

**O-364-21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3426784**

**BY KERRY-ANN LEVY**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 35:**

**CHAMPION MARKETING**

**AND**

**OPPOSITION THERETO UNDER NO. 419089  
BY CHAMPION PRODUCTS EUROPE LIMITED**

## BACKGROUND AND PLEADINGS

1. On 7 September 2019, Ms Kerry-Ann Levy (“the applicant”) applied to register the trade mark ‘Champion Marketing’ in the United Kingdom for the following services in class 35:

*Administration relating to marketing; Advertising and marketing; Advertising and marketing consultancy; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising, marketing and promotion services; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Advice concerning chemical product marketing; Advice in the field of business management and marketing; Advice relating to marketing management; Advisory services relating to marketing; Affiliate marketing; Analysis of marketing trends; Analysis relating to marketing; Arranging and conducting marketing promotional events for others; Arranging and conducting of marketing events; Business advice relating to marketing; Business advice relating to marketing management consultations; Business advice relating to strategic marketing; Business consultancy services relating to the marketing of fund raising campaigns; Business consultation and management regarding marketing activities; Business marketing consultancy; Business marketing consultation services; Business marketing consulting services; Business marketing services; Commercial information agencies [provides business information, e.g., marketing or demographic data]; Conducting marketing studies; Conducting of marketing studies; Consultancy relating to demographics for marketing purposes; Consultancy relating to marketing; Consultancy services in the field of affiliate marketing; Consultancy services relating to advertising, publicity and marketing; Consulting services in the field of Internet marketing; Consulting services relating to marketing; Database marketing; Design of marketing surveys; Development and implementation of marketing strategies for others; Development of marketing strategies and concepts; Digital marketing; Direct marketing; Direct marketing consulting; Direct marketing services; Dissemination of advertising, marketing and publicity materials; Distribution of advertising, marketing and promotional material; Estimations for marketing purposes; Event marketing; Marketing services; Marketing services in the field of dentistry; Marketing services in the field of restaurants; Marketing services in the field of travel; Marketing services provided by means of digital networks; Marketing services relating to esports events.*

The application was accepted and published for opposition purposes on 11 October 2019.

2. On 13 January 2020, Champion Products Europe Limited (“the opponent”) opposed the application in full based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The following trade marks and all goods and services for which they are registered are relied upon for the purposes of its opposition under sections 5(2)(b) and 5(3)<sup>1</sup>:

European Union Trade Mark (“EUTM”) 12628855<sup>2</sup>:

The logo for the brand 'Champion' is displayed. It features a stylized 'C' with a horizontal bar across its middle, followed by the word 'hampion' in a lowercase, sans-serif font.

Filing date: 24 February 2014; Registration date: 18 June 2016

*Class 18: Trunks and travelling bags; Umbrellas; Casual bags; Hand bags; Multipurpose sports bags; Baggage; Satchels; Rucksacks; Fanny packs; Beach bags; Canvas bags; Wallets; Briefcases; Key bags.*

*Class 25: Articles for clothing, Footwear, Headgear, Also including belts, Headscarves, Sashes for wear, Gloves, Sportswear: Stockings, Cuffs; Head sweatbands; Jackets [clothing], Jumpers, Undershirts; Tee-shirts; Elasticated t-shirts; Tank tops; Sweat shirts; Pants (Am); Trousers shorts; Bermuda shorts; Swimming costumes; Swimming trunks; Brassieres; Bath robes; Combinations (clothing); Full tracksuits for sports teams.*

*Class 28: Gymnastic and sporting articles and equipments not included in other classes.*

*Class 35: Management, organisation and administration in retail outlets, in particular of clothing, footwear and sporting articles; Retailing of clothing, footwear, bags and sporting articles; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Business services relating to the provision of sponsorship.*

EUTM 11298312:

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<sup>1</sup> In its original pleadings, the opponent relied upon four earlier trade marks. However, upon filing its evidence, the opponent notified the Tribunal of its intention to withdraw one of the marks from the proceedings (EUTM 11296852). The opposition continues in respect of three earlier marks, as outlined.

<sup>2</sup> Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application.



Filing date: 26 October 2012; Registration date: 27 March 2015

*Class 9: Optical, weighing and measuring apparatus and instruments; Eyeglass; Sunglasses; Sports glasses; Goggles for swimmers; Spectacle cases and frames.*

*Class 24: Textiles and textile goods, not included in other classes; Towels and cloths; Bath towels and beach towels.*

*Class 35: Management, organisation and administration in retail outlets, in particular of clothing, footwear and sporting articles; Retailing of optical, weighing and measuring apparatus and instruments, horological and chronometric apparatus and instruments, textiles and textile goods, bags, garments and sporting articles; Electronic commerce services, Namely providing information about products via telecommunication networks for advertising and sales purposes; Business services relating to providing sponsorship.*

*Class 41: Organising sporting events; Education, Providing of training, Entertainment and sporting activities.*

EUTM 122630<sup>3</sup>:

## CHAMPION

Filing date: 1 April 1996; Registration date: 10 August 1998

*Class 18: Luggage, cases, bags, wallets, pouches, purses, back packs, satchels, straps; parts for the aforesaid goods.*

*Class 25: Articles of clothing, footwear and headgear; parts for the aforesaid goods; babies' diapers of textile; babies' napkins of textile; boot uppers; cap peaks; dress shields; fittings of metal for shoes and boots; footwear uppers; hat frames [skeletons]; heel pieces for stockings; heelpieces for boots; heelpieces for boots and shoes; heelpieces for shoes; heelpieces for stockings; heels; inner soles; iron fittings for boots; iron fittings for shoes; non-slipping devices for boots; non-slipping devices for boots and shoes; non-slipping devices for shoes; pockets for*

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<sup>3</sup> The Tribunal notes that the opponent did not originally file 'Section A' of the TM7 in respect of this mark (that which relates to a 5(2)(b) claim) but it was deemed apparent from the accompanying submissions that the opponent intended to rely upon this mark in respect of both grounds from the outset. On 21 April 2021, the opponent filed 'Section A' retrospectively to rectify its administrative oversight.

*clothing; ready-made linings [parts of clothing]; shirt fronts; shirt yokes; soles for footwear; studs for football boots [shoes]; tips for footwear; visors [hatmaking]; welts for boots; welts for boots and shoes; welts for shoes.*

3. In its statement of grounds the opponent submits that, on account of the high similarity between the marks, and an identity or similarity between the respective specifications, there exists a likelihood of confusion, including a likelihood of association, on the part of the relevant public. Further, it states that the use of the applicant's mark would be detrimental to, and take unfair advantage of, the distinctive character and/or reputation of the trade marks relied upon by the opponent.

4. In the applicant's counterstatement, she submits that the parties operate in different fields and offer "completely different" products and services. Ms Levy concludes that her mark should therefore be granted registration.

5. The opponent is represented by Stobbs, whilst the applicant is unrepresented. Only the opponent elected to file evidence and neither party requested a hearing, though the opponent opted to file written submissions in lieu. This decision is taken following a careful reading of all the papers which I will refer to, as necessary.

