

O/0492/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3540140

BY WOLVERINE OUTDOORS, INC.

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 14 AND 25



AND OPPOSITION THERETO UNDER NUMBER 600001659

BY CHACOTT CO. LTD

AND

IN THE MATTER OF AN APPLICATION FOR REVOCATION UNDER NUMBER

504430 AGAINST THE TRADE MARK NUMBERED WO 1244690

BY

WOLVERINE OUTDOORS, INC

Background and Pleadings

Opposition

1. On 2 October 2020 Wolverine Outdoors, Inc. (“Wolverine”) applied to register the trade mark numbered 3540140, as shown on the front cover page (“the contested mark”) in the UK for goods in classes 14 and 25 namely, *wrist wraps [jewellery]* and *clothing; footwear; headgear*. The trade mark was accepted and published in the Trade Marks Journal on 25 December 2020. For the purposes of the opposition proceedings, only those goods in class 25 are opposed.

2. On 25 March 2021, Chacott Co. Ltd (“Chacott”) opposed the application based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying on the following International Registration designating the UK (“IR”):

IR no. 1244690

Chacott

UK designating date: 19 June 2014

Date protection granted in the UK: 16 July 2015

Claiming a priority date of 30 May 2014

Priority country: Japan

Whilst registered in classes 25 and 28 for the purposes of this opposition it only relies on goods in class 25.

Class 25: Leotards; tunics; tunic dress; jackets; vests; blouses; two-piece suits; half pants; capes; bare top; gauchos; one-piece suits; unitards; long pants; body shirts; bonnets; gloves and mittens [clothing]; mufflers; hooded mantles, cloak; shorts; spats; wristbands [clothing]; tights for ballet; tights; leggings [trousers]; socks and stockings; controlling undergarment for ballet; girdles; brassieres; padded camisoles; camisoles; straps for brassieres; arm warmers [clothing]; body warmers; leg warmers; overalls; tee-shirts; collars [for clothing]; wrapping skirts; headgear for wear; parka, anoraks; bow ties; circular skirts; clothing; ballet slippers; toeshoes; dancing shoes; mules; pumps [footwear];

training shoes; shoes for room; toe pads for shoes; inner soles; shoe covers; footwear [other than special footwear for sports]; stockings for sports; clothes for sports; skin shoes; half shoes; special footwear for sports; costumes for use in children's dress up play; costumes for use in role-playing games; masquerade costumes; sash belts; suspenders; garters; sock suspenders; suspenders [braces]; waistbands; belts for clothing; headband [clothing].

3. Whilst Chacott initially filed its opposition under the fast track procedure, Wolverine later sought permission for leave to file evidence¹ which was subsequently granted. The proceedings were, therefore, converted into a standard opposition in accordance with Rule 62(j) of The Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 on 6 October 2021.

4. It is argued by Chacott, that under section 5(2)(b) the marks are similar and that the goods are identical, leading to a likelihood of confusion on the part of the public, including a likelihood of association.

5. Wolverine filed a defence and counterstatement denying the claims made, disputing that there is similarity between the marks as alleged and denying that Chacott had sufficiently demonstrated use of its mark for the goods relied upon in order to substantiate its opposition. In the alternative it claims that if sufficient use has been established, then there is no similarity between the respective marks.

6. Given its filing date the IR qualifies as an earlier mark in accordance with section 6 of the Act. The IR was granted protection in the UK on 16 July 2015 which is a date outside the five years of the date of filing of the applied for mark and therefore Chacott is required to establish the use it has made of the mark for those goods in class 25 as relied upon.

Revocation

7. On 13 December 2021, Wolverine filed cross revocation proceedings against the IR for reasons of non-use under section 46(1)(b) of the Act claiming that the use of the IR in the UK has been suspended for an uninterrupted period of five years in relation to the goods in class 25 for which it is registered and there are no proper reasons for

¹ Rule 20(4) Trade Mark Rules 2008.

non-use. The period of non-use claimed is 1 October 2015 to 30 September 2020 with a date of revocation effective from 1 October 2020.

8. In these proceedings, Chacott is represented by ip21 Limited, whereas Wolverine is represented by Mitchiners. Both parties filed evidence during the evidence rounds. In addition Wolverine filed submissions and further submissions in lieu of hearing. No hearing was requested and therefore this decision is taken following a careful perusal of all the papers.

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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

Evidence

Chacott's evidence in chief

10. Chacott's evidence is in the form of a witness statement of Hara Isashi dated 31 May 2021, accompanied by seven exhibits marked HI1-HI7.

11. This witness statement supports Chacott's proof of use evidence in the opposition proceedings and serves to provide evidence of use in response to the revocation action later brought.

12. Mr Isashi is the Vice President of Chacott, a position he had held since 1st March 2017. The information contained within his statement is said to come from his personal knowledge, from company records or the internet.

13. Mr Isashi states that Chacott has used the earlier IR in respect of clothing and footwear, alongside gymnastic and sporting equipment and accessories throughout the UK for many years. The goods it is said are sold in the UK through a number of companies, including Freed of London Limited ("Freed"), a company which was purchased by Chacott in 2019. A copy of the share transfer agreement dated 1 August 2019 relating to the purchase is produced.²

² Exhibit H1 accompanied by a translation produced by Hiroko Tomita.

