

**O-515-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3366278  
BY BAFFOUR OWUSU AMANKWATIA  
TO REGISTER AS A TRADE MARK:**



**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 416382  
BY ORIGINAL BUFF, S.A.**

## **Background and pleadings**

1. On 11 January 2019, Baffour Owusu Amankwatia applied to register, under number 3366278, the trade mark shown below.



The application was published on 1 February 2019 in respect of “clothes” in class 25.

2. The application is opposed by Original BUFF S.A. (“the opponent”). The opposition is based upon ss. 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). It is, under each of these grounds, directed against all of the goods in the application.

3. Under both ss. 5(2)(b) and 5(3), the opponent relies upon the following trade marks:

i) International registration (UK) number 1370544 **BUFF** (“IR 544”)

Date of registration/designation: 11 August 2017; date of protection in the UK: 4 October 2018.

Goods relied upon:

Class 25: Ready-made clothing for external and internal use; handkerchiefs (not included in other classes); caps; footwear (except orthopedic footwear) and headgear.

- ii) European Union trade mark (“EUTM”) number 17137019 (“EU019”)



Filing date: 22 August 2017; date of registration 21 April 2018

Goods relied upon:

Class 25: Clothing, footwear, headgear; visors.

- iii) EUTM 9201856 **BUFF** (“EU856”)

Filing date: 25 June 2010; date of registration: 3 January 2011

Goods relied upon:

Class 25: Ready-made clothing, including underwear and outerwear; headscarves (not included in other classes), caps, footwear (except orthopaedic footwear) and headgear.

- iv) EUTM 10496321 (“EU321”)



Filing date: 15 December 2011; registration date 14 May 2012

Goods relied upon:

Class 25: Ready-made clothing, including underwear and outerwear; Headscarves (not included in other classes), caps, footwear (except orthopaedic footwear) and headgear.

v) EUTM10496404 (“EU404”)



Filing date 15 December 2011; registration date 14 May 2012

Goods relied upon:

Class 25: Ready-made clothing, including underwear and outerwear; Headscarves (not included in other classes), caps, footwear (except orthopaedic footwear) and headgear.

4. The opponent claims under s. 5(2)(b) that the contested mark is highly similar to the opponent's marks and that the goods at issue are identical or highly similar. It says that there is a likelihood of confusion, including the likelihood of association.

5. Under s. 5(3), the opponent claims that its mark has a reputation in the UK such that use of the contested mark would cause the relevant public to believe that there is an economic connection between the applicant and the opponent, where no such connection exists. It claims that the opponent is a market leader in its field and that use of the contested mark would constitute free-riding on the reputation of the earlier mark. The opponent further claims that there would be detriment to the reputation of the earlier mark if the goods provided under the contested mark were of inferior quality, which could result in the tarnishing of the opponent's reputation or loss of sales. The opponent also claims that the use of the contested mark would lead to a dilution of the earlier mark's distinctive character, particularly if the applicant's goods were of low quality, and consequent loss of sales.

6. Under s. 5(4)(a), the opponent says that it has used the following signs since 1996 in respect of the goods listed below and that it has a protectable goodwill associated with these signs:

i) **BUFF**

Goods relied upon: Ready-made clothing, including underwear and outerwear; headscarves (not included in other classes), caps, footwear (except orthopaedic footwear) and headgear.<sup>1</sup>



ii)

Goods relied upon: Clothing; headgear; visors.



iii)

Goods relied upon: Ready-made clothing, including underwear and outerwear; headscarves (not included in other classes), caps, footwear (except orthopaedic footwear) and headgear.



iv)

Goods relied upon: Ready-made clothing, including underwear and outerwear; headscarves (not included in other classes), caps, footwear (except orthopaedic footwear) and headgear

7. Mr Amankwatia filed a counterstatement denying the grounds of opposition. In particular, he highlights that whilst “buff” can mean shine, or be a colour, “buff” in the phrase “buff body” will mean attractive or well-toned.

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<sup>1</sup> The notice of opposition includes two claims based upon this sign (at pp. 12-13 and 35-36) but they are identical.

8. Given their dates of filing, the opponent's trade marks qualify as earlier marks in accordance with s. 6 of the Act. Although EU856, EU321 and EU404 had completed the registration process more than 5 years before the application date of the application in suit, and are, in theory, subject to the proof of use provisions contained in s. 6A of the Act, Mr Amankwatia indicated in his counterstatement that he did not require evidence of use. That being the case, the opponent may rely upon all of the goods it has identified, without demonstrating that it has used the marks. The proof of use provisions do not apply to IR544 or EU019, these marks not having been registered for five years at the date of application for the contested mark.

