

O/0524/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NO. UK00918275233

IN THE NAME OF YONGQIANG DONG

IN CLASSES 12 AND 35

AND

IN THE MATTER OF APPLICATION NO. UK00003656405

ALSO IN THE NAME OF YONGQIANG DONG

IN CLASS 12

BOTH FOR THE TRADE MARK:

TRIFOX

AND IN THE MATTER OF OPPOSITION AND AN APPLICATION FOR
INVALIDATION THERETO

UNDER NOS. 428233 AND 504854

BY FOX FACTORY, INC.

BACKGROUND AND PLEADINGS

1. Yongqiang Dong (“YD”) is the proprietor of trade mark number 918275233 (“the First Contested Mark”). The First Contested Mark was filed on 21 July 2020 and registered on 5 November 2020, for the following goods and services:

Class 12 Bicycles; motorcycle chains; bicycle wheel rims; Wheels for motorcycles; electric vehicles; bicycle frames; Mopeds; pushchairs; luggage carriers for vehicles; bicycle tyres.

Class 35 Advertising; demonstration of goods; Online advertising on a computer network; organization of trade fairs; commercial administration of the licensing of the goods and services of others; import-export agency services; Marketing; provision of an on-line marketplace for buyers and sellers of goods and services; updating and maintenance of data in computer databases; accounting.

2. On 16 June 2021, YD applied to register trade mark number 3656405, in the UK (“the Second Contested Mark”). The application was published for opposition purposes on 13 August 2021, and registration is sought for the following goods:

Class 12 Bicycle frames; Forks [bicycle parts]; Bicycle handlebars; Bicycle wheels; Bicycle seat posts; Bicycle saddles; Bicycles; Bottle cages for bicycles; Handle bar stems [bicycle parts]; Bicycle hubs.

4. On 15 November 2021 and 9 May 2022 respectively, FOX FACTORY, Inc. (“FF”) opposed the Second Contested Mark and applied to invalidate the First Contested Mark. The opposition and invalidation are both based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b), FF relies upon the following trade marks:

FOX

UKTM(A) no. 3682100¹

Filing date 16 August 2021

Priority date 6 May 2020

Relying on all goods, namely:

Class 12 Vehicles; apparatus for locomotion by land, air or water; suspension systems for vehicles, in particular, suspension systems for bicycles and motor vehicles; vehicle parts, in particular, shock absorbers (including for seats, in particular boat seats), suspension, and suspension parts consisting of lift kits comprising of spacers, linkages, cross members, shock absorbers, and mounting brackets; bicycle parts, in particular, shock absorbers, forks, sprockets, seat posts, handlebars, and wheels.

("the First Earlier Mark")



UKTM no. 902237568²

Filing date 30 May 2001; registration date 26 June 2002

Relying on all goods, namely:

Class 12 Vehicle parts, namely shock absorbers.

("the Second Earlier Mark")

¹ This application is filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU. Consequently, the opponent is entitled to rely upon the EU filing date of 6 May 2020.

² On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of FF having EUTMs being protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable trade marks shown here are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.



UKTM no. 908439499

Filing date 21 July 2009; registration date 22 February 2010

Relying on all goods, namely:

Class 12 Vehicle parts, namely, shock absorbers; bicycle parts, namely, shock absorbers.

("the Third Earlier Mark")



UKTM no. 910489466

Filing date 13 December 2011; registration date 25 April 2012

Priority date 30 June 2011

Relying on all goods and services, namely:

Class 12 Suspension systems for vehicles, bicycles and land motor vehicles; Vehicle parts, shock absorbers.

Class 35 Advertising, marketing and promotional services for dealers and distributors of vehicle suspension systems including shock absorbers for vehicles.

("the Fourth Earlier Mark")



UKTM no. 917882581

Filing date 3 April 2018; registration date 4 October 2018

Priority date 2 October 2017

Relying on all goods and services, namely:

- Class 12 Suspension systems for vehicles, suspension systems for bicycles and motor vehicles; Vehicle parts, shock absorbers; bicycle parts, shock absorbers; parts and accessories for all the foregoing.
- Class 18 Gear bags, backpacks.
- Class 25 Clothing, namely, shirts, T-shirts, tank shirts, jerseys, hoodies, hats, caps, head bands, sweat bands, wrist bands, footwear, socks, shorts, pants, jackets, gloves.
- Class 35 Retail store services and computerized online retail store services featuring vehicle parts, bicycle parts, clothing and fashion accessories, bicycle bags, sports bags, decals, and printed materials.

(“the Fifth Earlier Mark”)

5. Under section 5(2)(b), FF claims that there is a likelihood of confusion because the marks are similar, and the goods and services are identical or similar.

6. Under section 5(3), FF claims a reputation for all of the goods and services identified above and claims that use of YD’s mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

7. Under section 5(4)(a), FF relies upon signs identical to those listed above and for identical goods/services. FF claims to have used the signs throughout the UK since June 1999, June 1999, August 2009, September 2003 and April 2018 respectively. FF claims that use of YD’s mark would be contrary to the law of passing off.

8. YD filed counterstatements denying the claims made and putting FF to proof of use of the Second, Third and Fourth Earlier Marks.

9. YD is represented by Trademarkit LLP and FF is represented by Hogan Lovells International LLP.

10. Both parties filed evidence in chief. FF filed evidence in reply. A hearing took place before me on 15 March 2023, by video conference. FF was represented by Alaina Newnes of Counsel, instructed by Hogan Lovells International LLP and YD was represented by Mark Sorenti of Trademarkit LLP.

EVIDENCE

11. FF filed evidence in chief in the form of the witness statement of Wesley E Allinger dated 22 April 2022, which is accompanied by 14 exhibits. Mr Allinger is Executive Vice President for FF.

12. YD filed evidence in chief in the form of their own witness statement dated 24 June 2022, which is accompanied by 3 exhibits.

