

O-382-20

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK REGISTRATION NO. 3261345
IN THE NAME OF PDX SPORTS LTD
FOR THE TRADE MARK:**



AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 502388 BY SVA GLOBAL VENTURES LTD.**

BACKGROUND

1) The trade mark shown on the cover page of this decision stands registered in the name of pdx sports ltd ('the proprietor'). It was applied for on 04 October 2017 and entered in the register on 29 December 2017 in respect of the following goods:

Class 18: Bags; sports bags; parts and fittings for all of the aforesaid goods.

Class 25: Clothing, footwear and headgear for boxing and martial arts.

Class 28: Apparatus, articles and equipment for use in relation to boxing, martial arts body-building and weight-training; boxing gloves; sporting articles [padding] for protective purposes for use in relation to boxing and martial arts; shaped padding for protecting parts of the body [specially made for use in sporting activities]; punch bags; shields for use in martial arts; parts, accessories and fittings for all the aforesaid.

2) On 07 December 2018, SVA Global Ventures Ltd ('the applicant') filed an application to have this trade mark registration declared invalid. The applicant relies upon numerous grounds under the provisions of sections 47, 5(1), 5(2)(b), 5(3), 56, 5(4)(b) and 3(6) of the Trade Marks Act 1994 ('the Act').

3) Under the provisions of sections 5(1), 5(2)(b) and 5(3) the applicant relies upon four trade marks, as follows:

Trade Mark details	Goods and Services relied upon
TM Registration No: UK00002574971 RDX Filing date: 15 March 2011 Date of entry in register: 01 July 2011	All goods and services in classes 9 and 25.

<p>TM registration No: UK00002577142</p> <p>RDX</p> <p>Filing date: 04 April 2011</p> <p>Date of entry in register: 29 July 2011</p>	<p>All services in classes 06, 18 and 28.</p>
<p>TM Registration No: UK0000306081</p> <p>RDX</p> <p>Filing date: 20 June 2014</p> <p>Date of entry in register: 28 November 2014</p>	<p>All goods and services in classes 06, 09, 10, 18, 25, 28 and 35.</p>
<p>TM Registration No: EU011718095</p> <p>RDX</p> <p>Filing date: 08 April 2013</p> <p>Date of entry in register: 04 September 2013</p>	<p>All services in classes 06, 18, 25 and 28.</p>

4) The applicant's registrations are earlier marks, in accordance with section 6 of the Act. As three of the earlier marks (UK00002574971, UK00002577142 and EU011718095) completed their registration procedures more than five years prior to the date on which the application for invalidation was filed, they are subject to the proof of use conditions, as per section 6A of the Act. However, mark number

UK0000306081 is not subject to proof of use because it completed its registration procedure less than five years before the date on which the application for invalidation was filed.

5) The proprietor filed a counterstatement denying all the grounds of invalidation.

6) Both parties filed evidence. A hearing took place before me on 14 May 2020. The applicant was represented by Ms. Bushra Nasir; the proprietor was represented by Mr. Mohammed Tayyab.

EVIDENCE

7) The applicant's evidence consists of a witness statement from Shazaib Amin Malik and eleven exhibits thereto. The proprietor's evidence consists of a witness statement from Mohammed Tayyab and one exhibit thereto. I do not intend to summarise either party's evidence here. I have read all the evidence and will refer to it when it is relevant to do so in the following decision.

DECISION

8) I will begin by considering the grounds under Section 5(2)(b) of the Act. As earlier mark UK0000306081 is not subject to proof of use and covers goods in classes 18, 25 and 28, it clearly offers the applicant its best prospect of success and therefore I need only consider that mark under this ground. The relevant part of the Act states:

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

(a)....

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

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

9) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

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

The correct approach

10) Much of the proprietor's counterstatement and evidence serves to highlight the differences between the actual goods provided by the parties in the marketplace. Before going any further, it is necessary for me to explain why such comments and evidence do not assist the proprietor. This is because I am required to make the assessment of the likelihood of confusion notionally and objectively based on the proprietor's goods, as applied for, and the applicant's goods, as registered, in accordance with the relevant case law. For example, in *O2 Holdings Limited, O2*

(UK) Limited v Hutchison 3G UK Limited, Case C- 533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Further, in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

The actual goods which may currently be being provided in the marketplace by either party is therefore not relevant to my assessment. I must consider the matter on the basis of the notional and objective meanings of the terms covered by the parties’ respective trade mark specifications.

