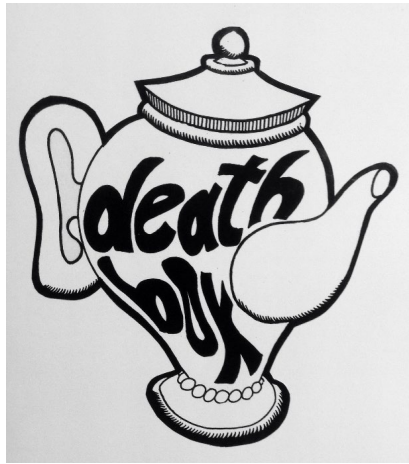


O-507-20

TRADE MARKS ACT 1994

**IN THE MATTER OF
THE APPLICATION UNDER NO. CA502617
BY JEREMY FOX
TO INVALIDATE UK TRADE MARK NO. 3152430:**



REGISTERED IN THE NAME OF GRAHAM MCEACHRAN IN CLASS 25

BACKGROUND AND PLEADINGS

1. Graham McEachran (“**the Proprietor**”) has a UK trade mark registration for the figurative trade mark shown on the cover of this decision. The Proprietor applied to register the mark on 1 March 2016 (“**the Relevant Date**”), and on 27 May 2016 it was entered in the register in respect of the goods in Class 25 listed as follows:

"T shirts" "sweatshirts" "polo shirts" "shorts" "sweat pants" "socks" "gloves" "skate shoes" "jackets" "belts" "denim trousers" "cargo pants" "hooded jackets" "baseball hats" "beanie hats" "bush hats" bobble hats.

2. On 21 May 2019, Jeremy Fox (“**the Applicant**”) applied seeking a declaration of invalidity against that registration (in its entirety). The Applicant bases its objections on grounds under **sections 5(2)(b), 5(3) and 5(4)(a)** of the Trade Marks Act 1994 (“**the Act**”).¹
3. For its claims under sections 5(2)(b) and 5(3) of the Act the Applicant relies on the following earlier filed EU trade mark registration:

EUTM: 14526768 for the word mark: **DEATHBOX**

Filing date: 4 September 2015

Registration date: 22 December 2015

Class 28: *Sporting goods, namely, skateboards, skateboard decks, skateboard trucks, and skateboard wheels.*

4. In relation to its **section 5(2)(b)** grounds, the Applicant claims that the parties’ marks are “highly similar” and that the prior word mark is “incorporated” in the Proprietor’s mark. It argues that “the graphical element” of the Proprietor’s mark “is irrelevant as the word element is still clearly visible and dominant” and that “the overall similarity between the marks outweighs any differences.” It claims that the respective goods are “similar and complementary”, arguing that the goods are of “similar nature, travel through identical channels of trade and are targeted at identical public. Moreover, typically those goods are provided by a single undertaking or connected undertakings. It is clear and obvious that if the average consumer would come across clothing provided by the proprietor with the same name as the sporting goods including skateboards, provided by the Applicant,

¹ Applicable to the cancellation action by virtue of section 47(2)(a) of the Act.

the average consumer will associate these types of goods and will think they come from the same undertaking. Considering the above there exists a likelihood of confusion on the part of the relevant public, which includes the likelihood of association.”

5. In relation to its **section 5(3)** grounds, the Applicant claims that its mark had acquired “a reputation amongst the relevant public in the UK”, and that the similarity between the respective marks is such that the relevant public will not only believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks, but also that:
- “the Proprietor would benefit from the Applicant's investment in the development, advertising and promotion of its brand, leading to advantage to the Proprietor without any investment on their side, which is unfair to the Applicant”;
 - “the Proprietor’s use of a highly similar mark would be outside the direct control of the Applicant and could negatively affect the Applicant’s brand if the Proprietor’s goods are of a poor quality, which would be detrimental to the Applicant’s brands which they have been developing for more than 20 years”;
 - “The Proprietor’s use of the mark would be detrimental to the distinctive character of the Applicant's mark as it would no longer signify a single origin. Furthermore, the economic behaviour of the relevant public would be affected as they would associate the Proprietor’s goods with those of the Applicant.”
6. For its **section 5(4)(a) claim**, the Applicant claims to have been using an identical figurative mark throughout the UK since at least 1991 “for the same or highly related goods” to those under the Proprietor’s registration. Thus the Applicant claims earlier



rights in the sign

(“**the sign**”) in relation to *clothing, T-shirts, skateboards,*

stickers, and *sporting goods* and that use of the contested registration was liable to have been prevented on the basis that use of the sign would have been contrary to the law of passing off.

7. It is claimed that “as a result of that use during these years the Applicant has built up a significant reputation and goodwill associated with their mark. The use by the Proprietor

of the registered mark constitutes a misrepresentation leading or likely to lead the public to believe that the goods they offer for sale are those of the applicant. The Applicant has no control of the quality of the Proprietor's goods and the average consumer may easily be confused if they are approached by the Proprietor providing the same or highly related goods to the applicant.”

