

O-501-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3057681
BY HQ ACCOUNTANCY SOLUTIONS LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 25:**



AND

**OPPOSITION THERETO (NO. 403205) BY
THE POLO/LAUREN COMPANY L.P.**

Background

1. This dispute concerns whether the following trade mark should be registered for the following goods:



Class 25: Clothing, footwear, headgear; clothing for horse-riding [other than riding hats]

2. The trade mark was filed by HQ Accountancy Solutions Limited (the applicant) on 29 May 2014 and was published for opposition purposes on 8 August 2014.

3. Registration of the mark is opposed by Polo/Lauren Company L.P. (the opponent). Its grounds are under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). I will come on to the marks that the opponent relies on later, but for the time being, it is sufficient to record that they all consist of, or contain, the word POLO and are all registered for goods which include items of clothing in class 25.

4. The opponent is represented by Mischon de Reya, a firm of solicitors. The opponent has filed evidence and written submissions during the course of the proceedings.

5. The applicant is self-represented. It too has filed evidence and written submissions. The applicant's sole director and shareholder is Ms Nicole Fowler. It is she that filed the evidence/submissions on behalf of the applicant. It is fair to say that Ms Fowler has, at times, been less than pleased with the conduct of the opponent during the proceedings and, also, employees of the Intellectual Property Office. I will touch on some of these issues later.

6. Neither party asked to be heard on the merits of the substantive proceedings.

Issues raised by the applicant

7. Ms Fowler filed a significant amount of correspondence during the course of the proceedings. At times it has been difficult to follow. Some of the issues raised will be dealt with in more detail when dealing with the substantive matters that I need to determine. Having gone through each and every letter, the following represents what appear to be Ms Fowler's main issues, together with my initial observations:

Polo is the name of a sport

8. Much of Ms Fowler's evidence and submissions focus of the sport of polo and her view that the opponent should not be able to monopolise the name of a sport. For the record, I accept that polo is a well-known and long standing sport. However, I will come back to the impact, if any, this has on the distinctiveness of the opponent's marks and the impact, if any, on the likelihood of confusion.

The integrity of the opponent

9. Ms Fowler has commented a number of times on the integrity of the opponent. For example, she claims that they bribed officials in Argentina and that they have evaded UK tax. She asks that the tribunal report them for latter. None of this is a matter for this tribunal. There is nothing in the points raised that in any way cast doubt on the evidence that the opponent filed. I need say no more about this.

TPOLO not POLO

10. Ms Fowler took issue with the opponent referring to the applicant's mark as consisting of the word POLO alongside a device of a polo mallet. She strongly argues that the mark consists of the word TPOLO, albeit the T being stylised. She states that the mark is an acronym based on the words "t-shirts" and "polo shirts" (some of the goods the opponent sells) with a "rustic look" and graphic representation of a T. She states that it makes no mention of polo and the graphic representation is not a polo mallet. She feels that the opponent's references represent an attempt to mislead the tribunal. Ms Fowler went so far as to demand that the opponent's references to POLO to be struck out from its evidence. I declined this request. The significance of a trade mark may often be open to interpretation. It matters not what the opponent or the applicant has called it in their evidence/submissions nor how the trade mark was recorded when it was filed at the IPO. What matters is how the average consumer will perceive it, a decision which I must reach, albeit bearing in mind the arguments that have been made by the parties.

Impartiality of the tribunal and government harassment

11. Ms Fowler has called the impartiality of the tribunal into question on a number of occasions. Most of her comments were aimed at the case-worker looking after the proceedings. Ms Fowler even went so far as to demand to know what financial links the case-worker has with the opponent company. The circumstances which led Ms Fowler into believing that the tribunal lacked impartiality include the failure to direct that the opponent amend references to the applied for mark so that it reads TPOLO

and, also, a decision to query a set of revocation pleadings Ms Fowler had lodged (against a mark owned by the opponent) without challenging the opponent's claims in these proceedings.

12. In terms of the TPOLO point, I have already given my views. In terms of the second point, the revocation claim does appear to have been misconceived as it was based on grounds under section 46(1)(c) and (d) of the Act (in essence a claim that the mark in question has, since registration, become generic or deceptive) but the supporting explanation was based on allegations appropriate to section 3(1), in essence, that the mark is (and never was) distinctive. The revocation has no impact on these proceedings anyway because, as I will explain in more detail later, the revocation was not lodged against any of the earlier marks pleaded by the opponent. In contrast, the opponent's claim is not misconceived. They have pleaded various grounds under section 5 of the Act and have identified the various marks on which they wish to rely. The case-worker, therefore, had no option other than to process the opponent's opposition in accordance with the Act and the procedural rules that underpin it (The Trade Mark Rules 2008 ("the Rules")). Ms Fowler also highlights that the opponent was granted an extension of time to file its evidence. However, the granting of additional time is provided for by the Rules and it was felt that such extra time was justified in these proceedings. In all, I can see nothing whatsoever in the conduct of the tribunal staff that calls their impartiality into question. Indeed, having read the correspondence on file, the tribunal's staff have acted in a fair, reasonable and patient manner with Ms Fowler.