13. FF filed evidence in reply in the form of the witness statement of Craig Richey dated 11 November 2022, which is accompanied by 5 exhibits. Mr Richey is the Director of Brand & Product Marketing for FF.

14. I have taken the evidence into consideration in reaching my decision and will refer to it below, where necessary.

RELEVANCE OF EU LAW

15. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

16. Sections 5(2)(b), 5(3) and 5(4)(a) have application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

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

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

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 5(2)(b)

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

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

(a)...

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

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

18. The trade marks upon which FF relies qualify as earlier trade marks pursuant to section 6 of the Act. As the First Earlier Mark is not yet registered, it is not subject to proof of use. Similarly, the Fifth Earlier Mark did not complete its registration process until 2018 and, consequently, is not subject to proof of use. However, the Second, Third and Fourth Earlier Marks had been registered for more than 5 years at the application date of the Second Contested Mark and 5 years prior to the application for invalidity in respect of the First Contested Mark, they are all subject to proof of use.

Proof of use

19. I will begin by assessing whether there has been genuine use of the Second, Third and Fourth Earlier Marks. The statutory provisions for the purposes of proof of use in an invalidation are set out above. The statutory provisions for proof of use in relation to an opposition are as follows:

“(1) This section applies where:

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

20. Section 100 of the Act states that:

“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.”

21. As the Second, Third and Fourth Earlier Marks are all comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

22. For the opposition, pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use is the five-year period ending with the date of the application in issue i.e. 17 June 2016 to 16 June 2021. For the invalidation, there are two relevant periods i.e. the five year period ending with the date of the application for the declaration (10 May 2017 to 9 May 2022) and the five year period ending with filing date of the application for the contested mark (22 July 2015 to 21 July 2020). For the parts of the relevant periods that fall prior to 31 December 2020 (inclusive), evidence of use in the EU will be relevant. After that date, only evidence of use in the UK will be relevant.

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

“114. [...] The 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 I-9223, 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].”

24. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

25. I note the following from FF’s evidence:

- a) FF was established in 1977 and since then it has been producing under the FOX brand suspension components for motorcycles, automobiles, all-terrain vehicles, snowmobiles, and mountain bikes.
- b) Mr Allinger has provided the following sales figures (USD) for “goods and services” sold under the earlier marks:

2016	403million
2017	475million
2018	619million
2019	751million
2020	890million
2021	1,299million

As Mr Sorenti submitted at the hearing, no information is provided as to what jurisdiction these figures relate to.

- c) Mr Allinger states: “I confirm that [FF] uses its Fox Earlier Marks in relation to shock absorbers for bicycles and vehicles” and “I confirm that [FF] has made intensive use of the Fox Earlier Marks across the UK and EU for many years, including during the Relevant Period of the present opposition proceedings, namely between 16 June 2016 and 16 June 2021”.
- d) Examples have been provided of FF’s goods for bicycles and vehicles:³

³ Exhibit WEA3



- e) FF's goods are currently distributed in the UK by a business called Silverfish UK Ltd and that business's website shows goods such as forks, seat posts and shock absorbers (and springs for shock absorbers) for bicycles, t-shirts, shorts, jackets, shirts, socks, hats, suspension fluid and mud guards.⁴ Although this document is not dated within the relevant period, Mr Allinger confirms that FF's "product offering was materially similar at the end of the Relevant Period (i.e. 16 June 2021)."
- f) An invoice displaying the Second Earlier Mark (apparently in duplicate) dated 12 July 2018 was issued to Silverfish in the sum of \$394.13.⁵
- g) Invoices have been provided, addressed to UK consumers (including Silverfish) dated 24 June 2021 to 4 May 2022.⁶ The customers are located across the UK, such as Leicestershire, Kilmarnock and Newcastle. They amount to sales of over \$1.2million. However, it is not clear to me from the invoices alone what goods some of the references relate to. Further, these invoices can only assist in relation to use in one of the relevant periods (10 May 2017 to 9 May 2022) as they post-date the other two. Mr Richey gives evidence that sales of FOX branded products through Silverfish during the period 17 June 2021 to 9 May 2022 in the UK amounted to over \$4million.

⁴ Exhibit WEA5

⁵ Exhibit WEA7

⁶ Exhibits CR8 and CR9

- h) FF's goods are also distributed in the UK by a business called Prolinx and that business's website showed goods such as shock absorbers in 2016, 2017 and 2018.⁷ These pages display the First and Second Earlier Marks.
- i) A business called Orange Bikes UK sells FF's bicycle forks as part of completed bicycles, for example:⁸ The First and Second Earlier Marks are visible.



- j) FF promotes its goods on social media and by 13 June 2021 its Facebook page had been liked by over 800,000 people, by 14 June 2021 its Twitter had over 75,000 followers and its Instagram account had over 1.8million followers.⁹ It is, of course, not possible to confirm whether these followers are based in the UK/EU or elsewhere in the world.
- k) Total sales of Fox branded products in the UK and EU between 16 June 2016 and 16 June 2021 were as follows:

⁷ Exhibit WEA8

⁸ Exhibit WEA10

⁹ Exhibit WEA11

Year	UK Sales (USD)	EU Sales (USD)
2016	In excess of 4 million	In excess of 70 million
2017	In excess of 6 million	In excess of 80 million
2018	In excess of 5 million	In excess of 90 million
2019	In excess of 4 million	In excess of 110 million
2020	In excess of 5 million	In excess of 140 million
2021	In excess of 8 million	N/A

l) Mr Richey gives narrative evidence that the total revenue for FOX branded products shipped into the UK during the period 17 June 2021 to 9 May 2022 was over \$3.7million. He also states that the total sales of shock absorbers for power vehicles in the UK during 2021 alone was \$937,761.22.

m) Mr Richey gives evidence that a business called Vital MTB conducts annual surveys of mountain bike customers to assess purchasing intent over the following 12 months.¹⁰ These results show the following:

