

BL O-651-21

TRADE MARKS ACT 1994

IN THE MATTER OF AN INTERNATIONAL REGISTRATION DESIGNATING THE

UNITED KINGDOM NO. 1541442

BY JOYWANT LLC

TO REGISTER:

JOYWANT

AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 421749

BY JOY SPORTSWEAR GMBH

BACKGROUND & PLEADINGS

1. On 24 June 2020, Joywant LLC (“the applicant”) designated the United Kingdom seeking protection of the trade mark shown on the cover page of this decision for the following goods in class 25:

Berets; Cap visors; Collars; Hats; Headwear; Scarfs; Shawls; Skull caps; Top hats; Turbans.

The designation was published for opposition purposes on 14 August 2020.

2. On 13 October 2020, the designation was opposed in full by JOY Sportswear GmbH (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:

(1) European Union Trade Mark (“EUTM”) no. 12182606 for the words “**JOY sportswear**” which was filed on 30 September 2013 and entered in the register on 24 February 2014. The opponent relies upon “Clothing” in class 25;

(2) International Registration designating the European Union (“IREU”) no. 1086418 for the trade mark:



This trade mark was filed on 6 July 2011 and entered in the register on 16 September 2013. The opponent relies upon “Clothing” in class 25;

(3) IREU no. 1188965 for the trade mark:



This trade mark was filed on 27 August 2013 (claiming an International Convention priority date of 1 March 2013 from an earlier filing in Germany) and entered in the register on 11 November 2014. The opponent relies upon "Clothing" in class 25.

3. The opponent states that in the five year period ending on the date of the designation in the UK, its trade marks had been used in relation to the goods mentioned above.

4. The applicant filed a counterstatement in which the basis of the opposition is denied.

5. In these proceedings, the opponent is represented by Kilburn & Strode LLP and the applicant by Greaves Brewster LLP. Only the opponent filed evidence. Although neither party requested a hearing, the opponent elected to file written submissions in lieu of attendance. I will bear these submissions in mind, referring to them to the extent I consider appropriate later in this decision.

6. 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 on 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

7. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

8. The trade marks being relied upon by the opponent qualify as earlier trade marks under the provisions of section 6 of the Act. As these earlier trade marks had been protected for more than five years at the date of the designation, they are subject to the proof of use provisions. As I mentioned earlier, in its Notice of opposition the opponent stated it had used its trade marks in relation to “Clothing” in class 25 and, in its counterstatement, the applicant asked the opponent to make good on that claim.

Proof of use

Section 6A:

9. This reads 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), (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 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) In relation to a European Union 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.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

10. In reaching a conclusion, I must apply the same principles as I would if I were considering an application for revocation based upon non-use. The relevant five-year period is 25 June 2015 to 24 June 2020.

11. I begin by reminding myself that section 100 of the Act reads:

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

12. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on 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].”

13. The earlier trade marks being relied upon consist of an EUTM and two IREUs. As a consequence, 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 also relevant i.e.

“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).”

The court held that:

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

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

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

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that “genuine use in the Community will in general require use in more than one Member State” but “an exception to that general requirement

arises where the market for the relevant goods or services is restricted to the territory of a single Member State”. On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon’s analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

15. The General Court (“GC”) restated its interpretation of *Leno Marken* 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.

16. 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/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

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

The opponent's evidence

17. This consists of a witness statement, dated 10 March 2021, from Reiner Unkel, the opponent's CEO, a position he has held since October 2020. Mr Unkel explains that the opponent was founded in 1977 and, in 1979, became "the first German brand manufacturer to introduce jogging tracksuits onto the German market under the trade mark JOY SPORTSWEAR." By 1990, the opponent was, he states, "the market leader in Germany for individual jogging clothing items under the trade mark "JOY SPORTSWEAR"". He further states:

"1...Today, my company manufactures and distributes products under the trade mark JOY SPORTSWEAR, including in word and figurative form, in Germany and throughout the EU in respect of a wider range of sports and leisurewear..."

18. Mr Unkel explains that: "The brand "JOY SPORTSWEAR" is used in connection with sportswear clothing." Exhibit 1 consists of pages from the opponent's website www.joy-sportswear.de. The pages provided all contain trade mark no. 3 at the top of the page. The goods shown are t-shirts, leisure pants, shorts and jackets. All of the goods are priced in Euros. As far as I can tell, none of the pages are dated.

