

o/738/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003632025

BY KAWISH ALI SIDDIQUI

TO REGISTER THE TRADE MARK:

A stylized logo consisting of the lowercase letters 'ajee' in a grey, rounded, sans-serif font. The 'a' is a circle with a vertical bar on the right side. The 'j' is a vertical bar with a small hook at the bottom. The 'e' is a rounded shape with a horizontal bar at the bottom. The second 'e' is identical to the first.A stylized logo consisting of the lowercase letters 'ajee' in an orange, rounded, sans-serif font. The 'a' is a circle with a vertical bar on the right side. The 'j' is a vertical bar with a small hook at the bottom. The 'e' is a rounded shape with a horizontal bar at the bottom. The second 'e' is identical to the first.

(SERIES OF 2)

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 427517

BY A.P.G. S.R.L.

BACKGROUND AND PLEADINGS

1. On 25 April 2021, Kawish Ali Siddiqui (“the applicant”) applied to register the series of 2 trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 16 July 2021. The applicant seeks registration for the following goods:

Class 25 Clothing; Clothes; Tops [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Knitwear [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Outer clothing; Women's clothing; Embroidered clothing; Jackets [clothing]; Capes (clothing); Woolen clothing; Ladies' clothing.

2. The application was opposed by A.P.G. S.R.L. (“the opponent”) on 14 October 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:



UK registration no. UK00911858354

Filing date 30 May 2013; registration date 10 October 2013.

(“the First Earlier Mark”)



International trade mark no. 1536537

International registration date 4 May 2020

Date of designation 4 May 2020

Date of protection granted in the UK 28 January 2021

(“the Second Earlier Mark”)

3. Under section 5(2)(b), the opponent only relies upon some of its goods for which its First Earlier Mark is registered, and all of the goods for which its Second Earlier Mark is registered, as underlined in the Annex to this decision. The opponent claims that due to the high similarity between the marks and the identity/high similarity between the goods, there exists a likelihood of confusion.

4. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Reddie & Grose LLP and the applicant is unrepresented. The opponent filed evidence in chief. Neither party requested a hearing, but both parties filed submissions in lieu. This decision is taken following a careful perusal of the papers.

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.

EVIDENCE

7. The opponent’s evidence consists of the witness statement of Alessia Piccolo dated 29 March 2022. Ms Piccolo is the Managing Director of A.P.G. S.R.L. Ms Piccolo’s statement was accompanied by 8 exhibits.

8. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties’ submissions into consideration in reaching my decision and will refer to it where necessary below.

DECISION

9. Section 5(2)(b) 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.”

10. 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 ... or international trade mark (UK) ... which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or

protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]"

11. Section 6A of the Act states:

“(1) This section applies where

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

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

12. As the First Earlier Mark is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9.— (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the “five-year period”) has expired before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.

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

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union”.

13. The opponent’s marks qualify as earlier marks in accordance with section 6(1)(a) and 6(1)(ab) as their filing dates are earlier dates than the applicant’s mark. As the Second Earlier Mark had not completed its registration process more than 5 years before the filing date of the mark in issue, it is not subject to proof of use pursuant to section 6A(1) and (1A) of the Act.

14. As the First Earlier Mark had completed its registration process more than five years before the application date of the mark in issue, and as requested by the applicant its counterstatement, it is subject to proof of use pursuant to section 6A(1) and (1A) of the Act.

Proof of use

15. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the application in issue i.e. 26 April 2016 to 25 April 2021.

16. The relevant provisions about proof of use in opposition proceedings are contained in section 6A of the Act, which I have set out above. 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.”

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

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken 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].”

Form of the mark

18. 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 Court of Justice of the European Union (“CJEU”) found that (my emphasis):

“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)

19. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

20. Where the opponent's First Earlier Mark has been used as registered this will, clearly, be use upon which the opponent can rely.

21. The opponent has also used the First Earlier Mark in the following variants:



22. I note that the additional elements are a black background, the font being presented in the colour yellow, and the Italian flag coloured line underneath the mark. I do not consider that any of these elements alters the distinctive character and therefore I consider that the above variants are acceptable use of the mark as registered.

23. I also note that the First Earlier Mark has also been used in the following variants:



24. I note that the "a" device which is a part of the First Earlier Mark is replicated above the "aLE" wording. In the first variant I note that the wording "Italian way" is presented underneath, and in the second variant, the "aLE" wording is presented vertically

alongside the “a” device. I consider that both variants are acceptable use of the mark because aLE will continue to be perceived as indicative of the origin and it still continues to have an independent distinctive role.¹

Sufficient/genuine use

25. 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.²

26. 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”.

