

O/371/20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3354347
IN THE NAME OF SUPERGLIDE BI-FOLDS LTD FOR THE TRADE MARK**



IN CLASS 37

AND

THE OPPOSITION THERETO UNDER NUMBER 415649

BY

DC COMICS (PARTNERSHIP)

Background

1. On 18 November 2018, Superglide bi-folds Ltd (“the applicant”) applied for the trade mark shown on the cover page of this decision (application number 3354347) for the following services:

Class 37: Advisory services relating to building refurbishment; Advisory services relating to the alteration of buildings; Apartment refurbishment services; Doors and windows (Installation of -); Double glazing installation; Window installation; Window replacement; Windows (Installation of doors and -).

2. The trade mark application was published for opposition purposes in the *Trade Marks Journal* on 30 November 2018. It was opposed under sections 5(2)(b), 5(3), 5(4)(a), 3(6) and 6(1)(c) (well-known mark) of the Trade Marks Act 1994 (“the Act”) on 21 December 2018 by DC Comics (partnership) (“the opponent”). The opponent relies upon the following earlier trade mark for its section 5(2)(b) ground:

European Union Trade Mark (“EUTM”) 3429354



Relying on some goods in class 20, which will be set out later in this decision. Date of filing: 22 June 22 October 2003; registration procedure completed 29 March 2005.

3. For its ground under section 5(3) of the Act, the opponent also relies on the above mark, claiming a reputation in all the goods and services covered by the registration in classes 3, 5, 9, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 29, 30, 32 and 41. There are a further two trade mark registrations relied upon under section 5(3):

(i) EUTM 38299



Date of filing: 1 April 1996; completion of registration procedure: 2 February 1998.
Claiming a reputation in all the goods and services covered by the registration in classes 3, 9, 14, 16, 21, 24, 25, 28, 30, 32 and 41.

(ii) UK 2031630



Date of filing: 25 August 1995; completion of registration procedure: 3 January 1997.
Claiming a reputation in all the goods and services covered by the registration in classes 9 and 28.

4. A full list of the goods and services relied upon under section 5(3) is contained within the annex to this decision.¹

5. The opponent claims that there is a likelihood of confusion under section 5(2)(b), also claiming that there is a family of marks which will enhance the likelihood of confusion, despite reliance upon only one mark under this ground.² Under section 5(3) the claim is that the identity or similarity between the applicant's mark and the opponent's marks will cause the relevant public to believe they are used by the same undertaking or an economically linked undertaking. The opponent also claims that use of the applicant's mark will tarnish the reputation of its earlier marks, erode their distinctiveness, and give an unfair advantage to the applicant by virtue of the reputation of the earlier marks.

¹ Reliance upon a further registration, 2123611, was withdrawn at the hearing.

² There cannot be a family of marks if only one mark is relied upon.

6. For its section 5(4)(a) ground, the opponent relies upon its use of the following signs, which it states were first used in 1940 throughout the UK in relation to entertainment services, publications, films and related merchandise:



7. The opponent claims that it owns goodwill connected to the signs and that it is entitled to prevent the use of the application under the law of passing off.

8. The section 3(6) ground is based upon the premise that the applicant had dishonest intentions in applying for a trade mark so closely similar to the opponent's marks of repute.

9. The section 6(1)(c) pleading is based upon section 5(3) of the Act: the black and white Superman logo is entitled to protection under the Paris Convention as a well-known trade mark.

10. The applicant filed a defence and counterstatement, denying the grounds.

11. Both sides filed evidence. The matter came to be heard by telephone conference on 21 May 2020. Mr David Stone, of Allen & Overy LLP, represented the opponent. Mr Karl Galert represented the applicant, as its Managing Director.

The evidence

12. The opponent's evidence comes from Mr Jay Kogan, the opponent's Senior Vice President and from Mr David Stone, a Partner at Allen & Overy LLP. The applicant's evidence comes from Mr Galert and from Mr Keith Seddon MBE BEM, an acquaintance of Mr Galert. I will refer to the evidence as it becomes necessary during this decision.