9. The opponent is represented by ip21 Ltd. Mr Amankwatia is a litigant in person. Both parties filed evidence. The opponent also filed written submissions during the evidence rounds, which I will bear in mind and refer to as appropriate below. Neither party requested a hearing. This decision is taken following a careful reading of all of the papers.

### **Case management**

10. A case management conference was held on 7 November 2019 regarding the opponent's evidence. Permission to exceed the 300-page guidelines was refused for the reasons given in my letter of that date. In order to assist the opponent, I also indicated that I would rule that use of the figurative marks was use of the word marks. That is because s. 6A(4)(a) provides that use of a form differing in elements which do not alter the distinctive character of the trade mark is permitted. In *Nirvana Trade Mark*, BL O/262/06, Richard Arnold Q.C. (as he then was) identified the relevant questions as "(a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)". In *hyphen GmbH v EU IPO*, Case T-146/15, the General Court ("GC") made it clear that an assessment of the relative distinctiveness of the trade mark and the additional components is required. As the word "BUFF" is a registered trade mark, by virtue of which it must be accorded a minimum

degree of inherent distinctiveness,<sup>2</sup> my view was that the slight stylisation of the letters, the circular border and, where applicable, the use of colour, were banal alterations which did not affect the distinctive character of the word “BUFF”.

## **Evidence**

### **Opponent’s evidence**

11. Two witness statements are provided. The first is the witness statement of Jacqueline Tolson, a Trade Mark Attorney at the opponent’s professional representatives. Ms Tolson’s statement is essentially a vehicle for the introduction of the witness statement of Harald Kouwijzer and accompanying exhibits. Ms Tolson does, however, give evidence that the content of Mr Kouwijzer’s statement remains valid.

12. Mr Kouwijzer’s statement was filed to support a claim of enhanced distinctiveness in another trade mark application (the mark itself is identical to EU321) and is dated 10 July 2018. Mr Kouwijzer is the Director of Finance and Administration for the opponent, a position which he has held for 7 years.

13. Mr Kouwijzer explains that the opponent started in 1991 and that although the original product was a tubular scarf, which remains the company’s most popular product, the “Buff” brand evolved to include a range of headgear and clothing. It is said that the company sells “BUFF”-branded goods in over 90 countries and that there are main subsidiaries in Germany, the US, Canada and the UK.<sup>3</sup> It is Mr Kouwijzer’s evidence that the opponent’s goods are sold through online retailers such as Amazon and through high street stores such as Cotswold Outdoor, Go Outdoors and Regatta trading as Hawkshead.<sup>4</sup>

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<sup>2</sup> *Formula One Licensing BV v OHIM*, Case C-196/11P

<sup>3</sup> §§2-3.

<sup>4</sup> Kouwijzer, §13.

14. UK wholesale turnover figures from 1999 are provided for “BUFF”-branded goods.<sup>5</sup> Turnover for the period 1999 to 2005 was between €350,000 and €1.1 million. Since 2006 it has been in excess of €1.39 million and, for the 6 years to 2018, around €2 million. There is no breakdown according to the goods.

15. Twelve invoices are provided, dated between October 2012 and October 2017, for values between €25,490 and €133,051.<sup>6</sup> They are all to the opponent’s UK subsidiary and show EU321; “BUFF®” is present in the item descriptions. Neckwear and various types of headwear dominate and from 2016 are the only goods specified. There are no recorded sales of other clothing after 2013.

16. Undated photographs of the opponent’s goods and packaging are in evidence.<sup>7</sup> All of the opponent’s registered trade marks are visible on product packaging, labels and on garments, to varying degrees. “BUFF” also appears on barcodes alongside the registered trade mark symbol (®) and it is specified that the mark is a registered trade mark.<sup>8</sup> Neck warmers, gloves and various types of headwear, including hats, caps, balaclavas and headbands, are shown. There is also evidence of a hood, visor, hoodie, t-shirt, unspecified tops (only the neck band is visible), socks, either trousers or shorts (again, the whole garment is not visible) and a waterproof jacket. EU019 is visible on coat hangers. Some of the caps and neck warmers specify “kids”, “junior” or “adult”. Many of the products are billed as “multifunctional headwear” or their packaging indicates that they may be used as neck warmers, hats or headbands. Some of the goods are licensed goods bearing trade marks of other entities, such as Disney, the Tour de France and Hello Kitty.