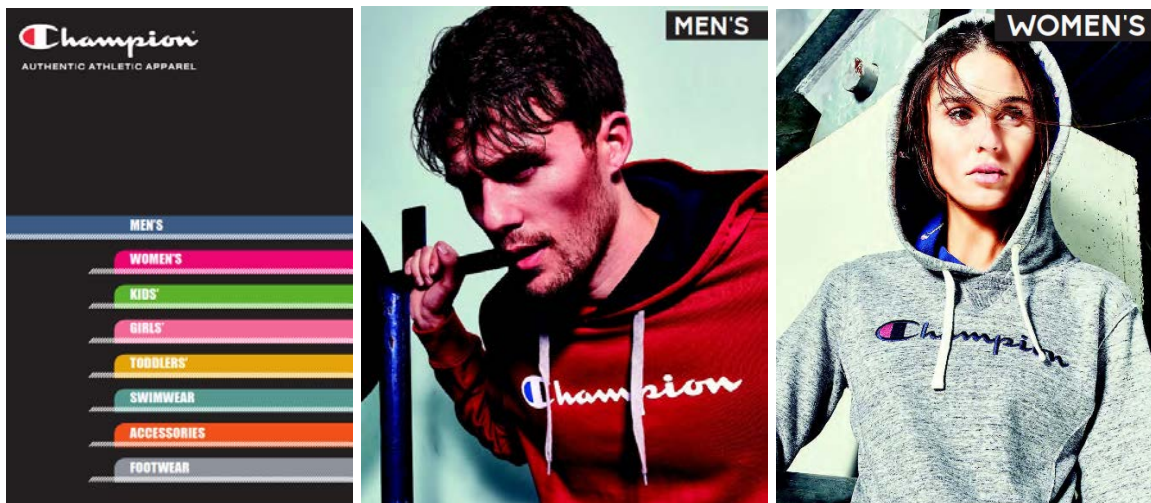
## **EVIDENCE**

6. The opponent's evidence comprises a witness statement from its managing director, Mr Chris Haggarty, and supporting exhibits CH1 to CH9. Mr Haggarty submits that the opponent's CHAMPION brand dates back to 1919 and has accumulated worldwide success in over 64 countries, including the UK. Its first European flagship store opened in London in 2017, followed closely by a store in Amsterdam and concessions remain in place in a number of stores in the UK, Holland, Greece, Italy and Romania. Mr Haggarty provides an annual breakdown of the opponent's turnover in the UK through sales of goods and services made under the CHAMPION brand from 2014 to 2019. The breakdown reads as follows:

Fiscal Year Jan – Dec	Turnover (£ Sterling in thousands)
2014	£4M
2015	£9M

2016	£10M
2017	£12M
2018	£35M
2019	£40M

7. At Exhibit CH2<sup>4</sup>, Mr Haggarty encloses extracts from catalogues published between 2014 and 2018 displaying a variety of goods sold under the opponent's CHAMPION brand. A selection of those extracts is provided below:



<sup>4</sup> At CH1, the opponent encloses the details of the trade marks relied upon.  
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8. At Exhibit CH3 are a number of invoices with dates ranging from 2014 to 2019 detailing various transactions made between the opponent and various UK stores. The invoices list a selection of apparel; hooded sweatshirts, crewneck t-shirts, pants and crew socks, for example. The customers include Harrods Ltd and SELFRIDGES RETAIL LIMITED (with an invoice exceeding £22,000<sup>5</sup>). An order from URBN UK Ltd. in London dated 23 February 2015 totals £51,841.80.

9. Exhibit CH4 encloses copies of external communications showing how the opponent's goods have 'typically been advertised since use commenced in the UK'<sup>6</sup>. In his witness statement, Mr Haggarty submits that the opponent's goods and services have and are promoted in a variety of ways including poster campaigns, bus campaigns, retailer activations, social media, PR and editorial projects, third party websites and sponsorship. In some of the enclosed pages, the opponent's mark sits above the words 'AUTHENTIC ATHLETIC APPAREL'. There are examples available from each year between 2002 and 2012, and I refer to a sample below:



<sup>5</sup> Dated 26 August 2014

<sup>6</sup> Mr Haggarty refers specifically to a leaflet which refers to the opponent's sponsorship of the MLB London Series in 2019, but this does not appear to be enclosed with Exhibit CH4 as stated.

10. At Exhibit CH5 are printouts from the opponent’s website, specifically pages relating to the heritage of its brand. There is also a printout from Wikipedia offering details on the Champion brand. The page is headed ‘Champion (sportswear)’.

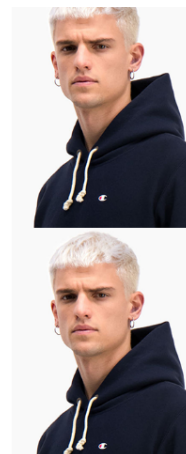


#### CHAMPION AND THE NBA

Champion was the official outfitter of all 27 teams of the National Basketball Association and outfitted every USA basketball team from 1989-2001. Champion’s jerseys were proudly worn by the first men’s “Dream Team” – the first American Olympic basketball team to feature active professional players from the NBA and the first women’s Dream Team in 1996. NBA Champion Glen Rice famously set a record for the Miami Heat wearing Champion shoes.

#### THE CHAMPION HOODIE BECOMES AN ICON

As testament to Champion’s rich heritage, the Reverse Weave Hoodie was exhibited in the Museum of Modern Art (MoMA) as part of the exhibition ‘Items: Is Fashion Modern?’ which displayed fashion items that have had a strong impact on modern society. In 2018, the hoodie became part of the permanent collection.



From the mid-1980s to the mid-1990s, it was a very common fashion trend to see girls and guys of all ages wearing Champion sweatshirts over a turtleneck and over jeans with slouch socks and sneakers. Girls of all ages and adults also wore the sweatshirts oversized or extra-long with leggings and slouch socks and athletic sneakers, Keds or boat shoes. Today, Champion is now considered a very well known brand.

From 2008, Champion produced kits for Premier League side, Wigan Athletic, the Wales national football team and the jersey of the Greek basketball team,<sup>[7]</sup> also Pallacanestro Cantù, in Italy.

For many years Champion supplied the athletic uniforms for the Notre Dame Fighting Irish. In 2001 Notre Dame signed a five-year exclusive agreement with Adidas, which ended a partnership Champion had with the university that spanned over 50 years.<sup>[8]</sup>

#### Past sponsorships

In the past, Champion manufactured uniforms mostly for basketball and American football teams, most notable its long-time partnership with the National Basketball Association (NBA) that extended until 2004, when Reebok took over.<sup>[10]</sup> Champion also sponsored International association FIBA until 2017.<sup>[11]</sup>

#### Merchandising licenses

Replica jersey uniforms made by Champion in the licensed sports business:

- NBA – all teams (1990–2002)
- NFL – all teams (1980s–2000)
- XFL – all teams (2001)

#### Sponsorships

##### Basketball

- KK Dynamic
- National Basketball League <sup>[9]</sup>

11. An insight into the opponent’s marketing strategies is provided at Exhibit CH6<sup>7</sup>. The pages show activities sourced by third parties and the marketing efforts of various retailers which stock the opponent’s goods. I provide examples of those pages below:

Invoice Date: 16 June 2017

Ana Maria Regonato  
Champion Products Europe Ltd  
Suite 8,  
Plaza 212,  
Blanchardstown Corporate Park 2,  
Dublin 15, D15V446  
Ireland