13. Ms Fowler has also, apparently, reported the tribunal to the police for fraud and theft. This is linked to the lodging of the revocation application (which costs £200). Ms Fowler believes that she was directed to make the application. This is not the case. As I will come on to discuss later, in the applicant's counterstatement Ms Fowler appeared to call the validity of the earlier marks into question. She was advised that it is not possible to challenge the validity of the earlier marks in this way, and that if she wished to make such a challenge then she should apply for declarations of invalidity. This is not a direction but a simple explanation of the facts. That Ms Fowler then filed a different type of application, against a mark that is not even relied on in these proceedings, and on misconceived grounds, is a matter for Ms Fowler and the applicant. I need say no more.

14. Government harassment has also been alleged because Ms Fowler states that the first to register a mark owns it. So, as she (or more accurately her company) filed the mark, she owns it without challenge. Whilst I understand the point, the fact remains that the Act and Rules provide for oppositions to be made to trade mark applications on various grounds. This is what has happened here, so the processing of the opposition cannot reasonably be taken to be any form of harassment.

Human Rights Act

15. Ms Fowler states that the opposition, if it were successful, would infringe her right to the freedom of expression and would contravene the human rights provisions on discrimination. Firstly, I see nothing whatsoever to suggest that she has been discriminated against. In terms of freedom of expression, the registration or

otherwise of a trade mark is not an act of expression, so I do not see how this would apply.

The opponent's earlier marks and their legal status in the proceedings

The earlier marks

16. Under sections 5(2)(b) & 5(3) of the Act, the opponent has based its opposition on eight earlier trade marks. The details of these are as follows:

i) UK Registration 1431976 for the mark **POLO** which was filed on 12 July 1990 and entered on the register on 28 January 1994. The mark is registered for the following goods:

Class 25: Articles of clothing for men, women and children; all included in Class 25; but not including clothing designed for use while playing polo and not including poloneck sweaters or babies napkins.

.....

ii) UK Registration 1161232 for the mark **POLO** which was filed on 14 September 1981 and entered on the register on 14 July 1989. The mark is registered for the following goods:

Class 25: Slacks, jackets; jeans and sports footwear, all being articles of clothing; but not including clothing for use in horse riding or the playing of polo.

.....

iii) Community trade mark (CTM) 404334 for the mark **POLO** which was registered on 29 September 2004 and entered on the register on 12 August 2010. Although the mark is registered (and relied on) for a wider range of goods, I list below those that fall in class 25:

Class 25: Clothing, underclothing; shoes and footwear; headgear; clothing for men, women, children and infants, jeans, slacks, trousers, skirts, shorts, wraps, jerseys, sweaters, waistcoats, dresses, jumpers, sleepwear, robes, warm-up suits, rainwear, sweaters, scarves, hats, caps, mittens, snow suits, belts, smocks, swimwear, playsuits, bibs, stockings, socks, waterproof clothing, underwear; footwear for men, women, children, and infants shoes, sneakers, sandals, slippers, boots; headgear for men, women, children, and infants hats, headbands, earmuffs, caps, sweaters, dress shirts, blouses; jackets, ties, suits, bathing suits, belts, skirts, dresses, coats, hats, caps, tuxedos, pants, vests, hosiery, scarves, pajamas, underwear, kilts, mufflers, shawls; footwear, shoes, boots, slippers, and athletic shoes; blazers, headbands, wristbands, coveralls, overalls, sweat pants, and sleepwear; but not including shirts other than dress shirts, and not including garments with polo necks, and not including any of the aforesaid goods being sports clothing intended for use in playing polo.

iv) CTM 8612871 for the mark **POLO  RALPH LAUREN** which was filed on 13 October 2009 and entered on the register on 8 June 2010. Although the mark is registered (and relied on) for a wider range of goods and services, I list below those that fall in class 25:

Class 25: Clothing, footwear, headgear.

.....

v) CTM 8814451 for the mark **POLO JEANS.CO** which was filed on 13 October 2009 and entered on the register on 8 June 2010. Although the mark is registered (and relied on) for a wider range of goods and services, I list below those that fall in class 25:

Class 25: Clothing, footwear, headgear.

.....

vi) CTM 8928772 for the mark **POLO TENNIS** which was filed on 4 March 2010 and entered on the register on 10 October 2011. Although the mark is registered (and relied on) for a wider range of goods and services, I list below those that fall in class 25:

Class 25: Footwear, headgear.

