

O/0345/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003751703

BY HONGKONG TOPHUNTER CO., LIMITED

TO REGISTER THE TRADE MARK:

TOPHUNTER

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 433752 BY

HUNTER BOOT LIMITED

BACKGROUND AND PLEADINGS

1. On 7 February 2022, Hongkong Tophunter Co., Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 25 February 2022 and registration is sought for the following goods:

Class 9 Spectacle cases; Camera casings; Sunglass cases; Lens cases; Computer cases; Eyewear cases; Glasses cases; Battery cases; Camera cases; Eyeglass cases; Phone cases; Laptop cases; Camcorder cases; Pince-nez cases; Eye glass cases; Waterproof camera cases; Memory card cases; Cases for headphones; Waterproof smartphone cases; Mobile phone cases; Cellular telephone cases; Cases for eyewear; Cases for smartphones; Camcorder waterproof cases; Cases for telephones; Contact lens cases; Mobile telephone cases; Cases for sunglasses; Computer carrying cases; Laptop carrying cases; Cases for spectacles; Cases for eyeglasses; Cases for loudspeakers.

2. On 24 May 2022, the application was opposed by Hunter Boot Limited (“the opponent”) based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b), the opponent relies upon the following trade marks:

HUNTER

UKTM no. 2493452

Filing date 24 July 2008; registration date 19 December 2008

Relying on some goods for which the mark is registered, namely:

Class 18 Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks; luggage; briefcases; travel bags; wallets; purses; wash bags; belts (made of leather); suit carriers; backpacks; leather gloves; game bags; gun slings and cartridge bags; boot and footwear bags.

(“the First Earlier Mark”)



UKTM no. 800993373

Filing date 23 January 2009; registration date 26 April 2010

Priority date 24 July 2008

Class 18 Leather and imitations of leather; and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas; parasols and walking sticks; luggage; briefcases; travel bags; wallets; purses; wash bags; belts (made of leather); suit carriers; backpacks; leather gloves; game bags; gun slings and cartridge bags; boot and footwear bags.

("the Second Earlier Mark")

3. The opponent claims that the trade marks are similar and that the goods are identical or similar, resulting in a likelihood of confusion.

4. Under section 5(3), the opponent relies upon the First and Second Earlier Marks. In addition to the class 18 goods listed above, the opponent also claims a reputation in relation to the class 25 goods of the First and Second Earlier Marks, namely:

Class 25 Clothing, footwear, headgear, boots; welts for boots and shoes; non-slipping devices for boots; inner soles; heels and soles for footwear; insoles for boots and shoes; liners for boots and shoes; bags and pouches adapted to carry boots and shoes; socks, hats, gloves, scarves; waterproof footwear; galoshes; garters; headbands; jackets; jerseys; jumpers; knitwear; neck ties; outer clothing; aprons; overalls; chef's hats; chef's whites; overcoats; pyjamas; pants; sandals; flip-flops; shirts; shoes; slippers; sun visors and caps; sweaters; swimsuits; t-shirts; top hats; top coats; trousers; underclothing; underpants and underwear; fishing vests, waistcoats and waterproof clothing; sports clothing; sports footwear; after-sports footwear, belts and money belts.

The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of the First and Second Earlier Marks.

5. Under section 5(4)(a), the opponent relies upon the sign **HUNTER** which it claims to have used throughout the UK since 1956 in relation to "clothing apparel, boots, bags and umbrellas". The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

6. The applicant filed a counterstatement denying the claims made. I have no submissions from the applicant other than those contained within the counterstatement and so I reproduce them in full here:

"Our trade mark "TOPHUNTER" is not similar and Totally [sic] different to an earlier trade mark "HUNTER" obviously and is to be registered for not identical and/or not similar goods and services.

Use our trade mark [sic] would not take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

Where the use of our trade mark would be not contrary to any relative law in fact, including the law of passing off."

7. The applicant is unrepresented and the opponent is represented by HGF Limited. Only the opponent filed evidence. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in the form of the witness statement of Rigel Moss McGrath dated 3 October 2022. Ms McGrath is the chartered trade mark attorney

acting on behalf of the opponent in these proceedings. Her evidence is accompanied by 11 exhibits.

