

O/949/22

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATIONS NOS. UK00003495813 AND UK00003495815
IN THE NAME OF
WORLD CHAMPION IMPRINT CLUB LIMITED
FOR THE TRADE MARKS:



IN CLASS 3, 9, 14, 16, 18, 21, 25, 28, 35, 38 AND 41

AND

OPPOSITIONS THERETO UNDER NOS. 423029 AND 423031
BY KABUSHIKI KAISHA ASICS TRADING AS ASICS CORPORATION

Background and pleadings

1. World Champion Imprint Club Limited (“the applicant”) applied to register the trade marks shown on the cover page on this decision in the UK on 01 June 2020.

2. The applications were accepted and published in the Trade Marks Journal on 30 October 2020 in respect of goods and services in classes 3, 9, 14, 16, 18, 21, 25, 28, 35, 38 and 41 though only classes 18, 25, 28, 35 and 41 form part of these oppositions.¹ The contested goods and services will be set out later in this decision.

3. On 01 February 2021, Kabushiki Kaisha Asics trading as Asics Corporation (“the opponent”) opposed the applications on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under Sections 5(2)(b) and 5(3) the opponent relies on the trade marks and specifications set out in the table below:

EU006383574



Filing date: 22 October 2007; Registration date: 03 September 2008

Class: 18: *Sports bags; waist bags; shoulder bags; clutch bags; tote bags; hand bags; duffle bags; boston bags; travelling bags; laundry bags; shoe bags; knapsacks; rucksacks; cases; brief cases; attaché cases; suit cases; trunks; bag with wheels; pouches; purses; wallets; parasols; umbrellas; walking sticks.*

Class 25: *Clothing, footwear, headgear.*

Class 28: *Gymnastic and sporting equipment; bats for games; rackets for games; clubs for games; balls for games; gloves for games; case and bag for bat, racket, club and ball; sports guards for head, face, chest, waist, shoulder, elbow, wrists, finger, legs, knees and ankles; nets for sports; mats for sports; ropes for sports; belts for sports; machines and apparatus for physical exercise; ski bags; skis; ski bindings; wax for skis; rope jumping; athletic tapes; game and playthings.*

¹ The opposed specifications are identical

UK00001476670



Filing date: 09 September 1991; Registration date: 05 November 1993

Priority date: 17 May 1991

Class 18: *Bags, trunks, knapsacks, handbags, suitcases, parasols, umbrellas, walking sticks; all included in Class 18.*

Class 25: *Clothing, footwear, headgear, sports shoes, athletic shoes, casual shoes, leisure shoes, sports socks, sports wear, casual wear, leisure wear, sports gloves, sports caps; all included in Class 25.*

Class 28: *Games and playthings; gymnastic and sporting articles; sports gloves; wrist bands, all for use in playing sports; leg guards and supporters, all for use in playing sports; head caps for rugby football; bats for table tennis, bats for games, tennis rackets, rackets, table tennis bat cases, racket cases, cases adapted for carrying sports articles, golf bags, caddy bags, bags adapted for carrying sports apparatus; golf clubs; golf club covers, golf nets, nets for sports; all included in Class 28.*

4. The opponent's trade marks both have a registration date that is earlier than the filing date of the application and, therefore, they are earlier marks, in accordance with Section 6 of the Act. As the registration procedure for both marks was completed more than 5 years prior to the filing date of the contested application, they are both subject to the proof of use conditions, as per Section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

5. Under Section 5(2)(b), the opponent claims that the contested goods and services are identical or similar to the goods covered by the earlier marks and that the device element of the contested applications is highly similar to the earlier marks creating a high level of visual similarity between the marks and the impression that the marks

applied for are similar to and associated with the opponent's marks, leading to a likelihood of confusion.

6. Under Section 5(3), the opponent states that the earlier marks have acquired a reputation in relation to the goods relied upon and that use of the applicant's marks would, without due cause, take unfair advantage or be detrimental to the distinctive character or repute of the earlier marks.

7. Lastly, under Section 5(4)(a) ground, the opponent relies on an unregistered sign that is identical to its earlier marks (I shall refer to the sign/mark as the 'ASICS swirl logo') and claims to have used it throughout the UK since 1993 for the following goods:

Bags, trunks, knapsacks, handbags, suitcases, parasols, umbrellas, walking sticks, clothing, footwear, headgear, sports shoes, athletic shoes, casual shoes, leisure shoes, sports socks, sports wear, casual wear, leisure wear, sports gloves, sports caps, games and playthings, gymnastic and sporting articles, sports gloves, wrist bands, all for use in playing sports, leg guards and supporters, all for use in playing sports, head caps for rugby football, bats for table tennis, bats for games, tennis rackets, rackets, table tennis bat cases, racket cases, cases adapted for carrying sports articles, golf bags, caddy bags, bags adapted for carrying sports apparatus, golf clubs, golf club covers, golf nets and nets for sports.

8. The applicant filed two counterstatements denying the grounds of opposition and requesting the opponent to provide proof of use of the earlier marks. In its counterstatement the applicant:

- denies that the opponent is the owner of the earlier UK00001476670 because the mark is registered in the name of Asics Corporation, whilst the opponent name is Kabushiki Kaisha Asics trading as Asics Corporation;
- denies that the marks are similar and that there is a likelihood of confusion;
- admits that the contested goods in classes 18, 25 and 28 are similar to the goods covered by the earlier marks but denies that the contested services in classes 35 and 41 are similar;
- denies that the opponent has a reputation and goodwill for the purpose of Sections 5(3) and Section 5(4)(a) and that the marks are sufficiently similar to create a link or cause misrepresentation.

9. Only the opponent filed evidence during the evidence rounds. It also filed written submissions dated 22 March 2022. I shall refer to the evidence and submissions to the extent that I consider necessary.

10. The applicant is represented by Level Law Limited and the opponent by Novagraaf UK. Neither party requested a hearing, nor did they file submissions in lieu. This decision is taken following a careful consideration of the papers.

11. 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.

PRELIMINARY ISSUE

12. As I have mentioned above, one of the points raised by the applicant in its counterstatements is that the opponent is not the recorded owner of the trade mark no. UK00001476670. Following this, the opponent was asked to provide explanatory comments for consideration, and/or file a Form TM21a,² on or before 17 May 2021.

13. On 17 May 2021 the opponent emailed the Tribunal providing the following explanation:

“[...] please find attached evidence supporting the fact that Kabushiki Kaisha Asics and Asics Corporation are the same entity. A Kabushiki Gaisha, or Kabushiki Kaisha, usually abbreviated as KK, is a type of business corporation defined under Japanese law. Japanese companies often translate the phrase as Co., Ltd, Corporation or Incorporated. Please see the attached article confirming this naming in Japanese business. We also attach a translation of the Articles of Association of ASICS Corporation. Article 1 of this document

² TM21a is a form used to change of name, address or email of the owner of a trade mark

confirms that “The name of the Company is Kabushiki Kaisha ASICS and in English, the Company shall be called ASICS Corporation”. In this case both registrations relied upon by the Opponent in the above opposition are owned by the same entity, but the way in which the name appears on the UK and EUIPO registers differs slightly in respect of the relevant registrations. We trust that this the above information and attached evidence is sufficient to assure the Examiner that the registrations are under the same ownership. Please do not hesitate to contact us if any additional information is required.”

