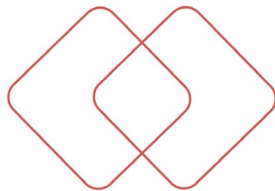
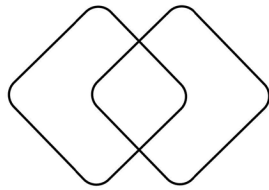


**O-136-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3264124  
BY VENUABILITY LIMITED  
TO REGISTER AS A SERIES:**

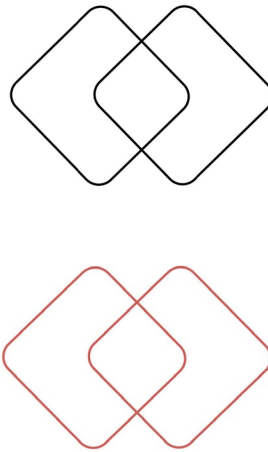


**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 411582 BY ERREA' SPORT S.P.A.**

## **Background and pleadings**

1. On 17 October 2017, an application was filed to register the series of two trade marks shown below, under number 3264124:



The application stands in the name of Venuebility Limited (“the applicant”). It was published for opposition purposes on 3 November 2017 in respect of various services in classes 35, 41 and 43. As the difference in colour makes no material difference, I will refer to the marks in the singular.

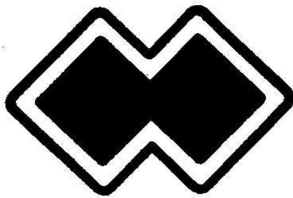
2. The application is opposed by Errea’ Sport S.p.A. (“the opponent”). The opposition is brought under ss. 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and is directed against the following services only:

**Class 35** Advertising; Advertising services, namely, providing information as to the availability of venues for hire or rent; Marketing and promotional services; provision of business information; creation and dissemination of advertising and promotional materials; performance comparison of the goods and services of others; Advertising the goods and services of other vendors, enabling customers to conveniently view and compare the goods and services of those vendors; Price comparison services; Advice, consultancy and information relating to the aforementioned services.

Class 41      Wedding celebrations (Organisation of entertainment for); Booking of entertainment; Booking of halls, venues or facilities for entertainment, cultural, sporting, educational, leisure or recreational purposes; Ticketing and event booking services; Ticket reservation and booking services for cultural, entertainment, sporting, educational events, leisure and recreational events, functions and activities; Arranging, conducting, organizing or hosting of events and activities for cultural, entertainment, sporting, educational, leisure and recreational purposes; Advice, consultancy and information relating to the aforementioned services.

3. The opponent relies on the following trade marks, whose full specifications are at the annex to this decision:

(i) European Union trade mark (“EUTM”) number 9929845 (“the device mark”).



Filing date 29 April 2011; registration date: 5 October 2011  
Registered in classes 3,9, 14, 16, 18, 25, 28, 35 and 41.

(ii) EUTM number 7008477 (“the composite mark”)



Filing date 23 June 2008; registration date 4 February 2009  
Registered in classes 3, 9, 14, 16, 18, 25, 28, 35 and 41.

4. Under s. 5(2)(b), the opponent relies upon all of the services in classes 35 and 41 of both of its marks. It claims that the contested mark is similar to the earlier marks and that the services are identical or similar. The opponent claims that there is a likelihood of confusion, including the likelihood of association.

5. Under s. 5(3), the opponent relies upon all of the goods and services for which its marks are registered. It claims that its trade marks have acquired a substantial reputation in the UK and EU as a result of the considerable use it has made of them. It claims that the relevant public will make a link between the marks and that use of the contested mark will result in the dispersion of the identity and hold upon the public of the earlier marks. Further, the opponent claims that, if the contested mark is used in relation to services which are poor or inferior, there would be damage to the reputation of the earlier marks. The opponent also claims that use of the contested mark would take unfair advantage of the earlier marks.

6. Given their dates of filing, both of the trade marks relied upon by the opponent qualify as earlier marks in accordance with s. 6 of the Act. In its notice of opposition, the opponent indicated that both marks have been used for all of the goods and services upon which it relies. This statement is made because, as both marks had completed their registration process more than 5 years before the publication date of the application in suit, they are subject to the proof of use provisions contained in s. 6A of the Act.

7. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of its claims. It indicated that it would require evidence of use for all of the services relied upon in class 35 for both of the marks relied upon. In class 41, for the earlier device mark, the applicant requests proof of use for all of the services relied upon and, for the composite mark, “organisation of sports competitions; education; providing of training; amusements”. The applicant did not request evidence of use for the remaining goods and services in the earlier specifications. The relevant period for genuine use is 4 November 2012 to 3 November 2017.

8. Only the opponent filed evidence. Neither party requested a hearing. Only the applicant filed written submissions in lieu, which I will bear in mind. Both parties have been professionally represented throughout, the opponent by Stobbs and the applicant by RevoMark. This decision is taken following a careful reading of all of the papers.

## **Evidence**

9. I should say at the outset that, whilst I have read all of the evidence, only the most relevant material is summarised below. There is, for example, a good deal of evidence from many years before the start of the relevant period (2004/2005 or earlier) which is so far removed from the relevant period that it has very limited evidential value. Moreover, its content does not, in my view, take the opponent any further than the evidence summarised below.

10. The opponent's evidence consists of the witness statement of Rosanna Fabbiani, who has held the position of the managing director for the opponent since 2015. Ms Fabbiani explains that the opponent is an Italian company specialising in the production of technical sportswear.<sup>1</sup> It has, she states, produced and sold technical sportswear and accessories for football, volleyball and basketball since 1988 and for rugby and running since 2003.<sup>2</sup> The opponent's marks have been in continuous use in the UK since 1988 and are, she says, displayed on the opponent's goods and website, as well as being used on all signage and promotional or advertising material.<sup>3</sup>

11. Ms Fabbiani exhibits a print from the opponent's website showing a number of distributors in the UK, though the precise number is unclear.<sup>4</sup> Retailers in Ely, Shrewsbury and Wolverhampton are identified on the page. The page is not clearly dated, though the map data appears to be from 2014. There are, in the same exhibit, prints from [www.maysim.co.uk](http://www.maysim.co.uk), apparently a distributor for the opponent, which bear a

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<sup>1</sup> §9.

<sup>2</sup> §10.

<sup>3</sup> §29.

