

O/831/21

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3509126
BY COVCO (H.K.) LIMITED
TO REGISTER:**

COVGUARD

**AS A TRADE MARK
IN CLASSES 9, 10 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 422062
BY INVOLVEX S.A**

Background and pleadings

1. On 7 July 2020, Covco (H.K.) Limited (“the applicant”) applied to register the trade mark “COVGUARD” in the UK. The application was accepted and published in the Trade Marks Journal on 14 August 2020 in respect of the following goods:

Class 9: *Protective clothing, headgear and footwear against accidents, injury, chemicals and irradiation; protective coveralls, protective gloves, protective smocks, protective aprons, protective beard covers, protective hairnets and hair coverings, protective over sleeves, protective visitors coats, protective shoe covers and protective face masks, all of the aforesaid goods against accidents, injury, chemicals and irradiation.*

Class 10: *Protective clothing, headgear and footwear for medical purposes; protective coveralls, protective gloves, protective smocks, protective aprons, protective beard covers, protective hairnets and hair coverings, protective over sleeves, protective visitors coats, protective shoe covers and protective face masks, all of the aforesaid goods for medical purposes.*

Class 25: *Laboratory coats.*

2. On 13 November 2020, Involvex S.A (“the opponent”) opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark:

COVERGUARD

EUTM: 7337207¹

Filing date 23 October 2008; registration date 27 May 2009

Relying on all goods, namely:

¹ Although the UK has left the EU and the EUTM relied upon by the opponent enjoys protection in the UK as a comparable trade mark, the EUTMs remains the relevant right in these proceedings. That is 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.

Class 9: *Footwear for protection against accidents, radiation and fire; protective goggles, eyeglasses, sports goggles, sunglasses.*

Class 24: *Blankets, travelling rugs, sleeping bags.*

Class 25: *Clothing, footwear, (except orthopaedic footwear), headgear.*

3. The opponent submits that there is a likelihood of confusion, including a likelihood of association, because the respective marks are similar, and the goods are either identical or similar.

4. The applicant filed a defence and counterstatement denying claims made and put the opponent to proof of use for its mark.

5. The opponent is represented by Mills & Reeve LLP; the applicant is represented by Carpmaels & Ransford LLP. Both parties filed evidence. No hearing was requested. Both parties filed submissions in lieu of a hearing. The decision is taken following a careful perusal of the papers.

6. 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 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.

Evidence

7. As set out above, both parties filed evidence. The opponent filed evidence in the form of a witness statement of Jean Seguy dated 29 March 2021. Mr Seguy is the Legal Director at Worldwide Euro Protection S.A (“WEP”), a position he has held since 2016. Mr Seguy’s statement sets out that WEP is the owner of the opponent. His statement is accompanied by 1 exhibit.

8. The applicant filed evidence in the form of a witness statement of Roger Lush dated 27 May 2021. Mr Lush is a Chartered UK Trade Mark Attorney and Partner at the applicant's representative. Mr Lush's statement is accompanied by 31 exhibits.

9. I do not propose to summarise the evidence or the parties' submissions in full at this stage. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

Preliminary Issue

10. I note that in its submissions, the opponent has submitted that :

“3.4 The Applicant has in its written submissions challenged the Opponent's evidence of use. However, the Applicant has not filed any evidence in reply nor has it requested a hearing at which it would have had the opportunity to cross-examine Mr Seguy. The Opponent therefore has been given no advance notice of the submissions made by the Applicant challenging its evidence of use and therefore has not been given the opportunity to address these submissions. The evidence of use adduced on behalf of the Opponent by Mr Seguy is not obviously incredible (on the contrary, it is entirely credible, and is supported by a statement of truth). It is therefore not open to the Applicant to invite the Tribunal to disbelieve or discount the Opponent's evidence of use.

3.5 Therefore, in relation to the Opposition, the Opponent's evidence of use must stand unchallenged and the use conditions referred to in Section 6A of the Act must be deemed to have been met.”