9. The opponent filed written submissions in lieu dated 13 January 2023.

10. I have taken the evidence and submissions into account in reaching my decision.

RELEVANCE OF EU LAW

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 Act relied upon 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.

DECISION

Section 5(2)(b)

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

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

(a)...

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

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

13. 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.”

14. By virtue of their earlier filing/priority dates, the First and Second Earlier Marks qualify as earlier marks pursuant to section 6 of the Act. Although they had completed their registration processes more than 5 years before the application date of the mark in issue (and are subject to the proof of use provisions in section 6A), the applicant has not requested that the opponent provide proof of use. Consequently, the opponent can rely upon all of the goods identified.

15. 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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

16. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p data-bbox="193 306 336 338"><u>Class 18</u></p> <p data-bbox="193 360 794 891">Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, parasols and walking sticks; luggage; briefcases; travel bags; wallets; purses; wash bags; belts (made of leather); suit carriers; backpacks; leather gloves; game bags; gun slings and cartridge bags; boot and footwear bags.</p>	<p data-bbox="799 306 922 338"><u>Class 9</u></p> <p data-bbox="799 360 1398 1332">Spectacle cases; Camera casings; Sunglass cases; Lens cases; Computer cases; Eyewear cases; Glasses cases; Battery cases; Camera cases; Eyeglass cases; Phone cases; Laptop cases; Camcorder cases; Pince-nez cases; Eye glass cases; Waterproof camera cases; Memory card cases; Cases for headphones; Waterproof smartphone cases; Mobile phone cases; Cellular telephone cases; Cases for eyewear; Cases for smartphones; Camcorder waterproof cases; Cases for telephones; Contact lens cases; Mobile telephone cases; Cases for sunglasses; Computer carrying cases; Laptop carrying cases; Cases for spectacles; Cases for eyeglasses; Cases for loudspeakers.</p>

17. When making the comparison, all relevant factors relating to the goods 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.”

18. Guidance on this issue has also 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.

19. 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.”

Camera casings; lens cases; battery cases; camera cases; camcorder cases; waterproof camera cases; memory card cases; camcorder waterproof cases;

20. These could all include cases used to transport camera/camcorders or their parts. The opponent submits that these goods are similar to the applicant's "travel bags" because they have a shared purpose of protecting goods during transit, they are likely to be similar to each other in nature and may be offered through the same trade channels to the same users. I accept that they could all be used by members of the general public. The purpose will overlap only to the extent that they are used to transport/carry goods; the specific purposes will differ. The method of use will overlap only in the action of putting other goods into the cases/bags. The nature may overlap as both could be made of the same materials. However, the specific nature will differ as the applicant's goods will be shaped to accommodate the goods they are intended to carry, whereas the opponent's goods will be large enough to carry a range of goods of varying size. In the absence of any evidence to the contrary, I consider it unlikely that there will be an overlap in trade channels. There is no competition or complementarity. Consequently, I consider the goods to be similar to between a low and medium degree.

Spectacle cases; Sunglass cases; Eyewear cases; Glasses cases; Eyeglass cases; Pince-nez cases; Eye glass cases; Cases for eyewear; Cases for sunglasses; Cases for spectacles; Cases for eyeglasses;

21. The opponent submits that "cases for sunglasses" are similar to the opponent's "travel bags" for the same reasons set out above. It does not make any submissions in relation to the other goods listed here, but as they are all cases for eyewear, I assume that the same reasoning will apply to them all. The same reasoning applies as set out at paragraph 20 above. I consider the goods to be similar to between a low and medium degree. I can see no other point of similarity which puts the opponent in a stronger position.

Computer cases; Laptop cases; Computer carrying cases; Laptop carrying cases;

22. In my view, these goods are clearly similar to “briefcases” in the opponent’s specification. The users will clearly overlap. They are likely to overlap in nature as they may be made of the same materials and are likely to be similar in terms of size and shape. The method of use and purpose of the goods will overlap. I consider it likely that there will be an overlap in trade channels. There may be a degree of competition as the user may choose to purchase either a laptop case or a briefcase that could be used to carry their laptop (and other goods). Consequently, I consider these goods to be highly similar.