.....

vii) CTM 9624784 for the mark **POLO DENIM & SUPPLY** which was filed on 23 December 2010 and entered on the register on 7 July 2011. Although the mark is registered (and relied on) for a wider range of goods and services, I list below those that fall in class 25:

Class 25: Clothing, footwear, headgear; boots; shoes; slippers; sandals; trainers; socks and hosiery; hats; caps; berets; scarves; gloves; mittens; belts (being articles of clothing); shirts; T-shirts; sports shirts; trousers; jeans; shorts; sports shorts; swimwear; underwear; lingerie; tracksuits; articles of outerwear; coats; jackets; ski jackets; waterproof and weatherproof clothing; ski wear; suits; jumpers; cardigans; knitwear; leggings; neckties; pyjamas; waistcoats; headbands and wristbands; menswear; womenswear; childrenswear; underclothing; clothing for men, women, children and infants; slacks; skirts; wraps; jerseys; blouses; dresses; sleepwear; robes; sweatshirts; bibs; stockings; earmuffs; ties; tuxedos; vests; kilts; shawls; blazers; overalls

viii) CTM 9624784 which was filed on 1 October 2010 and entered on the register on 14 March 2011. Although the mark is registered (and relied on) for a wider range of goods and services, I list below those that fall in class 25, together with the mark as registered:



Class 25: Clothing, footwear, headgear

.....

The status of CTMs

17. For the benefit of the applicant, I firstly explain that CTMs, which are administered by the Office for Harmonization in the Internal Market (OHIM) are, effectively, pan-European trade marks which cover all Member States of the EU. They may, therefore, be used as a basis for an opposition to a domestic UK trade mark application. Indeed, section 6(1)(a) specifically lists a CTM in its definition of what constitutes an earlier mark under the Act, namely:

“a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

The proof of use provisions

18. The second point I highlight is that if an earlier trade mark completed its registration procedure (the date on which it was entered on the register) five years or more before the date on which the applied for trade mark was published, it can only be relied upon in opposition proceedings to the extent that it has been genuinely used in the five years preceding publication of the applied for mark¹. Thus, if such a trade mark has not been used at all then it cannot be relied upon. The applicant's mark was published on 8 August 2014. This means that earlier marks that completed their registration processes on or before 8 August 2009 are potentially subject to the requirement to prove use. Of the opponent's marks, only marks i) and ii) fall into this category. The other marks may, therefore, be relied upon without having to prove genuine use and may be relied upon for their specifications as registered.

19. In the preceding paragraph, I used the words “potentially subject to the requirement to prove use”. This is because it is not always the case that evidence is required. This is because, when the opposition is lodged, an opponent is required to

¹ See Section 6A of the Act

make what is termed a “statement of use” in relation to any marks which are subject to the proof of use requirements. The opponent duly did this and claimed that marks i) and ii) had been used in relation to all of the goods for which they are registered. Having made a statement of use, it is then up to the applicant to decide whether it wishes the opponent to prove that claim. This is specifically dealt with in Part 7 of Form TM8, Notice of Counterstatement and Defence. Part 7 is headed “Request for “proof of use””. The first question on the form asks “Do you want the opponent to provide “proof of use” to which the applicant ticked YES. However, the follow up to this question reads:

“If more than one trade mark is being relied upon by the opponent or cancellation applicant, please provide the number(s) of the trade mark(s) for which you would like the other party to provide “proof of use”.”

20. The follow-up question was applicable in these proceedings given the multiple earlier marks being relied upon. The applicant went on to answer the question thus:

“UK0000143976”

21. This is clearly a typographical error and should have read “...1431976” [mark i)]. Consequently, the requirement to prove use applies only to mark i) not mark ii). Mark ii) may, therefore, be relied upon in these proceedings for its specification as registered without having to prove use.

Validity of earlier marks

22. The third point I highlight relates to the validity of the earlier trade marks. Part of the applicant’s evidence relates to the game of polo and the accompanying submission that no one party should be able to monopolize the name of a sport. I should say upfront that there is no *de facto* prohibition on the registration of trade marks which consist of the names of a sport. Registration depends on the name itself and what it is to be registered for. For example, it would not be possible to register POLO for sporting services because it is indeed a description of such services. The position is different for most types of clothing. Sometimes the use made of the mark by the person applying to register it may also be relevant. However, what is more significant here is that regardless of what the applicant feels the law ought to be, the opponent’s marks are in fact registered trade marks. There is a presumption of validity in relation to a registered trade mark. Section 72 of the Act reads:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

23. Furthermore, the judgment of the Court of Justice of the European Union (“CJEU”) in *Formula One Licensing BV v OHIM* specifically indicates that a registered trade mark must be considered to have at least a minimum degree of distinctive character; the CJEU stated:

“42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).