19. Exhibit 2 consists of what Mr Unkel describes as:

"5...photographs of articles of clothing produced by my company during the period 2015-2019. The photographs show the labels of articles of clothing such as shirts, sweatpants, and training jackets, which display the JOY SPORTSWEAR Marks. I note that the photographs are only examples because the range of products of my company is wide. Other articles of clothing that my company has sold are labelled in the same way."

20. The pages provided show trade mark no.1 (also shown in the format "JOY SPORTSWEAR"), "Joy sportswear GmbH" and trade mark no. 3 being used on the goods mentioned by Mr Unkel. The shirts appear to be either t-shirts or polo shirts.

21. Mr Unkel states:

“6. The articles are labelled with a hang tag that bears the JOY SPORTSWEAR Marks, and also have at least one textile tag which is normally sewn into the article. Some shirts have a textile print of the JOY SPORTSWEAR Marks at the back. Further, the polo shirts produced by my company also bear the JOY SPORTSWEAR Marks on the buttons.”

22. Exhibit 3 consists of photographs of hang tags used by the opponent since 2015. All of the hang tags bear trade mark no. 3 as well as containing references to “Joy sportswear GmbH” and www.joy-sportswear.de. Exhibit 4 consists of undated photographs of sports socks which Mr Unkel explains are “available in June and November during my company’s stock sales.” The sock bear the words “JOY SPORTSWEAR.”

23. Exhibit 6 consists of a “poster advertisement” (dating from August 2015) from a “German point of sale” in which trade mark no. 3 can be seen and in which the models can be seen wearing what Mr Unkel describes as “sports bras (underwear).”

24. Exhibit 7 consists of a booklet entitled “Company. Product. Brand”; the booklet is in English and German. Trade marks nos: 1 and 3 can be seen throughout the booklet. This booklet has, states Mr Unkel, been “given to the customers of my company in Europe since 2016.” Mr Unkel states that the booklet includes references to, inter alia, “trousers, tops and other clothing articles in the field of sportswear and casualwear”, “trousers and tops for men and women”, “photos of some of our points of sales”, includes references to around 750 points of sale in Germany and refers to the opponent’s trading partners in Germany.

25. Exhibit 8 consists of a booklet produced in 2016 entitled “PASST – The JOY sportswear brand booklet.” Trade marks nos. 1 and 3 can be seen throughout the booklet.

26. Exhibit 5 and exhibits 9 to 15 consist of product catalogues “for German customers” for the periods Autumn/Winter 2014, Spring/Summer 2016,

Autumn/Winter 2016, Spring/Summer 2017, Autumn/Winter 2017, Spring/Summer 2018 and Autumn/Winter 2018/2019, the front and back covers of which bear trade mark no. 3. Considered collectively, Mr Unkel states these catalogue contain references to “trousers, jackets, t-shirts, polo shirts, shorts, vests, shirts, leggings, sportswear and shapewear for men and women and sports bras (underwear).”

27. Exhibit 16 consists of what Mr Unkel describes as a “campaign flyer to promote the JOY SPORTSWEAR Marks”, adding that the “campaign was introduced in certain points of sales in Germany” in 2019. The pages provided bear trade mark nos. 1 and 3. Exhibit 17 is an advertisement published in 2019 in the weekly German journal “Bild Der Frau” for the advertising campaign shown in exhibit 16. The advertisement was, he states, also published in the weekly German journals “Tina”, “Bella” and “Laura.” Trade mark nos. 1 and 3 appear in the advertisement.

Assessment of the opponent’s evidence

28. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated:

“22. The burden lies on the registered proprietor to prove use...However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

And further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

29. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question,

and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

30. I begin by reminding myself that (i) the relevant period in which proof of use must be established is 25 June 2015 to 24 June 2020, and (ii) that as the earlier trade marks being relied upon are an EUTM and IREUs, the relevant market is the European Union.

31. In its written submission, the opponent states:

“14xii)...We note that Mr Unkel’s Witness Statement did not specify the financial turnover of goods sold under the earlier marks relied on in these proceedings. The Opponent was not comfortable providing such information which was commercially sensitive and not publicly available.”