11) Furthermore, in terms of assessing the similarities between the respective marks, I must only consider the representations of the parties’ marks as they appear on the register. Any additional or different matter/stylisation which is not present in those representations is irrelevant to my assessment.

Comparison of goods

12) The goods to be compared are:

Proprietor’s goods	Applicant’s goods
<p>Class 18: Bags; sports bags; parts and fittings for all of the aforesaid goods.</p>	<p>Class 18: Bags, sports bags, holdalls, equipment bags, travelling bags, luggage, rucksacks, knapsacks, belt pouches, bum bags, school bags, boot bags, purses, travel purses, wallets; gym</p>

Class 25: Clothing, footwear and headgear for boxing and martial arts.

Class 28: Apparatus, articles and equipment for use in relation to boxing, martial arts body-building and weight-training; boxing gloves; sporting articles [padding] for protective purposes for use in relation to boxing and martial arts; shaped padding for protecting parts of the body [specially made for use in sporting activities]; punch bags; shields for use in martial arts; parts, accessories and fittings for all the aforesaid.

bags; parts and fittings for all the aforesaid goods.

Class 25: Clothing, footwear, headgear; clothing, footwear and headgear for sports use; clothing, footwear and headgear for boxing and martial arts; gloves, sports gloves; boxing shoes, boxing shorts, boxing pants; gym wear, gym shorts, head bands, sweat bands, wrist bands, sweat shirts, sweat pants, hooded tops, hooded sweat shirts, track suits, track suit bottoms, jogging pants, jogging tops, jogging suits, casual clothing, shorts, trousers, pants, tops, vests, t-shirts, polo shirts, jackets, coats, jumpers, leg warmers, leggings, socks, belts (clothing), caps and hats, beachwear, swimwear, underclothing, boxer briefs, boxer shorts.

Class 28: Games and playthings, gymnastic and sporting articles, but not including sports rackets; sporting equipment and apparatus, but not including sports rackets; apparatus, articles and equipment for use in relation to boxing, martial arts, body-building and weight-training; sporting articles (padding) for protective purposes for use in relation to boxing and martial arts; shaped padding for protecting parts of the body (specifically made for use in

	sporting activities); shields for use in martial arts; punch bags, punching balls, boxing pads; sporting hand guards; boxing hand guards; martial arts hand guards; boxing pads; hands wraps; knuckle guards, body protectors, groin protectors, abdominal protectors, rib protectors, sports gloves, boxing gloves, boxing shoes, skipping ropes, gym balls.
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13) All of the proprietor’s goods are covered by the applicant’s specification in classes 18, 25 and 28. They are therefore, notionally and objectively, identical.

Average consumer and the purchasing process

14) It is necessary to determine who the average consumer is for the respective services and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

15) The average consumer for the goods at issue is the general public. The goods will be purchased mainly by the eye from retail premises or websites. That is not to say though that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with retail staff, for example. The cost of the goods is likely to vary but given that factors such as size, colour, pattern or suitability for purpose and

functionality are likely to be taken into account by the consumer, I would expect at least a medium degree of attention to be paid during the purchase for all the goods.


Comparison of marks

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

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

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

17) The marks to be compared are:

Proprietor's mark	Applicant's mark
	RDX

18) The proprietor's mark consists of the letters PDX on block capitals. On top of those letters is a red arc-type shape (hereafter the 'red device') extending from the base of the letter 'P' to near the top of the letter 'X'. The red device makes a substantial contribution to the visual impression of the mark. However, I find that the letters PDX have the greatest relative weight in the overall impression conveyed by the mark. Turning to the applicant's mark, this consists of the letters RDX in plain capital letters. The overall impression of that mark is based solely upon those three letters.

19) Visually, the marks coincide in so far as they both consist of three capital letters and the last two of those letters are the same (D and X). They differ in so far as the first letter is P in the proprietor's mark and R in the applicant's mark. That said, the letters P and R are quite visually similar. The red device in the proprietor's mark is also absent from the applicant's mark. Overall, I find a medium degree of visual similarity between the marks.

20) Aurally, the red device will not be vocalised. The comparison is therefore between RDX and PDX. Each mark will be pronounced, predictably, as an initialism i.e. as the three separate letters of which they are composed. The respective first letters sound different to the ear but the second and third are identical. Overall, there is a medium degree of aural similarity between the marks.

