

**O-261-19**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No. 3261155  
BY THE LIVERPOOL FOOTBALL CLUB AND ATHLETIC GROUNDS LIMITED  
TO REGISTER IN CLASSES 3, 14, 18, 24, 25 & 35  
THE TRADE MARK**



**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 411589 BY  
ERREA' SPORT S.p.A**

## **BACKGROUND**

1) On 4 October 2017, The Liverpool Football Club and Athletic Grounds Ltd (hereinafter the applicant) applied to register the trade mark shown on the front page in respect of the following goods and services

In Class 3: Cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; after-shave lotions; antiperspirant soap; antiperspirants; bath salts; beauty masks; breath freshening sprays; bubble bath; body creams; body wash; cosmetic kits; cosmetics; cosmetic creams; deodorant soap; eau de cologne; hair colourants; hair conditioners; hair dyes; hair lotions; hair spray; hair waving preparations; lipsticks; make-up; mascara; nail polish; nail varnish; perfumes; potpourri; shampoos; shaving lotions; shaving preparations; shaving soap; shower gel; skincare preparations; suntanning preparations; talcum powder; washing preparations.

In Class 14: Jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches; parts, fittings and accessories for all the aforesaid goods.

In Class 18: Trunks and travelling bags; rucksacks; backpacks; bags; beach bags; belts; briefcases; card cases; cases; garment cases for travel; handbags; holdalls; key cases; keyholders; keyfobs; purses; school bags; shopping bags; sports bags; suitcases; wallets; umbrellas, parasols and walking sticks; parts, fittings and accessories for all the aforesaid goods.

In Class 24: Textiles and textile goods, not included in other classes; bed and table covers; bath linen; bed linen; furniture coverings of textile; curtains of textile or plastic; fabrics; face towels; flags; handkerchiefs of textile; household linen; mattress covers; napkins of textile; pillowcases; place mats of textile; sheets; table linen; towels of textile.


In Class 25: Clothing, footwear, headgear; sports clothing; sports footwear; sports headgear; outerwear; swimwear; underwear; football shirts; football boots; football shorts; football socks; boots; shoes; caps; hats; beanie hats; baseball caps.

In Class 35: Retail and online retail services connected with the sale of cleaning, polishing, scouring and abrasive preparations soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, after-shave lotions, antiperspirant soap, antiperspirants, bath salts, beauty masks, breath freshening sprays, bubble bath, body creams, body wash, cosmetic kits, cosmetics, cosmetic creams, deodorant

soap, eau de cologne, hair colorants, hair conditioners, hair dyes, hair lotions, hair spray, hair waving preparations, lipsticks, make-up, mascara, nail polish, nail varnish, perfumes, potpourri, shampoos, shaving lotions, shaving preparations, shaving soap, shower gel, skincare preparations, suntanning preparations, talcum powder, washing preparations, jewellery, costume jewellery, precious stones, horological and chronometric instruments, clocks and watches, trunks and travelling bags, rucksacks, backpacks, bags, beach bags, belts, briefcases, card cases, cases, garment cases for travel, handbags, holdalls, key cases, keyholders, keyfobs, purses, school bags, shopping bags, sports bags, suitcases, wallets, umbrellas, parasols and walking sticks, textiles and textile goods, bed and table covers, bath linen, bed linen, furniture coverings of textile, curtains of textile or plastic, fabrics, face towels, flags, handkerchiefs of textile, household linen, mattress covers, napkins of textile, pillowcases, place mats of textile, sheets, table linen, towels of textile, clothing, footwear, headgear, sports clothing, sports footwear, sports headgear, outerwear, swimwear, underwear, football shirts, football boots, football shorts, football socks, boots, shoes, caps, hats, beanie hats, baseball caps; organisation, operation and supervision of sales and promotional incentive schemes; loyalty card services; discount card services; advisory, consultancy and information services relating to the aforesaid.

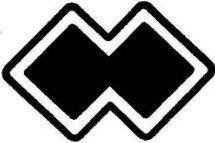
2) The application was examined and accepted, and subsequently published for opposition purposes on 27 October 2017 in Trade Marks Journal No.2017/043.

3) On 29 January 2018 Errea' Sport S.p.A. (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
	EU 7008477	23.06.08 04.02.09	3	Alcohol- and non-alcohol-based perfumes and perfumery, toilet water, perfume extracts, essential oils; facial tissues, toning lotions; moisturising and nutrient creams; lip gloss; hand creams, gels and lotions; moisturising, nutrient and exfoliating preparations for the body; multi-purpose creams, water and oils for

				the body; deodorants, antiperspirants, depilatory creams, sun creams; hair gels, lotions, foams, gels, water, shampoos and conditioners, hair lacquers, sprays, mousses; body hygiene products, namely solid, liquid and powdered soaps, bath and shower foam; salts, powders and oils, talcum powder and powders for sprinkling; food hygiene products; products for personal hygiene; dental hygiene products, dentifrices, mouthwashes, breath freshening sprays.
			14	Clocks, chronometers, chronographs, alarm clocks, jewellery.
			18	Bags, multipurpose sports bags, handbags, bags of leather and imitations of leather, gentlemen's handbags; canvas bags, bags for balls, bags, bags for campers, beach bags, travelling bags; key holders; beach bags; bum-bags; cosmetic bags sold empty; school satchels, trunks, travelling bags, suitcases, rucksacks; umbrellas, walking sticks, parasols; Leatherware; briefcases; leather and imitations of leather; satchels; business cards cases; purses, not of precious metal; notecases.
			25	Clothing for men, women and children; sportswear and leisurewear