17. Prints from the opponent’s [www.buff.com](http://www.buff.com) and [www.buff.eu](http://www.buff.eu) websites are exhibited, which show EU321 used in relation to neck warmers, various types of headwear, a jacket, a cycling jersey, tank top, gloves and shorts.<sup>9</sup> There is also use of “BUFF”, which is

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<sup>5</sup> §5.

<sup>6</sup> HK6.

<sup>7</sup> Exhibits HK1, HK3, HK4.

<sup>8</sup> Pp. 22-24, 26-28, 33, 34.

<sup>9</sup> HK2.



accompanied by the registered trade mark symbol, in relation to caps, neck warmers, a jacket, cycling jersey, tank top, shorts and gloves. Not all of the evidence is clear but “BUFF” is also in the title of a collection of goods which appears to include hooded jackets, trousers and gilets.<sup>10</sup> EU019, EU321 and EU404 are shown applied to a hat, balaclava and tops. Less clear are prints showing long- and short-sleeved tops, shorts, cycling tights, hats, gloves, socks and what appear to be leg warmers: EU019, EU321 and EU404 appear to be applied to some of these goods.<sup>11</sup> A date of 7 September 2018 is visible on only two of the prints (which show gloves).<sup>12</sup> The rest are not dated, though Mr Kouwijzer’s statement is that the websites “are available” to UK customers (presumably at the date of his statement).

18. Advertising spend in the UK has been at least €120,000 since 2012 and was at least €225,000 between 2014 and 2016. €105,000 was spent to August 2017.<sup>13</sup>

19. Reports of media coverage of the opponents’ products from August 2016 to January 2018 are provided.<sup>14</sup> Many of the magazines are sports or outdoor magazines but there are also examples of national publications with wider audiences, such as *Hello!* online, the *Telegraph* and the *Independent*. Although the reproductions are poor and much of the exhibit is illegible, it is possible to discern references to “Buff”/“BUFF” or “BUFF®”. The opponent’s figurative marks are also present, to a lesser extent, including on goods. The goods commented on are headwear (hats, caps, headbands, head liners, visors) and neckwear. The opponent and its goods are described as “that brilliant and ubiquitous neck/head tube that can famously be worn 13 different ways”, “headwear wizards Buff have launched a brand-new winterised version of their famed head/neck tube-scarf thing”, “a fantastic sports head and neckwear brand”, and “the original, multifunctional head wear brand”. It is also said to be “renowned globally for protecting fitness enthusiasts and sports professionals against the elements”, though the identical piece appears several times in

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<sup>10</sup> HK2, p. 70.

<sup>11</sup> HK2, pp. 71-72.

<sup>12</sup> HK2, pp. 76-77.

<sup>13</sup> Kouwijzer, §14.

<sup>14</sup> HK8.

different magazines and gives the impression of publicity material rather than independent assessment.<sup>15</sup>

20. Copies of newsletters, including electronic versions, produced by the opponent and distributed to existing and potential UK trade and retail customers, are exhibited.<sup>16</sup> They are dated between September 2016 and November 2017. The opponent's figurative marks are visible, though EU321 and EU404 are more prevalent, as is "BUFF®". The goods all appear to be headwear (including headbands, visors and hats) and neckwear, for both adults and children. Distribution numbers are between 24 and 1,213 (trade) and 16,795 and 55,165 (consumer).

21. There is also evidence that the opponent has sponsored various sporting events.<sup>17</sup> It sponsored the 2014 and 2017 Mountain Bike World Cup at Fort William (the 2014 event included the "BUFF 4X Pro Tour" and is said to have been watched by 20,000 viewers) and a series of trail running events in the Yorkshire Dales and Peak District called the "BUFF® X SERIES"; it is not clear whether the opponent also sponsored a sister event in Snowdonia. In addition, the opponent appears to have sponsored the Banff 2017 Mountain Film Festival World Tour (UK & Ireland) and was the Official Headwear Partner of a women's 10k running race series in Birmingham in 2016. Mr Kouwijzer also gives evidence that the opponent sponsored athletes (trail/mountain/endurance runners, mountain/BMX bikers, motorcyclists, skiers and climbers) at various times between 2013 and 2017.<sup>18</sup> It appears that in 2016 the "BUFF® Stott Team MTB" was created, though there is no information about their activities.

