

**O/090/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3475903  
BY SVA GLOBAL VENTURES LTD  
TO REGISTER AS A TRADE MARK:**

**YOGI BY RDX**

**IN CLASSES 6, 9, 10, 14, 18, 25, 27, 28 & 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001440  
BY FOCUS INTERNATIONAL LIMITED**

## **BACKGROUND AND PLEADINGS**

1. On 18 March 2020, SVA Global Ventures Ltd (“the applicant”) applied to register the trade mark **YOGI BY RDX**, under number 3475903 (“the application”). It was accepted and published in the Trade Marks Journal on 5 June 2020 in respect of a range of goods and services in classes 6, 9, 10, 14, 18, 25, 27, 28 and 35.

2. On 4 August 2020, the application was partially opposed by Focus International Limited (“the opponent”) by way of the fast track opposition procedure. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against the following goods and services of the application:

Class 18: All purpose sports bags; All-purpose athletic bags; Bags; Bags for clothes; Bags for sports; Bags made of leather; Bags made of imitation leather; Belt bags; Belts (Leather shoulder -); Cloth bags; Game bags; Garment bags; Imitation leather bags; Kit bags; Yoga Bags; Leather bags; Leather shoulder belts; Shoe bags; Shoulder belts; Sport bags; Sports bags; Sports [Bags for -]; Sports packs; Waist bags; Waist packs.

Class 25: Athletic clothing; Athletic footwear; Athletic shoes; Athletic tights; Athletics footwear; Athletics shoes; Athletics vests; Boots for sport; Boxing shoes; Boxing shorts; Clothes for sport; Clothes for sports; Clothing for gymnastics; Clothing for sports; Clothing for wear in judo practices; Clothing for wear in wrestling games; Footwear for sport; Footwear for sports; Footwear for track and field athletics; Footwear for use in sport; Gloves; Gloves [clothing]; Gloves for apparel; Gym boots; Gym shorts; Gym suits; Gymnastic shoes; Yoga Apparel; Gymshoes; Gymwear; Head bands; Head sweatbands; Head wear; Headgear; Headgear for wear; Jogging bottoms [clothing]; Jogging outfits; Jogging pants; Jogging sets [clothing]; Jogging shoes; Jogging suits; Jogging tops; Judo suits; Judo uniforms; Jumpsuits; Karate suits; Karate uniforms; Martial arts uniforms; Sport shirts; Sport shoes; Sports bras; Sports clothing; Sports clothing [other than golf gloves]; Sports footwear; Sports garments; Sports headgear [other than helmets]; Sports jerseys; Sports over uniforms; Sports overuniforms; Sports pants; Sports shirts; Sports shirts with short

sleeves; Sports shoes; Sports wear; Sportswear; Sweat bands; Sweat bands for the head; Sweat bands for the wrist; Taekwondo suits; Taekwondo uniforms; Track suits; Training shoes; Walking shoes; Walking shorts.

Class 35: Retail services connected with the sale of clothing and clothing accessories.

3. The opponent relies upon its International Registration Designating the European Union number 1301634 (“the earlier mark”), which consists of the following trade mark:



4. The earlier mark was registered on 21 March 2016 and protection was granted in the EU on 9 December 2016 for ‘*footwear, clothing, headgear*’ in class 25. For the purposes of the opposition, the opponent relies upon all the foregoing goods.

5. The opponent’s mark is an earlier mark, in accordance with Section 6 of the Act.<sup>1</sup> However, as it has not been protected for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within Section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier mark has protection.

6. The opponent argues that the contested goods and services of the application are identical or similar to the goods of the earlier mark. Moreover, the opponent contends that the distinctive and dominant elements of the competing marks are identical, that being the word ‘YOGI’. Based upon these factors, the opponent submits that there is a likelihood of confusion between the competing marks, including a likelihood of association.

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

7. The applicant filed a counterstatement denying the ground of opposition. As these are the only comments I have from the applicant, they are reproduced in full, and as written, below:

This counter-statement denies the entire claim made by the opponent in the Form TM7F submitted on 17/07/2020. Firstly, the opponent has failed to oppose against relevant classes covered by the opponents mark. The opponents mark covers Class 25 only whereas in his claim he has relied on class 18 and class 35 as well. Opponents claim should be rejected on this factor alone on the basic technicalities of his claim as he has opposed and relied on something that he or his mark has no right over (absence of protection under class 18 & 35 in his mark). Secondly, if the examiner does not strike out the opponents claim on the ground mentioned above alone, the mark 'Yogi' and 'Yogi by RDX' do not resemble in any way regarding visual, conceptual and aural elements. The opponents mark has a unique dotted texture included in the mark which becomes the dominant and distinctive element of his mark. The latter mark has no such unique or symbolic distinctive element to it thus no visual similarity. The latter mark when read fully and properly does not either sound exactly the same as opponents mark as the latter mark clearly states the ownership in its mark which is meant to be read out with the mark which is 'Yogi by RDX'. This is absent in the opponents mark hence no similarity. This factor takes away the aural and conceptual similarity of the marks as well and most importantly likelihood of confusion between the marks as it is impossible to confuse two marks when one mark is clearly stating its ownership in the mark and RDX is a well reputed global brand. An average eye of a consumer will realize the difference between the marks and there is near to zero chance that they will confuse or associate the marks together. The latter mark strictly relates to Yoga and sports wear which is clarified in the classes mentioned in the application for registration. However, the opponents mark vaguely mentions 'clothing, headgear, footwear' which could relate to any nature whatsoever. Therefore, after concluding the argument above, it is proved that the marks differ in every aspect and there lies no likelihood of confusion between the marks. Hence, opponents claim is baseless and may be rejected.

8. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disappplies paragraphs 1 to 3 of rule 20 of the Trade Mark Rules 2008 but provides that rule 20(4) shall continue to apply. Rule 20(4) stipulates that "the Registrar may, at any time, give leave to either party to file evidence upon such terms as the Registrar thinks fit". The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

9. The opponent is professionally represented by Urquhart-Dykes & Lord LLP, whereas the applicant represents itself. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions in lieu of an oral

hearing.<sup>2</sup> This decision is taken following a careful perusal of the papers, keeping all submissions in mind.

10. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive and, therefore, this decision continues to make reference to the trade mark case law of EU courts.

## **DECISION**

### **Section 5(2)(b): legislation and case law**

11. Sections 5(2)(b) and 5A of the Act read 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.”

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<sup>2</sup> The parties were informed by the Tribunal on 27 October 2020 that the deadline for providing written submissions was 24 November 2020. The opponent, through its representatives, filed its written submissions by email at 05:59 on 25 November 2020. Given the short delay and the explanation that was provided, a preliminary view to admit the submissions into proceedings was issued by the Tribunal on 30 November 2020. A period of 14 days was then given for either party to request a hearing in relation to the preliminary view. No such request was forthcoming. Moreover, on 22 December 2020, the applicant contacted the Tribunal to request further time in which to file its written submissions. The applicant's reasons for the request were not considered sufficient and, combined with the delay in making the request, a preliminary view to refuse the request was issued by the Tribunal on 23 December 2020. A period of 14 days was given for either party to request a hearing in relation to the preliminary view. However, neither party requested a hearing and, accordingly, the preliminary view was automatically confirmed.

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

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

13. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, 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”.

14. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, 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. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15. 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 Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“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”.



16. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 für 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”.

17. In *Separode Trade Mark*, BL O/399/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person confirmed at paragraph 5 that:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

18. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

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

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main

reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are '*similar*' to goods are not clear cut."

20. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*,<sup>3</sup> and *Assembled Investments (Proprietary) Ltd v. OHIM*,<sup>4</sup> upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*,<sup>5</sup> Mr Hobbs concluded that:

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

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

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

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<sup>3</sup> Case C-411/13P

<sup>4</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>5</sup> Case C-398/07P

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

21. The goods and services to be compared are outlined at paragraphs 2 and 4 above.

22. The opponent has argued that the goods in class 25 of the application are identical to the goods for which the earlier mark is protected. Moreover, the opponent has contended that there is a low degree of similarity between its goods and those in class 18 of the application. Finally, the opponent has submitted that there is a medium degree of similarity between the retail services in class 35 of the application and its goods.

23. Conversely, the applicant has intimated that there is no similarity between the goods and services in classes 18 and 35 of the application and the opponent's goods. This appears to be formulated on the basis that the earlier mark only has protection for goods in class 25. The applicant has also submitted that the contested mark "strictly relates to" yoga and sportswear, while the goods of the earlier mark are vague and could relate to "any nature whatsoever".

24. In respect of the applicant's argument that there can be no similarity between its goods and services in classes 18 and 35 and the opponent's goods in class 25, it is important to have regard to section 60A of the Act, which provides:

"(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

25. As a consequence of the above, whether goods or services are in the same or different classes is not decisive in determining whether they are similar or dissimilar.

26. Furthermore, for reasons which I will now explain, the applicant’s points about any differences in the actual goods offered by the parties will, as a matter of law, have no bearing on the outcome of this opposition. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion. Once a trade mark has been registered for five years, Section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods/services for which it is registered.

27. The mark relied upon by the opponent had not been protected for five years at the date on which the application was filed. Consequently, the opponent is not required to prove use for any of the goods for which the earlier mark is protected. The earlier trade mark is entitled to protection against a likelihood of confusion with the applicant’s mark based on the ‘notional’ use of that earlier mark for all the goods listed in the register. As the applicant has pointed out, the opponent’s goods are not limited by any particular commercial focus. Notionally, therefore, they could include goods of the kind described by the applicant. The concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a

finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place”.

28. So far as the applicant's claimed use of its applied-for mark is concerned, 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 in the context of registering a new trade mark it is necessary to consider all the circumstances in which the applied-for mark might be used if it were registered. As a result, even though the applicant has suggested the ways in which the mark will be used, and the goods and services for which it will be used, my assessment must take into account only the applied-for mark – and its specification – and any potential conflict with the opponent's earlier mark. Any differences between the actual goods and services provided by the parties are not relevant unless those differences are apparent from the applied-for and registered marks.