			<p>for men, women and children, including jumpers, T-shirts, vests, sweatshirts, pullovers, polo shirts, shirts, skirts, trousers, shorts, Bermuda shorts, jackets, coats, jeans, jerseys, neckties, suits, jump suits (clothing), full tracksuits for sports teams, training suits, sports kits, including kits for football, five-a-side football, volleyball, rugby and basketball, clothing for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running and exercisewear in general not included in other classes; belts (clothing), belts for sports; footwear, shoes, sports shoes, including shoes for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running, gymnastics and exercise in general not included in other classes, ski boots, swimshoes, slippers; headgear, including hats, berets, bonnets, ear muffs, headbands and sweat bands, hats and berets for sport in general, bandanas; gloves (clothing), scarves, wristbands; stockings, socks, sweat-absorbent stockings, slippers, tights; underwear, including briefs, bras, camisoles, underpants, boxers, thongs, underwear, in particular for playing</p>
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				<p>sport, namely leg warmers, Bermuda shorts, elasticated T-shirts, nightwear; beachwear and swimwear, including swimming costumes, swimming trunks, beach robes; rainwear.</p>
			35	<p>Wholesaling and retailing of perfumery, spectacles, horological instruments and jewellery, stationery, luggage, clothing, sporting articles; electronic commerce of the aforesaid goods.</p>
	<p>EU 9929845</p>	<p>29.04.11 05.10.11</p>	3	<p>Perfumes and alcoholic and non-alcoholic perfumery; Eaux de toilette; Extracts (perfumes); Essential oils; Pre-moistened cosmetic towelettes; Toning lotions; Moisturising and nourishing creams; Lip gloss; Creams; Gels and Hand lotion; Moisturizer; Nutrients and Body scrub; Multi-purpose creams, water and oils for the body; Deodorants; Antiperspirants; Depilatory creams; Sun creams; Gels; Lotions; Foams; Gels; Eaux de toilette; Hair shampoos and conditioners; Hair lacquers; Hair sprays and mousses; Body hygiene products; Including for example, solid soaps; Liquid and in powder; Shower and bath foam; Bath salts; Oils and make-up powder; Talcum powder and powders for sprinkling; Foot hygiene products; Products for personal hygiene; Products for dental hygiene;</p>

				Dentifrices; Mouthwash; Breath freshening sprays.
			14	Clocks and watches; Chronometers; Chronographs; Alarm clocks; Jewellery and artificial jewellery
			18	Bags; Multipurpose sports bags; Handbags; Bags of leather and imitations of leather; Small bags; Canvas bags; Bags for balls; Bags; Bags for campers; Bags; Travelling; Key holders; Beach bags; Bum-bags; Cosmetic bags sold empty; School rucksacks; Trunks; Travelling bags; Valises; Rucksacks; Umbrellas; Walking sticks; Parasols; Leatherware; Briefcases; Leather and imitations of leather; Satchels; Business cards cases; Change purses; Not of precious metal; Notecases; Sports bags; Football bags; Wetsuit bags.
			25	Sports clothing and leisurewear for men, women and children; Jerseys; Undershirts; T-shirts; Tank-tops; Sweatshirts; Pullovers; Polo-neck jerseys; Shirts; Skirts; Trousers; Shorts; Bermuda shorts; Jackets; Coats; Jeans; Jerseys; Ties; Suits; Combinations (clothing); Full tracksuits for sports teams; Training suits; Sports kits; Including kits for football; Five-a-side football; Volleyball; Rugby and Basketball;

				<p>Soccer clothing; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running and exercisewear in general not included in other classes; Trousers and Ski suits; Belts (clothing); Belts for sports; Footwear; Shoes; Sports shoes; Football boots and shoes; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running; Gymnastics and exercise in general not included in other classes; Ski boots; Swimshoes; Slippers; Headwear; Hats; Caps; Bonnets; Ear muffs; Head sweatbands; Hats and berets for sport in general; Bandannas; Gloves (clothing); Mufflers; Wristbands; Stockings; Socks; Sweat-absorbent stockings; Slippers; Panty hose; Underwear; Briefs; Brassieres; Singlets; Underpants; Boxer shorts; G-strings; Biancheria intima; In particular for sport; Namely leg warmers; Bermuda shorts; Elasticated t-shirts; Nightwear; Beach clothes and swimwear; Including bathing suits; Swimming trunks; Bath robes; Rainwear.</p>
			35	<p>Wholesaling and retailing of perfumery; Spectacles; Horological articles and jewellery; Stationery; Luggage; Clothing; Sporting articles;</p>



				Electronic commerce of the aforesaid goods.
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- a) The opponent relies upon all of the goods and services mentioned above and claims that it has reputation in all the goods and services listed. The opponent contends that its marks and the mark applied for are very similar and that the goods and services (other than class 24 goods) applied for are identical and/or similar to the goods and services for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent claims that use of the mark in suit would take unfair advantage of its marks as the marks / goods and services (in classes 3, 14, 18, 25 & 35) are identical / similar. Use of the mark in suit would also dilute the distinctiveness of its marks. As such the mark in suit offends against section 5(3) of the Act.
- 4) On 18 May 2018 the applicant filed a counterstatement basically denying all the grounds of opposition. It puts the opponent to strict proof of use of its marks.
- 5) Both parties filed evidence, and both also seek an award of costs in their favour. Neither side wished to be heard and neither provided written submissions, other than within their evidence.