27. As the First Earlier Mark relied upon is a UKTM, I must consider the UK as the market in which the opponent is required to show genuine use.

28. However, I note that as the opponent’s First Earlier Mark is a comparable mark it is possible for the opponent to rely on evidence of use in the EU as set out in Tribunal Practice Notice 2/2020.³ Furthermore, I also note that part of the relevant period, before completion day, i.e. 31 December 2020, the EU will be taken to include the UK.

29. I note that from Ms Piccolo’s witness statement, the opponent launched the brand ALÉ in 2014. However, **exhibit 1**, which is a screenshot from the opponent’s website, states that the brand was launched in 2013. I note that this exhibit also highlights that the opponent is a cycling clothing specialist based in Italy. ALÉ also is a “sponsor to a wide network of professional cycling and triathlon teams” and has produced technical

¹ As per *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

² *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

³<https://www.gov.uk/government/publications/tribunal-practice-notice-22020-end-of-transition-period-impact-on-tribunal-proceedings/tribunal-practice-notice-22020-end-of-transition-period-impact-on-tribunal-proceedings>

cycling clothing for some of the most prestigious WorldTour teams including Groupama FDJ and Movistar.

30. Ms Piccolo states that the opponent has made a turnover of £4,666,278.79, and sold 207,426 items on the goods bearing the UK national registration in the UK during the relevant period. I note that this is supported by **exhibit 2** whereby this figure is presented as the following:

Canale	GS	GRUPPO SPORTIVO		
3021732	ZAPPI RACING TEAM LTD	56	2.609,60	0,00
Totale Canale	GS	56	2.609,60	0,06
Totale Nazione	GB	207.426	4.666.278,79	0,00
Totale Generale		207.426	4.666.278,79	0,00

31. I also note that this exhibit is written in Italian, and that the breakdown of the sales are by the name of the consumer and not by the goods.

32. The opponent sells its goods through its UK distributor Paligap Limited who then distributes to other online retailers. The opponent's main online sports retailer in the UK is Wiggle, which has offered ALÉ goods since 2013. I note that **exhibit 3** shows the following screenshots from Wiggle's ALÉ page:

- A screenshot dated 20 November 2016. It shows men and women's clothing categories. It also lists other categories including base layers and thermals, clothing accessories, gloves, headwear, jackets, jerseys and tops, shorts and socks. The opponent's First Earlier Mark is clearly displayed on this page, as well as on the cycling clothing photos.
- A screenshot dated 20 November 2017 showing the above, however, it also lists tights and trousers as clothing sold under the ALÉ mark.
- A screenshot dated 26 June 2018. The opponent's First Earlier Mark is presented at the top of the page, and I note that the only categories presented on this page is men's, women's and accessories.

- A screenshot dated 22 October 2019. Again, the opponent's First Earlier Mark is presented at the top of the page, and I note that the only categories presented on this page is men's, women's and accessories.
- A screenshot dated 6 August 2020. The only categories presented on this page is men's, women's and accessories. I also note that under filtering for ALÉ, the page shows 350 results.
- A screenshot dated 8 February 2021. This page only shows the opponent's First Earlier Mark on a banner at the top of the page and advertises the Autumn/Winter 2020 collection.

33. **Exhibit 4** contains clothing catalogues which were in circulation in the UK during the relevant period. I note that the following goods are listed and presented within these:

Summer collection 2016

- Master jersey
- Roadster new strada skinsuit
- Bermuda bibshorts
- Avversario jersey
- Logo bibshorts
- Veloce jersey
- Elba top (triathlon)
- Elba sleeveless jersey (triathlon)
- Elba shorts (triathlon)
- Water resistant shoecover
- Aerolight summer shoecover
- Velocissimo crono glove
- Summer Qskin 8/12 unisex socks
- Linea ALÉ 2014 Italia polo shirt
- ALÉ bag

34. All of the above goods clearly display the opponents First Earlier Mark and have their own article codes.

Summer 2017

- B.B. Black Bibs Bibshorts
- Agonista bibshorts and shorts
- Master jersey
- Sprinter jersey
- Logo bibshorts
- Veloce jersey
- Radical bibshorts
- Long tri record body front zipper (triathlon)
- Olympic tri record body back zipper (triathlon)
- Record sleeveless jersey (triathlon)
- Record shorts (triathlon)
- Record top (triathlon)
- Sempre testa leggera earband
- Podio cap
- ALÉ cotton cap
- Verona summer cap
- Socks (unisex)
- Pantaloni bibshorts