22. There is also evidence that the opponent exhibited at the Core Bike Show 2017 (Northampton), Slide Trade Show January 2017 (Telford), the Outdoor Trade Show July 2017 (Warwickshire) and Motor Cycle Live November 2017 (Birmingham NEC).<sup>19</sup> Mr

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<sup>15</sup> Pp. 134, 155, 173, 186, 193, 199.

<sup>16</sup> HK9.

<sup>17</sup> HK9, Kouwijzer, §17 and HK10.

<sup>18</sup> Kouwijzer, §19.

<sup>19</sup> HK9, Kouwijzer, §18 and HK11.

Kouwijzer indicates that the opponent exhibits at international sports business trade fairs, including the ISPO Munich and OUTDOOR in Friedrichshafen, Germany.<sup>20</sup> The 2017 Munich event is said to have attracted 85,000 visitors. There is also evidence that the opponent has collaborated with third parties in the UK, including in support of the British Legion and Cancer Research UK, for neck warmers which are available for purchase in sterling.<sup>21</sup> EU321 is present on the packaging, as is “BUFF®”. The collaborations with Cancer Research UK and with a UK artist are dated 2016.

### **Applicant’s evidence**

23. Mr Amankwatia filed a witness statement in his own name. In it he makes various points about his plans to trade under the mark, the opponent’s business and other trade mark registrations. I will bear the submissions contained in his statement in mind but there is no need for me to record the contents in any greater detail here.

### **Preliminary point**

24. In his counterstatement and evidence, Mr Amankwatia submits that his brand is focused mainly on activewear and that the target market is female customers. He also points to the existence of other trade mark registrations including the word “BUFF”, partly in an attempt to cast doubt on the likely impact that registration of the contested mark might have on the opponent’s business.

25. Neither of these points is of assistance. Trade mark registrations are claims to legal property (the trade mark). Registered trade marks are entitled to protection against the use, or registration, of the same or similar trade marks for the same or similar goods if there is a likelihood of confusion. Once a trade mark has been registered for five years, a trade mark owner can be required to demonstrate that the mark has been used. However, as Mr Amankwatia chose not to request evidence of use, this case must be

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<sup>20</sup> Kouwijzer, §27.

<sup>21</sup> HK5. See also HK9 and Kouwijzer, §17.

assessed on the basis of the “notional” use of the earlier marks for all of the goods upon which the opponent relies, that is to say the notional use of the earlier marks across the width of the specifications relied upon.<sup>22</sup> Further, Mr Amankwatia’s plans to use the contested mark on particular goods are of no relevance because it is necessary to consider all of the circumstances in which the mark applied for might be used if it were registered.<sup>23</sup> That means that the assessment must take into account only the mark applied for (and its specification) and any potential conflict with the earlier trade marks. Any differences between the goods provided by the parties are irrelevant unless those differences are apparent from the contested and registered marks.

26. Mr Amankwatia also seeks to rely on the existence of other similar marks on the UK and Community trade mark registers. However, in the absence of evidence that such marks are in use this sort of evidence has always been given short shrift. This is because without evidence that the marks are in use on a scale that might have led to confusion, it cannot be shown that the public is used to distinguishing between them without confusion. There is ample authority to this effect (see, for example, *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281). It is therefore well established that the mere existence of similar marks on trade mark registers neither increases nor decreases the likelihood of confusion between one such mark and another trade mark under different ownership. I would also add that none of the marks highlighted by Mr Amankwatia is registered in class 25, the class with which the present dispute is concerned. This ‘state of the register’ evidence is therefore of no weight.

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

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

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

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<sup>22</sup> See *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22] and *Roger Maier v ASOS* [2015] EWCA Civ 220 at [78] and [84].

<sup>23</sup> *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 (CJEU).

[...]

(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”.

28. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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.

29. I will focus on IR544 first, as the trade mark, not being stylised, is the most similar of the opponent's marks to the mark applied for. Although the specification might appear

more specific than that of EU019, it is not clear to me how “clothing for internal and external use” is materially different from clothing at large. Additionally, “visors” are a type of headgear and orthopaedic footwear is not proper to class 25 in any event (so is not covered by “footwear” at large in that class). Accordingly, despite the different wording, EU019 does not appear to offer any advantage relating to the goods covered in its specification.

### **Comparison of goods**

30. The specification of the mark applied for is “clothes”. IR544 is registered for “Ready-made clothing for external and internal use” and “headgear”.

31. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, EU:T:2006:247, 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”.