## **OPPONENT'S EVIDENCE**

6) The opponent filed a witness statement, dated 20 July 2018, by Roseanna Fabbiani the Managing Director of the opponent company. The company prides itself on having products made to the highest ecological level in the world. The company sponsored Middlesbrough FC from 1994-2009 during which time it played in European competitions such as the UEFA cup final in 2006. It currently sponsors Norwich City and Millwall FC. She points out that the TV audience for the English Premier league is 4.7bn. Two of the clubs it sponsors play in the Premier league whilst another two play in the English Championship. The products are sold via various distributors. She also provides the following exhibits:

- RF2: At page 12 is a map showing 12 stores in the UK which sell the opponent's goods. There are also three in the Netherlands, two in Belgium and at least eight in France and five in Germany. The map does not show the whole of Europe and only parts of France and Germany. Other pages show items of sports clothing and footwear offered for sale in the EU

(priced in euros) on the company website, all with the Device logo EU 9929845 upon them and a number also having the name of the company in addition. The mark is said to originate from the founders two children whose names began with the letters “R” and “A”. The company sponsors a large number of sports teams around the world including a number in the UK. These include three UK basketball teams, and the national team; In football it currently includes Aldershot Town, Boston United, Brighton and Hove Albion, Blackpool, Bristol Rovers, Cheltenham Town, Grimsby Town, Hereford United, Mansfield Town, Norwich City, Woking. In rugby Union it sponsors Nottingham and Pontypridd; the Great Britain volleyball team.

- RF5: Details of the number of people who watch English football on TV in both the UK and the world.
- RF7: The names and leagues of the various British teams sponsored by the opponent in football, rugby league, volleyball and canoeing.
- RF8: Photographs of players from these teams, showing clear use of mark EU 7008477 upon the shirts they are wearing.
- RF9: Details of contracts with a number of the football teams mentioned which shows that the opponent provides free kit to the clubs and also agrees to provide items of sports clothing at set prices for the clubs to sell to fans.
- RF10: Photos of players from these clubs wearing clothing with the opponent’s mark EU 7008477.
- RF12: Copies of pages from a website ([www.maysim.co.uk](http://www.maysim.co.uk)) which is one of the opponent’s UK distributors and which shows a large number of sports clothing items, plus bags and equipment being offered for sale in the UK priced in UK£. Unfortunately, none of these pages are dated. The goods show use of both the opponent’s marks.
- RF13: The opponent provides the following figures:

Year	Bags	Balls	Textiles	Total (Euros)
2004	n/a	n/a	n/a	3,399,956
2005	n/a	n/a	n/a	3,219,892
2006	87,893	108,262	3,841,491	4,037,646

2007	96,335	109,919	4,292.847	4,499,112
2008	80,991	126,950	3,870321	4,078,263
2009	86,568	76,699	2,722,247	2,885,515
2010	2,684	3,628	81,435	87,747
2011	n/a	n/a	n/a	3,025,128
2012	n/a	n/a	n/a	4,696,371
2013	n/a	n/a	n/a	4,035,894
2014	n.a	n/a	n/a	4,536,968
2015	n/a	n/a	n/a	6,337,575
2016	n/a	n/a	n/a	7,435,388

- RF14: The opponent has promoted itself by attending trade shows in the UK such as Grass Roots Football (2012), Leaders Sports Summit (2012 & 2013), Rugby Expo (2012) and The Sports Merchandising and Marketing Exhibition (2014). In addition, it has sponsored advertising panels at sporting grounds and taken advertising out in sporting publications.
- RF15: Copies of thirteen invoices said to cover the period 2008-2017. In fact, they cover the period 3 April 2013- 21 May 2016. They are all, except two, addressed to football clubs. The two exceptions are addressed to a general sportswear outlet who clearly stocks a number of clubs kits and a motor racing team. All recipients are in the UK and every invoice has EU 7008477 upon it. The invoices show sales of shirts, shorts, coats, trousers, gloves, hats, bags, jackets and socks totalling approximately £300,000.

## **APPLICANT'S EVIDENCE**

7) The applicant filed a witness statement, dated 11 October 2018, by Timothy Carter its Trade Mark Attorney. He accepts that "the earlier trade marks have been used over a number of years". His statement consists mostly of submissions regarding the grounds of opposition rather than actual evidence. He also includes an exhibit which consists of other marks of a geometric shape which are on the Register. In the absence of evidence regarding use of these marks this exhibit is merely "state of the register" evidence and does not assist my decision.

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

## DECISION

9) The first 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.”

10) 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.”

11) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. Given that the mark in suit was published on 27 October 2017, whilst mark EU 7008477 was registered on 4 February 2009 and EU 9929845 was registered on 5 October 2011, both clearly falls foul of the proof of use (pou) requirements having been registered for five years at the point that the instant mark was published. The pou period is therefore 28 October 2012 – 27 October 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.”

12) 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.”

13) When considering the genuine use 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, “ernsthaf” (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].”

14) 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 (CJEU) 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).”

15) 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.”

