

**O-747-18**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION Nos. 3228701, 3228694, 3228635 & 3229819  
BY DKH RETAIL LIMITED  
TO REGISTER THE TRADE MARKS**

**WINDYACHTER**

**WINDTREKKER**

**WINDATTACKER**

**And the series of two trade marks**

**WIND HYBRID / WINDHYBRID**

**All IN CLASS 25**

**AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO  
UNDER Nos. 409751, 409752, 409763 & 409815 BY  
WIND SPORTS GMBH**

## BACKGROUND

1) On 3 May 2017, DKH Retail Limited (hereinafter the applicant) applied to register the following trade marks WINDYACHTER (3228701), WINDTREKKER (3228694) and WINDATTACKER (3228635); whilst on 9 May 2017 it applied for the series of two trade marks WIND HYBRID / WINDHYBRID (3229819) in respect of goods in class 25. All four marks applied for have an identical specification which is as follows:

- In Class 25: Clothing; casual clothing; formal clothing; sportswear; leisurewear; hooded sweatshirts; sweatshirts; printed T-shirts; T-shirts; polo shirts; short sleeved and long sleeved shirts; shirts; blouses; shorts; baggy shorts; long sleeved T-shirts; rugby tops; printed and embroidered sweatshirts; cardigans; sweaters; zip tops; joggers; trousers; jeans; knitwear; jumpers; fleece pullovers; dresses; skirts; tops; outer clothing; lined and unlined jackets; jackets; coats; trench coats; leather and imitation leather clothing; leather jackets; flatiron jackets; wax jackets; military blazers; macs; mackintoshes; gilets; hunting jackets; flax jackets; stormbreaker jackets; army jackets; blousons; suits; waistcoats; ties; leggings; socks; scarves; gloves; swimwear; belts; underwear; camisoles; bras; knickers; boxer shorts; underpants; slips [undergarments]; nightwear; pyjamas; bathrobes; dressing gowns; footwear; sandals; beach shoes; flip flops; canvas shoes; boots; shoes; leather shoes; slippers; headgear; hats; caps; bandanas; beanies.

2) The applications were examined and accepted, and subsequently published for opposition purposes on 12 May 2017 in Trade Marks Journal No.2017/019 (3228701, 3228694 & 3228635) and 19 May 2017 in Trade Marks Journal No.2017/020 (322819).

3) On 11 July 2017 Wind Sportswear GmbH (hereinafter the opponent) filed notices of opposition, subsequently amended and consolidated. The last change was made two days prior to the hearing, when the opponent reduced further the number of trade marks it relies upon in the oppositions and it also dropped the ground of opposition under section 5(4)(a). The opponent is the proprietor of the following trade marks:

| Mark        | Number         | Dates             | Class | Specification relied upon  |
|-------------|----------------|-------------------|-------|--|
| <b>wind</b> | EU<br>11901162 | Filed<br>14.06.13 | 18    | Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal |





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|  |  | Date of entry in register<br>27.11.13 | skins, hides; Trunks and travelling bags; Umbrellas, parasols, and walking sticks; Whips, harness and saddlery; Briefcases; Slings for carrying infants; Beach bags; Clothing for pets; Alpenstocks; Harness fittings; Pocket wallets; Bags for campers; Chamois leather, other than for cleaning purposes; Kid; Attaché cases; Boxes of leather or leather board; Boxes of vulcanised fibre; Net bags for shopping; Shopping bags; Casings, of leather, for springs; Sleeves, of leather, for springs; Coverings of skins [furs]; Umbrella or parasol ribs; Nose bags [feed bags]; Bits for animals [harness]; Walking sticks; Purses; Harness for animals; Goldbeaters' skin; Parts of rubber for stirrups; Collars for animals; Valises; Suitcases; Suitcase handles; Handbags; Handbag frames; Cattle skins; Curried skins; Horseshoes; Waist pouches; Dog collars; Dog leads; Hat boxes of leather; Game bags [hunting accessories]; Card cases [notecases]; Cases, of leather or leatherboard; Chain mesh purses; Sling bags for carrying infants; Chin straps, of leather; Garment bags for travel; Cat o' nine tails; Knee-pads for horses; Luggage boxes; Leather leashes; Vanity cases, not fitted; Toiletry kits; Imitation leather; Leather, unworked or |
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|  |  |  | <p>semi-worked; Leather twist; Girths of leather; Imitation leather; Leatherboard; Straps of leather (saddlery); Leather straps; Leather laces; Valves of leather; Straps for soldiers' equipment; Muzzles; Leather trimmings for furniture; Furniture coverings of leather; Moleskin [imitation of leather]; Music cases; Whips; Fur; Horse blankets; Halters; Horse collars; Umbrellas; Umbrella handles; Travelling trunks; Trunks [luggage]; Travelling sets [leatherware]; Travelling bags; Butts [parts of hides]; Backpacks; Bags for climbers; Riding saddles; Saddle trees; Covers for horse-saddles; Fastenings for saddles; Saddlery; Boxes of leather or leather board; Blinders [harness]; Umbrella covers; Frames for umbrellas or parasols; Umbrella rings; Umbrella sticks; Straps for skates; Key cases [leatherware]; School bags, satchels; Bandoliers; Walking stick seats; Parasols; Bags for sports; Stirrups; Stirrup leathers; Canes; Walking cane handles; Wheeled shopping bags; Bags; Pelts; Haversacks; Bridoons; Shoulder belts; Pads for horse saddles; Pouches, of leather, for packaging; Hiking poles; Tool bags of leather, empty; Gut for making sausages; Harness straps; Reins; Bridles [harness]; Traces [harness].</p> |
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|  |  |  | 35 | Advertising services for others; Retail services and wholesale services, including via the Internet, in relation to soaps for personal use, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses, clothing, footwear, headgear, gymnastic and sporting articles, towels. |
|--|--|--|----|---|