14. The Tribunal acknowledged receipt of the opponent’s written comments and documentation regarding the legal entity behind the earlier marks and, in a preliminary view dated 7 July 2021, indicated that the explanation provided was sufficient to allow the opposition to run as pleaded. As the applicant did not contest that view, it was automatically confirmed, and the issue was resolved.

THE EVIDENCE

15. The opponent filed evidence in the form of a witness statement of Masanori Inui dated 6 September 2021. Mr Inui is a manager within the opponent’s company, a position he has held for 5 years. His witness statement is accompanied by 21 exhibits (MI01-21).

DECISION

Proof of use

16. The applicant has requested proof of use in these proceedings in respect of the opponent’s earlier marks. I will begin by assessing whether and to what extent the evidence supports the opponent’s statement that it has made genuine use of the marks in relation to the goods relied upon. In accordance with Section 6A(1A) of the Act, the relevant period for this purpose is the five years ending on the filing date of the contested applications: 02 June 2015 to 01 June 2020.

Relevant statutory provision: Section 6A:

17. Section 6A is as follows:

“(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.”

18. 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.”

19. 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 Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

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

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

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

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

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

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

20. As one of the earlier marks is a EUTM, I must also consider evidence of use in the EU - see *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, paragraph 36.

Evidence

21. Mr Inui sets out some of the opponent’s background history. He says that the opponent was founded in 1949 and became the present ASICS corporation in 1977, after merging with manufacturers of sportswear. The name ASICS derives from the old Latin phrase “Anima Sana In Corpore Sano”, which means “a sound mind in a sound body”.

22. In terms of sale figures, Mr Inui states that ASICS has achieved a turnover in Europe that amounts to more than 3700 million US dollars in the period 2016-2019, reaching sales exceeding 887 million US dollar in Europe at the end of 2019.

23. Use of the ASICS swirl logo in the UK began in 1993 and the UK turnover for the period 2015-2020 is as follows:

2015 - £70,826,434

2016 - £74,330,670

2017 - £65,136,063

2018 - £66,536,425

2019 - £68,105,931

2020 - £53,354,747

24. Mr Inui states that “the type of goods sold under the earlier marks include sport clothing, shoes and accessories such as hats, headbands, socks, kneepads and gloves”. Goods are sold in the UK in 3,000 retailers including ASICS stores – the largest flagship store was opened in London in 2017 - and high street retailers such as Sport Direct, JD Sport, and Footlocker.

25. There are plenty of examples of branded goods within the evidence which show the ASICS swirl logo used on the goods themselves, either alone or in conjunction with the name ASICS, as shown below:





26. The evidence is well marshalled, and the opponent has filed details of extensive use and promotion. This includes:

- a. evidence of international advertising campaigns which promoted ASICS as a leading sport and running brand, including a global campaign called ‘MOVE ME’ which was launched in London in 2017 and centred on the theme of inspiring people to become more active;³
- b. evidence of collaboration with Disney (2018) and Eurosport (2018).⁴ The partnership with Disney created a cross-media campaign to get families moving and produced an “Incredibles 2” themed limited-edition footwear; the campaign was promoted in the EU, including the UK. ASICS was also the broadcast sponsor of a series called “BEYOND CHAMPIONS: MOVING STORIES OF GREAT ATHLETES” which was broadcasted on Eurosport channels, Eurosport 1 and Eurosport 2;
- c. evidence of ASICS sponsoring the Japanese Olympic and Paralympic teams at the 2020 Olympic Games in Tokyo. Although the games were postponed, and took place in 2021, the official sportswear (displaying the ASICS swirl logo)

³ MI-04

⁴ MI-05

was released in February 2020.⁵ ASICS has also been the sponsor of the IAAF (International Association of Athletes Federation) since 2016 taking over from ADIDAS;

- d. evidence of online articles describing the brand ASICS as *“one of the most iconic brands in performance footwear”, “one of the most prestigious running brands in the world”, “the pioneer of running shoes”, “a successful and globally recognised brand”, “a global brand centred in performance and fitness”, “a leading designer and manufacturer of running shoes, as well as other athletic footwear, apparel and accessories”*. One of the articles compares ASICS to global players, such as Nike and Adidas, stating: *“Since expanding globally in the ’60s, ASICS has risen to become one of the world’s leading sportswear brands alongside Nike, Adidas, and New Balance, specializing primarily in running shoes but also selling equipment and apparel for a wide range of sports”*;
- e. evidence of ASICS being consistently ranked as one of the top Japanese brands for sport goods.⁶ This evidence shows that ASICS was ranked as number 19 in 2015, number 25 in 2018, number 31 in 2019 and number 59 in 2020;
- f. evidence that the brand ASICS is recognised by 65% of those interviewed by www.yougov.co.uk an international research data and analytic group based in the UK;⁷
- g. evidence from the website www.logos-world.net (which lists the most famous brands and company logos in the world) showing both the brand ASICS and the ASICS swirl logo.

Form of the mark

27. The opponent is required to show use of the ASICS swirl logo in relation to the registered goods in classes 18, 25 and 28 during the period 02 June 2015 to 01 June 2020.

⁵ MI-06

⁶ MI-08- MI10. ASICS was ranked as 19 in the 40 top Japanese brands in 2016 and appears listed in the top brands consistently in the years 2015-2020

⁷ MI9

28. The ASICS swirl logo always appears on the products either alone or together with the brand name ASICS. In the same manner, the ASICS swirl logo is used on marketing and promotional material, including social media. It also appears on the opponent's website at <https://asics.com> in the form shown below:



29. The website explains that the logo was adopted in 1992, that it represents a “stylised letter A” (the initial letter of ASICS) “adopted as a motif intended to express the idea of unlimited speed and the dynamism of sports” and that “its spiral structure evokes how the related businesses all rotate around the axis of ASICS core competence”.

30. The ASICS swirl logo followed by the word ASICS also appears on video marketing campaigns, on the “BEYOND CHAMPIONS” series and on items from the Disney Incredibles 2 Collection, and from the 2020 Olympic Games:



31. Webpages from www.interbrand.com listing the best Japanese brands also identify the opponent's brand as incorporating the ASICS swirl logo (as shown below):



32. The same goes for other evidence (mentioned above) which ranks ASICS as number 19, number 25, number 31 and number 59 in the list of the top Japanese brands:



33. It is true that some of the use shown in the relevant 5-year period is in conjunction with the brand name ASICS. However, there is also plenty of evidence which shows the ASICS swirl logo prominently displayed on the goods on its own. Although this evidence is undated, the logo was launched in 1993 and it is reasonable to assume that the logo was displayed in the same or a similar manner on goods produced during the relevant period.

34. In any event, it is well established that use of a registered trade mark as part of another mark may constitute genuine use of the registered mark, provided it continues to be perceived as indicating the trade origin of the goods/services.⁸ That is clearly the case here. For example, the brand reports prove that the ASICS swirl logo is associated with the brand name ASICS and that the same logo is part of ASICS's brand as one the leading sportswear brands in the world today.

⁸ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 CJEU

Genuine use

35. During the relevant period, UK sales have been in the region of £50million to £70 million per year, for a total of nearly £400million. The EU sales are even higher, amounting to 3700 million USD in the period 2016-2019, with sales exceeding 887 million USD at the end of 2019.

36. The evidence clearly supports the opponent's claim that it has used the marks on a substantial scale both in the UK and in the EU in relation to sportswear, sport shoes, sport bags and various sport-related accessories.

37. The real issue is the identification of the goods provided under the marks and deciding on an appropriate notional specification for the purposes of this opposition.