<sup>4</sup> RF12.

printing date of 2014 and show “Errea” goods for sale. The goods sold as “Errea” goods include vests, t-shirts, socks, gloves, tracksuit bottoms and shorts, as well as shin pads and bags. The opponent’s marks are not clearly shown, though the composite mark is just about visible on some of the goods.<sup>5</sup>

12. Sales figures are provided, though those for the relevant period are not broken down for the various goods and services.<sup>6</sup> Nevertheless, sales for the period 2012 to 2016 were €4 million to €7 million annually in the UK, in excess of €4 million annually in France and over €2 million annually in Spain, with more modest but not insignificant figures in Germany. Breakdowns for the period 2006-2010 show that textiles accounted for around ninety-five percent of the opponent’s revenue in the UK, with bags and balls averaging between two and three per cent each. Advertising spend in 2012/2013 was over €400,000.

13. Invoices for the sale of goods to UK customers between 2013 and 2016 are evidenced at RF15. Goods such as trousers, shorts, polos, shirts, rain jackets, socks, fleeces, caps, mittens/gloves and, on one invoice (pp. 20-21), bags are specified. Some of the 2013 invoices are in Italian but terms such as “tech polo”, “polo rugby”, “Bermuda” and “mitten” are visible. Most of the goods appear to be for specific football teams. All of the invoices show the composite mark.

14. Ms Fabbiani provides invoices for stands at trade fairs attended by the opponent in the relevant period, in London and Manchester. The composite mark is shown in the Manchester fair information at pp. 4-5. There is also a page about the company from [fcbusiness.co.uk/business-directory](http://fcbusiness.co.uk/business-directory). The page has a printing date of 2014 but no other date is visible. The opponent is described as “one of the most innovative teamwear manufacturers”.<sup>7</sup>

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<sup>5</sup> Gloves, trousers and shin pads, at pp. 8, 20, 21 and 23.

<sup>6</sup> RF13.

<sup>7</sup> p. 22

15. Ms Fabbiani states that the opponent is a technical sponsor to a large number of sports clubs, from junior amateur to professional teams around the world, including in Italy and the UK.<sup>8</sup> The opponent sponsored the Premier League team Middlesbrough FC between 1994 and 2009 and has sponsored Norwich City FC and Millwall FC since 2011 and 2016, respectively.<sup>9</sup> It is also said to be the kit sponsor of a number of other English and Italian league football teams, as well as the Scottish national team and British Canoeing (the latter a four-year deal running until 2021). There are in evidence nine sponsorship agreements with UK football clubs, including Norwich City FC and Millwall FC (both 2015), and one with a community sports foundation, for the provision of kit during the relevant period.<sup>10</sup> A range of items are specified, including shirts (t-shirts, polo shirts), socks, base layers, thermal and underwear gear, shorts, training and leisure clothing, bench coats, sweatshirts and tracksuits, as well as players' kit bags. Most of the agreements specify that the kit will bear the logo of the opponent. Whilst there is no image of the logo in the body of the contract, the composite mark is visible on some of the agreements, as registered or with the device and word "errea" next to one another.<sup>11</sup> I also note that one Club undertakes to display "the logo" on background displays for post-match interviews and on the club's stationery and websites.<sup>12</sup> Supporting articles which discuss the sponsorship are evidenced, whilst the composite mark is shown on kit at p. 20. There are poor reproductions at pp. 27 and 28, on which the word "errea" is visible on various items, possibly as part of the composite mark, though it is not very clear. Further prints are provided of professional footballers said to be wearing branded kit but these are dated before the relevant period (2010 or earlier).<sup>13</sup>

16. Information about the opponent's sponsorship for 2013 to 2016, which appears to be prints from the opponent's websites, is included.<sup>14</sup> Several UK and EU teams, across various disciplines, are listed. The images of sportsmen and women are poor and I

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<sup>8</sup> §§9-10.

<sup>9</sup> §§12-13

<sup>10</sup> RF9.

<sup>11</sup> p. 9, p. 2.

<sup>12</sup> p. 4.

<sup>13</sup> RF5 and RF8.

<sup>14</sup> RF10.

cannot make out the earlier marks on kit, though the composite mark appears on all but the final page (either as registered or with the device and words next to one another). In introducing this evidence, Ms Fabbiani states the exhibit contains photographs “to show the various sponsorships of sporting teams across a range of disciplines, to include football, volleyball and basketball in the UK, all of which bear the ERREA trade marks”.<sup>15</sup>

17. Evidence regarding the popularity of the Premier League is provided at RF6. There are said to have been 761 million ‘views’ of Premier League games in Europe during the 2010-2011 season. UK viewing figures for 23 live matches were 22.6 million, whilst shows such as *Match of the Day* and *Match of the Day 2* drew several million viewers per show. The Championship TV audience is said to be between 380,000 and 900,000 on SKY SPORTS. It is claimed that RF6 shows details of viewing figures and exposure of the opponent’s trade marks on shirts and other apparel for Norwich City FC and Millwall FC. I can, however, find no mention of either club in that exhibit.

18. A print said to be dated March 2014 from the website monitoring site alexa.com is provided.<sup>16</sup> It appears to show that the opponent’s website ranked 38,880 in Italy at the time and that 50.9% of its visitors were located in Italy. Ms Fabbiani indicates that these figures would also have been typical in 2017.<sup>17</sup>

19. At exhibit RF16 are a number of articles, most of which are not dated within the relevant period or which do not concern the EU. I note an article relating to the “Errea Cup 2014” (pp. 19-21), though the country to which it relates is far from clear and the organiser of the league is “CENTER FOOTBALL and FUTSAL-04”, not the opponent.

20. There is a Facebook post from 2017 with the composite mark (device and word alongside one another), which appears to show that there was an “Errea Cup” for volleyball in Italy in 2017. The opponent is described as the technical partner for

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<sup>15</sup> §19.

<sup>16</sup> RF4.

<sup>17</sup> §12.



“Runner&Walker on Cruise” in November 2017, which has stops in EU ports (pp. 34-35). There is also described an “Erreà Truck Tour” of the Iberian Peninsula in April 2017 (pp. 36-37). The article states “during this month packed with events, the truck will be visiting the most important authorised retailers in the country, and meeting the most important sports clubs in the areas visited”. Further events at which the opponent was present (Exposport Venicemarathon, Pitti Uomo (Florence), Sports Business Summit 2016 (London) are also described.

21. That concludes my summary of the evidence, to the extent I consider necessary.

### **Proof of use**

22. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (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), (b) 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 period of five years ending with the date of publication.

(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 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, 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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”.

23. Section 100 of the Act is also relevant, which reads:

“100. 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”.

24. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use has been subject to a number of judgments. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch), Arnold J. summarised the case law on genuine use:

“114. The 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 Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C- 149/11 *Leno Marken 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]”.

25. As the earlier marks are EUTMs, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining

genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use”,

and

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark”.

It went on to state:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer*

*Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity”.

26. In *London Taxi*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In *Case T-278/13 Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a



general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use”.

27. The General Court (“GC”) restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now an EUTM). Consequently, in trade mark opposition and cancellation proceedings, the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods or services being limited to that area of the Union.

28. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods and services at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods and the market(s) for them
- iv) The geographical extent of the use shown

29. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Daniel Alexander Q.C., sitting 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:

“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”.

30. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Geoffrey Hobbs Q.C., sitting 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”.

31. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)" [emphasis added].

32. In the instant case, the device mark is identical to the device element in the composite mark. With *Colloseum* in mind, I see no reason why the use of the device mark as part of the composite mark would not be qualifying use of the device mark itself, provided that it still indicates origin. There is no clear use of the device mark *solus*.<sup>18</sup> However, in *Castellblanch SA v OHIM, Champagne Louis Roederer SA* the GC held that:<sup>19</sup>

"33 In the contested decision the Board of Appeal found that there is no precept in the Community trade mark system that obliges the opponent to prove the use of his earlier mark on its own, independently of any other mark. According to the Board of Appeal, the case could arise where two or more trade marks are used jointly and autonomously, with or without the name of the manufacturer's company, as is the case particularly in the context of the automobile and wine industries.

34 That approach must be followed. The situation is not that the intervener's mark is used under a form different to the one under which it was registered, but that several signs are used simultaneously without altering the distinctive character of the registered sign. As OHIM rightly pointed out, in the context of the labelling of wine products joint affixing of separate marks or indications on the same product, in particular the name of the winery and the name of the product, is a common commercial practice".

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<sup>18</sup> The only possible example is at RF8 but the reproduction is unclear.

<sup>19</sup> [2006] ETMR 61

33. Whilst I recognise that the word “errea” is highly distinctive and plays an equal part in the composite mark to the device, I have no doubt that the device is, of itself, distinctive for the goods and services upon which the opponent seeks to rely. It is also, in my view, capable of indicating the origin of the goods and services, notwithstanding the fact that it appears only to have been used alongside other matter. Use of the device mark as part of the composite mark is, therefore, use of the device mark which falls within the provisions of s. 6(A)(4)(a) and upon which the opponent may rely.

34. Turning to the composite mark, there is evidence of its use both in its registered form and with the device and the word “errea” next to one another, rather than one above the other. I consider that the latter use also falls within the provisions of s. 6(A)(4)(a), as the only difference between the registered mark and the form used is that the elements are arranged in a slightly different way. There are no other elements which might alter the distinctive character of the mark and no distinctive elements of the registered mark are omitted. The use is in a form which does not alter the distinctive character of the mark and is acceptable.<sup>20</sup>

35. As regards sufficiency of use, the opponent has provided evidence that its marks have generated several million Euros’ worth of sales annually in the UK during the relevant period. That is more than sufficient to reach the relatively low bar for genuine use.

36. On the issue of a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Geoffrey Hobbs Q.C., sitting 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

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<sup>20</sup> See *Nirvana Trade Mark*, BL O/262/06.

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

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

“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”.

38. Proof of use was only requested for certain services in classes 35 and 41. There is no evidence at all showing a trade or the provision of a service in relation to perfumery, spectacles, horological instruments, jewellery or stationery. The opponent’s evidence does show that it has sold not insignificant quantities of clothing to consumers, including to the public through UK distributors and via contracts with football clubs. There is some evidence that it has also supplied kit bags for players. It is not clear whether the kit bags are adapted for use or not; one of the invoices shows sales of “basic bag black”.<sup>21</sup>

39. I recognise that the use of a trade mark for retail (and by extension wholesale) services does not exclude the situation in which the services provided to the consumer include services provided by the proprietor itself.<sup>22</sup> However, in Case C-421/13, *Apple Inc. v Deutsches Patent- und Markenamt*, the CJEU ruled that a trade mark used in retail services may be protected for services intended to induce the consumer to purchase the goods, provided that those services do not form an integral part of the offer for sale of the goods. The court stated:

“26. [...] it must be held that, if none of the grounds for refusing registration set out in Directive 2008/95 preclude it, a sign depicting the layout of the flagship stores of a goods manufacturer may legitimately be registered not

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<sup>21</sup> RF15, p. 21.

<sup>22</sup> See *Netto Marken-Discount AG & Co. KG v Deutsches Patent- und Markenamt*, Case C-420/13 at [39].



only for the goods themselves but also for services falling within one of the classes under the Nice Agreement concerning services, where those services do not form an integral part of the offer for sale of those goods. Certain services, such as those referred to in Apple's application and clarified by Apple during the hearing, which consist of carrying out, in such stores, demonstrations by means of seminars of the products that are displayed there, can themselves constitute remunerated services falling within the concept of 'service'".

40. Accordingly, the manufacture and sale of one's own products, even to a distributor, does not amount by itself to the provision of a retail or wholesale service. There is no evidence at all that the opponent has effected any other kind of service which would properly be considered a wholesale or retail service. There is, for example, no evidence that the opponent sold any goods other than its own products or that it offered a service to third parties to induce consumers to buy any third party's products. I do not consider that the opponent has shown genuine use of the mark in relation to any of the services in class 35 for which its marks are registered.

41. As regards class 41, it appears that the opponent relies upon its sponsorship of various sporting events to support its claim to offering the sporting, cultural and educational services relied upon. I do not consider that the evidence establishes any such use. I have not overlooked Ms Fabbiani's comment that the RF16 shows "a number of high profile events [...] organised and sponsored by My Company".<sup>23</sup> That is, however, a broad claim which is not borne out by the documentary evidence. The opponent's logo certainly appears as part of the name of these events. Lending one's name to an event (or, for that matter, sporting teams) is not, though, the same as offering any of the services for which proof of use is sought. The evidence lacks any specificity which would induce me to believe that the opponent played a role in the organisation of the events referred to. Had that been the opponent's role, it ought to have been relatively straightforward for the opponent to produce evidence of its

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<sup>23</sup> §28.

involvement in the arrangement of, for example, football tournaments; there is certainly no evidence that it organised such events having been employed by a third party to do so. In short, the opponent has not demonstrated genuine use of any of the services for which evidence of use was required.

42. Although the opponent only relied upon classes 35 and 41 for its opposition under s. 5(2)(b), that is not the end of the matter under that ground because the applicant did not request that the opponent show genuine use for “sporting and cultural activities” included in the class 41 specification of the earlier composite mark. Whilst that term undoubtedly includes some of those services for which the opponent has not shown genuine use, it also encompasses other services and may, therefore, be relied upon by the opponent.

### **Section 5(2)(b)**

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

“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”.

44. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-

342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks creates a risk that the public 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 services**

45. When making the comparison, all relevant factors relating to the services in the specification should be taken into account. In *Canon*, the 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”.

46. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

47. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

48. It is permissible to group terms together in making the comparison, if the considerations are similar: *Separode Trade Mark* BL O/399/10.