Proof of use

13. The opponent's earlier marks had been registered for five years or more on the date on which the contested application was published. Under section 6A of the Act, they are potentially subject to proof that genuine use has been made in relation to the goods and services relied upon in the opposition. However, the potential onus on the opponent to provide evidence of proof of use is consequent upon the applicant requesting it. The form TM8 (defence and counterstatement) asks, at box 7, if the applicant wishes the opponent to provide proof of use, with a 'yes' and 'no' option. There is an explanatory note preceding the 'yes' and 'no' options which includes the following:

"If you do not request "proof of use" the opponent's statement of use will be accepted with the consequence that the earlier mark(s) may be relied upon or all the goods/services identified in the statement of use."

14. The applicant did not request that the opponent prove use of its marks. It did not select either the 'yes' or 'no' option, but instead stated:

"NO PROOF OF USE REQUIRED AS THE OPPONENT DOES NOT USE OR SUPPLY PRODUCTS IDENTICAL, SIMILAR OR RELATED AT ALL TO ALUMINUM BI-FOLD DOORS".

15. Therefore, as the applicant chose not to request proof of use, the opponent is not required to prove that it has used its marks in relation to all the goods and services relied upon under sections 5(2)(b) and 5(3). The consequence of this choice by the applicant is that I must make the assessments under sections 5(2)(b) and 5(3) of the Act based upon the full width of the goods and services relied upon by the opponent, regardless of whether or not the marks have actually been used in relation to those goods and services. I say more about this later in this decision.

Section 5(2)(b) of the Act

16. Section 5(2)(b) of the Act states:

“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”.

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

The principles

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings 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 and services

18. The opponent relies only upon some goods in its class 20 specification for EUTM 3429354 for the section 5(2)(b) ground. The parties' goods and services are shown in the table:

Opponent's specification	Applicant's specification
Class 20: Furniture; office furniture; mirrors; picture frames; photograph frames; photograph frames of metal, wood or paper; wall plaques; key cards (not encoded); curtain holders, hooks, rails, rings, rods, rollers and tie-backs; bamboo, bamboo curtains and bamboo blinds; bead curtains; blinds; storage containers; trunks and chests; cabinets; chairs; desks and tables; dressing tables; easy chairs; beds and waterbeds; bed fittings not of metal; bedsteads; furniture screens; coat stands; door fittings and door furniture; display boards; mirror tiles; trays not of metal.	Class 37: Advisory services relating to building refurbishment; Advisory services relating to the alteration of buildings; Apartment refurbishment services; Doors and windows (Installation of -); Double glazing installation; Window installation; Window replacement; Windows (Installation of doors and -).

19. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* in which the CJEU stated, at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is 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 General Court of the EU (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], 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...”.

21. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

22. 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.”

23. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

24. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

25. *Doors and windows (Installation of -); Double glazing installation; Window installation; Window replacement; Windows (Installation of doors and -)*. The opponent’s specification includes ‘door fittings and door furniture’. There is no similarity of nature, purpose and method of use between the parties’ goods and services. However, goods and services can still be similar on the basis of complementarity and/or competition and shared trade channels.

26. The opponent’s goods ‘door fittings and door furniture’ are an integral part of the goods which are the subject of the applicant’s services *Doors and windows*

(Installation of -); Double glazing installation; Window installation; Window replacement; Windows (Installation of doors and -). A customer of the applicant's services will expect to be provided with door fittings as well as the doors themselves. The trade channels are, therefore, shared. There is also an element of complementarity because the applicant's services require the goods in order to perform the service; it is usual in the window and door fitting trade for the goods to be provided along with the service. I find that the parties' goods are similar to a medium degree.

27. *Advisory services relating to building refurbishment; Advisory services relating to the alteration of buildings; Apartment refurbishment services*. The opponent submits that advising in relation to building refurbishment might include installation of furniture. That is a different service. However, I agree that there is a level of similarity between advice relating to refurbishment and alteration of buildings and furniture, which includes fitted furniture. The opponent's term 'furniture' includes fitted furniture. For example, a builder will provide advice about refurbishing and altering a kitchen and then will supply (and fit) the new kitchen, including refurbishing building work. Advisory services is less similar than the services which carry out the fitting of the goods. Therefore, I find that there is a low degree of similarity between the opponent's 'furniture' and the applicant's *Advisory services relating to building refurbishment; Advisory services relating to the alteration of buildings* and a medium degree of similarity between the opponent's 'furniture' and *Apartment refurbishment services* on account of shared trade channels and complementarity. The applicant's services are wide enough to include notional and fair use in relation to such services, despite its evidence showing that its current business is installation of doors and windows.