38. The relevant case-law was summarised by Carr. J. in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), as follows:

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

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

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

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

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

39. Although this case concerned partial revocation, exactly the same considerations apply to proof of use in opposition proceedings.

40. EU006383574 is registered in relation to the following goods in classes 18, 25 and 28:

Class: 18: *Sports bags; waist bags; shoulder bags; clutch bags; tote bags; hand bags; duffle bags; boston bags; travelling bags; laundry bags; shoe bags; knapsacks; rucksacks; cases; brief cases; attaché cases; suit cases; trunks; bag with wheels; pouches; purses; wallets; parasols; umbrellas; walking sticks.*

Class 25: *Clothing, footwear, headgear.*

Class 28: *Gymnastic and sporting equipment; bats for games; rackets for games; clubs for games; balls for games; gloves for games; case and bag for bat, racket, club and ball; sports guards for head, face, chest, waist, shoulder,*

elbow, wrists, finger, legs, knees and ankles; nets for sports; mats for sports; ropes for sports; belts for sports; machines and apparatus for physical exercise; ski bags; skis; ski bindings; wax for skis; rope jumping; athletic tapes; game and playthings.

41. Although Mr Inui does not give turnover figures broken down by products, the evidence tells me that the opponent has used the mark on sport goods, namely sport shoes, sport clothes, sport bags and sport accessories. Given the huge turnover generated by the opponent and the limited range of goods which the opponent sells, i.e. sport goods, the turnover that has been generated under each category of goods during the relevant period must be significant.

42. Examples of branded goods include sport clothing, running shoes, caps, visors, ear covers, tennis bandanas, bucket hats, beanies, gloves, backpacks, sport bags, sport belts and waist packs.

43. The opponent's specification in class 25 contains the broad terms *Clothing, footwear, headgear*. In my view, it would not be fair to allow the opponent to rely on such general terms, which would include all sorts of clothing, footwear and headgear. To my mind, a fair specification in class 25 would be *sport clothing, sport footwear, sport gloves and sport headgear*.

44. Moving on to Class 18, the only use shown in relation to *sport bags, rucksacks and waist bags*. There is no evidence of use in relation to the other goods listed in the specification, namely *shoulder bags; clutch bags; tote bags; hand bags; duffle bags; boston bags; travelling bags; laundry bags; shoe bags; knapsacks; cases; brief cases; attaché cases; suit cases; trunks; bag with wheels; pouches; purses; wallets; parasols; umbrellas; walking sticks*. In my view, given the absence of evidence of use for these goods, it would not be fair to allow the opponent to rely on these terms.

45. Lastly, I consider that the term *gymnastic and sporting equipment* is a broad one, and that the opponent has only shown use in relation to two specific types of equipment/accessories, namely *belts for sports* and *ear covers*. Further, Mr Inui makes no mention of the other goods listed in the registered specification with the exception

of kneepads. In my view, use in relation to ear covers and kneepads is sufficient for the opponent to retain *sports guards for head, face, chest, waist, shoulder, elbow, wrists, finger, legs, knees and ankles*; the average consumer would consider these goods to belong to the same group or category as those for which the mark has been used and which are not in substance different from them. The opponent can also rely on *belts for sports* because the evidence shows use in relation to these goods.

46. A fair specification for the earlier EU006383574 mark is therefore:

Class 18: *sport bags; rucksacks; waist bags.*

Class 25: *sport clothes; sport footwear; sport gloves; sport headgear.*

Class 28: *sports guards for head, face, chest, waist, shoulder, elbow, wrists, finger, legs, knees and ankles; belts for sports.*

47. The UK00001476670 is registered in relation to the following goods in classes 18, 25 and 28:

Class 18: *Bags, trunks, knapsacks, handbags, suitcases, parasols, umbrellas, walking sticks; all included in Class 18.*

Class 25: *Clothing, footwear, headgear, sports shoes, athletic shoes, casual shoes, leisure shoes, sports socks, sports wear, casual wear, leisure wear, sports gloves, sports caps; all included in Class 25.*

Class 28: *Games and playthings; gymnastic and sporting articles; sports gloves; wrist bands, all for use in playing sports; leg guards and supporters, all for use in playing sports; head caps for rugby football; bats for table tennis, bats for games, tennis rackets, rackets, table tennis bat cases, racket cases, cases adapted for carrying sports articles, golf bags, caddy bags, bags adapted for carrying sports apparatus; golf clubs; golf club covers, golf nets, nets for sports; all included in Class 28.*

48. I apply the same considerations to this specification with the following caveats: a) the term *bags* in class 18 is too broad as it covers all sort of bags; the terms *sport bags*; *rucksacks*; *waist bags* identify the appropriate subcategories of goods in relation to which the mark has been used and which would be viewed by the average consumer independently; b) the same goes for *gymnastic and sporting articles* in class 28: the term is too broad and the terms *belts for sports*; *protective pads for sports* identify the appropriate subcategories of goods in relation to which the mark has been used and which would be viewed by the average consumer independently.

49. A fair specification for the earlier UK00001476670 mark is therefore:

Class 18: *bags namely sport bags; rucksacks; waist bags.*

Class 25: *sport clothes; sport footwear; sport gloves; sport headgear; sports shoes, athletic shoes, sports socks, sports wear, sports gloves, sports caps; all included in Class 25.*

Class 28: *gymnastic and sporting articles, namely belts for sports; protective pads for sports.*

Section 5(2)(b)

50. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because-

[...]

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

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

51. Section 5A of the Act is as follows:

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

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

53.. The competing goods and services are as follows:

The contested goods in the applications	The opponent's goods
Class 18: <i>Wallets; handbags; rucksacks; luggage and carrying bags; trunks and travelling bags; Umbrellas; Parasols; Walking sticks.</i>	EU006383574 mark Class 18: <i>sport bags; rucksacks; waist bags.</i>

Class 25: Footwear; headwear; clothing; Hats; Caps; Visors; Headbands; Bandanas; Sweatbands; Pants; Shorts; Boxing shorts; Shirts; T-shirts; Pullovers; Jerseys; Sweat shirts; Sweat pants; Underwear; Sports bras; Dresses; Skirts; Sweaters; Jackets; Coats; Socks; Gloves; Hosiery; Tights; Vests; Hoods; Scarves; Belts; Athletic sleeves; clothing for athletic use; combative sports uniforms, athletic tights; athletics vests; baselayer bottoms; baselayer tops; insulated clothing; thermally insulated clothing; ventilated clothing; Sports clothing; sports footwear; football boots; boots for sports; waterproof clothing.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; sports training equipment and apparatus; bar-bells; body protectors for sports use; sports balls; protective padding for playing sports; bags specially designed for sports equipment; Indoor fitness apparatus; toys; Toy action figures; Equipment for exercise; footballs.

Class 35: Advertising, marketing and promotional services; promotion of sports competitions and events; promotion of goods and services through sponsorship of sports events; promotion of goods and services of third parties; advertising for sports events; television

Class 25: sport clothes; sport footwear; sport gloves; sport headgear.

Class 28: sports guards for head, face, chest, waist, shoulder, elbow, wrists, finger, legs, knees and ankles; belts for sports.

UK00001476670 mark

Class 18: bags namely sport bags; rucksacks; waist bags.

Class 25: sport clothes; sport footwear; sport gloves; sport headgear; sports shoes, athletic shoes, sports socks, sports wear, sports gloves, sports caps; all included in Class 25.