14. The remainder of the statement serves to introduce a number of documents.

15. Exhibit HI2 consists of two invoices, four pages in length, dated 30 March 2020, addressed from Chacott to Freed. It is said that these invoices show the sale of goods under the IR. The name Chacott is visible in the top right-hand corner of each page. Other than this, no meaningful information is included within the invoices because the goods are identified by serial number and not by product or category. There is no explanation as to which goods the serial numbers relate. In addition the references and the language of the documents are in Japanese, with no translation provided. The invoices' currency are displayed in Japanese yen.

16. Exhibit HI3 consists of example invoices from Freed dated x/10/15; x/3/2016; x/02/17; 20/2/2020; 21/04/2020; 24/7/2020; 2/10/2020; 11/12/20 and 8/2/2021 said to show sales of goods to customers throughout the UK, with addresses in London, Exeter, Stroud, Brentford and Lancashire. The reference number for the goods relating to the IR are presented as CHAC 1/2/3 or NELA 1/2/3 and the products are described as CHACOTT PERF SUIT/PANT/SHRT;³ CH KNIT TROUSERS; WRAP OVER SKIRT; OMBRE EFF SKIRT and LEOTARD MESH TOP. A number of despatch notes are also produced; not all the dates are legible but those that are, are dated 21/7/2020, 1/10/2020; 10/12/2020 and 8/2/2021.

17. Exhibit HI4 consists of a table (reproduced below) setting out details of sales in the UK between 1 October 2015 and 30 September 2020. The table is said to show the number of units sold and the sales figures (in pounds sterling) within this period.⁴

³ Paras 34 -37 of Mr Isashi's 2nd witness statement defines these abbreviations as performance shorts, long pants and all in ones.

⁴ Although not set out in his first witness statement Mr Isashi confirms in his witness statement in reply that the sales solely relate to the UK and are in GBP.

Date Range : 01/10/2015 – 30/09/2016

Items	Units	sales
①CHACOTT Ballet shoes etc.	5,635	38,084.44
②CHACOTT Goods etc.	435	9,815.75
③CHACOTT Garments	310	5,491.78
Total	6,380	53,391.97

Date Range : 01/10/2016 – 30/09/2017

Items	Units	sales
①CHACOTT Ballet shoes etc.	1,109	7,731.26
②CHACOTT Goods etc.	516	13,080.36
③CHACOTT Garments	284	4,972.59
Total	1,909	25,784.21

Date Range : 01/10/2017 – 30/09/2018

Items	Units	sales
①CHACOTT Ballet shoes etc.	24	175.94
②CHACOTT Goods etc.	432	9,613.35
③CHACOTT Garments	216	5,088.15
Total	672	14,877.44

Date Range : 01/10/2018 – 30/09/2019

Items	Units	sales
①CHACOTT Ballet shoes etc.	0	0.00
②CHACOTT Goods etc.	454	11,360.33
③CHACOTT Garments	183	3,575.81
Total	637	14,936.14

Date Range : 01/10/2019 – 30/09/2020

Items	Units	sales
①CHACOTT Ballet shoes etc.	0	0.00
②CHACOTT Goods etc.	263	7,891.70
③CHACOTT Garments	129	3,836.05
Total	392	11,727.75

GRAND TOTAL

Items	Units	sales
①CHACOTT Ballet shoes etc.	6,768	45,992
②CHACOTT Goods etc.	2,100	51,761
③CHACOTT Garments	1,122	22,964
Total	9,990	120,717.51

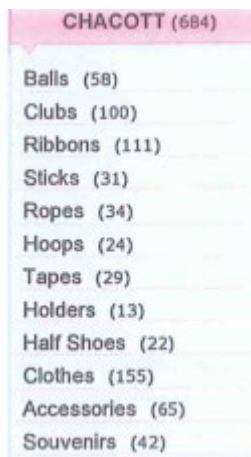
18. HI5 consists of extracts from Freed's retail price lists for clothing sold under the IR, dated 2015/2016, 2017/2018, 2018/2019 and 2019/2020. The category of goods listed, by reference to the mark Chacott, are performance pants, performance shorts, performance suits, ankle/leg warmers, knitted shorts, knitted crossover,⁵ knitted

⁵ Which I am led to believe are crossover tops.

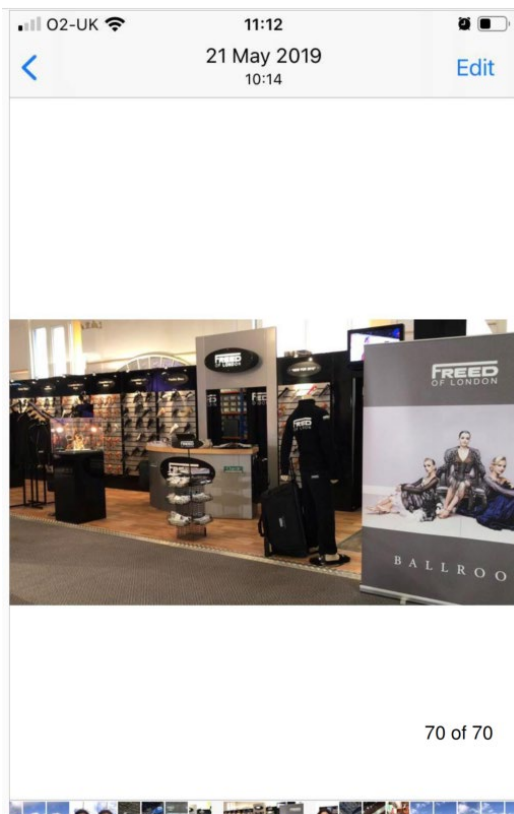
trousers. The reference codes correspond to those as described in the invoices and despatch notes.