32. Although the evidence has not been challenged by the applicant, it is far from perfect. Not only does the opponent not provide any evidence of any sales made under the trade marks relied upon, it has not provided, for example, any evidence of the quantity of goods sold or the amounts it has spent promoting its trade marks. The evidence does, however, include a range of product catalogues from as early as Autumn/Winter 2014 which target the German market and which continue throughout the relevant period. It also shows that from as early as 2016, the opponent had 750 points of sale in Germany and a list of its trading partners in Germany is provided.

Although I can find no evidence of the use of trade mark no.2, the evidence contains numerous examples of trade mark no. 3 and, to a lesser extent, trade mark no. 1 in use within the relevant period. As trade mark no. 1 is presented in a standard typeface, even if use of trade mark no. 2 had been provided, it would place the opponent in no better position.

33. Despite its various shortcomings, having applied the above case law, I am satisfied that when considered as a totality, the use the opponent has made of trade marks nos. 1 and 3 in Germany within the relevant period is sufficient to constitute genuine use. As to the goods upon which these trade marks have been used, Mr Unkel describes them as:

Trousers, jackets, t-shirts, polo shirts, shorts, vests, shirts, leggings, sportswear, and shapewear for men and women and sports bras (underwear).

What constitutes a fair specification?

34. As I agree that is a fair reflection of the goods shown in its evidence, I must now decide what constitutes a fair specification. 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.”

35. 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.”

36. In its written submissions, the opponent states:

“15. It is clear from the evidence that the Opponent has used the earlier marks in connection with a wide range of clothing items. We submit that the Office should consider that the scope of protection be afforded to the term “clothing” as a whole, without need to further filter the items of specific clothing which have been identified in the Witness Statement.”

37. While I accept that the opponent has used trade marks nos. 1 and 3 in relation to the goods identified in paragraph 33 above, as the evidence shows and as Mr Unkel appears to accept, they have only been used for a “range of sports and leisurewear”. Having applied the above case law, that use is not, in my view, sufficient for the opponent to retain the term “clothing” at large, which would, of course, include all types of clothing including, for example, formalwear such as evening gowns and tuxedos. Bearing all of the above in mind, a fair specification that reflects how the average consumer would describe the opponent’s use is, in my view, “Sportswear; casualwear”. It is on the basis of that specification that I shall conduct the comparison which follows.

Case law

38. The following principles are gleaned from the decisions of the courts of the European Union 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 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 the earlier mark to mind, is not sufficient;

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

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

Comparison of goods

39. The goods to be compared are as follows:

The opponent's goods (following the proof of use assessment)	The applicant's goods
Class 25 – Sportswear; casualwear.	Class 25 – Berets; Cap visors; Collars; Hats; Headwear; Scarfs; Shawls; Skull caps; Top hats; Turbans.

40. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

41. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

42. 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."

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

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

44. In its written submissions, the opponent states:

“31. Even if the Office was to consider the earlier rights only in respect of a narrower range of clothing, reflecting the evidence of use...then the goods would still be similar overall; all being items for clothing one’s body. The Goods are, at the very least, complementary.”

45. The applicant’s specification includes (i) goods which would either be regarded purely as headwear i.e. Berets; Cap visors; Hats; Headwear; Skull caps; Top hats; Turbans, (ii) goods which may be used as headwear but which have other uses i.e. Scarfs and Shawls”, and (iii) “Collars”.

46. Insofar as the applicant’s berets, cap visors, hats, headwear, scarfs, shawls and skull caps are concerned, there is likely to be an overlap in, at least, the nature, users and trade channels between such goods and those of the opponent following the proof of use assessment. Despite the opponent’s submissions, such goods are, however, unlikely to be complementary (at least not in the sense outlined in the case law) and there is no meaningful competitive relationship in play. Considered overall, I regard such goods as being similar to the opponent’s goods to a medium degree. However, while the nature and users may overlap, given (i) the very specific intended purpose of collars, top hats and turbans (ii), the absence of any complementary or competitive relationship and, (iii) the likely differences in trade channels between such goods and those of the opponent, there is, in my view, no meaningful degree of similarity between such goods and those of the opponent following the proof of use assessment.

47. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

48. Proceeding on that basis, the opposition to “collars”, “top hats” and “turbans” in the application fails and is dismissed accordingly.

The average consumer and the nature of the purchasing act

49. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods I have found to be similar. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

50. In its written submissions, the opponent states:

“20. The average consumer in this case will be a member of the general public. The goods may be purchased in a high street store, or online via the internet or by mail order. The goods will be selected from a primarily visual

perspective, although there may be an aural aspect to the selection process given that some goods may be selected or recommended aurally. The goods will vary in cost and the level of attention paid by the consumer would be reasonable.”