Class 28: gymnastic and sporting articles namely belts for sports; protective pads for sports.

advertising; radio advertising; advertising via the internet; rental of advertising space on the internet; business administration; business management; public relations and promotional services relating to professional athletes; office functions; Advertising, sponsorship (promotion and marketing services) and business management of athletes; advertising, sponsorship (promotion and marketing services) of sports competitions and sports events; Retail services in relation to clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, handheld electronic games, board games, sporting articles and equipment, cosmetic products, sunglasses, headphones, watches, bags, luggage, mugs, drinking glasses, statues, statuettes, figurines, trophies and model stadia of porcelain, terracotta, glass, china or earthenware; the bringing together, for the benefit of others, of a variety of goods namely clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, handheld electronic games, board games, sporting articles and equipment, cosmetic

products, sunglasses, headphones, watches, bags, luggage, mugs, drinking glasses, statues, statuettes, figurines, trophies and model stadia of porcelain, terracotta, glass, china or earthenware; the aforementioned services all available via any communications media.

Class 41: *Education; sporting and cultural activities; organisation of sporting and cultural events and activities; entertainment services; provision of leisure and recreation facilities; provision of museum facilities, presentation of educational exhibitions; theme park services; amusement park services; amusements and amusement arcade services; production and presentation of shows and displays; arranging and conducting of exhibitions and of lectures; organisation and presentation of award ceremonies; organisation of football exhibitions; organisation of sports competitions; issuing of tickets for events, including football sports events; reservation of entry tickets to sports or entertainment events; ticket reservation services for entertainment, sporting and cultural events; hosting of exhibitions and seminars relating to sport; educational services relating to sport; production of television programmes; training services; football academy services;*

<p><i>assessment and qualifications services; provision of facilities for sports events, seminars and concerts; personal training services; arranging and conducting of workshops relating to football; providing online training and coaching videos, not downloadable; Television and radio entertainment and educational services; production of television, radio and films; Provision of information relating to television and radio programmes, entertainment, music, sport and recreation.</i></p>	
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Class 18 - Wallets; handbags; rucksacks; luggage and carrying bags; trunks and travelling bags; Umbrellas; Parasols; Walking sticks.

54. The term **rucksacks** is identically contained in both specifications. These goods are **identical**.

55. The contested **handbags; luggage and carrying bags; trunks and travelling bags** are all products typically used for storing and carrying goods from one place to another securely. They all, therefore, overlap in use, method of use and nature with **sport bags** in the opponent's specifications and are likely to be sold through the same trade channels. There may also be a degree of competition between the goods. Consequently, I consider these goods to be similar a medium to high degree. Similar considerations apply to **wallets** which overlap in users, uses, method of use, nature and trade channels with **sport bags** and **waist bags** (the overlap with the latter is probably more pronounced as waist bags are smaller in size and could be used to carry coins and cash), in the opponent's specification. Consequently, I consider the goods to be **similar to a medium to high degree**.

56. The contested **Umbrellas; Parasols; Walking sticks** the applicant's specifications do not overlap in nature, purpose, use or method of use with the

opponent's goods. I do not consider there to be an overlap in terms of trade channels. There is no competition or complementarity involved. I consider the goods to be **dissimilar**.

Class 25 - Footwear; headwear; clothing; Hats; Caps; Visors; Headbands; Bandanas; Sweatbands; Pants; Shorts; Boxing shorts; Shirts; T-shirts; Pullovers; Jerseys; Sweat shirts; Sweat pants; Underwear; Sports bras; Dresses; Skirts; Sweaters; Jackets; Coats; Socks; Gloves; Hosiery; Tights; Vests; Hoods; Scarves; Belts; Athletic sleeves; clothing for athletic use; combative sports uniforms, athletic tights; athletics vests; baselayer bottoms; baselayer tops; insulated clothing; thermally insulated clothing; ventilated clothing; Sports clothing; sports footwear; football boots; boots for sports; waterproof clothing.

57. The contested **Footwear; headwear; clothing; Hats; Caps; Visors; Headbands; Bandanas; Sweatbands; Pants; Shorts; Boxing shorts; T-shirts; Sweat shirts; Sweat pants; Underwear; Sports bras; Jackets; Coats; Socks; Gloves; Hosiery; Tights; Vests; Hoods; Athletic sleeves; clothing for athletic use; combative sports uniforms, athletic tights; athletics vests; baselayer bottoms; baselayer tops; insulated clothing; thermally insulated clothing; ventilated clothing; Sports clothing; sports footwear; football boots; boots for sports; waterproof clothing** in the applicant's specifications are either self-evidently identical to the opponent's *sport clothes; sport footwear; sport gloves; sport headgear* or can be used for sport-related activities and, as such, are encompassed by and are **identical** to the opponent's goods on the principle outlined in Meric.

58. The remaining **Shirts; Pullovers; Jerseys; Dresses; Skirts; Sweaters; Scarves; Belts**, although not strictly sport-related, are still items of casual clothing or clothing accessories and are similar to a high degree to the opponent's sport clothes. The users, uses, methods of use, nature and purpose of the goods are highly similar, and the goods share trade channels. These goods are **highly similar**.

Class 28 - Games and playthings; gymnastic and sporting articles not included in other classes; sports training equipment and apparatus; bar-bells; body protectors for sports use; sports balls; protective padding for playing sports; bags specially designed for

sports equipment; Indoor fitness apparatus; toys; Toy action figures; Equipment for exercise; footballs.

59. Under both specifications, the opponent can rely on *belts for sports* and *protective pads and guards for sports*. The contested terms ***body protectors for sports use; protective padding for playing sports; gymnastic and sporting articles not included in other classes*** are all broad enough to encompass the opponent's protective pads and guards for sports and, as such, are **identical** (Meric). The same goes for the contested ***sports training equipment and apparatus; Equipment for exercise*** which include all the tools, materials, apparel, and gear used in sport, including the opponent's pads and guards for sports and are also **identical**.

60. The contested ***bar-bells; sports balls; Indoor fitness apparatus; footballs*** are tools used to play sports. Although the goods are not identical, they are complementary, target the same users and share trade channels. These goods are **similar to a medium degree**.

61. Although the contested ***bags specially designed for sports equipment*** are in a different class, they are either identical or highly similar to the opponent's *sport bags* which can be used to carry both clothing and equipment for taking part in sports. These goods are **identical or highly similar**.

62. This leaves ***Games and playthings; toys; Toy action figures***. While the opponent's *belts for sports* and *protective pads and guards for sports* in class 18 are intended for engaging in physical exercise, the sole function of toys, games and playthings is, in principle, to entertain. The goods in comparison have different intended purposes and they are not interchangeable or in competition with each other. They are usually not produced by the same specialist undertakings and even when found in the same distribution channels (e.g. large retail stores), they will not be placed in the same specialist departments.⁹ These goods are **dissimilar**.

⁹ See also T-524/18, BILLABONG, § 44-45, 51.

Class 35 - Advertising, marketing and promotional services; promotion of sports competitions and events; promotion of goods and services through sponsorship of sports events; promotion of goods and services of third parties; advertising for sports events; television advertising; radio advertising; advertising via the internet; rental of advertising space on the internet; business administration; business management; public relations and promotional services relating to professional athletes; office functions; Advertising, sponsorship (promotion and marketing services) and business management of athletes; advertising, sponsorship (promotion and marketing services) of sports competitions and sports events; Retail services in relation to clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, handheld electronic games, board games, sporting articles and equipment, cosmetic products, sunglasses, headphones, watches, bags, luggage, mugs, drinking glasses, statues, statuettes, figurines, trophies and model stadia of porcelain, terracotta, glass, china or earthenware; the bringing together, for the benefit of others, of a variety of goods namely clothing, footwear, headgear, games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, handheld electronic games, board games, sporting articles and equipment, cosmetic products, sunglasses, headphones, watches, bags, luggage, mugs, drinking glasses, statues, statuettes, figurines, trophies and model stadia of porcelain, terracotta, glass, china or earthenware; the aforementioned services all available via any communications media.