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

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

50. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

51. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal*

*Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

52. I also bear in mind the comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13, where he warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

53. The opponent submits that the services in class 41 are identical or similar.<sup>24</sup> The applicant makes only brief submissions regarding the services at issue, which I take into account but do not need to detail here. It also comments on the industries in which the parties operate or intend to operate. That point is not of assistance because the assessment must be made based on the notional use of the marks across the width of

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<sup>24</sup> Its comments are in the notice of opposition and do not take into account any potential difficulty in establishing genuine use across all of the services claimed.

the specifications, unless any limitation to the services is apparent from the wording of the specifications themselves.<sup>25</sup>

### Class 35

*Advertising; advertising services, namely, providing information as to the availability of venues for hire or rent; marketing and promotional services; creation and dissemination of advertising and promotional materials; performance comparison of the goods and services of others; advertising the goods and services of other vendors, enabling customers to conveniently view and compare the goods and services of those vendors.*

54. I accept that sporting and cultural activities may be the subject of advertising campaigns. However, that does not amount to similarity between the services. Sporting and cultural activities have as their purpose organising and running events with a sporting or cultural theme. Advertising services will involve, for example, the creation of advertising strategies and associated promotional material. Whilst the organisers of sporting or cultural activities may engage an advertising agency to promote the event, the nature and purpose of the respective services are different. There may be a superficial overlap in users as businesses may use both services but this is insufficient of itself to engage similarity. The services do not share channels of trade or method of use, nor are they in competition or complementary in the sense described in the case law. The services are not similar.

### *Provision of business information*

55. I can see no similarity between these services and those upon which the opponent may rely. Their nature, purpose, channels of trade and methods of use are all different. They are neither in competition nor complementary and any overlap in users is superficial. They are not similar.

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<sup>25</sup> See *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41 at [22], *Roger Maier v ASOS* ([2015] EWCA Civ 220 at [78] and [84] and *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06).



### *Price comparison services*

56. These services are also, in my view, dissimilar to those upon which the opponent may rely. They do not coincide in nature, purpose, method of use or channels of trade. They are not in competition and are not complementary. Whilst there is an overlap in users, it is at the most general level of them being members of the public. That is not adequate reason for a finding of similarity. These services are not similar.

### *Advice, consultancy and information relating to the aforementioned services.*

57. I do not consider that the provision of advice, consultancy or information regarding the above services is similar to the opponent's services in class 41. These advisory services relate to the services specified earlier and the same reasons for rejecting similarity between the above services and those of the opponent apply, if anything with more force, as advice about the services listed earlier in the specifications is a step removed from the provision of the service itself. The services are not similar.

### Class 41

*Booking of entertainment; booking of halls, venues or facilities for entertainment, cultural, sporting, leisure or recreational purposes; ticketing and event booking services; ticket reservation and booking services for cultural, entertainment, sporting, leisure and recreational events, functions and activities; arranging, conducting, organizing or hosting of events and activities for cultural, entertainment, sporting, leisure and recreational purposes.*

58. The opponent's "sporting and cultural activities" is a broad term which runs the gamut of services connected with sporting and cultural activities. In my view, the term includes all aspects of organising sporting and cultural events, including ticket and booking services for the events and facilities. As to the specific purposes of the contested services, whilst "leisure" and "recreational" purposes are not mentioned in the

earlier specification, events or activities for leisure or recreational purposes could easily be sporting or cultural activities or events. I have no submissions from either party regarding the extent to which “entertainment” purposes may overlap with “cultural” purposes. At its broadest, “entertainment” is anything one does to amuse oneself. It seems to me that events and activities concerned with theatre, music (e.g. plays and concerts) and literature could fairly be described as having both cultural and entertainment purposes, though I accept that there are certain activities which would not straddle the two categories. These services are, therefore, identical to those covered by the opponent’s specification, either because they are different ways of describing the same service or because they are identical on the principle outlined in *Meric*.

*Arranging, conducting, organizing or hosting of events and activities for educational purposes.*

59. It seems to me that a fair reading of an “educational” activity is not merely one connected with schools but one having a wider educational (i.e. learning) purpose. The term would, therefore, include events such as educational tours of museums or cultural sites. In the absence of any evidence or submissions on the point, the organisation of these activities is highly similar to the earlier “cultural activities”, differing in their specific purpose but overlapping in nature, channels of trade, method of use and users. They may be in competition and they may also be complementary (for example, a museum may provide educational activities based on its collections).

*Ticket reservation and booking services for educational events, functions and activities; booking of halls, venues or facilities for educational purposes.*

60. These services are highly similar to the booking services which I consider are covered by the earlier specification. The particular event which is booked may differ, and to that extent the purpose of the services, but they are likely to coincide in nature, channels of trade, users and method of use, though there is unlikely to be a pronounced competitive relationship or complementarity.

*Wedding celebrations (Organisation of entertainment for).*

61. I have, above, explained why I consider “cultural activities” to encompass a range of activities and events which may also be considered entertainment. However, I think that extending this to entertainment for weddings would be taking matters too far. In the absence of evidence or submissions to the contrary, I think that entertainment for weddings would typically be DJs and bands which, whilst undoubtedly entertainment, would not normally be “cultural” activities. Whilst the purpose of the services is not the same and I am doubtful that there is a significant overlap in their channels of trade, there may be some overlap in the nature of the services. Users will intersect but there is no real competitive relationship between the services, nor are they complementary. They are similar to a low degree.

*Advice, consultancy and information relating to the aforementioned services.*

62. These services offer information about the services listed in the applicant’s specification. Their purpose is to provide information etc. about the services, rather than to provide the service. Given that the opponent’s “sporting and cultural activities” at large runs the gamut of services for sporting and cultural activities, it will, in my view, include the provision of advice etc. about the services. I consider that the term in the contested specification is similar to the opponent’s services to the same degree as for the named services considered above.

63. If there is no similarity between the services, there can be no confusion.<sup>26</sup> The opposition under s. 5(2)(b) is therefore rejected for all of the services in class 35.

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<sup>26</sup> *Waterford Wedgwood plc v OHIM*, Case C-398/07P (CJEU), *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA at [49].

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

64. It is necessary for me to determine who the average consumer is for the respective parties' services. I must then decide the manner in which these services are likely to be selected by the average consumer in the course of trade. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 services in question: *Lloyd Schuhfabrik*.

65. 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”.