The defence

8. The Proprietor admitted that the Applicant’s EUTM 14526768 is an earlier trade mark, but denied the Applicant’s points claimed as to the similarity of the marks and denied that the Applicant’s goods in Class 28 are similar or complementary to the contested goods in Class 25. It denied any likelihood of confusion or association on the part of the relevant public between the respective marks and goods. It also denied the section 5(3) and 5(4)(a) grounds and put the Applicant to proof of its claims.

Representation and papers

9. In these proceedings, Basck Limited acts for the Applicant; Ward Trade Marks Limited for the Proprietor. During the evidence rounds, the Applicant filed written submissions along with its evidence in chief. The Proprietor filed evidence and submissions and the Applicant filed further written submissions and evidence in reply. The evidence in total filed ran to several hundred pages and some of its contents had little or no relevance to my task of deciding the claims. I outline below, to the extent I consider warranted, a summary of the evidence. I refer to points of evidence, as well as to points in submission, where appropriate in this decision. Neither party requested an oral hearing and I make this decision having read all the papers filed.

EVIDENCE

10. The following materials were filed during the evidence rounds:

Applicant’s evidence in chief and submissions

- Written submissions dated 30 September 2019
- Witness statement: **Jeremy Fox**, dated 30 September 2019, with **Exhibits JF1 - JF20**
- Witness statement: **Duncan Houlton**, dated 30 September 2019

Registered Proprietor's evidence and submissions

- Witness statement: **Graham McEachran**, dated 24 January 2020, with **Exhibits GM1 - GM14**
- Witness statement: **Rachael Elizabeth Ward**, dated 25 February 2020, with **Exhibits One to Six**.

Applicant's evidence and submissions in reply

- Written submissions dated 8 April 2020
- Witness statement: Jeremy Fox dated 26 March 2020, with **Exhibit JF2-1**

11. From the evidence filed, I note the following:

- i. That in 1987, Jeremy Fox, Duncan Houlton and Graham McEachran, were involved in various ways in the creation of a skateboard brand. The business traded as an unincorporated entity under the name Dee See Supplies.
- ii. The brand was known by the words Death Box, and its branding included use of the teapot device that is the contested mark. The brand appears to have been presented in various forms, including as one word or as two. For example: **Exhibit JF2:**



- iii. **Exhibit JF4** - is said to be a 1989 advertisement for the brand, and is a photo of a skateboard rider performing an aerial stunt and where the contested (teapot) logo appears in the bottom right of the picture and the top left features the following much



elaborated stylisation of the word mark:

- iv. Mr Fox states at paragraph 5 of his first witness statement that the DEATHBOX brand was applied on t-shirts and skateboards. Paragraph 5 states that he “put significant funding and effort into advertising and marketing the brand death box”.



- v. **Exhibit JF8** is undated, and shows this image in the corner of what is said to be an advertisement in UK skateboard magazine and where the main image shows a skateboard rider and two skateboard decks and skateboard wheels. **Exhibit JF5** shows the cover of “RAD” magazine, from 1990, where the skateboard rider is wearing a long-sleeved top which appears to bear the teapot logo. Mr Fox states at paragraph 7 of his statement that in 1988-1990 he sold stickers bearing the brand. **Exhibit JF12** is undated, but shows what appear to be stickers, some of which include various stylised renderings of the words death box, and amongst which is the contested logo.
- vi. In the late 1980s, the Proprietor was a young skateboarder, prominent in UK skateboarding circles. He created the logo; he states that it was his idea to use the term death box as the name for the business. (There is disagreement between the parties as to who may now own the copyright in the contested mark, but these proceedings are not based on copyright claims.)
- vii. **Exhibit GM6** shows that in 1990 Mr Fox (“trading as Dee See Supplies”) filed successful UK trade mark applications in classes 25 and 28 in respect of what was same sign (i.e. the teapot logo) contested in this opposition, but those trade mark registrations (Nos. 1412912 and 1412913) lapsed in 1997.
- viii. Sales under the deathbox brand ceased in 1992, but Mr Fox states that shirts, skateboards and other products were still largely promoted by professional skateboard riders (whom he names) and he states that “the reputation and goodwill remained the same”. Mr Fox moved to California in 1994 and established a skateboard brand named Flip.
- ix. In July 2007 Mr Fox organised a celebration in Rotterdam in the Netherlands to mark the 20th anniversary of the deathbox brand. **Exhibit JF13** shows a promotional flyer, showing the branding used and the opening times for the 3 days of the exhibition:



