

O-396-21

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3438538
BY KENSULATE HOLDINGS LIMITED
TO REGISTER THE TRADE MARK
CREPSLOCKER
IN CLASSES 14 & 18**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 419534 BY
RIN INTELLECTUAL PROPERTY LIMITED**

BACKGROUND

1) On 23 October 2019, Nazir Moosa Patel applied to register the trade mark CREPSLOCKER in respect of the following goods:


In Class 14: Amulets being jewellery; Amulets [jewellery]; Amulets [jewellery, jewelry (Am.)]; Amulets [jewelry]; Anchors [clock and watch making]; Articles of imitation jewellery; Articles of jewellery; Articles of jewellery coated with precious metals; Articles of jewellery made from rope chain; Articles of jewellery made of precious metal alloys; Articles of jewellery made of precious metals; Articles of jewellery with ornamental stones; Articles of jewellery with precious stones; Artificial jewellery; Atomic clocks; Automatic watches; Badges of precious metal; Barrels [clock and watch making]; Beads for making jewellery; Boxes for cufflinks; Boxes of precious metal; Bracelet charms; Bracelets; Bracelets and watches combined; Bracelets for watches; Bracelets [jewellery]; Brooches [jewellery]; Buckles for watchstraps; Cases for clock and watch-making; Cases for jewels; Cases for watches; Chains [jewellery, jewelry (Am.)]; Charms; Chronographs [watches]; Chronometers; Chronometrical instruments; Chronoscopes; Clock cases; Clock faces; Clock hands; Clocks; Clocks and watches; Clockworks; Cloisonné jewellery; Cloisonné jewellery [jewelry (Am.)]; Coins; Copper tokens; Cuff links; Cuff links and tie clips; Cufflinks; Dials [clock and watch making]; Diamonds; Earrings; Gold; Gold thread [jewellery]; Gold thread [jewellery, jewelry (Am.)]; Gold, unwrought or beaten; Hat ornaments of precious metal; Ingots of precious metals; Iridium; Ivory [jewellery, jewelry (Am.)]; Jet, unwrought or semi-wrought; Jewellery; Jewellery boxes; Jewellery cases; Key rings; Key rings [trinkets or fobs]; Locketts [jewellery, jewelry (Am.)]; Master clocks; Medals; Movements for clocks and watches; Necklaces; Necklaces [jewellery]; Necklaces [jewellery, jewelry (Am.)]; Ornamental pins; Ornaments [jewellery]; Ornaments of jet; Osmium; Palladium; Paste jewellery; Pearls; Pearls made of ambroid [pressed amber]; Pendulums [clock and watch making]; Pins [jewellery]; Pins [jewellery, jewelry (Am.)]; Platinum; Precious metals; Precious metals, unwrought or semi-wrought; Precious stones; Rhodium; Rings [jewellery]; Ruthenium; Semi-precious stones; Shoe ornaments of precious metal; Silver thread; Silver, unwrought or beaten; Spinel [precious stones]; Spun silver [silver wire]; Statues of precious metal; Statuettes of precious metal; Stop watches; Sun dials; Tie clips; Watch bands; Watch cases; Watch chains; Watch glasses; Watch springs; Watches; Wire of precious metal [jewellery, jewelry (Am.)]; Works of art of precious metal; Wrist watches.

In Class 18: Animal skins; Bags; Belt bags; Belt bags and hip bags; Belt pouches; Belts (Leather shoulder -); Boot bags; Brief cases; Briefcases and attache cases; Cosmetic bags; Credit card cases; Credit card holders; Fashion handbags; Hand bags; Handbags, purses and wallets; Harness; Hides; Holdalls; Leather and imitations of leather; Luggage; Parasols; Pocket wallets; Pocketbooks; Purses;

Ruck sacks; Saddlery; Shoe bags; Sport bags; Sports bags; Suitcases; Umbrellas; Walking sticks; Wallets.

2) The trade mark was subsequently assigned to Kensulate Holdings Limited (hereinafter the applicant). The application was examined and accepted, and subsequently published for opposition purposes on 22 November 2019 in Trade Marks Journal No.2019/047.

3) On 17 February 2020 RIN Intellectual Property Ltd (hereinafter the opponent) filed a notice of opposition, subsequently amended. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
Crep Protect	EU 13175005	14.08.14 03.12.14	3	Leather and shoe cleaning and polishing preparations; Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Boot cream; Boot polish; Waterproofing sprays for footwear.
			25	Clothing, footwear, headgear.
			26	Shoe laces; Boot laces; Laces for footwear; Shoe buckles; Stud buttons [fasteners] for shoes.
Creps	UK 3068415	13.08.14 14.11.14	25	Clothing, footwear, headgear.
 Colour Claimed : black, white, gold and grey.	EU 12434403	16.12.13 08.05.14	3	Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Waterproofing sprays for footwear.
			18	Leather and imitations of leather; Trunks and travelling bags; Beach bags; Bum bags; Clutch bags; Belt bags and hip bags; Sport bags; Duffle bags; Leather bags; Sling bags; Luggage; Rucksacks; Backpacks; Laptop bags; Leather.
			25	Clothing, footwear, headgear.