Invoice Number: 29097  
Job Number: FASCHA1702  
Client Ref: SS18 Film

Invoice Date: 6 September 2018

Terry Donovan  
Champion Products Europe Ltd  
Suite 8, Plaza 212  
Blanchardstown Corporate Park 2  
Dublin 15,  
D15V446  
IRELAND

Invoice Number: 30756  
Job Number: CLICHA1820  
Client Ref: JD Aut/Wint18/Prod

Champion SS18 Film	Amount (€)
Creation & Production of Champion SS18 Brand Film as requested by Chris Haggarty	8,500.00
<b>Total Excluding VAT</b>	<b>8,500.00</b>
<b>Total VAT</b>	<b>0.00</b>
<b>GRAND TOTAL</b>	<b>8,500.00</b>

Champion: JD Autumn/Winter 18	Amount (€)
JD Autumn/Winter 18 - INVOICE 1	
Production Costs:	
Talent	114,000.00
Production	
Paid Media	
Contingency	
<b>PAYMENT TERMS: IMMEDIATE</b>	
<b>Total Excluding VAT</b>	<b>114,000.00</b>
<b>Total VAT</b>	<b>0.00</b>
<b>GRAND TOTAL</b>	<b>114,000.00</b>

<sup>7</sup> At Exhibit CH6, Mr Haggarty refers to a specific document headed ‘Champion Europe Group (excluding G7A) Total Marketing Costs’ for the period 2002-2018. However, this document is not present in the exhibits before me. It is noted that the opponent was asked to reduce its original evidence to comply with the guidance set out in Tribunal Practice Notice “TPN” 1/2015 and subsequently revised, or reduced, its exhibits.



Champion Products Europe Limited  
 Suite 8, Plaza 212  
 Managing Director Chris Haggarty  
 Blanchardstown Corporate Park 2  
 Blanchardstown  
 Dublin, 15

**WOOD WOOD**

Ireland

**Carrington APIS**  
 Harborside 106, Bagginbowl 2,  
 CR 2000 Keshmestown 19  
 Phone +353 3531 6264  
 Fax  
 CUIR/VAT: 21416134  
 Ireland@woodwood.ie  
 www.woodwood.ie

**Sales - Invoice**

Sell to Customer No. 12173

Your Reference	Your Order No.	Order No.	Our Ref.	Invoice Date	Invoice No.
			ADM	06-03-17	125140

Style No.	Style description	Qty	Price	Amount
	AW17 WW x Champion Marketing contribution	1	13,000,00	13,000,00
Total Quantity		0		



URBN UK Limited  
 24 West Street  
 WC2H 9NA  
 United Kingdom

VAT Reg: 684 9363 82  
 Co Reg: 3124253

**Invoice To:**  
 CHAMPION PRODUCTS EUROPE  
 BLANCHARDSTOWN CORP PARK, PLAZA  
 212,SUITE 8  
 D15  
 DUBLIN  
 Ireland

**Customer VAT Reg:**

Invoice Number	Invoice Date
100000738	12-OCT-2018
Customer Number	Customer Location
82035	104208
Payment Terms	Due Date
10 NET	22-OCT-2018
Currency	Customer Reference
GBP	

Line	Description	Qty	Unit Price	Net Amount	VAT Total
1	Champion August 2018 Partnership	1	76,000,00	76,000,00	0,00
<b>Net Total</b>				76,000,00	0,00
<b>VAT Total</b>					0,00
<b>Invoice Total</b>				76,000,00	0,00

Currency	VAT Code	VAT Rate	Taxable Amount	Total VAT
GBP	INTRA EU AIR-ZERO RATED-SERVICE	0%	76,000,00	0,00

**Remit To:**  
 URBN UK Limited  
 Bank: Wells Fargo Account Name: URBN UK Limited  
 GBP Invoices: Sort Code: 40-51-33 A/C Number: 11122102  
 BIC: PNBGB2L IBAN: GB83PNBP1656711122102  
 EUR Invoices: Sort Code: 40-51-33 A/C Number: 11122166  
 BIC: PNBGB2L IBAN: GB83PNBP1656711122166  
 USD Invoices: Sort Code: 40-51-33 A/C Number: 2000002434766

**Special instructions**  
 Supply of services - VAT to be accounted by the recipient - Article 44 of Directive 2006/112/EC

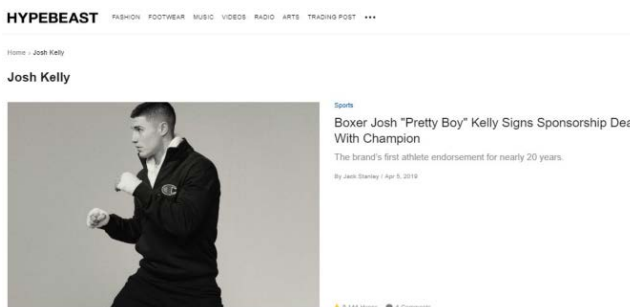
**CHAMPION HARRODS INSTORE - 2017**



**CHAMPION SELFRIDGES - 2018**



**USC INSTORE POS / WINDOWS / ONLINE - 2019**

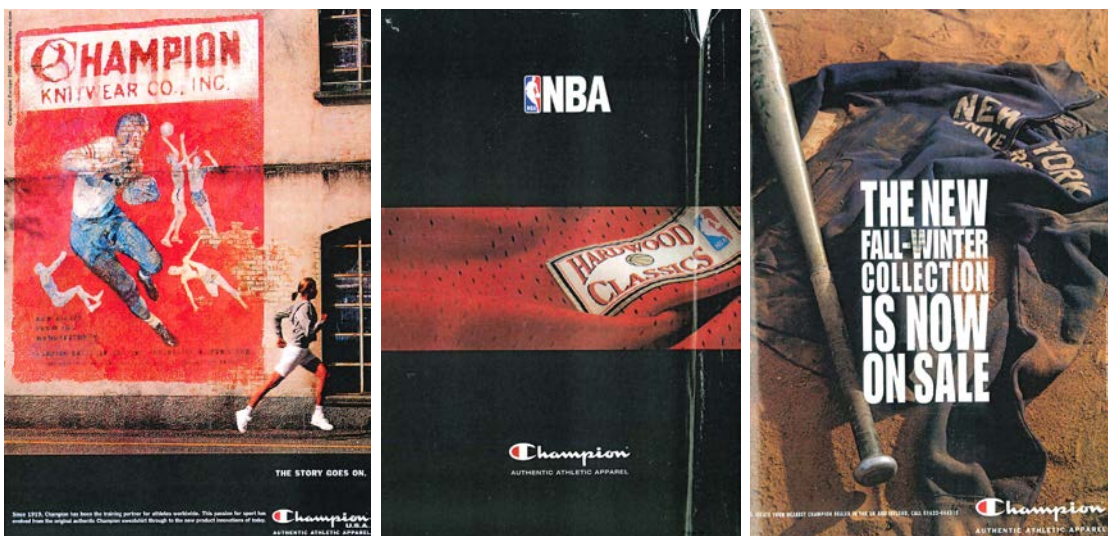


95 Buses across UK  
55 - London  
10 - Manchester  
10 - Liverpool  
10 - Birmingham  
10 - Glasgow  
Two week duration  
Supporting Brand & Webstore  
Men's & Woman's Imagery  
Use of Champion Corporate logo  
Call to Action - ChampionStore.com



12. At CH7 are a number of printouts showing the opponent's goods, predominantly clothing, available to purchase from a number of renowned retailers including Urban Outfitters, Next, USC, Very, JD Sports, Foot Asylum and ASOS. All prices are listed in GBP. Mr Haggarty states that, although some pages were downloaded on 4 August and 25 September 2020, they are nevertheless a representation of the way in which third parties have traditionally advertised the opponent's goods.