19. Mr Isashi states that Chacott also sells its products via online retailers such as Freed, Amazon and The Rhythmic Gymnastics Store. Example products for sale via these retailers are produced at HI6. It consists of screenshots taken from www.freedoflondon.com; www.amazon.com; www.rhythmic-gymnastic-store.co.uk and www.rsg-shop.com retrieved using the internet archive Wayback machine website, showing the following:

- Screenshots of captures from Freed of London’s website dated 30 April 2016, 7 June 2017 and 11 August 2018 displaying knitted crossover tops, shorts, trousers and all in one garments being offered for sale under the brand Chacott in GBP.
- An undated screenshot (save for a print/access date of 19 February 2021) taken from Amazon showing a pair of black “Freed Chacott Canvas Split Sole ballet shoes”. The product is said to have been available since 5 June 2015 and the brand is described as FREED.
- A number of screenshots from The Rhythmic Gymnastics Store websites which are undated, save for a print/access date of 19 February 2021. Images of garments and goods being offered for sale under the Chacott brand include a range of gymnastics equipment and goods not pertaining to class 25, but also leotards described as “body foundations”, leg warmers, knit shorts, dance socks, body warmers. The drop down menu shows a variety of items available to purchase under the Chacott brand as seen below:



20. The IR was said to be promoted on Freed’s stand at a leading dance festival in Blackpool between 23rd and 31st May 2019. It is said that the IR logo was clearly visible on the front of the cashier desk. The event it is said was attended by professional and amateur dancers and enthusiasts and is one of the UK’s leading events. HI7 consists of a mobile phone screenshot (reproduced below) of a photograph of the stand dated 21 May 2019. Whilst the logos FREED are clearly visible, I am unable to identify the Chacott logo or any goods labelled with the Chacott mark from the photograph.



Wolverine’s evidence

21. Wolverine’s evidence consists of the witness statement of James Mitchiner dated 6 December 2021, accompanied by 31 exhibits marked JM1-JM31. Mr Mitchiner is a principal in the employ of Mitchiners, Wolverine’s representative. The purpose of Mr Mitchiner’s statement is to challenge the evidence filed by Mr Isashi and to produce evidence to counter the statement of genuine use claimed. He states that a number of the details produced by Mr Isashi appear to be false such that an inference should be drawn that Mr Isashi’s statement be deemed unreliable. I do not propose to outline

the contents of Mr Mitchiner's statement in its entirety but the main criticisms are summarised as follows:

- a challenge as to when Chacott's relationship with Freed began;
- that the use demonstrated is trivial and no more than token and not directed at Chacott's goods as relied upon;
- broad and vague statements of use are claimed unsupported by the evidence filed;
- a number of the screenshots and evidence relied upon are either undated or dated outside the relevant period;
- the use that has been demonstrated is limited in geographical area;
- the extent of use is insufficient over a five year period;
- a number of invoices have had their details overwritten such that their credibility must be questioned;
- the sales figures and Freed's website are not directed at the UK consumer;
- zero sales for ballet shoes from October 2018 to September 2020 show that Chacott has abandoned use of its mark and indicates that it no longer uses the IR for "ballet shoes etc";
- Freed is the leading designer and manufacturer of professional dance shoes with an annual turnover of approximately £12.5 million in 2018 and 2019. The sales demonstrated by Chacott are therefore minimal against these figures amounting to less than 1%.

22. Furthermore, Mr Mitchiner produces copy screenshots from various sources⁶ said to show that Chacott supplies a large number of goods which bear no relation to the relevant products upon which it relies or do not show products being offered under the mark.

23. Mr Mitchiner argues that the market is not a niche or specialised one and is more widespread. He produces various articles/reports, showing the extent of dance and ballet participation in the UK. It is argued that the sales outlined by Chacott fall far short of being able to demonstrate a large market share. The size of the 'slippers and dancing footwear', manufacturing market in the UK , for example, is said to be 2.9%

⁶ www.trade.chacott-jp.com dated 10 November 2021 JM7-JM8; Freed USA

of a £520 million market, namely £15.08 million.⁷ The annual sales figures claimed by Chacott of £13,791, therefore represents less than 0.1% of that market.

24. Mr Mitchiner conducted his own research into the participation of adults in dance and ballet activities. He produces the results of that research, taken from the Statistica database over the periods 2015/2016 and 2016/2017. It shows participation levels for adults in England as 4.35/3.7 million (dance) and 330,000/275,000 (ballet).⁸ For children, he states the participation figures in England (assuming a child population of 10.5 million) average between 2.81 and 3.51 million between 2015 and 2020.⁹

25. It is submitted that the purported sales invoices produced at HI3 do not include an explanation as to whether they relate to sales invoiced to Freed in the UK or onward sales to customers in the UK. Mr Mitchiner suggests that they are simply intra group stock movements to Freed as a subsidiary of the Opponent for the European and wider market including the Singapore store.