63. As regards the similarity of these services, in its written submissions the opponent states that the services in class 35 are similar to the goods protected by the earlier registrations because they are offered in connection with sport and sport events and can be seen as complementary. Further, the opponent states that it is common for brands that manufacture the goods in classes 18, 25 and 28 (a) to have standalone retail stores and/or websites bearing the mark and (b) to sponsor and promote sport events.

64. The following **Advertising, marketing and promotional services; promotion of sports competitions and events; promotion of goods and services through sponsorship of sports events; promotion of goods and services of third parties; advertising for sports events; television advertising; radio advertising;**

advertising via the internet; rental of advertising space on the internet; public relations and promotional services relating to professional athletes; Advertising, sponsorship (promotion and marketing services) and business management of athletes; advertising, sponsorship (promotion and marketing services) of sports competitions and sports events services consist of providing others with assistance in the sale of their goods and services and in the promotion of their events. The services of **promotion of goods and services through sponsorship of sports events** must be interpreted as a service whereby the entity who provides the service assists the business/customer (that has contracted the services) in creating marketing strategies which involve the sponsorship of sport events as a way to promote the launch or sale of the goods and services offered by the business/customer. Whilst the evidence shows that the opponent has sponsored the Olympic Games and a number of athletes, those activities were undertaken by the opponent in order to advertise and sell its own goods; and whilst some big brands who manufacture sport goods might actually sponsor sport events, there is no sufficient evidence to support the conclusion that the goods and services have converged in the market in such a way that the average consumer would perceive them as complementary. Further, the mere fact that the goods covered by the earlier marks in classes 18, 25 and 28 might appear in advertisements is not sufficient for finding a similarity as the nature and purpose of the contested services is different from those of the opponent's goods, the goods and services have different uses, do not share trade channels and are neither complementary nor in competition. These services are **dissimilar**.

65. Turning to the contested **business administration; business management; office functions**, these services are mainly aimed at supporting or helping other businesses to do or improve business and are usually rendered by companies specialised in this specific field such as business consultants. Business management services are intended to help companies manage their business by setting out the strategy and/or direction of the company. They involve activities associated with running a company, such as controlling, leading, monitoring, organising, and planning. Similarly, business administration services are intended to help companies with the performance of business operations and consist of organising people and resources efficiently so as to direct activities toward common goals and objectives. Office

functions are the internal day-to-day operations of an organisation and include activities typical of secretarial services. These services have nothing in common with the earlier goods in classes 18, 25 and 28 and are **dissimilar**.

66. The contested specification in class 35 includes retail services connected with the sale of a variety of goods. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. It follows that the following retail services are **similar to a medium degree** to the opponent's goods: ***Retail services in relation to clothing, footwear, headgear, sporting articles and equipment, bags, luggage; the bringing together, for the benefit of others, of a variety of goods namely clothing, footwear, headgear, sporting articles and equipment, bags, luggage, the aforementioned services all available via any communications media.***

67. The remaining services namely ***Retail services in relation to games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, handheld electronic games, board games, cosmetic products, sunglasses, headphones, watches, mugs, drinking glasses, statues, statuettes, figurines, trophies and model stadia of porcelain, terracotta, glass, china or earthenware; the bringing together, for the benefit of others, of a variety of goods namely games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, handheld electronic games, board games, cosmetic products, sunglasses, headphones, watches, mugs, drinking glasses, statues, statuettes, figurines, trophies and model stadia of porcelain, terracotta, glass, china or earthenware; the aforementioned services all available via any communications media*** relate to goods which are dissimilar to those covered by the opponent's registrations. Hence, I find that these services are **dissimilar**.

Class 41 - Education; sporting and cultural activities; organisation of sporting and cultural events and activities; entertainment services; provision of leisure and recreation facilities; provision of museum facilities, presentation of educational

exhibitions; theme park services; amusement park services; amusements and amusement arcade services; production and presentation of shows and displays; arranging and conducting of exhibitions and of lectures; organisation and presentation of award ceremonies; organisation of football exhibitions; organisation of sports competitions; issuing of tickets for events, including football sports events; reservation of entry tickets to sports or entertainment events; ticket reservation services for entertainment, sporting and cultural events; hosting of exhibitions and seminars relating to sport; educational services relating to sport; production of television programmes; training services; football academy services; assessment and qualifications services; provision of facilities for sports events, seminars and concerts; personal training services; arranging and conducting of workshops relating to football; providing online training and coaching videos, not downloadable; Television and radio entertainment and educational services; production of television, radio and films; Provision of information relating to television and radio programmes, entertainment, music, sport and recreation.

68. The opponent states that the goods in classes 18, 25 and 28 are similar to the services in class 41 because given the broad range of goods sold under the marks, consumers would not be surprised to see the opponent endorsing a wide range of sporting activities, events and awards. This submission is misconceived insofar as the opponent endorsing a wide range of sporting activities, events and awards does not amount to providing services in class 41. As I have explained, whilst the opponent may endorse sport events and sponsor athletes, it does this for its own benefit in order to promote its brand and sell its products; it does not do it to provide a service to those who organise or attend the sport events. Likewise, when a company sponsors an athlete, it is ultimately to sell its own products. The contested services in class 41 do not have any relevant points of contact that could justify finding a level of similarity with the opponent's goods. The services at issue differ in their nature, purpose and method of use. They have distribution channels and are neither complementary, nor in competition. Therefore, they are **all dissimilar**.

69. As some similarity of goods and services is essential, the opposition under Section 5(2)(b) fails in relation to the goods and services which I found to be dissimilar, namely:

Class 18: *Umbrellas; Parasols; Walking sticks*

Class 28: *Games and playthings; toys; Toy action figures.*

Class 35: *Advertising, marketing and promotional services; promotion of sports competitions and events; promotion of goods and services through sponsorship of sports events; promotion of goods and services of third parties; advertising for sports events; television advertising; radio advertising; advertising via the internet; rental of advertising space on the internet; business administration; business management; public relations and promotional services relating to professional athletes; office functions; Advertising, sponsorship (promotion and marketing services) and business management of athletes; advertising, sponsorship (promotion and marketing services) of sports competitions and sports events; Retail services in relation to games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, handheld electronic games, board games, cosmetic products, sunglasses, headphones, watches, mugs, drinking glasses, statues, statuettes, figurines, trophies and model stadia of porcelain, terracotta, glass, china or earthenware; the bringing together, for the benefit of others, of a variety of goods namely games, toys and playthings, video game apparatus, computer games apparatus, electronic games, sports games, handheld electronic games, board games, cosmetic products, sunglasses, headphones, watches, mugs, drinking glasses, statues, statuettes, figurines, trophies and model stadia of porcelain, terracotta, glass, china or earthenware; the aforementioned services all available via any communications media.*

Class 41: *Education; sporting and cultural activities; organisation of sporting and cultural events and activities; entertainment services; provision of leisure and recreation facilities; provision of museum facilities, presentation of educational exhibitions; theme park services; amusement park services; amusements and amusement arcade services; production and presentation of shows and displays; arranging and conducting of exhibitions and of lectures; organisation and presentation of award ceremonies; organisation of football exhibitions; organisation of sports competitions; issuing of tickets for events,*

including football sports events; reservation of entry tickets to sports or entertainment events; ticket reservation services for entertainment, sporting and cultural events; hosting of exhibitions and seminars relating to sport; educational services relating to sport; production of television programmes; training services; football academy services; assessment and qualifications services; provision of facilities for sports events, seminars and concerts; personal training services; arranging and conducting of workshops relating to football; providing online training and coaching videos, not downloadable; Television and radio entertainment and educational services; production of television, radio and films; Provision of information relating to television and radio programmes, entertainment, music, sport and recreation.