11. I note that, in its submissions, the applicant has stated that:

“3. The applicant's summary of the deficiencies in the opponent's proof of use is as follows:

(a) The proof of use must relate to the use by the opponent or by third parties authorised by the opponent. The opponent in this case is Invovex

S.A. (a Luxembourg entity). The proof of use has been submitted by way of a witness statement dated 29 March 2021 of Jean Seguy (JS), the legal director of a French entity called Worldwide Euro Protection S.A (WEP). WEP is claimed to be the parent company of the opponent. There is no proof of the relationship between the opponent and WEP.

(b) The proof of use contains a number of invoices, none of which have been issued by the opponent or even by WEP; in fact these have been issued by a number of other companies whose relationship to the opponent or authorisation to sell the goods by the opponent has not been disclosed much less proven.

(c) The catalogue of goods that is relied on is undated, the opponent's name does not appear anywhere on the catalogues. The extent and whereabouts of the distribution (if any) of the catalogue is not discernible.

(d) Much of the proof of use relates to irrelevant goods, i.e. safety clothing in class 9 (which is not covered by the earlier registration) as opposed to normal clothing in class 25 (which is covered by the earlier registration).

12. For the avoidance of doubt, I am of the view that the applicant has not invited the Tribunal to disbelieve Mr Seguy's evidence but has instead, raised concerns with the sufficiency of the evidence provided, which it is entitled to do. This decision will be made on the balance of all the relevant factors and the weight of the evidence that has been provided by the opponent. The applicant has raised further issues with the opponent's proof of use evidence that I have taken into account and will address, as relevant, in the decision.

Proof of use

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or 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.”

14. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. I note that in its counterstatement, the applicant sought to put the opponent to proof of use of its mark because its mark completed its registration process more than 5 years before the date of the application in issue. Therefore, it is subject to proof of use pursuant to section 6A of the Act.

15. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A-(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 period of five years ending with the date of publication.

(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 mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application 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 Community 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.”

16. Section 100 of the Act is also relevant, which reads:

“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.”

17. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 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].”

18. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s mark is the 5-year period ending with the date of the application in issue i.e. 8 July 2015 to 7 July 2020.

19. As the earlier mark is an EUTM, the opponent must show use in the EU. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“the CJEU”) noted that:

“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.”²

20. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the mark

21. In *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

² Paragraph 36.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

22. Throughout its evidence, the opponent has used its mark in a number of ways. These are shown below:

Example 1:



Example 2:



Example 3:



Example 4:



Example 5:



Example 6:



Example 7:



23. The opponent's mark is a word only mark that is registered in black and white. I am of the view that the use of the word 'COVERGUARD' in the above examples are in line with the notional fair use of the mark as registered. As per the case of *Colloseum*, use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. In my view, the addition of the device elements in the marks shown above means that the use of the opponent's mark is as part of a composite mark. Despite being used as part of a composite mark, I consider that the 'COVERGUARD' element will be perceived independently and continue to be viewed as indicative of the origin of the goods at issue. Even taking into account the additional words and or numbers, I do not consider that these alter the distinctive character of the mark to the point that it would not be considered use of the mark as registered. Throughout all uses shown above, the word 'COVERGUARD' remains the primary indication of origin for the goods. As a result, and in accordance with *Colloseum*, I consider the marks shown above are all examples of use of the opponent's mark as registered.

24. Even for those marks wherein the word 'COVERGUARD' is split into two words, with the word 'COVER' being placed on top of 'GUARD' (being examples 1 and 2), I do not consider that the presentation alters the distinctive character of the opponent's mark to the point where it would be considered use of the mark in a different form.³ The word 'COVERGUARD' is still present within the examples shown and retains its independent role, thereby remaining the primary indication of origin for the goods. As a result, the finding I have made at paragraph 23 above applies to these marks also.

Genuine use

25. As the opponent's evidence is given by a representative of WEP, the applicant submits that it should not be considered as evidence of use by the opponent. This is on the basis that WEP has provided no proof that they are the parent company of the opponent.⁴ The opponent's evidence sets out that it is a wholly owned subsidiary of WEP. The opponent also confirms that it designs, manufactures and distributes personal protective equipment under the 'COVERGUARD' brand for WEP. I have no reason to consider why this statement is untrue. Further, I note that the evidence is accompanied by a statement of truth. On this basis, I accept the evidence that the opponent is owned by WEP and given this relationship, I am prepared to accept that any use of the mark by WEP is use with the consent of the opponent.