16) 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.”

17) The General Court (GC) restated its interpretation of *Leno Merken* 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.

18) 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
- v) The geographical extent of the use shown

19) I 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.”

20) 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.”

21) When considering the use that has or has not been made of the opponent’s mark I shall have to consider whether to reduce or re-write the opponent’s specifications. In doing so I shall take into consideration the case of *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), where Mr Justice Carr summed up the law relating to partial revocation as follows.

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

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

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

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

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

22) Both of the opponent’s marks are effectively registered for identical goods. They differ slightly in their wording but essentially where one specification is more detailed it is encompassed within general terms in the other mark’s specification. Both marks are registered for goods in classes 3, 14, 18 & 25 and services in class 35. It is clear that the opponent has maintained invoices which it uses to show use on class 25 items, but has chosen not to file the same for goods in classes 3 and 14. There is no evidence of use upon goods in classes 3 or 14, such as invoices or even references in the narrative, or any photographs in the exhibits. The only use of goods in class 18 is upon sports bags shown in RF 12 & 15 which allows the opponent to retain the following specifications: EU 7008477 “multipurpose sports bags; bags for balls;”, whilst for EU 9929845 it will be “Multipurpose sports bags; bags for balls; sports bags; football bags”. It is clear from the evidence that the marks are primarily used on sports kit such as shirts, shorts and socks, including replica kit for fans. There are a number of photographs, sales figures and invoices within the relevant period which clearly show genuine use. Looking at the class 25 specifications for both marks this means that they have shown use on the following:

EU 7008477: “Sportsclothing and leisurewear for men, women and children; polo shirts; shirts, skirts, trousers, shorts, jackets, coats, full tracksuits for sports teams, training suits, sports kits, including kits for football, five-a-side football, volleyball, rugby and basketball, clothing for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running and exercisewear in general not included in other classes; belts for sports; sports shoes, including shoes for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running, gymnastics and exercise in general not included in other classes, ski boots,

swimshoes, headbands and sweat bands, hats and berets for sport in general; gloves (clothing), wristbands; socks, sweat-absorbent stockings, slippers, tights; underwear, in particular for playing sport, namely leg warmers, elasticated T-shirts; swimwear, including swimming costumes, swimming trunks; rainwear.”

EU 9929845: “Sports clothing and leisurewear for men, women and children; Shirts; Skirts; Trousers; Shorts; Shorts; Jackets; Coats; Full tracksuits for sports teams; Training suits; Sports kits; Including kits for football; Five-a-side football; Volleyball; Rugby and Basketball; Soccer clothing; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running and exercisewear in general not included in other classes; Trousers and Ski suits; Belts for sports; Sports shoes; Football boots and shoes; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running; Gymnastics and exercise in general not included in other classes; Ski boots; Swimshoes; Head sweatbands; Hats and berets for sport in general; Bandannas; Gloves (clothing); Wristbands; Socks; Sweat-absorbent stockings; In particular for sport; Namely leg warmers; Elasticated t-shirts; swimwear; Including bathing suits; Swimming trunks; Rainwear.”

23) Lastly, I turn to consider the class 35 specifications. The opponent has provided copies of pages from its website showing that it offers EU customers a chance to purchase sportswear and sports footwear directly from the opponent. The specifications of both marks must be reduced to the following:

- EU 7008477 and EU 9929845: class 35: Wholesaling and retailing of sports clothing and sports footwear; sports bags; electronic commerce of the aforesaid goods.

24) The above findings mean that in the comparison tests under section 5(2)(b) the opponent can only rely upon the following goods:

EU 7008477	EU 9929845
Class 18: Multipurpose sports bags; bags for balls.	Class 18: Multipurpose sports bags; bags for balls; sports bags; football bags
Class 25: Sports clothing and leisurewear for men, women and children; polo shirts; shirts, skirts, trousers, shorts, jackets, coats, full	Class 25: Sports clothing and leisurewear for men, women and children; Shirts; Skirts; Trousers; Shorts; Shorts; Jackets; Coats; Full

<p>tracksuits for sports teams, training suits, sports kits, including kits for football, five-a-side football, volleyball, rugby and basketball, clothing for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running and exercisewear in general not included in other classes; belts for sports; sports shoes, including shoes for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running, gymnastics and exercise in general not included in other classes, ski boots, swimshoes, headbands and sweat bands, hats and berets for sport in general; gloves (clothing), wristbands; socks, sweat-absorbent stockings, slippers, tights; underwear, in particular for playing sport, namely leg warmers, elasticated T-shirts; swimwear, including swimming costumes, swimming trunks; rainwear.</p>	<p>tracksuits for sports teams; Training suits; Sports kits; Including kits for football; Five-a-side football; Volleyball; Rugby and Basketball; Soccer clothing; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running and exercisewear in general not included in other classes; Trousers and Ski suits; Belts for sports; Sports shoes; Football boots and shoes; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running; Gymnastics and exercise in general not included in other classes; Ski boots; Swimshoes; Head sweatbands; Hats and berets for sport in general; Bandannas; Gloves (clothing); Wristbands; Socks; Sweat-absorbent stockings; In particular for sport; Namely leg warmers; Elasticated t-shirts; swimwear; Including bathing suits; Swimming trunks; Rainwear.”</p>
<p>Class 35: Wholesaling and retailing of sports clothing and sports footwear; sports bags; electronic commerce of the aforesaid goods.</p>	<p>Class 35: Wholesaling and retailing of sports clothing and sports footwear; sports bags; electronic commerce of the aforesaid goods.</p>

25) When considering the above specifications it is clear that the opponent’s goods and services for each of its marks are either actually or effectively identical. They have minor differences which are encompassed within a more general term in the other mark. I shall therefore only carry out one comparison test of goods and services using the specification of EU 9929845.