UK - 2022		UK - 2021		UK - 2020		UK - 2019		UK - 2018	
RockShox	40.7%	RockShox	39.3%	Fox	37.5%	RockShox	33.3%	RockShox	30.9%
Fox	22.9%	Fox	26.4%	RockShox	30.4%	Fox	30.8%	Fox	30.3%
Undecided	15.3%	Undecided	12.1%	Undecided	12.5%	Undecided	13.2%	Undecided	17.7%
Ohlins	4.2%	EXT	5.7%	Ohlins	5.4%	Marzocchi	5.7%	DVO	4.6%
DVO	3.4%	Marzocchi	4.3%	Marzocchi	3.6%	DVO	3.8%	Ohlins	3.4%
Marzocchi	3.4%	Ohlins	2.9%	DVO	2.4%	Ohlins	3.8%	Cane Creek	2.9%
Manitou	2.5%	DVO	2.1%	Manitou	1.8%	DT Swiss	1.9%	Manitou	2.3%
Formula	1.7%	Manitou	2.1%	MRP	1.2%	Formula	1.9%	Marzocchi	2.3%
SR Suntour	1.7%	DT Swiss	1.4%	SR Suntour	1.2%	Cane Creek	1.3%	MRP	2.3%
Cane Creek	0.9%	Formula	1.4%	X-Fusion	1.2%	BOS	0.6%	SR Suntour	1.1%

UK - 2022		UK - 2021		UK - 2020		UK - 2019		UK - 2018	
RockShox	26.3%	RockShox	24.0%	Fox	40.0%	Fox	32.7%	Fox	35.0%
Fox	20.0%	Fox	20.8%	RockShox	18.9%	RockShox	16.4%	Undecided	18.9%
Undecided	11.3%	Undecided	13.5%	Ohlins	11.1%	Undecided	14.4%	RockShox	15.4%
EXT	8.8%	EXT	9.4%	Undecided	10.0%	Ohlins	9.6%	Cane Creek	11.2%
Ohlins	8.8%	Ohlins	8.3%	DVO	6.7%	Cane Creek	8.7%	Ohlins	8.4%
Cane Creek	7.5%	DVO	6.3%	EXT	4.4%	DVO	7.7%	DVO	5.6%
Push Industrie	6.3%	Cane Creek	4.2%	Push Industrie	4.4%	EXT	5.8%	EXT	2.1%
Marzocchi	5.0%	Marzocchi	4.2%	Cane Creek	2.2%	Push Industrie	2.9%	Diverse	0.7%
DVO	2.5%	Push Industrie	4.2%	Manitou	1.1%	DT Swiss	1.0%	MRP	0.7%
Intend	1.3%	Fast	2.1%	MRP	1.1%	Marzocchi	1.0%	Push Industrie	0.7%

¹⁰ Exhibit CR11

These show the percentage of people who intend to buy fork shock absorbers (the top row) and rear shock absorbers (the second row) from these individual brands. Clearly, FF features in the top two brands for the years 2018, 2019 and 2020.

- n) *Mountain Bike Rider* describes one of FF's racing forks as "one of the best race forks out there" in November 2019 and describes another as "one of the longest serving forks on the market" in November 2020.¹¹
- o) A website called "off.road.cc", which lists prices in GBP and, so, is presumably aimed at the UK market describes FF as having a "long history in the world of shocks in both mountain biking and motocross" and states that their first mountain bike suspension fork was launched in 2001.¹²

26. There has clearly been use of the Second Earlier Mark as registered, albeit presented in differing colours. I note that the Third and Fourth Earlier Marks are slight variations in that one includes an additional circular border and the other includes the words RACING SHOX. I consider that it is the word FOX which is the most distinctive element of all three marks and I do not consider that the addition of the foxtail device alters the distinctive character (as it just serves to reinforce the message conveyed by the word itself). I consider that the opponent can rely upon use of the word FOX to demonstrate use of the Second, Third and Fourth Earlier Marks. I also consider that use of the Second Earlier Mark, is use of an acceptable variant of the Third and Fourth Earlier Marks (and vice versa).

27. There are clearly issues with FF's evidence. For example, its sales figures are not broken down by goods. However, taking into account that most of the evidence refers to suspension-related goods for bicycles, I consider it likely that a significant proportion of these figures would relate to those goods. Taking the evidence as a whole into account, I am satisfied that FF has demonstrated genuine use of the Second, Third and Fourth Earlier Marks in relation to shock absorbers and forks for bicycles.

¹¹ Exhibit WEA12

¹² Exhibit WEA12

28. I must now consider whether, or the extent to which, the evidence shows use of the Second, Third and Fourth Earlier Marks in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

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

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

“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."

30. The Second Earlier Mark is registered for "vehicle parts, namely shock absorbers". The evidence overwhelmingly refers to bicycle parts, rather than the broader category of vehicles. The same applies to the Third Earlier Mark. The Fourth Earlier Mark is registered for "suspension systems for vehicles, bicycles and land motor vehicles; vehicle parts, shock absorbers" in class 12 and "advertising, marketing and promotional services for dealers and distributors of vehicle suspension systems including shock absorbers for vehicles" in class 35. Ms Newnes (rightly) accepted that there is no evidence of use of the class 35 services. I note that there is evidence of use of shock absorbers and suspension forks (which both appear to me to be types of suspension systems for bicycles). Consequently, I also consider it appropriate for FF to retain the term "suspension systems" for bicycles in relation to the Fourth Earlier Mark. Consequently, I consider a fair specification for the Second, Third and Fourth Earlier Marks to be:

Second Earlier Mark

Class 12 – Bicycle parts, namely shock absorbers.

Third Earlier Mark Class 12 – Bicycle parts, namely, shock absorbers.

Fourth Earlier Mark Class 12 – Suspension systems for bicycles;
Bicycle parts, shock absorbers.