66. The parties have not identified the average consumer for the services at issue. The most likely user of the parties' services is a member of the public. However, some of the services, such as the booking of venues, may also be engaged by professional users. For both groups of consumer, the services are likely to be selected through primarily visual means, for example via websites and printed advertising material. However, as such services may be discussed or benefit from, for example, oral recommendations, I do not discount that there may be an aural component to the purchase. The member of the public using the majority of the services is likely to pay a medium level of attention, being attentive to, for example, the precise offering available or the reliability of a


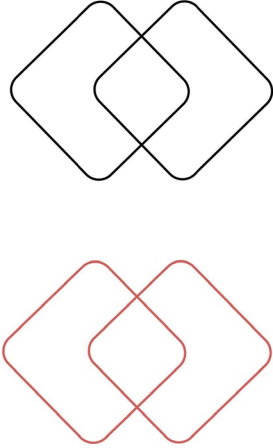
particular service provider. Services such as the booking of venues and the organisation of wedding entertainment, however, are likely to be subject to a greater degree of care, given that they may be more costly and that most individuals attach greater importance to arrangements for their wedding day. The level of attention for these services will be reasonably high. Business users are likely to pay a reasonably high degree of attention to the selection of all of the services, given that the reputation or image of a business could be affected by the effectiveness of the service or because large sums and repeat contracts may be in issue.

### **Comparison of trade marks**

67. It is clear from *Sabel* (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 *Bimbo*, 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”.

It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given 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:

Earlier mark	Contested marks (series of two)
	

68. The opponent submits that the contested marks and the device in the composite mark are very similar and that the marks as wholes are, therefore, similar overall. The applicant submits that the marks are not similar.

69. The earlier trade mark consists of two elements. The first is a device which comprises two solid squares which are presented side by side and rotated 45 degrees, overlapping at the corners in the centre of the device. The resulting shape also has a black outline, the corners of which are slightly rounded. Underneath the device is the word “errea” in a bold but otherwise unremarkable typeface. There is a thin line, in white, which crosses the top right of the letter “a”. Both elements in the mark play a roughly equal part in the overall impression. I think it unlikely that the consumer will notice the line at the top of the letter “a”, due to its size, and it plays only a very weak role.

70. The contested marks also consist of two squares, with rounded corners, presented side by side. They are rotated through 45 degrees and overlap at their centre corners. The squares are presented in outline form, the first in the series being in a thin black

line, the second in a thin red line. There are no other elements in either mark and the overall impression rests in the device as a whole.

71. There is some visual similarity due to the presence in both marks of a device which includes two squares rotated through 45 degrees. However, there are also differences because the earlier mark is solid in the centre, has a border and includes the word “errea”, whilst the later marks are much simpler and in outline form. Overall, there is a low degree of visual similarity. The use of colour in the second later mark makes no material difference, as notional and fair use of the earlier mark would permit its use in any colour.

72. Aurally, the marks are different. The device will not be articulated in either mark, so the only verbal element is “errea” in the earlier mark, which is likely to be vocalised. Its pronunciation, for the UK consumer, is likely to be “ERR-AY-AH” or “ERR-EE-AH”, though for present purposes the precise pronunciation matters not.

73. The average consumer is unlikely to attribute any concept to the word “errea”, which is most likely to be perceived as an invented word. Neither device conveys a concept. The conceptual position is, therefore, neutral.

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

74. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and*

*Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

75. The evidence does not establish that the opponent has enhanced the distinctiveness of the mark in relation to the services at issue, there being no evidence of any turnover or market share and no relevant advertising material. There is, therefore, only the inherent position to consider. The earlier mark is inherently highly distinctive. However, the high level of distinctiveness of the mark is attributable to the word “errea” as an invented word, rather than to the device, which is not particularly complex. My view of the device is that it has an average level of inherent distinctive character.



## Likelihood of confusion

76. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

77. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 as follows:

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

78. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not

be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

79. I must also bear in mind that, whilst the earlier mark is highly distinctive in its totality, the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. This was explained by Mr Purvis, again sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, where he said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it”.

80. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

81. The consumer will be either a member of the public or a businessperson. I remind myself that all of the services at issue will be selected through primarily but not exclusively visual means with at least a medium level of attention which, in some instances, will rise to a reasonably high level of attention. Some of the services are

identical and some only similar to varying degrees, while the marks have a low level of visual similarity, are aurally different and the conceptual position is neutral. Taking the position most favourable to the opponent first (a medium level of attention and identical services), I do not consider that there is any likelihood of direct confusion. The presence of the word “errea” in the earlier mark is sufficient to avoid any risk that one mark would be mistaken for the other. Nor do I consider that there is a likelihood of indirect confusion. The differences between the respective devices, combined with the presence of the highly distinctive word “errea”, are unlikely to give rise to indirect confusion. I have taken into account the judgments in *Medion* and *Bimbo*,<sup>27</sup> along with the subsequent comments in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*.<sup>28</sup> I fully accept that the device in the earlier mark has distinctive character independent of the whole and that it bears some similarity to the device of the contested marks. I have found that the device in the earlier mark, though not very complex, is averagely distinctive. However, the similarities are not sufficiently pronounced to give rise to a likelihood of confusion. It follows that, where there is no likelihood of confusion for identical services with a medium level of attention, there is also no likelihood of confusion where the services are less similar and/or where a higher level of attention is paid. The opposition under s. 5(2)(b) is dismissed.

### **Section 5(3)**

82. Section 5(3) states:

“(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 a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark

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<sup>27</sup> *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04 and *Bimbo SA v OHIM*, Case C-591/12P.

<sup>28</sup> 2015] EWHC 1271 (Ch)

without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

83. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

## Reputation

84. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. 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.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it”.

85. As is clear from the case law cited above, as the earlier marks are EUTMs, they must be known by “a significant part” of the relevant public in the EU.<sup>29</sup> It is also clear from the comments of Geoffrey Hobbs QC, sitting as Deputy Judge of the High Court, in *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC) that a reputation in the UK will qualify as a reputation in the Community:

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<sup>29</sup> *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH*, C-301/07 (CJEU).

“76. Article 9(1)(c) provides protection for Community trade marks which have a reputation “in the Community”. Kenwood suggested that this means a reputation across the Community as a whole or at least a large area of it. I do not agree. In the case of a trade mark registered at the national level, protection of the kind provided by art.9(1)(c) can be claimed for trade marks which have a reputation in the sense that they are known by a significant part of the public concerned by the products or services covered by that trade mark in the territory of registration. Since the territory of registration is part of the Community, the trade mark has a reputation in the Community. The trade mark does not cease to have a reputation in the Community if the national registration is either subsumed within a Community trade mark registration under art.34(2) of the CTMR on the basis of a valid claim to seniority or duplicated by a Community trade mark registration. In principle, a Community trade mark should not receive less protection than a national trade mark with a reputation in the same territory. I think that the aim should generally be to prevent conflict occurring in any substantial part of the Community and that the United Kingdom can for that purpose be regarded as a substantial part of the Community, with or without the addition of France and Germany. It thus appears to me that Whirlpool's Community trade mark has a reputation in the Community”.

