

o/0041/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003536293 AND UK00003585511

BY THE BIG HORSE SHOP

TO REGISTER THE TRADE MARKS:

EPIC RIDER

IN CLASSES 18 AND 25

AND

EPIC EQUESTRIAN

IN CLASSES 18 AND 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NOS. 423134 AND 426381

BY SCANDINAVIAN TRAVEL INNOVATION AB

BACKGROUND AND PLEADINGS

1. On 23 September 2020, The Big Horse Shop Ltd (“the applicant”) applied to register the **EPIC RIDER** mark (“**293 Mark**”) shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 6 November 2020. The applicant seeks registration for the following goods:

Class 18 LUGGAGE, BAGS, BELTS, UMBRELLAS, LEATHER GOODS.

Class 25 FOOTWEAR; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Baselayer bottoms; Baselayer tops.

2. On 27 January 2021, the applicant also applied to register the **EPIC EQUESTRIAN** mark (“**511 Mark**”) shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 28 May 2021. The applicant seeks registration for the following goods:

Class 18 Clothing for horses; horse blankets; horse exercise sheets; rugs and covers; Horse boots being protective leg and hoof wear for horses; Harnesses and saddlery; leather strapping; bridles; headbands; halters; reins; nosebands; saddle girths; martingales; saddle pads; saddle cloths; numnahs; tail covers for horses; reflective leg bands for horses; riding gear bags; clothing for animals; knee-pads; leads; leashes; leg-wraps; horse masks; muzzles; saddle bags; bridle bags; grooming bags; tack bags; saddle covers; saddle protectors; Dog coats; dog coats treated with wax; quilted dog coats; wallets; purses; suit carriers; bags; back packs; fanny packs; bum bags; luggage; luggage bags; wash bags; handbags; shoulder bags; umbrellas; Bags for Footwear.

Class 25 Clothing, footwear and headgear; hats and hat frames; caps; underwear; clothing for horse riding; Jodhpurs; Riding Breeches; Leggings; footwear for horse riding; Riding Boots; Clothing for sportswear; baselayers; leisure clothing; gym clothing; articles of clothing; outer clothing;

overcoats; jackets; articles of clothing coated with wax; articles of quilted clothing; articles of waterproof clothing; Fleeces; Tweed Coats; Tweed Jackets; Capes; Blousons; Vests; Liners; Mackintoshes; Blazers; Waistcoats; Gilets; Body Warmers; Sweaters; Pullovers; Jumpers; Cardigans; Shorts; Trousers; Over Trousers; Jeans; Blouses; Shirts; Shirts (long sleeved); Shirts (short sleeved); T-Shirts; T-Shirts (Long Sleeved); T-Shirts (Short Sleeved) Polo Shirts; Polo Shirts (Short Sleeved); Polo Shirts (Long Sleeved); Polo-necks; Rugby Shirts; Hats; Hats made of Leather; Hats made of Wool; Tweed Hats; Hats Coated with Wax; Caps; Hoods; Scarves; Cravats; Socks; Gloves; Inner Gloves; Gloves made of Leather; Mittens; Fingerless Gloves; Belts (made of Fabric); Ties; Shoes; Boots; Walking Boots; Waterproof Boots; Waterproof Shoes; Wellington Boots; Gaiters; Gaiters (coated with Wax); leather gloves; leather hats; leather jackets; leather coats; Sweat shirts; sweat pants; sweat bands; Belts.

3. The applications were opposed by Scandinavian Travel Innovation AB (“the opponent”) on 8 February 2021, and 24 August 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark:

EPIC

International registration no. 912817

International registration date 5 May 2006

Date of designation granted in UK 7 September 2008

Relying upon all of the goods for which the mark is registered, namely:

Class 18 Bags, travelling bags, rucksacks, wallets and purses, wheeled shopping bags; not including any such goods designed for fishing.

4. The opponent claims that the goods are identical or similar, and the marks are highly similar.

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is represented by Potter Clarkson LLP and the applicant is represented by Taylors Legal Services Limited. Neither party requested a hearing, however, both parties filed evidence in chief and submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

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

EVIDENCE

8. The applicant's evidence consists of the first witness statement of Joanne Exton dated 20 November 2021. Ms Exton is the Director and owner of the applicant, a position in which she has held since 2009. Ms Exton's witness statement was accompanied by 6 exhibits (1-6).

9. The opponent's evidence consists of the witness statement of Harrison Lee dated 16 March 2022. Mr Lee is a Senior Associate at Potter Clarkson LLP who is the opponent's representative in this matter. Mr Lee's statement was accompanied by 3 exhibits (HL1-HL3).

10. The applicant's evidence also consists of the second witness statement of Joanne Exton dated 16 May 2022. Ms Exton's statement was accompanied by 1 exhibit (JE-1).

11. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to it where necessary below.

PRELIMINARY ISSUE

12. In the above witness statements, multiple references are made to the applicant's UK00002556172 ("**172 Mark**") 'Epic' trademark, that I intend to address as a preliminary issue.

13. In her first witness statement, Ms Exton references the 172 trademark, which was registered back in 2010. In Mr Lee's witness statement, he also references the 172 Mark, and encloses it as an exhibit at **HL1**. Mr Lee notes that "this registration is not for the word EPIC, per se, but is for a figurative trade mark containing the word EPIC dwarfed by the representation of a horse's head". I note that this mark is clearly depicted on its "equestrian luggage" as demonstrated in **exhibits 1 to 6** of Ms Exton's first witness statement. In Ms Exton's second witness statement, further reference is made to the 172 Mark, highlighting that there has been "extensive use" of the mark on clothing since 2012 and bags since 2016.