			26	Shoe laces; Boot laces; Laces for footwear; Stud buttons [fasteners] for shoes.
			40	Fabric waterproofing; Textile and fabric treating.

4) The grounds of opposition are, in summary:

- a) The opponent contends that its marks above and the mark applied for are very similar and that the goods and services of the two parties are identical and / or similar. As such the mark in suit offends against Section 5(2)(b) of the Act. This ground was amended at the hearing as I shall reflect in my decision.
- b) The opponent also contends that it has a considerable reputation in its EU12434403 mark in respect of the goods and services for which it is registered. It states that the similarity between the marks and businesses is such that there is a likelihood of consumers assuming a link. It contends that this will enable the applicant to take unfair advantage of the opponent's reputation and free ride on its investment in promoting and advertising the brand. Use of the mark in suit will dilute and tarnish the reputation of the opponent. It contends that the mark in suit offends against section 5(3) of the Act.

5) On 13 July 2020 the applicant filed a counterstatement, in which it puts the opponent to strict proof of use of its marks in respect of clothing, footwear, headgear; trunks and travelling bags, bum bags, clutch bags, hip bags, sports bags, duffle bags, sling bags, luggage, rucksacks, backpacks and laptop bags. The opponent denies the grounds of opposition, stating that the marks and goods of the two parties are not similar. It denies that the opponent can have the goodwill and reputation claimed.

6) The opponent is professionally represented, whilst the applicant has its own internal legal department. Both seek an award of costs in their favour; only the opponent filed evidence. The matter came to be heard on 21 April 2021 when the opponent was represented by Mr Beebe of Counsel instructed by Messrs Lawdit Solicitors Limited; the applicant was represented by Mr Jamal an in-house legal adviser.

OPPONENT'S EVIDENCE

7) The opponent filed a witness statement, dated 22 October 2020, by Nohman S Ahmed a director of the opponent company. He states that since 2014 the opponent has run a business which has substantial exposure and is recognised as the creator of the leading products in the shoe care industry. He states that the opponent sells to shoe industry giants and also holds worldwide licences for Adidas shoe care, manufacturing and selling shoe care under the Adidas brand name, it also holds licences with the National Basketball Association (NBA) and New Era. He states: “The opponent [sic] sales figures to UK customers are as follows:

Year	Sales £ million
September 2014 -February 2016	2.5
March 2016-February 2017	2.8
March 2017- February 2018	4.6
March 2019 – February 2019	5.2

8) Mr Ahmed provides the following exhibit:

- NA1: Pages 1-23 copies of pages from the internet which shows examples of products which have the EU mark 12434403 upon them. The goods shown are products for cleaning shoes, shoe trees, laces and insoles. Most show a copyright date of 2019 and a price in UK£. Page 3 of this exhibit shows a zipped case with a brush, a can of cleaning product and a cloth. The price shown is £14. The case shows the logo of the NBA and also the opponent’s mark 12434403.
- NA1: pages 24-27 Shows the company listed in the FT 2019 1000 European fastest growing companies, and the Sunday Times 2018 Fastest growing companies.
- NA1: Pages 33-37: These show a sneaker cleaning service at an Adidas UK store in London. The counter, staff uniforms and products all have both the opponent’s mark EU 12434403 and also the Adidas trade mark upon them, with the Adidas being in the most prominent position.
- NA1: pages 38-44The opponent sponsors two football teams Rochdale and Oxford United.

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

DECISION

10) 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.

11) The first ground of opposition is under section 5(2)(b) which reads:

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

(a)

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

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

12) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

13) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The opponent has put the opponent to strict proof of use. The proof of use requirements state:

“(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 –

(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.”

14) The application date, and therefore the relevant date, is 23 October 2019. The proof of use period is 24 October 2014 - 23 October 2019. Only the opponent’s EU mark 12434403 was registered before the relevant period and so only this mark has to meet the proof of use requirements. The opponent can rely upon its registered specifications in full for marks EU 13175005 and UK 3068415. The opponent’s trade mark EU 12434403 is registered for the following goods:

- In Class 3: Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Waterproofing sprays for footwear.
- In Class 18: Leather and imitations of leather; Trunks and travelling bags; Beach bags; Bum bags; Clutch bags; Belt bags and hip bags; Sport bags; Duffle bags; Leather bags; Sling bags; Luggage; Rucksacks; Backpacks; Laptop bags; Leather.
- In Class 25: Clothing, footwear, headgear.
- In Class 26: Shoe laces; Boot laces; Laces for footwear; Stud buttons [fasteners] for shoes.
- In Class 40: Fabric waterproofing; Textile and fabric treating.

15) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (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 Bundervsvereinigung 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 Marken 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].”