Average consumer

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

71. 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.”

72. The average consumer for the contested goods and services in classes 18, 25, 28 and 35 will be a member of the general public. The goods and services will be

purchased reasonably frequently and may be relatively expensive or relatively inexpensive. Considerations such as individual taste and suitability of the product will be taken into account when selecting the goods whereas factors such as stock and price of goods offered are likely to be considered when selecting the services. I am of the view that a medium degree of attention will be paid during the purchasing process.

73. The average consumer is likely to obtain the goods through self-selection from a shelf, catalogue or online equivalent. Visual considerations will therefore dominate the selection process. However, I do not discount that there may be an aural aspect to the selection process, such as word-of-mouth recommendation or discussions with retail staff.

74. In respect of the services, I consider these would typically be available from physical retail outlets and their online equivalents. When making their selection, the average consumer would most likely consider promotional material (such as flyers, posters, media campaigns or online adverts) and signage appearing on the high street. I therefore find that visual considerations will be the most important part of the selection process however, I do not exclude aural considerations entirely given that word of mouth recommendations may also play a part.




Comparison of marks

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

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

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

76. 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. The respective marks are shown below:

The applicant’s mark	The opponent’s earlier mark
 <p>(the contested mark no.1)</p>	
 <p>(the contested mark no.2)</p>	

77. The opponent’s ASICS swirl logo is a purely figurative sign consisting of a graphic symbol. The symbol is created by a black line that curves to the left (inside to outside) whilst revolving around the point from which it emanates in an anti-clockwise elliptical direction. As the opponent’s mark consists exclusively of a device, that is the overall impression it will convey.

78. The contested mark no.1 consists of the words ‘WORLD’, ‘FOOTBALL’ and ‘AWARD’ presented in block capital letters and a figurative element. The words are displayed on three levels, with the element ‘WORLD’ placed above the element

'FOOTBALL' (in bold) and the latter placed above the element 'AWARD' (also in bold). To the left of the verbal elements there is a striking, large figurative element that consists of three swirls each curving to the right (inside to outside) in clockwise elliptical direction. This device is likely to be understood as a stylised representation of a football by the relevant public – this is common ground since, in its written submissions, the opponent states that the three swirls are positioned in a round shape *“which resemble an abstract football as claimed by the applicant in its counterstatement”*.

79. The contested mark no. 2 is very similar to the contested mark no.1, the only difference being that the word 'WORLD' is followed by the words 'FOOTBALL LIFETIME' and is placed above the word 'ACHIEVEMENT' whilst the word 'AWARD' is identically positioned below the other words.

80. The opponent argues that the words are *“completely descriptive”* in respect of the relevant goods and services and are less distinctive than the device.

81. The words 'WORLD FOOTBALL AWARD' and 'WORLD FOOTBALL LIFETIME ACHIEVEMENT AWARD' are likely to be perceived as the names of awards handed out to football teams and players as a way of marking their achievements. Whilst these words are not directly descriptive of the goods and services which I have found to be similar, they are either allusive of the fact that some of the goods concerned are football-related goods (in which case they have a weak distinctive character) or are likely to be interpreted as indicating that the (unrelated) goods sold under the mark are endorsed by the entity who sponsors the football award and/or are promotional products or merchandising.

82. In this case I find that the device and the words contribute equally in terms of relative weight to the overall impression of the contested marks because: i) the word have a weak distinctive character in relation to some of the goods concerned – this weak distinctiveness is also transferred to the unrelated goods which will be perceived as promotional items, ii) the figurative elements of the contested marks will be perceived as a football; such a perception is likely to be assisted by the presence of the word 'FOOTBALL AWARD' in the marks and iii) the perception of the device as a

football in the applicant's marks will, in turn, reinforce the meaning of the word 'FOOTBALL AWARD'. The two elements, namely the words and the device, reinforce each other and convey to the consumer the same concept; vi) the device is large in size and visually striking.

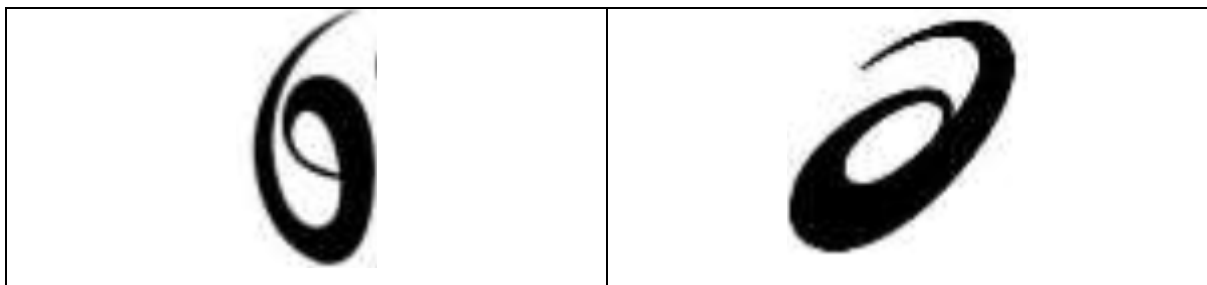
83. The upshot of this is that the principle that the first part of a trade mark tends to have a greater visual impact than the final part counteracts the basic tenet that words speak louder than devices, and both the figurative and verbal elements of the marks have the same weight in the overall impression.

Visual similarity

84. Visually, the opponent states:

"[...] the trade mark of the opponent is a spiral and a mirrored version of this trade mark can be found three times in the applications. [...] Overall there is visual similarity between the marks created by the shared, distinctive elements."

85. The swirl devices in the respective marks are shown below (I have selected the swirl whose vertical/slightly oblique position is closer to that of the opponent's mark):



86. Both signs consist of swirls that rotate in an elliptical direction.

87. As it can be seen, the tail end of the swirl in the applicant's marks is slightly longer than that in the opponent's mark, as it goes further than the corner point of the ellipse – the point at which the ellipse takes the first turn – in the applicant's mark whilst it stops before it in the opponent's mark. Also, the curved line in the opponent's mark

increases progressively in size from the inside to the outside until the first turn and then it becomes progressively slimmer until it ends, whilst the curved line in the applicant's mark stays thinner until it suddenly becomes chunkier at the first turn and then it maintains more or less the same size until the second turn when it becomes slimmer again.

88. Notwithstanding these differences and the fact that the swirls in the applicant's marks are depicted in a different position and orientation, the opponent's swirl logo and the applicant's swirls (taken as standalone elements) are similar to a **fairly high degree**.

89. However, the average consumer will not dissect the applicant's mark in such a way that it will extrapolate one swirl and perceive it separately from the other elements of the marks. On the contrary, the average consumer will perceive the three swirls placed in a circular position as one figurative element resembling a football, reducing the similarity between the figurative elements of the marks to **medium**. Finally, when the impact of the verbal elements of the applicant's marks is factored in, there is a **low degree of overall similarity** between the marks.