14. Ms Exton also references the opponent, and how it "has minimal presence in the UK" as it only has 3 UK "bricks and mortar" outlets, whereas the opponent has 608 outlets throughout Europe. Ms Exton states that the opponent's mark which is registered for class 18, "is heavily, if not solely, concentrated on the travel market. Thus it is not surprising that the Applicant's and the Opponent's brands have co-existed without any risk of confusion for almost 10 years".

15. Firstly, for the purposes of these proceedings, the opposition is directed against the 293 and 522 Marks. Therefore, any reference to the applicants prior 172 Mark is irrelevant.

16. Secondly, the applicant in question 7 in both Forms TM8, had ticked 'no' to the opponent providing proof of use of its mark. Therefore, the opponent is entitled to rely upon its full specification without demonstrating use of its mark or how it has marketed and sold its goods in the UK. Furthermore, the submission that the opponent only sells its goods in 3 UK "bricks and mortar" outlets, again, does not assist the applicant. I have to carry out a notional assessment based on the marks and the goods before

me. The way in which the marks and goods are used in practice is not relevant to my assessment.

17. Lastly, in Mr Lee's witness statement, he attaches screenshots in **exhibit HL2** of the applicant's website. He states the following:

"6. From the archived extracts of the website that I have seen, there was no reference to the trade mark EPIC EQUESTRIAN, for any goods up to July 2021.

[...]

8. Based on the information available from <https://web.archive.org/> and the statement of Joanne Exton, I have not seen use of EPIC EQUESTRIAN or the related mark EPIC RIDER prior to 2021. There was no evidence on the website that the goods for the person have been available prior to July 2021."

18. I note that the above information is irrelevant in these proceedings, which does not assess whether the applicant has used their marks.

DECISION

19. Section 5(2) reads as follows:

"5(2) A trade mark shall not be registered if because –

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

(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.”

20. The earlier mark has completed its registration process more than five years before the relevant date (the filing date of the marks in issue). Accordingly, the use provisions at s.6A of the Act do apply. However, as the applicant did not request that the opponent prove use of its mark, it is entitled to rely upon all of the goods without demonstrating that it has used the mark.

Section 5(2)(b) case law

21. 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

22. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 18</u> Bags, travelling bags, rucksacks, wallets and purses, wheeled shopping bags; not including any such goods designed for fishing.</p>	<p><u>EPIC RIDER 293 Mark</u> <u>Class 18</u> LUGGAGE, BAGS, BELTS, UMBRELLAS, LEATHER GOODS.</p> <p><u>Class 25</u> FOOTWEAR; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Baselayer bottoms; Baselayer tops.</p> <p><u>EPIC EQUESTRIAN 511 Mark</u> <u>Class 18</u> Clothing for horses; horse blankets; horse exercise sheets; rugs and covers; Horse boots being protective leg and hoof wear for horses; Harnesses and saddlery; leather strapping; bridles; headbands; halters; reins; nosebands; saddle girths; martingales; saddle pads; saddle cloths; numnahs; tail covers for horses; reflective leg bands for horses; riding gear bags; clothing for animals; knee-pads; leads; leashes; leg-wraps; horse masks; muzzles; saddle bags; bridle bags; grooming bags; tack bags; saddle covers; saddle protectors; Dog coats; dog coats treated with wax; quilted dog coats. wallets; purses; suit carriers; bags; back packs; fanny packs; bum bags; luggage; luggage bags; wash</p>

bags; handbags; shoulder bags; umbrellas; Bags for Footwear.

Class 25

Clothing, footwear and headgear; hats and hat frames; caps; underwear; clothing for horse riding; Jodhpurs; Riding Breeches; Leggings; footwear for horse riding; Riding Boots; Clothing for sportswear; baselayers; leisure clothing; gym clothing; articles of clothing; outer clothing; overcoats; jackets; articles of clothing coated with wax; articles of quilted clothing; articles of waterproof clothing; Fleeces; Tweed Coats; Tweed Jackets; Capes; Blousons; Vests; Liners; Mackintoshes; Blazers; Waistcoats; Gilets; Body Warmers; Sweaters; Pullovers; Jumpers; Cardigans; Shorts; Trousers; Over Trousers; Jeans; Blouses; Shirts; Shirts (long sleeved); Shirts (short sleeved); T-Shirts; T-Shirts (Long Sleeved); T-Shirts (Short Sleeved) Polo Shirts; Polo Shirts (Short Sleeved); Polo Shirts (Long Sleeved); Polo-necks; Rugby Shirts; Hats; Hats made of Leather; Hats made of Wool; Tweed Hats; Hats Coated with Wax; Caps; Hoods; Scarves; Cravats; Socks; Gloves; Inner Gloves; Gloves made of Leather; Mittens; Fingerless Gloves; Belts (made of Fabric); Ties; Shoes; Boots; Walking Boots; Waterproof Boots;

	Waterproof Shoes; Wellington Boots; Gaiters; Gaiters (coated with Wax); leather gloves; leather hats; leather jackets; leather coats; Sweat shirts; sweat pants; sweat bands; Belts.
--	--

23. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors

25. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

26. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

27. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

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

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

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

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

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

EPIC RIDER 293 Mark

Class 18

BAGS

30. “Bags” appears identically in both specifications.

LUGGAGE

31. I consider that the applicant’s above goods falls within the broader category of “travelling bags” in the opponent’s specification. I consider them identical on the principle outlined in *Meric*.