45. Such a finding would be detrimental to national trade marks identical to a sign considered as being devoid of distinctive character, as the registration of such a Community trade mark would bring about a situation likely to eliminate the national protection of those marks. Hence, such a finding would not respect the system established by Regulation No 40/94, which is based on the coexistence of Community trade marks and national trade marks as stated by the fifth recital in the preamble to that regulation, given that the validity of an international or national trade mark may be called into question for lack of distinctive character only in cancellation proceedings brought in the Member State concerned by virtue of Article 3(1)(b) of Directives 89/104 and 2008/95.

46. It should be noted that Article 8(2)(a)(ii) of Regulation No 40/94 expressly provides, in opposition proceedings, for trade marks registered in a Member State to be taken into consideration as earlier trade marks.

47. It follows that, in order to avoid infringing Article 8(1)(b) of Regulation No 40/94, it is necessary to acknowledge a certain degree of distinctiveness of an earlier national mark on which an opposition against the registration of a Community trade mark is based.”

24. It is open to an applicant who is faced with an opposition based on earlier marks to seek the invalidation of those marks so as to destroy the basis of the opposition. It appeared at one point that the applicant was attempting to do so with various claims being made in the counterstatement. However, as stated earlier, there is no provision in the Act or the Rules for an invalidation procedure to operate within an opposition. Instead, the Act and Rules specify that a claim for invalidity must be made in its own right. It would then be possible to consolidate the opposition and invalidation proceedings (in so far as invalidation against UK marks is concerned) so that they are dealt with at the same time. Invalidation claims against CTMs will, though, need to be lodged at OHIM. The tribunal asked for part of the applicant's counterstatement to be struck out because it was attempting to raise invalidity claims. The letter from the tribunal stated:

“Thank you for striking out the counter claims filed in the original Form TM8 and for filing amended pleadings regarding the Section 5(4)(a) claim. The official letter dated 27 November 2014 explained there are no provisions for making a counter-claim in proceedings before the Registrar. If the applicant wishes to proceed with these claims they should file invalidation proceedings against the opponent’s registered trademarks.

25. Subsequent to the above, the applicant sought the revocation (not invalidation) of a mark owned by the opponent. However, the revocation was lodged in respect of a mark that was not even relied on in these opposition proceedings. Given this, and given the claims that had been made, I called a case-management conference (CMC). After explaining to Ms Fowler the procedures for filing invalidation claims, and, also, the consequences of not doing so (that the opponent’s earlier marks could be relied upon), Ms Fowler confirmed that no proceedings were to be lodged against any of the earlier marks, albeit with the caveat that if the applicant lost these proceedings she may do so then. As a result of the CMC, I then set out a number of directions which i) set the evidence timetable and ii) declined to consolidate the revocation with the opposition as the one had no material impact on the other.

Distinctiveness of earlier marks

26. The fourth point I make here is that although it is true that an earlier registered trade mark must be taken to have at least some distinctive character, that distinctive may vary according to the goods at issue, and, also, according to the evidence that the opponent has presented (which I will turn to later). Therefore, in relation to the opponent’s earlier marks, the following can be summed up:

- i) All eight marks are valid registrations and must be assumed to have at least some distinctive character, in a trade mark sense.
- ii) The degree of distinctive character may vary (but there will always be some) in accordance with the goods they cover and the evidence presented.
- iii) All of the earlier marks, except mark i), may be taken into account for their specifications as registered and relied upon.
- iv) Earlier mark i) is subject to the proof of use provisions and, so, may only be relied upon to the extent that it has been genuinely used.

The section 5(4)(a) claim

27. The opponent has also raised a ground based on section 5(4)(a) of the Act. This relates to the law of passing-off, the opponent claiming that it has used the sign **POLO** since the 1960s in relation to various clothing items. In relation to this claim the opponent must establish through evidence that it has a business in the clothing field and that the word POLO is associated with the goodwill of that business. I will, though, begin with section 5(2)(b) of the Act.

Section 5(2)(b)

The legislation and leading case-law

28. Section 5(2)(b) of the Act states:

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

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

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

29. The following principles are gleaned from the judgments 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

My approach

30. There is no single “best case” earlier mark to focus on. The closest earlier marks are those which consist of the word POLO alone. However, these marks have narrower specifications than some of the other marks. Furthermore, even for the POLO marks, the exclusions applied to their specifications are different and, also, one is subject to proof of use.

31. My initial approach under section 5(2)(b) will be as follows:

- i) To focus firstly on earlier CTM 404334. It is for the word POLO and is registered for a fairly wide specification and, furthermore, this mark is not subject to the proof of use provisions.
- ii) When assessing the opposition on the basis of CTM 404334, I will deal firstly with the position involving identical goods and decide if there is a likelihood of confusion.
- iii) If there is a likelihood of confusion, I will then consider the matter for any remaining goods, be it on the basis of CTM 404334, or, alternatively, any of the other earlier POLO marks.
- iv) If I have found no likelihood of confusion (be it for the identical goods or for the other goods), I will consider the opposition under section 5(2)(b) on the basis of the other earlier marks.