13. At CH8 are a selection of advertisements which Mr Haggarty advises were available in a number of publications between 1984 and 2016 including FourFourTwo, Company, Heat, Maxim, Drapers, FHM, Arena, Crown Sports Magazine and Loaded. The opponent also encloses printouts from its social media accounts. A printout<sup>8</sup> from the Facebook page of 'Champion Europe - UK' shows that the account has 17,903 followers. The official Instagram account of 'Champion Europe' has 1.1 million followers.



<sup>8</sup> Dated 25 September 2020

14. Exhibit CH9 shows how the opponent has typically advertised its goods via its own website over the years. I refer to examples of those advertisements below, and that will conclude my summary of the opponent’s evidence, insofar as I consider it necessary.



ROCHESTER 1919  
Girls Script Logo Classic Hoodie

£40.00

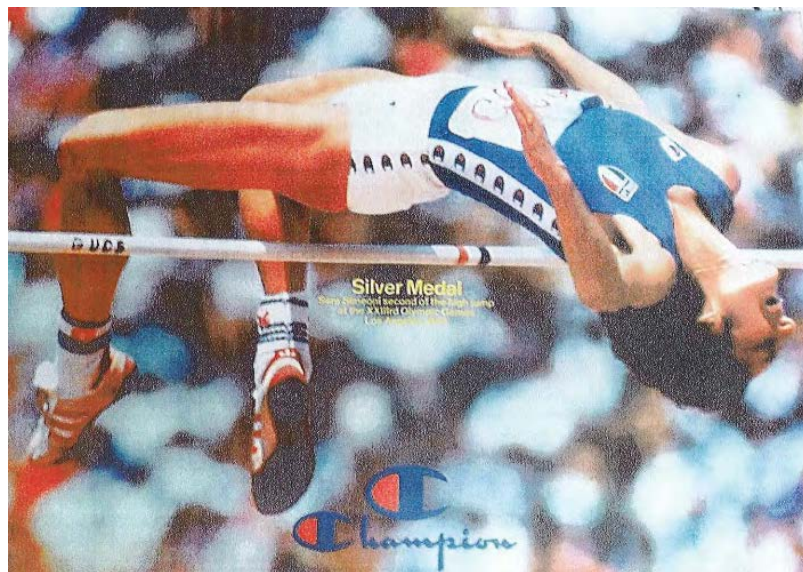
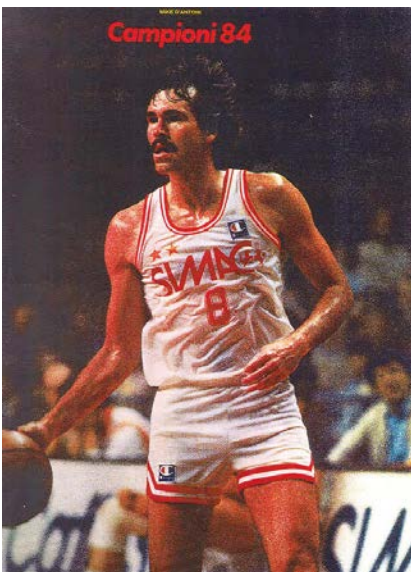


ROCHESTER 1919  
Girls Script Logo Crew Neck T-Shirt

£23.00



Hoodies	T-Shirts	Sweatshirts
<a href="#">SHOP.MEN</a> <a href="#">SHOP.WOMEN</a>	<a href="#">SHOP.MEN</a> <a href="#">SHOP.WOMEN</a>	<a href="#">SHOP.MEN</a> <a href="#">SHOP.WOMEN</a>



**DECISION**

15. The opposition is based upon sections 5(2)(b) and 5(3) of the Act which 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.

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

16. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

17. The marks relied upon by the opponent for the purposes of section 5(2)(b) are laid out at paragraph 2 of this decision and all qualify as earlier trade marks under the above provisions. As only EUTM ‘630 had been registered for five years before the filing date of the application, this is the only mark which is, therefore, subject to the proof of use provisions set out in s. 6A of the Act.

## **Preliminary matter**

18. I note that, in her counterstatement, the applicant relies partly on the different environments within which the parties operate. Ms Levy states:

“I strongly disagree with the opponent because the mark that they are defending ‘Champion’ or ‘Champion Products Europe Ltd’ provide products aimed at the sports industry. Products include racing car products, sports bag, clothing and accessories etc.

‘Champion Marketing’ will not provide any products, it will solely provide a Digital Marketing Consultant service....

... for the fact that the marks are different, operating in different markets and are offering completely different products and services which do not compete with each other or is affiliated in any way; I believe that I can be granted the right to register the trade mark in question.”

19. In *Oakley v OHIM*, Case T-116/06, it is made clear that the consideration of a likelihood of confusion is prospective and cannot be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks, ...cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors...”

20. Further, marketing strategies are temporal and may change with the passage of time. See for instance, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the Court of Justice of the European Union (“CJEU”) stated:

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

circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

21. It follows that, for the purposes of section 5(2)(b), I am required to make the assessment of the likelihood of confusion notionally and objectively solely on the basis of the respective specifications (and marks) as they appear on the register (and subject to my proof of use findings below). The *actual* part of the market they may currently target must be irrelevant to that assessment.

### **Proof of use**

22. The proof of use provisions at s. 6A of the Act read:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services”.

23. Section 100 is also relevant and states as follows:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

24. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a



single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use

of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]”.

25. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU noted that:

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

And

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

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a

priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

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

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

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

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

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

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

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

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

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

29. As regards a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C., as the Appointed Person, summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned”.

30. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

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

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

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

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc [2015] EWCA Civ 220 ("Asos")* at [56] and [60].

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

31. It is worth noting here that much (though not all) of the opponent's evidence shows its mark presented in the same way as EUTM '312, as below.

**Champion**

As it is the opponent's 'CHAMPION' mark which is subject to the proof of use provisions, I must consider whether the above representation constitutes use of the word-only mark. In my view, the distinctive character of CHAMPION is not altered by the script in which it is presented; the distinctive character continues to reside, at least predominantly, in the word CHAMPION/Champion and that is what will ultimately resonate in the mind of the average consumer. For that reason, I find the use of the mark in this format acceptable.

32. The relevant period for assessing use is 8 September 2014 to 7 September 2019. Notwithstanding that some exhibits fall outside of these dates, and that the opponent has not clarified its market share, taking the evidence as a whole, it is clear that the opponent has made use of its mark during the relevant period. Although the evidence relates to the UK market, I find it sufficient to constitute genuine use in the EU, in accordance with the aforementioned case law. There is a large volume of exhibits showing the opponent's goods advertised alongside the earlier mark both in catalogues and a number of high profile publications. The opponent has generated a substantial, and annually increasing, turnover in the UK throughout the relevant period, reaching £40m in 2019<sup>9</sup>. The invoices enclosed show significant orders from a number of well regarded retailers, which also feature in several photographs showing large displays dedicated solely to the launch of the opponent's goods. The opponent has also benefitted from a number of sponsorships with sporting teams and organisations likely to generate a significant degree of interest and awareness amongst the relevant public. Whilst I have not had sight of the opponent's marketing breakdown (intended to be included in Exhibit CH6), the evidence indicates that the opponent has invested heavily in the marketing and promotion of its brand. That being said, I am not satisfied that the evidence shows use of all goods and services relied upon by the opponent. It falls to me now to consider a fair specification.

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<sup>9</sup> The table header suggests that the amounts are expressed in 'thousands' but the body of the table indicates that the amounts are expressed in millions. I will proceed on the basis that the figures were intended to be expressed in millions, though it is worth stating that, even if those figures were to be displayed in thousands, I find the proof of use criteria is satisfied.

33. To my mind, none of the evidence demonstrates use of the mark in relation to services, nor has the opponent shown use in relation to many of the goods relied upon (luggage or babies' diapers, for example). Whilst the mark has clearly been used alongside the promotion of specific goods bearing the CHAMPION mark, the evidence points to a mark associated with apparel, primarily in a sporting context, though I am mindful not to narrow the specification too finely. Still, given that none of the opponent's evidence shows what I would consider formal wear, when I consider the evidence alongside the relevant case law, I consider a fair specification for the opponent's mark to be *casualwear* (comprising clothing, footwear and headgear).

## **DECISION**

### **Section 5(2)(b) - case law**

34. 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.

#### The principles

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

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



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

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

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

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

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

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

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


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

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

35. Although the UK has left the EU, section 6(3)(a) of the European Union (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. This is why this decision continues to make reference to the trade mark case-law of EU courts.

### Comparison of goods and services

36. The competing goods and services are laid out in the table below:

The opponent's goods and services	The applicant's services
<p>EUTM 12628855:</p>  <p><i>Class 18: Trunks and travelling bags; Umbrellas; Casual bags; Hand bags; Multipurpose sports bags; Baggage; Satchels; Rucksacks; Fanny packs; Beach bags; Canvas bags; Wallets; Briefcases; Key bags.</i></p> <p><i>Class 25: Articles for clothing, Footwear, Headgear, Also including belts, Headscarves, Sashes for wear, Gloves, Sportswear: Stockings, Cuffs; Head sweatbands; Jackets [clothing], Jumpers, Undershirts; Tee-shirts; Elasticated t-shirts; Tank tops; Sweat shirts; Pants (Am); Trousers shorts; Bermuda shorts; Swimming costumes; Swimming trunks;</i></p>	<p><i>Class 35: Administration relating to marketing; Advertising and marketing; Advertising and marketing consultancy; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising, marketing and promotion services; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising, marketing and promotional services; Advertising, promotional and marketing services; Advice concerning chemical product marketing; Advice in the field of business management and marketing; Advice relating to marketing management; Advisory services relating to marketing; Affiliate marketing; Analysis of marketing trends; Analysis relating to marketing; Arranging and conducting</i></p>

<p><i>Brassieres; Bath robes; Combinations (clothing); Full tracksuits for sports teams.</i></p> <p><i>Class 28: Gymnastic and sporting articles and equipments not included in other classes.</i></p> <p><i>Class 35: Management, organisation and administration in retail outlets, in particular of clothing, footwear and sporting articles; Retailing of clothing, footwear, bags and sporting articles; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Business services relating to the provision of sponsorship.</i></p> <p>EUTM 11298312:</p>  <p>Filing date: 26 October 2012; Registration date: 27 March 2015</p> <p><i>Class 9: Optical, weighing and measuring apparatus and instruments; Eyeglass; Sunglasses; Sports glasses; Goggles for swimmers; Spectacle cases and frames.</i></p> <p><i>Class 24: Textiles and textile goods, not included in other classes; Towels and cloths; Bath towels and beach towels.</i></p>	<p><i>marketing promotional events for others; Arranging and conducting of marketing events; Business advice relating to marketing; Business advice relating to marketing management consultations; Business advice relating to strategic marketing; Business consultancy services relating to the marketing of fund raising campaigns; Business consultation and management regarding marketing activities; Business marketing consultancy; Business marketing consultation services; Business marketing consulting services; Business marketing services; Commercial information agencies [provides business information, e.g., marketing or demographic data]; Conducting marketing studies; Conducting of marketing studies; Consultancy relating to demographics for marketing purposes; Consultancy relating to marketing; Consultancy services in the field of affiliate marketing; Consultancy services relating to advertising, publicity and marketing; Consulting services in the field of Internet marketing; Consulting services relating to marketing; Database marketing; Design of marketing surveys; Development and implementation of marketing strategies for others; Development of marketing strategies and concepts; Digital marketing; Direct marketing; Direct marketing consulting; Direct marketing services; Dissemination of advertising, marketing and publicity materials; Distribution of advertising, marketing and promotional material;</i></p>
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<p><i>Class 35: Management, organisation and administration in retail outlets, in particular of clothing, footwear and sporting articles; Retailing of optical, weighing and measuring apparatus and instruments, horological and chronometric apparatus and instruments, textiles and textile goods, bags, garments and sporting articles; Electronic commerce services, Namely providing information about products via telecommunication networks for advertising and sales purposes; Business services relating to providing sponsorship.</i></p> <p><i>Class 41: Organising sporting events; Education, Providing of training, Entertainment and sporting activities</i></p> <p>EUTM 122630:</p> <p>CHAMPION</p> <p><i>Class 25: Clothing, footwear and headgear.</i></p>	<p><i>Estimations for marketing purposes; Event marketing; Marketing services; Marketing services in the field of dentistry; Marketing services in the field of restaurants; Marketing services in the field of travel; Marketing services provided by means of digital networks; Marketing services relating to esports events.</i></p>
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37. Where goods or services are not literally identical, a further provision for identity was set out in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05. The GC stated:

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

38. In the judgment of the CJEU in *Canon*,<sup>6</sup> 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”.

39. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>7</sup> 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.

40. In *Kurt Hesse v OHIM*,<sup>8</sup> the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,<sup>9</sup> the GC stated that “complementary” means:

“...there is 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”.

41. The opponent’s submissions regarding the similarity between the respective services read as follows:

“In the first instance, the terms covered by the Application for *"advice in the field of business management and marketing; advice relating to marketing management; business advice relating to marketing management consultations; business consultation and management regarding marketing activities; and administration relating to marketing;"* are various services rendered by specialist companies such as business consultants. They are at least similar, if not identical, to the Opponent's term for *"Management, organisation and administration in retail outlets, in particular of clothing, footwear and sporting articles;"* in particular.

The management and administration services covered by both the Applicant's and the Opponent's Class 35 specification have the same purpose of providing tools and expertise to enable customers to carry out their business or providing businesses with the necessary support to acquire, develop and expand market share. The respective services are provided by the same business consultants, they are directed at the same consumers and they have the same distribution channels.