### Class 18

29. The terms '*bags; bags made of leather; bags made of imitation leather; belt bags; cloth bags; imitation leather bags; leather bags; waist bags; waist packs*' refer to general purpose bags. There is clear case law which indicates that '*clothing*' in class 25 and clothing accessories which complement them, such as handbags, purses and wallets, are similar insofar as the intention is to create a coordinated look.<sup>6</sup> Whilst, stylistically, all-purpose bags such as those in the application may differ from handbags and the like, they are, in many cases, used for the same purpose, namely, to carry everyday personal items. They may also be made from the same materials, such as leather or imitations thereof. Therefore, consumers might consider these

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<sup>6</sup> *Gitana v OHIM*, Case T-569/11 and *El Corte Ingles v OHIM*, Case T-443/05

goods to be aesthetically complementary accessories to articles of clothing, in a similar sense as handbags. On that basis, I find that these goods in the application are similar to a low degree to the opponent's '*clothing*'.

30. Given that the opponent's '*clothing*' would include sports and athletic clothing, this finding would, in my view, extend to the applicant's '*all purpose sports bags; all-purpose athletic bags; bags for sports; game bags; kit bags; yoga bags; shoe bags; sport bags; sports bags; sports [bags for -]; sports packs*'. In these contexts, the coordination would factor upon the activity for which the look is put together. Moreover, the respective goods are often sold in the same outlets, which is likely to support the impression in the mind of the consumer that the responsibility for the production of the goods lies with the same undertaking.

31. It is also considered that there is a low degree of similarity between the opponent's '*footwear*' and the applicant's '*shoe bags*'. While I accept that the nature, intended purpose and method of use of the respective goods is different, it is not uncommon for shoe bags to be sold in the same outlets as footwear. Further, the respective goods will often be found alongside one another, or at least in the same section of those outlets. Therefore, the respective goods will reach the market through shared channels of trade. There is no competition between the respective goods. However, footwear is important, if not indispensable, for the use of shoe bags; there is a close connection between these goods in such a way that consumers would assume that the responsibility for them lies with the same undertaking. Accordingly, these goods are complementary.

32. To my mind, very similar considerations exist in relation to '*bags for clothes; garment bags*'. Given that these bags are generally used to ease the transportation of clothing, there is a low degree of similarity between them and the opponent's '*clothing*'. It is true that the nature, intended purpose and method of use of the respective goods is different. However, they are commonly sold in the same outlets, wherein the respective goods will be located alongside one another, or at least in the same section of those outlets. As such, the respective goods have common trade channels. In my view, there is no competition between the respective goods. Nevertheless, they are complementary as clothing is important, if not indispensable, for the use of these bags;

the close connection between the respective goods is such that consumers would assume that the responsibility for them lies with the same undertaking.

33. It has been established that the Registrar is entitled to treat the class number (of the Nice classification system) as relevant to the interpretation of the scope of an application.<sup>7</sup> Further, that a class may be used as an aid to interpret terms where the wording is vague or could refer to goods or services in numerous classes.<sup>8</sup> To my mind, as *'belts (leather shoulder -); leather shoulder belts; shoulder belts'* appear in class 18 of the application, they cannot be interpreted as referring to belts as items of clothing or clothing accessories (which would be proper to class 25). With this in mind, I interpret these terms as referring to straps or harnesses – made of leather or other materials – for carrying luggage or bags on the shoulder. Accordingly, there is no overlap in the nature, intended purpose and method of use of these goods and the opponent's goods. Moreover, whilst the opponent's goods are typically sold through clothing and footwear retailers, the applicant's goods will be sold by more specialist luggage retailers. In this connection, the trade channels through which the respective goods reach the market are not the same. Given that the respective goods have very different intended purposes, I can see no basis for finding a competitive relationship between them. Furthermore, the respective goods are neither important nor indispensable to the use of one another and, therefore, they are not complementary. In light of the above, I conclude that there is no similarity between the applicant's *'belts (leather shoulder -); leather shoulder belts; shoulder belts'* and the goods of the earlier mark.

#### Class 25

34. The terms *'athletic clothing; athletic tights; athletics vests; boxing shorts; clothes for sport; clothes for sports; clothing for gymnastics; clothing for sports; clothing for wear in judo practices; clothing for wear in wrestling games; gloves; gloves [clothing]; gloves for apparel; gym shorts; gym suits; yoga apparel; gymwear; jogging bottoms [clothing]; jogging outfits; jogging pants; jogging sets [clothing]; jogging suits; jogging*

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<sup>7</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA)

<sup>8</sup> *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch)

*tops; judo suits; judo uniforms; jumpsuits; karate suits; karate uniforms; martial arts uniforms; sport shirts; sports bras; sports clothing; sports clothing [other than golf gloves]; sports garments; sports jerseys; sports over uniforms; sports overuniforms; sports pants; sports shirts; sports shirts with short sleeves; sports wear; sportswear; taekwondo suits; taekwondo uniforms; track suits; walking shorts'* all refer to items of clothing and, as such, they are encompassed by the broader category of '*clothing*' in the opponent's specification. Accordingly, these goods are identical under the principle outlined in *Meric*.