Identical goods when compared to CTM 404334

32. The earlier mark is registered for the following:

Class 25: Clothing, underclothing; shoes and footwear; headgear; clothing for men, women, children and infants, jeans, slacks, trousers, skirts, shorts, wraps, jerseys, sweaters, waistcoats, dresses, jumpers, sleepwear, robes,

warm-up suits, rainwear, sweaters, scarves, hats, caps, mittens, snow suits, belts, smocks, swimwear, playsuits, bibs, stockings, socks, waterproof clothing, underwear; footwear for men, women, children, and infants shoes, sneakers, sandals, slippers, boots; headgear for men, women, children, and infants hats, headbands, earmuffs, caps, sweaters, dress shirts, blouses; jackets, ties, suits, bathing suits, belts, skirts, dresses, coats, hats, caps, tuxedos, pants, vests, hosiery, scarves, pajamas, underwear, kilts, mufflers, shawls; footwear, shoes, boots, slippers, and athletic shoes; blazers, headbands, wristbands, coveralls, overalls, sweat pants, and sleepwear; but not including shirts other than dress shirts, and not including garments with polo necks, and not including any of the aforesaid goods being sports clothing intended for use in playing polo.

33. As can be seen, the earlier mark is registered not only for specific items of clothing, but, also, wide terms which cover clothing, footwear and headgear generally. There are, though, exclusions to the goods, namely:

- i) Shirts other than dress shirts.
- ii) Garments with polo necks.
- iii) Sports clothing intended for use in playing polo.

34. The applicant seeks registration for:

Class 25: Clothing, footwear, headgear; clothing for horse-riding [other than riding hats]

35. In *Gérard Meric v OHIM* (Case T-133/05) the General Court explained that goods can be considered as identical if they fall within the ambit of a general category of the competing specification; it stated:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, *OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

36. The applicant is applying for a range of clothing which is encompassed by the broad terms of the opponent’s 404334 mark. This includes the applied for “clothing for horse-riding”, which is covered by the general term ‘clothing’ in the opponent’s specification as that term covers clothing worn whilst horse riding. The applied for goods must, therefore, be held to be identical to the opponent’s goods.

37. The only exception to the above is that the applied for goods also notionally cover the goods which have been excluded from the opponent’s registration (shirts other than dress shirts, garments with polo necks, sports clothing intended for use in playing polo). Such goods (insofar as they are notionally covered by the applied for

specification) cannot therefore be held to be identical. As indicated in my approach above, I will deal with these goods later.

Average consumer and the purchasing act

38. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

39. The conflict relates to clothing products. Such goods are “consumed” by members of the general public. The goods may be tried on and are likely to be inspected for colour, size, style, fitness for purpose etc. All of this increases the potential exposure to the trade mark. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and, although cost can vary, it is not, generally speaking, a highly expensive purchase. I consider the purchasing process to be a reasonably considered one, no higher or lower than the norm. In relation to clothing for horse-riding (such as jodhpurs for example) similar observations apply, although there may be a slightly more considered process involved, albeit still not of the highest degree.

40. In terms of how the goods will be selected, this will normally be via self-selection from a rail or shelf (or the online equivalents) or perhaps chosen from catalogues/brochures. This suggests a process of mainly visual selection, a view which has been expressed in previous cases².

Comparison of marks

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

² See, for example, *New Look Ltd v OHIM* – Joined cases T-117/03 to T-119/03 and T-171/03 (GC)

“.....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.”

42. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:



and **POLO**

43. I have already touched on the dispute as to how the applied for mark will be perceived. I come to the view that the average consumer will see the applicant's mark as comprising the word POLO with a picture of a polo mallet alongside it. It will not be seen as an invented and stylised word TPOLO. The polo mallet does not blend with the word POLO in such a way to be seen in the manner suggested by the applicant. It may have been the applicant's intention to create a TPOLO mark, but that does not matter, it is the perception of the average consumer that matters. I accept that the mallet has a strong degree of stylisation and without context the average consumer may not know what it is. However, the word POLO gives it context so that its significance will be understood.

44. In terms of overall impression, the opponent's mark consists of just one element, the word POLO. That word, therefore, is the only aspect of its overall impression. In terms of the applicant's mark, the two elements (the word POLO and the polo mallet) make what I regard as a roughly equal contribution to the overall impression of the mark.

45. Aurally, the marks are identical. For the reasons already given, the applicant's mark will not be articulated as T-POLO. The only verbal element is the word POLO and I consider it unlikely that the average consumer will attempt to articulate the picture alongside that word. Consequently, both marks will be articulated as POE-LOW.