The average consumer and the purchasing process

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

29. The average consumer for the parties' goods and services will be members of the general public and businesses. There is likely to be a reasonable level of attention to purchasing the goods and services because there is an expectation that they will last and that they will have the functionality required. Installation of doors and windows is undertaken relatively infrequently and can be an expensive outlay which means that consumers are likely to pay more than an average attention. The parties' goods and services are likely to be purchased primarily visually. The average consumer will research websites, reviews and product/service information, and may examine the physical goods. I do not discount the potential for an aural aspect to the purchase, for example, word-of-mouth recommendation.


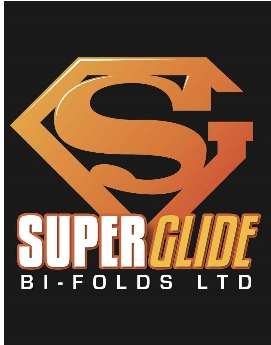
Comparison of marks

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in 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.”

31. 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.

32. The marks to be compared are:

Opponent's mark	Applicant's mark
	

33. The opponent's mark comprises a squashed top-heavy S inside a border resembling a diamond or cut gemstone. The overall impression of the mark resides in the combination of the S and the border. The applicant's mark also contains a top-heavy S within a diamond/gemstone-shaped border, albeit, there is a gap on one side of the border. The applicant's mark also contains the word elements SUPERGLIDE BI-FOLDS LTD. The device element is large, as are the words SUPERGLIDE. However, the words are low in distinctiveness, resulting in the device element contributing more distinctive weight in the overall impression. I find that the device is the dominant, distinctive element in the applicant's mark.

34. The marks coincide visually in the device elements. These are not quite identical, but are highly similar. The top-heavy S in each device appear identical, with the bulbous end to the lower part and the up-tick at the end of the top part appearing the same. The border is the same shape and fits around the S in the same way in each mark. The difference between the devices is that the border around the device in the applicant's mark has a gap at the top-right, squared off at the bottom part of the gap, and the top slanted side is longer than in the opponent's device.

35. The applicant's mark also contains words which are entirely absent from the opponent's mark. Balancing the visual similarities with the differences, the marks are visually similar to a medium degree.

36. It is likely that the opponent's mark would be seen as a device, rather than articulated as an S. There is no evidence from the opponent suggesting that consumers have used the letter S as an approximation of its mark in the course of trading in its goods and services. I also consider that the applicant's mark would be articulated by pronouncing the words, rather than the S device. Accordingly, there is no aural similarity between the marks. However, if the S in the marks would be articulated, the marks are aurally similar to a very low degree, bearing in mind the degree of difference created by the other words.

37. The applicant's mark contains the clear concept of bi-fold doors which glide very well (Superglide). This concept is absent from the opponent's mark. Both marks share highly similar devices containing the letter S. The conceptual comparison as required by the caselaw is aimed at identifying whether there is similarity in meaning and it is hard to see how a single letter has a meaning.³ Therefore, I find that there is no conceptual similarity between the marks.

38. The opponent submitted that the reputation of the earlier mark makes the marks similar. This is wrong in law. Reputation plays no part in the assessment of the similarity between the marks, per *Ravensburger AG v OHIM*, Case T-243/08, in which the GC held that:

“27. It is appropriate at the outset to reject that complaint as unfounded. The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51).”

³ See *Honda Motor Europe Ltd v OHIM*, case T-363/06, in which the GC considered that the S device contained within the earlier mark did not have any semantic content of its own.

Distinctive character of the earlier mark

39. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁴ the CJEU stated that:

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

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

40. One of the principles which must be taken into account in deciding whether there is a likelihood of confusion is that 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 (*Sabel*). As set out in the extract from *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the distinctive character must be in relation to the goods or services for which the mark has been registered. It follows that the only goods or services which are relevant for the purposes of section 5(2)(b) are those

⁴ Case C-342/97

which are a) registered under the mark relied upon and b) are relied upon for this ground. Any enhanced distinctive character acquired through use must be in the UK because a likelihood of confusion is to be assessed from the perspective of the UK average consumer.