35. Given that the terms '*athletic footwear; athletic shoes; athletics footwear; athletics shoes; boots for sport; boxing shoes; footwear for sport; footwear for sports; footwear for track and field athletics; footwear for use in sport; gym boots; gymnastic shoes; gymshoes; jogging shoes; sport shoes; sports footwear; sports shoes; training shoes; walking shoes*' in the applicant's specification describe various items of footwear, they would fall within the scope of the broader category of '*footwear*' in the opponent's specification. Consequently, the respective goods are identical under the principle outlined in *Meric*.

36. The term '*headgear*' in class 25 of the application has a direct counterpart in class 25 of the earlier mark. These goods are self-evidently identical.

37. Although the terms '*head wear; headgear for wear*' in the application are worded slightly differently to '*headgear*' in the opponent's specification, they essentially describe the same goods, namely, items that are worn on the head. As such, these goods are considered identical.

38. The term '*sports headgear [other than helmets]*' in the applicant's specification describes a subcategory of items which are worn on the head when engaged in sport. In my view, the broader category of '*headgear*' in class 25 of the earlier mark would incorporate this subcategory. Therefore, under the principle outlined in *Meric*, the respective goods are identical.

39. '*Head bands; head sweatbands; sweat bands; sweat bands for the head*' in the application refer to bands of fabric worn around the head as decoration or to keep the



hair or perspiration off the face. These goods fall within the broader category of *'headgear'* in the opponent's specification, rendering the goods identical under the principle outlined in *Meric*.

40. The term *'sweat bands for the wrist'* describes a band of material worn around the wrist. They are typically used in a sporting context to absorb perspiration. However, these goods are also worn as clothing accessories. Given that the goods are wearable items, there will be an overlap in nature with *'clothing'* in the opponent's specification. The intended purpose of the respective goods will not always be the same, though there is a degree of overlap; while sweat bands are commonly worn around the wrist to absorb perspiration, they are also used as accessories for protection against the elements or for self-expression, as is clothing. The method of use of the respective goods will also overlap insofar as they are worn on the body. Moreover, users of the respective goods will be the same, those being members of the general public. In addition, the trade channels through which the respective goods reach the market will overlap as it is not uncommon for sweat bands to be sold in clothing retail environments. Even in circumstances where the respective goods are not found on the same shelves, sweat bands will often be located in close proximity to items of clothing. Although sweat bands may be used with other items of clothing, the respective goods are neither important nor indispensable to the use of one another and, as such, are not complementary in the sense outlined in caselaw. Further, there is no competition between the respective goods as I can see no reason why a consumer seeking an item of clothing would instead purchase a sweat band, or vice versa. In light of the above, it is considered that the respective goods are similar to between a medium and high degree.

#### Class 35

41. The applicant's *'retail services connected with the sale of clothing'* and the opponent's *'clothing'* would differ in nature, purpose and method of use. Nevertheless, clothing is integral to the retailing of clothing and the connection between these goods and services is such that the average consumer would assume that the responsibility for them lies with the same undertaking. Accordingly, it is considered that clothing and the retailing of clothing are complementary. Moreover, the respective goods and

services are distributed through the same channels of trade; clothing and the retailing of clothing are commonly offered together by the same undertaking. In light of the foregoing, I am of the view that the respective goods and services are similar to a medium degree.

42. Similarly, the applicant's '*retail services connected with the sale of clothing accessories*' and the opponent's '*clothing*' would also differ in nature, purpose and method of use. To my mind, the finding above regarding complementarity does not extend to these services as clothing is neither important nor indispensable to the retailing of clothing accessories. However, clothing accessories are often sold in the same retail environment as clothing and these goods and services are commonly provided by the same undertaking. Therefore, the trade channels through which the respective goods and services reach the market overlap significantly. As such, it is considered that there is between a low and medium degree of similarity between these goods and services.

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

43. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

44. 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.”

45. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

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

46. The opponent has submitted that the goods and services will be purchased by the general public whom are likely to pay a medium degree of attention when selecting them. Furthermore, the opponent has contended that visual considerations are likely to be key to the selection process but that aural considerations cannot be discounted. I have no submissions from the applicant regarding the average consumer of the goods and services.

47. The goods at issue in these proceedings consist of items of clothing, headgear, footwear and bags. I agree with the opponent that the average consumer of such goods will be members of the general public. The goods are likely to be purchased relatively frequently for the purposes of functionally clothing one’s self or as a form of self-expression. The cost of the goods may vary, with cheaper items of limited quality at one end of the spectrum and more expensive fashion pieces at the other. However, the purchasing act will not require an overly considered thought process as, overall, they are relatively inexpensive purchases; the purchasing of the goods is likely to be more casual than careful. The average consumer will, nevertheless, consider factors such as the style, quality, size and suitability of the product in accordance with their individual needs and preferences. Taking the above factors into account, I find that the level of attention of the general public in respect of these goods would be medium. The goods are typically sold in bricks-and-mortar retail establishments or their online

equivalents, where the goods are likely to be self-selected from rails and shelves or after viewing information on the internet. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations in the form of word of mouth recommendations or receiving advice from a sales assistant.