46. Visually, there is some similarity given the common presence of the word POLO in the mark. However, there is also a difference on account of the additional picture in the applicant's mark. Bearing in mind my assessment of the overall impressions of

the marks, I consider that this equates to there being a medium (but not high) level of visual similarity.

47. Conceptually, the opponent's mark will be seen as a reference to the sport of polo. The applicant's mark will make much the same reference, although it has the added ingredient of a polo mallet. Nevertheless, given the shared significance of the sport of polo, there is a high degree of conceptual similarity.

Distinctiveness character of the earlier marks

48. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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).”

49. I will consider the position firstly on an inherent basis. As stated already, distinctiveness lies on a spectrum, the position on the spectrum depending on the nature of the mark and the goods for which it is registered. As I have already observed, the earlier mark must, though, be held to have some distinctive character. In the assessment I am making at this stage, I am considering only the position with regard to identical goods, so I am considering all items of clothing except shirts other than dress shirts (which would include polo shirts), polo necked garments and sports clothing intended for playing polo.

50. To illustrate best the spectrum of distinctiveness, consider firstly a wedding dress. The word POLO has no relationship whatsoever with such goods and, as such, would be regarded as having a reasonably high degree of inherent distinctive character. The same would apply in relation to business suits, formal shoes, underpants and so on. Then consider more casual items such as jeans. I see no

specific link between polo and jeans, even if someone watching polo may wear such items and even though it may be possible to market jeans specifically to a polo watching average consumer. For such goods the mark has at least an average level of inherent distinctive character. For some goods the level of distinctive character may be low. For example, the applicant's goods include goods for horse-riding, goods which are also notionally covered by the opponent's mark. Here, the mark has suggestive characteristics given that horses are ridden whilst playing the sport. Even though the level of distinctiveness may be low, it must still, though, be regarded as having some distinctiveness for such goods.

51. It would not be practical to go through every possible item of clothing that may fall in class 25. But, hopefully, the above gives an indication of how I consider matters. In the applicant's evidence, Ms Fowler explains what the applicant is selling or intending to sell. This appears to be t-shirts, polo shirts, hoodies and long sleeve t-shirts. There are also some unspecified items for women and children. Of the specified goods, it is only the hoodies that fall within the identical goods I am considering at this stage of the decision (I will come back later to deal with t-shirts and polo shirts). However, what is also clear from the applicant's evidence is that the goods being sold feature designs associated with the sport of polo. Whilst this may be so, the applicant's prospective use is simply a marketing strategy for the goods currently being sold. I must consider the position generally in relation to hoodies. There is no specific link between hoodies and the sport of polo. I still, therefore, consider the word POLO to be averagely distinctive for hoodies.

52. That then leads to the opponent's evidence. It comes from Ms Anna Dalla Val, vice president and secretary of PRL International, Inc, "General Partner of the opponent". She provides considerable detail about the opponent's business which was founded in 1967 in the US by the fashion designer Ralph Lauren. Its first shop outside of the US was opened in London in 1981. It has since opened retail outlets across the world with around 138 directly operated "freestanding" stores, 235 factory outlets and 22,000 "shop[s]-within-shops. As at the date of the filing there are said to have been 6 retail stores, and 13 factory shops within the UK across 7 locations and "numerous" shops-in-shops. Ms Dalla Val states that the marks have been used on the opponent's goods for many years including in the UK in relation to various articles of men and women's clothing, as well as clothing and fashion accessories. At Exhibits ADV8 and ADV10 she provides extracts from the opponent's catalogues and website showing examples of the marks in use on goods including various types of clothing, headgear and footwear. By way of example, use is shown in relation to belts, caps, shoes, shirts (formal), polo shirts, t-shirts, sweaters and socks.

53. Ms Dalla Val identifies a number of sponsorship activities that have taken place including some in the UK. For example, it has been the official outfitter for the Wimbledon tennis tournament since 2006 and has sponsored the Open Championship golf tournament in a similar way. It was also the outfitter of the US Olympic and Paralympic teams in 2012. The evidence also shows that the turnover in the UK was considerable. Turnover has grown since 2005, but to best illustrate the level of sales, in 2012 total sales in Europe were worth \$1,484.9 million with around 20% of this attributable to the UK market. In her evidence, Ms Fowler states that the opponent's market-share may not be as large as some of its competitors and that the

opponent is not listed on the London Stock Exchange. However, neither of these points means that the use shown is less than considerable.

54. In assessing the evidence I bear in mind that the use of POLO is almost always made in conjunction (or close conjunction) with other matter, namely, the name RALPH LAUREN and/or the stylised polo player emblem. However, I come to the view that the average consumer will nevertheless see the word POLO as, effectively, a recognisable sub-brand of Ralph Lauren. I consider that the word POLO is highly distinctive in so far as most of the type of products mentioned in paragraph 52 is concerned (although I accept that the enhancement of distinctiveness will have been less in relation to polo shirts given the inevitable lower starting point on the spectrum of distinctiveness for such goods).