26) 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 Cw -3/03, *Medion AG v. Thomson*



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

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

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

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

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

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

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

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

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

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

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

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

27) 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.”

28) The goods and services at issue in these proceedings are not particularly wide ranging incorporating, inter alia, sports bags, sports clothing, sports footwear and sports headgear, and the retail and wholesale of same. All of the goods will be for personal use and the average consumer for such goods will be the public at large. Such goods 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. I accept that more expensive items of sports clothing, footwear and headgear etc may, for example, be researched or discussed with a member of staff or be made to measure. The latter, along with

personal recommendations, bring aural considerations into play. 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.”

29) 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.”

30) 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 for personal use such as sports clothing/footwear/headgear such as socks/slippers/caps the average consumer will pay attention to considerations such as size, colour, fabric and cost. **Overall the average consumer from the public for these types of goods and services is likely to pay a medium degree of attention to the selection of items of sports clothing, footwear and headgear, sports bags and retail services for the same.**

31) A number of these goods and services will also be purchased by businesses. It is normal to assume that businesses take slightly more care in making decisions regarding the purchase of goods

and services as their survival may depend upon making the correct choice both economically and for the image of the business. **To my mind, the average business consumer for these types of goods and services is likely to pay at least a medium degree of attention to the selection of items of clothing and footwear, sports bags and retail services for the same.**

### **Comparison of goods**

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

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

33) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

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

34) I must also consider whether the goods and services could be regarded as complementary. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

35) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

36) As I determined earlier, the opponent’s strongest case lies in its mark EU 9929845 and so I shall use its specification for the comparison test, taking into account my findings following the proof of use findings. The goods and services to be compared are as follows:

Applicant’s specification	Opponent’s specification EU 9929845
Class 3: Cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; after-shave lotions; antiperspirant soap; antiperspirants; bath salts; beauty masks; breath freshening sprays; bubble bath; body creams; body wash; cosmetic kits; cosmetics; cosmetic creams; deodorant soap; eau de cologne; hair colourants; hair conditioners; hair dyes; hair lotions; hair spray; hair waving preparations; lipsticks; make-up; mascara; nail polish; nail varnish; perfumes; potpourri; shampoos; shaving lotions; shaving preparations; shaving soap; shower gel; skincare preparations; suntanning preparations; talcum powder; washing preparations.	

<p>Class 14: Jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches; parts, fittings and accessories for all the aforesaid goods.</p>	
<p>Class 18: Trunks and travelling bags; rucksacks; backpacks; bags; beach bags; belts; briefcases; card cases; cases; garment cases for travel; handbags; holdalls; key cases; keyholders; keyfobs; purses; school bags; shopping bags; sports bags; suitcases; wallets; umbrellas, parasols and walking sticks; parts, fittings and accessories for all the aforesaid goods.</p>	<p>Class 18: Multipurpose sports bags; bags for balls</p>
<p>Class 24: Textiles and textile goods, not included in other classes; bed and table covers; bath linen; bed linen; furniture coverings of textile; curtains of textile or plastic; fabrics; face towels; flags; handkerchiefs of textile; household linen; mattress covers; napkins of textile; pillowcases; place mats of textile; sheets; table linen; towels of textile.</p>	
<p>Class 25: Clothing, footwear, headgear; sports clothing; sports footwear; sports headgear; outerwear; swimwear; underwear; football shirts; football boots; football shorts; football socks; boots; shoes; caps; hats; beanie hats; baseball caps.</p>	<p>Class 25: Sports clothing and leisurewear for men, women and children; Shirts; Skirts; Trousers; Shorts; Shorts; Jackets; Coats; Full tracksuits for sports teams; Training suits; Sports kits; Including kits for football; Five-a-side football; Volleyball; Rugby and Basketball; Soccer clothing; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running and exercisewear in general not included in other classes; Trousers and Ski suits; Belts for sports;</p>

	<p>Sports shoes; Football boots and shoes; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running; Gymnastics and exercise in general not included in other classes; Ski boots; Swimshoes; Head sweatbands; Hats and berets for sport in general; Bandannas; Gloves (clothing); Wristbands; Socks; Sweat-absorbent stockings; In particular for sport; Namely leg warmers; Elasticated t-shirts; swimwear; Including bathing suits; Swimming trunks; Rainwear.”</p>
<p>Class 35: Retail and online retail services connected with the sale of cleaning, polishing, scouring and abrasive preparations soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, after-shave lotions, antiperspirant soap, antiperspirants, bath salts, beauty masks, breath freshening sprays, bubble bath, body creams, body wash, cosmetic kits, cosmetics, cosmetic creams, deodorant soap, eau de cologne, hair colorants, hair conditioners, hair dyes, hair lotions, hair spray, hair waving preparations, lipsticks, make-up, mascara, nail polish, nail varnish, perfumes, potpourri, shampoos, shaving lotions, shaving preparations, shaving soap, shower gel, skincare preparations, suntanning preparations, talcum powder, washing</p>	<p>Class 35: Wholesaling and retailing of sports clothing, sports footwear and sports bags; electronic commerce of the aforesaid goods.</p>

