, usually from food. I can see no meaningful similarity between these goods and underwear. Their nature, purpose, method of use and channels of trade are unlikely to overlap. They are not complementary and they are not in competition. There is no similarity between these goods.

### *Footwear; sneakers and training shoes*

73. Neither party has offered any comments on the scope of “footwear”. It is defined in the *Oxford English Dictionary* as “outer coverings for the feet, such as shoes, boots, and sandals”.<sup>8</sup> I recognise that socks are items worn on the feet. However, it seems to me that they are more properly described as items of clothing rather than footwear. I do not have the benefit of submissions on the point. As the definition quoted above accords with my own understanding of the term, I adopt that definition and proceed on the basis that the ordinary meaning of “footwear” does not include socks. There is no similarity in nature or purpose with underwear. The goods have different channels of trade, they do not compete and they are not complementary. There is no meaningful similarity between these goods. If I am wrong that socks are not included within ‘footwear’, these goods are similar to the opponent’s goods only to the extent indicated, above, in relation to socks.

### **Comparison of trade marks**

74. It is clear from *Sabel* (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 *Bimbo*, 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

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<sup>8</sup><[http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m\\_en\\_gb0308930?rskey=IRuBW7&result=1](http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0308930?rskey=IRuBW7&result=1)> [accessed 1 August 2017]

light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

75. It would be wrong, therefore, artificially to 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. The marks to be compared are:

Opponent's marks	Applicant's mark
<p data-bbox="391 850 602 919"><b>SKINY</b></p> <p data-bbox="349 989 651 1073"><b>SKINY</b></p>	<p data-bbox="1079 850 1177 884">SKINS</p>

76. The opponent claims in its notice of opposition that the marks are “almost identical”. It maintains that its marks are pronounced in the same way as the word “skinny” and adds in its submissions that there is no “considerable distinguishing effect” as a result of the marks ending in “Y” and “S”, respectively.<sup>9</sup>

77. By contrast, the applicant argues in its counterstatement that “[in] short words, small differences are noticeable and can have considerable distinguishing effect”. It claims that the marks are aurally different because the opponent’s marks will be pronounced “sky-nee”.<sup>10</sup> It also argues that the marks are conceptually different, because “SKINS is the plural of the dictionary word *skin*, meaning the epidermis or outer layer of

<sup>9</sup> Submissions filed on 18 May 2017.

<sup>10</sup> Paragraph 7.

something. 'SKINY' is an invented word: it would appear to be a misspelling of the dictionary word *skinny*, meaning thin or emaciated".<sup>11</sup>

78. Both of the earlier marks consist of the word "SKINY" presented in capital letters. The overall impression is dominated by the word itself; the stylisation plays only a very weak role.

79. The application consists of the word "SKINS", in capital letters. There are no other elements to contribute to the overall impression, which is contained in the word itself.

80. Visually, the marks only differ by one letter, which is the final letter of the mark ("Y" in the earlier mark and "S" in the application). I agree with the applicant to the extent that a single letter difference in a short mark can have a greater impact than it might in a much longer mark. However, in this case the different letter is at the end of the mark, which lessens the visual impact of the difference. I consider that the marks are visually similar to a reasonably high degree.

81. The opponent has filed evidence with which it attempts to demonstrate that the earlier marks are pronounced in the same way as the word "skinny".<sup>12</sup> I do not think that the evidence establishes that proposition, given that there is no accompanying information to show whether or how widely the average UK consumer would have been exposed to the presentation. Notwithstanding the inadequacy of the evidence on the point, I consider that most average consumers will perceive the earlier marks as misspellings of the word "skinny" and that they will articulate the marks as that word. I do not agree with the applicant that the average consumer will verbalise the earlier marks as "sky-nee": whilst I accept that that may be the case for some average consumers, they would, in my view, be a small minority. The application will be pronounced entirely conventionally, with the final "S" articulated. As a consequence, the

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<sup>11</sup> Ibid.

<sup>12</sup> Exhibit CW5

earlier marks consist of two syllables (SKIN-Y), in contrast to the application, which is one syllable (SKINS). The marks are aurally similar to a medium degree.

82. The application has the distinct conceptual meaning, as outlined by the applicant, of the epidermis or the outer layer of something. As I have indicated, I consider that the earlier marks will be perceived as misspellings of the word “skinny”, the consequence of which will be that they are accorded the same meaning, i.e. very thin. I think it unlikely that the average consumer will consider that the marks mean of or relating to skin, there being nothing else in the mark to suggest such a meaning (such as a hyphen after “SKIN”). The marks are conceptually dissimilar.

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

83. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, 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-2779, 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)".

84. Invented words usually have the highest degree of distinctive character, while words which are descriptive of the goods normally have the lowest. Distinctiveness can be enhanced through use of the mark. Although the opponent has not made a specific claim of enhanced distinctiveness, it has filed evidence of use. There is some evidence of sales to the UK but it is limited. There is only one example of a promotional article in the relevant period and no evidence of the market share enjoyed by the opponent. On the basis of the evidence filed, I am unable to determine that the earlier mark has an enhanced distinctive character in relation to the goods at issue in class 25.

85. Turning to the inherent position, I bear in mind that "SKINY" is not a dictionary word. It does, however, resemble the word "skinny". As a consequence, while not inherently highly distinctive, the earlier mark has an average degree of inherent distinctive character.

## Likelihood of confusion

86. If there is no similarity between the goods, there can be no likelihood of confusion.<sup>13</sup> Accordingly, the opposition against “footwear; headgear; caps; knitted hats, wristbands, scarves, gloves, ties, cloth bibs, sneakers and training shoes” is dismissed.

87. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]) and I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]). Confusion can be direct (where 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).

88. In making my decision, I bear in mind the comments of the GC in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where it noted that the beginnings of words tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’,

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<sup>13</sup> *Waterford Wedgwood plc v OHIM* (C-398/07 P (CJEU)). See also *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA.

which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar".<sup>14</sup>

89. I also remind myself of the guidance of the European courts on the correct approach when assessing whether there is a likelihood of confusion between marks which are conceptually dissimilar. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law",

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<sup>14</sup> See also *Castellani SpA v OHIM*, T-149/06 and *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, T-438/07; in *CureVac GmbH v OHIM* (T-80/08) identical beginnings between marks were not decisive.



while in *Nokia Oyj v OHIM*, Case T-460/07, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98)”.

90. I consider the position first in relation to the identical goods, which are bought with an average degree of attention by a member of the general public. The marks at issue are visually similar to a reasonably high degree and aurally similar to a medium degree. They are conceptually different. The earlier marks have an average degree of inherent distinctive character. Whilst I accept that the beginnings of the marks are likely to have a greater impact on the average consumer, the different endings are sufficiently marked that the overall impressions of the marks are capable of differentiation. That is reinforced by distinct and discrete conceptual meanings, which will act as a hook for the average consumer and which mitigate against confusion. Notwithstanding my finding that the purchase is likely to be predominantly visual, and the greater relative weight that I must consequently give to the visual similarity in the overall comparison, I consider that the different conceptual meanings are sufficient to counteract the visual similarity between the marks. Taking all of the factors into account, I come to the view that there is no likelihood of confusion, whether direct or indirect, even when the effects of imperfect recollection are taken into account.

91. It follows that, because of the interdependency principle, if there is no likelihood of confusion in relation to identical goods, there will be even less likelihood of confusion in relation to goods where there is less similarity and which are purchased in the same way, with no greater degree of attention. With regard to those goods I have found to be dissimilar, I should make it clear that, even if I am found to be wrong that there is no similarity, my finding that there is no likelihood of confusion in relation to identical goods

would still mean that the opposition fails under this ground. The opposition under s. 5(2)(b) fails.

### **Section 5(3)**

92. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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”.

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

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the

public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

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

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

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

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

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

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

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

### Reputation

94. As is clear from the case law cited above, the earlier mark must be known by “a significant part” of the relevant public for the goods relied upon in order to qualify for protection under this ground. Although the opponent has shown some sales to the UK, it has adduced only two invoices dated within the relevant period. The sales figures provided are for sums which are modest at best. There is no evidence of market share and the only relevant promotional material is one article about the brand's launch in the UK. I do not consider that the opponent has shown that its earlier mark benefits from a reputation among a significant part of the relevant public. The opposition under section 5(3) falls at the first hurdle and is dismissed accordingly.

### **Conclusion**

95. The opposition has failed and the application will proceed to registration.

## Costs

96. The applicant has been successful and is entitled to a contribution towards its costs. The applicant's evidence was of no assistance and I make no award in respect of it. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Using that TPN as a guide but bearing in mind my comments, above, I award costs to the applicant on the following basis:

Considering the Notice of Opposition and preparing the counterstatement:	£200
Considering the other side's evidence and filing submissions:	£500
<b>Total:</b>	<b>£700</b>

97. I order Huber Holding AG to pay NFL Properties (UK) Limited the sum of **£700**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 18<sup>th</sup> day of August 2017**

**Heather Harrison**  
**For the Registrar**  
**The Comptroller-General**