35. All of the above goods clearly display the opponents First Earlier Mark and have their own article codes.

Fall-Winter 2019/20

- Warm reflective bibtights
- Dots DWR jersey
- Dots DWR stretch jacket
- Dots DWR bibtights

- Summit DWR jacket
- Winter lady bibtights
- Seamless armwarmers
- Seamless kneewarmers
- Seamless legwarmers

36. All of the above goods clearly display the opponents First Earlier Mark and have their own article codes.

Fall- Winter 2020/21

- Logo DWR stretch jacket
- Fuga DWR ciclocross skinsuit
- Fuga DWR ciclocross overpants
- Blend winter jersey
- Summit DWR jacket
- Black reflective jacket and vest
- Kilma headcover
- K-Elements cap
- Podio 2.0 cap

37. All of the above goods clearly display the opponents First Earlier Mark and have their own article codes.

38. **Exhibit 5** contains copies of invoices illustrating the sales of the goods (which bear the mark) throughout the UK during the relevant period. Ms Piccolo confirms that the “article codes in the left hand column of the invoices correspond to the images of the goods displayed in the opponent’s dated catalogues at **exhibit 4**”.

39. I note that the first 32 invoices are all addressed to the UK distributor Paligap Limited. The invoices clearly reference the goods in English alongside the article codes, for example, “jersey”, “bike wear jacket”, “bikewear shoe covers”, “bikewear socks” and “bibshorts”. The last 9 invoices contain the customer’s name and address.

I note that this includes the locations North Yorkshire, London, Tranent, Ipswich, Ellesmere Port, Sherborne and Farmborough. As highlighted above, these invoices include the article codes of the goods.

40. Ms Piccolo has also provided the following promotional and advertising expenditure for the last 5 years in the UK:

Year	Promotional and Advertising Expenditure (€)
2016	€35,000
2017	€46,984
2018	€139,369
2019	Expenses borne local distributor
2020	Expenses borne local distributor
2021	Expenses borne local distributor

41. From the above evidence it is reasonable for me to conclude that all of the above figures will be in relation to its range of cycling and triathlon clothing and accessories. However, I note that no specific figures have been provided for the years 2019, 2020 and 2021.

42. Ms Piccolo also explains that the opponent utilises various social media channels to promote and advertise its brand ALÉ. This includes its Facebook page which has 49,869 followers and its Twitter page which has 3,658 followers. Ms Piccolo has provided screenshots of these pages at **exhibit 7**. I note that these pages clearly display the opponent's First Earlier Mark, and describes the brand ALÉ as having "30 years of passion for professional cycling clothing and custom kit to ensure quality and performance to enthusiastic riders". However, I note that these screenshots are dated 2 April 2022 which falls after the relevant period.

43. **Exhibit 6** shows third party publications which have advertised the opponent's goods, including:

- Cycling weekly dated 6 October 2016. This shows the ALÉ Klimatik Extreme which is priced at £260. It is scored 9 out of 10 (excellent). The article comments on the jackets eVent fabric which is waterproof and lasts a long time. It also

includes a picture of the jacket which clearly displays the First Earlier Mark. I also note it says “contact www.paligap.cc” which is the opponent’s UK distributor, and therefore indicates that this article is UK based.

- Waitrose Weekend dated 22 June 2017. The front cover of this newspaper shows well known TV presenter Angellica Bell sporting one of ALÉ’s cycling jerseys. The First Earlier Mark is clearly presented across the jersey.
- Cycling weekly dated 24 January 2019. On the front page of this magazine, is a cyclist also wearing one of ALÉ’s cycling jerseys, with the First Earlier Mark clearly presented across it.

44. The opponent also sponsors the British women’s cycling team CAMS-Basso as a method of promotion. **Exhibit 8** includes screenshots from the CAMS-Basso Instagram account which prominently feature the opponent’s marks, including:

- A post from “March 19”, with 48 likes, with the First Earlier Mark presented on the side of a vehicle.
- 6 posts from 5 October 2021, 29 September 2021, 6 October 2021, 15 August 2021, “February 17” and “February 26” with the First Earlier Mark presented on all of the cyclists’ jerseys.