51. I agree with the majority of the opponent’s submissions. However, if by referring to a “reasonable” level of attention being paid during the selection process it meant at least a normal or (medium) degree of attention, then I also agree. Irrespective, it is on that latter basis I shall proceed.

Comparison of the trade marks

52. 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 them, 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.”

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

Opponent's trade marks	Applicant's trade mark
<p>1. JOY sportswear & 3.</p> 	<p>JOYWANT</p>

Overall impression

The opponent's trade marks

54. Although the word "sportswear" will contribute to the overall impression conveyed by both trade marks, as it is, self-evidently, wholly descriptive, that contribution will not be a distinctive one. It is the word "JOY" presented in block capital letters in trade mark no. 1 that will dominate the overall impression conveyed and it is in that word the distinctiveness lies. Insofar as trade mark no.3 is concerned, although given its size and positioning the distinctive device component will make a modest contribution to the overall impression conveyed, it is the word "JOY" presented in a slightly stylised but unremarkable bold font that will make by far the greatest contribution to the overall impression conveyed and it is in that word the majority of the distinctiveness lies.

The applicant's trade mark

55. The applicant's trade mark consists of a single word presented in upper case letters. Although no part of the trade mark is highlighted or emphasised in any way, it will not go unnoticed by the average consumer that it is formed by the joining of two very well-known English language words i.e. "JOY" and "WANT." Although the overall impression conveyed by the trade mark and its distinctiveness lies in its totality, as the word "JOY" appears as the first part of the trade mark, it is that word

which the average consumer is likely to notice first. I will bear the above conclusions in mind when conducting the comparison which follows.

Visual similarity

56. All of the trade marks at issue contain the word “JOY” presented in upper case letters. Bearing in mind my earlier comments on the role “sportswear” plays in the opponent’s trade marks, I note that the device component in trade mark no. 3 and the word “WANT” are alien to the other party’s trade marks. Weighing the similarities and differences, in particular, the fact that the word “JOY” appears as the first part of the applicant’s trade mark, it results in what I regard as a medium degree of visual similarity with trade mark no. 1 and a slightly lower degree of visual similarity with trade mark no. 3.

Aural similarity

57. As I mentioned earlier, the words in the competing trade marks will be well-known to the average consumer. As a consequence, how they will be verbalised is predictable. In addition, it is well-established that when a trade mark consists of a combination of words and figurative components, it is by the word component(s) the trade mark is likely to be referred to. Proceeding on that basis and as the descriptive word “sportswear” in the opponent’s trade marks is, in my view, most unlikely to be articulated by the average consumer when referring to the opponent’s trade marks, they will be referred to by the single syllable word “JOY”, whereas the applicant’s trade mark will be referred to by the two syllable combination “JOY-WANT.” Although the second syllable in the applicant’s trade mark is absent from the opponent’s trade marks, as the word “JOY” will be either the only or first word articulated respectively, it results in what I regard as a medium degree of aural similarity between the competing trade marks.

Conceptual similarity

58. While the device component in trade mark no. 3 is unlikely to evoke any concrete concept in the mind of the average consumer, the word “JOY” in the opponent’s

trade marks is likely to evoke either the concept of “a feeling of great happiness” (collinsdictionary.com refers) or may be construed as a feminine forename. Although when considered as a totality, the applicant’s trade mark is unlikely to create a concrete conceptual picture in the average consumer’s mind, the individual words of which it is composed are, insofar as the word “JOY” is concerned, likely to evoke the same concepts it does in the opponent’s trade marks, whereas the word “WANT” will evoke the concept of having a “desire or need” for something. To the extent that all the trade marks are likely to evoke the concepts relating to “JOY” I have mentioned, they are conceptually similar to a medium degree.

Distinctive character of the earlier trade marks

59. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings – *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

60. Although the opponent has filed evidence to satisfy the proof of use requirement, as that evidence discloses no use in the United Kingdom, it is only the inherent distinctiveness of the earlier trade marks that I have to consider. As I explained earlier, the word “sportswear” in the earlier trade marks is descriptive. Although the device component in trade mark no.3 is distinctive (making that trade mark more distinctive than trade mark no. 1), as I have already concluded that it is in the word “JOY” in the earlier trade marks all or the majority of the distinctiveness lies, it is upon that word I shall focus. Whether considered as either a feminine forename or on the basis of the dictionary definition mentioned earlier, as the word is neither descriptive of nor non-distinctive for the goods upon which it has been used, it is possessed of a medium degree of inherent distinctive character.