16) In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

17) In the instant case the opponent’s mark EU 12434403 is registered for the goods and services shown at paragraph 14 above. However, in its counterstatement the applicant only sought proof of use of the opponent’s mark in respect of clothing, footwear, headgear; trunks and travelling bags, bum bags, clutch bags, hip bags, sports bags, duffle bags, sling bags, luggage, rucksacks, backpacks

and laptop bags. For its part the opponent is not relying upon the whole of its registered specification under this trade mark (paragraph 7 of its skeleton refers). It is only relying upon the following:

- In Class 3: Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Waterproofing sprays for footwear.
- In Class 18: Trunks and travelling bags; Leather bags;
- In Class 26: Shoe laces; Laces for footwear;
- In Class 40: Fabric waterproofing; Textile and fabric treating.

18) Because the applicant did not seek proof of use on all the above the opponent can rely upon its registered specification in respect of all of the above with the exception of “Trunks and travelling bags” in class 18. In considering the evidence provided I shall restrict my review in relation to these goods only. The opponent has provided sales figures which average approximately £4million per annum. However, the opponent gives no breakdown into classes or goods. The only evidence of use relates to a small cleaning kit which comes in a zipped case which contains a brush, a can of cleaning product and a cloth. The price shown is £14. The case shows the logo of the NBA and also the opponent’s mark 12434403. To my mind, this does not constitute evidence of making a market in travelling bags or trunks. The opponent cannot rely upon these goods in the comparison test. In the **comparison tests the opponent can only rely upon its mark EU12434403 in respect of:**

- In Class 3: Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Waterproofing sprays for footwear.
- In Class 18: Leather bags;
- In Class 26: Shoe laces; Laces for footwear;
- In Class 40: Fabric waterproofing; Textile and fabric treating.

19) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95,

Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

The average consumer and the nature of the purchasing decision

20) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

21) At the hearing Mr Beebe clarified that the ground of opposition under section 5(2)(b) was no longer being pursued against the class 14 goods applied for by the applicant. Therefore, the goods at issue in these proceedings are, broadly speaking, bags, luggage and leather goods. The average consumer for such goods will be the public at large (including businesses). Such goods will typically be sold via retail outlets and on the internet, which may include orders being placed by telephone. I must also take into account personal recommendations. The selection process is likely to be

predominantly a visual one, although I accept that aural considerations will also play their part. Turning now to the level of attention the average consumer will display when selecting the goods. The cost of these goods will vary enormously from a purse costing a few pounds to enormously expensive luggage such as that produced by certain fashion houses. The attention span will vary accordingly. All of these items have a practical use, whilst most will also be purchased based on their decorative nature. The average consumer will be concerned to ensure that they meet their practical and aesthetic requirements and so are likely **to pay at least an average level of attention to the selection of the goods in class 18 at issue.**

Comparison of goods

22) I must compare the applicant's goods in class 18 to the opponent's goods. For ease of reference the goods to be compared are as follows:

Applicant's goods	Opponent's
In Class 18: Animal skins; Bags; Belt bags; Belt bags and hip bags; Belt pouches; Belts (Leather shoulder -); Boot bags; Brief cases; Briefcases and attache cases; Cosmetic bags; Credit card cases; Credit card holders; Fashion handbags; Hand bags; Handbags, purses and wallets; Harness; Hides; Holdalls; Leather and imitations of leather;	EU 13175005: Class 3: Leather and shoe cleaning and polishing preparations; Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Boot cream; Boot polish; Waterproofing sprays for footwear. Class 25: Clothing, footwear, headgear. Class 26: Shoe laces; Boot laces; Laces for footwear; Shoe buckles; Stud buttons [fasteners] for shoes.
Luggage; Parasols; Pocket wallets; Pocketbooks; Purses; Ruck sacks; Saddlery; Shoe bags; Sport bags; Sports bags; Suitcases; Umbrellas; Walking sticks; Wallets.	EU12434403 Class 3: Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Waterproofing sprays for footwear. Class 18: Leather bags; Class 26: Shoe laces; Laces for footwear;

	Class 40: Fabric waterproofing; Textile and fabric treating.
	UK 3068415: Class 25: Clothing, footwear, headgear.

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

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

24) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

25) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

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

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

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

Whilst on the other hand:

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

27) In considering whether there is any similarity between the opponent’s goods in classes 3 and 25 and the applicant’s class 18 goods I take into account the comments in *Gitana SA, v OHIM*, Case T-569/11, where the General Court stated that:

“45. Moreover, in respect of the relationship between the ‘goods in leather and imitations of leather’ in Class 18 covered by the trade mark sought and the goods in Class 25 covered by

the earlier mark, it is apparent also from settled case-law that the ‘goods in leather and imitations of leather’ include clothing accessories such as ‘bags or wallets’ made from that raw material and which, as such, contribute, with clothing and other clothing goods, to the external image (‘look’) of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased. Furthermore, the fact that those goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and support the impression that the same undertaking is responsible for the production of those goods. It follows that some consumers may perceive a close connection between clothing, footwear and headgear in Class 25 and certain ‘goods made of these materials [leather and imitations of leather] and not included in other classes’ in Class 18 which are clothing accessories. Consequently, clothing, shoes and headgear in Class 25 bear more than a slight degree of similarity to a category of ‘goods made of these materials [leather and imitations of leather] and not included in other classes’ in Class 18 consisting of clothing accessories made of those materials (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 42 above, paragraphs 49 to 51; paragraph 32; and *GIORDANO*, paragraph 42 above, paragraphs 25 to 27).”

