

**O/776/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003257506 BY  
ALEX AND ANI, LLC TO REGISTER:**

**ALEX AND ANI** 

**AS A TRADE MARK IN CLASSES 3, 14, 18 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 411234 BY  
SIGNA SPORTS IPCO GMBH**

## BACKGROUND AND PLEADINGS

1. On 18 September 2017, ALEX AND ANI, LLC (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 6 October 2017. The applicant seeks to register its marks for the following goods:

Class 3      Colognes; perfumes; cosmetics; make-up; nail enamel; non-medicated skin care preparations namely, creams, lotions, gels, body and bath oils, toners, cleansers, soaps, masks, peels, body spray, body polish, foot scrubs; scented room sprays.

Class 14     Jewelry.

Class 18     Leather bags and wallets; Leather bags, suitcases and wallets; Leather credit card wallets; Leather handbags; Leather pouches; Leather purses.

Class 25     Scarves; Shirts; Tops; Women's clothing, namely, shirts, dresses, skirts, blouses.

2. The application was opposed by SIGNA Sports IPCo GmbH (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is based on the earlier EU Trade Mark registration no. 4111076 for the mark **ALEX**. The opponent’s mark has an application date of 8 November 2004 and a registration date of 21 October 2009. The following goods are relied upon in this opposition:

Class 18     Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25     Clothing, headgear, technical footwear for sports.

3. The opponent argues that the respective goods are identical or similar and that the marks are similar.

4. The applicant has filed a counterstatement denying the claims made (and requested that the opponent provides proof of use of its earlier trade mark in respect of the goods relied upon).

5. The opponent is represented by Boulton Wade Tennant and the applicant was originally represented by Katten Muchin Rosenman UK LLP and is now represented by Trade Mark Wizards Limited. The opponent's evidence consists of the witness statement of Wolfram Keil dated 28 May 2018 and the witness statement of Gillian Sarah Farmer dated 29 May 2018. The opponent's evidence was accompanied by written submissions which were undated but were received by the Tribunal on 29 May 2018. The applicant's evidence consists of the witness statement of Kate Richards dated 24 August 2018. This was accompanied by written submissions dated 29 August 2018. The opponent filed written submissions in reply which were undated but were received by the Tribunal on 24 September 2018. No hearing was requested but both parties filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

### **The Opponent's Evidence**

6. As noted above, the opponent's evidence consists of the witness statement of Wolfram Keil dated 28 May 2018, with 25 exhibits, and the witness statement of Gillian Sarah Farmer dated 29 May 2018, with 1 exhibit.

7. Mr Keil is the Chief Executive Officer of the opponent. Mr Keil states that the opponent has used the earlier mark during the relevant period for bags, clothing, headwear and technical footwear for sports. Mr Keil states that the opponent is one of the leading sports retailing groups in Europe and states that it is wholly owned by Signa Retail GmbH.

8. Exhibit WK1 to Mr Keil's statement consists of various print-outs which are intended to provide background information to companies within the Signa group, including the opponent. The earlier mark is not displayed on any of these print-outs.

9. Mr Keil states that the earlier mark was first used in Germany in 1982 by the opponent's predecessor in title, which Mr Keil states is now known as Karstadt Sports GmbH ("Karstadt Sports"). The opponent acquired the majority of shares in Karstadt Sports in 2013 and it is now a wholly owned subsidiary of the opponent. Mr Keil states that Karstadt Sports is one of Germany's leading sportswear and equipment retailers and sells goods from 28 stores across Germany.

10. Exhibit WK2 to Mr Keil's statement consists of print-outs from the [www.karstadtsports.de](http://www.karstadtsports.de) website, which list the locations of its stores in Germany. These display a print date of 21 May 2018. The earlier mark is not displayed on any of these print-outs.

11. Exhibit WK3 to Mr Keil's statement consists of print-outs from the [www.karstadtsports.de](http://www.karstadtsports.de) website which Mr Keil states show some of the goods currently being sold under the earlier mark. These display a print date of 21 May 2018. The earlier mark is displayed in word form in the product description for the following items: fleeces, t-shirts, football shoes, trousers, jackets and training shoes.

12. Mr Keil states that orders placed online can be shipped to addresses in Germany and Austria. Exhibit WK4 to Mr Keil's statement is a print-out from Karstadt Sport's website which confirms that goods can be delivered to Austria.

13. Mr Keil states that Karstadt Warenhaus GmbH ("Karstadt Warenhaus") is also a wholly owned subsidiary of Signa Retail GmbH that sells goods under the opponent's mark. Exhibit WK5 is a print-out from the website [www.karstadt.de](http://www.karstadt.de) showing goods sold under the opponent's mark. It has a print date of 23 May 2018 and shows the opponent's mark in word form in the description of the following goods: t-shirts, shorts, trousers, weights, gym equipment, jackets and football shoes.