Likelihood of confusion in respect of the identical goods

55. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

56. The goods being considered are identical. This is an important point because of the potential for this to offset a lesser degree of similarity between the marks (as per paragraph 29 (g)). In any event, the marks have a medium degree of visual similarity, are aurally identical, and conceptually similar to a high degree. The earlier mark is also highly distinctive in fact through use for a range of clothing items. Even where there is no such specific use, the earlier mark, for most of the goods, has an average level of distinctiveness.

57. Many of the above factors go in favour of the opponent. It seems to me that the underlying point Ms Fowler is attempting to make in support of the applicant's case is that the opponent cannot stop other traders (including the applicant) from using the word POLO as a description for goods which have a polo theme. It is true that a trader ought not to be worried about using a descriptive term in a descriptive sense. For example, section 11(2)(b) indicates that a trade mark is not infringed by:

“the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services”

58. However, the above relates to use in the course of trade not to trade mark registration *per se*. Nevertheless, in the context of assessing whether there is a likelihood of confusion, if the average consumer perceives an element of a trade mark as a pure descriptor then he or she would unlikely confuse the marks in the sense of assuming that the goods are the responsibility of the same or an economic undertaking. But, the difficulty the applicant has here is that the earlier mark POLO is to be considered as distinctive (in a trade mark sense). Furthermore, it is not the case here that the applied for mark uses the word POLO in an obviously descriptive manner. To illustrate the point, if the verbal element in the applied for mark had been

something along the lines of “For polo players everywhere”, the word POLO would be perceived by the average consumer purely as a descriptor and, thus, would unlikely confuse it with the earlier POLO mark. In her evidence Ms Fowler gives an example of some promotional use on the website of *Lacoste* which uses the expression “polo news – the business of casual polo”, this, though, is an example of the use of the word polo in a more descriptive manner, not use as part of a trade mark. In contrast, the applicant has applied for its mark as a trade mark and the word POLO, and the role it plays within the applicant’s mark, is not obviously descriptive. Given all this, I consider there is a likelihood of confusion. The average consumer would believe that the goods sold under the applied for mark are from the same stable as the opponent’s POLO range of goods. **The opposition succeeds for the identical goods I have considered thus far.** In reaching this view I have not ignored Ms Fowler’s references to other POLO marks on the register (and company names with that word) and her specific highlighting of the use of the trade mark Marc O’Polo. However, I must consider the mark before me and the impact that the use of the word POLO within it will potentially have. To best illustrate the point, it may be the case that the use of Marc O’Polo may not cause confusion because in that mark the use of POLO will be seen as part of a person’s name. This is not the case with the applied for mark.

Likelihood of confusion in respect of the other goods

59. I have so far considered the opposition on the basis of identity between the goods, in other words all items of clothing except for i) shirts other than dress shirts, ii) polo neck garments and iii) sports clothing intended for playing polo. None of these goods are specifically listed in the applied for specification, although they are notionally covered by it. The applicant has not provided any fall-back specification to signify that these goods are of interest. I note from the applicant’s evidence that at least shirts other than dress shirts may be of interest. I will begin by considering the position in relation to such goods and then make further observations on the other goods later.

Shirts other than dress shirts

60. Such shirts would include garments such as t-shirts, polo shirts, and casual button-up shirts. Although they are excluded from earlier CTM 404334, they are not excluded from one of the other earlier POLO marks, namely UK registration 1431976. That mark is registered for the following class 25 goods:

Articles of clothing for men, women and children; all included in Class 25; but not including clothing designed for use while playing polo and not including poloneck sweaters or babies napkins.

61. The one issue I bear in mind is that registration 1431976 is subject to the proof of use requirements. However, it is clear from the evidence filed that the opponent has genuinely used its POLO mark as a trade mark for a range of clothing products. I set out earlier the type of goods on which use has been made. Without going into the manner of use in any more detail than is necessary, I find that the earlier mark meets the proof of use assessment for a variety of goods, including shirts (casual shirts, polo shirts etc). Although POLO is often used alongside the Ralph Lauren name

and/or polo player device, the nature of use is such that POLO alone also distinguishes the opponent's goods. As stated earlier, it will be seen as a recognisable sub-brand. This means that the opponent is able to rely on shirts with regard to this earlier mark. The consequence of this is that there is identity between the goods. For the benefit of Ms Fowler, the case-law and the legal principles relevant to the proof of use assessment are set in the Annex to this decision.