- x. **Exhibit JF14** shows a blogpost on blogspot.com, dated 24th July 2007, referencing the anniversary event and referring to the company as “set up by Mr Fox, McEachran and Duncan Houlton”. The blogpost is shown to have attracted 4 comments between July 2007 and November 2010.
- xi. Mr Fox states that he had teapot logo tee-shirts and stickers produced as merchandise for the anniversary event which he states “was sold to the public and presented to the riders and to the proprietor”. Mr McEachran acknowledges that t-shirts bearing the teapot logo were available at the reunion and states (at paragraph 32 of his witness statement) that he did not object to the deathbox branding because it was a one-off event and “all the merchandise was given away, not sold”. He states that he did not witness any sales.
- xii. Mr Fox states at paragraph 12 that “the reputation of the deathbox brand and goodwill in the UK was such that about five years ago there was an internet petition created” directed to Mr Fox asking that he reissue his skateboards in the UK. Mr Fox states that this shows how the brand is directly associated with his name in the community of skateboard riders. **Exhibit JF15** shows a print-out, dated 24 September 2019, from 38degrees.org.uk showing that petition. It is not clear how many signatures the petition has gathered but page 3 indicates that five years ago it had attained 100 signatures and page 2 shows that 6 months ago it had gathered 500 signatures (although that would have been after the relevant date).
- xiii. To support its position as to the likelihood of confusion arising from the parties’ goods, the Applicant filed **Exhibit JF16**, which shows the assessment expressed in an official letter by the USPTO where it rejected an application by the Applicant to register its trade mark in the USA. The USPTO refused to register the Applicant’s mark for skateboards in Class 28 because a third party had an earlier US registration for the

identical word mark in relation to clothing goods, headwear and footwear in Class 25. The USPTO considered the goods related and rejected the application in view of the identical prior mark. Along with the content of the official letter from the USPTO are copies of the evidence filed in that case, which showed companies online selling both skateboards and apparel.

- xiv. Ms Ward is the Proprietor's trade mark attorney and she makes various submissions in relation to the grounds claimed in these cancellation proceedings. She also presents evidence at **Exhibit Five** to her witness statement to indicate the proportion of the public who engage in skateboarding.

DECISION

The section 5(2)(b) grounds

12. Section 5(2)(b) of the Act, reads as follows:

"5. – [...]

(2) A trade mark shall not be registered if because – [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

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

- (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.

Comparison of the goods

14. The respective goods are as follows:

Class	The Applicant's goods
28	<i>Sporting goods, namely, skateboards, skateboard decks, skateboard trucks, and skateboard wheels.</i>
Class	The Proprietor's goods
25	<i>"T shirts" "sweatshirts" "polo shirts" "shorts" "sweat pants" "socks" "gloves" "skate shoes" "jackets" "belts" "denim trousers" "cargo pants" "hooded jackets" "baseball hats" "beanie hats" "bush hats" bobble hats.</i>

15. Section 60A(1)(b) of the Act makes clear that goods are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification. Rather, in considering the extent to which there may be similarity between goods, I take account of the guidance from relevant case law. Thus, in *Canon* the Court of Justice of the European Union (“**the CJEU**”) stated that:

*“In assessing the similarity of the goods ... all the relevant factors relating to those goods .. 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”.*²

16. In *Boston Scientific*, the General Court described goods as “complementary” in circumstances where “... *there is a close connection between [the goods], 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*”.³ I also take note that in *Kurt Hesse v OHIM*, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.⁴

² Case C-39/97, at paragraph 23.

³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

⁴ Case C-50/15 P

17. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case⁵ for assessing similarity were:
- (a) The respective uses of the respective goods or services;
 - (b) The respective users of the respective goods or services;
 - (c) The physical nature of the goods or acts of service;
 - (d) The respective trade channels through which the goods or services reach the market;
 - (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
 - (f) The extent to which the respective goods or services are competitive.
18. The Applicant claims in its statement of grounds (and at paragraph 13 of its opening submissions) that the goods are of a similar nature - I disagree. The competing goods are made of different materials and are completely different in form, function and appearance. They are clearly not similar in their nature, intended purpose nor method of use. The Applicant's goods are used as a means of transport and/or for performing riding stunts, whereas the Proprietor's goods are clothing, headwear and footwear to be worn on the body – their uses therefore have no similarity, and nor are they in competition with each other.
19. In comparing the goods, the Applicant directed its opening and closing submissions to argue as follows:
- i. the goods are provided by a single undertaking or connected undertakings and it is common knowledge that companies provide both clothing and sporting goods under the same brand;
 - ii. the goods may be considered complementary;
 - iii. they travel through the same channels of trade;
 - iv. are likely to be found next to each other on shop shelves or in the same category in online shops;
 - v. they target the same general public.