26. The opponent has provided invoices within its evidence⁵ (that I discuss in more detail below) which the applicant submits are provided by companies that have not had their relationship to the opponent explained. Firstly, I note that some of the invoices are provided under the 'COVERGUARD' brand. Secondly, the evidence explains that on 20 January 2020, the opponent consolidated twelve of its historic brands under the 'COVERGUARD' mark. The brands that were consolidated included Coverguard footwear, Coverguard Xpert and Coverguard tidy.⁶ An undated print-out is provided that lists the marks that were consolidated under the 'COVERGUARD' branding.⁷ While the evidence is not entirely clear, the brands 'Lux Optical', 'Top Lock'

³ *NIRVANA Trade Mark*, BL O/262/06

⁴ Page 2 paragraph 3 of the applicant's Submissions in lieu.

⁵ Pages 3 to 39 of Exhibit JS1 of the Witness Statement of Jean Seguy

⁶ Paragraph 6 of the Witness Statement of Jean Seguy

⁷ Page 2 of Exhibit JS1 of the Witness Statement of Jean Seguy

and 'Euro Protection' can be made out. Given that the evidence suggests that Euro Protection exists under the same corporate umbrella as the opponent, I am content to conclude that any use by Euro Protection was with the consent of the opponent, being the owner of the mark. I also note that there are some invoices that do not include the opponent's mark and appear to have been issued by companies called 'Ganteline' and 'SACLA'.⁸ I will consider these below.

27. In addition to the invoice evidence, the opponent has provided evidence in respect of the packaging it uses, the catalogues it issues and its website. For reasons that will become clear when assessing the invoices further, I will first address this evidence, of which I note the following:

- a) Images of the packaging typically used to transport and/or sell the opponent's goods in displaying use of the opponent's mark.⁹
- b) Extracts from the opponent's 2015 catalogue which is used to market the opponent's goods. The catalogue displays use of the opponent's mark throughout. The extent and distribution of the opponent's catalogue has not been provided. However, it was confirmed in the evidence that the catalogue was distributed throughout the relevant territory.¹⁰
- c) Extracts from the opponent's 2020 catalogue of clothing and footwear which, the opponent states, is used to market the opponent's goods. The extracts display use of the opponent's mark throughout.¹¹
- d) Extracts from the opponent's website magprod.europrotection.com displaying product listings of protective goggles. The extracts display use of the opponent's mark.¹²

28. As set out above, the evidence contains a number of sample invoices. The invoices are for sales to customers in France, Luxembourg, Belgium, Italy, Germany and one invoice that has a shipping address of the Netherlands but a customer address in the UK. These invoices are dated during the relevant period. Some of the opponent's invoices have been provided in English; however, some are provided in other

⁸ Pages 3 to 4, 9 to 13 and 17 to 20 of the Witness Statement of Jean Seguy

⁹ Pages 39 to 42 of Exhibit JS1 of the Witness Statement of Jean Seguy

¹⁰ Pages 43 to 139 of Exhibit JS1 of the Witness Statement of Jean Seguy

¹¹ Pages 140 to 177 of Exhibit JS1 of the Witness Statement of Jean Seguy

¹² Pages 178 to 183 of Exhibit JS1 of the Witness Statement of Jean Seguy

languages and no translations have been supplied. I am of the view that the content of the untranslated invoices is self-evident and do not necessarily require translation. For example, the information regarding products, sales figures and the address are identifiable. It is not clear from the invoices themselves what goods are sold via these invoices and whether they bear the opponent's mark or not. However, the section of the opponent's evidence wherein the invoices are discussed,¹³ there are repeat cross-references to the catalogue evidence referred to at points b and c of paragraph 27 above. Having reviewed the evidence, I can see that the goods covered by the opponent's invoices show the sale of footwear, clothing, safety goggles and footwear for protection against accidents, fire and radiation, all bearing the opponent's mark. In examining this evidence, I am content to conclude that the goods sold via the COVERGUARD and Euro Protection invoices were goods that bear the opponent's mark and, therefore, valid use of the mark by the opponent or with its consent. While I note that the explanations also show that the 'SACLA' and 'Ganteline' invoices referred to at paragraph 26 above were goods bearing the opponent's mark, I have no explanation as to the opponent's relationship with these companies. Therefore, despite being for goods bearing the opponent's mark, I do not consider them to be evidence of use by the opponent.