Aural similarity

90. The applicant's marks will be articulated as 'WORLD FOOTBALL AWARD' and 'WORLD FOOTBALL LIFETIME ACHIEVEMENT AWARD' respectively.

91. The opponent states that since its mark is a logo, no phonetic comparison can be made. The applicant states that a purely figurative element without the word ASICS cannot be pronounced but considers that the opponent's mark could be spoken as the letter 'a' or as the word 'ASICS' if associated with the opponent's brand name.

92. The most likely scenario is that the opponent's mark will not be articulated. Likewise, whilst the words in the applicant's marks will be spoken, the football device will not. Consequently, it is not possible to carry out an aural comparison of the figurative elements of the competing marks – which are the elements from which the similarity stems.

Conceptual similarity

93. The evidence shows that the opponent's device is directly related to the brand name and represents a stylised oblique letter 'a' which is the first letter of the word ASICS. However, this is unlikely to be obvious to the average consumer when the logo is used on its own. This is because the high stylisation of the sign makes it illegible and is likely to prevent the consumer from identifying it as a letter without being assisted by other elements.

94. The figurative element in applicant's marks will be conceptualised as a device of a football (a fact which is not disputed by the opponent). In addition to this, the verbal elements in the applicant's marks will convey the concept of football-related awards, which has no counterpart in the opponent's mark.

95. The opponent states that the presence in the competing marks of spiral elements creates a conceptual similarity. I agree. Even if the average consumer conceptualises the device element in the applicant's marks as a football, the highly similar graphic representation of the swirls in the respective marks means that the competing marks evoke the concept of a distinctively similar swirl or a spiral (although this is repeated three times in the applicant's marks). What I mean is that the average consumers will not simply perceive the conceptual similarity created by the devices at a general level (as two devices that represent spirals or swirls), but they will perceive it at a more specific level, namely as two devices that represent spirals or swirls that are graphically represented in a distinctive and strikingly similar manner.

Distinctive character of earlier mark

96. 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).”

97. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

98. I will begin by assessing the inherent distinctive character of the earlier mark.

99. The earlier mark is a figurative mark, consisting of a striking graphical design. The sign (being it perceived as a letter or as a symbol with no conceptual significance) does not have a relationship with the goods relied upon, directly or allusively. I consider the mark to be inherently distinctive to a medium to high degree.

100. The opponent has filed evidence of use of the mark and claims that the mark benefits from a high level of recognition in the UK and the EU which enhances its distinctive character.

101. The relevant market for assessing whether the distinctiveness of the opponent's mark has been enhanced through use is the UK market. As I have said earlier, the use of the sign is longstanding, and the opponent has provided turnover figures which enable me to conclude that it has used the mark to a very significant extent. Even if the opponent has not provided evidence of market share in the UK, the sales figures provided are huge, even for what is likely to be a significant market within the UK. My finding is, therefore, that the opponent's mark is widely known, and its distinctiveness has been enhanced to **a very high degree** for the registered goods in classes 18, 25 and 28.

Likelihood of confusion

102. 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 marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

103. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis K.C.(formally 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.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

104. Earlier in this decision I have found that although the competing marks are visually similar to a low degree, the opponent’s ASICS swirl logo and the applicant’s swirls (taken as standalone elements) are similar to a fairly high degree. Aurally and conceptually, there are differences introduced by the verbal elements of the marks which will assist the perception of the device in the applicant’s marks as a football; however, there is also a degree of conceptual similarity insofar as the average consumers will perceive the devices in the respective marks as strikingly similar graphic representations of spirals or swirls. The goods are identical or similar to various degree, from medium to high. The average consumer is a member of the

general public who will select the goods visually with a medium degree of attention, although I do not discount aural considerations. The distinctiveness of the mark has been enhanced to a very high degree.

105. Although the differences between the marks are sufficient to avoid consumers directly confusing the marks, there is in my view a likelihood of indirect confusion in this case.

106. This is because the swirls incorporated in the applicant's marks are so similar to the swirl of the opponent's logo mark that the visual differences between them will be overlooked, taking into account the principle of imperfect recollection.

107. In my view, once it is accepted – as I do - that the individual swirls of the applicant's marks are likely to be recognised by the average consumer as the opponent's highly distinctive ASICS swirl logo (because with imperfect recollection the average consumer may not notice that the swirls in the later mark are inverted), the fact that the swirls are arranged in such a way as to evoke the image of a football is not sufficient to neutralised the propensity of the swirls to give rise to a likelihood of confusion. In my view the opponent's proposition that the football device in the applicant's marks will be perceived as made up of three ASICS swirl logos holds true, because of the significant enhanced distinctive character of the ASICS swirl logo.

108. This conclusion is supported by the evidence directed at the reputation the opponent has acquired for its sponsorship activities including the sponsorship of athletes, the sponsorship of the Japanese Olympic team in 2020 and the official sponsorship of the Association of Athletic Federation (IAAF) since 2016; the latter is described in the evidence as part of the opponent's "*strategic expansion of its brand recognition internationally*".

109. Although this case does not fit squarely into any of the categories of indirect confusion exemplified by Mr Purvis, the examples of indirect confusion provided in *L.A. Sugar Trade Mark* are not exhaustive. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporates another trade mark (or a similar sign) in such a way as to lead consumers to believe

that the goods or services have been co-branded and “*that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing)*”.¹⁰ That is in my view the case here. Taking all of the above into account, I agree with the opponent that the applicant’s marks are likely to be perceived as a message that the football awards to which the signs refer (and therefore the goods and services offered under the contested signs) are co-branded/sponsored by the opponent. Finally, based on the evidence showing use of the opponent’s logo on its own (without the name ASICS), I am satisfied that the absence of the brand name ASICS does not mean that there cannot be confusion.

110. There is a likelihood of indirect confusion.

111. The partial oppositions based on Section 5(2)(b) succeed for all the goods and services which I found to be similar. I shall now turn to Section 5(3).

Section 5(3)

112. Section 5(3) states:

“(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”.

113. Section 5(3A) states:

¹⁰ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

114. 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, *Adidas-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*).

Reputation

115. 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.”

116. The relevant date to assess whether the opponent has a reputation is the filing date of the contested applications, namely 01 June 2020.

117. Based on the following factors:

- the length of use – the opponent’s ASICS swirl logo was launched in the UK in 1993 and has been used continuously since that date for nearly 30 years;
- the intensity of use in terms of turnover – the opponent has generated over £400 million turnover in the UK in latest 5-year period only;
- the marketing efforts – I refer in particular to the evidence showing that the brand has been promoted through global advertising campaigns and has built a reputation as a leading manufacturer of sport goods which supports athletics around the world as an official partner of the IAAF;
- the degree of brand recognition – I refer to the evidence showing recognition of the brand by 65% of consumers interviewed by YouGov and the evidence

about the opponent's brand being consistently ranked as one of the top Japanese brands in the period 2015-2020.

118. I am satisfied that the opponent had a strong reputation in the ASICS swirl logo in the UK at the relevant date for the goods relied upon.

Link

119. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in Intel are:

The degree of similarity between the conflicting marks. I have concluded that although the competing marks are visually similar to a low degree, the opponent's ASICS swirl logo and the applicant's swirls (taken as standalone elements) are similar to a fairly high degree. Aurally and conceptually, there are differences introduced by the verbal elements of the marks - which will assist the perception of the device in the applicant's marks as a football - but there is also a degree of conceptual similarity insofar as the average consumers will perceive the devices in the respective marks as strikingly similar graphic representations of spirals or swirls.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public. I have concluded that some of the goods and services are similar, and some are dissimilar.