14. Mr Keil states that the opponent's mark has been used in Germany for over 30 years. Exhibit WK6 is a print out from the website [www.karstadt.de](http://www.karstadt.de) dated 2 July 2013. It is not clear what goods are being offered for sale in these images, but they show the mark used in the following variants:



15. Exhibit WK7 to Mr Keil's statement is a print out from the website [www.karstadtsports.de](http://www.karstadtsports.de) dated 1 July 2014. ALEX appears in the website address ([www.karstadtsports.de/Alex](http://www.karstadtsports.de/Alex)) but does not appear on the actual web page itself. In any event it is, again, not clear what goods are being offered for sale. WK8 is identical to WK7 but is dated 30 March 2015. WK9 is a print out from the website [www.karstadt.de](http://www.karstadt.de) dated 14 July 2017. The opponent's mark appears in word only form in the description for the following goods: bags, jackets, t-shirts, trainers, weights and gym equipment.

16. Mr Keil states:

“14. I confirm that the amount of sales for goods under the ALEX trade mark in Germany is significant. I confirm that Karstadt Sports' turnover figures for goods sold under the ALEX trade mark which including clothing, footwear, bags, sporting accessories and sporting apparatus was approximately 15 million GBP in 2016 and 2017.”

17. Mr Keil also states that a significant amount of money is spent on advertising and promoting goods under the ALEX mark. Mr Keil states that Karstadt publishes a brochure advertising goods sold under the ALEX mark which is circulated weekly in national German newspapers – “Sueddeutsche Zeitung” and “Frankfurter Allgemeine

Zeitung". Exhibit WK10 consists of a print-out from the website [www.eurotopics.net](http://www.eurotopics.net) which states that the former had a circulation of 415,300 in 2016 and a print out from the website Wikipedia which states that the latter had a circulation of 256,188 in 2016. Both have a print date of 22 May 2018.

18. Exhibit WK11 to Mr Keil's statement is a brochure for Karstadt Sport which Mr Keil states was used as a newspaper insert in October 2014. The date on the brochure is 2014/2015. It displays the ALEX mark in word only form in the text of the page, in the third variant shown in paragraph 14 above and in the following variant:



19. The brochure is in poor print quality and is difficult to read. However, it appears to relate entirely to gym and fitness equipment rather than the goods upon which the opponent relies for the purposes of this opposition.

20. Mr Keil states that Exhibits WK12, WK13, WK14, WK15 and WK16 are extracts from yearly brochures that were used as newspaper inserts between 2013 and 2018. Translations have been provided, but they are not certified. In any event, it is clear that the ALEX mark has been used in word only form, in the third variant shown in paragraph 14 above and the following variants in relation to t-shirts, trainers, football shoes, shorts, trousers, jackets, socks, hats and holdall-style bags:



21. Mr Keil states that Exhibit WK17, Exhibit WK18 and Exhibit WK19 are extracts from the Karstadt Sports & Style catalogue released in the years 2014, 2015 and 2016 respectively. The exhibits are of poor print quality and very small, meaning that the text is illegible. From the images that are visible, there does not appear to be any different variant use from those shown above. The goods in relation to which the mark appears to have been used are t-shirts, shorts, trousers, jumpers and hats.

22. Mr Keil states that Exhibit WK20, Exhibit WK21 and Exhibit WK22 are extracts from the Karstadt Running Catalogue released in the years 2014, 2015 and 2016 respectively. Again, the exhibits are of poor print quality and very small, meaning that the text is illegible. The goods in relation to which the mark appears to have been used are t-shirts, hats, trainers and shorts. Again, there does not appear to be any different variant use from those shown above.

23. Exhibit WK23 consists of an extract from Trend Magazine from 2018, Karstadt's Sport & Style Magazine from 2017 and Veramedia's Trend Magazine from 2017 which display pictures of t-shirts, trousers, holdalls and shorts. No specific date is given for the 2017 documents and so it is not clear whether they were published before or after the relevant date. They display the opponent's mark in the first variant shown in paragraph 14 above and the following variant:



24. Mr Keil states that Exhibit WK24 consists of various promotional materials from Karstadt's newsletters, flyers and coupons between 2016 and 2018. Again, these are very small and of poor print quality. Only two examples from this exhibit actually display the opponent's mark. Both are dated 2018 and are, therefore, dated after the relevant period.

25. Exhibit WK25 consists of three examples of advertisements used in social media. Mr Keil states that the first is from Facebook in 2012, but it does not display the opponent's mark. Mr Keil states that the second is also from Facebook in 2012. This displays the opponent's mark in the following variant next to a jacket and training shoe:



Mr Keil states that the third example is from Instagram in 2014, but does not display the opponent's mark.

26. Mr Keil states:

“23. I confirm that the Opponent has made use of its ALEX trade mark in Germany for a continuous period of five years before the date of publication of the Application.”

27. Ms Farmer is a trade mark attorney representing the opponent in these proceedings. Exhibit GSF1 consists of various print-outs and screen-shots from the websites of Tom Ford, Saint Laurent, Michael Kors, Dior and Chanel. They all display a print date of 21 May 2018. The print-outs from the Tom Ford website show watches, coats, a top, a dress and belts for sale. The print out also shows a page which states “WELCOME TO TOM FORD BEAUTY” with a sub-heading of “FRAGRANCE”, although no products are actually displayed for sale on this page. The print-outs from the YSL website show make up, jewellery, dresses, playsuits and bags for sale. The print-outs from the Michael Kors website show bags, dresses, jewellery and perfume for sale. The print-outs from the Dior website show perfume, jewellery, skincare, bags, shoes, clothing and make up for sale. The print-outs from the Chanel website show clothing, bags, make up and skin care for sale.