26. It is argued that the level of sales demonstrated in the table at HI4 is insufficiently specific to demonstrate use of the goods as relied upon. Mr Mitchiner states that it is unclear what is meant by the broad description 'garments' and 'goods' without a further breakdown or explanation. Mr Mitchiner asks me to discount the figures produced under the description 'ballet shoes etc' as being 'uncertain'. However, I consider that the term ballet shoes is sufficiently specific in description for me and more importantly the average consumer to understand the meaning of this term. I do not consider that it is ambiguous.

27. The price lists at HI5 are limited to a small number of items mainly knitwear and leg warmers and make no reference amongst other matters to ballet shoes. This, it is said, contradicts the claim that Freed sell ballet shoes on Amazon.

Chacott's evidence in reply

28. Mr Hira Isashi produces a second witness statement dated 28 June 2022 accompanied by 4 exhibits marked HI8 – HI14. The purpose of this statement is to

⁷ Footwear Manufacturing Report, IBISWorld, May 2021

⁸ Para 74 and Exhibit JM27.

⁹ Para 75 and Exhibit JM28.

rebut the claims and criticisms made by Mr Mitchiner in his statement. Mr Isashi provides the following information and documents:

- Further background information as to the acquisition of Freed shares by Chacott and the group structure of its holding company and subsidiaries/affiliates.
- Further invoices (accompanied by packing lists and Placing Order Formats) are produced from Chacott to the Rhythmic Gymnastics Store UK dated 18 October 2019, 2 November 2020 and 10 November 2020.¹⁰ Garments such as body warmers, leg covers, dancing socks and half shoes are identified within the descriptions.
- Confirmation that the sales figures produced in the table at HI4 are to be read in pounds sterling and relate to sales in the UK. The products identified as shorts, pants and all in one suits, have continuously been sold to FREED and continue to do so. Images of these products taken from an unknown source are produced.¹¹
- Further undated screenshots of products listed on FREED's website are produced consisting of leotards and skirts in a variety of styles, referenced as CHACLE01; CHACLE02; CHACLE03; NELA01; NELA02 and NELA03. The manufacturer is identified as Chacott underneath the images of the product. The prices are displayed in pounds sterling.¹² The only dates that can be identified from the screenshots are a reference to "AW21" and "NELA 2022" which I understand to mean the 2021 Autumn Winter season and the 2022 season, all of which, therefore, are outside the relevant period.
- the claim that the use of the IR for 'ballet shoes etc' being abandoned is denied. Chacott uses the mark on sneakers, half shoes and ballet shoes. Website extracts are produced (undated and from unknown sources) showing images of various 'shoes' namely ballet shoes, sandals, half shoes and overshoes all branded with and sold under the Chacott trade mark.¹³
- A number of undated screenshots (save for a print/access date of 4/12/21) are produced from Rhythmic Gymnastics Store UK's website showing various

¹⁰ HI8

¹¹ HI10

¹² HI9

¹³ HI11

We are hoping to get Chacott balls back in stock in January. There has been a manufacturing/supply issue with Chacott resulting in a delay of nearly a year! Sincere apologies but unfortunately it's out of our hands.

- A further invoice/packing list dated 10 January 2019 is produced, showing sales of 5 pairs of half shoes to Rhythmic Gymnastics Store UK.¹⁵
- The ballet dance market is not limited to children nor can it be assessed by calculations based on population by age only. It is said to consist of two types; the professional ballet dancer and the amateur. It is said that professional ballet dancers buy more ballet shoes than amateurs. The number of adults enjoying ballet as a hobby is said to be increasing. Consequently Mr Isashi states that these factors make it impossible to accurately assess the market. Undated screenshots (save for a print date of 7/2/2022) taken from the Royal Academy of Dance and Birmingham Royal Ballet's website, are produced showing the availability of adult classes and workshops being offered.¹⁶
- Chacott sponsors the PRIX de Lausanne, a world renowned international ballet competition and is a partner of the FIG International Gymnastics Federation. Undated extracts taken from the respective websites are produced confirming these partnerships. The screenshot from the Prix de Lausanne's website appears to be dated in 2022. Within the text it refers to Chacott announcing "its continuing support for the Prix de Lausanne", that it is "the leading company of ballet and dance supplies in the world"; and includes the following statements that Chacott was "established in 1950 as a manufacturer and retailer of Classic Ballet products"; "it has expanded its range to include more varieties of dance such as Ballroom Dance, Rhythmic Gymnastics...Stage Performances and Special Costumes"; "In 2010 it celebrated its 60th anniversary"; and that "Chacott is now the official licensing partner for the Prix de Lausanne branded products."

¹⁴ HI12

¹⁵ HI12

¹⁶ HI14 -

- The FIG's website states that it is the governing body for Gymnastics worldwide, governing eight sports and counting 156 national member federations. Chacott is listed as one of its partners.

29. This concludes my summary of the evidence. In addition Wolverine filed submissions. Whilst I have read these submissions I do not propose to outline them here, but will bear them in mind during my decision.