LEATHER GOODS.

32. I consider that the opponent’s class 18 “bags”, “wallets” and “purses” would fall within the applicant’s broader category of “leather goods”. I consider the goods identical on the principle outlined in *Meric*.

BELTS, UMBRELLAS.

33. I do not consider that the applicant’s above goods would overlap with the opponent’s class 18 goods. I do not consider that there would be an overlap in trade channels, method of use, nature or purpose. They would not be selected as part, or with the intention to, create a ‘coordinated look’.¹ They are neither complementary nor competitive. Albeit there is an overlap in user, this is not enough on its own to establish similarity. Consequently, the goods are dissimilar.

¹ *El Corte Ingles SA v OHIM*, Case T-443/05, paragraphs 42-51, and *ASOS v ASSOS*, Case T-647/11 paragraphs 45-52

Class 25

Articles of clothing made of leather; Articles of outer clothing.

34. In *Gitana SA, v OHIM*, Case T-569/11, the General Court ('GC') stated that:

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

35. It is clear from the *Gitana* case, outlined above, that goods such as handbags are considered as similar to at least a medium degree to clothing. This is because they are thought to be accessories for clothing, to create a co-ordinated look, and are generally sold in the same retail environment to the same consumers, leading them to think that the respective goods are produced by the same undertaking.

Articles of sports clothing.

36. I do consider that sports clothing is used to create a co-ordinated look, or paired with accessories, such as bags. Therefore, I do not consider that similarity can be established between the applicant's articles of sports clothing and the opponent's bags. The goods do not overlap in purpose, nature and method of use. I note that they may potentially be sold in the same general retail outlet, however, they would not be sold in the same aisle. The goods are not complementary, and they are not in competition. Consequently, they are dissimilar.

Articles of underclothing; Baselayer bottoms; Baselayer tops.

37. I also do not consider that the applicant's above goods would be used to create a co-ordinated look with the opponent's bags on the basis that they are garments that are worn under clothing, and therefore are unlikely to require co-ordination. The goods do not overlap in purpose, nature and method of use. I note that they may potentially be sold in the same general retail outlet, however, they would not be sold in the same aisle. The goods are neither complementary nor in competition. Therefore the goods are dissimilar.

FOOTWEAR

38. In *Giordano Enterprises Ltd v OHIM* (case T-483/08) the GC stated:

"22. In respect of the goods in Class 18 for which the applicant seeks registration of its trade mark, the Board of Appeal observed in substance, firstly, that the goods listed in the last sentence of paragraph 9 above, essentially bags of different sorts, made of leather or imitations of leather, are often sold with goods in Class 25 at points of sale in both major retail establishments and more specialised shops and, secondly, that such bags are complementary to footwear in that they share a common aesthetic function by jointly contributing to the image of the consumer concerned.

23. The first of those observations directly echoes the case-law of the Court, to the effect that goods in Class 18, namely leather and imitation leather goods not included in other classes such as handbags and purses, are often sold with goods in Class 25, to which 'footwear' belongs, at points of sale in both major retail establishments and more specialised shops (*PiraÑam*, paragraph 10 above, paragraph 45, and *Tsakiris-Malla*, paragraph 20 above, paragraph 32). Moreover the Court emphasised, in those same judgments, that this is a factor which must be taken into account in assessing the similarity of such goods.

24. Although the applicant claims that the points of sale of footwear and bags are often different, it does not contest the observation that those items are sold in the same retail outlets, both specialised and general. In those circumstances, it is appropriate to hold that both the goods in Class 18 listed in the last sentence of paragraph 9 above and 'footwear' are, at least sometimes, sold in the same specialised retail outlets as well as in major retail establishments. That observation is relevant to the assessment of similarity between the goods at issue.

25. As regards the observation that the goods in Class 18 listed in the last sentence of paragraph 9 above are complementary to footwear in that they share a common aesthetic function, the Court observed in Case T-150/04 *Mulhens v OHIM – Minoronzoni (TOSCA BLU)* [2007] ECR II-2353, paragraph 35, invoked by the applicant in support of its arguments, that goods whose nature, purpose and method of use are different may be aesthetically complementary in the eyes of the relevant public, particularly in business sectors such as fashion. It further observed, at paragraph 36 of the same judgment, that in order to give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 40/94, this aesthetically complementary nature must involve a genuine aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSE ROSSI)* [2005] ECR II-685, paragraphs 60 and 62, and *PiraÑam*, paragraph 10 above, paragraphs 48 and 49).

26. Contrary to the applicant's argument, that case-law, in particular *TOSCA BLU* (paragraph 25 above), does not require that use of one product must necessarily be 'indispensable' for the use of the other product in order for a finding of similarity to be made on the basis that the goods at issue are aesthetically complementary. In fact, the Court indicated that it was sufficient that the use of one product be 'important' for the use of the other.

27. In the present case, it is appropriate to observe that some consumers may perceive a close connection between 'footwear' in Class 25 and the goods in Class 18 listed in the last sentence of paragraph 12 above, on the basis that they are aesthetically complementary, since both categories of goods may be regarded as accessories and may contribute jointly to the external image of the consumer concerned. That observation provides an indication that the goods at issue may be considered to be similar, in the sense that one is important for the use of the other and customers may therefore think that the responsibility for the production of those goods lies with the same undertaking (see, to that effect, *PiraÑam*, paragraph 10 above, paragraphs 48 to 51).