It is established practice, following case law, that the above identified services relate to the control and organisation of a business to enable it to achieve certain strategic and organisational goals. The Opponent's *"management, organisation and administration services"* could be concerned with the same subject matter as that of the Applicant's *'management and administration services'*, as the Applicant's services may include projects relating to the organisation, management structure or promotion of a business with regard to retail outlets and in such circumstances, would be considered identical services, or, at the very least, these services would be highly similar.

Secondly, the terms covered by the Application for "*advertising and marketing; advertising and marketing consultancy; advertising and marketing services; advertising and marketing services provided by means of blogging; advertising and marketing services provided by means of social media; advertising and marketing services provided via communications channels; advertising, marketing and promotion services; advertising, marketing and promotional consultancy, advisory and assistance services; advertising, marketing and promotional services; advertising, promotional and marketing services; consultancy services relating to advertising, publicity and marketing; dissemination of advertising, marketing and publicity materials; distribution of advertising, marketing and promotional material;*" are highly similar to the Opponent's Class 35 term for "*Electronic commerce services, Namely providing information about products via telecommunication networks for advertising and sales purposes;*" in particular.

This is because it is established practice following case law that advertising services consist of providing others with assistance in the sale of their goods and services by promoting their launch and/or sale, or of reinforcing a client's position in the market and acquiring competitive advantage through publicity. Many different means and products can be used to fulfil this objective. These services can be provided by specialist companies, which study their client's needs, provide all the necessary information and advice for marketing the client's goods and services, and by creating a personalised strategy for advertising them through newspapers, websites, videos, the internet, etc. Therefore, the e-commerce services of the Opponent provided for advertising and sales purposes are included in the Applicant's broad category "*advertising and marketing services*" in particular and as such, are identical and highly similar because they have the same nature, the same purpose and the same method of use. They can also originate from the same undertaking, target the same relevant public and can be offered through the same distribution channels.

Thirdly, the terms covered by the Application for "*advice in the field of business management and marketing; business advice relating to marketing; business advice relating to marketing management consultations; business advice relating to strategic marketing; business consultancy services relating to the marketing of fund raising campaigns; business consultation and management regarding marketing activities;*"

*business marketing consultancy; business marketing consultation services; business marketing consulting services; business marketing services; commercial information agencies [provides business information, e.g., marketing or demographic data]*" are identical and highly similar to the Opponent's term for "*Business services relating to providing sponsorship.*" in particular, as this term is wholly encompassed within the broad "*business marketing*" service terms covered by the Application.

It is submitted that the services mainly consist of organising people and resources efficiently so as to direct activities towards the common goals and objectives of a business. They serve the same purpose, can target the same end users and can be offered by the same undertakings as business management and organisation consultancies. The respective services identified are therefore highly similar."

42. When assessing the services' similarity, I will adopt the groupings of terms set out by the opponent, though I note several terms are included within different groups. Where the terms are not set out explicitly, I will consider where those terms can be grouped appropriately and assess them independently where required.

*Administration relating to marketing; advice in the field of business management and marketing; advice relating to marketing management; business advice relating to marketing management consultations; business consultation and management regarding marketing activities*

43. The opponent submits that the aforementioned services are at least similar, if not identical, to its *management, organisation and administration in retail outlets, in particular of clothing, footwear and sporting articles*, in particular. It claims that the services share a purpose, are provided by the same bodies, are directed toward the same consumers and move through the same distribution channels. To my mind, the uses of the respective services are not greatly similar. Whilst I note the opponent's comments insofar as both provide consumers with useful 'tools and expertise', the fields are distinct and I am reluctant to allow too broad an interpretation to the respective terms. When it comes to the services' consumers, I accept that there may be some degree of overlap, though this is unlikely to be consistent. The opponent's services are likely to be selected by consumers with a vested interest in the retail sector and, whilst individuals within that sector may also employ



services relating to marketing or business management, for example, the applicant's services are likely to be selected by a wider pool of consumers; they will not be limited to those in retail. There may be some crossover in the nature of the parties' approach to 'management' or 'administration', broadly speaking, but the arenas in which those approaches are conducted are not similar. I would expect effective management of a retail outlet to require a different set of actions to management or business services which relates strictly to marketing. Whilst I am willing to accept there may be some overlap in the services' trade channels, I would not consider it to be of any meaningful degree. The services are not competitive, nor are they complementary. On balance, I find the services dissimilar.

*Advertising and marketing; advertising and marketing consultancy; advertising and marketing services; advertising and marketing services provided by means of blogging; advertising and marketing services provided by means of social media; advertising and marketing services provided via communications channels; advertising, marketing and promotion services; advertising, marketing and promotional consultancy, advisory and assistance services; advertising, marketing and promotional services; advertising, promotional and marketing services; consultancy services relating to advertising, publicity and marketing; dissemination of advertising, marketing and publicity materials; distribution of advertising, marketing and promotional material*

44. The opponent submits that the aforementioned services are highly similar to *electronic commerce services; namely providing information about products via telecommunication networks for advertising and sales purposes*. It also states that the opponent's 'e-commerce' services are captured within the applicant's *advertising and marketing services*. I agree that the services could be deemed identical on the basis of the *Meric* principle but will explore the services' similarity in case this is an incorrect approach and, nevertheless, I am required to assess all of the remaining services. The applicant's services are selected for the purposes of acquiring promotion, marketing or advertising. The opponent's services are, by definition, provided for advertising and sales purposes. There is, therefore, a correlation in the services' purpose, though I note that the opponent's services relate specifically to products, and are provided electronically, whereas the applicant's appear to have a wider remit. The correlation in use, in my view, will likely mean that there is a crossover in the respective users. Where the applicant's services are provided via

telecommunication networks, the nature of the services will be highly similar, though of course the applicant's specification cannot be narrowed to this medium of advertisement only. The services are likely to reach the market via the same channels of trade and could, in my view, prove to be competitive. The services are not complementary. All things considered, I find the services similar to a fairly high degree.

45. I apply the same reasoning to the applicant's *consultancy relating to marketing; digital marketing; direct marketing; direct marketing consulting; direct marketing services; marketing services; marketing services provided by means of digital networks; database marketing; arranging and conducting marketing promotional events for others; event marketing; arranging and conducting of marketing events and marketing services provided by means of digital networks*, as many of these are encapsulated by the wider terms listed above and the close relationship between services pertaining to advertising and those pertaining to marketing remains.

*Marketing services in the field of dentistry; marketing services in the field of restaurants; marketing services in the field of travel; marketing services relating to esports events.*

46. The difference in the above services is that they express a specific field (to which the marketing relates). Whilst the opponent's term remains broad, much of my previous reasoning can be applied. There may still be similarity in use, users and trade channels. However, given that the opponent's e-commerce services specify an interest in *products* specifically, and the fields expressed by the applicant's services are not necessarily 'products', there may be a further degree of separation in nature and lesser opportunity for competitiveness. On balance, I find the services similar to at least a medium degree.