Preliminary issues

30. Mr Mitchiner casts doubt on Mr Isashi's statement and in particular claims that a number of key details produced within his statement appear to be false. Consequently, he states that it calls into question whether the evidence given can be relied upon at all and that I should draw a negative inference from the information filed. I note that Mr Isashi's witness statement is signed and includes a statement of truth, it has been prepared for the proceedings and Wolverine did not apply to cross examine Mr Isashi. On this basis, there appears to be no reason for me to conclude that the statement was not given in good faith or that there has been an attempt to conceal or misinterpret the evidence. Whether it demonstrates genuine and sufficient use in accordance with the caselaw, will be assessed in due course, later in my decision. At this stage, however, I see no reason to disregard the evidence, nor do I find that Mr Isashi has deliberately tried to mislead the Registry.

31. The proceedings have been suspended at various points throughout the duration of the proceedings, causing a delay in the decision being issued. The decision was due to be issued in March 2023 but the parties requested a further period of suspension to explore settlement terms. Those negotiations did not result in any agreement being finalised and despite further time being requested by Chacott, Wolverine objected to any further suspension. The Registry wrote to the parties on 5 April 2023 advising that the suspension would be lifted and the matter would now proceed to a final decision.

Decision

Proof of use

32. Chacott is required to prove use of its IR to defend the revocation action brought against it. In addition, given that the IR has been registered for more than five years

at the date of the application against which the opposition is brought, it must also prove use for the purposes of the opposition pursuant to section 6A of the Act.

33. Section 46 of the Act is relevant to the revocation proceedings which states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) [...]

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

34. Section 6A of the Act is relevant to the proof of use in the opposition, which states as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

35. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

36. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The Court of Justice of the European Union (“CJEU”) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall*

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

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

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

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

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

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

Relevant periods

37. The relevant period for the purposes of the revocation is 1 October 2015 to 30 September 2020. The relevant period for the opposition is the five year period ending with the date of the application of the contested mark i.e. 3 October 2015 until 2

October 2020.¹⁷ Given that the dates for each period overlap, bar a few days, I shall consider the evidence of use in its entirety for both sets of proceedings.

Form of the mark

38. Where Chacott has used the IR in the form in which it is registered then clearly this is use upon which the Opponent may rely, but since notional and fair use would also include it to be presented in word only format in any font or case, this is also acceptable use.¹⁸ I note that Chacott has also used the IR in combination with the word FREED. It is settled caselaw that a mark may be used with another mark and still retain trade mark significance.¹⁹ It matters not, therefore, whether the mark is used solus or in combination with a different mark provided it does not alter the distinctive character of the mark. In the decision in suit the distinctiveness of the word Chacott would be unaffected by its use with another mark and I do not consider it would impair its ability to indicate trade origin.

Genuine Use

Assessment of the evidence

39. Whether the use shown is sufficient for this purpose, will depend on whether there has been real commercial exploitation of the IR, in the course of trade, sufficient to create or maintain a market for the goods at issue during the relevant five-year period. In making the required assessment, I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them;
- e. The geographical extent of the use shown.

¹⁷ Whilst I note that Wolverine has claimed a period which is one day earlier, in reality a one day variation will make little difference to my assessment.

¹⁸ *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

¹⁹ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 at [31] to [35]

40. Use does not need to be quantitatively significant in order to be genuine, however, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not genuine use.²⁰

41. At the outset I note that there are some issues with Chacott’s evidence, in that a number of the documents relied upon are either undated or dated outside the relevant periods. Furthermore, very little evidence has been provided to show promotion of its brand such as advertising expenditure, examples of printed, online or social media material, which would demonstrate how it has engaged with its consumers. The photograph of Freed’s trade stand at the Blackpool dance festival in May 2019, said to show the IR at the till point, whilst within the relevant period, is insufficient by itself to show significant promotion of the IR. I have no evidence of the footfall at the festival or the sales of goods bearing the IR, or images of Chacott branded goods on display.

42. The sales figures and units sold in HI4 are also fairly modest and are described in general terms such as “garments etc” and “Ballet shoes etc.” Wolverine has argued that the sales only demonstrate trivial or token use and are insufficient to show that the IR has been commercially exploited. It was also submitted that given the relationship between FREED and Chacott any invoices or sales between these companies should be disregarded as only demonstrating internal use.

43. Despite these deficiencies I note that Chacott has sponsored the Prix de Lausanne, a world renowned ballet competition. Whilst the screenshot taken from the competition’s website was dated outside the relevant period, the text clearly referred to Chacott’s ongoing commitment as a manufacturer and supplier of ballet/dance wear and ballet/dance shoes and as a sponsor of the event. I also note that the invoices and price lists from Freed (said to be its main supplier in the UK) show that dance/ballet all in one suits, leotards, skirts, pants/trousers, shorts and ballet shoes/half dance shoes were available for sale and sold within the relevant period. I accept that the total sales figures within the table for clothing and shoes in the five year period amounted to no more than £23,000 and £46,000 respectively and only 1,122 and 6,768 units were said to have been sold over this period, in total. Furthermore, the sales of ballet

²⁰ *Naazneen Investments Ltd v OHIM*, Case T-250/13.

shoes etc had reduced considerably from only 24 pairs being sold in 2017-2018 to zero sales in 2018-2020. Despite the evidence filed by Mr Mitchiner regarding the extent of the dance/ballet wear and shoes market, I consider that it is a relatively niche and specialised market, when compared to the general clothing and shoes market overall. Chacott goods are clearly being marketed on specialised websites such as the Rhythmic Gymnastics Store UK and Freed, and whilst not extensive, in combination with the example invoices, do demonstrate ongoing sales and repeated orders throughout the relevant period. A footnote underneath the description of a leotard available to order from Rhythmic Gymnastics Store UK's website, for example, states "This product was added to our catalogue on Monday 19 February 2018." It is clear, therefore, that despite the date of the screenshot being outside the relevant period, Chacott branded garments were available for sale a number of years prior.