45. The opponent’s evidence confirms that the opponent has been operating since 2013, with a distributor in the UK, and evidence of customers based in different UK locations (North Yorkshire, London, Tranent, Ipswich, Ellesmere Port, Sherborne and Farmborough). The opponent has also provided the notable figures of 207,426 items sold in the UK on goods bearing the UK registration during the relevant period and with a turnover of £4,666,278.79. Albeit these were not broken down, I have been provided with invoice evidence and brochure evidence showing the goods which were sold during the relevant period. I note that although I have not been provided with any market share figures, I consider that the figures provided seem notable for what is likely to be a significant market within the UK. I have also been provided with advertising figures and evidence of marketing activity in the form of social media posts,

as well as third party publications which mention the opponent and clearly displays the First Earlier Mark on its goods. Taking all of the above into account, I am satisfied that the opponent has demonstrated genuine use of its First Earlier Mark in the UK during the relevant period.

Fair Specification

46. I must now consider whether, or the extent to which, the evidence shows use of the services relied upon. 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.”

47. 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."

48. The goods for which the First Earlier Mark is registered and upon which the opponent relies are a range of cyclist clothing and accessories in class 25.

49. It is clear, as set out above, that the opponent's First Earlier Mark has been used only in relation to cyclists clothing. I do not consider that this is too wide of a specification because, as highlighted by the brochure and invoice evidence above, the opponent has sold a wide range of clothing such as jerseys, bibishorts, tops and socks.

50. However, for the remaining goods, such as "bandanas" and "balaclavas" there has been no evidence of use. I also consider that "waterproof clothing" is too wide a

specification as it could encompass a whole range of waterproof items for which the opponent has not demonstrated use of.

51. Therefore, taking all of the above into account, I consider a fair specification of the First Earlier Mark to be:

Class 25 Cyclists' clothing.

Section 5(2)(b) case law

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only

when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

53. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p data-bbox="193 250 796 291">The First Earlier Mark</p> <p data-bbox="193 293 796 336"><u>Class 25</u></p> <p data-bbox="193 338 796 380">Cyclists' clothing.</p> <p data-bbox="193 472 796 512">The Second Earlier Mark</p> <p data-bbox="193 515 796 557"><u>Class 25</u></p> <p data-bbox="193 560 796 891">Cyclists' clothing; bicycle shoes; tee-shirts; polo shirts; bicycle gloves; jumper suits; sports socks; waterproof clothing; goloshes; leggings; muffs [clothing]; bandanas [neckerchiefs]; balaclavas; leotards; underwear.</p>	<p data-bbox="798 250 1398 291"><u>Class 25</u></p> <p data-bbox="798 293 1398 1167">Clothing; Clothes; Tops [clothing]; Motorcyclists' clothing; Hoods [clothing]; Leisure clothing; Infant clothing; Children's clothing; Childrens' clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Plush clothing; Girls' clothing; Knitwear [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Combinations [clothing]; Shorts [clothing]; Collars [clothing]; Babies' clothing; Outer clothing; Women's clothing; Embroidered clothing; Jackets [clothing]; Capes (clothing); Woolen clothing; Ladies' clothing.</p>

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

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

55. Guidance on this issue has 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

56. 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.”

57. I note that at least some of the goods covered by the parties' respective specifications are identical. For example, the term "cyclists' clothing" in the opponent's First and Second Earlier Marks specifications falls within the broader category of *Clothing; Clothes; Infant clothing; Children's clothing; Childrens' clothing; Girls' clothing; Women's clothing; Ladies' clothing; Sports clothing; Waterproof clothing and Weatherproof clothing* in the applicant's specification. I consider that the goods are identical on the principle outlined in *Meric*. For this reason, I will not undertake a full comparison of the goods above. The examination of the opposition will proceed on the basis that the contested goods are identical to those covered by the opponent's mark. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

The average consumer and the nature of the purchasing act

58. 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."

59. The average consumer for the goods will be members of the general public. The cost of purchase is likely to vary, and the goods will be purchased relatively frequently. However, various factors are still likely to be taken into account during the purchasing process, such as materials used, cut, aesthetic appearance and durability.

Consequently, I consider that a medium degree of attention will be paid by the average consumer when selecting the goods.

60. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, online or catalogue equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, as advice may be sought from a sales assistant or representative.




Comparison of the trade marks

61. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the 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.”