Phone cases; Waterproof smartphone cases; Mobile phone cases; Cellular telephone cases; Cases for smartphones; Cases for telephones; Mobile telephone cases;

23. I consider that there may be an overlap in trade channels with the opponent’s “briefcases” and “wallets”. This is because businesses may sell a range of goods for carrying valuables such as phones, credit cards and laptops. The nature may overlap to the extent that they may be made of the same material although the size and shape will clearly differ. The purpose will overlap to the extent that they are all intended to carry/transport goods, although the specific purpose will differ as they are used for different goods. The method of use will overlap only in the action of putting other goods in them. There will clearly be an overlap in user. I do not consider there to be competition or complementarity. Taking this into account, I consider the goods to be similar to a medium degree.

Contact lens cases;

24. These goods are typically sold by retailers who sell contact lenses. Consequently, I can see no point of overlap in trade channels with the opponent’s goods. The nature of the goods will differ as the applicant’s goods are typically designed to be of a size and material to hold contact lenses in a liquid solution. The method of use of the goods will overlap only to the extent that both parties’ goods may be used to put things in. The overlap in purpose will be very limited. Clearly, there could be an overlap in user. I do not consider there to be competition or complementarity. Taking all of this into

account, I consider the goods to be dissimilar. If I am wrong in this finding, they will be similar only to a very low degree.

Cases for headphones; Cases for loudspeakers.

25. The same reasoning will apply to these goods as set out in paragraph 20. I consider the goods to be similar to between a low and medium degree.

The average consumer and the nature of the purchasing act

26. 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 (as he then was) 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.”

27. The average consumer for the goods will be a member of the general public or a professional user (in the case of cases for camera equipment). The goods are unlikely to be particularly expensive, but will be relatively infrequent purchases. Various factors are likely to be taken into consideration such as material, aesthetics and any protective qualities. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

28. The goods are likely to be selected following perusal of signage on physical premises, websites and advertisements. Consequently, visual considerations will

dominate the selection process. However, given that advice may be sought from sales assistants, I do not discount that there will also be an aural component to the purchase.

Comparison of trade marks

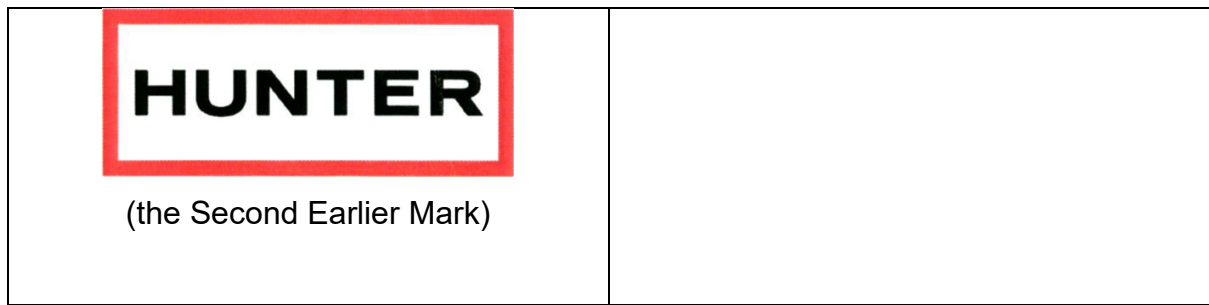
29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed 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.”

30. 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.

31. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
HUNTER (the First Earlier Mark)	TOPHUNTER



Overall Impression

32. The applicant's mark consists of the conjoined words TOP and HUNTER. Although conjoined, these words will be identified as two separate dictionary words by the average consumer. There are no other elements to contribute to the overall impression of the mark which lies in the combination of these words. The First Earlier Mark consists of the word HUNTER. There are no other elements to contribute to the overall impression of the mark, which lies in the word itself. The Second Earlier Mark consists of the word HUNTER in bold font, surrounded by a red rectangular outline. The eye is naturally drawn to the element of the mark that can be read and so the text element plays the greater role in the overall impression, with the red outline playing a lesser role.

Visual Comparison

33. The First Earlier Mark is replicated identically in the applicant's mark. However, in the applicant's mark, it is conjoined with the word TOP (which appears before it). Consequently, I consider there to be between a medium and high degree of visual similarity between the marks.

34. The same applies to the Second Earlier Mark, although the red outline acts as a further point of visual difference. Consequently, I consider the marks to be visually similar to a medium degree.

Aural Comparison

35. As the red outline in the Second Earlier Mark will not be articulated, the same aural comparison will apply to both earlier marks. The word HUNTER will be articulated identically in all three marks. However, the word TOP in the applicant's mark will be a point of aural difference. Taking all of this into account, I consider the marks to be aurally similar to between a medium and high degree.

Conceptual Comparison

36. The word HUNTER will be given its ordinary dictionary meaning in all three marks i.e. someone who hunts wild animals for sport or food. The opponent submits as follows:

“TOP’ is another word for ‘BEST’ in the English language and therefore it is a laudatory term. The consumer may perceive the trade mark to be, in effect ‘BEST HUNTER’ and in this respect there is a strong conceptual similarity between the Parties [sic] trade marks.”

I agree that the word TOP in the applicant's mark, when combined with the word HUNTER, is likely to be seen as indicating the best or most successful hunter. The red outline in the Second Earlier Mark does not convey any particular message. Taking all of this into account, I consider the marks to be conceptually similar to between a medium and high degree.

Distinctive character of the earlier trade marks

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

38. 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 distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

39. I note that the majority of the opponent’s evidence focuses upon use of the earlier marks in relation to footwear. As these goods are not relied upon under section 5(2)(b) this evidence does not assist the opposition under this ground. However, bearing in mind that the relevant market for assessing enhanced distinctiveness is the UK market, I note the following:

- a) An article dated 9 October 2019 noted that the opponent had placed a series of giant inflatable backpacks around London.¹

¹ Exhibit RMM6

- b) Hunter backpacks appeared in *Vogue* (September 2017), *On The Radar* (April 2019), *Conde Naste Traveller* (April 2019), *The Guardian* (August 2018), *The Sunday Telegraph* (September 2018), *ES Magazine* (February 2019), *You Magazine* (January 2019) and *Mail Online* (January 2019).²
- c) The opponent was Runner Up in the *Independent's* Best Backpacks for women article in October 2018.³
- d) A range of goods, including backpacks, were launched in collaboration with Disney in December 2018, to celebrate the launch of the new *Mary Poppins* film.⁴ However, these are listed in US dollars and so it is not clear to me whether these were available/marketed in the UK.
- e) To mark the 15th anniversary of the *Peppa Pig* television series, the opponent launched a range of goods, including backpacks.⁵

40. Whilst the above evidence clearly shows that the opponent's marks have been referenced in UK publications, I have been provided with no information about promotional/marketing spend, turnover or market share. Consequently, I am not satisfied that the opponent's evidence is sufficient to establish enhanced distinctiveness. I have, therefore, only the inherent position to consider.

41. The First Earlier Mark consists of the word HUNTER. It is an ordinary dictionary word, with no allusive qualities for the goods. Consequently, I consider it to be inherently distinctive to a medium degree. The Second Earlier Mark consists of the same word in a bold font, surrounded by a red outline. I do not consider that the red outline raises the distinctiveness of the Second Earlier Mark to any significant degree. Consequently, I find it to also be inherently distinctive to a medium degree.

² Exhibit RMM8

³ Exhibit RMM8

⁴ Exhibit RMM10

⁵ Exhibit RMM10

Likelihood of confusion

42. 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 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, 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.

43. I have found as follows:

- a) The goods vary from being similar to a very low degree to highly similar (except where I have found them to be dissimilar).
- b) The average consumer is a member of the general public or a professional user (for some of the goods) who will pay a medium degree of attention during the purchasing process.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The First Earlier Mark and the opponent's mark are visually, aurally and conceptually similar to between a medium and high degree.

- e) The Second Earlier Mark and the opponent's mark are visually similar to a medium degree and conceptually and aurally similar to between a medium and high degree.
- f) The earlier marks are inherently distinctive to a medium degree.

44. Given its position at the beginning of the applicant's mark, I consider it unlikely that the word TOP will be overlooked and that the marks will be mistakenly recalled or misremembered as each other. Consequently, I do not consider there to be a likelihood of direct confusion.

45. I will now consider whether there is indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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)".

46. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

47. Given that the word TOP, when combined with the word HUNTER, may be seen as indicating the best or most successful, it is my view that this may be viewed by the average consumer as a non-distinctive addition indicating a premium sub-brand. Consequently, I consider there to be a likelihood of indirect confusion for those goods that I have found to be similar to at least a medium degree. Where there is greater distance between the goods, I consider that this will offset the similarity between the marks and there will be no likelihood of confusion.

48. The opposition based upon section 5(2)(b) succeeds in relation to the following goods:

Class 9 Computer cases; Phone cases; Laptop cases; Waterproof smartphone cases; Mobile phone cases; Cellular telephone cases; Cases for smartphones; Cases for telephones; Mobile telephone cases; Computer carrying cases; Laptop carrying cases.

Section 5(3)

49. Section 5(3) of the Act states:

“5(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 and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

50. Section 5(3A) of the Act states:

“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.”

51. 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*).

52. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks and the applicant's mark are similar. Secondly, the opponent must show that the earlier marks have achieved a knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Finally, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

53. There are plenty of examples of the opponent's wellington boots being referenced in UK publications. These include the opponent's wellington boots being worn by famous people, such as the Royal Family. However, I have been provided with no turnover figures, no market share information, no advertising/promotional expenditure, and no information about the geographical spread of sales within the UK market. These are all very relevant pieces of information that I would expect an opponent to

provide when seeking to demonstrate a reputation.⁶ In the absence of this information, and taking the evidence as a whole into account, I am not satisfied that the opponent has demonstrated the requisite reputation and the opposition based upon section 5(3) fall at the first hurdle.

54. However, even if I am wrong in that finding, I do not consider that this ground would have put the opponent in any stronger position. The opponent's evidence focuses predominantly on wellington boots. Any reputation that does exist would be in relation to these goods specifically. However, they differ in nature, method of use and purpose to the remaining goods in the applicant's specification. I consider it unlikely that there would be any overlap in trade channels between them and they are not complementary or in competition. Whilst there may be an overlap in user, this is not sufficient on its own for a finding of similarity. Consequently, the goods are dissimilar. Given the distance between the remaining goods in the applicant's specification and the opponent's wellington boots, I do not consider it likely that a link would be made or, if a link was made, that any damage would arise.

55. The opposition based upon section 5(3) is dismissed.

Section 5(4)(a)

56. Section 5(4)(a) of the Act states as follows:

“5(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)...

⁶ *General Motors*, Case C-375/97

b) ...

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

57. Subsection (4A) of section 5 of the Act 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.”

58. I can deal with this ground relatively swiftly. Again, there are clearly issues with the opponent’s evidence which would make it difficult for me to assess the extent of the opponent’s goodwill in the UK. However, in any event, I do not consider that this ground would put the opponent in any stronger position. As I explained above, the majority of the opponent’s evidence relates to wellington boots. Any goodwill that could be established by the evidence provided would be in relation to those goods only. Given the distance between those goods and the applicant’s goods, I do not consider that a misrepresentation would occur or that any damage would arise.

59. The opposition based upon section 5(4)(a) is dismissed.

CONCLUSION

60. The opposition is successful in relation to the following goods for which the application is refused:

Class 9 Computer cases; Phone cases; Laptop cases; Waterproof smartphone cases; Mobile phone cases; Cellular telephone cases; Cases for smartphones; Cases for telephones; Mobile telephone cases; Computer carrying cases; Laptop carrying cases.

61. The opposition is unsuccessful in relation to the following goods for which the application may proceed to registration:

Class 9 Spectacle cases; Camera casings; Sunglass cases; Lens cases; Eyewear cases; Glasses cases; Battery cases; Camera cases; Eyeglass cases; Camcorder cases; Pince-nez cases; Eye glass cases; Waterproof camera cases; Memory card cases; Cases for headphones; Cases for eyewear; Camcorder waterproof cases; Contact lens cases; Cases for sunglasses; Cases for spectacles; Cases for eyeglasses; Cases for loudspeakers.

COSTS

62. The applicant has enjoyed the greater degree of success and so would ordinarily be entitled to a contribution towards their costs. As the applicant is unrepresented it would ordinarily be invited to file a costs proforma if it wished to claim costs in these proceedings. This has not yet been done and so **the applicant is given a period of 14 days from the date of this decision in which to file a costs proforma if it wishes to claim costs.** I will then issue a supplementary costs decision.

APPEAL

63. The appeal period for this decision will not begin to run until I have issued my supplementary costs decision.

Dated this 6th day of April 2023

S WILSON

For the Registrar