28. Ms Farmer states:

“3... As demonstrated by this Exhibit, goods sold under the same trade mark by one proprietor include clothing, make-up, cosmetics, bags and jewellery. These types of goods are therefore frequently supplied and distributed by the same, or economically linked, undertakings and it is not uncommon for clothing manufacturers to branch out and extend their product offering to cosmetics, make-up, jewellery and bags.

4. The above therefore demonstrates that goods in classes 3 and 14 can be considered to be associated, complementary or similar to goods covered by classes 18 and 25.”

29. The opponent’s evidence was accompanied by written submissions. The opponent also filed written submissions in reply and written submissions in lieu of a hearing. Whilst I do not propose to summarise those here, I have taken them into account and will refer to them below as appropriate.



## **The Applicant's Evidence**

30. As noted above, the applicant's evidence consists of the witness statement of Kate Richards dated 24 August 2018, with 12 exhibits. Ms Richards is Senior Vice President Brand Creative at the applicant.

31. Ms Richards states that the applicant was founded in 2004. It started selling products under the applied for mark in the European Union in 2012. Exhibit KR1 and KR2 provide some background information about the applicant and examples of the goods sold by the applicant.

32. The applicant opened its first stand-alone store in the United Kingdom in 2017 in Bluewater, Kent. Exhibit KR3 to Ms Richards' statement consists of various articles which relate to the store opening. Ms Richards states that the applicant has registered its mark in various countries around the world and excerpts from the registers of those countries are provided at Exhibit KR4. Ms Richards has provided information about the sales achieved by the applicant and has provided sample invoices at Exhibit KR5.

33. Ms Richards states that ALEX is a common name. Exhibit KR6 consists of print-outs from the websites [www.behindthename.com](http://www.behindthename.com), [www.babycenter.com](http://www.babycenter.com), [www.ourbabynames.com](http://www.ourbabynames.com) and [www.telegraph.co.uk](http://www.telegraph.co.uk). The first print-out relates to 'Alex' as a girl's name. The second relates to the name Alexander and gives background information about the name. The third states that Alex was ranked the 147<sup>th</sup> most popular boy's name in the United States in 2016. It also lists the number of babies named Alex from 1880 to 2016. The fourth print-out is an article from the Telegraph which lists the most popular baby names in countries around the world and lists Alexander as the most popular name in Iceland and Russia.

34. Ms Richards states that ALEX is also a common part of company names and trade marks and has provided examples of this at Exhibit KR7 and Exhibit KR8. Ms Richards states that Exhibit KR9 lists examples of companies which use the word ALEX in their name and trade in similar fields to those for which the applicant seeks registration.

35. Ms Richards states that, contrary to ALEX, 'ANI' is an unusual name. Ms Richards states that Exhibit KR10 confirms this. Exhibit KR10 consists of print-outs from various websites, the first of which describes 'Ani' as a "very unique female name". It is described on the website [www.babycenter.com](http://www.babycenter.com) as being number 1,948 in popular baby names in 2018. Ms Richards states that the fact that Ani is an unusual name is demonstrated by the relative lack of company names and trade marks which contain the word Ani. Ms Richards has provided a list of the number of companies and trade marks with Ani in the name at Exhibit KR11 and Exhibit KR12.

36. The applicant's evidence was accompanied by written submissions dated 29 August 2018. The applicant also filed submissions in lieu of a hearing. Whilst I do not propose to summarise these here, I have taken them all into account and will refer to them below where appropriate.

## **PROOF OF USE**

37. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

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

6A-(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

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

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

39. According to section 6(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for mark. The relevant period is, therefore, 7 October 2012 to 6 October 2017.

40. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in 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 that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court

of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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] to [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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *Leno* at [55].

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

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

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the

reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

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

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

42. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of

whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

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

43. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

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

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant’s challenge to the Board of Appeal’s conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that



the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guilford, and thus a finding which still left open the possibility of conversion of the community trade mark to a national trade mark may not have sufficed for its purposes.

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

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

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

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

46. 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.

### **Form of the mark**

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

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

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

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

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

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

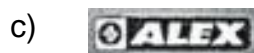
48. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (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)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

49. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

50. As noted above, the mark appears in the opponent's evidence both in word only form and in the following variants:





51. Where the mark is used in the same format as it is registered, such as in the body of the text of the brochures provided by the opponent, this will clearly be use upon which the opponent may rely.

52. In variants a), b), c) and j) the mark is used in a capitalised slightly stylised font. The background on which the mark is presented is split, with one part being used as a background to the word ALEX and the other being used as a background for a symbol presented on a circular background. The stylisation used in these variants is, in my view, acceptable in terms of fair and notional use of the mark. It is clear from the case law in *Colloseum*, cited above, that use in conjunction with other matter falls within the ambit of genuine use. That applies here. The background and symbol presented in a circle do not prevent this from being use upon which the opponent may rely. Further, it is not uncommon for marks to be registered in black and white and used in a colour. I do not, therefore, consider that the opponent's use of the mark in different colours and on different colour backgrounds alters the distinctive character of the mark as registered (as explained in *Nirvana*).