44. In light of the evidence filed, I accept use of the IR has been demonstrated. It is now necessary for me to assess whether the evidence demonstrates sufficient use to create a market for the goods, in accordance with the caselaw.

45. I am guided by the decision in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

46. Furthermore in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to

satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

47. Additionally there have been a number of cases where it was found that the use shown either was or was not sufficient to cross the evidential burden of demonstrating genuine use. For example in *Memory Opticians Ltd’s Application*,²¹ Professor Ruth Annand, as the Appointed Person, upheld the Hearing Officer’s decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. In that case there had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and were localised to 3 branches. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

48. Whereas in *Masterbuilders, Heiermann, Schmidtman GbR v EUIPO*,²² the General Court (“GC”) held that relatively low sales volumes of timers and downloadable application software in class 9 were still sufficient to be genuine use of the trade mark when taken in combination with other factors. Furthermore in *Industria de Diseño Textil, SA (Inditex) v EUIPO*,²³ the GC held that representative invoices showing sales of pasta in Italy totalling something over €40,000 were sufficient to show genuine use in the EU, when taken together with marketing material and evidence of regular use over the relevant period. Although this case was decided after the end of the Brexit transition period and is not binding, it has persuasive value.

²¹ BL O/528/15

²² T-76/21, EU:T:2022:16

²³ T-467/20, EU:T:2021:842.

49. Furthermore, it is to be noted that there is no quantitative threshold in the genuine use assessment and that sometimes even minimal use is sufficient. As stated by the GC in Naazneen “*it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine.*” It is clear from these decisions that each case turns on its own facts, and that it is necessary for me to consider the evidential picture as a whole and not whether each individual piece of evidence shows use by itself.

50. The evidence is not extensive, but despite its deficiencies, the goods shown for sale on the websites with Rhythmic Gymnastics and Freed, albeit that some are dated outside the relevant period, are nevertheless consistent with the sale of goods contained within the invoices and the price lists, which are dated within the relevant period. The goods themselves are not everyday consumer goods and whilst the sales figures are not particularly significant neither are they token. The sales and the evidence on the whole, does point to being sufficiently significant to demonstrate the frequency and geographical scope of the use of the IR in the UK, to create a market for the goods over the relevant period, when considered in its entirety.

51. Taking the evidence as a whole into account, overall I am prepared to find that the IR has been put to genuine use during the relevant period in the UK, but only for the following goods namely leotards, body warmers, crossover tops, shorts, pants/trousers, skirts, ballet shoes/half shoes, dance socks and leg warmers.

Fair Specification

52. In light of these findings, I must now identify what a fair specification would be, taking account of the categories of goods currently registered and the genuine use established.

53. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

54. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

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

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

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

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of

protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

55. With consideration to the case law, it would not be appropriate to reduce the protection under the marks to only specific categories of goods for which use has been shown. However, the registration covers goods relied upon for which no use was shown or broad terms such as “clothing” and “footwear [other than special footwear for sports]”. Whilst I am satisfied that the list of garments and footwear for which use had been shown fall within these broad categories, the terms *clothing* and *footwear [other than special footwear for sports]* generally are unnecessarily broad and would cover all manner of apparel and footwear. I do not consider that the use demonstrated is sufficient to maintain a registration for such broad terms. I consider that an appropriate description of the use shown within these sub-categories would be “ballet clothing” and “ballet shoes”.

56. It is my view that the consumer would consider that the terms of the registration as set out below fairly cover and provide adequate and fair protection for leotards, body warmers, crossover tops, shorts, pants/trousers, skirts, ballet shoes/half shoes, dance socks and leg warmers for which use has been shown and is thus a fair description of the goods offered under the mark, such to maintain its registration.

Class 25: Ballet clothing; leotards; one-piece suits; unitards; controlling undergarment for ballet; body warmers; half pants; long pants; leggings [trousers]; shorts; wrapping skirts; circular skirts; dance socks; leg warmers; ballet shoes; ballet pumps; ballet slippers; toeshoes; dancing shoes; half shoes.

Outcome of the revocation

57. I find that Chacott may maintain its protection for the following goods under its registration and its opposition may proceed as against these goods:

Class 25: Ballet clothing; leotards; one-piece suits; unitards; controlling undergarment for ballet; body warmers; half pants; long pants; leggings [trousers]; shorts; wrapping skirts; circular skirts; dance socks; leg

warmers; ballet shoes; ballet pumps; ballet slippers; toeshoes; dancing shoes; half shoes.