28. However, the Court also held in *TOSCA BLU* (paragraph 25 above, paragraph 37) that the fact that the goods at issue have an aesthetically complementary nature, such as that referred to in the previous paragraphs, is not enough to establish similarity between those goods on its own.

29. In the present case, the Board of Appeal relied not only on the fact that the goods at issue were aesthetically complementary but also on the consideration, which the Court has also found to be valid in the present judgment, that both the goods in Class 18 listed in the last sentence of paragraph 9 above and 'footwear' are, at least sometimes, sold in the same specialised retail outlets as well as in major retail establishments. It is thus appropriate to hold, on the basis of those two mutually reinforcing considerations, that the Board of Appeal did not err in holding that those two categories of goods are similar within the meaning of Article 8(1)(b) of Regulation No 40/94, at least to a certain degree."

39. Taking the above case law into account, I consider that the opponent's class 18 bags, and the applicant's class 25 footwear, is similar to between a low and medium degree.

EPIC EQUESTRIAN 511 mark

Class 18

Suit carriers; bags; back packs; fanny packs; bum bags; luggage; luggage bags; wash bags; handbags; shoulder bags; Bags for Footwear.

40. All of the applicant's above goods falls within the broader category of "bags" and/or "travelling bags" in the opponent's specification. I consider the goods identical on the principle outlined in *Meric*.

Wallets; purses.

41. "Wallets" and "purses" appears identically in both specifications.

Saddle bags; bridle bags; grooming bags; tack bags.

42. I consider that the applicant's above goods, are all types of bags in relation to horse riding. However, as the opponent has the wider category of "bags" in its specification, I consider that all types of bags would be covered. Therefore, I consider the goods identical on the principle outlined in *Meric*.

Clothing for horses; horse blankets; horse exercise sheets; rugs and covers; Horse boots being protective leg and hoof wear for horses; Harnesses and saddlery; bridles; headbands; halters; reins; nosebands; saddle girths; martingales; saddle pads; saddle cloths; numnahs; tail covers for horses; reflective leg bands for horses; riding gear bags; knee-pads; leg-wraps; horse masks; muzzles; saddle covers; saddle protectors.

43. I consider that the applicant's above goods, which are all in relation to horses and horse riding, are dissimilar to the opponent's class 18 goods. The goods do not overlap

in nature, method of use, purpose and user because the applicant's goods are to be worn by horses. They will not overlap in trade channels because the applicant's goods would be sold by horse-riding specialist undertakings. The goods are neither complementary nor in competition. Consequently, the opponent's class 18 goods are dissimilar to the applicant's above goods.

Dog coats; dog coats treated with wax; quilted dog coats

44. I consider that a similar comparison applies as above, however, instead, the applicant's goods are to be worn by dogs. Therefore, these goods will most likely be sold in pet stores. However, I also appreciate that some general department stores may also distribute all of the opponent's and applicant's goods, but they will be sold in different aisles. Taking all of the above into account, the opponent's class 18 goods are dissimilar to the applicant's above goods.

Clothing for animals

45. I consider that a similar comparison applies as above, however, the applicant's goods could be worn by a variety of different animals, including cats. The trade channels, method of use, nature, purpose and user all differ from the opponent's class 18 bag goods. They are not in competition nor complementary. Consequently, the goods are dissimilar.

Leads; leashes.

46. I consider that the applicant's above goods are dissimilar to all of the opponent's class 18 bags. I note that whilst all of the goods could be made from leather, this is not sufficient in itself to establish similarity. The goods do not overlap in nature, purpose and method of use as leads and leashes are used to walk domestic animals. The opponent's goods are to be worn and used as accessories by the general public. I do not consider that there would be an overlap in trade channels. There may be an overlap in user, to the extent that they may all be purchased by members of the general public, however, this is not enough on its own to establish similarity. The goods are

neither in competition nor complementary. Taking the above into account, I consider the applicant's goods are dissimilar to the opponent's goods.

Leather strapping.

47. I consider that the applicant's above goods are dissimilar to all of the opponent's class 18 bags. As established in *Les Éditions Albert René v OHIM*,² it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of similarity between those goods. Therefore, although the opponent's bags could be made with leather strapping, this is not sufficient in itself to establish similarity. Although the applicant's leather strapping would most likely be used to make other goods, such as belts and bags, I do not consider that it overlaps in trade channels, method of use, nature and user with the opponent's bags, which are the finished product ready for sale in retail stores. The applicant's goods would be sold by leather specialists onto those who would then make the bags. The goods are therefore not in competition nor complementary. Taking the above into account, I consider that the goods are dissimilar.

Umbrellas

48. The same comparison applies in paragraph 33 above. The goods are dissimilar.

Class 25

49. I consider that the strongest comparison to be made with the applicant's goods in class 25 is the opponent's class 18 bags (as highlighted by the above case law, *Gitana SA, v OHIM*). Therefore, if similarity cannot be established with bags, it wouldn't be established with the opponent's remaining goods in class 18.

Clothing; articles of clothing; Outer clothing; overcoats; jackets; Tweed Coats; Tweed Jackets; Capes; Mackintoshes; Blazers; leather jackets; leather coats.

² Case T-336/03

50. It is clear from the Gitana case that handbags can be thought as accessories for clothing, to create a co-ordinated look, and therefore similarity can be established. I consider that outer clothing, the most visible part of the users look, would be co-ordinated with the users handbag to create a cohesive look. Especially as the applicant's goods are more formal-wear pieces. I consider that the goods would be sold in the same retail environment and the consumers would think that the respective goods are produced by the same undertaking. Consequently, I consider that the applicant's above goods are similar to the opponent's bags to at least a medium degree.