20. On behalf of the Proprietor, Ms Ward argued that there was no basis to consider the goods similar or complementary.
21. In my view, given the very clear ways in which the goods are dissimilar, if the Applicant sought to establish similarity premised on shared manufacture and/or channels of trade, it would need to have presented robust evidence to support that contention.⁶ Despite the assertions of “common knowledge” put forward in submission, I do not consider it a notorious fact that those who make and sell skateboards and their parts likewise market the clothing and headwear goods contested in these proceedings. It is not open to me to take judicial notice in that regard.
22. I do not overlook that **Exhibit JF16** included evidence relating to websites that sold not only skateboards, but also goods such as caps and hoodies under brand names such as “Santa Cruz”. However, that evidence was filed for the proceedings before the USPTO and there is no indication that the websites there referenced are directed to the UK market, so I do not consider this to be evidence of the market norms in the UK. Nor can it be determined whether a brand such as Santa Cruz would be typical or more exceptional. Paragraph 23 of the Applicant’s closing submissions stated that “skateboards and parts thereof are often sold even in supermarkets, not any specialised stores.” If shops in the UK normally sell the respective goods at issue (both under a common brand), then the Proprietor could have filed evidence of that. I can say, in my experience as an average consumer, that it is not the case that such goods are typically sold alongside one another in supermarkets, and nor are skateboards typically in clothing shops.
23. The Applicant’s goods are not indispensable to those of the Proprietor, and while it may be sensible and desirable not to be naked while skateboarding, the clothing and headwear goods of the Proprietor are not so important to the use of the Applicant’s goods that customers may think that the responsibility for those goods lies with the same undertaking.
24. The Proprietor’s goods include “skate shoes”. Although I noted no evidence or submissions specifically addressing those goods, it seems to me that the term “skate shoes” implies a type of footwear intended to be well suited for use while skateboarding.

⁶ See paragraph 43 of the judgment of the General Court in *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, to the effect that if the similarity between the goods/services is not self-evident, it may be necessary to adduce evidence of similarity, even if the marks are identical.

In that regard, such suitable footwear may fairly be considered important for use with skateboards. The evidence does not establish that those goods are usually of shared origin, but the relationship between “skateboards” and “skate shoes” - given the shared sectoral focus (or at least interest) apparent from those words - strikes me as sufficiently close that a material portion of those who make up the average consumer group may think that the responsibility for those goods lies with the same undertaking. I find such goods may therefore be considered complementary in line with the description of that factor in *Boston Scientific*.

25. Ms Ward’s **Exhibit Five** included a print-out from an article published on *statista.com* relating to levels of skateboarding participation in England between November 2016 and May 2019.⁷ Ms Ward concluded from the survey response figures in the article that the proportion of the adult population of England (based on ONS figures) skating on a monthly basis equated to 0.14%. While I treat this survey evidence and Ms Ward’s conclusion with a high level of caution, I accept that the proportion of the general public who skateboard is very small. More importantly, the Applicant’s goods as registered are not specialised (except perhaps “skate shoes”); therefore, while there is an overlap in users, since the parties’ respective goods are targeted at the general public at large, I do not consider that a strong factor in this case, and not a basis operating alone to warrant a finding of similarity.⁸
26. On the basis of my analysis as set out above, I conclude that “*T shirts*” “*sweatshirts*” “*polo shirts*” “*shorts*” “*sweat pants*” “*socks*” “*gloves*” “*jackets*” “*belts*” “*denim trousers*” “*cargo pants*” “*hooded jackets*” “*baseball hats*” “*beanie hats*” “*bush hats*” *bobble hats* are not similar to the Applicant’s skateboards (or parts); nor are those goods complementary.
27. In *eSure Insurance v Direct Line Insurance*, Lady Justice Arden stated that: “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.”⁹ Since some similarity of the goods

⁷ Participation was defined as at least twice in the last 28 days. The survey was based on nearly 178,000 respondents (aged 16+).

⁸ While I have noted the decision of the USPTO filed as **Exhibit JF16**, as the Applicant’s submissions correctly acknowledged, this tribunal is not bound by assessments of other trade mark offices. The US proceedings not only involved different (identical) marks and evidence filed in a different context, but the legal approach is also different in the USA, where technically, similarity of goods is not needed at all, as long as likely confusion can be shown through other indicia.

⁹ [2008] ETMR 77 CA at para 49

is essential under section 5(2)(b),¹⁰ the claim based on that ground must fail in relation to the goods just listed.

28. In relation to "skate shoes" my analysis has allowed that those goods may be considered complementary to the Applicant's skateboards and that there is a stronger aspect of shared users. I shall continue my consideration of the section 5(2)(b) claim in respect of those goods (only).

The average consumer and the purchasing process

29. In *Hearst Holdings Inc*,¹¹ Birss J explained that "... *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 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 word "average" denotes that the person is typical*".
30. The average consumer both for skateboards (or their parts) and for skate shoes will be a member of the general public. Neither the goods of the Applicant, nor the Proprietor's "skate shoes" are casual everyday purchases, but nor are they likely to be especially expensive; skate shoes will be chosen for fit, comfort, looks and suitability, and the skateboards and parts for their looks, form and function. The Applicant submitted that the goods involve on the part of the purchaser an "average degree of attention".¹² In line with that assessment, I agree that the average consumer will pay **a medium level of attention**.
31. The average consumer will purchase the goods either by self-selection from a retail outlet, or from a website or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase, given the potential for oral recommendations and that advice may be sought from retail assistants.