48. The average consumer of the applicant's retail services will also be members of the general public. Purchases are likely to be fairly frequent and will vary in cost, depending on the nature of the goods being purchased through the services. Again, the purchasing act will not require an overly considered thought process and is likely to be more casual than careful. However, when purchasing the services, the average consumer is likely to consider factors such as the quality of service and the range of goods offered. As such, the average consumer is likely to demonstrate a medium level of attention. The services will be purchased from retail outlets and their online equivalents. The purchasing process for the services is likely to be dominated by visual considerations, as the average consumer will select the services following an inspection of the premises' frontage on the high street, after viewing information on websites, or viewing advertisements (such as flyers, posters, media campaigns or online adverts). Nevertheless, given that word of mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

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

49. 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).”

50. The opponent has submitted that, given that the earlier mark is not descriptive of the goods for which it is protected, it has a “normal level” of distinctiveness. Moreover, the opponent has argued that the stylisation present in the mark “may add to its distinctiveness”. The applicant has not commented on the distinctive character of the earlier mark.

51. The distinctiveness of a mark may be enhanced as a result of it having been used in the market. However, the opponent has not pleaded that its mark has acquired enhanced distinctive character and has filed no evidence of use. Consequently, I have only the inherent position to consider.

52. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle.

53. The earlier mark is figurative and comprises two elements, namely, the word ‘YOGI’ and six devices. The word ‘YOGI’ is defined as a person who is proficient in yoga.<sup>9</sup> While it is possible that some would be aware this meaning, I am unconvinced

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<sup>9</sup> <https://www.lexico.com/definition/yogi>

that this would be true for the vast majority of consumers in the UK; in my view, those who may understand the meaning of the word would not comprise a significant proportion of consumers. Rather, in the absence of any evidence or submissions from the parties to the contrary, I consider it more likely that the average consumer would perceive it as an invented word. The word is presented in a bold and somewhat unusual font. However, the word 'YOGI' will still be identified by consumers. The devices vary in size and shape but are all roughly circular. Five of the shapes precede the word element while one acts as a full stop punctuation mark. The opponent has suggested that the devices will be seen as "toes on a right foot". While this is, of course, possible, I do not believe that the mark would immediately present itself to consumers in this way; in my view, this would require a level of analysis which would not be undertaken by the average consumer on initial sight of the mark. Rather, it is considered that consumers would simply perceive the devices as roughly circular shapes. Whilst neither the stylisation nor the devices would be overlooked by consumers, they are likely to be perceived as decorative. Thus, they do not increase the distinctiveness of the mark by any material extent, which lies predominantly in the word 'YOGI'. Overall, I find that the earlier mark possesses a high level of inherent distinctive character.

### **Comparison of trade marks**

54. 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.”

55. Therefore, it would be wrong to artificially dissect the trade marks, though it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

56. The competing trade marks are as follows:

Earlier trade mark	Applicant's mark
	YOGI BY RDX

#### Overall impression

57. The opponent has argued that the word ‘YOGI’ is the dominant element of the competing trade marks. Conversely, the applicant has contended that the five devices preceding the word dominate the overall impression of the earlier mark.

58. The earlier mark is figurative and consists of the stylised word ‘YOGI’ and six roughly circular devices. I have already found that the word ‘YOGI’ would be perceived as an invented word. It is also, by far, the largest element in the configuration of the mark. Moreover, it is generally accepted that the eye is naturally drawn to elements that can be read.<sup>10</sup> Accordingly, the word ‘YOGI’ will dominate the overall impression of the mark. As previously outlined, the stylisation and devices would be seen as decorative and, although they will still contribute to the overall impression, they will have much less impact and play lesser roles.

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<sup>10</sup> *Wassen International Ltd v OHIM*, Case T-312/03

59. The contested mark is in word-only format and comprises the words 'YOGI BY RDX'. In accordance with my finding in respect of the earlier mark, the word 'YOGI' would be perceived as an invented word. The word 'BY' would be understood by consumers as an identifier of the responsible entity. The word 'RDX' is comprised of letters from the English language which do not form a word with any obvious meaning. Due to the formulation of the words in the mark, I am of the view that the word 'RDX' would be seen as the house brand, i.e. an indication of the ultimate economic origin. However, the word 'YOGI' appears at the beginning of the mark, a position which is generally considered to have more impact due to consumers in the UK reading trade marks from left to right.<sup>11</sup> For this reason, while the words 'YOGI' and 'RDX' both dominate the overall impression of the mark, the former has a degree more impact. Given that it is a common preposition, the word 'BY', although still contributing, will play a reduced role.

#### Visual comparison

60. The opponent has argued that the competing marks are similar to a medium degree, submitting that the word 'YOGI' is reproduced in both. The opponent has accepted that the competing marks differ in their additional elements. The applicant, on the other hand, has disputed any visual resemblance between the competing marks, highlighting that the earlier mark has "a unique dotted texture", which is absent from the contested mark.