Articles of clothing coated with wax; articles of quilted clothing; articles of waterproof clothing.

51. I consider that the applicant's above goods would cover outer clothing which is usually worn to keep the user warm and dry. Therefore, I consider that the same comparison applies in paragraph 50 above. I consider that the applicant's above goods are similar to the opponent's bags to at least a medium degree.

Jumpers; Cardigans.

52. I consider that a similar comparison applies in paragraphs 50 and 51 above. Jumpers and cardigans are outer garments. Jumpers can be worn just by themselves on the top half of the user. Cardigans will most likely be worn over a top to keep the user warm. Therefore, I consider that the user would want to match their outer garments, which can be worn for more formal occasions, with their bags, in order to create a co-ordinated look. The goods will be sold in the same retail environment. The consumers would think that the respective goods are produced by the same undertaking. Therefore, I consider that the applicant's above goods are similar to the opponent's bags to at least a medium degree.

Blousons; Blouses; Shirts; Shirts (long sleeved); Shirts (short sleeved).

53. I consider that the user of the applicant's above blouses and shirts would match them with their handbag, whether that be for work or to a more formal occasion. I

consider that this is especially the case because blouses and shirts can be worn just by themselves, for example, without a jacket or coat etc. I consider that the goods would be sold in the same retail environment and the consumers would think that the respective goods are produced by the same undertaking. Consequently, I consider that the applicant's above goods are similar to the opponent's bags to at least a medium degree.

Gloves made of Leather; leather gloves.

54. I consider that a user would want to co-ordinate and accessorise their leather gloves with a leather handbag to create a cohesive look. I consider that the goods would be sold in the same retail environment and the consumers would think that the respective goods are produced by the same undertaking. I therefore consider that the applicant's above goods are similar to the opponent's bags to at least a medium degree.

Headgear; Hats; Hats; Hats made of Leather; Hats made of Wool; Tweed Hats; Hats Coated with Wax; Leather hats.

55. I consider that the applicant's above hats are those which are more formal in nature, and therefore, the user would want to co-ordinate, and accessorise, their formal hats with a handbag made from the same material (e.g. leather or tweed). I consider that the goods would be sold in the same retail environment and the consumers would think that the respective goods are produced by the same undertaking. Therefore, I consider that the applicant's above goods are similar to the opponent's bags to at least a medium degree.

Footwear; Shoes; Boots; Walking Boots; Waterproof Boots; Waterproof Shoes; Wellington Boots.

56. The same comparison applies in paragraph 39. I consider that the opponent's class 18 bags, and the applicant's class 25 footwear, is similar to between a low and medium degree.

Fleeces; Gilets; Body Warmers; Sweaters; Pullovers.

57. Albeit the applicant's above goods are outer-garments, I consider that these goods are casual wear which wouldn't be worn to a formal occasion/outing. Therefore, I do not consider that the wearer of these goods would want to match or co-ordinate these items with a handbag to create a cohesive look. The goods do not overlap in purpose, nature and method of use. I note that they may potentially be sold in the same general retail outlet, however, they would not be sold in the same aisle. The goods are not complementary, and they are not in competition. Consequently, I consider that the applicant's above goods are dissimilar to the opponent's bags.

Shorts; Trousers; Over Trousers; Jeans.

58. The applicant's above goods are to be worn on the lower half of the users body. I note these goods are also outer-wear. However, I do not consider that the user of these goods would want to match their bags with their shorts or trousers to create a co-ordinated look. The goods do not overlap in purpose, nature and method of use. I note that they may potentially be sold in the same general retail outlet, however, they would not be sold in the same aisle. The goods are not complementary, and they are not in competition. Therefore, I consider that the opponent's bags and the applicant's above goods are dissimilar.

T-Shirts; T-Shirts (Long Sleeved); T-Shirts (Short Sleeved) Polo Shirts; Polo Shirts (Short Sleeved); Polo Shirts (Long Sleeved); Polo-necks.

59. I consider that the applicant's above goods, are causal wear items, that the user will wear day-to-day. Therefore I do not consider that the user will want to co-ordinate, or accessorise, their casual tops with their bags to create a cohesive look. The goods are therefore not complementary, nor in competition. The goods do not overlap in purpose, nature and method of use. I note that they may potentially be sold in the same general retail outlet, however, they would not be sold in the same aisle. I consider that the opponent's bags and the applicant's above goods are dissimilar.

Clothing for sportswear; leisure clothing; gym clothing; Rugby Shirts; Sweat shirts; sweat pants; sweat bands.

60. I consider that the same comparison applies in paragraph 36 above. The opponent's bags and the applicant's above sports and leisurewear goods are dissimilar.

Underwear; baselayers; Vests; Liners.

61. I consider that the same comparison applies in paragraph 37 above. The opponent's bags and the applicant's above under-garment/underwear goods are dissimilar.

Caps; Caps.

62. I consider that the applicant's caps are worn day-to-day for practical reasons such as to protect the user from the sun. Therefore, I do not consider that they would be worn to create a co-ordinate a look with a bag. The goods do not overlap in purpose, nature and method of use. I note that they may potentially be sold in the same general retail outlet, however, they would not be sold in the same aisle. The goods are not complementary, and they are not in competition. Consequently, I consider that the opponent's bags and the applicant's above goods are dissimilar.

Scarves; Socks; Gloves; Inner Gloves; Mittens; Fingerless Gloves; Belts (made of Fabric).