32. As I indicated above, although the terms are expressed differently, it is difficult to envisage how “ready-made clothing for external and internal use” is materially different from “clothes”, which includes clothing for use indoors or outdoors. It is not clear to me what other categories of clothing there might be which are not covered by the earlier specification’s term. On that basis, I would find that these goods are identical. However, even if there are other categories, “clothes” covers all types of clothing and the goods are identical on the principle outlined in *Meric*.

33. I should also give my views on the similarity between “clothes” and “headgear”. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

34. 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.

35. A further factor which must be taken into account is whether there is a complementary relationship between the respective goods. It was explained by the CJEU in *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, 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, EU:T:2009:428, 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”.

36. There is a difference in nature between clothing and headgear but they share a purpose insofar as both are intended to cover and/or protect (from the elements) parts of the body. They are likely to be sold in the same retail premises, though they may be in separate areas (headgear being with other accessories rather than in the same aisles as clothes). The users will be the same but as they are not alternatives to one another there is no competition between the goods. There may, however, be a complementary relationship, as defined in the case law, because the goods may be sold as part of a coordinated look and because the closeness of their respective uses is such that the average consumer is likely to believe that they are the responsibility of the same undertaking. These goods are similar to a high degree.

37. As to the comparison between the contested goods and the earlier “footwear”, whilst they may overlap in purpose and users, be complementary and their channels of trade may coincide, there is no competition and the nature of the goods is different. These goods are similar to a fairly high degree.

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

38. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. 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 goods in question: *Lloyd Schuhfabrik*.

39. The average consumer of the goods at issue is a member of the general public. The opponent submits that "little or moderate time" will be spent by the average consumer on the purchase. Mr Amankwatia has made no submissions on this point.

40. The goods are neither infrequent nor daily purchases. The average consumer will wish to ensure that they are, for example, the desired fit, colour or style. Consequently, a medium degree of attention will be paid to their selection. The goods at issue are generally sold through bricks and mortar retail premises (such as shops on the high street or in supermarkets) and online and will normally be chosen via self-selection from a shelf or a website, or perhaps from a catalogue. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

"50. [...] Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion".

Consequently, whilst I do not rule out that there may be an aural component, when considered overall, the selection process will be mainly visual.

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

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

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

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

42. The word “buff” has a number of meanings, as pointed out by Mr Amankwatia. It may be a colour, mean an expert (for example, a film buff) or be a verb meaning to polish. It

may also mean that a person is attractive or muscular. There is no evidence on the extent to which the latter meaning would be known to the UK consumer. *Collins English Dictionary* indicates that as an adjective meaning “fit” or “attractive” it is an informal word.<sup>24</sup> The *Oxford English Dictionary* shows that it is a slang word (meaning “muscular”, “well-toned” or “attractive”) which originated in the US.<sup>25</sup> It seems to me that its inclusion in two major dictionaries signals that it is in current if not frequent use and will be understood as meaning, broadly, attractive, by the average consumer. I would add that this confirms rather than contradicts my original impression, based upon my own experience as an average consumer, which I do not consider atypical. In the context of goods worn on the person, the word may, therefore, be taken to be a statement about the wearer rather than indicating trade origin, or descriptive of a characteristic of the goods (i.e. their colour, or their ability to enhance the appearance of muscles, e.g. by being close-fitting). That is reflected in the registration through acquired distinctiveness of the earlier mark. It is possessed of no inherent distinctiveness. However, as the mark is registered, the case law is clear that there cannot be a finding that the mark is non-distinctive: *Formula One*. I will proceed on the basis that “BUFF” is distinctive to the minimum required for registration.

43. The opponent has provided evidence to support its claim to enhanced distinctiveness. The evidence shows that the opponent has enjoyed not insignificant sales in the UK since 1999, broadly rising over time. However, these figures are not broken down and, even taken at their highest, are unlikely to represent a significant share of the UK clothing market, which is likely to run to billions each year. Even if the market in headgear were taken separately, the sales figures are still likely to be relatively small in proportion to the market as a whole. The only evidence which is dated and which shows clothing items on sale are 2018 prints showing gloves. That does not necessarily mean that the opponent’s claim must be dismissed, if there is enough evidence elsewhere to show that there has been sufficient use in relation to the goods relied upon. What is fatal, at least regarding

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<sup>24</sup> <https://www.collinsdictionary.com/dictionary/english/buff> [accessed 2 October 2020]