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|-----------------|----------------|---|----|--|
| sun. fun. wind. | EU<br>11739844 | Filed<br>15.04.13<br>Entry in<br>register<br>28.08.13 | 25 | Clothing, footwear, headgear; Heels; Heelpieces for footwear; Suits; Layettes [clothing]; Babies' pants; Swimsuits; Bathing trunks; Bath robes; Bathing caps; Bath sandals; Bath slippers; Bandanas (scarves); Berets; Clothing of imitations of leather; Motorists' clothing; Clothing; Paper clothing; Boas [necklets]; Teddies [undergarments]; Brassieres; Bodices (lingerie); Chasubles; Dresses; Shower caps; Inner soles; Pocket squares; Masquerade costumes; Mittens; Fishing vests; Football boots; Foodstuffs, not electrically heated; Gabardines [clothing]; Galoshes; Spats; Money belts [clothing]; Non-slipping devices for boots; Belts [clothing]; Clothing for gymnastics; Gymnastic shoes; Half-boots; Scarfs; Gloves [clothing]; Slipper; Slips [undergarments]; Ladies' shirts; Shirt yokes; Shirts; Detachable collars; Shirt fronts; Wooden shoes; Trousers; Gaiter straps; Suspenders; Girdles; Hats; Hat frames [skeletons]; Jackets |
|-----------------|----------------|---|----|--|



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|  |  |  |  | <p>[clothing]; Jerseys [clothing]; Stuff jackets [clothing]; Skull caps; Hoods [clothing]; Ready-made linings [parts of clothing]; Pockets for clothing; Ready-made clothing; Wimpels; Headgear for wear; Camisoles; Corsets [underclothing]; Shoulder wraps; Neckties; Ascots; Bibs, not of paper; Clothing of leather; Underwear; Sweat-absorbent underclothing (underwear); Liveries; Maniples; Cuffs; Coats; Pelisses; Mantillas; Corselets; Miters [hats]; Dressing gowns; Muffs [clothing]; Caps [headwear]; Cap peaks; Outerclotting; Ear muffs [clothing]; Combinations [clothing]; Slippers; Paper hats [clothing]; Parkas; Pelerines; Furs [clothing]; Petticoats; Pullovers; Pyjamas; Cyclists' clothing; Waterproof clothing; Skirts; Sandals; Saris; Collar protectors; Sashes for wear; Sleepsuits; Sleep masks; Veils [clothing]; Breeches for wear; Lace boots; Fittings of metal for shoes and boots; Shoes; Welts for boots and shoes; Soles for footwear; Footwear uppers; Tips for footwear; Footwear; Smocks; Aprons [clothing]; Dress shields; Ski gloves; Ski boots; Underpants; Socks; Sock suspenders; Boots for sports; Sports shoes; Boots; Boot uppers; Headbands [clothing]; Esparto shoes or sandals; Shawls; Fur stoles; Studs for football boots; Beach</p> |
|--|--|--|--|---|



|   |               |   |    |  |
|---|---------------|---|----|--|
|   |               |   |    | clothes; Beach shoes; Garters; Stockings; Sweat-absorbent stockings; Heelpieces for stockings; Stocking suspenders; Tights; Sweaters; Tee-shirts; Togas; Knitwear [clothing]; Singlets; Turbans; Topcoats; Uniforms; Underwear; Anti-sweat underwear; Pants; Underclothing; Leggings; Underwear; Wet suits for water-skiing; Vests; Hosiery; Top hats. |
|   |               |   | 35 | Advertising services for others; Retail services and wholesale services, including via the Internet, in relation to soaps for personal use, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses, clothing, footwear, headgear, gymnastic and sporting articles, towels.  |
| <b>wind</b>   | EU<br>7332455 | Filed<br>21.10.08<br>Entry in<br>register<br>22.09.09       | 25 | T-shirts, sweatshirts, jumpers, shirts, polo-shirts, blouses.  |
|  | EU<br>4854147 | Filing date<br>24.01.06<br>Entry in<br>register<br>05.12.06 | 18 | Leather and imitations of leather and goods made of these materials, in particular bags, small leather goods, purses, wallets, key cases, belts for clothing, not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.                                     |
|   |               |   | 25 | Clothing, footwear, headgear, in particular T-shirts, jackets, sweatshirts,  |





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|  |  |  |  | sweatpants, caps, scarves, gloves, swimwear. |
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4) The opponent contends that its marks and the marks applied for are very similar and that the goods applied for are identical or similar to the goods / services for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Act.

5) On 11 January 2018 the applicant filed counterstatements, basically denying all the grounds, pointing out the differences between the parties' marks. It puts the opponent to strict proof of use of its marks EU 7332455 & EU 4854147 on all goods for which they are registered. It also states that the word "wind" when used upon outerwear is of "little distinctive character as it is widely used to indicate that a garment is wind proof".

6) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 15 November 2018 when Mr Sherlock of Messrs Superdry Plc represented the opponent; the applicant was represented by Mr Wood of Wood IP Ltd.

## **OPPONENT'S EVIDENCE**

7) The opponent filed a witness statement, dated 16 May 2018, by Frank Terstiege the CEO of the opponent company a position he has held since January 2008. He states that his company has used all of the marks relied upon in the oppositions in Germany upon clothing and headgear. The clothing is sold through shops owned by the opponent and also through licensees. As of 1 January 2018 these stores numbered 57. He states:

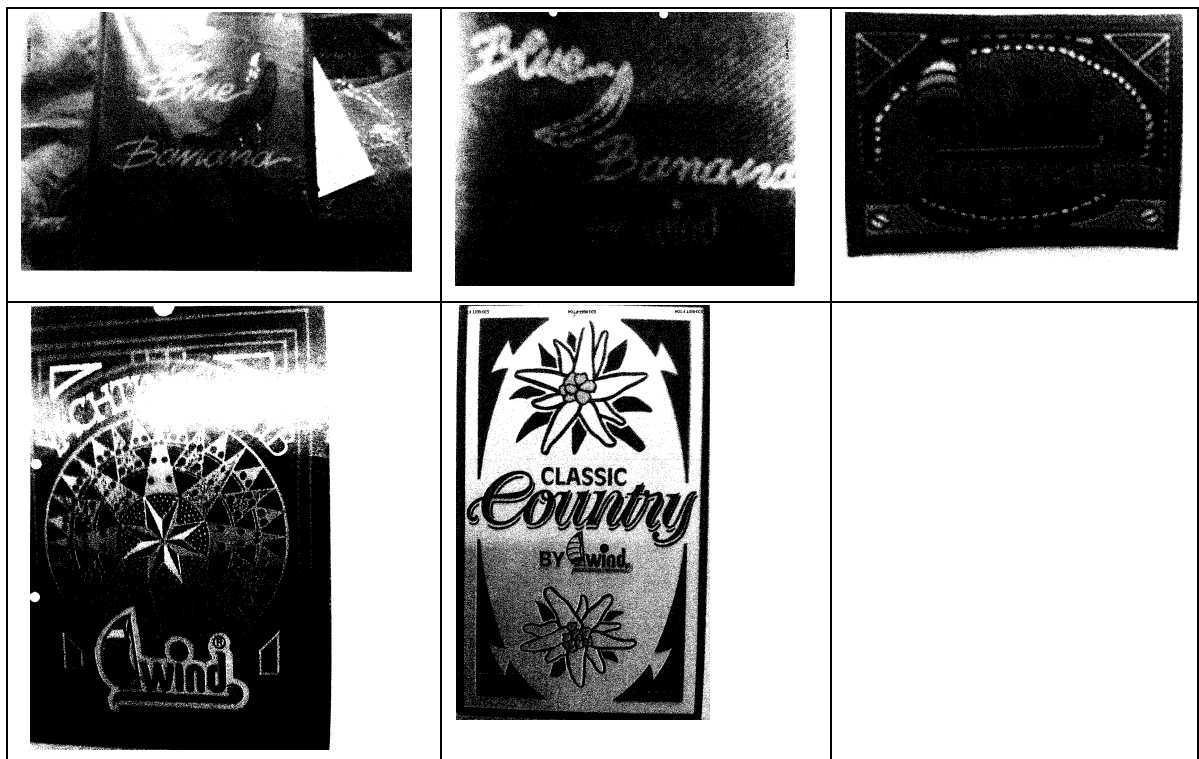
"21. My company sells a lot of clothing under our trade marks. During the period at paragraph 2 within the European Union were [sic] more than €5,000,000 (five million euro)" [It is unclear what paragraph 2 is being referred to by the opponent, and therefore what period is being referred to as paragraph 2 of the witness statement contains no such dates].

And:

"23. In addition to having sales of more than €5,000,000 every year during the period 2011 to 2017 we spent between €150,000 and €250,000 each and every year advertising and promoting our trade mark."

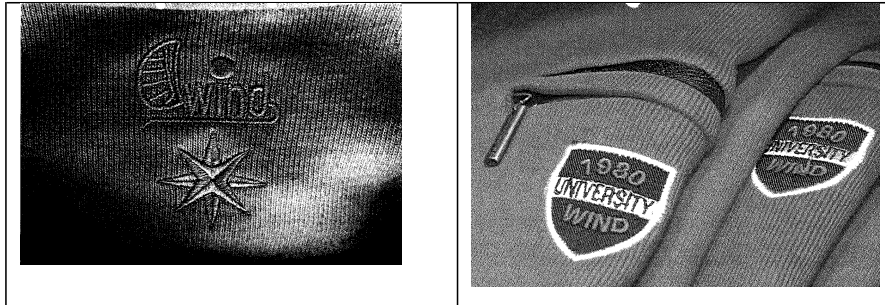
8) He provides the following exhibits:

- FT02 & 3: shows photographs of the outside and inside of some of these stores and the mark EU 4854147 can clearly be seen, on the frontage and internally, as the shop name. Also shown in the photographs are numerous items of clothing. One photograph (page 4) shows the mark EU 4854147 without the word “sportswear” underneath the “wave” device on hangers with knitted jumpers on them. The “wave” device is different from the one in EU 4854147 being identical to that in EU 4855227 (see paragraph 24 below). None of the photographs are dated.
- FT04, 5 & 6: Examples of hangtags and labels affixed to items of the opponent’s clothing which show use of trade marks EU 4854147, EU 4855227 & a variant of EU 4854147 without the word SPORTSWEAR underneath the wave device and where the “wave” device is different from the one in EU 4854147 being identical to that in EU 4855227. None of the photographs are dated. They also show use of the following marks on pages 3,4,7,8 &9 of exhibit FT04:



- FT07: An undated photograph of a carrier bag with mark EU 4854147 upon it.

- FT08: a photograph said to be the outside of a parcel, which appears to be dated 19 April 2013, and which has the mark EU 4854147 upon it.
- FT09: Undated photographs of various labels used upon clothing. These show use of trade mark EU 4855193 (see paragraph 24 below) upon a jumper and the two images from pages 3 & 4 below:



- FT10: Copies of 44 pages, dated 15 May 2018 (outside the proof of use period), from the opponent’s internet site which shows clothing such as shirts, blouses, polo shirts, jackets, fleeces, hats, scarves, sweatshirts, dresses, skirts, trousers sold under trade mark EU 4854147 and also the plain text words “wind sportswear”.
- FT11: Copies of catalogues for the years 2012, 2015 & 2016. No details are provided as to whom they were sent to, where the recipients lived or the number of catalogues distributed. These show various items of clothing being offered for sale (shirts, shorts, jackets, trousers and fleeces) under the marks EU 4854147 and EU 11739844.
- FT12: Copies of eleven invoices dated between September 2013 and October 2017. These are all addressed to premises in Germany and show use of trade mark EU 4854147 and the plain words “wind sportswear”. There appear to be items of clothing on some invoices, whilst another is clearly for software and another appears to be gift vouchers of some sort. As they are all in German it is somewhat unclear precisely what is being sold.
- FT13: Examples of advertising which would seem to consist mostly of sponsoring sporting events. Trade mark EU 4854147 and the plain words “wind sportswear” can be seen on competitor’s kit, flags and advertising hoardings at the events. These are dated August 2012 and September 2016.

## APPLICANT'S EVIDENCE

9) The applicant filed a witness statement, dated 13 August 2018, by Thomas Allister Webb, the in-house trade mark attorney for Superdry plc, which owns the applicant company. He states that his company already has as registered marks, for class 25 goods, in the UK the following words, WINDCHEATER, WINDSPRINTER, WINDTRACER, WINDTRAINER and WIND FADER. He further states:

“9. The word WIND is used by a number of brands in relation to jackets and other outerwear items as a prefix together with another word element to provide more distinctiveness and identify to the name used. The WIND element is used to describe the qualities and characteristics of the garment in that it provides protection from the wind (either wind-resistant or wind-proof).

10) Mr Webb provides at exhibit TAW4 pages from the internet which shows that a number of brands use the terms “windbreaker” and “windcheater” in a descriptive manner and not as a trade mark.

## DECISION

11) The only ground of opposition is under section 5(2)(b) which reads:

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

(a) .....

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

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

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

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

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

13) The opponent is relying upon its trade marks listed in paragraph 3 above which are all clearly earlier trade marks. The instant marks were published on 12 and 19 May 2017. As two of the earlier marks (EU 7332455 & EU 4854147) were registered on 22 September 2009 and 5 December 2006 respectively the proof of use (pou) requirements apply. However, the pou requirements do not apply to EU marks 11901162 registered 27 November 2013 and EU 11739844 registered 28 August 2013. The pou periods are therefore 13 May 2012 – 12 May 2017 and 20 May 2012 – 19 May 2017. Section 6 reads as follows:

“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 European Union 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 Union.

(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.”

14) Section 100 of the Act states that:

“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.”

15) When considering the pou issue I look to the case of *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, where Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159

and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] *ETMR* 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [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).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

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 Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [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].”

16) In the instant case the opponent’s marks are EU registered trade marks. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

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

17) The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

18) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used

in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

19) The General Court (GC) restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

20) Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown

- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

21) I note that the opponent operates a number of shops. However, the turnover has not been split to differentiate between the stores the opponent owns and the stores of others who happen to sell the opponent's goods. Nor are any figures given separately for sales upon the internet. Further, whilst it is clear that a great number of marks are used by the opponent, it is not clear if these are the only marks used within its stores. I also note that no breakdown has been provided to differentiate between the goods which vary from, broadly speaking, clothing to whips to leashes, and services which vary from advertising services, to sales of cosmetics, perfumes and clothing. In *Netto Marken*, Case C-420/13, the CJEU held that it was possible to register a trade mark for services involved in the bringing together of other services, even where some of the latter services were provided by the trade mark proprietor itself. The court explained that:

“...even though the assortment of services offered by Netto Marken-Discount could include services provided by itself, that in no way casts doubt on the fact that the supply described in its application for registration, by means of the words ‘the bringing together, for the benefit of others, of a variety of services enabling customers conveniently to purchase those services’, is capable of being categorised..... as a service. At the risk of depriving the applicant in the main proceedings of the possibility of having that sign registered as a trade mark with respect to that bringing together service, its application for registration with respect to Class 35 of the Nice Classification cannot be rejected on the sole ground that the assortment of services which it intends to provide to the consumer could also include services offered by itself.”

22) I also note that in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, 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.”

23) Whilst 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.”

24) Whilst the opponent has provided some evidence of use of some of its marks it is unclear what marks the figures for turnover and advertising relate to. On the original form TM& the opponent stated that it was relying upon 15 trade marks. It positively stated that it had used eleven of these within the last five years (from the date of the TM7), with regard to the other four marks it did not tick either the “yes” or “no” box in answer to the question “Has the trade mark been used?”. The following eleven trade marks are those where a positive statement of use was made.

| Mark  | Number        | Mark  | Number        |
|---|---------------|---|---------------|
|  | M718313       | OCEAN WIND  | EU<br>8769895 |
| wind men  | EU<br>8612335 |  | M702264       |
| wind  | EU<br>7332455 | wind yachting club  | EU 8243586    |
|   | EU<br>4855227 | wind sailing  | EU 8243057    |
|   | EU<br>4855193 | sea wind  | EU 6586127    |

|   |               |  |  |
|---|---------------|--|--|
|  | EU<br>4854147 |  |  |
|---|---------------|--|--|

25) The following four marks are those where the question of use was not answered upon the TM7. However, Mr Terstiege did state in his statement that all the marks relied upon had been used.

| Mark         | Number      | Mark            | Number   |
|--------------|-------------|-----------------|----------|
| Nordsee wind | EU 10795037 | wind            | 11901162 |
| Ostsee wind  | EU 10795045 | sun. fun. wind. | 11739844 |

26) I also note that the evidence shows use of other marks, which are:





27) The turnover and advertising figures would appear to relate to all of the marks above in paragraphs 24-26 inclusive. I must therefore decide whether these marks can be considered to be use of a mark in a different form, or as part of or with another mark. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.



35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' with in the meaning of

Article 15 (emphasis added)  
(1)".

28) Whilst 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."

29) Although this cases 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 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.

30) It is obvious that a number of the marks have within them an image of a yacht with a spinnaker sail stretched by the wind. This device appears in numerous places such as a) at the start of the mark; b) in the middle of the mark between the prefix "wind" and another word; and c) as part of the word "wind" where it replaces the letter "l". The dot above letter "l", or in one case above the sail, is significantly over scale and has the appearance more of an image of the sun. Three also have one of two versions of a sea device, the differences being notable. These devices are quite powerful and would be clearly seen by the average consumer. Use of the word "wind" in plain font (whether lower

or upper case is of no regard) is to my mind a mark which has a different distinctive characteristic and

is therefore not use of the same mark. There are a number of marks where the word “wind” precedes words which alter its meaning such as “wind sailing”. In other instances the word “wind” is used as a suffix to other words which again completely alters the conceptual meaning of the mark. To my mind, whilst there are a few marks which would be acceptable as use of a mark in a different form or use of a mark within another mark, there is no way that all of the above marks can be so regarded. It was entirely within the opponent’s control to have provided turnover figures for each of the marks or groups which would confirm with the law and could be considered a single mark. Instead it chose to rely upon a plethora of marks but then simply provided evidence as if the marks were all the same mark and that use of any one of the marks would count as use of any of the remainder.

31) Even if I simply consider the four trade marks which were on the final version of the TM7 provided by the opponent (see paragraph 3 above), these also fail the tests set out above as they do not have a single mark which appears in each trade mark as part of the overall mark, nor can they be considered marks which are different but without affecting the distinctive character.

32) At the hearing Mr Sherlock asked me to simply consider the four marks now relied upon, He stated that the photographs of the shops showed use of the mark 4854147, that the same mark was used upon the catalogues and also the invoices. He accepted that the photographs of the shops were not dated but stated that as the catalogues and invoices were within the periods being considered. It was accepted that the turnover and advertising figures were not attributed to each mark or broken down into the respective goods and services, however it was contended that I could infer that the marks had been used from the photographs, catalogues, invoices and statement of Mr Terstiege. As pointed out earlier there were no details as to the distribution of the catalogues, the invoices being in German it was not possible to state that all the items upon them were clothing. Whilst I could identify some items of clothing it was also clear that the invoices related to software and some form of vouchers. As to comments within the witness statement some of these are unclear, possibly as a result of the witness being less able than he thought in written English. I am unwilling to infer use when it would have been relatively simple for the opponent to provide proper evidence which would have left no room for ambiguity or doubt. I also note that a number of examples of use are use of a mark which differs to the registered mark 4854147. To my mind, the opponent has failed to show use of its marks which fell within the pou provisions and so it cannot rely upon any of these marks under the section 5(2)(b) ground. The section 5(2)(b) ground will therefore only be considered on the basis of the opponent’s trade marks EU 11901162 and EU 11739844.

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

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

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

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

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

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

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

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

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

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

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

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

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

34) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

35) The applications are for, broadly speaking clothing footwear and headgear, whilst the opponent's marks cover differing areas. 11901162 is registered for, broadly speaking, leather goods and bags in

class 18 and clothing retail in class 35. 1739844 is registered for clothing footwear and headgear. The consumers for such goods and services would be the general UK public including businesses. The will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial selection is therefore primarily visual. It is clear that some of the goods will be researched or discussed with a member of staff. The latter, along with personal recommendations, bring aural considerations into play. The consumers of retail services will be the same UK public, the initial selection will mostly be made visually either from outside the shop or online. A retail outlet could also be recommended verbally so aural consideration also need to be taken into account. I note that in *New Look Ltd v OHIM Cases T-117/03 to T-119/03 and T-171/03*, the GC said this about the selection of clothing:

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

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

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

37) Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of clothing/footwear/headgear such as socks/slippers/cap the average consumer will pay attention to

considerations such as size, colour, fabric and cost. I believe that the same considerations and conclusions would be reached in respect of the class 24 goods and the class 35 retail services. **Overall the average consumer for these types of goods and services is likely to pay a medium degree of attention to the selection of items of clothing, footwear, headgear, leather goods, bags, and retail services.**

### **Comparison of goods and services**

38) In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

“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”.

39) Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

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

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

41) In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM*) case T-133/05, the GC stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 *Vedial V OHIM France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

42) I also take into account the case of *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, where the GC pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06



P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

43) The specifications of both sides are reproduced below for ease of reference:

| Opponent’s goods and services   | Applicant’s goods  |
|---|--|
| <p>11901162 Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas, parasols, and walking sticks; Whips, harness and saddlery; Briefcases; Slings for carrying infants; Beach bags; Clothing for pets; Alpenstocks; Harness fittings; Pocket wallets; Bags for campers; Chamois leather, other than for cleaning purposes; Kid; Attaché cases; Boxes of leather or leather board; Boxes of vulcanised fibre; Net bags for shopping; Shopping bags; Casings, of leather, for springs; Sleeves, of leather, for springs; Coverings of skins [furs]; Umbrella or parasol ribs; Nose bags [feed bags]; Bits for animals [harness]; Walking sticks; Purses; Harness for animals; Goldbeaters' skin; Parts of rubber for stirrups; Collars for animals; Valises; Suitcases; Suitcase handles; Handbags; Handbag frames; Cattle skins; Curried skins; Horseshoes; Waist pouches; Dog collars; Dog leads; Hat boxes of leather; Game bags [hunting accessories]; Card cases [notecases]; Cases, of leather or leatherboard; Chain mesh purses; Sling bags for carrying infants; Chin straps, of leather; Garment bags for travel; Cat o' nine tails; Knee-pads for horses; Luggage boxes; Leather leashes; Vanity cases, not fitted; Toiletry kits; Imitation leather; Leather, unworked or semi-worked; Leather twist; Girths of leather; Imitation leather; Leatherboard; Straps of leather (saddlery); Leather straps; Leather laces; Valves of leather; Straps for soldiers' equipment; Muzzles; Leather trimmings for furniture; Furniture coverings of leather; Moleskin [imitation of leather]; Music cases; Whips; Fur; Horse blankets; Halters; Horse collars; Umbrellas; Umbrella handles; Travelling trunks; Trunks [luggage]; Travelling sets [leatherware]; Travelling bags; Butts [parts of hides];</p> | <p>In Class 25: Clothing; casual clothing; formal clothing; sportswear; leisurewear; hooded sweatshirts; sweatshirts; printed T-shirts; T-shirts; polo shirts; short sleeved and long sleeved shirts; shirts; blouses; shorts; baggy shorts; long sleeved T-shirts; rugby tops; printed and embroidered sweatshirts; cardigans; sweaters; zip tops; joggers; trousers; jeans; knitwear; jumpers; fleece pullovers; dresses; skirts; tops; outer clothing; lined and unlined jackets; jackets; coats; trench coats; leather and imitation leather clothing; leather</p> |