Likelihood of confusion

61. In determining whether there is a likelihood of confusion, 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 vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

62. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

63. 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.”

64. Earlier in this decision, I concluded that:

- following the proof of use assessment, I would conduct the comparison on the basis of a specification for the opponent reading “sportswear; casualwear”;
- the remaining goods in the application i.e. berets, cap visors, hats, headwear, scarfs, shawls and skull caps are similar to the opponent’s goods (following the proof of use assessment) to a medium degree;
- the average consumer is a member of the general public who, while not ignoring aural considerations, will select the goods at issue by predominantly visual means whilst paying at least a medium degree of attention during that process;
- the applicant’s trade mark is visually similar to trade mark no. 1 to a medium degree (and to a slightly lower degree to trade mark no. 3) and aurally and conceptually similar to a medium degree;
- the word “JOY” in the opponent’s trade marks is possessed of a medium degree of inherent distinctiveness.

65. In its written submissions, the opponent states:

“40. It is generally understood that the average consumer is unlikely to compare marks side by side. A consumer must deal with their imperfect recollection when attempting the purchasing process. There is a likelihood of direct confusion for consumers when faced with the JOYWANT mark, believing it to be the JOY Sportswear brand of the Opponent. The differences between the marks are insufficient to avoid the marks being potentially mistaken for one another. The dominance of the JOY element in the earlier mark leads to the prospect that consumers may make a connection between the respective marks and lead to a conclusion that the goods of one party originated from or are connected to the other. The consumer may consider

that the respective marks come from economically connected entities. Further, or in the alternative, if direct confusion is not found, there is the possibility of indirect confusion, whereby a consumer might recognise differences between the respective marks but takes note of the commonality of the shared distinctive word JOY. This may lead consumers to conclude that the opposed mark is another brand of the owner of the earlier trade mark. Such indirect confusion can be compounded when goods are referred to aurally, but particularly if the consumer uses the word “want” in normal parlance, such as “I want a JOY Sportswear t-shirt”. Imperfect recollection, combined with a consumer juxtaposing the word elements in a sentence may aid to the prospect of indirect confusion on the part of the consumer.” (my emphasis).

66. Notwithstanding the opponent’s argument in relation to direct confusion, even in relation to trade mark no. 1, I think the presence in the applicant’s trade mark of the word “WANT” is, given the at least medium degree of attention that will be paid by the average consumer during the purchasing process (which is likely to make him/her less prone to the effects of imperfect recollection), unlikely to go unnoticed. That conclusion is even stronger in relation to trade mark no. 3 which also includes a device component. The prospect of direct confusion is, in my view, remote.

67. However, in relation to the remaining goods in the application, the fact that the word “JOY” appears as the first part of the applicant’s trade mark (and the degree of visual, aural and conceptual similarity this creates) is, for essentially the reasons the opponent suggests above which I have underlined, likely to result in indirect confusion with, in particular, trade mark no. 1. Although trade mark no. 3 is less similar from a visual perspective, as the word “JOY” will make by far the greatest contribution to both the overall impression conveyed and the trade mark’s distinctiveness, I reach the same conclusion. As indirect confusion is sufficient, the opposition to the remaining goods in the application succeeds.

Overall conclusion

68. The opposition has succeeded in relation to all the goods in the application with the exception of “collars”, “top hats” and “turbans”. Subject to any successful appeal, the application will be refused to the extent indicated.

Costs

69. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Although both parties have achieved a measure of success, the opponent has been substantially more successful than the applicant. Applying the guidance in the TPN mentioned, but making a reduction (calculated on a “rough and ready” basis) to what I would otherwise have awarded to the opponent to reflect the measure of the applicant’s success, I award costs to the opponent on the following basis:

Filing the Notice of opposition and reviewing the counterstatement:	£210
Official fee:	£100
Filing of evidence:	£560
Written submissions:	£280
Total:	£1150

70. I order Joywant LLC to pay to Joy Sportswear GmbH the sum of **£1150**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of September 2021

C J BOWEN

For the Registrar