28) The opponent provided a list of the goods covered by its registrations and stated whether it considered them similar and to what degree. However, the only explanation as to why it believed they were similar was set out in its skeleton shown below:

“28. First, the goods and services are complementary in that they are intended to be used together, this close connection is such that the average consumer is likely to think that responsibility for the goods or services lies with the same or an economically connected undertaking. By way of example, goods such as leather and shoe cleaning and polishing preparations or services such as fabric waterproofing or textile and fabric treatment are complementary to leather goods, which includes each of the types of bags for which registration is sought (there being no limitation to products other than leather), as well as other leather products, namely, animal skins; harness; hides; leather and imitations of leather; saddlery, which can be treated by complementary care products and services. This close connection between the goods makes it likely that the average consumer will think that the responsibility for those goods/services lies with the same or economically connected undertakings.

29. Second, in many respects, the goods would usually be sold through the same trade channels (for example, being sold in the same stores):

(1) In some cases this is because of similar types of goods. Many of the goods for which registration is sought for the Applicant's Marks are accessories to footwear, such as boot bags or shoe bags and would appear in the same section of a store as the goods bearing the Earlier Marks, for example, leather and shoe cleaning and polishing preparations or shoe laces. Another example is the trunks and travelling bags of the 403 Mark would likely to be found in the same section of the bags (of all types) for which registration is sought.

(2) In other cases, it is because a store would be expected to stock both categories of goods – for example, a store selling footwear would be expected to also sell care products for footwear, such as boot bags or shoe bags or a store selling clothing would be expected to also sell belts or bags (of all the types for which registration is sought).

30. Third, the respective users of the goods are the same.”

29) The opponent contends that its cleaning products are complementary to leather goods as they are designed to clean /treat such goods. The fact that the cleaning product is designed for leather goods does not mean that the opponent's cleaning products are indispensable to the applicant's leather goods. Many leather goods such as bags, wallets, belts etc will never have specific leather cleaning products used upon them. Further, even if they are cleaned or treated by such a product most consumers will not assume a connection between the manufacturers. One of the main suppliers of shoe polish in the UK is Cherry Blossom but no-one assumes that they also make shoes. The opponent has provided no evidence that consumers will assume otherwise. According to the opponent's chart, shoe/boot bags are similar to footwear, laces, shoe cleaning products and waterproofing services. However, it offers no evidence that consumers will assume that these goods are from the same manufacturer, and they are not indispensable to one another. I do not accept that one automatically purchases a shoe bag every time one is in a shoe shop purchasing shoes. Nor do I accept that even if that were the case, that the consumer would assume they were from the same point of origin. The fact that many of the items would be sold in the same store to the same consumers is not determinative in this matter. **To my mind there is no similarity between the opponent's classes 3 and 26 products or class 40 services and the class 18 goods of the applicant.**

30) Turning to consider the similarity between the applicant's class 18 goods and the class 25 goods of the opponent I conclude that the applicant's specification has items which "contribute, with clothing and other clothing goods, to the external image ('look') of the consumer concerned, that is to say coordination of its various components at the design stage or when they are purchased." Those items are: Bags; Belt bags; Belt bags and hip bags; Belt pouches; Belts (Leather shoulder -); Fashion handbags; Hand bags; Handbags, purses and wallets; Leather and imitations of leather; Pocketbooks; Purses; Credit card cases; Credit card holders; Pocket wallets; Shoe bags; Wallets. **I therefore regard these items in the applicant's specification as similar to the opponent's class 25 goods to a low degree.** However, within the applicant's class 18 specification there are a number of items which do not, in my opinion, contribute to the external look of the consumer. These items are: Animal skins; Boot bags; Brief cases; Briefcases and attache cases; Cosmetic bags; Harness; Hides; Holdalls; Luggage; Parasols; Ruck sacks; Saddlery; Sport bags; Sports bags; Suitcases; Umbrellas; Walking sticks. **I therefore regard these items in the applicant's specification as not similar to the opponent's class 25 goods.**