86. Under this ground, the opponent relies upon all of the goods and services in the earlier specifications. The evidence does not support the opponent's claim to a reputation in classes 3, 9, 14 or 16: the only instance of potential use in relation to any of these goods is the undertaking by a football club to put the opponent's logo on its stationery and posters, which is a very long way from being sufficient to establish a reputation in those goods. I have explained, above, why the evidence does not show genuine use in respect of classes 35 and 41. Those reasons are equally applicable here, including for “sporting and cultural activities” in class 41, for which there is no evidence which goes beyond that considered above.

87. The evidence does show that the opponent supplied football clubs and at least one UK distributor with sports clothing (including socks, shorts, trousers, shirts, tops and jackets) during the relevant period. Although there is some evidence that the opponent was contracted to supply thermal and underwear to football clubs, these goods would not have been visible to the public when in use, nor do they appear to have been offered to the public, as they do not appear on the website prints and no sales are recorded in the invoices provided. Press reports in evidence refer only to “kit”, which appears to be principally shirts and shorts but would reasonably include goods such as tracksuit tops and trousers.<sup>30</sup>

88. There is evidence of several million Euros’ worth of sales of textiles each year between 2012 and 2016 in the UK, with lower but not insignificant sales in three other EU countries during the same period. Although there is no explicit statement that such sales were under the marks at issue, there is consistent use throughout the evidence of the use of the composite mark on clothing and it is reasonable to infer that the goods were branded with or sold under that mark. I also take into account that the principal method through which the opponent appears to have advertised its goods is through sponsorship of various sporting teams, including UK football teams from various leagues, including the Premier League. Although the evidence relating to the Premier League viewing figures does not go to the relevant period, it is unlikely that numbers would have fallen dramatically by 2012. In any event, I take judicial notice of the fact that football is a very popular, if not the most popular, sport in the UK. As a consequence, use of a trade mark on football kit is likely to reach a wide audience. There is, however, little evidence to assist me in assessing the impact of such use. The articles confirming the opponent’s position as kit supplier, for example, are not particularly convincing, being taken from football clubs’ own websites and, where figures are given, attracting a very limited number of views.<sup>31</sup> There is also no evidence of market share and, given the sizeable nature of the relevant market, the sales figures provided suggest only a small share. Taking all of the above into account, and while I

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<sup>30</sup> See also the invoices at RF15, where club names appear only against tops/jackets, shorts, trousers and socks.

<sup>31</sup> RF9, pp. 17, 30.



keep in mind that the clothing market in the EU is very large, I am prepared to accept that the opponent has established, at the relevant date, a reputation in the EU for sports clothing. However, any such reputation is, in my view, modest.

89. Evidence that the opponent provided bags during the relevant period is limited and only a few instances are in English. Kit bags formed part of the contracts at RF9 and “basic” bags are on one invoice. It is not anywhere explained what a “basic” bag is and the quantity is modest. Bags accounted for 2-3% of the opponent’s UK sales in 2006-2010 and there is nothing to suggest that this figure would have greatly changed by 2012. Although shin pads are shown in the evidence as on sale through a distributor, there is no evidence of the level of sale in relation to these goods or any other sporting equipment. Whilst sales figures of balls are recorded, there is no evidence of them for sale bearing or under either of the earlier marks. For all of these goods, I do not consider that the relatively high test for a reputation has been met. There is no evidence showing these goods in advertising matter and where any sales figures can be inferred they are tiny in relation to the relevant market.

#### Link

90. My assessment of whether the public will make the required mental link between the marks must take account of all relevant factors. The factors identified in *Intel* are:

#### *(i) the degree of similarity between the marks*

I have assessed the similarity between the composite mark and the contested mark, above. I adopt those findings here. There is clearly a greater degree of visual similarity between the device mark and the contested marks. Both contain two tilted squares which overlap. Nonetheless, the solid shading of the earlier mark and its border, and the outline form of the contested marks, constitute significant differences. There is a fairly low level of visual similarity between these marks. The aural and conceptual positions are neutral, since neither mark will be articulated and neither has a concept.

*(ii) the nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public*

I do not consider that there is any similarity between the goods for which the opponent has established a reputation and the contested services. In class 35, the contested services are, broadly, marketing and advertising services, or business services. They differ in nature, purpose and method of use from sports clothing. They are not in competition and do not share channels of trade. These services are, for the most part, used by businesses rather than individuals, unlike the opponent's goods. Where they do coincide in users (for example, price comparison services), it is at too a high level of generality for similarity to be engaged on that basis alone. Although sports clothing may be the subject of advertising or price comparison services, neither is essential or important for the other and, what is more, the consumer will not consider that the goods and services emanate from the same undertaking. They are not, therefore, complementary. The same applies with more force to the advice, consultancy and information services covered by the contested specification, which are a step further removed and are not similar to the opponent's goods.

In class 41, there is no overlap between the nature, purpose or method of use of the contested services and sports clothing. They are not in competition, are not complementary and share only a superficial point of similarity in their users.

*(iii) the strength of the earlier mark's reputation*

The reputation is modest.

*(iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use*

The composite mark is highly distinctive, though this high level of distinctiveness is due to the word "errea" rather than the device. The device mark is distinctive to an average degree.

*(vi) whether there is a likelihood of confusion*

Given the gap between the goods and services, and the differences between the marks which result in a fairly low level of visual similarity at best, I do not consider that there would be a likelihood of confusion.

91. I note that much of the opponent's advertising has been in the form of sponsorship of sporting teams. The exposure of the relevant public to the composite mark on clothing in the sponsorship context may make a link more likely, particularly for the contested services in class 41 which include the organisation of sporting events and facilities. There is also some evidence that the opponent's sponsorship has extended to the sponsorship of trophies and activities such as cruises. However, this evidence does not relate to the UK and it is, therefore, not possible to determine whether, or to what extent, it may have had an impact on the UK consumer. Moreover, none of the evidence shows the device mark in use by itself: it always appears as part of the composite mark. Bearing in mind the differences between the respective devices, outlined above, the fact that the UK public's familiarity with the opponent's brand is only through the composite mark, the gap between the goods and services at issue and the modest reputation of the opponent, I do not consider that the public will make the required link. The opposition under s. 5(3) falls at the first hurdle and is dismissed accordingly.

92. In case I am wrong that there will be no link, I will briefly give my views regarding the specific heads of damage.

## Unfair advantage

93. Unfair advantage was considered in *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch). Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.