|   |   |
|---|---|
| <p>Backpacks; Bags for climbers; Riding saddles; Saddle trees; Covers for horse-saddles; Fastenings for saddles; Saddlery; Boxes of leather or leather board; Blinders [harness]; Umbrella covers; Frames for umbrellas or parasols; Umbrella rings; Umbrella sticks; Straps for skates; Key cases [leatherware]; School bags, satchels; Bandoliers; Walking stick seats; Parasols; Bags for sports; Stirrups; Stirrup leathers; Canes; Walking cane handles; Wheeled shopping bags; Bags; Pelts; Haversacks; Bridoons; Shoulder belts; Pads for horse saddles; Pouches, of leather, for packaging; Hiking poles; Tool bags of leather, empty; Gut for making sausages; Harness straps; Reins; Bridles [harness]; Traces [harness].</p>   | <p>jackets; flatiron jackets; wax jackets; military blazers; macs; mackintoshes; gilets; hunting jackets; flax jackets; stormbreaker jackets; army jackets; blousons; suits; waistcoats; ties; leggings; socks; scarves; gloves; swimwear; belts; underwear; camisoles; bras; knickers; boxer shorts; underpants; slips</p> |
| <p>11901162 Class 35: Advertising services for others; Retail services and wholesale services, including via the Internet, in relation to soaps for personal use, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses, clothing, footwear, headgear, gymnastic and sporting articles, towels.</p>   | <p>[undergarments]; nightwear; pyjamas; bathrobes; dressing gowns; footwear; sandals; beach shoes; flip flops; canvas shoes; boots; shoes; leather shoes; slippers; headgear; hats; caps; bandanas; beanies.</p>  |
| <p>11739844: Class 25: Clothing, footwear, headgear; Heels; Heelpieces for footwear; Suits; Layettes [clothing]; Babies' pants; Swimsuits; Bathing trunks; Bath robes; Bathing caps; Bath sandals; Bath slippers; Bandanas (scarves); Berets; Clothing of imitations of leather; Motorists' clothing; Clothing; Paper clothing; Boas [necklets]; Teddies [undergarments]; Brassieres; Bodices (lingerie); Chasubles; Dresses; Shower caps; Inner soles; Pocket squares; Masquerade costumes; Mittens; Fishing vests; Football boots; Foodstuffs, not electrically heated; Gabardines [clothing]; Galoshes; Spats; Money belts [clothing]; Non-slipping devices for boots; Belts [clothing]; Clothing for gymnastics; Gymnastic shoes; Half-boots; Scarfs; Gloves [clothing]; Slipper; Slips [undergarments]; Ladies' shirts; Shirt yokes; Shirts; Detachable collars; Shirt fronts; Wooden shoes; Trousers; Gaiter straps; Suspenders; Girdles; Hats; Hat frames [skeletons]; Jackets [clothing]; Jerseys [clothing]; Stuff jackets [clothing]; Skull caps; Hoods [clothing]; Ready-made linings [parts of clothing]; Pockets for clothing; Ready-made clothing; Wimpels; Headgear for wear; Camisoles; Corsets [underclothing]; Shoulder</p> | <p>shorts; underpants; slips [undergarments]; nightwear; pyjamas; bathrobes; dressing gowns; footwear; sandals; beach shoes; flip flops; canvas shoes; boots; shoes; leather shoes; slippers; headgear; hats; caps; bandanas; beanies.</p>  |

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| <p>wraps; Neckties; Ascots; Bibs, not of paper; Clothing of leather; Underwear; Sweat-absorbent underclothing (underwear); Liveries; Maniples; Cuffs; Coats; Pelisses; Mantillas; Corselets; Miters [hats]; Dressing gowns; Muffs [clothing]; Caps [headwear]; Cap peaks; Outerclothing; Ear muffs [clothing]; Combinations [clothing]; Slippers; Paper hats [clothing]; Parkas; Pelerines; Furs [clothing]; Petticoats; Pullovers; Pyjamas; Cyclists' clothing; Waterproof clothing; Skirts; Sandals; Saris; Collar protectors; Sashes for wear; Sleepsuits; Sleep masks; Veils [clothing]; Breeches for wear; Lace boots; Fittings of metal for shoes and boots; Shoes; Welts for boots and shoes; Soles for footwear; Footwear uppers; Tips for footwear; Footwear; Smocks; Aprons [clothing]; Dress shields; Ski gloves; Ski boots; Underpants; Socks; Sock suspenders; Boots for sports; Sports shoes; Boots; Boot uppers; Headbands [clothing]; Esparto shoes or sandals; Shawls; Fur stoles; Studs for football boots; Beach clothes; Beach shoes; Garters; Stockings; Sweat-absorbent stockings; Heelpieces for stockings; Stocking suspenders; Tights; Sweaters; Tee-shirts; Togas; Knitwear [clothing]; Singlets; Turbans; Topcoats; Uniforms; Underwear; Anti-sweat underwear; Pants; Underclothing; Leggings; Underwear; Wet suits for water-skiing; Vests; Hosiery; Top hats.</p> |  |
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44) I shall first consider the opponent’s goods in class 18 above to the applicant’s class 25 goods. In considering this issue I take into account the comments of the GC in *Gitana SA, v OHIM, Case T-569/11*, where it stated that:

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

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

45) To my mind, and taking into account the views expressed in paragraph 44 above, the following items within the class 18 specification of the opponent’s mark 11901162 can be said to **be similar to a low degree to the class 25 goods of the applicant**: “Leather and imitations of leather, and goods made of these materials and not included in other classes; Pocket wallets; Handbags; Purses; Bags”.

46) I next turn to the class 35 services which relate to retail services in relation to clothing, footwear and headgear. Clearly the retail services relate to precisely the goods applied for by the applicant. In determining this issue I look to the comments in *Oakley, Inc v OHIM*, Case T-116/06, where, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

47) I also note that in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether

there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

48) However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>1</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>2</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>3</sup>, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

**49) Taking all the above into account I find that the opponent's retail services in class 35 in mark 11901162 are similar to a low degree to the goods in class 25 of the applicant.**

50) Lastly, I turn to the opponent's class 25 goods under trade mark 11739844. This specification includes the following terms: "Clothing, footwear, headgear;". **These terms encompass the whole of the applicant's class 25 specification and must be regarded as identical.**

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<sup>1</sup> Case C-411/13P

<sup>2</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>3</sup> Case C-398/07P

## Comparison of trade marks

51) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

52) The marks of the two parties are as follows:

| Applicant's marks |                                     | Opponent's marks |                        |
|-------------------|-------------------------------------|------------------|------------------------|
| 3228701           | <b>WINDYACHTER</b>                  | EU<br>11901162   | <b>wind</b>            |
| 3228694           | <b>WINDTREKKER</b>                  |                  |                        |
| 3228635           | <b>WINDATTACKER</b>                 | EU<br>11739844   | <b>sun. fun. wind.</b> |
| 3229819           | <b>WIND HYBRID /<br/>WINDHYBRID</b> |                  |                        |

53) The opponent contended that “it is generally accepted that more weight should be given to the beginnings of marks in any comparison”. Also:

“40. The Opponent's earlier trade marks are for wind or wind is the dominant and distinctive part of the mark. The opposed applications all contain wind at the beginning as a dominant and

distinctive prefix. All four trade mark applications are comprised of the prefix WIND- combined with a descriptive or non-distinctive words YACHTER, ATTACKER, TREKKER and HYBRID when considered in relation to the goods. The marks applied for are therefore visually, phonetically and conceptually similar to the Opponent's earlier trade marks.