preparations, jewellery, costume jewellery, precious stones, horological and chronometric instruments, clocks and watches, trunks and travelling bags, rucksacks, backpacks, bags, beach bags, belts, briefcases, card cases, cases, garment cases for travel, handbags, holdalls, key cases, keyholders, keyfobs, purses, school bags, shopping bags, sports bags, suitcases, wallets, umbrellas, parasols and walking sticks, textiles and textile goods, bed and table covers, bath linen, bed linen, furniture coverings of textile, curtains of textile or plastic, fabrics, face towels, flags, handkerchiefs of textile, household linen, mattress covers, napkins of textile, pillowcases, place mats of textile, sheets, table linen, towels of textile, clothing, footwear, headgear, sports clothing, sports footwear, sports headgear, outerwear, swimwear, underwear, football shirts, football boots, football shorts, football socks, boots, shoes, caps, hats, beanie hats, baseball caps; organisation, operation and supervision of sales and promotional incentive schemes; loyalty card services; discount card services; advisory, consultancy and information services relating to the aforesaid.	
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37) 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).”

38) Thus, where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar. The opponent did not provide evidence regarding similarity. The opponent has no goods to rely upon in classes 3,14 or 24 following



the pou exercise. It therefore has no obvious goods which are similar and has not provided any evidence or submissions to the contrary. It is clear that some similarity of goods is essential for an opposition under section 5(2)(b) to succeed. This was initially set out in *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU) and confirmed in the case of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

**39) The opposition in respect of the goods in classes 3, 14 and 24 therefore fails.**

40) I next turn to the goods in class 18. The opponent’s specification of “Multipurpose sports bags; bags for balls” is clearly identical to the following in the applicant’s specification “rucksacks; backpacks; bags; garment cases for travel; holdalls; sports bags; parts, fittings and accessories for all the aforesaid goods.”

41) I consider the opponent’s class 18 goods to be similar to a medium degree to the following items within the applicant’s class 18 specification: “Trunks and travelling bags; beach bags; belts; briefcases; card cases; cases; handbags; key cases; keyholders; keyfobs; purses; school bags; shopping bags; suitcases; wallets; parts, fittings and accessories for all the aforesaid goods.”

42) I consider the opponent’s goods in class 18 to be not at all similar to the following items in the applicant’s class 18 specification: “umbrellas, parasols and walking sticks; parts, fittings and accessories for all the aforesaid goods”. I also do not consider that the goods of the two parties are complementary. The opposition in respect of section 5(2)(b) therefore fails for the goods identified within this paragraph.

43) Moving to the class 25 goods, the opponent’s specification in Class 25 is: “Sports clothing and leisurewear for men, women and children; Shirts; Skirts; Trousers; Shorts; Shorts; Jackets; Coats; Full tracksuits for sports teams; Training suits; Sports kits; Including kits for football; Five-a-side

football; Volleyball; Rugby and Basketball; Soccer clothing; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running and exercisewear in general not included in other classes; Trousers and Ski suits; Belts for sports; Sports shoes; Football boots and shoes; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running; Gymnastics and exercise in general not included in other classes; Ski boots; Swimshoes; Head sweatbands; Hats and berets for sport in general; Bandannas; Gloves (clothing); Wristbands; Socks; Sweat-absorbent stockings; In particular for sport; Namely leg warmers; Elasticated t-shirts; swimwear; Including bathing suits; Swimming trunks; Rainwear.”

44) The above clearly encompasses the applicant’s specification of “Clothing, footwear, headgear; sports clothing; sports footwear; sports headgear; outerwear; swimwear; underwear; football shirts; football boots; football shorts; football socks; boots; shoes; caps; hats; beanie hats; baseball caps.”

**The class 25 specifications are identical.**

45) Lastly, I turn to consider the class 35 services of the two parties. The opponent’s specification is limited to: Class 35: “Wholesaling and retailing of sports clothing, sports footwear and sports bags; electronic commerce of the aforesaid goods.” These encompass the following in the applicant’s specification: “Retail and online retail services connected with the sale of rucksacks, backpacks, bags, garment cases for travel, holdalls, sports bags, parts, fittings and accessories for all the aforesaid goods; clothing, footwear, headgear, sports clothing, sports footwear, sports headgear, outerwear, swimwear, underwear, football shirts, football boots, football shorts, football socks, boots, shoes, caps, hats, beanie hats, baseball caps; ” and must be regarded as identical.

46) The opponent’s class 35 services identified above are similar to a medium degree to the applicant’s services of “Retail and online retail services connected with the sale of “Trunks and travelling bags; beach bags; belts; briefcases; card cases; cases; handbags; key cases; keyholders; keyfobs; purses; school bags; shopping bags; suitcases; wallets; parts, fittings and accessories for all the aforesaid goods”.