81. The second question is whether there is a requirement for evidence of a change in the economic behaviour of consumers or a serious likelihood of such a change. As counsel for House of Fraser pointed out, the CJEU has held that proof that the use of the sign is or would be detrimental to the distinctive character of the trade mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the trade mark is registered or a serious likelihood that such change will occur in the future: see *Intel* at [77], [81] and Case C-383/12 *Environmental Manufacturing LLP v Office for Harmonisation in the Internal Market* (unreported, 14 November 2013) at [34]-[43]. As counsel for House of

Fraser accepted, there is no requirement for evidence of a change in the economic behaviour of consumers of the *trade mark proprietor's* goods or services in order to establish the taking of unfair advantage of the distinctive character or repute of the trade mark. He submitted, however, that it was necessary that there should be evidence of a change in the economic behaviour of the consumers of the *defendant's* goods or services.

82. Counsel for Jack Wills did not dispute that, in order for advantage to be taken of the trade mark's distinctive character or repute, it was necessary for there to be some change in the behaviour of the defendant's consumers as a result of the use of the allegedly infringing sign, or a serious likelihood of such a change. Nor did he dispute that what was required was a change in the behaviour of the consumers as consumers of the relevant goods and services, and in that sense in their economic behaviour. He submitted, however, that the trade mark proprietor could not be expected to adduce positive evidence that consumers had changed their behaviour as a result of the use of the sign.

83. In my judgment the correct way to approach this question is to proceed by analogy with the approach laid down by the CJEU in *Environmental Manufacturing* in the following passage:

“42. Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the

probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'.”.

94. The opponent claims that use of the contested mark would result in an unfair advantage through parasitism or free-riding. It claims that the opponent is a leading national and international sportswear brand. The evidence does not, in my view, support such a claim. The opponent is a manufacturer which has supplied kit to sports teams, it appears through sponsorship arrangements. It may have a reputation as a supplier of technical performance clothing but the evidence on that point is not compelling. Even assuming that it had at the relevant date a reputation as a manufacturer of performance sportswear, I do not see how the transfer of that image would be of benefit to the applicant for the services in classes 35 or 41. There is too great a distance between the goods and services for there to be a risk of image transfer and I can see no other way in which the applicant would gain an unfair advantage through its use of the contested mark. The consumer merely being reminded of the earlier marks does not amount to an unfair advantage. I reject this head of injury for the contested services.

#### Detriment to reputation

95. In *Unite The Union v The Unite Group Plc*, BL O/219/13, Anna Carboni, sitting as the Appointed Person, considered whether a link between an earlier mark with a reputation and a later mark with the mere potential to create a negative association because of the identity of the applicant or the potential quality of its goods/services was sufficient to found an opposition based on detriment to reputation. She said:

“46. Indeed, having reviewed these and other opposition cases, I have not found any in which the identity or activities of the trade mark applicant have been considered in coming to a conclusion on the existence of detriment to reputation of an earlier trade mark. I can understand how these matters would form part of the relevant context in an infringement case, but I have difficulty

with the notion that it should do so in an opposition. After all, many, if not most, trade mark applications are for trade marks which have not yet been used by the proprietor; some are applied for by a person or entity that intends to license them to a third party rather than use them him/itself; and others are applied for by an entity that has only just come into existence.

47. I do not exclude the possibility that, where an established trading entity applies to register a mark that it has already been using for the goods or services to be covered by the mark, in such a way that the mark and thus the trader have already acquired some associated negative reputation, perhaps for poor quality goods or services, this fact might be taken into account as relevant “context” in assessing the risk of detriment to repute of an earlier trade mark. Another scenario might be if, for example, a trade mark applicant who was a known Fascist had advertised the fact prior to the application that he was launching a new line of Nazi memorabilia under his name: I can see how that might be relevant context on which the opponent could rely if the goods and services covered by the application appeared to match the advertised activities. But I would hesitate to decide an opposition on that basis without having had confirmation from a higher tribunal that it would be correct to take such matters into account”.

96. I reject the tarnishing pleading for the following reasons:

- i) There is nothing in the provision of the services at issue which would cause any form of negative reaction;
- ii) The claim of tarnishing is no more than hypothetical;
- iii) There is no evidence that the applicant already has a negative reputation.

97. The claim under this head of damage is dismissed.

## Detriment to distinctive character

98. The opponent claims that identity of the earlier marks will be dispersed by use of the contested mark. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment)”.

It went on:

“42. Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.<sup>32</sup>

99. It is well established that there must be evidence that there has been a change in the economic behaviour of the opponent’s customers or that there is a serious likelihood of such a change. The opponent has not, in my view, provided any convincing

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<sup>32</sup> See also *32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch) at [133], in which the judge held that a change in consumers’ economic behaviour could be inferred from the inherent probabilities of the situation and para. 137 of - *Ziff Management Europe Ltd v Och Capital LLP* [2011] F.S.R. 11 (HC).



submissions which would account for such a change, particularly in respect of the dissimilar services. Nor is there an obvious reason why in this case the presence of another mark, albeit similar to a degree to the earlier marks, would result in a change in the economic behaviour of the opponent's customers. The s. 5(3) ground based on damage to distinctive character is rejected.

### **Conclusion**

100. The opposition has failed. The application will proceed to registration.

### **Costs**

101. The applicant has been successful and is entitled to an award of costs. The relevant Tribunal Practice Notice ("TPN") is TPN 2/2016. I bear in mind when making the award that much of the opponent's evidence was dated outside the relevant period. I award costs to the applicant as follows:

Considering the notice of opposition and preparing a counterstatement:	£200
Considering the other party's evidence:	£700
Filing written submissions:	£300
Total:	£1,200

102. I order Errea' Sport S.p.A. to pay Venuebility Limited the sum of **£1,200**. This sum is to 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.

**14<sup>th</sup> March 2019**

**Heather Harrison  
For the Registrar**

## Appendix

### **EUTM 9929845**

Class 3: Perfumes and alcoholic and non-alcoholic perfumery; Eaux de toilette; Extracts (perfumes); Essential oils; Pre-moistened cosmetic towelettes; Toning lotions; Moisturising and nourishing creams; Lip gloss; Creams; Gels and Hand lotion; Moisturizer; Nutrients and Body scrub; Multi-purpose creams, water and oils for the body; Deodorants; Antiperspirants; Depilatory creams; Sun creams; Gels; Lotions; Foams; Gels; Eaux de toilette; Hair shampoos and conditioners; Hair lacquers; Hair sprays and mousses; Body hygiene products; Including for example, solid soaps; Liquid and in powder; Shower and bath foam; Bath salts; Oils and make-up powder; Talcum powder and powders for sprinkling; Foot hygiene products; Products for personal hygiene; Products for dental hygiene; Dentifrices; Mouthwash; Breath freshening sprays.

Class 9: Spectacles; Sunglasses; Spectacle cases and frames; Blank CD-ROMs and DVDs for sound and/or video recording.

Class 14: Clocks and watches; Chronometers; Chronographs; Alarm clocks; Jewellery and artificial jewellery.