62. The consequence of finding that the goods are identical to the goods in one of the other earlier POLO marks is that the assessment to be made is the same as I have already made on the preceding page of this decision. The only potential difference is in terms of the arguments to be considered in relation to polo shirts (a specific type of non-formal shirt). Although the earlier mark must be held to be distinctive (in the sense of indicating trade origin) it could be argued that because the goods are polo shirts, the use of the word POLO in the applied for mark loses any capacity to be seen as an element that indicates trade origin as it will be regarded purely as a descriptor of the type of shirt. However, the conjunction of that word alongside a polo mallet means that the perception of the mark on such goods will be as a trade mark making a reference to the sport of polo (in exactly the same way the opponent's mark will be perceived) and not as a simple descriptor. In view of this, I conclude that there is also a likelihood of confusion for these goods.

Polo neck garments

63. Given that the applicant is interested in a range of casual clothing, I will comment on these goods. Polo neck garments/sweaters are excluded from both of the specifications I have so far considered. In terms of the one remaining earlier POLO mark, such garments are not covered by the specification. This means that none of the earlier POLO marks cover identical goods. However, that there is not identity does not end matters. A likelihood of confusion may be found on the basis of similar goods. When assessing similarity, all relevant factors relating to the goods should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

"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."

64. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

65. Earlier CTM 404334 covers various types of clothing including traditional sweaters. This is highly similar to a polo neck sweater in terms of nature, purpose and channels of trade. The other factors I have already assessed remain the same and, also, the comments I made about the role POLO plays in the applied for mark in respect of polo shirts is equally applicable here. Again, I consider that there is a likelihood of confusion.

Sports clothing intended for playing polo

66. There is nothing whatsoever to suggest that the applicant is interested in sports clothing intended for playing polo. Even if there was some sign that the applicant was so interested in these goods then I do not consider its position to be improved. The earlier mark, as stated earlier, covers all types of clothing save for the three categories mentioned earlier. Consequently, it notionally covers goods for horse-riding (as I stated earlier). These means that such goods are still highly similar to clothing intended for paying polo on the basis of purpose, nature and channels of trade. There is the same degree of similarity between the marks as assessed earlier. Although the earlier mark has less distinctiveness in this field, the fact remains that one is dealing with potential trade mark use by the applicant not descriptive use in trade. I consider, for these reasons, that there is still a likelihood of confusion.

67. The opposition succeeds based on the earlier POLO marks. Subject to appeal, the application is to be refused. For procedural economy, it is not necessary to comment on whether the opponent would also have succeeded on the basis of its other earlier marks/grounds.

Costs

68. The opponent has succeeded and is entitled to an award of costs. My assessment as to costs is as follows:

Preparing a statement and considering the other side's statement - £300

Considering and filing evidence - £800

Written submissions - £400

Attending the CMC - £200

Total - £1700

69. I therefore order HQ Accountancy Solutions Limited to pay Polo/Lauren Company L.P. the sum of £1700. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26TH day of October 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**

ANNEX

Proof of use legislation, leading-case-law and relevant principles

A) The use conditions are set out in section 6A of the Act as follows:

“(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application 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 [.....]”

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [.....]

(5) “In relation to a Community trade mark [.....], any reference in subsection (3) [.....] to the United Kingdom shall be construed as a reference to the European Community”.

B) Section 100 is also relevant, it 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.”

C) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

D) In relation to coming up with a fair specification to reflect the use made, I note that Mr Geoffrey Hobbs Q.C. (sitting as the Appointed Person), when deciding case *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* (BL O/345/10), stated:

“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.”

E) More recently, in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for

devising a fair specification where the mark has not been used for all the goods/services for which it is registered; he said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that 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 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. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

Section 5(4)(a) legislation, leading-case-law and relevant principles

A) Section 5(4)(a) of the Act reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

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

B) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing-off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

C) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

D) Whether there has been passing-off must be judged at a particular point (or points) in time. In *Assos* Mr Justice Arnold summarised the position thus:

“165. There is a further complication, however. Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

Misrepresentation

E) The relevant test for misrepresentation was outlined by Morritt L.J. in *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473:

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

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

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

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this

court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

Section 5(3) legislation, leading-case-law and relevant principles

A) Section 5(3)³ of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Reputation

B) The earlier mark must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 the CJEU stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

The required link

C) In addition to having a reputation, a link must be made between the subject trade mark and the earlier mark. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22,

³ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“*Addidas-Salomon*”) (C-408/01)).

and Marca Mode, paragraph 40).”

D) In *Intel Corporation Inc v CPM (UK) Ltd (C-252-07)* (“Intel”) the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

The heads of damage

E) There are three heads of damage, often referred to as: i) free-riding, ii) dilution, and iii) tarnishing. The three kinds of damage were conveniently summarised by the CJEU in Case C-487/07), *L’Oréal v Bellure*, as follows:

“39. As regards detriment to the distinctive character of the mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29).

40. As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41. As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation."