

**BL O/0357/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003503307**

**BY SIMPSON PERFORMANCE PRODUCTS, INC.**

**TO REGISTER THE TRADE MARK:**

**BANDIT**

**IN CLASSES 9, 18 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 422832**

**BY ANDREAS FREUNDLIEB**

## **CONTEXT OF THIS REMITTED DECISION**

1. This decision is to determine opposition proceedings brought against the trade mark application made by Simpson Performance Products, Inc. (“the applicant”). The contested application is detailed below. The opposition has been brought by Andreas Freundlieb (“the opponent”) based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”).

2. The UK IPO trade mark Tribunal has previously issued a decision in this matter which was published under the British Library (BL) reference number O/812/22. That decision was the subject of an appeal, which was heard by Mr Phillip Johnson sitting as the Appointed Person (“the AP”). The appeal decision was published under BL number O/0197/23. The AP found that the earlier mark was found, incorrectly, to be invalid, and this meant, in turn, that the oppositions under sections 5(1) and 5(2)(a) of the Act needed to be decided.

## **BACKGROUND AND PLEADINGS**

3. On 22 June 2020, 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 the 20 November 2020. The applicant seeks registration for the following goods:

Class 9        Safety clothing for the motor sports industry, in particular safety helmets, suits, gloves, shoes and socks for protection in the event of accidents and fire; racing harnesses.

Class 18       Backpacks, suitcases, briefcases, bum bags, handbags, bags and wallets, luggage tags, leather shaving kits, and travel bags, all also made of leather.

Class 25       Jackets, gloves, pants, headwear, motorcycle clothing, protective motorcycle clothing, all also made of leather.

4. The application was opposed by the opponent on the 19 January 2021. The opponent relies upon the following trade mark:

# **BANDIT**

UK registration no. UK00003258521

Filing date 22 September 2017.

Registration date 23 February 2018.

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

Class 9      Safety helmets.

5. The opponent claims that its marks are identical, its class 9 goods are identical, and therefore the application should be refused under section 5(1).

6. The opponent claims that there is a likelihood of confusion because the marks are identical, and its goods are similar under section 5(2)(a).

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

8. The opponent is represented by Kilburn & Strode LLP and the applicant is represented by K&L Gates LLP. A hearing took place on 7 July 2022, which was attended by Charlotte Blythe of Counsel for the applicant, and the opponent was not present at the hearing and therefore filed submissions in lieu of attendance. Both parties filed evidence in chief and submissions, and the opponent filed evidence in reply. 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.

9. 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.

## DECISION

10. Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trademark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

11. 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

[...]

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

12. The earlier mark had not completed its registration process more than five years before the relevant date (the application date of the mark in issue).

13. Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used the mark.

### Identity of the marks

14. It is a prerequisite of sections 5(1) and 5(2)(a) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

15. Both the opponent's and applicant's marks are the word BANDIT. They are self-evidently identical.

16. In making this decision, I bear in mind the following principles 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**

17. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
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<p><u>Class 9</u> Safety helmets.</p>	<p><u>Class 9</u> Safety clothing for the motor sports industry, in particular safety helmets, suits, gloves, shoes and socks for protection in the event of accidents and fire; racing harnesses.</p> <p><u>Class 18</u> Backpacks, suitcases, briefcases, bum bags, handbags, bags and wallets, luggage tags, leather shaving kits, and travel bags, all also made of leather.</p> <p><u>Class 25</u> Jackets, gloves, pants, headwear, motorcycle clothing, protective motorcycle clothing, all also made of leather.</p>
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18. 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.”

19. 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

20. In *Gérard Meric v OHIM*, 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 für 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.”

21. 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.”

22. 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 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.”

### Class 9

23. In CX02 BL O/393/19, Professor Phillip Johnson as Appointed Person stated as follows:

“Once such an admission is made it is deemed to be conclusively proved (a formal admission is sometimes called a “waiver of proof”: Phipson on Evidence (19th Ed), paragraph 4-03). This means neither party can lead evidence contrary to the admitted fact and, accordingly, a Hearing Officer cannot find a fact contrary to the admission (as doing so is the same as finding facts contrary to the evidence).<sup>1</sup>

24. At the hearing, Ms Blythe stated that:

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<sup>1</sup> Paragraph 33

“We accept the goods in class 9 are all identical or similar to the product safety helmets. In those circumstances, we do not dispute that there would be a likelihood of confusion given the identity of the marks. Class 9 we do not dispute.”

25. It is therefore unnecessary for me to undertake a comparison of the class 9 goods as this issue has been conceded by Ms Blythe.

### Class 18

26. At the hearing, Ms Blythe stated the following:

“Class 18 comprises various different leather bags as well as wallets, luggage tags and shaving kits. We say those goods have a different target market in that “safety helmets” are geared at motorcycle drivers or racing drivers whereas the class 18 products are geared at the general public. They will be sold through different trade channels and have different purposes, for example, safety versus fashion, or safety versus a method of carrying things, or safety versus shaving. Again, there is also no complementarity. Just because these goods are leather it does not mean they will be worn or used while riding a motorcycle [...] most motorcyclists wear it because it protects them, but it does not necessarily mean that a leather backpack would be carried by a motor cycle driver. We say if they are, there is no assumption they will have the same commercial origin. These are not products that are commonly used together.”

27. I agree with the above submissions. The goods do not overlap in nature, method of use, purpose or trade channels. They are also neither in competition nor complementary. Furthermore, even if there was an overlap in user, this is not enough on its own to establish similarity. Therefore the goods are dissimilar.

### Class 25

28. Ms Blythe also stated the following regarding the applicant’s class 25 goods at the hearing:

“I think we have to draw a distinction between some of the goods [...] “Jackets, gloves, pants, all made of leather” is just fashion material. Jackets, gloves, pants, we say are generic items of clothing, with different target users, different purposes again, and made from leather, which is a common fashion material. We say different they are trade channels and purposes, and there is no evidence they are the same suppliers etc. We say that those are dissimilar goods.

With regards to the other goods in class 25, “headwear, motorcycling clothing, protective motorcycle clothing”, I cannot make that same submission. Plainly they are going to be similar to a degree with safety helmets, and have some complementarity, but we say the level of similarity is low. We are not talking specifically about helmets here, we are talking about any other type of clothing, so worn on different parts of the body, different in nature. Again, there is no evidence of sales of those types of products alongside safety helmets, so we do not know if they are complementary or similar trade channels, etc. those are our submissions on those goods and services.”

29. The opponent’s “safety helmets” overlaps with the applicant’s “headwear”. I note that the goods overlap in nature, method of use, purpose and user as all of the goods are to be worn on the users head. However, I note that the opponent’s goods will be made out of a sturdier plastic, and worn specifically for safety purposes. Therefore, I consider that the goods are similar to between a medium and high degree.

30. I agree that the applicant’s “motorcycle clothing, protective motorcycle clothing, all also made of leather” overlaps with the opponent’s “safety helmets”. I consider that the goods will overlap in purpose and user as they are to be worn whilst riding a motorcycle. There will also be an overlap in distribution channels, as the goods would be sold by general motorcycle undertakings which provides clothing and accessories for riders of all abilities. However, as highlighted by Ms Blythe, the applicant’s goods are to be worn on the body (torso, arms and legs) whereas the opponent’s goods are worn on the users head. They are also made from different materials, with the applicant’s goods made from leather, and the opponent’s helmets made from sturdier plastics. The goods are neither complementary nor in competition. Taking the above

into account, I consider that the goods are similar to a between a low and medium degree.

31. I also agree that the applicant's "jackets, gloves, pants, all also made of leather" will have some, but minimal, overlap with the opponent's "safety helmets". I note that the applicant's goods would cover a broad range of jackets, gloves, pants, all made of leather, which would include those which are to be used for motorcycling, and therefore there will be some overlap in distribution channels, user and purpose. However, as highlighted by paragraph 30 above, there will not be an overlap in nature and method of use. The goods are neither complementary nor in competition. Therefore, I agree with Ms Blythe that the goods are similar to a low degree.

32. It is a prerequisite of section 5(1) that the goods be identical. As noted above, Ms Blythe accepts that "the goods in class 9 are all identical" and that class 9 is not disputed. Therefore, the opposition based upon section 5(1) succeeds for the class 9 goods.

33. It is also a prerequisite of section 5(2)(a) that the goods be similar. The opposition therefore fails in respect of the above goods that I have found to be dissimilar. The opposition under section 5(2)(a) fails for the following goods:

Class 18      Backpacks, suitcases, briefcases, bum bags, handbags, bags and wallets, luggage tags, leather shaving kits, and travel bags, all also made of leather.

### **The average consumer and the nature of the purchasing act**

34. 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.”

35. The average consumer for the goods will be motorcyclists. The cost of the goods in question is likely to vary, however, it is not likely to be at the very highest end of the scale. I also consider that the frequency of purchase is also likely to vary, although it is unlikely to be particularly regular. Even where the cost of purchase is low, various factors will be taken into consideration such as cost, materials used, aesthetic appearance and most importantly, durability and strength of the goods, which are primarily worn for protecting the user. Taking the above into account, especially as these goods are used for safety reasons, the level of attention paid during the purchasing process will be at least between a medium and high degree.

36. The goods are likely to be obtained by self-selection from the shelves of a motorcycle retail outlet, or catalogue equivalent. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. 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.

### **Distinctive character of the earlier trade mark**

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 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).”

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

39. The word BANDIT is an ordinary dictionary word which the average consumer would recognise as meaning a type of robber. I note that this is neither allusive nor descriptive of the opponent’s goods. Consequently, I consider that the mark is inherently distinctive to a medium degree.

### **Likelihood of confusion**

40. 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.

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

- I have found the marks to be identical.
- I have found the opponent's mark to be inherently distinctive to a medium degree.
- I have identified the average consumer to be motorcyclists, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that between a medium and high degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to range between being identical to similar to a low degree.

42. According to the interdependency principle, 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.<sup>2</sup> It therefore follows that where I have found any level similarity between the goods, on the basis that the marks are identical, I consider that the average consumer will clearly mistake one mark for the other. I subsequently find there to be a likelihood of direct confusion.

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<sup>2</sup> *Canon* paragraph 17

## **CONCLUSION**

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

Class 9 Safety clothing for the motor sports industry, in particular safety helmets, suits, gloves, shoes and socks for protection in the event of accidents and fire; racing harnesses.

Class 25 Jackets, gloves, pants, headwear, motorcycle clothing, protective motorcycle clothing, all also made of leather.

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

Class 18 Backpacks, suitcases, briefcases, bum bags, handbags, bags and wallets, luggage tags, leather shaving kits, and travel bags, all also made of leather.

## **COSTS**

45. In the order dated 26 February 2023, Mr Phillip Johnson, the AP, ordered costs of £3,500 for the invalidation and appeal proceedings. I therefore will only be issuing costs in respect of the partially successful opposition.

46. The opponent 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 opponent's only partial success.

47. In the circumstances, I award the applicant the sum of £200 as a contribution towards the costs of the proceedings. The sum is calculated as follows:



Filing a Notice of opposition and considering the applicant's counterstatement	£100
Official Fee	£100
<b>Total</b>	<b>£200</b>

48. I therefore order Simpson Performance Products, Inc. to pay Andreas Freundlieb the sum of £200. 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 12<sup>th</sup> day of April 2023**

**L FAYTER**

**For the Registrar**