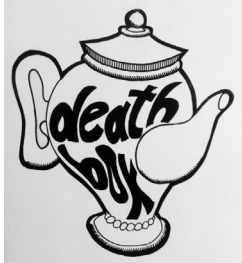
¹⁰ See too *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

¹¹ *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), at paragraph 60.

¹² For example, at paragraph 24d of its closing submissions.

Comparison of the marks

32. It is clear from *Sabel* 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 in *Bimbo* that: “.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”¹³
33. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

The earlier trade mark:	DEATHBOX
The contested mark:	

34. The overall impression of the earlier word mark of the Applicant is that it is the word DEATHBOX, which is an unusual coinage or expression, albeit that it will be seen to be the product of conjoining two common and familiar words – “death” and “box”.
35. The contested mark is a composite mark where textual and graphical elements contribute variously to the overall impression. Far from being “irrelevant” as claimed by the Applicant in its statement of grounds, the representation of a cartoonish teapot contributes significantly to the overall impression. It is a strikingly quirky depiction and is the largest element. The textual elements are presented as if applied to the irregular outer contours

¹³ *Bimbo SA v OHIM, Case C-591/12P* (at paragraph 34)

of the teapot, and while the word “death” is readily discernible, the word “box” is less legible. The text does not dominate the mark. In my view, the role of the teapot device is at least as important and distinctive as the text in the overall impression of the contested mark.

Visual similarity

36. Whereas the Applicant’s mark is the single word “DEATHBOX”, it can readily be seen to comprise the two words “death” and “box”. Those words form the textual components of the contested mark. However, even between the text of the marks visual differences arise: firstly, the words in the contested mark are presented with some cartoonish stylisation. Case law affords plain word marks broad protection that allows their use in different fonts and typefaces, so I do not consider the font differences to be an issue per se.¹⁴ Secondly, a visual difference arises from the fact that in the contested mark the text is not presented as a single word “deathbox” - or even with the words presented side by side as “death box” - rather the words “death” and “box” are presented one above the other. However, the far more significant visual difference between the textual elements arises from the degree of distortion of the lower, separated word “box” as it is presented in the contested mark. Ms Ward’s submissions included that: “.. *the word “box” has been more heavily stylised so as to fit in the narrower lower part of the teapot. Indeed the word “box” is portrayed in such a way that it is difficult to work out what the word is; the “b” slips back significantly the “o” could be said to look like the numeral 8 and the “x” could well be the letter “k”.* I consider those reasonable points of submission, although I also allow that the word “box” will be perceived by many among the average consumer group.
37. Ms Ward also submitted that “*To a consumer, this trade mark, when applied to clothing, would be seen, recognised and referred to as a teapot device or logo. The teapot device would not be referred to by the stylised lettering shown on the teapot. It is the fact that the teapot is being used to indicate origin on clothing that is unusual and likely to be remembered by consumers during the purchasing decision. The striking image of a teapot would stay in the mind of the consumer as it is novel usage in relation to the goods for which the mark is registered (various clothing items in class 25). For these reasons the respective marks DEATHBOX and the teapot device are visibly very different.*”

¹⁴ See Case T-24/17 *La Superquímica v EUIPO*, EU:T:2018:668 at paragraph 39; see too paragraphs 11 and 12 of the appeal decision BL O/091/19, Professor Phillip Johnson as the Appointed Person.

38. While I agree that the teapot device has a memorable visual impact, I also recognise that the average consumer will likely attempt to make out words where text is present in a mark. That said, the notion that in trade marks words speak louder than devices can be taken only so far; taking into account the overall impressions of the marks, the lack of clarity in the second word in the Proprietor's mark, and particularly the central presence of the teapot device, I find that from a visual perspective the marks may be considered similar **to a degree between low and medium.**

Aural similarity

39. Ms Ward submitted that the contested mark would be referred to orally by reference to the teapot logo, arguing that that is the dominant and distinguishing feature and that the words are arranged in such a way as to lack clear visibility. While I do not rule out the possibility that some may reference it that way, in my view there will be many consumers who will note not only the clear word "death", but also discern the less clear second word "box" and will consequently voice those textual elements in the same way as the Applicant's mark will be said. On that basis, I consider the respective marks to be **aurally identical.**

Conceptual similarity

40. The concept attaching to the Applicant's mark must come from that single word, albeit that within that single word, the average consumer will readily perceive the two ordinary words "death" and "box". The general public will understand the first word as the opposite of life; the second word has several meanings, prime among which is the notion of a container (typically with square or rectangular sides, and a lid), but perhaps also the action of fighting with fists.

41. The single conjoined word that is the Applicant's mark will seem an invented term to many among the general public. However, there is evidence that the term has a particular meaning within the skateboarding community. For example, **Exhibit GM2** refers to the description on urbandictionary.com of a small rectangular section of an inground pool recessed into the top of the pool wall, offering daring riders an opportunity to leave the surface of the pool altogether, "catch some air" and then drop back into the bowl of the pool. "If re-entry was not done correctly things could go horribly wrong and thus the name death box."¹⁵ While the evidence is not clear on how widely known that term remains,

¹⁵ (and Ms Ward's Exhibit Three)

since the Applicant's goods will be bought by members of the general public who have a particular interest in skateboarding, I allow that a significant part of the relevant public may be aware of that conceptual implication of the term.