41. At this point, I turn to the evidence about the opponent's use of its mark. There is no use in the UK (or anywhere else) in relation to door fittings and door furniture. There is also no use in relation to any of the other goods relied upon for this ground. It is not possible for the opponent to claim an enhanced level of distinctive character in relation to the goods relied upon for the section 5(2)(b) ground.

42. A single letter is relatively weak in distinctive character *per se*.⁵ In BL O/487/17, *Tissot S.A. v. Mrs Margaret Walker*, Mr Daniel Alexander QC, sitting as the Appointed Person, considered an earlier mark which consisted largely of the single letter "T". He said, at [49]:

"The opponent criticises this evaluation saying that the hearing officer should have found that the marks had greater distinctiveness, mainly on the basis that "T" as such was not descriptive of the goods. While that is true, the real question in evaluating distinctiveness is the extent to which, either inherently or by use, it would be thought that the mark or element of the mark denoted the goods or services of a single trader. The difficulty with single letters is that, for many goods and services, there is no reason to think that such would be the case and it is only the embellishments that actually serve to distinguish. That is all the more so, given the evidence showing that other traders in this general area also use differently stylised "T" marks."

43. However, the letter in the earlier mark is a top-heavy S, which is not the way an S is normally written, and it is squashed within a diamond/gemstone shaped border. This increases the inherent distinctiveness to a level of medium.

⁵ *Borco-Marken-Import Matthiesen GmbH & Co. KG v OHIM* Case C-265/09 P, CJEU.

Likelihood of confusion

44. As indicated earlier in this decision, the consequence of the applicant not requiring the opponent to prove that it has used its mark in relation to the goods relied upon in class 20 is that the opponent can rely upon the goods as they are registered. This is because the opponent is entitled to protection across the breadth of what it has registered on a 'notional' use basis. The opponent has a registration for the goods relied upon under this ground (in class 20) and is entitled to rely upon them, regardless of whether the mark has been used in relation to those goods because it has not been asked to prove any use. Likewise, the applicant has applied for services which are not limited to its current business of window and door fitting: I have to consider all the terms in the applicant's specification, too, on a notional basis.

45. A further consequence of the opponent not being required to prove that it has used its mark in relation to the goods is that it is not possible to say that the parties' marks have co-existed in the marketplace to such an extent that the average consumer has become accustomed to differentiating between them. The opponent has filed no use in relation to the class 20 goods relied upon so it is not possible to say whether it has, in actual fact, used the mark in relation to such goods. I will say more about the applicant's evidence later in this decision, but the opponent accepts that the applicant's evidence shows that it has a business with an "outstanding local reputation" (as it was put by Mr Stone at the hearing).

46. Therefore, despite Mr Galert and his acquaintance, Mr Seddon, stating that the applicant's mark has been used and that the applicant's business is successful and has a good reputation in Mr Galert's locality in relation to fitting windows and doors, and that fact being accepted by the opponent, this does not prove that there is no confusion between the parties' marks. There is no evidence that the average consumer has been exposed to both parties' marks in relation to the similar goods and services, so it is not possible to find that the average consumer has not, in fact, been confused.⁶

⁶ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

47. The fact that the applicant's mark is represented in orange, black and white makes no difference to the assessment as to whether there is a likelihood of confusion. The Court of Appeal has stated on two occasions following the CJEU's judgment in *Specsavers*, that registration of a trade mark in black and white covers use of the mark in colour.⁷ This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter).⁸ Thus a black and white version of a mark should normally be considered on the basis that it could be used in any colour. Notional and fair use of the opponent's mark would include use in orange and black, as it is represented in the applicant's mark. This would not extend to the shading because it is not appropriate to apply complex colour arrangements notionally to a mark registered in black and white. The reason why this is so is because it is necessary to evaluate the likelihood of confusion on the basis of normal (notional) and fair use of the marks, and applying complex colour arrangements to a mark registered without colour would not represent normal and fair use of the mark.