Section 5(2)(b) – case law

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

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

32. I have only included the goods and services that I consider represent FF's best case in the table below. With that in mind and bearing in mind my proof of use findings, the competing goods and services are as follows:

FF's goods (the opponent/applicant for invalidation)	YD's goods (the applicant/registered proprietor)
<p>The First Earlier Mark</p> <p><u>Class 12</u></p> <p>Vehicles; apparatus for locomotion by land, air or water; suspension systems for vehicles, in particular, suspension systems for bicycles and motor vehicles; vehicle parts, in particular, shock absorbers (including for seats, in particular boat seats), suspension, and suspension parts consisting of lift kits comprising of spacers, linkages, cross members, shock absorbers, and mounting brackets; bicycle parts, in particular, shock absorbers, forks, sprockets, seat posts, handlebars, and wheels.</p> <p>The Second Earlier Mark</p> <p><u>Class 12</u></p> <p>Bicycle parts, namely shock absorbers.</p> <p>The Third Earlier Mark</p> <p><u>Class 12</u></p> <p>Bicycle parts, namely, shock absorbers.</p> <p>The Fourth Earlier Mark</p> <p><u>Class 12</u></p> <p>Suspension systems for bicycles; Bicycle parts, shock absorbers.</p> <p>The Fifth Earlier Mark</p>	<p>The First Contested Mark</p> <p><u>Class 12</u></p> <p>Bicycles; motorcycle chains; bicycle wheel rims; Wheels for motorcycles; electric vehicles; bicycle frames; Mopeds; pushchairs; luggage carriers for vehicles; bicycle tyres.</p> <p><u>Class 35</u></p> <p>Advertising; demonstration of goods; Online advertising on a computer network; organization of trade fairs; commercial administration of the licensing of the goods and services of others; import-export agency services; Marketing; provision of an on-line marketplace for buyers and sellers of goods and services; updating and maintenance of data in computer databases; accounting.</p> <p>The Second Contested Mark</p> <p><u>Class 12</u></p> <p>Bicycle frames; Forks [bicycle parts]; bicycle handlebars; bicycle wheels; bicycle seat posts; bicycle saddles; bicycles; bottle cages for bicycles; handle bar stems [bicycle parts]; bicycle hubs.</p>

Class 12

Suspension systems for vehicles, suspension systems for bicycles and motor vehicles; Vehicle parts, shock absorbers; bicycle parts, shock absorbers; parts and accessories for all the foregoing.

Class 35

Retail store services and computerized online retail store services featuring vehicle parts, bicycle parts, clothing and fashion accessories, bicycle bags, sports bags, decals, and printed materials.

33. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

34. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

The First Contested Mark

Class 12

Bicycles; electric vehicles;

35. In my view, these goods are identical on the principle outlined in *Meric* to “vehicles” in the specification of the First Earlier Mark. At the hearing, Mr Sorenti submitted that vehicles would be considered by the average consumer to only include modes of transport that had an engine and, therefore, could not be considered identical to a pedal bicycle. However, even if that is correct, these goods will be identical on the principle outlined in *Meric* to “apparatus for locomotion by land” in the specification of the First Earlier Mark.

36. “Bicycle parts, namely shock absorbers” in the specifications of the Second and Third Earlier Marks and “bicycle parts, shock absorbers” in the specification of the Fourth and Fifth Earlier Marks could all be parts of the above goods in YD’s specification (electric vehicles could include electric bicycles). Consequently, there will be an overlap in trade channels and user. The method of use, nature and purpose of

the goods may differ. However, they will be complementary. Consequently, I consider them to be similar to a medium degree.

Mopeds;

37. For the same reasons set out in paragraph 35 above, these goods are identical on the principle outlined in *Meric* to “vehicles” and “apparatus for locomotion by land” in the specification of the First Earlier Mark.

38. I can see no point of overlap with the specifications of the Second, Third, Fourth and Fifth Earlier Marks. Consequently, I find no similarity.

Bicycle wheel rims; bicycle frames; bicycle tyres.

39. These are all goods that would be parts of “vehicles” or “apparatus for locomotion by land” in the specification of the First Earlier Mark. Consequently, there will be an overlap in trade channels and user. The method of use, nature and purpose of the goods may differ. However, they will be complementary. Consequently, I consider them to be similar to a medium degree.

40. I accept that there may be an overlap in trade channels for those goods relating to bicycles with “bicycle parts, namely shock absorbers” in the specifications of the Second and Third Earlier Marks and “bicycle parts, shock absorbers” in the specification of the Fourth and Fifth Earlier Marks because they could all be sold through retailers selling parts and fittings for bicycles. The users will clearly overlap. However, the nature and method of use will differ. There will be some overlap in purpose. The goods are not complementary and are not in competition. Consequently, they are similar to a medium degree.

Motorcycle chains; wheels for motorcycles;

41. These goods are parts of “vehicles” in the specification of the First Earlier Mark. Consequently, there will be an overlap in trade channels and user. The method of use,

nature and purpose of the goods differ. However, they will be complementary. Consequently, I consider them to be similar to a medium degree.

42. There is no point of overlap with the specifications of the Second, Third, Fourth and Fifth Earlier Marks. Consequently, I find no similarity.

Luggage carriers for vehicles;

43. These goods may be sold through the same retailers as “vehicles” in the specification of the First Earlier Mark because the same businesses may supply both the vehicles themselves and accessories for them. Consequently, there will be an overlap in trade channels and user. The method of use, nature and purpose of the goods may differ. However, they will be complementary. Consequently, I consider them to be similar to a medium degree.

44. There is no point of overlap with the specifications of the Second, Third, Fourth and Fifth Earlier Marks. Consequently, I find no similarity.