42. The concept attaching to the Proprietor's mark comes partly from the discernible words and partly from the device of a teapot. Those who perceive both words, will readily give each word its ordinary meaning. Since the teapot is labelled that way, it is possible some may conjure the concept that the device is a quirky urn for ashes – a death box. However, in my view, for the public at large the significance of the words together - as opposed to individually - will conjure no immediately graspable cohesive concept. That said, since I have found "skate shoes" to be complementary to "skateboards" and to share the same users, I allow that some of the relevant public may again be aware of the conceptual implication of the term in a skateboarding context.
43. On the basis of their textual aspects, there are therefore clearly conceptual overlaps between the marks. However, the prominent device in the Proprietor's mark immediately conveys the concept of a teapot and that striking image creates conceptual difference. In my view, taking into account the overall impressions of the marks, the lack of clarity in the second word in the Proprietor's mark, and particularly the central presence of the teapot device, I find that from a conceptual perspective the marks may be considered similar **to no more than a medium degree.**

Distinctiveness of the earlier mark

44. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.¹⁶ In *Lloyd Schuhfabrik*, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

¹⁶ *Sabel* at [24]

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)".

45. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark may be enhanced by virtue of the use that has been made of it.
46. The earlier mark involves two ordinary words, but they are conjoined to create a single word that appears more or less invented, albeit that the word may have been coined in reference to part of the arena for pool-based skateboarding. For those who may be aware of the skating pool derivation, there is a degree of allusiveness in relation to the Applicant's goods, but the word-phrase remains striking. For the majority of the general public, the origin of the word will be unknown and the skating connection not perceived, such that the word is all the less familiar and striking. **I consider the earlier mark to be inherently distinctive to a reasonably high degree.**
47. Were the Applicant to have any prospect of benefiting from a claim of enhanced distinctiveness, the evidence would need to show use of his mark, in relation to the registered goods relied on, sufficient to have enhanced the distinctiveness of the mark among the average consumer in the UK, and to have done so by the date that the Proprietor applied for his marks i.e. by 1 March 2016 (the relevant date). As implied by the extract from *Lloyd Schuhfabrik* above, evidence going to enhanced distinctiveness may include elements such as turnover and sales, advertising expenditure, market share, duration and reach of use and so on. The earlier mark does not appear to have been used since it was registered, but there is some evidence of use of the mark in respect of skateboards in the late 1980s to 1992. However, the evidence filed gives no information at all on turnover, sales volume, advertising expenditure or market share and taken in the

round falls very far short of what would be needed to conclude that the mark benefits from enhanced distinctiveness through use.

Conclusion as to likelihood of confusion

48. In my global assessment of likelihood of confusion, I take account of my findings set out in the foregoing sections of this decision and of the case law principles outlined in paragraph 13 above. Central points from my analysis above may be summarised as follows:

- Most of the Applicant's goods lack the required similarity or complementarity and I have therefore ruled out success under section 5(2)(b) in respect of: "*T shirts*" "*sweatshirts*" "*polo shirts*" "*shorts*" "*sweat pants*" "*socks*" "*gloves*" "*jackets*" "*belts*" "*denim trousers*" "*cargo pants*" "*hooded jackets*" "*baseball hats*" "*beanie hats*" "*bush hats*" "*bobble hats*".
- The Applicant's skateboard goods are not similar to "*skate shoes*" in nature, intended purpose, uses, method of use and nor are they are in competition with each other. However, I allowed that those goods may be considered complementary and that there is a stronger aspect of shared users. I have also noted that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.
- The average consumer will be members of the public who in the purchasing process will pay a medium level of attention.
- The consumer will primarily encounter the marks visually and the marks are visually similar to a degree between low and medium.
- The marks are aurally identical. The conceptual similarity is to no more than a medium degree, with some conceptual difference.
- The Applicant's earlier trade mark is inherently distinctive to a reasonably high degree, but the evidence is insufficient to establish any enhancement of distinctive character on the basis of use.

49. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public;¹⁷ occasional confusion by a small minority is not sufficient to find a likelihood of confusion. The relative weight of the factors is not laid down by law, but is a

¹⁷ Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at §34
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matter of judgment for the tribunal on the particular facts of each case.¹⁸ The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person; it involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade and it is often very difficult to make such prediction with confidence.¹⁹ Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.