63. The applicant's above goods are to be worn for practical purposes, such as to keep the user warm, or to hold up their trousers. Therefore, they are not chosen to be matched with the users bag to create a co-ordinated look. The goods are not complementary, nor in competition. The goods do not overlap in purpose, nature and method of use. I note that they may potentially be sold in the same general retail outlet, however, they would not be sold in the same aisle. Therefore, I consider that the opponent's bags and the applicant's above goods are dissimilar.

Waistcoats.

64. I consider that the applicant's waistcoats are formal wear pieces which would be worn most likely by men. I do not consider that they would chose to co-ordinate their waistcoats with a bag, instead they would ensure that it matches their suit (trousers and jacket). Therefore the goods are not complementary, nor are they in competition. The goods do not overlap in purpose, nature and method of use. I note that they may potentially be sold in the same general retail outlet, however, they would not be sold in the same aisle. Therefore, I consider that the opponent's bags and the applicant's above goods are dissimilar.

Cravats; Ties.

65. I also consider that although the applicant's cravats and ties are more formal wear pieces, and the user, who would most likely be male, would not chose to co-ordinate them with a bag. The goods are stand alone pieces to complement the users suit. The goods do not overlap in purpose, nature and method of use. I note that they may potentially be sold in the same general retail outlet, however, they would not be sold in the same aisle. The goods are not complementary, and they are not in competition. The applicant's above goods and the opponent's bags are therefore dissimilar.

Gaiters; Gaiters (coated with Wax)

66. I note that gaiters are a waterproof covering for the ankle mostly worn by climbers.³ I therefore consider that these goods would not be worn to co-ordinate with, or accessorise, a bag. The goods are therefore not complementary, nor in competition. The goods do not overlap in purpose, nature and method of use. I consider it unlikely that the goods would be sold in the same retail environment, as the applicant's goods are more niche and specialised for climbers. However, if they were, they would not be sold in the same aisle. Therefore, the applicant's above goods and the opponent's bags are therefore dissimilar.

³ <https://www.collinsdictionary.com/dictionary/english/gaiter> accessed 11 January 2023

Hat frames; Hoods.

67. I consider that the applicant's above goods, are parts of headgear and clothing. The goods do not overlap in trade channels, because the applicant's goods would be purchased wholesale to be used in the production of the finished article, which would then be on sale to the general public. The opponent's goods would be sold in general retail outlets. I therefore do not consider that there is an overlap in user. The goods do not overlap in purpose, method of use or nature. they are neither in competition nor complementary. Therefore, the opponent's bags and the applicant's hat frames and hoods are dissimilar.

Clothing for horse riding; Jodhpurs; Riding Breeches; Leggings.

68. The Gitana case above establishes that goods such as bags are considered as similar to at least a medium degree to clothing. This is on the basis that bags are thought to be accessories for clothing, and therefore can be co-ordinated, and are also generally sold in the same retail environment.

96. I consider that the applicant's above goods would overlap with the opponent's bags which would cover *bridle bags; grooming bags; tack bags*, which are all types of horse-riding bags, as they would be sold from the same specialised equestrian undertaking. There would also be an overlap in user. However, these goods are not complementary as they would not be worn as accessories to create a "co-ordinated look". They are all used for practical purposes for horse riding. The goods do not overlap in nature, method of use or purpose, nor are they in competition. Therefore, I consider that the applicant's above goods are similar to the opponent's bags to a low degree.

Footwear for horse riding; Riding Boots.

69. The same consideration applies at paragraphs 39 and 56 above. I consider that the opponent's class 18 bags, which would cover all types of horse-riding bags, is similar to the applicant's class 25 (horse) riding boots and footwear, to between a low and medium degree.

Belts.

71. The same comparison applies in paragraph 33 above. The applicant's "belts" are dissimilar to the opponent's "bags".

72. It is a prerequisite of section 5(2)(b) that the goods be identical or at least similar. The opposition will, therefore, fail in respect of the above goods that I have found to be dissimilar.⁴

73. The opposition under section 5(2)(b) fails for the following goods:

EPIC RIDER 293 Mark

Class 18 *BELTS, UMBRELLAS.*

Class 25 Articles of sports clothing; Articles of underclothing; Baselayer bottoms; Baselayer tops.

EPIC EQUESTRIAN 511 Mark

Class 18 Clothing for horses; horse blankets; horse exercise sheets; rugs and covers; Horse boots being protective leg and hoof wear for horses; Harnesses and saddlery; leather strapping; bridles; headbands; halters; reins; nosebands; saddle girths; martingales; saddle pads; saddle cloths; numnahs; tail covers for horses; reflective leg bands for horses; riding gear bags; clothing for animals; knee-pads; leads; leashes; leg-wraps; horse masks; muzzles; saddle covers; saddle protectors; Dog coats; dog coats treated with wax; quilted dog coats; umbrellas.

Class 25 Hat frames; caps; underwear; clothing for horse riding; Jodhpurs; Riding Breeches; Leggings; Clothing for sportswear; baselayers; leisure clothing; gym clothing; Fleeces; Vests; Liners; Waistcoats; Gilets; Body

⁴ eSure Insurance v Direct Line Insurance, [2008] ETMR 77 CA

Warmers; Sweaters; Pullovers; Shorts; Trousers; Over Trousers; Jeans; T-Shirts; T-Shirts (Long Sleeved); T-Shirts (Short Sleeved) Polo Shirts; Polo Shirts (Short Sleeved); Polo Shirts (Long Sleeved); Polo-necks; Rugby Shirts; Caps; Hoods; Scarves; Cravats; Socks; Gloves; Inner Gloves; Mittens; Fingerless Gloves; Belts (made of Fabric); Ties; Gaiters; Gaiters (coated with Wax); Sweat shirts; sweat pants; sweat bands; Belts.