And:

“42. The mark WINDTREKKER describes clothing that can be used for trekking, while WIND HYBRID / WINDHYBRID, could be descriptive of clothing that uses hybrid materials. The mark WINDATTACKER is devoid of distinctive character in relation to clothing that can be used to 'attack' adverse weather conditions. The marks applied for are therefore a combination of the Opponent's distinctive mark wind, with descriptive or non-distinctive terms and should be considered visually, phonetically and conceptually similar to the Opponent's earlier trade marks.”

54) The applicant submitted that the word “WIND” is of low inherent distinctiveness as it is used by a number of brands in relation to outerwear items as a prefix together with another word element to describe the qualities and characteristics of the garment in that it provides protection from the wind (either wind-resistant or wind-proof). In its evidence the applicant provided examples from the internet of various brands using the terms “windbreaker” and “windcheater” in a descriptive manner and not as a trade mark. I agree with this opinion. Therefore, in the following comparisons I shall take into account the fact that the word “wind” when used upon clothing has a low degree of distinctiveness as it implies a characteristic of the clothing in that it is wind-proof.

55) I shall first compare the marks applied for with the opponent's mark 11901162 “wind”. Clearly, the applicant's marks have the whole of the opponent's mark at the start of each of its marks. However, all of the applicant's marks have a second element in the form of other well-known words. The applicant's first mark WINDYACHTER, to my mind, forms a unit in that the word “wind” is qualified by the term “yachter” to create an image of either a sail boat or land yacht being driven by the wind. It suggests that the clothing thus branded is suitable for such activity by protecting the wearer from the elements to be encountered in such sports. In contrast the opponent's mark suggests either a weather phenomenon that it will protect against or a euphemism for flatulence. Visually and aurally there are similarities and differences, whilst conceptually the marks are quite different. Taken overall, I believe that the differences outweigh the similarities so that there is only a low degree of similarity at best.

56) Turning to consider the applicant's mark WINDTREKKER to the opponent's mark "wind" many of the same conclusions are drawn as those set out in the preceding paragraph. The applicant's mark conjures up an image of an intrepid walker. Visually and aurally there are similarities and differences, whilst conceptually the marks are quite different. Taken overall, I believe that the differences outweigh the similarities so that there is only a low degree of similarity at best.

57) I next turn to WINDATTACKER, again many of the comments in paragraph 54 in respect of the opponent's mark are relevant. The applicant's mark conjures up an energetic image. Visually and aurally there are similarities and differences, whilst conceptually the marks are quite difference. Taken overall, I believe that the differences outweigh the similarities so that there is only a low degree of similarity at best.

58) Lastly, I consider the applicant's series of two marks WIND HYBRID / WINDHYBRID again many of the comments in paragraph 54 in respect of the opponent's mark are relevant. The applicant's marks suggest that the clothing is a mixture of two different elements with a suggestion of a technological element. Visually and aurally there are similarities and differences, whilst conceptually the marks are quite difference. Taken overall, I believe that the differences outweigh the similarities so that there is only a low degree of similarity at best.

59) Moving onto the comparison with the opponent's mark "sun.fun.wind." (EU 11739844). The mark has the overall impression of a strap line for a seaside resort. None of the words within the mark are particularly distinctive or dominant. Although the opponent's mark clearly contains the word "wind" it is the last of the three words and despite it therefore also appearing in each of the applicant's marks I do not consider there to be any real visual, aural or conceptual similarity. **Overall, I find that the applicant's marks WINDYACHTER, WINDTREKKER, WINDATTACKER and WIND HYBRID / WINDHYBRID have no similarity to the opponent's EU 11739844 mark.**

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

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as



coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

61) The word “wind” has a clear meaning when used upon clothing but not upon leather goods or retail services. The mark is inherently distinctive to only a low degree in respect of clothing and retail services relating to clothing; and to a medium degree in respect of leather goods. The evidence filed is not sufficient to persuade me that the opponent’s mark should enjoy enhanced distinctiveness. The opponent states quite clearly that all of the use has been in Germany, hence it cannot have acquired any enhanced distinctiveness amongst the relevant consumers which in this instance are the UK public.

### **Likelihood of confusion**

62) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public, who will select the goods and services by predominantly visual means, although not discounting aural considerations, and that they will pay a medium degree of attention to the selection of such goods and services.
- the opponent's marks have a low degree of distinctiveness in respect of clothing and retail services relating to clothing; whilst having an average degree of inherent distinctiveness, in relation to leather goods and retail services relating to such goods and also advertising services but cannot benefit from distinctiveness through use in respect of any of these goods or services.
- The applicant's marks are similar to a low degree to the opponent's EU 11901162 mark "wind". The applicant's marks are not similar to the opponent's EU 11739844 mark "sun.fun.wind".
- The class 25 goods under the opponent's mark 11739844 are identical to the goods applied for by the applicant for its four marks. The retail services relating to clothing in class 35 under mark 11901162 are similar to a low degree to the goods in class 25 of the applicant. Whilst the class 18 goods "Leather and imitations of leather, and goods made of these materials and not included in other classes; Pocket wallets; Handbags; Purses; Bags" in the opponent's mark 11901162 are similar to a low degree to the class 25 goods of the applicant's four trade mark applications.

63) It is clear that some similarity of marks is required in order for there to be a likelihood of confusion. In *Calvin Klein Trademark Trust v OHIM*, Case C-254/09 P, the CJEU found that:

"53. As regards the third part of the first ground of appeal, it should be noted, first, that, where there is no similarity between the earlier mark and the mark applied for, the reputation of or the goodwill attaching to the earlier mark and the fact that the goods or services concerned are identical or similar are not sufficient for it to be found that there is a likelihood of confusion between the marks at issue (see, to that effect, Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraph 54; Case C-234/06 P II *Ponte Finanziaria v OHIM* [2007] ECR I-7333, paragraphs 50 and 51; and the judgment of 11 December 2008 in Case C-57/08 P *Gateway v OHIM*, paragraphs 55 and 56).