53. The same points apply to variants d), e), f), g) and h). However, in these variants the word "ATHLETICS" is presented beneath the applicant's mark. As noted above, use in conjunction with other matter falls within the ambit of genuine use as explained in *Colloseum*. The word "ATHLETICS" is likely to be seen by the consumer as being descriptive of the goods sold by the opponent (being sports related clothing) and is not likely to be given any trade mark significance. This is, therefore, use upon which the opponent may rely.

54. Variant i) shows the opponent's mark presented in the same capitalised stylised font as described above. This time, the symbol presented in a circle does not appear on a split background, but on its own, at the beginning of the word ALEX. As per *Colloseum*, this is use in conjunction with additional matter upon which the opponent

may rely. For the same reasons described above, use in colour does not prevent the opponent from being able to rely on this variant.

### **Sufficient Use**

55. I have lengthy submissions from the applicant on the evidence provided by the opponent to prove use of the earlier mark. Whilst I do not propose to summarise those submissions here, I have taken them into consideration in reaching my decision.

56. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself<sup>1</sup>.

57. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded 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”.

58. Mr Keil’s evidence is that the earlier mark was first used in Germany in 1982 by the opponent’s predecessor in title (which is now known as Karstadt Sports GmbH). The opponent now owns Karstadt Sports, which sells goods under the opponent’s mark with the opponent’s consent. Karstadt Sports has stores across Germany. Goods are also sold under the opponent’s mark by Karstadt Warenhaus, with the opponent’s consent. Exhibit WK3 to Mr Keil’s statement is of limited use to the opponent as it is undated save for the print date of 21 May 2018 (which is after the relevant period). Similarly, Exhibit WK5 to Mr Keil’s statement is of limited use to the opponent as it is undated save for the print date of 23 May 2018 (which is also after the relevant period). The print-out from the website [www.karstadt.de](http://www.karstadt.de) at Exhibit WK6 is dated 2 July 2013 and is therefore during the relevant period. This shows the mark being used (in acceptable variations) in relation to various clothing items. Exhibit WK7 and WK8 to

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<sup>1</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

Mr Keil's statement are print outs from the website [www.karstadtssports.de](http://www.karstadtssports.de) dated 1 July 2014 and 30 March 2015 (and therefore also within the relevant period). Whilst the word 'Alex' appears in the website address, it does not appear on the webpage itself. Exhibit WK9 is dated within the relevant period and shows the opponent's mark being used in relation to various goods. Mr Keil states that the sales for goods sold under the opponent's mark are significant, with Karstadt Sports' turnover in relation to these goods only being approximately £15million in 2016 and 2017. However, this figure does include goods which do not appear in the specification for the earlier mark and no detailed breakdown is provided.

59. Exhibit WK10 and Exhibit WK11 show that brochures advertising goods for sale under the opponent's mark are circulated in newspapers with not insubstantial circulation figures. Mr Keil has provided examples of newspaper inserts that were used between 2013 and 2018. Exhibits WK17, WK18, WK19, WK20, WK21 and WK22 are all extracts from catalogues released in 2014, 2015 and 2016 respectively which show goods offered for sale under the opponent's mark. Exhibit WK23 consists of extracts from magazines which display goods available under the opponent's mark. One of these is dated 2018 and is therefore after the relevant period. The other two are dated 2017, but it is not clear whether they were published during or after the relevant period (which ends during 2017). As noted above, only two examples provided at Exhibit WK24 actually display the opponent's mark. Both are dated after the relevant date. Only one of the social media advertisements shown at Exhibit WK25 display the opponent's mark. This is dated 2012 and so it is not clear whether this pre-dated the relevant period or whether it was published during the relevant period. Ms Farmer's evidence does not assist the opponent in proving use of its mark as it relates entirely to the similarity of the goods which are the subject of these proceedings.

60. The evidence is certainly unclear in parts as to whether it relates to use of the mark during the relevant period. Further, the evidence is mostly limited to use of the mark in Germany, although Exhibit WK4 does demonstrate that it is possible for goods to be purchased from and delivered to Austria. Indeed, Mr Keil states that they "are purchased online and shipped by Karstadt Sports to addresses in Germany and in Austria" (emphasis added). Although no figures are provided to support this, it does appear from this statement that goods have been sold in both Germany and Austria.

No turnover figures are provided by Mr Keil, although he states that turnover for Karstadt Sports in 2016 and 2017 was in excess of £15million in respect of goods sold under the ALEX mark. However, Mr Keil acknowledges that these sales include goods (such as sporting apparatus) which are not the subject of these proceedings and no breakdown is provided. Brochures have been produced over sequential years offering for sale the goods which are the subject of these proceedings. If no (or limited) sales had been made, brochures would not have continued to be produced. Overall, the evidence creates a picture which is sufficient to establish genuine use of the mark by the opponent during the relevant period.

### **Fair Specification**

61. I must now consider whether, or the extent to which, the evidence shows use for all of the goods relied upon.

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

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

63. 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."