The average consumer and the nature of the purchasing act

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

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

75. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability.

76. Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

77. The goods are likely to be obtained by self-selection from the shelves of a clothing retail outlet, online or catalogue equivalent. This means that the mark will be seen and so the visual element of the mark will be the most significant: see *New Look Limited v OHIM*, Joined cases T-117/03 to T-119/03 and T-171/03, paragraph 50. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.

Comparison of the trade marks

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

79. 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.

80. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade marks
<p>EPIC</p>	<p>EPIC RIDER (“293 Mark”)</p> <p>EPIC EQUESTRIAN (“511 Mark”)</p>

Overall Impression

81. The opponent's mark consists of the word EPIC. There are no other elements to contribute to the overall impression which lies in the word itself.

82. The 293 Mark consists of the words EPIC RIDER, in a stylised typeface. I consider that the word “RIDER” is descriptive for some of the applicant's horse-riding goods. Therefore, I consider that the word EPIC plays a greater role in the overall impression of the mark, with the word RIDER and stylisation playing a lesser role, but not negligible.

83. The 511 Mark consists of the words EPIC EQUESTRIAN. I consider that the word “EQUESTRIAN” is descriptive for some of the applicant's goods. Therefore, I consider that the word EPIC plays a greater role in the overall impression of the mark, with the word EQUESTRIAN playing a lesser role, but not negligible.

Visual Comparison

The opponent's mark and the 293 mark

84. The marks coincide in the presence of the word EPIC. This acts as a visual point of similarity. The applicant's mark ends in the word RIDER. It is also presented in a

slightly stylised typeface. This is a visual point of difference. However, I note that the average consumer tends to pay for attention to the beginning of marks. I also bear in mind that registration of a word only mark covers use in any standard typeface. Therefore, I consider that the marks are similar to a medium degree.

The opponent's mark and the 511 mark

85. The marks coincide in the presence of the word EPIC. This acts as a visual point of similarity. However, the applicant's mark ends in the word EQUESTRIAN. Therefore, I consider that the marks are similar to a medium degree.

Aural Comparison

The opponent's mark and the 293 mark

86. The opponent's mark will be pronounced as EH-PIC. The applicant's mark will be pronounced as EH-PIC RYE-DER. As the marks overlap in the pronunciation of EPIC, I consider that the marks are aurally similar to a medium degree.

The opponent's mark and the 511 mark

87. The applicant's mark will be pronounced as EH-PIC EE-QUEST-TREE-AN. As the marks overlap in the pronunciation of EPIC, I consider that the marks are aurally similar to a medium degree.

Conceptual Comparison

The opponent's mark and the 293 mark

88. Conceptually, both marks contain the word EPIC. I consider that the average consumer would assign it the ordinary dictionary definition of something "very large

and impressive”.⁵ I note that this word is laudatory (expresses praise and commendation).

89. The applicant’s mark contains the word RIDER, which is also an ordinary dictionary word/term used for someone who rides a horse, bicycle or motorbike. I consider that this element is descriptive of some of the applicant’s goods which are aimed towards, and used during horse riding.

90. Regardless, as both marks overlap in the meaning of EPIC, I consider that the marks are conceptually similar to a medium degree.

The opponent’s mark and the 511 mark

91. The same considerations apply above. However, the applicant’s mark ends in the word EQUESTRIAN (instead of RIDER). EQUESTRIAN is also an ordinary dictionary word which means connected with the activity of riding horses.⁶ I consider that this is descriptive of some of the applicant’s goods.

92. Regardless, as both marks overlap in the meaning of EPIC, I consider that the marks are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

93. 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

⁵ <https://www.collinsdictionary.com/dictionary/english/epic> accessed 11 December 2022

⁶ <https://www.collinsdictionary.com/dictionary/english/equestrian> accessed 11 December 2022

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of 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).”

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

95. As highlighted above, the opponent’s mark consists of the word EPIC, which has an ordinary dictionary definition (something that is very large and impressive).

96. The applicant submits that “when used as an objective, the Opponent’s Mark may be said to be descriptive, as it alludes to size, particularly largeness, which is a common selling point for bags, particularly luggage and rucksacks”.

97. Although I do not agree that the word EPIC is wholly descriptive, I do consider that it is laudatory i.e. their bags are epic, and therefore they are impressive.

98. Therefore, taking the above into account, I consider that the opponent’s mark is inherently distinctive to between a low and medium degree.

Likelihood of confusion

99. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods 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 trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

100. The following factors must be considered to determine if a likelihood of confusion can be established:

- The opponent's mark consists of the word EPIC. There are no other elements to contribute to the overall impression which lies in the word itself.
- The 293 Mark consists of the words EPIC RIDER. I consider the word EPIC plays a greater role in the overall impression of the mark, with the descriptive word RIDER (for some of the goods) playing a lesser role.
- The 511 Mark consists of the words EPIC EQUESTRIAN. I consider the word EPIC plays a greater role in the overall impression of the mark, with the descriptive word EQUESTRIAN (for some of the goods) playing a lesser role.
- I have found all of the marks to be visually, aurally and conceptually similar to a medium degree.
- I have found the opponent's mark to be inherently distinctive to between a low and medium degree.

- I have identified the average consumer to be members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical and similar to varying degrees, but I have also found some goods to be dissimilar.