47) I consider the following services in the applicant’s class 35 specification to be not at all similar to the opponent’s class 35 specification: “Retail and online retail services connected with the sale of cleaning, polishing, scouring and abrasive preparations soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, after-shave lotions, antiperspirant soap, antiperspirants, bath salts, beauty masks, breath freshening sprays, bubble bath, body creams, body wash, cosmetic kits, cosmetics,

cosmetic creams, deodorant soap, eau de cologne, hair colorants, hair conditioners, hair dyes, hair lotions, hair spray, hair waving preparations, lipsticks, make-up, mascara, nail polish, nail varnish, perfumes, potpourri, shampoos, shaving lotions, shaving preparations, shaving soap, shower gel, skincare preparations, suntanning preparations, talcum powder, washing preparations, jewellery, costume jewellery, precious stones, horological and chronometric instruments, clocks and watches; umbrellas, parasols and walking sticks, textiles and textile goods, bed and table covers, bath linen, bed linen, furniture coverings of textile, curtains of textile or plastic, fabrics, face towels, flags, handkerchiefs of textile, household linen, mattress covers, napkins of textile, pillowcases, place mats of textile, sheets, table linen, towels of textile, umbrellas, parasols and walking sticks, textiles and textile goods, bed and table covers, bath linen, bed linen, furniture coverings of textile, curtains of textile or plastic, fabrics, face towels, flags, handkerchiefs of textile, household linen, mattress covers, napkins of textile, pillowcases, place mats of textile, sheets, table linen, towels of textile". I also do not consider that the services of the two parties are complementary. The opposition in respect of section 5(2)(b) therefore fails for the services identified within this paragraph.

48) This leaves the following services in the applicant class 35 specification: "organisation, operation and supervision of sales and promotional incentive schemes; loyalty card services; discount card services; advisory, consultancy and information services relating to the aforesaid". To my mind, any retail outlet will potentially involve "organisation, operation and supervision of sales and promotional incentive schemes; loyalty card services; discount card services". These services must therefore be regarded as identical to the opponent's services in class 35 of "Retail and online retail services". However, such services would not normally include services such as "advisory, consultancy and information services relating to the aforesaid". When one starts to advise others about retailing, discount cards and loyalty schemes then one moves from simple retailing into consultancy which is a different skill set entirely. Therefore, the applicant's specification of "advisory, consultancy and information services relating to the aforesaid" must be considered to be not at all similar nor complementary to the applicant's services and so these services must fail in respect of the opposition under section 5(2)(b).

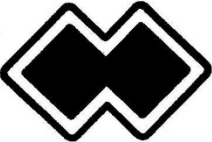


### **Comparison of trade marks**

49) 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.”

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

Opponent's trade marks	Applicant's trade mark
<p data-bbox="233 905 383 930">EU 9929845</p>  <p data-bbox="233 1131 375 1157">EU7008677</p> 	<p data-bbox="667 905 784 930">3261155</p> 

51) To my mind, the opponent's strongest case must be with its mark EU 9929845 as it is a device only mark, whereas the opponent's other mark contains the word "errea" which is not found in the applicant's mark and so is an additional point of difference. The applicant's submissions are:

**“Visual Comparison**

9. On a straightforward visual comparison, the Contested Mark is clearly visually different from the Earlier Trade Marks. The Contested Mark consists of the wording SGG APPAREL in combination with a logo element. This logo element consists of two equal sided and overlapping

diamond or square shapes, which are shown in outline. The diamond/square shapes are placed over each other in a vertical arrangement, with one diamond/square shape directly above the other. In contrast, the Earlier Trade Marks both contain a logo element consisting of a solid shape eight sided shape with a border in a contrasting colour. Rather than being placed vertically, the logo element of the Earlier Trade Marks would be seen as being placed horizontally as part of each mark. In addition, Earlier Trade Mark No. EU007008477 contains the word ERREA in a stylised font, which further serves to distinguish this Earlier Trade Mark from the Contested Mark. In terms of a visual comparison, the Contested Mark is clearly visually distinguishable from the Earlier Trade Marks of the Opponent. Customers seeing the Contested Mark will see *it* as a SGG APPAREL trade mark. The visual identity of the logo elements of the Contested Mark and Earlier Trade Marks are also sufficiently different that the trade marks cannot be said to be visually similar to each other. The clear differences in the proportions, shading and placement of the individual elements of the logo, coupled with the use of the distinguishing wording, SGG APPAREL, are sufficient to visually distinguish the Contested Mark from the Earlier Trade Marks.

### **Aural Comparison**

10. The Contested Mark consists of the words SGG APPAREL. This wording is aurally completely dissimilar to the word ERREA which appears in Earlier Trade Mark No. EU007008477. Earlier Trade Mark No. EU009929845 simply consists of the logo element, and does not contain any distinguishing wording. This trade mark has no aural character, and so there can be no aural comparison between this Earlier Trade Mark and the Contested Mark. The Contested Mark is aurally dissimilar to Earlier Trade Mark No. EU009929845. The Opponent cannot simply ignore the fact that the Contested Mark contains the wording SGG APPAREL, which is not present in any of the Earlier Trade Marks. Nor can the wording SGG APPAREL be said to be aurally similar to the word ERREA in Earlier Trade Mark No. EU007008477. The inclusion of this wording creates a clear, aural difference between the Contested Mark and the Earlier Trade Marks.