31) Lastly, I consider the class 18 goods of the opponent "Leather bags" to the applicant's class 18 goods. In its submissions the opponent made no mention of its views on the similarity of the applicant's goods to its leather bags. I must therefore consider the matter as best I can in the absence of comment. I have to accept that all of the applicant's goods in class 18 (with the exception of Parasols, Umbrellas and Walking sticks) can be made of leather. It is also unarguable that the term "leather bag" would encompass the following items in the applicant's specification "Bags; Belt bags; Belt bags and hip bags; Belt pouches; Boot bags; Brief cases; Briefcases and attache cases; Cosmetic bags; Credit card cases; Credit card holders; Fashion handbags; Hand bags; Handbags, purses and wallets; Holdalls; Pocket wallets; Pocketbooks; Purses; Ruck sacks; Shoe bags; Sport bags; Sports bags; Luggage; Suitcases & Wallets". Whilst such items can and are made from materials other than leather, **they must be regarded as identical to the opponent's "leather bags"**. Similarly, "Animal skins; Hides; Leather and imitations of leather" are the raw materials for leather bags **and are therefore highly similar**. Whilst "Belts (Leather shoulder -); Harness; Saddlery" are traditionally also made from leather they tend to be sold in outlets which specialise in equestrian goods in the case of harness & saddlery, or clothing shops in the case of leather shoulder belts. The consumers will not necessarily be the same as those for leather bags, their uses are quite different, and they will have different trade channels. **These goods are not similar to the opponent's leather bags. For much the same reasons the applicant's parasols, umbrellas and walking sticks are not similar to the opponent's leather bags.**

32) For the sake of clarity, the table below shows whether the goods and services of the two parties have any degree of similarity.

Applicant's goods	Opponent's goods	Result
All of class 18	<p>EU 13175005: Class 3: Leather and shoe cleaning and polishing preparations; Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Boot cream; Boot polish; Waterproofing sprays for footwear.</p> <p>EU12434403: Class 3: Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Waterproofing sprays for footwear.</p>	<p>No similarity</p> <p>No similarity</p>
Bags; Belt bags; Belt bags and hip bags; Belt pouches; Boot bags; Brief cases; Briefcases and attache cases; Cosmetic bags; Credit card cases; Credit card holders; Fashion handbags; Hand bags; Handbags, purses and wallets; Holdalls; Pocket wallets; Pocketbooks; Purses; Ruck sacks; Shoe bags; Sport bags; Sports bags; Luggage; Suitcases & Wallets	EU12434403: Class 18: Leather bags	Identical
Animal skins; Hides; Leather and imitations of leather	EU12434403: Class 18: Leather bags	Highly similar
"Belts (Leather shoulder -); Harness; Saddlery; parasols, umbrellas and walking sticks	EU12434403: Class 18: Leather bags	No similarity


Bags; Belt bags; Belt bags and hip bags; Belt pouches; Belts (Leather shoulder -); Fashion handbags; Hand bags; Handbags, purses and wallets; Leather and imitations of leather; Pocketbooks; Purses; Credit card cases; Credit card holders; Pocket wallets; Shoe bags; Wallets.	EU 13175005: Class 25: Clothing, footwear, headgear. UK 3068415: Class 25: Clothing, footwear, headgear.	Low degree of similarity Low degree of similarity
Animal skins; Boot bags; Brief cases; Briefcases and attache cases; Cosmetic bags; Harness; Hides; Holdalls; Luggage; Parasols; Ruck sacks; Saddlery; Sport bags; Sports bags; Suitcases; Umbrellas; Walking sticks.	EU 13175005: Class 25: Clothing, footwear, headgear. UK 3068415: Class 25: Clothing, footwear, headgear.	No similarity No similarity
All of class 18	EU 13175005: Class 26: Shoe laces; Boot laces; Laces for footwear; Shoe buckles; Stud buttons [fasteners] for shoes. EU12434403: Class 26: Shoe laces; Laces for footwear.	No similarity No similarity
All of class 18	EU12434403: Class 40: Fabric waterproofing; Textile and fabric treating.	No similarity

Comparison of trade marks

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

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

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

Opponent's earlier marks		Applicant's Mark
EU 13175005	Crep Protect	CREPSLOCKER
UK 3068415	Creps	
EU 12434403		

35) Although the word “crep” is not found in any dictionary it is claimed by the opponent in its statement of grounds to be a UK slang term for trainers. The applicant contends that the opponent’s mark is entirely descriptive. However, even if I were to agree with this view, which I do not, the opponent’s mark would have to be credited with at least a medium degree of distinctiveness on the basis that it is registered (see *Formula One Licensing BV v OHIM*, Case C-196/11P). I do not accept that the word “crep”, particularly when used in respect of goods other than footwear in class 25 or footwear related items would immediately be regarded as a reference to trainers. When the opponent’s marks are used on clothing for example, the fact that the word “crep” might be seen as meaning trainers does not describe an item of clothing unless it could be considered to be designed specifically to be used with a trainer.

36) The opponent submitted:

“42. The word CREPS in the case of the Applicant’s Mark and the 415 Mark and the word CREP in the 005 Mark and 403 Mark is the dominant and distinct element of the relevant marks.