Pushchairs;

45. I can see no point of overlap with FF’s specifications. These are goods that would be sold by retailers specialising in products for infants and children. There is no apparent overlap in trade channels with FF’s goods. The users may overlap at the broad level of being goods for the general public. However, the method of use and nature of the goods will clearly differ. There may be an overlap in purpose with “vehicles” in the specification of the First Earlier Mark, only to the extent that both are used to get things from one place to another. Consequently, I consider these goods to be similar to a very low degree, at best.

Class 35

Advertising; Online advertising on a computer network; Marketing; organization of trade fairs; commercial administration of the licensing of the goods and services of

others; import-export agency services; updating and maintenance of data in computer databases; accounting.

46. As far as I can see, there is no point of overlap with FF's specifications. These are all services sold by specialist businesses and I can identify no point of overlap, nor do I have any evidence to suggest that such an overlap exists. Consequently, I consider the goods and services to be dissimilar.

Demonstration of goods;

47. I recognise that as part of a retail service, large businesses (such as, for example, department stores) may provide an offering to demonstrate the goods being sold to potential customers. Consequently, there may be some very limited overlap in trade channels. However, the users of the services will differ as YD's services are provided to businesses, whereas FF's services are provided to the general public. The nature and method of use of the services will differ and the overlap in purpose will be limited. The services are not in competition and are not complementary. Consequently, I consider them to be similar to a low degree to the retail services in the specification of the Fifth Earlier Mark.

48. There is no point of overlap with the specifications of the First, Second, Third and Fourth Earlier Marks. Consequently, I find no similarity.

Provision of an on-line marketplace for buyers and sellers of goods and services;

49. Whilst I do not consider these services to be retail services, as such, there is clearly an overlap in purpose as they are intended to provide a way of consumers accessing a selection of goods for sale. The users will clearly overlap, as may the method of use and nature (as both, for example, may be provided online through a website in similar manners). There may also be a degree of competition. Consequently, I consider the services to be similar to the retail services in the specification of the Fifth Earlier Mark to a high degree.

50. I can identify no point of overlap with the specifications of the First, Second, Third or Fourth Earlier Marks. Consequently, the goods and services are dissimilar.

The Second Contested Mark

Bicycle frames; Forks [bicycle parts]; Bicycle handlebars; Bicycle wheels; Bicycle seat posts; Bicycle saddles; Bottle cages for bicycles; Handle bar stems [bicycle parts]; Bicycle hubs.

51. These are all parts or accessories for bicycles. For the same reasons set out in paragraphs 39 and 40 above, they are similar to a medium degree to “vehicles” or “apparatus for locomotion by land” in the specification of the First Earlier Mark, “bicycle parts, namely shock absorbers” in the specifications of the Second and Third Earlier Mark, and “bicycle parts, shock absorbers” in the specifications of the Fourth and Fifth Earlier Marks.

Bicycles;

52. For the same reasons set out in paragraphs 35 and 36 above, this term is identical to “vehicles” and “apparatus for locomotion by land” in the specification of the First Earlier Mark and will be similar to a medium degree to “bicycle parts, namely shock absorbers” in the specifications of the Second and Third Earlier Marks and “bicycle parts, shock absorbers” in the specifications of the Fourth and Fifth Earlier Marks.

The average consumer and the nature of the purchasing act

53. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

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

54. The average consumer for the parties’ goods and services is likely to be a member of the general public. In relation to the level of attention paid, Mr Sorenti directed me to the evidence of Mr Richey, in which he stated:

“prospective buyers of bicycles and/or power vehicles typically read closely into the specifications of the goods. The Opponent’s goods are usually priced at the higher-end of the respective markets, partly due to the fact that the Opponent’s goods cost more than its competitors. These prospective buyers would therefore spend more money on the item and therefore need to know, prior to purchase, whether that model of bicycle or power vehicle had the particular specification e.g. the Opponent’s Fox shock absorber or fork incorporated into it.”

55. For the avoidance of doubt, I do not consider this to be an admission as to the level of attention paid by the average consumer. This is because Mr Richey is discussing the price point of the goods actually supplied by the opponent. However, my assessment must take into account the full breadth of the parties’ respective specifications, not the actual goods that they provide or the cost of those goods in the marketplace. The cost of the goods and services will vary. For example, shock absorbers would not be as expensive as the vehicles themselves. None of the goods are likely to be purchased frequently. The services are unlikely to be particularly costly and may be more frequent in nature. However, various factors will be taken into account such as technical specifications, functionality and performance (for the goods) and speed of service and ease of use (for the services). Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process (although for some of the goods it may be higher).

56. In my view, the goods and services are likely to be purchased following perusal of signage on websites, in physical premises or on advertisements. Consequently, visual considerations will dominate the selection process. However, given that advice may be sought from retail assistants or, as Ms Newnes submitted, orders may be placed verbally, I do not discount an aural component to the purchase.






Comparison of trade marks

57. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... 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.”

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

59. The respective trade marks are shown below:

FF's trade marks	YD's trade mark
<p data-bbox="331 309 655 398">FOX (the First Earlier Mark)</p>	
 <p data-bbox="311 674 679 712">(the Second Earlier Mark)</p>	
 <p data-bbox="328 1081 662 1120">(the Third Earlier Mark)</p>	
 <p data-bbox="319 1408 671 1447">(the Fourth Earlier Mark)</p>	
 <p data-bbox="333 1680 655 1718">(the Fifth Earlier Mark)</p>	

Overall Impression

60. YD's mark consists of the conjoined words TRIFOX, presented in a slightly stylised font. It is the word itself which plays the greater role in the overall impression, with the stylisation playing a lesser role.

61. The First Earlier Mark consists of the word FOX. There are no other elements to contribute to the overall impression, which lies in the word itself. The Second Earlier Mark consists of the word FOX with a foxtail device coming out of the letter O. The word FOX plays the greater role in the overall impression, with the device playing a lesser role. It is the word FOX which is the most distinctive element of the mark. The same applies to the Third Earlier Mark, with the additional circular border playing a much lesser role in the overall impression. Again, the same applies to the Fourth Earlier Mark, with the additional words RACING SHOX identifying the goods sold under the mark and, given their relative size, playing a lesser role in the overall impression. The Fifth Earlier Mark consists of the words FOX FACTORY, with a foxtail device coming out of the first letter O. The words play the greater role in the overall impression as the eye is drawn to the element that can be read, with the foxtail device playing a lesser role.