<sup>25</sup> <https://www.oed.com/view/Entry/257652?rskey=UloYUw&result=7&isAdvanced=false#eid> [accessed 2 October 2020]

the claim to enhanced distinctiveness for clothing at large, is that there is no breakdown whatsoever of the turnover figures by goods and there are no invoices which show sales of clothing (other than neckwear, to which I will return shortly) after 2013. I acknowledge that there is some evidence regarding socks, which are arguably clothing rather than footwear, but there is no additional material, such as sales figures, and no invoice evidence after 2013. Without any clear evidence that any clothing sales were made after 2013, and no evidence at all of the level of any such sales if they were in fact made, the evidence does not establish that the mark enjoyed any enhanced distinctiveness for clothing at large at the relevant date. There is no evidence concerning any footwear items other than socks. There is no evidence at all of any sales of handkerchiefs. There is no enhancement of the mark's distinctiveness in relation to these goods.


44. The evidence as a whole, including the invoices, strongly suggests that the opponent's principal business is headgear and neckwear. Mr Kouwijzer's evidence is that the opponent's tubular scarf remains (as at the date of his statement in 2018) the company's most popular product. Given the lack of evidence of sales of other goods after 2013, I infer that the bulk, if not all, of the turnover after 2013 actually relates to headgear and neckwear. The use of "BUFF" has been on labels (both swing tags and labels fixed inside garments) and in item descriptions. Advertising spend has been reasonable and there is some evidence of the trade mark in nationwide publications, including occasional references to the renown of the company, though I treat the evidence showing the same piece repeatedly with circumspection, as it has the air of a press release created by the opponent rather than a third party's assessment of the opponent's fame. There is also consistent use of the registered trade mark symbol, which will have assisted in indicating to the consumer that the word is being used as a trade mark, and some evidence of event sponsorship. Despite the absence of evidence of the size of the market, the evidence is sufficient to establish a modest degree of enhanced distinctive character for headgear and neckwear. However, given the low starting point, this results in the earlier mark being factually distinctive only to a fairly low degree for headgear and neckwear.

### **Comparison of trade marks**

45. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* 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”.

46. It would be wrong, therefore, to dissect the trade marks artificially, 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 mark
BUFF	

47. The opponent submits that the word “BODY” is non-distinctive and that the marks are visually and aurally similar to a medium to high degree. It submits that there is a high degree of conceptual similarity. Mr Amankwatia submits that neither the “logos” nor the meanings of the marks are similar.

48. The earlier mark consists of the word “BUFF”. The overall impression is contained in that word.

49. The contested mark has a number of elements. At the top of the mark is a device which consists of a female silhouette in a handstand position on a circular orange background. The orange of the circle is darker at the centre and fades towards the edge; there is a graduated black line around the top right half of the circle. The device is rather unusual and occupies just over half of the upper part of the mark. Beneath the device are the letters “BB”, in black. They are in capitals and a stylised typeface, though the letters remain clearly recognisable. They are about half the size of the device. Both the device and the letters “BB” are distinctive in their own right. At the base of the mark and much smaller in size are the words “BUFF BODY”, which are in grey and what appears to be the same stylised typeface as the initials. As the words “BUFF BODY” form a recognisable phrase, they are likely to be perceived as a unit. However, as the word “BODY” is non-distinctive in relation to clothing, the balance of distinctiveness is in favour of “BUFF”. The device, the letters “BB” and the words “BUFF BODY” all make a contribution to the mark. Given the size and position of the device and the letters “BB”, these elements are more dominant, making a roughly equal contribution to the mark. The position and size of the words “BUFF BODY” make them less obviously striking, though I bear in mind the general tendency of words to make a stronger impression on the consumer than devices and the fact that “BUFF BODY” provides a meaning for the letters “BB”. In my view, the words “BUFF BODY” make a contribution but to a lesser extent than the first two elements. The stylised font has only a weak role.

50. There are a number of elements which provide points of visual difference between the marks, namely the device, the letters “BB” and the word “BODY”. The stylised

typeface of the contested mark does not assist the applicant as the earlier mark could be used in the same font. The only point of visual similarity is the word “BUFF”, which is the sole component of the earlier mark, but it is in a subordinate position in the contested mark. Taking into account all of the competing factors, my view is that there is a low degree of visual similarity overall.