The strength of the earlier mark's reputation. I have concluded that the opponent's reputation in the mark is strong.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use. I have concluded that the opponent's mark is distinctive to a very high degree as a result of the use made of it.

Whether there is a likelihood of confusion. I have concluded that there is a likelihood of indirect confusion.

120. Overall, I am satisfied that that the opponent's mark will be brought to mind by the applicant's mark due to the similarities between the figurative elements of the marks, even where dissimilar goods and services are involved.

Damage

121. In terms of damage, the opponent's claim both unfair advantage and detriment to the distinctive character.

122. The opponent's logo mark is widely known and although the words 'WORLD FOOTBALL AWARD' and 'WORLD FOOTBALL LIFETIME ACHIEVEMENT AWARD' have no counterpart in the opponent's mark, they introduce a concept, namely, that of a sport award, which relates to the field in which the opponent has a reputation.

123. Further, the opponent's reputation as a leading manufacturer of sports goods is also associated with its activity as a sponsor of the IAFF, and the opponent has also sponsored sport events like the Olympic Games and professional athletes. This will increase the likelihood that customers will understand the contested signs as indicating that the opponent sponsors the football awards to which the signs refer, even where the signs are used in relation to dissimilar goods and services (this is so, even if it is not established that the relevant public will also think that the opponent is the source of unrelated goods and services).

124. This is sufficient to establish that concurrent use of the applicant's marks is likely to result in the applicant benefitting from the opponent's logo's power of attraction, reputation and prestige and exploiting the marketing effort made by the opponent, without paying any financial compensation. The claim to unfair advantage is made out. Hence, I do not need to consider the other heads of damage.

125. The partial oppositions based on Section 5(3) succeed in relation to all of the goods and services objected to by the opponent.

Section 5(4)(a)

126. Section 5(4)(a) states:

“(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) [...]

(c)

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.”

127. 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.”

128. 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)."

129. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ 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 indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which 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 claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;

- (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 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”.

Goodwill

130. In this case the date for deciding whether the applicant's conduct amounts to passing off is the date of the applications, namely 01 June 2020. Based on my previous considerations about reputation and enhanced distinctiveness, I am satisfied that the opponent had a significant reputation and goodwill in the mark relied upon at the relevant date.

Misrepresentation

131. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

132. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

133. Accordingly, once it has been established that the party relying on the existence of an earlier right under Section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

134. In its written submissions the opponent states:

108. The goods provided under the Swirl logo are identical and similar to the goods and services in the Applications. Taking into account the similarity of the respective trademarks, there is a likelihood that the Applications could be associated with the mark of the Opponent in the sense that one could be linked to the other i.e. to members of the public it could seem goods and services provided by the Applicant are being offered by the Opponent.

109. The use of these highly similar marks by the Applicant, in the same field as that of interest to the Opponent, is likely to mislead members of the public to believe that the Applicant and its goods and services are authorised by, or otherwise connected with, the Opponent and its goods. This would lead to damage to the goodwill of the unregistered mark of the Opponent and its reputation in the same, as well as providing the Applicant with opportunity to gain an unfair advantage by free-riding on the investment of the Opponent in its brand.

135. The opponent relies on a form of misrepresentation whereby although the public would distinguish the respective goods and services (because the marks and/or the goods and services are not close enough to give rise to direct confusion), they would assume an association between them in the form of there being a common manufacturer/provider. To this the opponent added further possibility, that the public would assume that the applicant's goods and services had been authorised from the opponent. The argument is further developed by the opponent by reference to the terms 'endorsement' and 'sponsorship':

3. Within the sporting world, the Opponent's brand is so well known that consumers would presume that the presentation of its logo in a 'football' shape is a clever use of the Opponent's mark to indicate its endorsement, or sponsorship, of the relevant sporting events and awards.

136. Although the argument about 'endorsement' and 'sponsorship' was advanced within the submissions relating to the claim under Section 5(3) it can be carried to the claim under Section 5(4)(a).

137. In *Irvine v Talksport Ltd* [2003] F.S.R. 35, the Court of Appeal approved Laddie J.'s analysis that the tort of passing off was wide enough to cover false endorsement. Parker L.J. stated that:

"31. In his first judgment, Laddie J, after setting out the relevant facts, turned first to a submission made by Mr Hicks that the cause of action in passing off does not cover a case where the claimant is represented as having 'endorsed'

a particular product or service unless it can also be shown that the claimant and the defendant shared a common field of activity or that the 'endorsement' will, at least in the short term, result in some financial loss to the claimant.

32. Having conducted what is, if I may respectfully say so, an impressive analysis of the historical development of the tort of passing off, the judge rejected Mr Hicks' submission, concluding (in paragraph 38 of his judgment) that it is not necessary for a claimant who has been falsely represented as endorsing a particular product or service to establish these additional facts in order to recover substantial damages in passing off. The judge continued:

'Of course there is still a need to demonstrate a misrepresentation because it is that misrepresentation which enables the defendant to make use or take advantage of the claimant's reputation.'

33. In paragraph 46 of his judgment, the judge said this:

'It follows from the views expressed above that there is nothing which prevents an action for passing off succeeding in a false endorsement case. However, in order to succeed, the burden on the claimant includes a need to prove at least two, interrelated, facts. First, that at the time of the acts complained of he had a significant reputation or goodwill. Second, that the actions of the defendant gave rise to a false message which would be understood by a not insignificant section of his market that his goods have been endorsed, recommended or are approved of by the claimant..... '

134. See also *Robyn Rihanna Fenty v Top Shop Ltd*, [2013] EWHC 2310 (Ch), in which Birss J. held that Top Shop's use of various images of the pop star known as Rihanna on t-shirts and the like amounted to a misrepresentation that the goods were endorsed by Rihanna. The judge rejected the argument that the use of any images of Rihanna were liable to have this effect, but upheld the claim on the basis of the facts in that case. Amongst these were that the images used resembled those from the artists album covers and the defendant had previously publicly collaborated with the

artist in selling ventures intended to promote its clothing, thereby increasing the likelihood that the images at issue would signal official approval or endorsement of the goods bearing the contested images.

135. I return to what I have said above about the mark conveying the message that the opponent has sponsored the football awards to which the contested marks refer. In my view, in seeing the applicant's marks, a substantial number of customers, or potential customers, of the opponent's business would be likely to be deceived into making the false assumption that the figurative elements of the contested marks use three ASICS logos to create the image of a football leading to the belief that the opponent's business officially approve or endorse the goods and services bearing the contested images.

136. Such misrepresentation leading to the belief that the opponent is associated with the applicant will damage the opponent's goodwill even in the absence of diversion of sales.

137. The partial oppositions under Section 5(4)(a) are entirely successful.

OVERALL OUTCOME

138. The partial oppositions have been successful for all the goods and services objected to by the opponent which will be refused registration. The applicant's trade marks can proceed to registration for the goods and services which have not been opposed.

COSTS

139. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of £2,400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing and filing a TM7

and considering the counterstatement:

£500

Filing evidence:	£1,500
Written submissions:	£500
Official fees:	£400
Total	£2,400

140. I therefore order World Champion Imprint Club Limited to pay Kabushiki Kaisha Asics trading as Asics Corporation the sum of £2,400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 1st day of November 2022

Teresa Perks
For the Registrar