Visual comparison

62. YD's mark and the First Earlier Mark overlap to the extent that the First Earlier Mark makes up the last three letters of YD's mark. They differ in that YD's mark includes the additional first three letters TRI. I bear in mind that the beginnings of marks tend to make more of an impact than the ends. Although YD's mark is stylised, as the First Earlier Mark is a word only mark it could be used in any font. Consequently, I consider YD's mark and the First Earlier Mark to be visually similar to between a medium and high degree.

63. The same applies to the Second Earlier Mark and YD's mark. However, the stylisation is different in both, and the foxtail device acts as an additional point of difference. In my view, the Second Earlier Mark and YD's mark are visually similar to between a low and medium degree.

64. The same applies to the Third Earlier Mark and YD's mark. However, the circular border acts as an additional point of difference. In my view, the Third Earlier Mark and YD's mark are similar to a low degree.

65. The Fourth and Fifth Earlier Marks and YD's mark, again, overlap to the extent that they both contain the word FOX. However, the additional words RACING SHOX/FACTORY and the foxtail device in the Fourth and Fifth Earlier Mark and the word TRI in YD's mark, and the difference in stylisation, all act as points of visual difference. Taking all of this into account, as well as the fact that the beginnings of marks tend to make more of an impact than the ends, I consider the marks to be visually similar to only a very low degree.

Aural Comparison

66. The First, Second and Third Earlier Marks will all be pronounced identically i.e. FOX. They overlap with YD's mark to the extent that they will be pronounced identically to the second syllable of YD's mark. However, the additional word TRI at the beginning of YD's mark will act as a point of aural difference. Consequently, I consider the First, Second and Third Earlier Marks and YD's mark to be aurally similar to between a medium and high degree.

67. The same will apply to the comparison with the Fourth and Fifth Earlier Marks. However, they have the additional points of aural difference created by the articulation of the words RACING SHOX/FACTORY, which have no counterpart in YD's mark. Consequently, I consider the marks to be aurally similar to a low degree.

Conceptual Comparison

68. The First Earlier Mark refers to an animal. At the hearing, Mr Sorenti submitted that YD's mark will be viewed as an invented word with no meaning. I disagree. Clearly, it is a word made up of two ordinary dictionary words – TRI and FOX – and the consumer will be able to identify these words, despite the fact that they are conjoined. I consider that the reference to an animal will also be present in YD's mark,

although it is conjoined with the word TRI, meaning three. Consequently, I do not consider there to be any more than a medium degree of similarity conceptually.

69. The Second and Third Earlier Marks will convey the same message as the First Earlier Mark. The foxtail device simply reinforces this. Consequently, the same finding will apply to these marks and they are conceptually similar to YD's mark to a medium degree.

70. The Fourth Earlier Mark contains the additional word RACING SHOX. However, given that they just describe the goods (being a misspelling of shock (absorbers) for racing), I do not consider that this impacts the conceptual message conveyed by the mark to any real degree. Consequently, I consider the Fourth Earlier Mark and YD's mark to be conceptually similar to a medium degree.

71. The Fifth Earlier Mark consists of the words FOX FACTORY. Factory will, of course, be recognised as a place where things are produced/processed. The mark as a whole has an ambiguous meaning, but it is clearly referring to a factory (a message which is absent from YD's mark. The TRI element of YD's mark also acts as a point of conceptual difference. Consequently, I consider any conceptual similarity to be at a low degree.

Distinctive character of the earlier trade marks

72. 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-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).”

73. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

74. I will begin by assessing the inherent distinctive character of the earlier marks. The First Earlier Mark consists of the word FOX. This is an ordinary dictionary word which has no connection to the goods and services. Consequently, I consider it to be inherently distinctive to a medium degree. I do not consider that the foxtail device, the circular border or the word RACING SHOX in the Second, Third and Fourth Earlier Mark alter the distinctiveness of the marks to any meaningful degree, and I consider them all to be inherently distinctive to a medium degree. The Fifth Earlier Mark consists of the words FOX FACTORY with a foxtail device. The words are somewhat ambiguous in their meaning as a whole, but are both ordinary dictionary words. Taking all of this into account, I consider the Fifth Earlier Mark to be inherently distinctive to between a medium and high degree.

75. I now turn to consider whether the distinctiveness of the earlier marks has been enhanced through use. There are clearly issues with FF’s evidence. For example, the UK sales figures provided have not been broken down by mark or by product. Further, a number of the invoices provided are after the relevant dates. However, it is important

to take the evidence as a whole into account and to assess the picture that it creates in the round. The sales figures for the UK market are clearly significant. The evidence overwhelmingly demonstrates sales of shock absorbers and suspension systems for bicycles in relation to the FOX brand. FF has a number of UK distributors that sell these goods in the UK. Use has been long-standing, with independent evidence showing that these goods were first released in the UK in 2001. The evidence shows that FOX branded goods have consistently been identified by consumers as being in the top two most likely to be purchased for suspension systems for bicycles. I note that the articles that reference FF's long-standing and highly regarded use in the UK post-date the relevant dates. However, given the nature of their content, they inevitably refer back to activities already undertaken. When taking the evidence as a whole into account, I consider that the distinctiveness of the First Earlier Mark has been enhanced through use to between a medium and high degree for bicycle suspension systems. As the word FOX plays the greater role in the Second, Third and Fourth Earlier Marks I also consider that they have been enhanced through use to between a medium and high degree. The addition of the word FACTORY in the Fifth Earlier Mark changes the meaning overall and so I do not consider that use of the word FOX can enhanced the distinctiveness of this mark and the evidence is not sufficient to justify any enhancement through use of the Fifth Earlier Mark.