51. The device in the contested mark will not be verbalised. It is possible that the contested mark will be articulated as either “BB BUFF BODY”, as “BB” or as “BUFF BODY”. I regard the former as the most likely, given the prominence of the letters “BB” and the additional meaning offered by the words. In this situation, the marks share the word “BUFF” but there are differences because of the letters “BB” and the word “BODY”. There is a fairly low degree of aural similarity. Where the letters “BB” are pronounced alone, the comparison is “BUFF” against “BEE-BEE”. I do not think that there is material similarity in this situation. Where the contested mark is articulated as “BUFF BODY”, the first word is shared with the only word of the earlier mark but there is a difference because of the additional word “BODY”. This results in a medium degree of aural similarity.

52. As I have already indicated, the word “BUFF” may have a number of meanings. In the context of the goods at issue, the average consumer is likely to think of it as meaning “attractive” or “muscular”, though I accept that some will perceive other meanings of the word (the colour, shine) when it is used alone. As regards the words “BUFF BODY” in the contested mark, the average consumer is likely to perceive this phrase as meaning an attractive or toned body. The device and the letters “BB” do not have an independent concept; they are if anything likely to be read in association with the words “BUFF BODY”. I have considered whether it is likely that the average consumer, or a sufficiently large proportion of average consumers will perceive “BUFF” as an independent distinctive element in the contested mark. On balance, I do not think it is probable: the words “BUFF BODY” have a recognisable meaning and, absent any other indication that the words should be perceived independently (such as a colon after “BUFF”), the consumer is unlikely to split the phrase in that way. With all of that in mind, the marks have a medium degree of conceptual similarity.



## Likelihood of confusion

53. 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]). Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion involves the consumer recognising that the marks are different but nevertheless concluding that the later mark is another brand of the earlier mark owner. The difference between these two types of confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Iain Purvis Q.C. explained that:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

54. 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 another mark to mind. This is mere association not indirect confusion.

55. I earlier found that the respective specifications include identical clothing goods, that headgear is similar to a high degree to the contested “clothes” and that footwear is similar to “clothes” to a fairly high degree. The earlier mark benefits from some enhanced distinctiveness for headgear and neckwear (the latter being a subset of clothing), in relation to which it is factually distinctive to a fairly low degree. I found varying levels of aural similarity but will proceed on the basis that the marks are aurally similar to a medium degree. Bearing in mind the mainly visual purchasing process, which will be undertaken with a medium degree of care, I am satisfied that the visual differences between the marks

will not result in the consumer mistaking one mark for the other, even for identical goods where there is an enhanced distinctive character. There is no likelihood of direct confusion.

56. Turning to indirect confusion, when considering an earlier mark of low distinctive character, in *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

57. Further, in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an

element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors”.

58. I will take the position regarding the opposition based on clothing and footwear first. The goods at issue are identical or similar to high degree. That is a factor clearly in the opponent’s favour. The marks are conceptually similar to a medium degree; again I

proceed on the basis of a medium degree of aural similarity. The low degree of visual similarity between the marks points against confusion, particularly as visual selection is likely to dominate. Whilst care must be taken not to reduce the question to one of distinctiveness alone, per *L'Oréal*, the distinctiveness of the common element is a factor which must be borne in mind and, where the common element is of low distinctiveness, that points away from confusion.<sup>26</sup> The earlier mark is factually distinctive to a fairly low degree. Despite the similarity between the conceptual messages, the words "BUFF BODY" do have a distinct meaning and the word "BUFF" has only limited distinctiveness. Further, "BUFF BODY" has less relative weight in the overall impression of the contested mark than either the device or the letters "BB", both of which are more distinctive than either "BUFF BODY" or "BUFF" alone. Taking all of this into account, my conclusion is that there is no likelihood of indirect confusion. In the context of the contested mark as a whole, where it plays a subordinate role to other, more distinctive elements, the fact that there is a reference to attractiveness or muscularity in the contested mark, as in the earlier mark, will not lead to confusion on the part of the consumer who is paying a medium degree of attention. My view is that any similarity will be attributed to coincidence rather than economic connection, due to the suggestive connotations of the word "BUFF" in relation to the goods at issue. It follows that the opposition based on this ground also fails insofar as it is based on footwear: the goods are less similar and the earlier mark has an even lower level of distinctive character.

59. I should make it clear that, despite my finding above that "BUFF" is unlikely to be perceived as an independent distinctive element, I have considered whether a significant proportion of the public who have been exposed to the opponent's trade mark may view "BUFF" in the contested mark as such and may, therefore, be more likely to perceive an economic connection. However, given the clear meaning of "BUFF BODY" and the, at best, allusive nature of "BUFF", I do not think it likely that even this subset of consumers would perceive "BUFF" to be an independent distinctive element in the mark as whole or that they would perceive the contested mark as a different mark used by the same undertaking.