21) Turning to the conceptual position, a conceptual message is only relevant if it is capable of immediate grasp¹. Both marks contain a string of three letters (PDX in the proprietor's mark and RDX in the applicant's mark). As neither the letters in the respective marks nor the red device in the proprietor's mark evoke any immediately graspable concept, the conceptual position is, effectively, neutral.

¹ This is highlighted in numerous judgments of the GC and the CJEU, including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

Distinctive character of the earlier mark

22) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

23) The applicant’s mark consists of the plain letters RDX. It is not descriptive or allusive in relation to the goods covered by the earlier mark in any way. I find it to have a normal (average) degree of inherent distinctiveness. Having reviewed the applicant’s evidence, it does not establish that that degree of distinctiveness has been enhanced through use in the UK.

Likelihood of confusion

24) When conducting the global assessment of the likelihood of confusion, I must keep in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

25) I will first consider the likelihood of direct confusion. This is where the consumer mistakes one mark for the other because they think they are the same. The lack of any conceptual hook for the consumer for either mark, resulting in them being conceptually neutral, means that the average consumer is likely to be more prone to the effects of imperfect recollection because the consumer will not have any conceptual hook to aid them in accurately recalling the marks. Bearing this in mind, together with the normal degree of distinctiveness of the earlier mark, the medium degree of visual and aural similarity between the marks and the identical goods in play, I find that an average consumer paying a medium degree of attention is likely to mistake one mark for the other through imperfect recollection. There is therefore a likelihood of direct confusion.

26) In case I am wrong to find a likelihood of direct confusion, I will also consider whether there is a likelihood of indirect confusion. In this connection, I note that 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.”

27) Further, 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.

28) I find that, in the event, that the average consumer does recognize that the respective marks are different, this is likely to be because they recall that one mark has the red device but the other mark does not. However, there is still, in that scenario, a likelihood, given the conceptually neutral position and medium degree of visual and aural similarity between the marks overall, that they will misremember the letters within the marks as being the same. In such a scenario, they are likely to believe that the recalled difference (i.e. the presence/absence of the red device) is merely due to the same undertaking using variant marks. They are therefore likely to believe that the goods still come from the same undertaking. There is a likelihood of indirect confusion.

OTHER GROUNDS

29) I can deal with all the other grounds briefly. The grounds under section 5(1) are clearly without merit given that the respective marks are patently not identical. Turning to the claims under section 5(3) of the Act, suffice it to say, the evidence before me comes nowhere near establishing that any of the earlier marks have the requisite reputation in the UK for the purpose of section 5(3) of the Act or, indeed, that they are well-known marks as per section 56 of the Act. Furthermore, the

applicant does not, in any event, appear to satisfy the requirement under section 55(1)(b) of the Act which is necessary to bring a claim under section 56.

30) As for the claim under section 3(6), this is based on the applicant's contention that the proprietor has intentionally applied for a confusingly similar mark to its own. If I am wrong to have found that the marks are confusingly similar under section 5(2)(b), it seems to me that I would also be wrong to find that proprietor has acted in bad faith i.e. it cannot be bad faith to apply for a mark which is not confusingly similar (and there is no other reason advanced by the applicant as to why the mark has nevertheless been applied for in bad faith).

31) Insofar as the claim under section 5(4)(b) is concerned, those grounds clearly have no prospect of success. The contested trade mark and the earlier registered designs relied upon, for an iron hanger (registration number 4043149) and a boxing glove (registration number 4044501), would patently make different overall impressions on the relevant informed user.

OUTCOME

32) The application to invalidate the trade mark registration succeeds.

COSTS

33) As the applicant has been successful, it is entitled to a contribution towards its costs. In an official letter to the applicant, dated 07 April 2020, the applicant was advised that, if it intended to make a request for an award for costs it should complete and return the relevant costs proforma by 01 May 2020. The same letter stated that:

“If the proforma is not completed and returned, no costs, other than official fees arising from the action (excluding extensions of time), will be awarded.”

34) As the applicant did not respond to that invitation the only costs it is entitled to is in respect of the official fee for filing its notice of invalidation. **I therefore order pdx sports ltd to pay to SVA Global Ventures Ltd the sum of £200.** This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 05th day of August 2020

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