Likelihood of confusion

76. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the

average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

77. I have found as follows:

- a) The goods and services vary from being similar to a very low degree to identical (except where I have found them to be dissimilar).
- b) The average consumer is a member of the general public who will pay at least a medium degree of attention during the purchasing process (although for some of the goods it may be higher).
- c) The purchasing process will be predominantly visual, although I do not discount an aural component.
- d) The First Earlier Mark and YD's mark are visually and aurally similar to between a medium and high degree, and conceptually similar to a medium degree.
- e) The Second Earlier Mark and YD's mark are visually similar to between a low and medium degree, aurally similar to between a medium and high degree, and conceptually similar to a medium degree.
- f) The Third Earlier Mark and YD's mark are visually similar to a low degree, aurally similar to between a medium and high degree, and conceptually similar to a medium degree.
- g) The Fourth Earlier Mark and YD's mark are visually similar to a very low degree, aurally similar to a low degree and conceptually similar to a medium degree.
- h) The Fifth Earlier Mark and YD's mark are visually similar to a very low degree, aurally and conceptually similar to a low degree.

- i) The First, Second, Third and Fourth Earlier Marks are inherently distinctive to a medium degree, which has been enhanced through use to between a medium and high degree for shock absorbers and suspension systems for bicycles.
- j) The Fifth Earlier Mark is inherently distinctive to between a medium and high degree.

78. Taking all of the above factors into account, and bearing in mind the visual differences between the marks, and the predominantly visual purchasing process, I do not consider that the marks are likely to be mistakenly recalled or misremembered as each other, even when used on identical goods. Even in respect of the First Earlier Mark, which is the most visually similar to YD's mark, I do not consider it likely that the average consumer will overlook the word TRI at the beginning of YD's mark. Consequently, I do not consider there to be a likelihood of direct confusion.

79. I will now consider whether there is indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, 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)".

80. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

81. I consider that the addition of the word TRI to the word FOX (albeit using a different stylistic presentation) is one likely to be viewed by the average consumer as indicating a sub-brand (perhaps referring to a three-wheeled vehicle or a product suitable for use with three-wheeled vehicles). I also consider that, given that the distinctiveness of the First, Second, Third and Fourth Earlier Marks has been enhanced through use, that the average consumer would conclude that only one undertaking could be using the word FOX in relation to goods that are similar to at least a medium degree. Where

there is a greater distance between the goods, I consider that the similarity between the marks will be offset, in accordance with the interdependency principle. Consequently, I consider there to be a likelihood of indirect confusion based upon the First, Second, Third and Fourth Earlier Marks. In relation to the Fifth Earlier Mark, I am not convinced there is a likelihood of indirect confusion. I do not consider the removal of the word FACTORY to be consistent with a brand extension or alternative mark.

82. The application for invalidation against the First Contested Mark based upon section 5(2)(b) succeeds in relation to the following goods only:

Class 12 Bicycles; motorcycle chains; bicycle wheel rims; Wheels for motorcycles; electric vehicles; bicycle frames; Mopeds; luggage carriers for vehicles; bicycle tyres.

83. The opposition based upon section 5(2)(b) against the Second Contested Mark succeed in its entirety.

Final Remarks

84. Even if I am wrong in my finding regarding enhanced distinctiveness of the First, Second, Third and Fourth Earlier Marks, this would not change my overall finding. This is because the addition of the word TRI to the only or most distinctive element of the marks (inherently), in the context of the goods for which I have found a likelihood of confusion, would still be seen as indicating three-wheeled products (or parts for those goods) sold by the same undertaking.

Section 5(3)

85. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation

in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

86. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

87. As the earlier trade marks are comparable marks, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom include the European Union”.

88. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L’Oreal v Bellure and Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM*. 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 and Environmental Manufacturing, paragraph 34*.

(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*).

89. The conditions of section 5(3) are cumulative. Firstly, FF must show that the earlier marks and the YD's mark are similar. Secondly, FF must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier marks being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

90. In *General Motors*, Case C-375/97, 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.”

91. At the hearing, Ms Newnes submitted that this is “not a particularly onerous requirement”. However, I am reminded of the comments of Mr Phillip Johnson, sitting as the Appointed Person in *SACURE O/360/20*, in which he stated:

“31. It is important to remember that the burden of establishing a reputation for the purposes of section 5(3) falls on the proprietor of the earlier mark. For a mark with an established reputation this may not be “a particularly onerous requirement” to satisfy: *Och-Ziff Management Europe Ltd & Anor v Och Capital LLP & Anor* [2010] EWHC 2599 (Ch), [2011] FSR 11, paragraph 126. However, this does *not* mean that the proprietor of an earlier mark who has filed only weak, incomplete or irrelevant evidence to establish the reputation should be given the benefit of the doubt at the expense of the applicant. The reason it is not an onerous requirement is because collecting the evidence should be straightforward (even if time consuming) where a mark has the necessary reputation.”

However, whilst there are clearly issues with FF's evidence, I am satisfied that it has established that the First, Second, Third and Fourth Earlier Marks have a moderate reputation for shock absorbers and suspension systems for bicycles. For the same reasons set out above, I do not consider the evidence sufficient to establish the requisite reputation for the Fifth Earlier Mark.

Link

92. 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

I have found the First Earlier Mark and YD's mark to be visually and aurally similar to between a medium and high degree and conceptually similar to a medium degree.

I have found the Second Earlier Mark and YD's mark to be visually similar to between a low and medium degree, aurally similar to between a medium and high degree, and conceptually similar to a medium degree.

I have found the Third Earlier Mark and YD's mark to be visually similar to a low degree, aurally similar to between a medium and high degree, and conceptually similar to a medium degree.