58. In so far as the remaining goods as set out below, the IR will be revoked as of 1 October 2020:

Class 25: tunics; tunic dress; jackets; vests; blouses; two-piece suits; capes; bare top; gauchos; body shirts; bonnets; gloves and mittens [clothing]; mufflers; hooded mantles, cloak; spats; wristbands [clothing]; tights for ballet; tights; socks and stockings; girdles; brassieres; padded camisoles; camisoles; straps for brassieres; arm warmers [clothing]; overalls; tee-shirts; collars [for clothing]; headgear for wear; parka, anoraks; bow ties; clothing; mules; pumps [footwear]; training shoes; shoes for room; toe pads for shoes; inner soles; shoe covers; footwear [other than special footwear for sports]; stockings for sports; clothes-for sports; skin shoes; special footwear for sports; costumes for use in children's dress up play; costumes for use in role-playing games; masquerade costumes; sash belts; suspenders; garters; sock suspenders; suspenders [braces]; waistbands; belts for clothing; headband [clothing].

Opposition

Section 5(2)(b)

59. 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.”

The principles

60. 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 the goods

61. In light of my earlier findings, the comparison of the goods shall be undertaken as against Wolverine's goods as applied for in class 25 namely *clothing; footwear; headgear* as against those of Chacott's goods that survived the revocation, as set out in paragraph 57.

62. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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.”

63. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

64. Furthermore in *Gérard Meric v Office for Harmonisation in the Internal Market*, (“OHIM”) Case T-133/05, the 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 Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

65. Wolverine’s application covers the broad terms *clothing* and *footwear* which encompass Chacott’s goods and thus are identical in accordance with the principles in *Meric*.

66. In so far as the broad term, “*headgear*” in the application, notwithstanding that some of Chacott’s goods appear to be specifically dance and ballet clothing/footwear, some of Chacott’s terms are drafted more broadly. In any event, the assessment must be undertaken on a notional and fair basis, on the terms as registered and not restricted to only how the goods are actually used in the market. In this regard, I consider that the nature of the applied for goods are very similar to Chacott’s clothing

garments, even though some are specifically ballet related. They serve the same purpose, being goods to cover and protect parts of the body, albeit different parts of the body. They are often seen and sold together in the same retail outlets, within close proximity to each other. I also consider that the designers and manufacturers of clothing and headgear would overlap, such that they would reach the market by the same methods, directed at the same end user. I consider that they are similar to a medium degree.

The average consumer and the nature of the purchasing process

67. As the case law indicates part of the global factors to be taken into account is an assessment as to whom the goods are directed and the manner in which the goods are likely to be selected. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods and services in question.²⁴

68. 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 was then) 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.”

69. Whilst some of Chacott's goods such as its ballet shoes could also be directed towards professional dancers and children, on the whole both parties agree that, overall, the average consumer of the goods not specifically specified as ballet goods are directed at the general member of the public. The cost of the items are fairly low cost and are purchased on a relatively regular basis accounting for normal wear and tear, although I do not consider that they are daily purchases.

²⁴ *Lloyd Schuhfabrik Meyer*, case C-342/97.

70. I consider that the selection process would be mainly visual, via self-selection from retail stores and their online equivalents. Aural considerations cannot be discounted completely, however, following requests for assistance from sales staff or word of mouth recommendations. Considerations such as fit, comfort, quality, price, suitability as well as aesthetic qualities will be undertaken in the purchasing process. Taking these matters into account, I consider that the levels of attention will be average, no higher or lower than the norm for such goods. Where the goods are directed at professionals I do not consider that the level of attention or the considerations will vary to any higher degree and therefore an average level of attention will apply equally for professionals.



Comparison of the trade marks

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

72. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider 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 trade marks.

73. The respective trade marks are as follows:

Applicant's Mark	Opponent's mark
	

Overall impression

74. Neither the font or stylisation of the IR detracts from the word itself and, therefore, the overall impression of the IR resides in the totality of the word.

75. The contested mark has a number of elements present, the word Chaco presented in an unremarkable, yet emboldened black font, encircled within an open oval device which includes a pictorial element of a lizard. Given that the oval device acts as a border within which the other elements are encompassed, it will play a lesser role in the overall impression of the mark, when taken as a whole. It is the word Chaco together with the lizard which play the greater roles within the mark, each making an equal contribution to the overall impression of the mark.

76. I shall bear these factors in mind when undertaking the mark comparison.

Visual comparison

77. The marks are similar to the extent that the first five letters of the IR and the entirety of the word element of the contested mark are identical. They differ to the extent that the IR is a word only mark, seven letters in length (as opposed to five) and includes the letters TT at the end; the contested mark also includes a lizard and an oval device, there being no counterpart in the other mark. Weighing up the differences and the similarities, overall, I consider that the marks are visually similar to a low to medium degree.

Aural comparison

78. No pronouncement will be given to the lizard device or the oval border in the contested mark and therefore following normal paradigms the word CHACO will be pronounced as CHAH-COH. The IR is likely to be pronounced as CHAH-COT where the letters TT at the end will be pronounced (as in apricot). I do not discount the possibility that there may be some consumers who pronounce the IR as CHAH-COH, where the letters TT at the end are silent, but I do not consider that those consumers would constitute a sufficiently significant proportion of average consumers. On this basis, given that the first syllable in the respective marks are identical differing only in their endings the marks are aurally similar to a medium degree.