64. It is plain that the evidence does not support the claim for use in relation to all of the goods claimed in the notice of opposition.

65. The applicant has noted in its written submissions that the opponent's goods in class 25 are separated with commas and not semi-colons. The effect of this is that the specification should read: "clothing...for sports", "headgear...for sports" and "technical footwear for sports". I agree with the applicant that this is how the opponent's specification should be read.

66. The opponent's evidence shows that the earlier mark has been used in relation to a broad range of clothing items. I am satisfied that this range is broad enough to enable it to rely on "clothing...for sports" in its specification. The opponent has demonstrated that it has used its mark in relation to trainers and what appear to be football boots. I am, therefore, satisfied that the opponent is entitled to rely on "technical footwear for sports". The opponent has demonstrated use of its mark in relation to hats and so I consider that it is entitled to rely on "headgear...for sports" in its specification. The evidence shows that the opponent's mark has been used on draw-string bags and holdalls. In my view, the draw-string bags and the sports-style holdalls shown in the opponent's evidence do, in my view, fall within the meaning of "travelling bags". As the term "travelling bags" is already fairly narrow I do not propose to reduce this any further. The opponent has shown no use in relation to any of the other goods in class 18 of its specification. A fair specification will, therefore be:

Class 18      Travelling bags

Class 25      Clothing, headgear, technical footwear for sports

67. Even if I am wrong in my finding that the goods in class 25 of the opponent's specification should be read as "clothing...for sports", "headgear...for sports" and "technical footwear for sports", this would not alter my finding regarding a fair specification for the opponent's mark.

## **PRELIMINARY ISSUES**

68. The applicant has made reference to (and provided documents to demonstrate) that it was launched in 2004 in the United States and expanded to various other countries across the world, including the UK. The applicant has also provided evidence

of sales. The purpose of the applicant submitting this evidence is not entirely clear and no explanation is given in the applicant's written submissions. However, for the avoidance of doubt, if the applicant's intention was to show that its mark had been used prior to the opponent's application for registration and is therefore entitled to some unregistered right, this argument cannot assist the applicant. Section 72 of the Act provides that registration shall be taken as *prima facie* evidence of the validity of a registered mark. The applicant has not sought to invalidate the earlier mark on the basis of a pre-existing common law right. Similarly, if the intention of the applicant is to show that both parties' marks have been available on the market and there has been no confusion, this does also not assist the applicant. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

"80. ...the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however, as the reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."

69. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, Millet LJ stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

70. I will, therefore, proceed on the basis that this evidence is provided by way of background information only.

71. The applicant has also made reference to the existence of other marks registered which use the name Alex (as well as a lack of marks which use the name Ani). However, my assessment must take into account only the applied for mark and any potential conflict with the earlier mark. The existence (or lack) of other trade marks on the register is not relevant to the decision I must make<sup>2</sup>.

## **DECISION**

72. 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.”

73. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question,

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<sup>2</sup> *Zero Industry Srl v OHIM*, Case T-400/06

taking account (where appropriate) of the priorities claimed in respect of the trade marks

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

74. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions.

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

75. 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.

The principles:

(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 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

76. As a result of my finding at paragraph 66 above, the competing goods are as follows:

Opponent's goods	Applicant's goods
<p data-bbox="204 528 336 562"><u>Class 18</u></p> <p data-bbox="204 582 427 616">Travelling bags</p> <p data-bbox="204 694 336 728"><u>Class 25</u></p> <p data-bbox="204 748 785 837">Clothing, headgear, technical footwear for sports</p>	<p data-bbox="809 528 922 562"><u>Class 3</u></p> <p data-bbox="809 582 1390 949">Colognes; perfumes; cosmetics; make-up; nail enamel; non-medicated skin care preparations namely, creams, lotions, gels, body and bath oils, toners, cleansers, soaps, masks, peels, body spray, body polish, foot scrubs; scented room sprays.</p> <p data-bbox="809 1025 938 1059"><u>Class 14</u></p> <p data-bbox="809 1079 927 1113">Jewelry.</p> <p data-bbox="809 1189 938 1223"><u>Class 18</u></p> <p data-bbox="809 1243 1390 1442">Leather bags and wallets; Leather bags, suitcases and wallets; Leather credit card wallets; Leather handbags; Leather pouches; Leather purses.</p> <p data-bbox="809 1518 938 1552"><u>Class 25</u></p> <p data-bbox="809 1572 1390 1715">Scarves; Shirts; Tops; Women's clothing, namely, shirts, dresses, skirts, blouses.</p>

77. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, C-39/97, the court stated at paragraph 23 of its judgment 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.”

78. 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.

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

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks)* (IP



*TRANSLATOR*) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

80. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

81. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

82. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the

goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

83. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

84. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

85. In its Grounds of Opposition, the opponent stated that:

“7. It is submitted that the Opposed Goods are either identical or highly similar or highly complementary to the goods covered by the Registration.”

86. In its Counterstatement, the applicant stated:

“8. [...] the Application is made in respect of goods in classes 3, 14, 18 and 25. It is accepted that there is similarity in the goods in classes 18 and 25, for which the Opponent’s Mark is registered. However, it is not accepted that there is any similarity in respect of the other classes to which the Application relates (i.e. goods such as colognes, perfumes, cosmetics in class 3 and jewellery in class 14).