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

63. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade marks
 <p data-bbox="304 499 678 533">("the First Earlier Mark")</p>  <p data-bbox="284 797 703 831">("the Second Earlier Mark")</p>	 <p data-bbox="1007 763 1193 797">(Series of 2)</p>

Overall Impression

64. The First Earlier Mark is the word 'aLE' with the 'a' being presented in lower case, and the L and E being presented in upper case. I also note that there is a black square in the middle of the letter 'a', and a break in the top horizontal line of the letter E. I consider that the word 'aLE' plays a greater role in the overall impression of the mark, with the stylisation playing a lesser role.

65. The Second Earlier Mark consists of the word ALÉ. There are no other elements to contribute to the overall impression which lies in the word itself.

66. The opponent submits that the applicant's marks consists of the word "ALEE". However, I do not agree. Firstly, the applicant's series of marks consists of two figurative marks, the first presented in a grey colour, and the second presented in an orange colour. I consider that the double "e" at the end of the mark is clear and would be recognised by the average consumer. However, I consider that the first part of the mark looks like a decorative device, which isn't an identifiable shape or image. Therefore, I do not consider that the average consumer would attribute any meaning to this device. I do not consider that, as the opponent submits, the average consumer

would recognise the letters A and L. I consider that if the opponent was correct, and a proportion of average consumers did recognise these letters within the mark, it would be so few in number that it wouldn't amount to a significant proportion. I therefore consider that the device and the stylised letters 'ee' dominate the overall impression of the mark in roughly equal measure.

Visual Comparison

The First Earlier Mark and the applicant's marks

67. Visually, the marks coincide in the letter E at the end of the marks. However, I note that the letter E is in upper case in the First Earlier Mark and in lower case in the applicant's marks. The First Earlier Mark begins with the letters 'a' and 'L', whereas the applicant's marks start with the decorative device. Furthermore, the letter 'a' in the First Earlier Mark also contains a black square device. As highlighted by the opponent, it is accepted that consumers pay the most attention to the beginning of the marks. Therefore, taking the above into account, I consider that the marks are similar to a low degree.

The Second Earlier Mark and the applicant's marks

68. Visually, the marks coincide in the letter E at the end of the marks. However, the letter E at the end of the Second Earlier Mark has an accent. I also note that applicant's 'e' is in lower case. The First Earlier Mark begins with the letters 'a' and 'L', whereas the applicant's marks start with the decorative device. Consequently, I consider that the marks are similar to a low degree.

Aural Comparison

The First Earlier Mark and the applicant's marks

69. I consider that the First Earlier Mark will be pronounced as AL-EE. I consider that as the only identifiable letters in the applicant's marks is the double E, is that it may be

pronounced as EE or EE-EE. Regardless, the marks would only overlap in the one syllable and therefore I consider that the marks are aurally similar to a medium degree.

The Second Earlier Mark and the applicant's marks

70. I consider that the accent on the letter É changes the pronunciation of the applicant's Second Earlier Mark. I consider that it would be pronounced as AL-EH. Therefore, because there would be minimal overlap in the "E" part of the second syllable, I consider that the marks would be aurally similar to a low degree.

Conceptual Comparison

The First Earlier Mark and the applicant's marks

71. I consider that the First Earlier Mark is likely to be viewed as an invented word which would be attributed no particular meaning. I consider that the applicant's figurative marks also wouldn't be attributed any particular meaning. Therefore, I consider that the marks are conceptually neutral.

The Second Earlier Mark and the applicant's marks

72. I consider that the same comparison applies as above. I consider that the marks are conceptually neutral.

Distinctive character of the earlier trade mark

73. 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 C108/97 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).”

74. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

75. I will begin by assessing the inherent distinctive character of the earlier trade marks.

75. As highlighted above, I consider that the First Earlier Mark and the Second Earlier Mark will be viewed as an invented word which is neither allusive nor descriptive in relation to the goods for which the marks are registered. Therefore, I consider the First Earlier Mark and the Second Earlier Mark to be inherently distinctive to a high degree.

77. The opponent has also pleaded that its marks have acquired enhanced distinctiveness. The relevant market for assessing this is the UK market.