43. This is particularly so in respect of many of the goods in class 18 for which registration is sought – specifically, any of the goods referring to ‘bags’ or similar objects – for example (but not limited to), belt bags, boot bags, cosmetic bags, hand bags, shoe bags and sports bags. It is important for the Tribunal to bear in mind that the word LOCKER in the Applicant’s Mark is non-distinctive and/or descriptive in respect of such goods. That is because the word LOCKER conveys a sense of safety or security – that one’s goods are safely secured or ‘locked’ in the bag. As defined in the Merriam-Webster Dictionary, the meaning of ‘locker’ includes:

“1a: a drawer, cupboard, or compartment that may be closed with a lock especially: one for individual storage use”.

44. The consequence of this is when comparing the Applicant’s Mark against the Earlier Mark in respect of such goods the average consumer would place little attention on this part of the Applicant’s Mark given its non-distinctive and/or descriptive nature. Further, and in any event, the word LOCKER is an ordinary English word and given the distinctiveness of the word CREPS the addition of the word LOCKER does little to distinguish.

Visual similarity

45. In the case of the Applicant’s Mark and the 415 Mark, the Applicant’s Mark entirely incorporates the word CREPS of the 415 Mark. The word LOCKER is descriptive in respect of many of the class 18 goods regarding bags and is otherwise an ordinary English word which does little to distinguish the Applicant’s Mark from the 415 Mark. It is well established that the average consumer pays more attention to the beginning of a mark than to the end of it and therefore it is submitted that the similarities between the Application and the Opponent’s marks are magnified. An average consumer is likely to recognise the identical nature of the beginning of the Applicant’s Mark as an indication that it is associated or endorsed by the Opponent.

46. Viewing the marks as a whole but bearing in mind the distinctive and dominant element, the 415 Mark is similar to a high degree to the Applicant's Mark.

47. Each of the 005 Mark and the 403 Mark are similar to a medium degree to the Applicant's Mark and the distinctive and dominant element of the 005 Mark and the 403 Mark being the word CREP is entirely incorporated into the Applicant's Mark.

Aural similarity

48. Both the Applicant's Mark and the 415 Mark are aurally identical to the first five letters of the Applicant's Mark. This has a significant impact on the overall impression give the distinctive nature of the word CREPS and the descriptive/non-distinctive nature of the ordinary English word LOCKER. When spoken by an average consumer, these marks both contain the word CREPS, which resonates a strong, distinct phonetic sound in reference to 'cr'.

49. The 415 Mark is aurally similar to a high degree. The 005 Mark and the 403 Mark are aurally similar to a medium degree.

Conceptual similarity

50. The Applicant's Mark and the 415 Mark each comprise a word which is not known to the average consumer and therefore carries with it no conceptual idea. Therefore, the marks are conceptually similar to a high degree. In the case of the 005 Mark and the 403 Mark, similarly, neither mark conveys a known conceptual idea and they are therefore conceptually similar to a high degree.

51. Insofar the Tribunal decides that the word CREP is perceived by the average consumer (in the absence of any such evidence) as a slang term for trainers, the conceptual message is nevertheless similar to a high degree."

37) I shall first compare the opponent's mark 3068415 to the mark in suit. The opponent's mark appears in full at the start of the mark in suit. There is clearly visual and aural similarity in the start of both marks due to them having the word "creps" at the beginning. The mark in suit then differs visually

and aurally in that it has the addition of the word “locker” which does not appear in the opponent’s mark. Conceptually, if the average consumer is aware of the slang term “creps” meaning “trainers” then both marks will have the same connotation, the exception being that the mark in suit will conjure an image of a lockable storage facility for said trainer. If the consumer is unaware of the term “creps” then there are, to my mind, two possibilities. They will either consider the word locker to mean a secure storage for “creps” whatever they maybe, or they will believe that it is a new form of storage facility in which case there is a conceptual difference. **Overall, the similarities outweigh the differences such that the opponent’s mark 3068415 must be considered to be similar to at least a medium to high degree to the mark in suit.**

38) Clearly, the opponent’s marks 13175005 and 12434403 share the same words, the only difference being that mark 12434403 has the words in a slightly stylised font and this mark also has an unremarkable device element that to my mind does not amend the nature of the mark. Both of the opponent’s marks start with the word “crep” which compares to the plural form of the word in the applicant’s mark (Crepes). The opponent’s marks both have the word “protect” whereas the applicant’s mark has the term “locker”. The visual and aural similarities and differences are obvious. Conceptually, as stated earlier the mark in suit will conjure an image of a lockable storage facility for trainers, whereas the opponent’s marks suggest some form of protection for said trainers. Again, if the consumer is not aware of the meaning of the slang term, then they will either consider the word locker to mean a secure storage for “creps” whatever they maybe, or they will believe that it is a new form of storage facility. The same consumer would view the opponent’s marks as protecting a “crep”, and so there is a degree of conceptual similarity. **Overall, the opponent’s marks 13175005 and 12434403 are similar to the mark in suit to a low to medium degree.**