87. The parties have expanded further on these points in their written submissions and, whilst I do not propose to summarise them here, I have taken them into account in reaching my decision and will refer to them below as appropriate.

88. The opponent argues that the applicant’s class 3 goods are “similar, associated and complementary” to its class 18 and class 25 goods because “all the goods are fashion related items, or generally for personal beautification and/or adornment and therefore the users and uses are essentially the same.” Similar arguments are made in respect of the applicant’s class 14 goods.

89. In *Frag Comercio Internacional, SL v OHIM*, Case T-162/08, at paragraph 30 of its judgment, the GC found that there is no similarity between perfumery goods in class 3 and goods in class 18 and class 25, stating:

“Secondly, the Board of appeal did not err in finding, in paragraph 20 of the contested decision, that the goods in Classes 18 and 25 covered by the earlier Community mark were not complementary in relation to the ‘perfumery’ in Class 3 covered by the mark applied for. In that regard, the Court has held previously that perfumery goods and leather goods in Class 18 cannot be considered similar. Perfumery goods and leather goods are plainly different as regards both their nature and their intended purpose or their method of use. Moreover, there is nothing that enables them to be regarded as in competition with each other or functionally complementary. The same conclusion must be drawn concerning a comparison between perfumery goods and clothing in Class 25. Those goods, as of themselves, also differ as regards both their nature and

their intended purpose or their method of use. There is nothing, either, that enables them to be regarded as in competition with each other or complementary (Case T-150/04 *Mülhens v OHIM – Minoronzoni (TOSCA BLU)* [2007] ECR II-2353, paragraphs 31 and 32).”

90. In *Compagnie des montres Longines, Francillon SA v OHIM*, Case T-505/12, the GC held that there is no similarity between clothing and jewellery stating:

“50. First, the raw materials from which they are manufactured are different, except for some similarities between certain materials which may be used both in the manufacture of optical sunglasses and for certain horological goods or jewellery, such as glass.

51. Secondly, clothing and footwear in Class 25 are manufactured to cover, conceal, protect and adorn the human body. Optical sunglasses are above all produced to make it easier to see, to provide users with a feeling of comfort in certain meteorological conditions and, in particular, to protect their eyes from rays of sunlight. Watches and other horological goods are designed, inter alia, to measure and indicate the time. Lastly, jewellery has a purely ornamental function (see, to that effect, judgment in *nollie*, cited in paragraph 41 above, EU:T:2010:114, paragraph 33 and the case-law cited).

52. In the second place, it must be pointed out that as the nature, intended purpose and method of use of the goods at issue are different, they are neither in competition with each other nor interchangeable.

53. The applicant has not shown that it is typical, notwithstanding the abovementioned differences, for a consumer who, for example, intends to buy himself a new watch or some jewellery, to decide, suddenly, to buy himself, on the contrary, clothing, footwear or optical sunglasses, and vice versa.”

91. I accept that there will be some overlap between the users for such goods because they are all consumer items. However, this is not sufficient to find similarity on its own. The goods are entirely different in their nature and their intended purpose (the

applicant's class 3 goods being to make the user smell nice or to care for the skin and its class 14 goods being for decorative purposes and the opponent's class 18 goods being to carry things and its class 25 goods being used to cover the body). The goods cannot be said to be competitive as they are in no way interchangeable. The opponent relies on the evidence of Ms Farmer which it states demonstrates that the same (or economically linked) undertakings often provide goods in class 3, 14, 18 and 25. However, in *Compagnie* (cited above) the GC rejected that argument in respect of sunglasses, jewellery and watches stating:

“55 Moreover, it must be stated that to accept that such claims are well-founded would be tantamount, in essence, to rendering irrelevant any differentiation between goods which belong to the luxury sector and are protected by the respective marks, since the applicant's theory relating to the impulse purchase aimed at the instant gratification of consumers leads to the conclusion that a likelihood of confusion may actually exist irrespective of the goods concerned, on the sole condition that they all fall within that sector. Such an approach, by which the applicant in actual fact alleges that all the goods at issue are interchangeable, is manifestly contrary to the principle of speciality of marks which the Court must take into account in its analysis in accordance with Article 8(1)(b) of Regulation No 207/2009 and would improperly extend the area of protection of trade marks. For the same reasons, it is necessary to reject as irrelevant the applicant's claim that the goods are interchangeable inasmuch as each of them may be given as a gift and the consumer impulsively chooses one or other of them. To accept such a vague connection would lead to holding that goods which are manifestly different in their nature and intended purpose are similar.”

92. This applies here. All of the evidence provided by the opponent relates to luxury brands. The mere fact that such brands provide all of these goods is insufficient on its own to find similarity between them. This would result in a finding that goods which are “manifestly different in their nature and intended purpose” are similar. Although this case applied to jewellery specifically, the same reasoning also applies to perfume and other goods in class 3 of the applicant's specification.