50. In my view, the average consumer will surely not overlook through imperfect recollection that the contested mark, based centrally on the image of a cartoonish teapot, is markedly different from the earlier plain word mark; however, since the earlier word mark is inherently distinctive to a high degree, and given the overlap with the textual element in the contested mark (where it is fully perceived) then I find there is a risk of confusion on the part of the average consumer – in other words, they may believe that the skateboards (and parts) under the earlier mark and skate shoes under the contested mark, being complementary goods, are from the same or related undertaking. **The claim based on section 5(2)(b) succeeds in respect of “skate shoes” (only).**

The section 5(3) ground

51. Section 5(3) of the Act states that a trade mark that is identical or similar to an earlier trade mark shall not be registered to the extent that the earlier trade mark has a reputation in the United Kingdom 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. Section 5(3A) states that those provisions apply “irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”
52. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel Corporation*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and

¹⁸ See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O-079-17, (*Rochester Trade Mark*).

¹⁹ Again see comments of Iain Purvis as the Appointed Person, *ibid*.

C-487/07, *L'Oreal v Bellure*, Case C-487/07 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*).

53. Success under this ground requires (i) identity or similarity between the contested mark and the earlier mark; (ii) evidence that the earlier registered mark has a reputation in the relevant territory (in this case, the UK); (iii) that use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark; and (iv) that such use must be without due cause. These conditions are cumulative and failure to satisfy any one of them is sufficient to defeat the claim.

54. I will first deal with the question of reputation, since it seems to me the central issue in this instance. To show that an earlier mark has acquired a reputation there must be clear and convincing evidence to establish all the facts necessary for a tribunal to conclude safely that the mark is known by a significant part of the public. Reputation cannot be merely assumed and must be evaluated by making an overall assessment of all factors relevant to the case.

55. In *Enterprise Holdings Inc. v Europcar Group UK Ltd*,²⁰ Arnold J stated that proving a reputation "is not a particularly onerous requirement." However, the evidence before

²⁰ [2015] EWHC 17 (Ch)

Arnold J in that case showed that the claimant was in fact the market leading car hire company in the UK with a 30% share of the UK market. It was in that context that the judge said that proving a reputation “is not a particularly onerous requirement.” He had no reason to turn his mind to situations where the claimant had only a small and/or unquantified share of the relevant market.

56. Professor Phillip Johnson, as the Appointed Person in the SACURE appeal decision,²¹ stated to the effect that it is not the case that a party relying on an earlier mark who has filed only weak, incomplete, or irrelevant evidence to establish the reputation should be given the benefit of the doubt at the expense of the other party. The reason it is not an onerous requirement is because collecting the evidence should be straightforward (even if time consuming) where a mark has the necessary reputation.
57. The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I “take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”
58. Nonetheless, I take note of the comments of the General Court in *Farmeco AE Dermokallyntika v OHIM*,²² where it stated that a finding that an earlier mark had a reputation “... is not called into question by the applicant’s argument that the turnover figures for sales and the amount spent on promoting the goods covered by the earlier marks ... have not been proved. It should be pointed out that the absence of figures is not, in itself, capable of calling into question the finding as to reputation. First, the list of factors to be taken into consideration in order to ascertain the reputation of an earlier mark only serve as examples, as all the relevant evidence in the case must be taken into consideration and, second, the other detailed and verifiable evidence produced by the opposing party is already sufficient in itself to prove the reputation of its mark ...”.
59. I have noted that Mr Fox states in his evidence that he put significant funding and effort into advertising and marketing the brand death box. Although **Exhibits JF3 to JF11** indicate at least some exposure of the brand in skateboard magazines in the UK in the late 1980s/early 1990s, there is no clear information about expenditure on promotion nor

²¹ Case BL O/360/20

²² Case T-131/09 at paragraph 59

on how many people may have encountered the brand through the reach of such media. Nor does the evidence contain information at all as to the level of sales of the registered goods or of market share during the five years of trading. It is not possible to gauge what reputation may have been achieved by the brand even by the time that sales ceased in 1992, nor to what extent the mark may have retained a reputation by the relevant date, over two decades later.

60. The evidence shows that an anniversary event was held in 2007, but **Exhibit JF14** shows only four online comments relating to that event and no information is provided on the numbers of people from the UK who attended or were aware of the celebration in the Netherlands. The evidence also shows a campaign via an online petition website for the renewed production of the “old boards and graphics”. The full context of that petition is not clear, but **Exhibit JF15** shows that the number of signatories by the relevant date was not large and not of an order to demonstrate the claimed reputation.
61. Taken as a whole, I find that the evidence provides no clear or convincing basis on which I may safely conclude that the mark is known by a significant part of the relevant public. **In the absence therefore of the required reputation the claim under section 5(3) of the Act must fail** and I need not decide the questions of link and consequent injury.

The section 5(4)(a) ground

62. Section 5(4)(a) of the Act provides that: “... a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.” Section 5(4) also states that “A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of ‘an earlier right in relation to the trade mark’.”
63. The Applicant claims an earlier right in relation to the Proprietor’s mark arising from use of an unregistered sign that appears to be precisely the same as that now registered as a trade mark by the Proprietor. The Applicant claims to have used the sign since “at least 1991” for *clothing, T-shirts, skateboards, stickers, and sporting goods*.