29. The opponent has also provided evidence regarding its turnover. Of this, I note that the opponent states that between 2015 and 2020 the following value of products were sold "in the relevant territory": €31 million (2016), €33 million (2017), €32 million (2018), €30 million (2019) and €12 million (up to 7 July 2020); for a total of €138 million over the same period. The opponent explains that these figures are expressed as "in excess of" to preserve the commercial sensitivity of the information. The opponent has not provided a breakdown as to what products are included in the turnover figures. However, as previously mentioned, sample invoices have been provided that I consider to show the sale of a wide range of goods bearing the opponent's mark by or with consent of the opponent. I am, therefore, content to conclude that the figures provided relate to all of the opponent's goods and that they bear the opponent's mark.

30. Although, I do not have evidence or submissions from the parties to assist me on the matter of the size of the EU market for the goods concerned, I believe the market

¹³ Paragraph 9.1 to 9.20 of the Witness Statement of Jean Seguy

to be substantial, numbering in billions of euros per annum. In my view, when compared against the size of the relevant market, these figures are low. However, despite this, they are a significant level of sales that indicate a frequent level of use on a reasonable scale across the EU in respect of the goods for which the opponent's mark is registered. In making this finding, I have taken into account the fact that some of the sample invoices provided do not show use by or with the consent of the opponent. However, the evidence confirms that the turnover figures provided are figures of the opponent itself and not unrelated third parties.

31. The opponent submits that its 2015 and 2020 catalogues are evidence of marketing. While I accept the catalogues to be of assistance in determining what goods have been sold, the opponent has provided no indication as to how the catalogues are distributed and has not provided any evidence to demonstrate how widely the catalogues reach consumers. As a result, I do not consider it to be valid evidence of marketing. Further, I note that no further evidence of marketing or advertising expenditure has been provided.

32. Taking all of the above evidence into account, I am of the view that it is clear that the opponent has attempted to create and maintain a market for its goods under its mark. Therefore, I am satisfied that the opponent has demonstrated genuine use of its mark during the relevant period in the EU.

Fair Specification

33. I must consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as follows:

“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.”

34. The opponent relies on the following goods:

Class 9: *Footwear for protection against accidents, radiation and fire; protective goggles.*

Class 25: *Clothing, footwear, (except orthopaedic footwear).*

35. I note from the evidence provided that the mark COVERGUARD has been used in relation to all of the goods listed above. This is particularly the case when taking into account the evidence that connects the invoices to specific goods the bear the opponent’s mark within the catalogues provided. I consider the use shown to be broad enough to allow the opponent to rely on its current specification, which I consider to be a fair specification of the mark.

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

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

“(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 or association with the earlier trade mark.”

37. Section 5A of the Act states as follows:

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

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

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impression 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 greater 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of the goods

39. The goods to be compared are as follows:

Applicant's goods	Opponent's goods
<u>Class 9</u> <i>Protective clothing, headgear and footwear against accidents, injury, chemicals and irradiation; protective coveralls, protective gloves, protective smocks, protective aprons, protective</i>	<u>Class 9</u> <i>Footwear for protection against accidents, radiation and fire; protective goggles.</i> <u>Class 25</u>

<p><i>beard covers, protective hairnets and hair coverings, protective over sleeves, protective visitors coats, protective shoe covers and protective face masks, all of the aforesaid goods against accidents, injury, chemicals and irradiation.</i></p> <p><u>Class 10</u></p> <p><i>Protective clothing, headgear and footwear for medical purposes; protective coveralls, protective gloves, protective smocks, protective aprons, protective beard covers, protective hairnets and hair coverings, protective over sleeves, protective visitors coats, protective shoe covers and protective face masks, all of the aforesaid goods for medical purposes.</i></p> <p><u>Class 25</u></p> <p><i>Laboratory coats.</i></p>	<p><i>Clothing, footwear, (except orthopaedic footwear).</i></p>
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40. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the 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”.

41. Guidance on this issue has also come from Jacob J. (as he was then) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.”

42. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

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

43. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

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

Class 9

44. The applicant admits that there is a partial overlap of goods in class 9 insofar as protective/safety footwear is concerned. However, the applicant does not clarify to what degree it considers the goods to be similar, therefore, I will conduct a full goods and services comparison.

45. I agree with the opponent that some of the goods at issue are identical. For example, “*protective [...] footwear against accidents, injury[...] and irradiation*” in the applicant’s specification and “*footwear for protection against accidents, radiation[...]*” in the opponent’s specification, although worded slightly differently, are identical.

46. “*Protective [...] footwear against[...] chemicals*” in the applicant’s specification share a level of similarity with “*footwear for protection against accidents, radiation[...]*” in the opponent’s specification as they coincide in users, method of use, trade channels, have a very similar nature and are likely to be produced by the same or economically linked undertaking. They also share general purpose in that they are goods worn for protection. Overall, I consider these goods to be similar to a high degree.

47. “*Protective clothing, headgear [...] against accidents, injury, chemicals and irradiation*” and “*protective coveralls, protective gloves, protective smocks, protective aprons, protective beard covers, protective hairnets and hair coverings, protective over sleeves, protective visitors coats and protective face masks, all of the aforesaid goods against accidents, injury, chemicals and irradiation*” in the applicant’s specification and

“footwear for protection against accidents, radiation and fire” in the opponent’s specification are similar. There is some overlap in the goods at issue in nature, as they are all goods that are worn on the body. The goods at issue also serve the same purpose, to protect the wearer from identical or highly similar elements. The goods also coincide in users in that someone who is looking to buy protective clothing or headgear is also likely to buy protective footwear. There is also an overlap in trade channels as the goods will be sold by the same or economically linked undertakings. The goods are neither in competition nor complementary. Therefore, I find the goods to be similar to a medium degree.

48. *“Protective shoe covers [...], all of the aforesaid goods against accidents, injury, chemicals and irradiation”* in the applicant’s specification and *“footwear for protection against accidents, radiation and fire”* in the opponent’s specification are similar. The goods at issue have a similar purpose as they are used to protect the wearer from identical or highly similar elements. The goods at issue may also overlap in nature as they are both used for foot protection, however, the applicant’s goods are used to cover the shoe, whereas, the opponent’s goods are the shoe itself. The goods are not complementary but are, in my view, competitive. This is on the basis that a user may choose to buy protective footwear or protective covers for their existing footwear, or vice versa. Therefore, I find the goods to be similar to a medium degree.

Class 10

49. The applicant submits that its goods in class 10 are different from the opponent’s goods in class 9. On the other hand, the opponent submits that the goods are identical or highly similar as they coincide in nature, purpose, method of use, distribution channels and are complementary and competitive.

50. I agree with the opponent that *“protective [...] footwear for medical purposes”* in the applicant’s specification and *“footwear for protection against accidents, radiation and fire”* in its specification have the same or a highly similar nature and method of use, as they are worn on the feet. I am not prepared to accept that there is some overlap in users, as it is highly unlikely that a consumer who wants protective footwear for medical purposes will also want protection against fire, accidents and radiation.

There is an overlap in end purpose generally as both goods aim to protect the feet, albeit for different reasons. The goods are not, therefore, in competition and neither are they complementary. The applicant provided evidence to demonstrate that the trade channels of the goods at issue differ.¹⁴ The applicant states that “where businesses offer both types of goods [...] there is a different and discrete marketing and sales channels for the different types of goods”.¹⁵ In my view, the evidence is insufficient to demonstrate that the trade channels differ between the parties goods; as categorisation into separate industries by each safetywear provider in the applicant’s evidence does not negate that the goods are provided by the same company. Taking all these factors into account, I find the goods to be similar to a medium degree.

51. “*Protective clothing, headgear [...] for medical purposes*”, “*protective coveralls, protective gloves, protective smocks, protective aprons, protective beard covers, protective hairnets and hair coverings, protective over sleeves, protective visitors coats, protective shoe covers and protective face masks, all of the aforesaid goods for medical purposes*” in the applicant’s specification and “*clothing*” in the opponent’s specification have the same or similar nature and method of use. The applicant’s goods will be worn by medical professionals, and while it is also likely that medical professionals will also wear the opponent’s clothing goods, this very general overlap alone is insufficient to warrant a finding that there is an overlap in user. However, the goods differ in purpose, as the applicant’s goods have a specialist use to protect the safety of personnel and keep the environment clean, whereas, the opponent’s goods have the purpose of covering and shielding the body. Therefore, the goods are neither complementary nor in competition. The goods at issue have different trade channels and will not be provided by the same producer. Taking all these factors into account, I find the goods to be similar to a low degree.

Class 25

52. “*Laboratory coats*” in the applicant’s specification is encompassed by the broader category of “*clothing*” in the opponent’s specification. Therefore, I find the goods to be identical on the principle outlined in *Meric*.

¹⁴ RCL17- RCL30 of the witness statement of Roger Lush

¹⁵ Applicant’s submission in lieu paragraph 65

The average consumer and the purchasing process

53. As the law above indicates, it is necessary for me to determine who the average customer is for the parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

54. The average consumer for the goods at issue will be a member of the general public, workmen/women, medical and healthcare professionals or a business user purchasing safety equipment for use in a commercial context. The selection of the goods at issue are likely to be selected visually from the shelves of a retail shop (or its online equivalent), catalogues or the website or premises of a specialist. I do not discount aural considerations in the form of, for example, advice received from a sales assistant or word-of-mouth recommendations.

55. The cost of the goods are relatively inexpensive and will be purchased relatively frequently. Generally speaking, the average consumers will pay a medium degree of attention during the selection process of the goods at issue. However, for some goods in the parties' specifications, the level of attention will vary from low (for goods such as hair nets) to an above medium (but not high) degree of attention for the goods in classes 9 and 10, as they are goods that are used for safety and/or protection of the user.

Comparison of the marks

56. The respective trade marks are shown below:

COVGUARD	COVERGUARD
The applicant's mark	The opponent's trade mark

57. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) 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 trade marks must be assessed by reference to all 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 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.”

58. 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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

59. The opponent's mark is a word-only mark that consists of the text “COVERGUARD” and the applicant's mark is a word-only mark that consists of the text “COVGUARD”. There are no other elements that contribute to the overall impression of the marks.

60. Visually, the only point of difference between the marks is the presence of the letters “ER” between “COV” and “GUARD” in the middle of the opponent’s mark. Overall, I consider the marks to be visually similar to a high degree.

61. Aurally, the opponent’s mark will be pronounced KUH-VUH-GARD and the applicant’s mark will be pronounced KOV-GARD. The last syllables of the marks are identical. All other elements are different. Overall, I find the marks to be aurally similar to a medium degree.

62. Conceptually, COVERGUARD will be perceived as a combination of two ordinary dictionary words, being COVER and GUARD. When used in combination, it may be perceived that there is cover that is designed to protect (or ‘guard’) against something. COVGUARD on the other hand, will be perceived as a combination of a made-up element, being ‘COV’ and a discernible word, being ‘GUARD’. The concept of ‘GUARD’ will be the same across both marks. However, given that ‘COV’ will have no clear meaning to the average consumer, it will, in my view, act as a point of conceptual difference between the marks. Overall, I find the marks to be conceptually similar to a medium degree.

Distinctiveness of the earlier mark

63. 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-2779, 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).”

64. 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 a high inherent distinctive character, such as invented words which have no allusive qualities.

65. The opponent has not pleaded that the mark has acquired enhanced distinctive character through use. I have considered the evidence in support of a claim of enhanced distinctiveness and do not consider the evidence is sufficient to demonstrate such a claim in regard to the opponent’s mark in the UK. Enhanced distinctiveness must be established in relation to the UK market because the test for confusion will be assessed by reference to the average consumer who is a member of the UK general public. No evidence has been provided to suggest that the UK consumers would be aware of the opponent’s mark or indicating the proportion of the relevant class of people who identify the goods as originating from the opponent’s undertaking. There is also no evidence of marketing or advertising expenditure to support a claim. The opponent’s evidence does not point to its mark having acquired any enhanced distinctiveness in the UK through use. I have, therefore, only the inherent position to consider.

66. The opponent submits that its mark is inherently distinctive to a high degree. I disagree with the opponent. As outlined in paragraph 62 of this decision, although the conjoined word “COVERGUARD” is not dictionary defined, I do not consider that the average consumer would see it as an invented word, but as two words, being

“COVER” and “GUARD”. In my view, the words “COVER” and “GUARD” are descriptive of the goods for which the opponent’s mark is registered, particularly footwear for protection against accidents, radiation and fire. Therefore, the opponent’s mark is inherently distinctive to a low degree. As for the goods that do not relate specifically to protective equipment, such as clothing, the mark will not be overtly descriptive. It is my view, that whilst some articles of clothing can protect you from the weather there are other items of clothing that can be used for fashion purposes and do not provide that protection, i.e. fishnet stockings. For those goods, I consider the mark enjoys a medium degree of inherent distinctiveness.

Likelihood of confusion

67. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. 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 goods or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

68. I have found the marks to be visually similar to a high degree and conceptually and aurally similar to a medium degree. I have identified the average consumer to be members of the general public, professionals and businesses who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that a low to above medium degree of attention will be paid during the purchasing process. I have found the opponent’s mark enjoys a low degree of inherent distinctive character, for goods that relate to protective equipment, and a medium degree of inherent distinctive character, for goods that do not (Class 25). I have found the goods to vary in similarity from identical to similar to a low degree.

69. Although I recognise that the earlier mark has a weak distinctive character, that does not imply that there is no likelihood of confusion.¹⁶

70. I recognise that the word COVERGUARD may be descriptive and therefore only distinctive to a low or medium degree, depending on the goods at issue, which is in favour of the applicant. Having said that, the only difference between the marks is the presence of the letters “ER” in the middle of the opponent’s mark. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that the average consumer will overlook the differences between the marks. This is particularly the case given that the average consumer tends to focus on the beginning of marks¹⁷ meaning that, in the present circumstances, the focus will be aimed towards the beginnings of the marks, which are identical. Therefore, it is likely that the marks will be misremembered or mistakenly recalled as each other, even when an above medium degree of attention is applied. Consequently, I consider there to be a likelihood of direct confusion between the marks. This is the case in the context of identical goods or goods similar to a medium degree or higher. However, for those goods that I have found to be similar to a low degree, I do not consider that the similarities between the marks will off-set the low similarity of the goods. Therefore, my finding of direct confusion does not extend to those goods.

Conclusion

71. The opposition is has succeeded for the following goods which will be refused:

Class 9: *Protective clothing, headgear and footwear against accidents, injury, chemicals and irradiation; protective coveralls, protective gloves, protective smocks, protective aprons, protective beard covers, protective hairnets and hair coverings, protective over sleeves, protective visitors coats, protective shoe covers and protective face masks, all of the aforesaid goods against accidents, injury, chemicals and irradiation.*

Class 10: *Protective [...] footwear for medical purposes.*

¹⁶ L’Oréal SA v OHIM, Case C-235/05 P

¹⁷ El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02

Class 25: *Laboratory coats.*

72. The opposition has failed in relation to the following goods which will proceed to registration:

Class 10: *Protective clothing, headgear [...] for medical purposes, protective coveralls, protective gloves, protective smocks, protective aprons, protective beard covers, protective hairnets and hair coverings, protective over sleeves, protective visitors coats, protective shoe covers and protective face masks, all of the aforesaid goods for medical purposes.*

Costs

73. In my view, both parties have enjoyed an approximately equal degree of success in these proceedings. As a result, I do not consider it appropriate to make an award of costs in the favour of either party.

Dated this 11th day of November 2021

A Klass

**For the registrar,
the Comptroller-General**