61. Visually, the competing marks are similar as they share the identical word 'YOGI'. This word appears at the beginning of the contested mark and is the dominant element of the earlier mark. I agree with the parties that the marks differ in their additional elements, namely, the stylisation and device elements present in the earlier mark and the words 'BY RDX' in the contested mark. However, I disagree with the applicant that this renders the marks visually dissimilar. Bearing in mind my assessment of the overall impressions, I consider there to be between a low and medium degree of visual similarity between the marks.

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<sup>11</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02



### Aural comparison

62. The opponent has contended that, although the additional word elements in the contested mark create a point of aural difference between the marks, the marks are aurally similar to a high degree as a result of the shared word 'YOGI'. Conversely, the applicant has denied that there is any aural similarity between the marks due to these additional word elements.

63. Aurally, the earlier mark consists of two syllables, i.e. "YOW-GEE". In my view, consumers would not pronounce the device elements in any way. The contested mark comprises six syllables, i.e. "YOW-GEE-BIY-AHR-DEE-EX". The first two syllables of the contested mark are aurally identical to the earlier mark. I accept that the contested mark contains four additional syllables which are lacking from the earlier mark, which, as the applicant has identified, will be articulated by consumers. Nevertheless, taking into account the overall impressions, I find that there is a medium degree of aural similarity between the competing marks.

### Conceptual comparison

64. The opponent has argued that the competing marks overlap conceptually to the extent that they both incorporate the word 'YOGI', which it submits will be given its ordinary dictionary meaning. Owing to the same, the opponent has contended that the competing marks are conceptually similar to a medium degree. For its part, the applicant has argued that there is no conceptual resemblance between the competing marks due to the additional words 'BY RDX'. These words, according to the applicant, will be understood by consumers as referring to the "well reputed global brand" RDX.

65. As I have already found that the average consumer is unlikely to readily understand the meaning of the word 'YOGI', I disagree with the opponent that this concept is common to both trade marks. To my mind, the word would, instead, be perceived as an invented word and, as such, conveys no concept. Furthermore, as outlined above, the device elements in the earlier mark would be seen as decorative and, therefore, would not provide any meaningful conceptual message. In light of the foregoing, it is

considered that the earlier mark is conceptually neutral. In respect of the contested mark, the word 'YOGI' would also be perceived as a conceptually neutral invented word. The word 'BY' would be understood as the common preposition identifying the responsible entity. The combination of the letters 'RDX' do not have any clear and obvious meaning which would be understood by the average consumer. I disagree with the applicant that this element would be understood by consumers as referring to the 'RDX' brand. It is important to point out that reputation and conceptual meaning are not the same thing; reputation, in a trade mark sense, concerns the factual extent to which a sign is recognised by a significant part of the public as a trade mark, whereas conceptual meaning is a level of immediately perceptible notoriety or independent meaning, outside of a purely trade mark context.<sup>12</sup> Although there are cases where an extensive reputation has transferred into conceptual meaning, these are the exception rather than the rule and depend on their own facts.<sup>13</sup> Exceptional cases where trade mark reputation evolves into a conceptual meaning need to be properly proven. The applicant has not adduced any evidence to support its assertion and I am disinclined to take judicial notice of it. Instead, it is considered that the word 'RDX' would be perceived as a conceptually neutral combination of letters from the English language. Overall, the only concept that the contested mark conveys is one of responsibility (provided by the word 'BY'). As this is lacking from the earlier mark, it introduces a degree of conceptual dissimilarity between the marks, albeit limited.

### **Likelihood of confusion**

66. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor 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 necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing

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<sup>12</sup> *Retail Royalty Company v Harringtons Clothing Limited*, O/593/20, paragraphs 74-75

<sup>13</sup> *Retail Royalty Company v Harringtons Clothing Limited*, O/593/20, paragraph 76

See, for example, Joined Cases C-449/18 P and C-474/18 P, EU:C:2020:722, *EUIPO v Messi Cuccittini and J.M.-E.V. e hijos v Messi Cuccittini*

process. In doing so, I must be alive to 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 that they have retained in their mind.

67. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

68. 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.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

69. I have borne in mind that these examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.

70. Earlier in this decision, I concluded that:

- There is no similarity between *‘belts (leather shoulder -); leather shoulder belts; shoulder belts’* in class 18 of the application and any of the opponent’s goods;
- There is a low degree of similarity between the remaining goods in class 18 of the application and the opponent’s goods;
- Where not identical, the goods in class 25 of the application are similar to the goods of the earlier mark to between a medium and high degree;
- The applicant’s class 35 services are similar to the opponent’s goods to either a medium degree or between a low and medium degree;
- Average consumers of the goods and services at issue are members of the general public, who would demonstrate a medium level of attention during the purchasing act;

- The purchasing process for the goods and services would be predominantly visual in nature, though I have accepted that it will include an aural element in certain circumstances;
- The earlier mark possesses a high level of inherent distinctive character;
- The overall impression of the earlier mark would be dominated by the word 'YOGI', while the figurative elements would play lesser roles;
- The overall impression of the contested mark would be dominated by the words 'YOGI and 'RDX', the former having a degree more impact, while the word 'BY' would play a reduced role;
- The competing marks are visually similar to between a low and medium degree, while there is a medium degree of aural similarity between them;
- There is a limited degree of conceptual dissimilarity between the competing marks.

71. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, 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.”

72. As I have found some goods of the application to be dissimilar to the goods of the earlier mark, the opposition under section 5(2)(b) of the Act must necessarily fail in

relation to those goods, namely, *'belts (leather shoulder -); leather shoulder belts; shoulder belts'* in class 18.

73. In respect of the remaining goods and services, although the competing marks share the identical word 'YOGI', there are differences between the marks which, to my mind, would not be overlooked by the average consumer during the purchasing process. I accept that the identical element is highly distinctive. I also acknowledge that the word dominates the earlier mark and jointly dominates the contested mark. However, the earlier mark also includes circular device elements and the word 'YOGI' is presented in a stylised font; although I have found these figurative elements to play lesser roles in the overall impression of the mark, they still contribute to it and would not be entirely overlooked by consumers. More significantly, perhaps, the contested mark contains additional word elements which have no counterparts in the earlier mark, namely, 'BY' and 'RDX'. I have already found that the latter jointly dominates the contested mark and it is highly unlikely that consumers would overlook it, despite the fact that it appears at the end of the mark. Taking the above factors into account, the differences between the competing trade marks are, in my judgement, likely to be sufficient to avoid the average consumer mistaking one trade mark for the other, even on goods and services which I have found to be identical. Therefore, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion.

74. Nevertheless, whilst I consider that the average consumer will recognise that there are differences between the marks, the consumer will also recognise the identical shared word 'YOGI'. Whether consciously or unconsciously, this will lead the average consumer through the mental process described by Mr Purvis, namely, that there is a difference between the marks, but there is also something in common. I have found that this common element will be perceived as an invented word and is, therefore, highly distinctive. The word dominates the earlier mark and jointly dominates the contested mark, appearing in a prominent position in the beginning of the mark. This common element is, in my view, so strikingly distinctive that the average consumer would assume that no other undertakings would be using it in a trade mark. In addition, or in the alternative, the formulation of the contested mark readily lends itself to a brand variation, not least because the word 'YOGI' retains an independent distinctive role in

the context of the contested mark. Due to the word 'BY' in the contested mark denoting the responsible entity, the following word 'RDX' would be perceived as the house brand, i.e. an indication of the ultimate economic origin. Therefore, the additional elements present in the contested mark would be seen as conveying the undertaking that is responsible for the 'YOGI' sub-brand. The earlier mark, on the other hand, would be perceived as a variation of the 'YOGI' brand presented with additional decorative elements. In light of the above, I am satisfied that the average consumer would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared word 'YOGI'. Consequently, I consider there to be a likelihood of indirect confusion.

## **CONCLUSION**

75. The opposition under section 5(2)(b) of the Act has been largely successful. Subject to any successful appeal against my decision, the application will be refused in respect of the following goods and services:

Class 18: All purpose sports bags; All-purpose athletic bags; Bags; Bags for clothes; Bags for sports; Bags made of leather; Bags made of imitation leather; Belt bags; Cloth bags; Game bags; Garment bags; Imitation leather bags; Kit bags; Yoga Bags; Leather bags; Shoe bags; Sport bags; Sports bags; Sports [Bags for -]; Sports packs; Waist bags; Waist packs.

Class 25: Athletic clothing; Athletic footwear; Athletic shoes; Athletic tights; Athletics footwear; Athletics shoes; Athletics vests; Boots for sport; Boxing shoes; Boxing shorts; Clothes for sport; Clothes for sports; Clothing for gymnastics; Clothing for sports; Clothing for wear in judo practices; Clothing for wear in wrestling games; Footwear for sport; Footwear for sports; Footwear for track and field athletics; Footwear for use in sport; Gloves; Gloves [clothing]; Gloves for apparel; Gym boots; Gym shorts; Gym suits; Gymnastic shoes; Yoga Apparel; Gymshoes; Gymwear; Head bands; Head sweatbands; Head wear; Headgear; Headgear for wear; Jogging bottoms [clothing]; Jogging outfits; Jogging pants; Jogging sets [clothing]; Jogging shoes; Jogging suits; Jogging tops; Judo suits; Judo uniforms; Jumpsuits; Karate suits; Karate uniforms;

Martial arts uniforms; Sport shirts; Sport shoes; Sports bras; Sports clothing; Sports clothing [other than golf gloves]; Sports footwear; Sports garments; Sports headgear [other than helmets]; Sports jerseys; Sports over uniforms; Sports overuniforms; Sports pants; Sports shirts; Sports shirts with short sleeves; Sports shoes; Sports wear; Sportswear; Sweat bands; Sweat bands for the head; Sweat bands for the wrist; Taekwondo suits; Taekwondo uniforms; Track suits; Training shoes; Walking shoes; Walking shorts.