Conceptual Comparison

79. The IR is not a known dictionary word in the English language and therefore it will be regarded as invented. Similarly, I am unaware as to the meaning of the word Chaco and therefore it will also be regarded as an invented word. On this basis the words Chaco and Chacott are conceptually neutral. The lizard device in the contested mark acts as a point of conceptual difference, with the oval device merely being perceived as a banal border which is unlikely to form a concept in the consumer's mind.

Distinctive character

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

81. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, others being highly inherently distinctive, such as invented words. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

82. Whilst Chacott filed evidence which was sufficient to cross the threshold for genuine use, I am not satisfied that it justifies a finding of enhanced distinctive character. The level of sales are minimal and at the lower end of the scale, with no sales for ballet shoes occurring in the years before the relevant date. Notwithstanding that the market for ballet and dance clothing and footwear is not widespread, the volume of sales produced by Chacott only demonstrates a very low market share. Furthermore, no advertising or marketing spend has been provided and very little evidence has been produced to show that the IR has been actively promoted in the UK. Consequently, I have only the inherent position to consider. As noted Chacott is an invented word with no association to the goods. For this reason I consider it to be inherently distinctive to a high degree.

Likelihood of confusion

83. Confusion can be direct or indirect. Direct confusion is where one mark is mistaken for the other, whereas, for indirect confusion to arise, the consumer recognises that the marks are not the same but, nevertheless, puts the similarities between the marks and the respective goods down to the same or related source.

84. A number of factors must also be borne in mind when undertaking the assessment of confusion. 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/services and vice versa. It is also necessary for me to

keep in mind a global assessment of all relevant factors when undertaking the comparison, to include the distinctive character of the earlier mark, the average consumer for the goods in question and the nature of the purchasing process and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider 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.

85. I remind myself that the marks are visually similar to a low to medium degree and aurally similar to a medium degree. I found that the words Chacott and Chaco are conceptually neutral but that the lizard device in the contested mark acts as point of conceptual difference. The IR is inherently distinctive to a high degree. I found the average consumer to be a member of the general public or for some of the goods a dance/ballet professional. I found that an average degree of attention will be paid in the purchasing process, no higher or lower than the norm for such goods, irrespective of whether the consumer was a professional or not. I found that visual considerations will dominate the purchasing process, although aural considerations cannot be discounted. The respective goods were either identical or similar to a medium degree.

86. Although as a general rule of thumb the beginning of word marks have greater impact than their endings this does not apply on every occasion. Whilst the word elements of the respective marks overlap in the first five letters, the likelihood of confusion assessment is not solely against the words, there are other elements here to consider and I of course must take into account the marks as wholes. In the contested mark the lizard device is of equal impact to the word Chaco, and acts to create a point of visual difference between the later and the earlier mark. Bearing in mind that the purchasing process will be predominantly visual, the visual difference created by the addition of the lizard device, in particular in the contested mark, helps to distinguish it from the word only IR. It is my view that this additional element will not be overlooked or misremembered by the average consumer paying an average degree of attention.

87. Despite the identity of the goods, and the IR being inherently distinctive to a high degree, it is unlikely in my view that the marks will be regarded as the same or related undertakings. The lizard device, particularly, is an equally distinctive element in

combination with the word Chaco, to denote trade origin such that it will not be disregarded by consumers when the mark is encountered visually. I have considered the possibility of the word element of the contested mark being mistakenly recalled or misremembered for the IR when spoken, but dismiss this on the basis that this is not how the goods are predominantly purchased. Both the word elements are relatively short words and therefore the differences created by each having different endings will not be overlooked. I consider that the inclusion of the lizard device, together with the words being different both in terms of length and their endings are sufficient for the marks not to be directly or indirectly confused one for the other.

Conclusion

88. The opposition under section 5(2)(b) fails. Subject to any successful appeal the application may proceed to registration for the following:

Class 14: wrist wraps [jewellery].²⁵

Class 25: clothing; footwear; headgear.

Costs

Revocation action

89. Within the revocation proceedings both parties achieved roughly an equal measure of success and as such I make no award of costs in respect of this element of the proceedings.

Opposition

90. As Chacott has failed in its opposition, Wolverine is entitled to an award of costs in its favour in relation to the opposition proceedings. Whilst the proceedings originally commenced by way of the fast track procedure it was converted into a standard opposition. The proceedings were also suspended at various times for lengthy periods, but I consider that this was to the benefit of both parties in an attempt to reach settlement terms, and not to cause delay or which I regard as unreasonable behaviour.

²⁵ No opposition having been raised against these goods.

91. I see no reason, therefore, to depart from the scale as set out by TPN 2/2016 and award costs to Wolverine on the following contributory basis:

Considering the notice of opposition and preparing a defence and counterstatement:	£200
Preparing evidence and considering and commenting on Chacott's evidence:	£700
Preparing submissions in lieu of hearing	£300
Total	£1200

92. I order Chacott Co. Ltd to pay costs to Wolverine Outdoors, Inc. in the sum of £1,200 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against the decision is unsuccessful.

Dated this 30th day of May 2023

Leisa Davies

For the Registrar