78. The opponent has provided sales figures to enable me to assess the extent of use that has been made of the First Earlier Mark in the UK. The opponent has made a

turnover of £4,666,278.79, and sold 207,426 items, on the goods bearing the UK registration, in the UK, during the relevant period. As previously highlighted, the evidence shows that the opponent has a distributor in the UK, and customers based in North Yorkshire, London, Tranent, Ipswich, Ellesmere Port, Sherborne and Farmborough. This is supported by sample invoices. I therefore consider that, to some extent, use has been geographically widespread. I also note that the opponent has provided me with promotional and advertising expenditure for the UK. From 2016 to 2018 the total expenditure was €221,353.00. I do not consider that the sums invested seem particularly high. I also note that no market share figures have been provided, however, I consider that the sales figures provided seem notable for which is likely to be a significant market within the UK. In light of the above, I find that the distinctive character of the First Earlier Mark has been marginally enhanced by virtue of the use made of it.

79. I note that use of the Second Earlier Mark has been demonstrated in all of the above evidence, alongside the First Earlier Mark, as explored in my sufficient/genuine use section. However, as highlighted above, Ms Piccolo states that the opponent has made a turnover of £4,666,278.79, and sold 207,426 items, on the goods bearing the UK registration, in the UK. Therefore, I consider that it is reasonable to assume that these figures are only in relation to the First Earlier Mark. Therefore, the evidence does not support a finding that the distinctiveness of the Second earlier mark has been enhanced through use. Even if I am wrong in this finding, and the figures were to relate to the Second Earlier Mark, it would not make any material difference because the mark is inherently distinctive to a high degree.

Likelihood of confusion

80. 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 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 vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for 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.

81. The following factors must be considered to determine if a likelihood of confusion can be established:

- The First Earlier Mark is visually similar to the applicant's mark to a low degree.
- The Second Earlier Mark is visually similar to the applicant's mark to a very low degree.
- All of the marks are aurally similar to a medium degree.
- All of the marks are conceptually neutral.
- I have found the First Earlier Mark and Second Earlier Mark to be inherently distinctive to a high degree.
- I have found the distinctiveness of the First Earlier Mark has been marginally enhanced through use.
- I have identified the average consumer for the goods to be members of the general public, who will select the goods primarily by visual means.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be identical.

82. As established above, both the First and Second Earlier marks consist of invented words which have no particular meaning and are both highly distinctive. The First Earlier Mark has also been marginally enhanced through use. The applicant's marks would also not be assigned any conceptual meaning and therefore there will be no conceptual hook to assist in differentiating between the marks. These are clearly factors in favour of the opponent.

83. However, taking all of the factors listed in paragraph 81 into account, particularly the visual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. This is particularly the case given the relatively low visual similarity between the marks and the predominantly visual purchasing process.

84. I note that the only common element between the First Earlier Mark and the applicants marks is the presence of the letter E at the end of the marks. I also note that the letter E is also present in the Second Earlier Mark, however, it has an accent. I also consider that the beginnings of marks tend to make more of an impact than the ends. Consequently, I do not consider that the average consumer would overlook the beginning letters a/A and L in the First and Second Earlier marks, nor do I consider that the average consumer would overlook the decorative device at the beginning of the applicant's figurative marks. Consequently, I do not consider there to be a likelihood of direct confusion.

85. 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.”

86. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

87. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the applicant’s trade mark was connected with the opponent, simply because they both end with the letter “E” or the letter E with an accent (É). The marks are clearly not natural variants or brand extensions of each other. Consequently, I consider there is no likelihood of indirect confusion.

CONCLUSION

88. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

89. Award of costs are governed by TPN 2/2016. The applicant has been successful and would normally be entitled to a contribution towards its costs.

90. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited them to indicate whether they intended to make a request for an award of costs. The applicant was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that “if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded”.

91. The applicant did not file a completed Pro Forma and paid no official fees. That being the case, I make no award of costs in this matter.

Dated this 30th day of August 2022

L FAYTER

For the Registrar

ANNEX

The First Earlier Mark

Class 9

Goggles for sports, Cyclists' helmets, Bicycle speedometers.

Class 18

Backpacks, Bags for sports, Waist pouches.

Class 25

Cyclists' clothing, Cyclists' shoes, Undershirts, Bicycle gloves, Salopettes, Sport stockings, Waterproof clothing.

The Second Earlier Mark

Class 25

Cyclists' clothing; bicycle shoes; tee-shirts; polo shirts; bicycle gloves; jumper suits; sports socks; waterproof clothing; goloshes; leggings; muffs [clothing]; bandanas [neckerchiefs]; balaclavas; leotards; underwear.