64. The criteria for a passing off claim have been well established through UK case law. As set out in the decision by the House of Lords in *Reckitt & Colman Ltd v Borden Inc*,²³ the following three points must be established in order to claim passing off successfully:

- (a) First, the plaintiff must establish a goodwill or reputation attached to the goods or services which it supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which its particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services.
- (b) Second, the plaintiff must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are the goods or services of the plaintiff.
- (c) Third, the plaintiff must demonstrate that it suffers or that it is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

The need for goodwill

65. Case law has described goodwill as: "the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."²⁴ In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are

²³ [1990] 1 All E.R. 873

²⁴ *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL)

considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

66. *In Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

67. While a small business can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small, goodwill must be more than trivial in extent.²⁵ In *Smart Planet Technologies, Inc. v Rajinda Sharm* [BL O/304/20], Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend &*

²⁵ See comments of Jacob J. (as he then was) at paragraph 62 of *Hart v Relentless Records* [2002] EWHC 1984 (Ch); and the Court of Appeal in *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

Sons (Hull) Ltd [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

68. It is clear from the above case law that the Applicant must show that he had actionable business goodwill by reference to the sign at the relevant date. (I will leave aside the question of who may have owned any goodwill generated by the death box skateboards business that which existed between 1987 and 1992, but I note that the Proprietor characterised the business as an “enterprise of equals” and did not accept that the Applicant was “the main person behind the brand”.)
69. In considering whether the Applicant has demonstrated goodwill connected to the sign, I note the following points:
- i. Although there is evidence that the sign (teapot logo) was used as part of the branding of the death box skateboards business, which existed between 1987 and 1992, and was applied to skateboards and featured on promotional materials, the evidence also shows a wide range of branding artwork and renditions of the word elements and the importance of the teapot logo as the sign founding goodwill is not fully clear.²⁶ That said I note that it is the image that was used to promote the 20-year anniversary in Rotterdam (**Exhibit JF13**).
 - ii. While I accept that the death box skateboard business sold skateboards while it existed, there is no information at all as to turnover or level of sales; this makes it impossible to assess the level of goodwill enjoyed by the skateboard business for those goods.
 - iii. The evidence contains a few images of the sign (teapot logo) on tee-shirts, but there is no evidence showing clothing goods offered for sale at any point.
 - iv. The Applicant claims to have used the sign since at least 1991, but also states that there was a cessation of sales under the death box brand in 1992. This indicates that any use of the sign must have been for a very limited time. That said, I also note that Mr McEachran states that the sign was “jointly applied to skateboards” by Mr

²⁶ For example see Exhibits JF2, JF4, JF7 and JF12, and paragraph 19 of the Mr McEachran’s witness statement.
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McEachran, Mr Houlton and Mr Fox in 1987, although how that tracked through to sales is unclear.

- v. Goodwill has no independent existence apart from the business to which it is attached; when a business stops trading, the goodwill attaching to it starts to dissipate. As Recorder Iain Purvis QC, sitting as a Deputy Judge of the Patents County Court observed in the *Brooks Brothers* case: “Goodwill is not merely the memory of a business. It is the ‘attractive force which brings in custom’.”²⁷
- vi. The sign featured on tee-shirts and stickers produced as merchandise for the anniversary event in 2007 and Mr Fox states these were “sold to the public”, but this is not evidence of UK custom.

70. In light of the above, I conclude that while there was likely goodwill for skateboards under the sign, since the business has not operated since 1992, there was, at the relevant date, after more than twenty years with no custom under the mark, no residual goodwill sufficient to sustain a claim for passing off. **In the absence of goodwill, the claim under section 5(4)(a) fails** and there is no need for me to consider misrepresentation or damage.

OUTCOME

- 71. The application for a declaration of invalidity **succeeds only in respect of “skate shoes”**; those goods (only) shall be removed from the goods specified in the Proprietor’s registration. In line with section 47(6) of the Act, the mark shall be deemed never to have been registered in respect of skate shoes.
- 72. The application fails in relation to *T shirts* “sweatshirts” *polo shirts* “shorts” “sweat pants” “socks” “gloves” “jackets” “belts” “denim trousers” “cargo pants” “hooded jackets” “baseball hats” “beanie hats” “bush hats” bobble hats - **those goods remain registered.**

COSTS

- 73. The Proprietor has successfully defended almost all of his registration. He is entitled to a contribution towards his costs in defending these proceedings, in line with the scale published in the annex to Tribunal practice notice (2/2016) and where the sums take account of the fact that the application for invalidity succeeded in relation to “skate shoes”.

²⁷ *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18, paragraph 74.

Reviewing the statement of grounds and preparing a counterstatement:	£300
Considering and responding to the other side's evidence:	£600
Total	£900

74. I order Jeremy Fox to pay Graham McEachran the sum of £900 (nine hundred pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 13th day of October 2020

Matthew Williams

For the Registrar