I have found the Fourth Earlier Mark and YD's mark to be visually similar to a very low degree, aurally similar to a low degree and conceptually similar to a medium degree.

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

For the reasons set out above, all of the goods in the specification of the Second Contested Mark and the following goods in the specification of the First Contested Mark are similar to at least a medium degree to the goods for which FF has a reputation are: *bicycles; electric vehicles; bicycle wheel rims; bicycle frames; bicycle tyres.*

For the reasons set out above, the remaining goods and services in the specification of the First Contested Mark vary from being dissimilar to a similar to a low degree to those goods for which FF has a reputation.

The strength of the earlier mark's reputation

I have found the First and Second Earlier Marks to have a moderate reputation.

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

First, Second, Third and Fourth Earlier Marks are inherently distinctive to a medium degree, which has been enhanced through use to between a medium and high degree.

Whether there is a likelihood of confusion

I have found there to be a likelihood of indirect confusion.

93. Given the similarities between the earlier marks and the First and Second Contested Marks, I am satisfied that a link would be made in the mind of the average consumer, where the marks are used on goods that are similar to at least a medium degree. Where the distance is greater, I consider it likely that the similarity between the marks will be offset by the distance between the goods and services.

Damage

94. I will now consider whether any of the types of damage pleaded will arise.

95. In the Form TM7, the opponent submits:

“The use of the Applicant’s Sign, without due cause, would take unfair advantage of the Opponent’s Earlier ‘568 Mark’s reputation by feeding on its fame, riding on its coat-tails and/or free-riding on the substantial investment made by the Opponent’s Business in the reputation and goodwill associated with the Opponent’s Earlier ‘568 Mark and exploiting, without paying any financial compensation, the marketing effort expended by the Opponent’s Business in order to create or maintain the image of the Opponent’s Earlier ‘568 Mark.”

96. I bear in mind that unfair advantage has no effect on the consumers of the earlier mark’s goods and services. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

97. 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.”

98. Clearly, to the extent that the relevant public believe that the goods of YD originate from FF, there will be unfair advantage. However, if they do not consider that the goods originate from the same undertaking, I consider that YD will still gain an unfair advantage. This is because FF has a reputation for longevity (resulting in increased familiarity) and producing the “best” goods in their field (see paragraph 25 above). In my view, there is clear potential for this image to transfer to YD. Consequently, I consider damage is made out.

99. As damage is made out on the basis of unfair advantage, I do not consider it necessary to consider the other heads of damage.

100. The application for invalidation against the First Earlier Mark based upon section 5(3) succeeds in relation to the following goods:

Class 12 Bicycles; bicycle wheel rims; electric vehicles; bicycle frames; bicycle tyres.

101. The opposition against the Second Earlier Mark based upon section 5(3) succeeds in its entirety.

Section 5(4)(a)

102. Section 5(4)(a) of the Act states as follows:

“5(4) 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, where the condition in subsection (4A) is met,

aa)...

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”.

103. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

104. I can deal with this ground relatively swiftly. I note that YD has filed evidence to demonstrate that they have been using the First and Second Contested Marks in the UK since January 2019. However, as FF’s evidence of use pre-dates January 2019, I do not consider that this evidence takes YD’s case any further forward and does not establish an earlier relevant date for the purposes of the passing off ground.

105. Although there are issues with FF’s evidence, I am satisfied that it is sufficient to demonstrate a moderate degree of goodwill at the relevant date in relation to bicycle shock absorbers and suspension systems for bicycles. I am also satisfied that the sign FOX is distinctive of that goodwill. Whilst the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it has been acknowledged that they are unlikely to produce different outcomes in practice.¹³ Certainly, I believe that to be the case here. Consequently, I do not consider that there

¹³ *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

would be misrepresentation or damage in relation to the sign that corresponds to the Fifth Earlier Mark. However, in relation to the FOX sign (and those that correspond to the Second, Third and Fourth Earlier Marks), the similarity of the marks, combined with the overlapping fields of activity for “Bicycles; bicycle wheel rims; electric vehicles; bicycle frames; bicycle tyres” in the specification of the First Contested Mark and all of the goods in the specification of the Second Contested Mark would result in misrepresentation. Damage through diversion of sales is easily foreseeable. However, in relation to the remaining goods and services in YD’s specification, the distance is sufficient to offset the similarity of the marks and FF’s goodwill, and there would be no misrepresentation or damage.

106. The invalidation against the First Contested Mark based upon section 5(4)(a) succeeds in relation to the following goods only:

Class 12 Bicycles; bicycle wheel rims; electric vehicles; bicycle frames; luggage bicycle tyres.

107. The opposition against the Second Contested Mark based upon section 5(4)(a) succeeds in its entirety.

CONCLUSION

108. The opposition against application no. 3656405 is successful in its entirety.

109. The application for invalidation against UKTM no. 918275233 is successful in relation to the following goods for which the registration is declared invalid:

Class 12 Bicycles; motorcycle chains; bicycle wheel rims; Wheels for motorcycles; electric vehicles; bicycle frames; Mopeds; luggage carriers for vehicles; bicycle tyres.

110. The application for invalidation against UKTM no. 918275233 is unsuccessful in relation to the following goods and services for which it may remain registered:

Class 12 Pushchairs.

Class 35 Advertising; demonstration of goods; Online advertising on a computer network; organization of trade fairs; commercial administration of the licensing of the goods and services of others; import-export agency services; Marketing; provision of an on-line marketplace for buyers and sellers of goods and services; updating and maintenance of data in computer databases; accounting.

STATUS OF THIS DECISION

111. As part of this decision is based upon the First Earlier Mark, which is not yet registered, it must be provisional pending the registration of that mark. Consequently, I will issue a supplementary decision once the registrability of that mark is known to confirm the scope of the success and the matter of costs.

112. The appeal period will not begin to run until that supplementary decision is issued.

Dated this 6th day of June 2023

S WILSON

For the Registrar