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<sup>26</sup> *Whyte and Mackay* at [44].

60. The opponent's other marks are less similar visually than the mark upon which I have reached my conclusions. Any increased distinctiveness would be attributable to the stylisation, which is not present in the contested mark. It follows that the same conclusions on confusion must apply. The opposition under s. 5(2)(b) is dismissed.

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

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

62. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07, EU:C:2008:655 *Intel*, [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Salomon*, [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L’Oreal v Bellure* [2009] ETMR 55; and Case C-323/09, EU:C:2011:604, *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

63. 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".

64. For the reasons given at paragraphs 42 to 44, above, I am satisfied that the earlier mark was known by a significant part of the public and that it had, at the date of application, a reputation for headgear and neckwear but not for clothing at large, handkerchiefs or footwear. The strength of the reputation, for the same reasons as expressed above, was modest.

## **Link**

65. As I noted above, 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:

### The degree of similarity between the conflicting marks

66. My findings at paragraphs 48 to 52 are equally applicable here and I adopt them accordingly.

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

67 I have compared the respective goods at paragraphs 32 and 36, above. Those findings are equally applicable here. The average consumer of the relevant goods will, as I found above, be a member of the public paying a medium degree of attention and for whom the selection will be mainly but not exclusively visual.

The strength of the earlier mark's reputation

68. The earlier mark has a modest reputation for headgear and neckwear.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

69. The earlier mark has a fairly low degree of factual distinctiveness for headgear and neckwear.

Whether there is a likelihood of confusion

70. Given the limited distinctiveness of the earlier mark and the subordinate role of the phrase "BUFF BODY", and with it the word "BUFF, in the contested mark as a whole, I see no likelihood of confusion on the part of the relevant public.

71. Despite a lower level of similarity being required to establish a link than is the case for confusion, I find that the relevant public will not make a link between the marks. Although the goods are identical or highly similar, the suggestive nature of the earlier mark and its modest reputation are not sufficient to establish that there will be a link when considered against the differences between the marks, in particular the visual differences and the specific meaning of the phrase "BUFF BODY". The opposition under s. 5(3) is dismissed.

**5(4)(a)**

72. Section 5(4)(a) states:

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

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

(b) [.....]

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

73. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a Deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)”.

74. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

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

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

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

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

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

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

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

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

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

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

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

75. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander Q.C., sitting as the Appointed Person, considered the matter of the relevant date in a passing off case. He said:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”.

76. There is no claim and no evidence that the contested mark was in use prior to the date of application. That being the case, the relevant date is 11 January 2019.

77. Mr Amankwatia accepted in his evidence that the opponent has goodwill dating back 30 years, though he did not specify whether this included all of the goods for which goodwill is claimed. I will proceed on the basis that the opponent’s claims to goodwill are accepted. Again, I will focus on the word sign “BUFF”, as that is the most visually similar of the signs to the contested mark.

78. I recognise that the test for misrepresentation is different from that for the likelihood of confusion. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. I believe that this is the case here. Even accepting that the opponent has a goodwill identified by the word “BUFF”, my view is that members

of the public are unlikely to be misled into purchasing the applicant's goods in the belief that they are the goods of the opponent. For the reasons given above, there is a low degree of visual similarity between the mark and the sign which, coupled with the allusiveness of the word "BUFF", the particular meaning of the words "BUFF BODY" and their lower relative weight in the overall impression of the contested mark lead me to conclude that there will be no misrepresentation. I extend these findings to the figurative signs, which are less similar and where any additional distinctiveness is attributable to the stylisation which has no counterpart in the contested sign. The opposition based upon s. 5(4)(a) fails.

### **Conclusion**

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

### **Costs**

80. Mr Amankwatia has been successful and would ordinarily be entitled to an award of costs. However, the tribunal wrote to him on 20 March 2020 indicating that, as an unrepresented litigant, he would be required to complete a costs pro-forma if an award of costs was sought. The letter stated that if the pro forma was not completed and returned, "costs, other than official fees arising from the action [...] may not be awarded". No costs pro-forma has been filed. The applicant incurred no official fees. That being the case, I make no award of costs.

**Dated this 19th day of October 2020**

**Heather Harrison**

**For the Registrar**

**The Comptroller-General**