Class 16: Adhesive tapes for stationery purposes; Ball-point pens, fountain pens; Pen cases; Calendars; Rubbers; Diaries; Writing or drawing books; Paint brushes; Pencils; Greeting cards; Coasters; Mouse pads (stationery); Paper handkerchiefs; Paper table covers; Paper; Cardboard and goods made from this material, not included in other classes; Stationery; Rulers (stationery).

Class 18: Bags; Multipurpose sports bags; Handbags; Bags of leather and imitations of leather; Small bags; Canvas bags; Bags for balls; Bags; Bags for campers; Bags; Travelling rugs; Key holders; Beach bags; Bum-bags; Cosmetic bags sold empty; School rucksacks; Trunks; Travelling bags; Valises; Rucksacks; Umbrellas; Walking sticks; Parasols; Leatherware; Briefcases; Leather and imitations of leather; Satchels; Business cards cases; Change purses; Not of precious metal; Notecases; Sports bags; Football bags; Wetsuit bags.

Class 25: Sports clothing and leisurewear for men, women and children; Jerseys; Undershirts; T-shirts; Tank-tops; Sweatshirts; Pullovers; Polo-neck jerseys; Shirts; Skirts; Trousers; Shorts; Bermuda shorts; Jackets; Coats; Jeans; Jerseys; Ties; Suits; Combinations (clothing); Full tracksuits for sports teams; Training suits; Sports kits; Including kits for football; Five-a-side football; Volleyball; Rugby and Basketball; Soccer clothing; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running and exercisewear in general not included in other classes; Trousers and Ski suits; Belts (clothing); Belts for sports; Footwear; Shoes; Sports shoes; Football boots and shoes; Five-a-side football; Volleyball; Rugby; Basketball; Tennis; Cycling; Golf; Baseball; Spinning; Running; Gymnastics and

exercise in general not included in other classes; Ski boots; Swimshoes; Slippers; Headwear; Hats; Caps; Bonnets; Ear muffs; Head sweatbands; Hats and berets for sport in general; Bandannas; Gloves (clothing); Mufflers; Wristbands; Stockings; Socks; Sweat-absorbent stockings; Slippers; Panty hose; Underwear; Briefs; Brassieres; Singlets; Underpants; Boxer shorts; G-strings; Biancheria intima; In particular for sport; Namely leg warmers; Bermuda shorts; Elasticated t-shirts; Nightwear; Beach clothes and swimwear; Including bathing suits; Swimming trunks; Bath robes; Rainwear.

Class 28: Bags adapted for carrying sporting articles; Gymnastic apparatus; Training and body building; Gymnastic and sporting articles not included in other classes; Balls for games; Playground balls; Gloves for goalkeepers; Gloves for games; Shin guards (sports articles); Knee guards; Bands for sports; Sports equipment.

Class 35: Wholesaling and retailing of perfumery; Spectacles; Horological articles and jewellery; Stationery; Luggage; Clothing; Sporting articles; Electronic commerce of the aforesaid goods.

Class 41: Organisation of sports competitions; Education; Providing of training; Amusements; Entertainment.

### **EUTM 7008477**

Class 3: Alcohol- and non-alcohol-based perfumes and perfumery, toilet water, perfume extracts, essential oils; facial tissues, toning lotions; moisturising and nutrient creams; lip gloss; hand creams, gels and lotions; moisturising, nutrient and exfoliating preparations for the body; multi-purpose creams, water and oils for the body; deodorants, antiperspirants, depilatory creams, sun creams; hair gels, lotions, foams, gels, water, shampoos and conditioners, hair lacquers, sprays, mousses; body hygiene products, namely solid, liquid and powdered soaps, bath and shower foam; salts, powders and oils, talcum powder and powders for sprinkling; food hygiene products; products for personal hygiene; dental hygiene products, dentifrices, mouthwashes, breath freshening sprays.

Class 9: Spectacles, sunglasses, spectacle cases and frames, blank CD-ROMs and DVDs for audio and/or video recording.

Class 14: Clocks, chronometers, chronographs, alarm clocks, jewellery.

Class 16: Adhesive tapes for stationery purposes, ball-point pens and fountain pens, pen cases for typewriters, calendars, rubber erasers, diaries, note books, paint brushes, pencils, greeting cards, coasters, mouse pads (stationery), handkerchiefs of paper, tablecloths of paper, paper, cardboard and goods made from these materials, not included in other classes, stationery, rulers (stationery).

Class 18: Bags, multipurpose sports bags, handbags, bags of leather and imitations of leather, gentlemen's handbags; canvas bags, bags for balls, bags, bags for campers,

beach bags, travelling bags; key holders; beach bags; bum-bags; cosmetic bags sold empty; school satchels, trunks, travelling bags, suitcases, rucksacks; umbrellas, walking sticks, parasols; Leatherware; briefcases; leather and imitations of leather; satchels; business cards cases; purses, not of precious metal; notecases.

Class 25: Clothing for men, women and children; sportswear and leisurewear for men, women and children, including jumpers, T-shirts, vests, sweatshirts, pullovers, polo shirts, shirts, skirts, trousers, shorts, Bermuda shorts, jackets, coats, jeans, jerseys, neckties, suits, jump suits (clothing), full tracksuits for sports teams, training suits, sports kits, including kits for football, five-a-side football, volleyball, rugby and basketball, clothing for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running and exercisewear in general not included in other classes; belts (clothing), belts for sports; footwear, shoes, sports shoes, including shoes for football, five-a-side football, volleyball, rugby, basketball, tennis, skiing, cycling, golf, baseball, spinning, running, gymnastics and exercise in general not included in other classes, ski boots, swimshoes, slippers; headgear, including hats, berets, bonnets, ear muffs, headbands and sweat bands, hats and berets for sport in general, bandanas; gloves (clothing), scarves, wristbands; stockings, socks, sweat-absorbent stockings, slippers, tights; underwear, including briefs, bras, camisoles, underpants, boxers, thongs, underwear, in particular for playing sport, namely leg warmers, Bermuda shorts, elasticated T-shirts, nightwear; beachwear and swimwear, including swimming costumes, swimming trunks, beach robes; rainwear.

Class 28: Bags adapted for carrying sporting articles, bags for sports, football bags, wetsuit bags, apparatus for gymnastics, training and body building, gymnastic and sporting articles not included in other classes; balls for games, play balloons, gloves for goalkeepers and sport in general, gloves (accessories for games), shin guards (sports articles), knee-pads, bands for sports, sports equipment.

Class 35: Wholesaling and retailing of perfumery, spectacles, horological instruments and jewellery, stationery, luggage, clothing, sporting articles; electronic commerce of the aforesaid goods.

Class 41: Organisation of sports competitions; education, providing of training; amusements; sporting and cultural activities.