93. Further, the fact that one might purchase jewellery to go with a particular outfit is not sufficient to result in a finding of complementarity. In the same case, the GC stated:

“59 Furthermore, according to the case-law, aesthetic complementarity between goods may give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 207/2009. Such aesthetic complementarity must involve a genuine aesthetic necessity, in the sense that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use those products together. That aesthetic complementarity is subjective and is determined by the habits and preferences of consumers, to which producers’ marketing strategies or even simple fashion trends may give rise (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 51 and the case-law cited).

60 However, it is important to point out that the mere existence of aesthetic complementarity between the goods is not sufficient to conclude that there is a similarity between them. For that, the consumers must consider it usual that the goods are sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same (see judgment in *Emidio Tucci*, cited in paragraph 48 above, EU:T:2012:499, paragraph 52 and the case-law cited).”

94. I do not, therefore, consider that there is any similarity between the opponent’s goods and the applicant’s goods in class 3 and class 14. As some degree of similarity is required for there to be a likelihood of confusion<sup>3</sup>, the opposition must fail in respect of these goods.

95. “Travelling bags” in the opponent’s specification could be made of a number of materials, including leather. These, therefore, could fall within the broader categories of “leather bags and wallets” and “leather bags, suitcases and wallets” in the applicant’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*. “Leather handbags” in the applicant’s specification are

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<sup>3</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

generally smaller than the opponent's "travelling bags". However, they have the same users, uses and method of use. There may be some overlap in trade channels. I, therefore, consider these goods to be highly similar. "Leather credit card wallets", "leather pouches" and "leather purses" are all intended to hold specific small items such as money and could not properly be described as 'bags'. Their users will be the same and there will be overlap in trade channels. I therefore consider these goods to be similar to no more than a medium degree.

96. As noted above, the applicant has indicated that the use of commas in the opponent's specification means that it should be read as "clothing...for sports", "headgear...for sports" and "technical footwear for sports". I agree with the applicant. "Shirts" and "tops" in the applicant's specification will fall within the broader category of "clothing...for sports" and are therefore identical on the principle outlined in *Meric*. "Women's clothing, namely, shirts, dresses, skirts, blouses" in the applicant's specification shares a degree of overlap with "clothing... for sports" in the opponent's specification. Shirts, dresses and skirts can clearly all be sportswear (with skirts and dresses often being worn by women to play tennis, for example). However, blouses are less clearly within this category. In my view, these goods are likely to be considered identical on the principle outlined in *Meric*, but if I am wrong in this finding, then they will at the very least be highly similar as there will be a significant overlap in their users, uses, method of use and trade channels. "Scarves" in the applicant's specification are not commonly worn for sport. However, there is some overlap in purpose, users and trade channels. Their primary use will be the same (to cover the body). I consider these goods to be similar to a medium degree.

97. Even if I am wrong in finding that the opponent's specification should be limited to sports clothing then this would not have changed the outcome of my comparison of the parties' specifications.

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

98. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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 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.”

99. In its written submissions, the opponent states:

“22. The average consumer for the contested goods is the general public. We submit that there will be a normal level of attention to be paid by the consumer when selecting such goods. Even in the event that a higher level of attention is paid, the marks themselves do not contain sufficient differences to allow the consumer to differentiate between them.”

100. In its written submissions, the applicant states:

“76. It is submitted that the average consumer for the relevant goods will be the public at large. None of the goods are particularly specialised.

77. it is submitted that the average consumer will not do more than give an average degree of attention to the origin of the goods, save that where the goods are more expensive, the average consumer is liable to pay closer attention.

78. The Applicant accepts, however, that the registration does not specify that it is for higher priced goods and that, accordingly, the price of the goods is not liable to be of relevance for the purposes of the Opposition.



79. Since the goods are consumer goods, they are liable to be chosen based on a visual consideration of the signs and, since the goods may be purchased on the basis of word of mouth recommendation, aural consideration is also important.

80. The average consumer will also be familiar with the wide range of brands offering goods such as those in classes 3, 14, 18 and 25 for which registration is sought. The average consumer will be familiar with the need to pay attention to subtle differences in brands to ensure the origin of the goods being sold.”

101. The average consumer for the goods in issue will be a member of the UK general public. These purchases are likely to vary in cost depending on the nature of the specific goods being purchased. For the same reason, they will vary in frequency of purchase. The level of attention paid by the average consumer during the purchasing process will be at least average.

102. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods given that advice may be sought from a sales assistant.

### **Comparison of trade marks**


103. 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 mark must be assessed by reference to the overall impressions created by the trade 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.”

104. 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 impression created by the marks.

105. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
ALEX	ALEX AND ANI 

106. I have lengthy submissions from both of the parties on the similarity of the marks. Whilst I do not propose to reproduce those submissions here, I have taken them into account in reaching my decision.

107. The opponent's mark consists of the four-letter word ALEX. There are no other elements to contribute to the overall impression, which is contained in the word itself. The applicant's mark consists of the words ALEX AND ANI. The words are followed by a heart which the applicant states is presented in the style of the American flag. The overall impression lies in the combination of the wording and the heart device, with the wording playing a greater role and the heart device playing a lesser role.