*Advice in the field of business management and marketing; business advice relating to marketing; business advice relating to marketing management consultations; business advice relating to strategic marketing; business consultancy services relating to the marketing of fund raising campaigns; business consultation and management regarding marketing activities; business marketing consultancy; business marketing consultation services; business marketing consulting services; business marketing services; commercial information agencies [provides business information, e.g., marketing or demographic data];*

47. The opponent concludes that the above services share a high similarity with its *business services relating to providing sponsorship* (in particular). Whilst the respective services are consistently concerned with matters of business, the applicant's services are strictly related to marketing. That said, sponsorship, to my knowledge, though not the same as marketing (which is a much wider concept), could be used as a means of marketing or as a contributory element in a marketing campaign intended to generate awareness or funding. I do consider there to be some similarity in the respective uses. The services are likely to share the same consumers; specifically those operating within a business arena considering ways in which to develop or expand. Given the relationship between marketing and sponsorship services, there may be some degree of similarity in the nature of the services, as delivered, though admittedly this is likely to be variable. I find it likely that the services will share distribution channels. There could be an element of competitiveness and, though not strictly complementary, it would not seem unreasonable for consumers to expect the same entity to offer both services. On balance, I find the services are similar to a fairly high degree.

48. The opponent's 'business services', though related to sponsorship, encapsulate a number of activities which could include those specified in the applicant's specification. I apply the same reasoning to the applicant's *advice relating to marketing management; advisory services relating to marketing; advice concerning chemical product marketing; administration relating to marketing; analysis of marketing trends; analysis relating to marketing; estimations for marketing purposes; consulting services relating to marketing; consulting services in the field of Internet marketing; consultancy relating to demographics for marketing purposes; design of marketing surveys; conducting marketing studies; conducting of marketing studies; development of marketing strategies and concepts and development and implementation of marketing strategies for others*. These are similar to a fairly high degree.

49. When compared against the same of the opponent's business services (...relating to providing sponsorship), I find a greater degree of similarity in respect of the applied for *affiliate marketing* and *consultancy services in the field of affiliate marketing* as I understand affiliate marketing to refer to a similar process to sponsorship, at least in terms of offering a mutual benefit to both parties. There is similarity to be found in the services' use and users,

and there is likely to be a correlation in nature and trade channels. The services are not complementary but could be competitive. Here, I find the similarity high.

50. It is worth noting here that I have found similarity only in respect of the services for which the opponent's earlier marks (EUTMs '855 and '312) are registered. The specification of the opponent's '630 mark has been restricted to casualwear (which comprises *clothing, footwear and headgear*). I do not consider there to be any similarity between these goods and the services for which registration is sought. Given that a likelihood of confusion requires some degree of similarity in goods and/or services<sup>10</sup>, the opponent's 5(2)(b) claim based on its '630 mark fails at this juncture. I will proceed to consider a likelihood of confusion in respect of the remaining marks.

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

51. It is necessary for me to determine who the average consumer is for the services in question. I must then determine the manner in which the services are likely to be selected by the average consumer in the course of trade.

52. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

53. 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

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<sup>10</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA  
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person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

54. In my view, the average consumer of the services at issue is likely to be a professional body, be that a single business person or an organization, though the services are of course available to the general public. The services are likely to be employed for the purpose of administering a business operation of some kind or marketing a particular product or service (for example). In either case, I would not expect the selection to be made with any degree of frequency and I suspect that the associated costs can (though not necessarily) reach a fairly high level. Generally, the services are likely to be selected from online platforms or trade publications, suggesting that visual considerations are likely to play the predominant role during the purchasing process. That said, I do not discount the significance of the aural element as it would not seem unusual for consumers to seek recommendations from peers or professionals in the relevant field. The purchase is likely to be well-considered, with factors such as compatibility and reputation in play. Weighing all considerations, I find that the level of attention likely to be adopted during the selection process will be fairly high.



### **Comparison of marks**

55. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment 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 relevant 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.”

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

57. The trade marks to be compared are as follows:

Opponent's marks	Applicant's mark
<p>EUTM 12628855:</p>  <p>EUTM 11298312:</p> 	<p style="text-align: center;"><b>CHAMPION MARKETING</b></p>

Overall impression

58. The applicant's mark comprises two words; CHAMPION MARKETING. Its overall impression lies in the unit created by the combination of the two words, though 'MARKETING' is likely to be viewed as a nod toward the nature of the services provided.

59. The opponent's '855 mark comprises the word 'Champion' punctuated by a full stop, which is positioned just beneath the word's final letter (n). The word's first letter 'C', the only one which is capitalized, is hooked onto the letter it precedes ('h'). The word is presented in an unremarkable black typeface. The mark's overall impression lies in the word 'Champion'.

60. The opponent's '312 mark comprises a single word; Champion. The letter 'C' is capitalized, with the remaining letters presented in lower-case and a handwritten script.

The letter C has a thick, vertical line running through the centre, though it is still recognizable as the letter C, particularly in the context in which it is positioned, as the initial letter of a well-known, dictionary word. The mark's overall impression lies predominantly in the word 'Champion'.

#### The opponent's '855 mark

61. Visually, the marks coincide in the word 'Champion', though it is subject to some degree of stylization in the opponent's mark and the opponent's mark incorporates a full stop. Whilst the additional word in the application has no counterpart in the opponent's mark, I keep in mind the rule of thumb regarding the *beginnings* of marks which, at least generally, have a greater impact on consumers (than their endings). On balance, I find the visual similarity to be of a medium degree.

62. Aurally, the applicant's mark will be articulated in six syllables; CHAMP-EE-YUN-MARKET-ING. The opponent's will be articulated in three; CHAMP-EE-YUN. The first three syllables in the applicant's are identical to those which make up the opponent's mark in its entirety. Still, there are three additional syllables in the applicant's mark. I find the aural similarity to be of a medium degree.

63. In the application, conceptually, it seems likely that consumers will place a greater weight on CHAMPION, as MARKETING is likely to be seen as a descriptive element serving to inform consumers of the nature of the services provided under the applicant's mark. In my view, consumers will be wholly familiar with the meaning of 'champion', which is used to describe a person who has succeeded or been victorious in a certain field. In that respect, the marks share an identical conceptual element. Where consumers fail, as I suspect they would, to attribute any distinctive significance to the MARKETING element of the applicant's mark, the respective marks are conceptually identical. If that is incorrect, the marks are at least conceptually highly similar.

#### The opponent's '312 mark

64. Visually, the marks share an identical element in the word 'Champion/CHAMPION'. In the opponent's mark, the word is presented in a script-format, with an additional flair to

the letter C. The word 'MARKETING' in the applicant's mark has no equivalent in the opponent's. I find the marks' visual similarity to be of a medium degree.

65. Aurally, I find that the opponent's marks are likely to be articulated identically. On that basis, I apply the same reasoning as I did when assessing the aural similarity between the opponent's '855 mark and the application. The marks are aurally similar to a medium degree.

66. Similarly, I find the opponent's marks conceptually identical (with the respective distinctive concepts residing solely in the word 'Champion). For the reasons outlined above, I consider the marks conceptually similar to at least a high degree.

### **Distinctive character of the earlier marks**

67. The degree of distinctiveness of the earlier marks must be assessed. The more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* 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).”

68. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. That said, the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

69. I will begin by assessing the inherent distinctive character of the earlier marks. Each of the opponent’s marks comprises the word ‘Champion’. Though admittedly an ordinary, dictionary word with a definition readily identifiable for the average consumer, when considered in respect of the various goods and services for which the marks are registered, despite the word’s positive connotations, I can see no allusive or suggestive qualities. On balance, I consider the inherent distinctiveness of all earlier marks to be of a medium degree.

70. Whilst the opponent filed evidence intended to demonstrate the use made of its ‘630 (‘CHAMPION’) mark, I have already dismissed a likelihood of confusion on the basis of that mark. Still, as I have found that much of the evidence demonstrates use of the opponent’s ‘312 mark, I will consider whether the distinctive character of that mark has been enhanced through use. In *CX02 Trade Mark*<sup>11</sup>, Professor Phillip Johnson, sitting as the Appointed Person, stated:

“39. Before looking at the issue relevant to this case, I will make a comment on this passage. I agree with the Hearing Officer that reputation in itself does not make a mark highly distinctive. However, while distinctiveness and reputation are different, the nature, factors, and evidence used to prove enhanced distinctiveness are the same as for reputation. Furthermore, reputation for the purposes of section 5(3) is a higher threshold than for acquired distinctiveness. In other words, if there is a reputation then distinctiveness should be enhanced. Where it fits on the distinctiveness scale after this enhancement is a question of fact in each individual case.”

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<sup>11</sup> BL-O-393-19

71. The opponent's evidence shows a significant turnover and a consistently high number of sales within the UK. The opponent's brand has been widely publicized by way of both sponsorships and advertisements in a number of high-profile publications. However, the opponent has not shown use in relation to any of the services where I have found similarity to exist and it is only whether the distinctiveness of the mark has been enhanced in relation to those particular services that is relevant to my assessment under section 5(2)(b). For that reason, I cannot conclude that the mark has acquired an enhanced distinctiveness, at least for the purposes of assessing a likelihood of confusion.

### **Likelihood of confusion**

72. When assessing the likelihood of confusion, I must adopt the global approach set out in the aforementioned case law and take account of my earlier conclusions. I must also keep in mind the average consumer of the services at issue and the nature of the purchasing process. It is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them retained in their mind (see *Lloyd Schuhfabrik Meyer*, paragraph 27).

73. There are two types of confusion: direct and indirect. The distinction between the two was summed up by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>13</sup>

“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 recognised 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’.

17. 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).”

74. I begin by considering a likelihood of direct confusion. Whilst I have found the respective marks visually similar to a medium degree, I must keep in mind that the average consumer is likely to apply a fairly high degree of attention to the selection process. The applicant’s mark contains an additional word of nine letters. Notwithstanding the allusive nature of the word ‘Marketing’, in my view, these factors suggest that the average consumer is unlikely to fall susceptible to the effects of the direct confusion; the marks will not simply be mistaken for one another.

75. I move now to consider indirect confusion. As above, ‘Champion’ is the most distinctive element in the respective marks and where the average consumer will attribute the greatest conceptual weight. This shared element, in my view, considering the closeness of the services and that the additional element in the applicant’s mark will be seen simply as an indication of the field in which the applicant operates, will move consumers to conclude

that the marks originate from the same, or at least a related, undertaking. In other words, indirect confusion will occur.

76. The opposition under section 5(2)(b) has been successful.

### **Section 5(3)**

77. The relevant case law pertaining to 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*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68;

whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

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

78. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of

the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and/or services be similar, although the relative distance between them is one of the factors which must be considered in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the date of the application; 7 September 2019.

## **Reputation**

79. For the purpose of section 5(3), the opponent relies upon the same marks and evidence as it did to support its opposition under section 5(2)(b) of the Act. However, as set out above, under this ground, the opponent is required to prove that its earlier mark has a reputation. Reputation in this context means that the earlier trade mark is known by a significant part of the public concerned with the goods or services covered by that mark.

80. My earlier assessment of the opponent's evidence led me to conclude that it had shown genuine use of its CHAMPION brand, with the evidence demonstrating use of both the '630 mark and '312 mark. Whilst I was unable to conclude that the marks' distinctiveness had been enhanced in relation to any of the services where similarity was engaged under section 5(2), the evidence, to my mind, indicates that the marks' distinctive character has been enhanced by virtue of the use made of it in respect of casualwear. The turnover of the opponent's brand is significant (notwithstanding a lack of clarification on the market share) and the goods sold under the brand have attracted high-profile sponsorships and been promoted through a number of mediums with wide-reaching audiences across the UK. I am satisfied, based on the evidence provided, that a significant part of the relevant public would be aware of the opponent's mark and, weighing my findings with the aforementioned case law, I find the applicant had accrued a strong reputation in the UK, at the relevant date, in respect of casualwear (comprising clothing, footwear and headgear). This being sufficient to establish a reputation in the EU as a whole, this element of the criteria is satisfied

## **Link**

81. My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

I have found the respective marks visually and aurally similar to a medium degree and conceptually similar to at least a high degree (if they are not identical).

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

When I limit the comparison to those goods for which the earlier mark has a reputation, I find the nature of the respective goods and services to be distinct and dissimilar. The opponent's goods are likely to be selected by the general public. The services for which registration is sought, though *available* to the general public, are likely to attract, at least predominantly, professional bodies.

The strength of the earlier mark's reputation

The opponent's mark has a reasonably strong reputation in the UK in respect of casualwear.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

The earlier mark has a medium degree of inherent distinctive character which has been enhanced to a high degree through use (in relation to the aforementioned goods).

Whether there is a likelihood of confusion

I have found a likelihood of confusion in relation to some of the services for which the opponent's earlier marks are registered. However, as mentioned earlier in my decision, I do not consider there to be a likelihood of confusion in respect of the goods in respect of which the opponent has shown a reputation, specifically casualwear.

82. Weighing all factors, in my view, the respective goods and services are sufficiently far apart here, with the applicant's mark stipulating an area of operation (i.e. Marketing), that a member of the relevant public encountering the applicant's mark will not bring the earlier mark to mind to any meaningful degree, at least not to the extent that damage may follow. Whilst I keep in mind the strength of the opponent's reputation, any bringing to mind which occurs here will be fleeting. The disparity of the goods and services is, in my view, sufficient to offset any similarities that exist between the marks, and indeed the strength of the opponent's reputation. Consequently, any link consumers do make will be dismissed almost instantly. On that basis, I can see no way for such a link to cause any damage to the earlier mark's reputation and distinctive character nor for it to give an unfair advantage to the later mark; the link will simply be too weak. Consequently, the section 5(3) ground fails.

## **Conclusion**

**83. The opposition has succeeded under section 5(2)(b) and failed under section 5(3). In the absence of any successful appeal, the application will be refused.**

84. The opponent has succeeded and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 2/2016. I award costs as follows:

Official fee	£100 <sup>12</sup>
Preparing a statement and considering the other side's statement	£200
Preparing evidence	£600

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<sup>12</sup> I make an award of £100 to reflect that the opponent has succeeded in respect of section 5(2) only.  
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Preparation of submissions in lieu of a hearing                      £200

**Total** 

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 **£1100**

100. I order Kerry-Ann Levy to pay Champion Products Europe Limited the sum of £1100. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings (subject to any order of the appellate tribunal).

**Dated this 14th day of May 2021**

**Laura Stephens**  
**For the Registrar**