Class 35: Retail services connected with the sale of clothing and clothing accessories.

76. The application will proceed to registration in the UK in relation to the following goods and services which were not opposed, or against which the opposition has failed:

Class 6: Metal swivels for boxing apparatus; metal swivels for speed bags or punch bags; metal key rings; parts and fittings for all the aforesaid goods.

Class 9: Clothing that protects against serious or life-threatening injuries, for example, clothing for protection against accidents, irradiation and fire, bullet-proof clothing, protective helmets, head guards for sports, mouth guards for sports, protective suits for aviators, knee-pads for workers.

Class 10: Elasticated supports for the body; elasticated supports for the ankle; Acupressure pillow; elasticated supports for the elbow; elasticated supports for the knee; Acupressure mat; Meditation cushion; elasticated supports for the wrist; elasticated bandages for supportive use.

Class 14: Key chain tags; key chains; key fobs; key fobs of imitation leather.

Class 18: Belts (Leather shoulder -); Imitation leather; Imitations of leather; Leather; Leather and imitation leather; Leather and imitations of leather; Leather shoulder belts; Leather shoulder straps; Leather straps; Polyurethane



leather; Shoulder belts; Shoulder belts [straps] of leather; Shoulder straps; Straps (Leather -); Synthetic leather; Tanned leather.

Class 27: Yoga mats; Mats.

Class 28: Abdomen protectors for athletic use; Abdomen protectors for Taekwondo; Ankle and wrist weights for exercise; Apparatus for achieving physical fitness [for non-medical use]; Apparatus for games; Appliances for gymnastics; Arm guards for sports use; Arm pads adapted for use in sporting activities; Arm protectors for athletic use; Athletic protective sportswear; Balls being sporting articles; Balls for playing sports; Belts for weightlifting; Belts (Weight lifting -) [sports articles]; Body protectors for sports use; Body training apparatus [exercise]; Body-building apparatus; Body-building apparatus [exercise]; Boxing gloves; Chest exercisers; Chest expanders; Chest expanders [exercisers]; Chest protectors adapted for playing the sport of taekwondo; Chest protectors for athletic use; Elbow guards [sports articles]; Exercise balls; Exercise bands; Exercise bars; Gloves (Boxing -); Gloves for games; Gloves for sports; Gymnastic apparatus; Gymnastic articles; Gymnastic parallel bars; Gymnastics (Appliances for -); Hand wraps for sports use; Inflatable balls for sports; Inflatable punching bags; Jump ropes; Karate gloves; Karate kick pads; Karate shin pads; Karate target pads; Knee guards for athletic use; Knee guards for sports use; Knee guards [sports articles]; Knee pads for athletic use; Knee pads for sports use; Leg guards for athletic use; Martial arts training equipment; Men's athletic supporters [sports articles]; Paddings (Protective -) [parts of sports suits]; Pads for use in sports; Parallel bars; Yoga Blocks; Yoga Carry Strap; Yoga Accessories Parallel bars [for gymnastic]; Parallel bars for gymnastics; Portable home gymnastic apparatus; Protective padding for sports; Protective paddings for Taekwondo; Protective paddings [parts of sports suits]; Protective supports for shoulders and elbows [sports articles]; Protective vests for martial arts; Punchbags; Punching bags; Punching bags for boxing; Push up stands; Push-up handles; Ring games; Shin guards; Shin guards for athletic use; Shin guards for sports use; Shin guards [sports articles]; Shin pads; Shin pads for athletic use; Shin pads for sports use; Yoga Wheels; Shin pads for use in sports; Yoga Straps; Shin pads [sports articles];

Shin protectors [sports articles]; Shock absorption pads for protection against injury [sporting articles]; Sparring gloves; Sporting articles and equipment; Sports equipment; Sports games; Taekwondo kick pads; Taekwondo mitts; Weight lifting belts; Weight lifting belts [sports articles]; Weight lifting gloves; Wrist guards for athletic use.

Class 35: Administration of business affairs; Administration of businesses; Administration of sales and promotional incentive schemes; Administration of sales promotion incentive programs; Administration of the business affairs of retail stores; Advertising; Advertising and marketing; Advertising services relating to the sale of goods; Business accounts management; Business administration; Business administration and management; Business administration services; Business administration services for processing sales made on the internet; Business management; Business management and administration; Retail services in relation to sporting articles; Retail services in relation to sporting equipment; Retail services relating to sporting goods.

## **COSTS**

77. As the opposition has been largely successful, the opponent is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2015. The decision has been taken from the papers without an oral hearing. The opponent did not file evidence but did file written submissions in lieu of a hearing. In the circumstances, I award the opponent the sum of **£350** as a contribution towards the cost of the proceedings. The sum, accounting for a reduction to reflect the measure of success, is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£100
Preparing written submissions	£150
Official fee	£100
<b>Total</b>	<b>£350</b>

78. I therefore order SVA Global Ventures Ltd to pay Focus International Limited the sum of **£350**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 5<sup>th</sup> day of February 2021**

**James Hopkins**  
**For the Registrar**