108. Visually, the applicant's mark starts with the word ALEX, which is the sole element of the opponent's mark. As a general rule, the beginnings of marks tend to make more impact than the ends<sup>4</sup>. The difference between the marks lies in the addition of the words AND ANI and the heart device in the applicant's mark. Notwithstanding the

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<sup>4</sup> *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

common first word, I consider the marks to share a no more than medium degree of visual similarity.

109. Aurally, the word ALEX will be given its ordinary English pronunciation and will be pronounced identically in both marks. The differences between the marks lies, again, in the addition of the words AND ANI. The consumer will not, of course, pronounce the heart device. I consider there to be a medium degree of aural similarity between the marks.

110. Conceptually, the word ALEX, present in both marks, is a common shortening of the well-known male first name Alexander and of the well-known female name Alexandra. The word ANI in the applicant's mark is also likely to be viewed as a name, particularly as it follows the recognisable name ALEX. This is likely to be seen as an alternative spelling for the well-known English female first name Annie. The marks share some conceptual similarity to the extent that they both refer to the name ALEX. However, the opponent's mark refers to only one name (or person) whereas the applicant's mark refers to two, giving the impression of two distinct people. If the heart device is recognised as depicting the American flag then it may convey a conceptual message of love for the United States or of goods that are from the United States. This will create a further point of difference between the marks. If not, then it will add very little to the conceptual meaning conveyed by the applicant's mark. In either case, there remains a low degree of conceptual similarity between the marks.

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

111. 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 promotion of 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)."

112. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

113. The opponent claims that the distinctiveness of its mark has been enhanced through use. However, enhanced distinctiveness must be established in relation to the UK market because the test for confusion will be assessed by reference to the average consumer who is a member of the UK general public. It is the opponent's own case that it has only used its mark in Germany and Austria and no evidence has been provided to suggest that the opponent has a customer base in the UK or that UK consumers would be aware of its mark. The earlier mark cannot, therefore, have acquired any enhanced distinctiveness in the UK through use.

114. I can, therefore only consider the inherent distinctiveness of the earlier mark. I must consider the inherent distinctiveness of the earlier mark as a whole. The earlier mark consists of the name ALEX and does not allude to the goods in issue. The name ALEX is a fairly common name. This is supported by the evidence of the applicant. In *Becker v Harman International Industries*, Case C-51/09 P, the distinctive character of a surname was considered and the CJEU stated as follows:

“Although it is possible that, in part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate to take account of factors specific to the case and, in particular, to the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character.”

115. Although this case concerned surnames, the same reasoning can be applied to forenames; that is, the more common the forename the lower the distinctive character of the mark. In this case, the only element of the opponent’s mark is a relatively common English name. I therefore consider that the opponent’s mark has no more than an average degree of inherent distinctive character.

### **Likelihood of confusion**

116. 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 the marks 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 opponent’s trade mark, the average consumer of the goods 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.

117. I have found there to be no more than a medium degree of visual similarity between the marks. I have found the parties’ marks to be aurally similar to a medium degree and conceptually similar to a low degree. I have found the earlier mark to have no more than an average degree of inherent distinctive character. I have identified the

average consumer to be a member of the general public who will select the goods primarily through visual means (although I do not discount an aural component). I have concluded that at least an average degree of attention will be paid during the purchasing process. I have found the parties' goods to be identical, highly similar or similar to a medium degree (except for those which I have found to share no similarity at all).

118. I consider that the visual, aural and conceptual differences between the marks are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. I am satisfied that there is no risk of direct confusion.

119. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

120. The applicant has referred me to the judgment of the GC in *Giovanni Cosmetics, Inc v OHIM*, Case T-559/13, in which it stated:

“117. It should be noted that the presence of the same Italian first name, which is not perceived as either common or rare, in trade marks covering cosmetic preparations and perfumery does not always permit a conclusion that there is

a likelihood of confusion: in a situation involving a first name which the relevant public does not regard as rare, that public will not expect only one producer to use that name as an element of a trade mark.”

121. Whilst that case was fact specific (and those facts differed to those in the present case), I acknowledge the point that the applicant seeks to make; that is, that such a common name appearing in the marks will not lead the consumer to believe the goods come from the same or economically linked undertakings. Bearing in mind my conclusions listed at paragraph 117 above, I agree with the applicant and do not consider that the average consumer would expect that the goods would be provided by the same or economically linked undertakings. There is no evidence that it is common practice for clothing brands which use a name as their trade mark to extend their brand by adding an additional person’s name. The average consumer is far more likely to view these marks as simply referring to two different people, who happen to both be called Alex, particularly as Alex is a common English name. A finding of confusion should not be made merely because two marks share a common element; it is not sufficient that one mark merely calls to mind the other<sup>5</sup>. I do not consider there to be a likelihood of indirect confusion.

## **CONCLUSION**

122. The opposition has been unsuccessful and the application will proceed to registration.

## **COSTS**

123. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1200 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering	£200
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<sup>5</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

the opponent's statement

Preparing evidence and considering the opponent's evidence	£600
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Preparing two sets of written submissions	£400
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<b>Total</b>	<b>£1200</b>
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124. I therefore order SIGNA Sports IPCo GmbH to pay ALEX AND ANI, LLC the sum of £1200. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 4<sup>th</sup> day of December 2018**

**S WILSON**

**For the Registrar**