### **Conceptual Comparison**

11. The Contested Mark has a clear conceptual meaning, that is not present in the Earlier Trade Marks. The wording SGG APPAREL indicates a trade mark that is being used in relation to the sale of apparel products being sold by reference to the SGG brand. There is no equivalent

wording in the Earlier Trade Marks. Earlier Trade Mark No. EU007008477 contains the word ERREA, which does not have any recognisable meaning in English. Earlier Trade Mark No. EU009929845 does not contain any wording, and is a pure logo trade mark. This trade mark cannot be said to have any immediate, or obvious, conceptual meaning to consumers. The wording SGG APPAREL in the Contested Mark will be the dominant conceptual meaning that customers will understand from this trade mark. This is sufficient for the Contested Mark to be considered conceptually dissimilar to the Earlier Trade Marks.

12. For the reasons detailed above, it is submitted that there are clear conceptual differences between the Contested Mark and the Earlier Trade Marks, and that the respective trade marks are clearly distinguishable from each other on this basis.”

52) The only comment made by the opponent regarding the similarity of the marks was in the statement of grounds where it stated:

“The Opponent submits that the device element of the mark “” which is the .subject of UK Trade Mark Application No 3261155 (hereinafter referred to as the " Application") is similar to the Earlier Trade Marks on an overall comparison. Visually the Earlier Trade Marks which consist of the device element for “”are very similar to the applied for mark. The marks are therefore similar on an overall impression and furthermore, we submit that case law supports our argument that the Application and the Earlier Trade Marks consisting of the device element as detailed above, means that the marks are similar.”

53) To my mind, visually the device element in the mark in suit is readily identified as the outline of two diamonds placed one above the other and interlocking so that the points form a third diamond in the middle of the device. It also includes the words “SGG APPAREL” underneath. In contrast the opponent’s mark consists of two solid diamonds alongside each other and also overlapping, surrounded by a background colour formed by the outline device around the whole logo. It has no letters or words as part of the mark. Whilst there is a very small amount of similarity in that both devices have two interlocking diamonds, they are significantly different visually before one considers the letters and word in the instant mark which simply add to the degree of difference. Aurally, the mark in suit will be “SGG Apparel” whilst the opponent’s mark cannot be spoken. The marks are aurally not similar. Conceptually, the mark in suit is clearly identified as being from “SGG” irrespective of whether the consumer recognises who SGG is referring to. It has the concept of being from “SGG”.

The opponent's mark has no such conceptual meaning being simply a device mark. **Overall the marks are not similar, with the differences far outweighing the minor superficial similarities.**

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

54) 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).”

55) The opponent's mark is a relatively simple geometric design which has no meaning for the goods and services for which it is registered. The average consumer is used to non-verbal designs being used as trade marks and it must be considered to be **inherently distinctive to at least a medium degree**. The opponent has shown use of its mark in the UK and EU and **so can benefit from enhanced distinctiveness**.

### **Likelihood of confusion**

56) 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 the 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 for the goods is a member of the general public including who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay an average degree of attention to the selection of said goods and services.
- overall the marks are not similar, with the differences far outweighing the minor superficial similarities.
- the opponent's mark has a medium level of inherent distinctiveness and can benefit from an enhanced distinctiveness through use.
- the goods of the two parties fall into three categories. Some are identical, others similar to a medium degree whilst others have no similarity whatsoever. These are set out at paragraphs 38-48 above.

57) It is necessary to consider the likelihood of both direct and indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person, explained that:

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



common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

58) I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

59) In view of all of the above and allowing for the concept of imperfect recollection there is no likelihood of consumers being confused, directly or indirectly, into believing that any of the goods and services applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it, even when it is used upon identical goods or services. **The opposition under Section 5(2)(b) therefore fails in respect of all the goods and services applied for by the applicant. As the opposition against the application based upon the opponent's earlier mark EU 9929845 has failed the obvious corollary is that the opposition based upon its other earlier trade mark EU7008477 which has the device element as well as the word "errea" in it must also fail.**

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

"5. (3) A trade mark which-

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

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

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

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

62) The first hurdle is the issue of reputation as set out at points (a) and (b) above. The onus is upon the opponent to prove that its trade marks enjoy a reputation or public recognition. Earlier in this decision I accepted that the opponent did have a reputation for broadly speaking, sports clothing, sports footwear, sports bags and retail services in respect of these goods under both of its earlier trade marks.

63) I next have to consider whether the public will make a link. In Case C-408/01, *Adidas-Salomon*, the CJEU held that:

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

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which

the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

64) The level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

65) In C-252/07 *Intel Corp* [2008] ECR I-8823 at paragraph 42 the court set out the factors used to assess a link. Those factors include:

the degree of similarity between the conflicting marks;

the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

the strength of the earlier mark’s reputation;

the degree of the earlier mark’s distinctive character, whether inherent or acquired through

use;

the existence of the likelihood of confusion on the part of the public.

66) Earlier in this decision I found that both of the opponent's marks are not similar. To my mind, despite the fact that the users and some of the goods and services are identical and the fact that the opponent has reputation under its marks for these goods and services, if a member of the public saw the applicant's mark they would not immediately make the link to the opponent. **The ground of opposition under section 5(3) fails.**

## **CONCLUSION**

67) The opposition under sections 5(2)(b) and 5(3) fail in respect of all the goods and services sought to be registered

## **COSTS**

68) As the applicant has succeeded in it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence	£800
Providing submissions	£500
<b>TOTAL</b>	<b>£1,600</b>

69) I order Errea' Sport S.p.A to pay The Liverpool Football Club and Athletic Grounds Limited the sum of £1,800. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 17 May 2019**

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