101. I recognise that the word EPIC is laudatory, i.e. the goods are impressive, and therefore is inherently distinctive to between a low and medium degree. However, I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.

102. Therefore, taking all of the factors listed in paragraph 99 into account, bearing in mind the principle of imperfect recollection, I consider there is a likelihood of direct confusion only on the applicant's riding or equestrian related goods. This is particularly the case given the medium degree of visual similarity between the marks and the predominantly visual purchasing process. As established above, the beginning of marks tend to make more of an impact than the ends. Therefore, as the applicant's marks both begin with the word EPIC, and the opponent's mark in its totality is the word EPIC, I consider that the average consumers may overlook the words RIDER and EQUESTRIAN in the applicant's marks, especially as they are descriptive of the applicant's riding and equestrian goods. Consequently, I consider there to be a likelihood of direct confusion, only for the applicant's riding or equestrian goods.

103. In the event that I am wrong in that regard, and for the sake of completeness, I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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.”

104. I consider that the shared common use of the word EPIC in all of the marks will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I therefore find a likelihood of indirect confusion, however, only for the applicant’s riding or equestrian goods because the average consumer will see the additional words RIDER or EQUESTRIAN, in the applicant’s marks, as descriptive of those goods.

105. The average consumer will therefore perceive them as alternative marks for a sub-brand of ‘EPIC’ specifically focussed on riding and equestrian goods. Therefore, as the average consumer will perceive the marks as originating from the same or economically linked undertakings, I consider there to be a likelihood of indirect confusion for the applicant’s riding and equestrian goods.

106. For the applicant’s remaining goods, which are not riding or equestrian related, I do not consider that there is a likelihood of direct or indirect confusion. This is on the basis that the words RIDER and EQUESTRIAN in the applicant’s marks are no longer descriptive, and therefore are unusual words to be used on non-riding goods. I, therefore, do not consider that the words RIDER or EQUESTRIAN would be overlooked in the applicant’s marks for there to be a likelihood of direct confusion. I also do not consider that the addition of the words RIDER or EQUESTRIAN would be seen as a logical brand extension when none of the goods are riding or equestrian related. Therefore, I do not consider there to be a likelihood of indirect confusion.

CONCLUSION

107. The opposition is partially successful in respect of the following goods, for which the application is refused:

EPIC EQUESTRIAN 511 Mark

Class 18 Saddle bags; bridle bags; grooming bags; tack bags.

Class 25 Footwear for horse riding; Riding Boots.

108. The application can proceed to registration in respect of the following goods for which the opposition has been unsuccessful:

EPIC RIDER 293 Mark

Class 18 LUGGAGE, BAGS, BELTS, UMBRELLAS, LEATHER GOODS.

Class 25 FOOTWEAR; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Baselayer bottoms; Baselayer tops.

EPIC EQUESTRIAN 511 Mark

Class 18 Clothing for horses; horse blankets; horse exercise sheets; rugs and covers; Horse boots being protective leg and hoof wear for horses; Harnesses and saddlery; leather strapping; bridles; headbands; halters; reins; nosebands; saddle girths; martingales; saddle pads; saddle cloths; numnahs; tail covers for horses; reflective leg bands for horses; riding gear bags; clothing for animals; knee-pads; leads; leashes; leg-wraps; horse masks; muzzles; saddle covers; saddle protectors; Dog coats; dog coats treated with wax; quilted dog coats; wallets; purses; suit carriers; bags; back packs; fanny packs; bum bags; luggage; luggage

bags; wash bags; handbags; shoulder bags; umbrellas; Bags for Footwear.

Class 25 Clothing, footwear and headgear; hats and hat frames; caps; underwear; clothing for horse riding; Jodhpurs; Riding Breeches; Leggings; Clothing for sportswear; baselayers; leisure clothing; gym clothing; articles of clothing; outer clothing; overcoats; jackets; articles of clothing coated with wax; articles of quilted clothing; articles of waterproof clothing; Fleeeces; Tweed Coats; Tweed Jackets; Capes; Blousons; Vests; Liners; Mackintoshes; Blazers; Waistcoats; Gilets; Body Warmers; Sweaters; Pullovers; Jumpers; Cardigans; Shorts; Trousers; Over Trousers; Jeans; Blouses; Shirts; Shirts (long sleeved); Shirts (short sleeved); T-Shirts; T-Shirts (Long Sleeved); T-Shirts (Short Sleeved) Polo Shirts; Polo Shirts (Short Sleeved); Polo Shirts (Long Sleeved); Polo-necks; Rugby Shirts; Hats; Hats made of Leather; Hats made of Wool; Tweed Hats; Hats Coated with Wax; Caps; Hoods; Scarves; Cravats; Socks; Gloves; Inner Gloves; Gloves made of Leather; Mittens; Fingerless Gloves; Belts (made of Fabric); Ties; Shoes; Boots; Walking Boots; Waterproof Boots; Waterproof Shoes; Wellington Boots; Gaiters; Gaiters (coated with Wax); leather gloves; leather hats; leather jackets; leather coats; Sweat shirts; sweat pants; sweat bands; Belts.

COSTS

109. The applicant has enjoyed a greater degree of success in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I will make an appropriate reduction in the award of costs made to reflect the applicant's only partial success. In the circumstances, I award the applicant the sum of **£700** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£150
---	------

Preparing and filing evidence	£350
Preparing and filing submissions in lieu	£200
Total	£700

110. I therefore order Scandinavian Travel Innovation AB to pay The Big Horse Shop Ltd the sum of £700. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of January 2023

L FAYTER

For the Registrar