Distinctive character of the earlier trade mark

39) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

40) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

41) The opponent’s three marks consist of the words “CREPS” and CREPS PROTECT (in one instance solus, the other it has a device element). The opponent’s goods in class 3 and 26 are

orientated entirely to shoe related goods, whereas the goods in classes 18 and 25 and the services in class 40 all include footwear items or services amongst other uses. The term “creps”, by the opponent’s own admission, is a slang term for trainers. The term “protect” is clearly a descriptive word when used with the class 40 services of waterproofing services or the class 3 products which clean and protect the shoes. Therefore, when any of the opponent’s marks are used upon goods or services which are footwear related, the marks are highly descriptive and therefore inherently distinctive to a very low degree. I cannot regard them as having no inherent distinctiveness as they are registered marks (see *Formula One Licensing BV v OHIM*, Case C-196/11P). I accept that for goods such as clothing and bags (other than for shoes) the mark is inherently distinctive to an average degree. The opponent has filed little evidence of use. The opponent’s marks are registered for a wide range of goods and services and has provided sales figures which average approximately £4million per annum. **However, the opponent gives no breakdown into classes or goods. As such it cannot benefit from enhanced distinctiveness through use.**

Likelihood of confusion

42) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- The average consumer will be concerned to ensure that they meet their practical or aesthetic requirements and so are likely to pay at least an average level of attention to the selection of the goods in class 18 at issue.
- Overall, the marks of the two parties are similar to at least a medium degree.

- The opponent’s marks are inherently distinctive to an average degree at best, but on some goods and services this reduces to a very low degree of inherent distinctiveness, none of the marks can benefit from enhanced distinctiveness through use.
- Overall, the opponent’s mark 3068415 must be considered to be similar to at least a medium to high degree to the mark in suit, whilst the opponent’s marks 13175005 and 12434403 are similar to the mark in suit to a low to medium degree.

Applicant’s goods	Opponent’s goods	Result
All of class 18	EU12434403: Class 3: Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Waterproofing sprays for footwear.	No similarity
Bags; Belt bags; Belt bags and hip bags; Belt pouches; Boot bags; Brief cases; Briefcases and attache cases; Cosmetic bags; Credit card cases; Credit card holders; Fashion handbags; Hand bags; Handbags, purses and wallets; Holdalls; Pocket wallets; Pocketbooks; Purses; Ruck sacks; Shoe bags; Sport bags; Sports bags; Luggage; Suitcases & Wallets	EU12434403: Class 18: Leather bags	Identical
Animal skins; Hides; Leather and imitations of leather	EU12434403: Class 18: Leather bags	Highly similar
“Belts (Leather shoulder -); Harness; Saddlery; parasols, umbrellas and walking sticks	EU12434403: Class 18: Leather bags	No similarity

<p>Bags; Belt bags; Belt bags and hip bags; Belt pouches; Belts (Leather shoulder -); Fashion handbags; Hand bags; Handbags, purses and wallets; Leather and imitations of leather; Pocketbooks; Purses; Credit card cases; Credit card holders; Pocket wallets; Shoe bags; Wallets.</p>	<p>EU 13175005: Class 25: Clothing, footwear, headgear.</p> <p>UK 3068415: Class 25: Clothing, footwear, headgear.</p>	<p>Low degree of similarity</p> <p>Low degree of similarity</p>
<p>Animal skins; Boot bags; Brief cases; Briefcases and attache cases; Cosmetic bags; Harness; Hides; Holdalls; Luggage; Parasols; Ruck sacks; Saddlery; Sport bags; Sports bags; Suitcases; Umbrellas; Walking sticks.</p>	<p>EU 13175005: Class 25: Clothing, footwear, headgear.</p> <p>UK 3068415: Class 25: Clothing, footwear, headgear.</p>	<p>No similarity</p> <p>No similarity</p>
<p>All of class 18</p>	<p>EU 13175005: Class 3: Leather and shoe cleaning and polishing preparations; Shoe sprays; Shoe wax; Shoe polishes; Shoe cleaners [preparations]; Boot cream; Boot polish; Waterproofing sprays for footwear.</p> <p>Class 26: Shoe laces; Boot laces; Laces for footwear; Shoe buckles; Stud buttons [fasteners] for shoes.</p>	<p>No similarity</p> <p>No similarity</p>
<p>All of class 18</p>	<p>EU12434403:</p> <p>Class 26: Shoe laces; Laces for footwear.</p> <p>Class 40: Fabric waterproofing; Textile and fabric treating.</p>	<p>No similarity</p> <p>No similarity</p>

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43) I take into account the views expressed in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

45) I also note that a degree of similarity in the goods of the two parties is essential. This was stated in *Waterford Wedgwood plc v OHIM – C-398/07 P* (CJEU) and also in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that:

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

46) From the above it is clear, in respect of all three of the opponent’s marks, that where I have determined that there is no similarity between the goods and services of the two parties the opposition

must fail. However, where there is identity or a high degree of similarity between the goods and a low to medium degree of similarity between the marks, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being directly confused into believing that the goods applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. Equally where there is a low degree of similarity of the goods but a medium to high degree of similarity of marks there is also a likelihood of direct confusion. The opponent under section 5(2)(b) therefore succeeds against the following goods in class 18:

Bags; Belt bags; Belts (Leather shoulder -); Belt bags and hip bags; Belt pouches; Boot bags; Brief cases; Briefcases and attache cases; Cosmetic bags; Credit card cases; Credit card holders; Fashion handbags; Hand bags; Handbags, purses and wallets; Holdalls; Pocket wallets; Pocketbooks; Purses; Ruck sacks; Shoe bags; Sport bags; Sports bags; Luggage; Suitcases & Wallets; Animal skins; Hides; Leather and imitations of leather.

47) The opposition in relation to the following items in class 18 fails as there is no prospect of direct or indirect confusion due to the absence of any similarity with the opponent's goods or services.

In Class 18: Harness; Parasols; Saddlery; Umbrellas; Walking sticks.

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

“(3) A trade mark which-

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

49) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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* and *Environmental Manufacturing, paragraph 34*.

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction

of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

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

50) I must first consider whether the opponent has shown it has the requisite reputation. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

51) The evidence filed by the opponent is scant to say the least and is far from overwhelming. Whilst it has turnover figures, it does not state specifically the mark or the goods or services to which these figures relate. The opponent has three marks registered, and they are registered for a wide range of goods such as clothing, footwear, headgear, leather goods and cleaning products. There is no evidence of sales of any of these goods other than show cleaning products, and possibly a trainer cleaning service. I also note that the opponent uses other parties' marks on its products before its own marks. Given that its marks are descriptive for shoes and shoe cleaning products, even allowing for the *Formula 1* case, it is not clear if the average consumer would view the opponent's mark on the product as merely informative as to what the product does whilst the initial mark such as Adidas indicates the origin of the product. **The opponent therefore fails at the first hurdle.**

52) In case I am wrong in the above view I next turn to consider whether the average consumer will make the necessary link between the marks of the two parties. In carrying out this comparison I am aware that the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion (*Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P). Earlier in this decision I determined that the marks of the two parties had a degree of similarity, but also found that the opponent's marks all had a very low level of distinctiveness when used on shoes or shoe cleaning / treating services. I am aware that because the marks are registered they must be considered to have a degree of distinctiveness (see *Formula One Licensing BV v OHIM*, Case C-196/11P). To my mind, the opponent's mark has such a low level of distinctiveness for the goods and services which it has shown any use at all upon that the average consumer would not make a link to the mark in suit. The ground of opposition therefore fails at the second hurdle as well as the first.

53) Lastly, I turn to the ground of opposition under section 5(4)(a) which reads:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

54) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

55) Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

56) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

57) The relevant date is therefore 23 October 2019. I have commented earlier in this decision about the paucity of evidence of use provided by the opponent. To my mind the opponent has not shown that it has goodwill in the UK under any of its marks, as at this date. The opposition under this ground therefore fails.

58) In case I am wrong in the above finding I will continue to consider whether there would be misrepresentation. Given the evidence of use filed the only possible goods and services that the opponent could claim goodwill in are shoe cleaning products and services. I have previously commented that the marks of the opponent are descriptive of such goods and services. As such there is no likelihood that a substantial number of the relevant public would be deceived. The opposition under section 5(4)(a) fails.

CONCLUSION

59) The opposition under Section 5(2)(b) is partly successful in respect of the following goods in class 18:

Bags; Belt bags; Belts (Leather shoulder -); Belt bags and hip bags; Belt pouches; Boot bags; Brief cases; Briefcases and attache cases; Cosmetic bags; Credit card cases; Credit card holders; Fashion handbags; Hand bags; Handbags, purses and wallets; Holdalls; Pocket

wallets; Pocketbooks; Purses; Ruck sacks; Shoe bags; Sport bags; Sports bags; Luggage; Suitcases & Wallets; Animal skins; Hides; Leather and imitations of leather.

60) The opposition under section 5(2)(b) fails in respect of the following goods in class 18:

Harness; Parasols; Saddlery; Umbrellas; Walking sticks.

61) The oppositions under grounds 5(3) and 5(4) fail in respect of all the goods in classes 14 & 18 applied for by the applicant.

COSTS

62) As the applicant has been mostly successful in defending its application it is entitled to a contribution towards its costs. As the applicant has represented itself in these proceedings, the Registry invited it to complete a proforma, setting out the time it had spent on particular activities. No proforma was returned by the applicant and so I make no award of costs.

Dated this 27th day of May 2021

George W Salthouse
For the Registrar,
the Comptroller-General