54. In the judgment under appeal, the General Court found that there was no similarity between the marks at issue. It stated, at paragraph 52 of that judgment, that the visual, phonetic and conceptual examination of the marks shows that the overall impression created by the earlier marks is dominated by the element 'ck' whereas that created by the trade mark applied for is dominated by the element 'creaciones kennya', concluding that the lack of similarity between the signs at issue thus stems from their visual, phonetic and conceptual differences.


56. It must be observed in that connection that, contrary to what appears to be stated at paragraph 39 of the judgment under appeal, the existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. According to established case-law, in order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (see *OHIM v Shaker*, paragraphs 41 and 42; the judgment of 20 September 2007 in Case C-193/06 P *Nestlé v OHIM*, paragraphs 42 and 43; and *Aceites del Sur-Coosur v Koipe*, paragraph 62). In that connection, it is sufficient for the common component not to be negligible.

57. However, it is clear that the General Court found, first, that the overall impression created by the mark applied for is dominated by the element 'creaciones kennya', on which the consumer concerned will to a very great extent focus his attention and, second, in particular at paragraph 44 of the judgment under appeal, that the element 'ck' occupies only an ancillary position in relation to that element, which, in essence, amounts to a conclusion that the element 'ck' in the mark applied for is negligible.

58. Thus, having ruled out, on the basis of a properly conducted analysis, any similarity between the marks at issue, the General Court correctly concluded, at paragraphs 53 to 57 of the judgment under appeal, that, notwithstanding the reputation of the earlier marks and the fact that the goods covered by the marks at issue are identical, there is no likelihood of confusion between the marks.”

64) As I have found no similarity between the applicant’s four trade marks and the opponent’s EU 11739844 there can be no likelihood of confusion. **The opposition in respect of this mark under section 5(2)(b) must therefore fail.** Turning to the question of the opponent’s mark EU 11901162 the low degree of similarity of goods and services as well as the marks means that there is no likelihood of consumers being confused into believing that goods applied for under the marks in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) in respect of the goods and services fails.**

65) Earlier on in paragraph 32 I determined that the opponent had not shown proof of use of its trade marks. In case I was incorrect in reaching this decision I have decided to provide an opinion upon the likelihood of confusion in respect of the only mark that it is possible to claim use upon, that mark being EU 4854147. The only use that it could be inferred is upon retail services in respect of clothing and clothing itself. Clearly clothing is identical to part of the applicant’s class 25 specification and highly similar to the balance such as footwear and headgear. The retail of clothing has, earlier in this decision been deemed to be similar to the class 25 specification of the applicant’s trade marks to a low degree. The questions regarding the average consumer and distinctiveness of the earlier marks have already been determined, and there is nothing in the evidence of use which would affect either finding. The only point left is to compare the marks of the two parties shown below:

| Opponent’s mark   | Applicant’s marks   |
|---|---|
|  | <p>WINDYACHTER<br/> WINDTREKKER<br/> WINDATTACKER<br/> WIND HYBRID / WINDHYBRID</p> |

66) The opponent’s mark has a very distinct device element of a sailing boat with a spinnaker, stretched by the wind, at the beginning then the word “wind” where the dot above the letter “i” is out of proportion, being much bigger than normal and more like a device of a sun. There is a stylised wave running under the device and word with the word “sportswear” underneath. The opponent claimed at the hearing that the dominant and distinctive element was the word “wind”, and that this was the first element of all of the applicant’s marks. However, I do not agree with this contention. To my mind, the word “wind” is descriptive or at least highly allusive of a type of clothing designed to protect against this element, just as the word “rain” is used on waterproof / resistant clothing. The term “sportswear” to my view, qualifies the word “wind” in explaining to the average consumer that wind proof

sportswear is on sale in the shop, or that the garment which the mark appears on is such an item. The dominant element is the sail boat or more precisely the spinnaker sail. I have earlier in this decision provided my views on the applicant's trade marks. Whilst there are visual and aural similarities there are also considerable visual and aural differences which combined with the conceptual differences far outweigh any similarity to such an extent that in my view the marks have such a low level of similarity that even when used on identical goods there is no likelihood of confusion, direct or indirect, occurring in the mind of the average consumer. The ground under section 5(2)(b) would therefore fail even if it had got past the pou hurdle.

## CONCLUSION

67) The oppositions in relation to all the marks and goods applied for have failed.

## COSTS

68) As the applicant has been successful it is entitled to a contribution towards its costs. The applicant contended that the opponent's behaviour was unreasonable as it pleaded section 5(4)(a) and contended that their marks had been used in the UK on the TM7 form, when all their business is in Germany with no evidence of any use of the mark in the UK thus meaning that there can be no goodwill in the UK, and maintained this position up to two days prior to the hearing despite it being obvious from the evidence filed that there was no goodwill in the UK. The opponent had also originally pleaded a large number of earlier rights and yet these were reduced to four earlier rights just two days prior to the hearing. The applicant seeks an award of costs above the normal scale. I accept that the opponent could and indeed should have realised sooner that its section 5(4)(a) ground was untenable given the evidence it filed. Further, the opponent should have honed considerably the number of earlier rights relied upon given the evidence it actually filed and the considerations it should have made regarding whether the marks could be considered use of a mark in a different form or use of a mark within another mark. However, I do not believe that these failings are enough to award off the scale costs, instead I have provided an award towards the top end permissible.

|  |               |
|--|---------------|
| Preparing a statement and considering the other side's statement x 4 | £2400         |
| Preparing evidence & considering other side's evidence               | £2000         |
| Attendance at hearing  | £1400         |
| <b>TOTAL</b>   | <b>£5,800</b> |

69) I order Wind sportswear GmbH to pay DKH Retail Limited the sum of £5,800. 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 22<sup>nd</sup> day of November 2018**

A handwritten signature in black ink, reading "G Salthouse". The signature is written in a cursive, slightly slanted style.

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