48. Mr Galert states in his evidence that the device in the applicant's mark was conceived as a result of choosing the words Super and Glide. The device represents the S (for super) and the border is a G (for glide), represented in a diamond shape to indicate a diamond-class service.

49. The average consumer perceives marks as wholes and does not unpack them piecemeal (*Sabel*). It seems to me most unlikely that the average consumer would examine the applicant's mark with sufficient scrutiny to reach the conclusion that the diamond-shaped border represents a G: it is too disguised.

50. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by

⁷ Paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.

⁸ See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

a greater degree of similarity between the trade marks, and vice versa. I have found the parties' goods and services to be similar to a medium degree.

51. The parties' marks are not conceptually similar. Any aural similarity, if it exists, will not have much of an impact in the assessment because the parties' goods and services will be primarily a visual purchase. The marks are visually similar to a medium degree, but they share a highly similar dominant and distinctive element. The differences between those elements are too slight to be recalled with accuracy since average consumers do not analyse the finer details of complex marks and also rarely have the opportunity to compare them side by side. Average consumers retain and recall an imperfect picture of marks. I consider that the device elements of the marks will be recalled as being the same or almost the same. The marks as wholes will not be directly confused for one another. By this, I mean that the average consumer will recognise that they are different marks because of the additional wording in the applicant's mark. They will not, therefore, mistake the marks for one another.

52. Despite there being no likelihood of direct confusion, I nevertheless find that there will be indirect confusion. The goods and services are sufficiently similar, coupled with the medium level of distinctive character of the earlier mark, to cause average consumers to presume that the almost identical/highly similar dominant and distinctive device elements mean that the marks are variations on the same brand; or that one is a sub-brand of the other belonging to one of the parties, or to an undertaking which is economically linked thereto. Indirect confusion was explained by Mr Iain Purvis QC, 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.

53. Although the goods and services will be bought with some care, this is not of such a high level that consumers will dismiss the likelihood that the marks are economically linked. Furthermore, the fact that the words in the applicant’s mark are semi-descriptive or allusive of the services for which protection is sought will add to the perception of co-branding or sub-branding by the same or an economically linked undertaking. The applicant’s mark will be perceived as a version of the opponent’s mark which states what the business is: bi-fold doors. This is indirect confusion.

54. I find that there is a likelihood of confusion between the applicant’s mark and the opponent’s mark which has been relied upon for this ground.

Section 5(2)(b) outcome

55. The ground of opposition under section 5(2)(b) succeeds in full.

Section 5(3) of the Act

56. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

57. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the

goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.



(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).


58. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks are similar to the applicant's mark. Secondly, that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the

goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

59. The first condition of similarity between the marks is satisfied: the marks are visually similar to a medium level, and are not aurally or conceptually similar.

60. The next condition is reputation. Although it adheres to its original claim of a reputation in all the goods and services relied upon for this ground, as set out in the annex, at the hearing Mr Stone said that he would focus on the following goods and services:

Prior Registration		Opponent's reputation
EUTM no. 38299		<p>Class 9: Cinematographic films; sound and/or video recordings, all in the form of records, tapes, discs or cassettes; computer games and video games</p> <p>Class 16: Printed matter; printed periodical publications</p> <p>Class 28: Toys</p> <p>Class 41: Entertainment services all relating to the production and distribution of films, video tapes, cassettes, tapes, records and compact discs.</p>
EUTM no. 3429354		<p>Class 9: motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; video and computer games; video game discs, cartridges and cassettes;</p> <p>Class 16: printed matter; printed matter and paper goods, namely, books featuring characters from [sic] animated;² action, adventure, comedy and/or drama features, comic books, children's books, magazines featuring characters from animated, action adventure, comedy and/or drama features, colouring books, children's activity books</p> <p>Class 28: Toys; namely action figures and accessories therefor</p> <p>Class 41: entertainment services in the nature of live-action, comedy, drama and/or animated television programmes; production of live-action comedy, drama and/or animated television</p>

Prior Registration		Opponent's reputation
		programmes; entertainment services in the nature of live-action comedy, drama and/or animated motion picture theatrical films; production of live-action comedy, drama and/or animated motion picture theatrical films
UKTM 2031630	no. 	Class 9: Game cartridges, video and computer game programs, cartridges and cassettes. Class 28: Toys; playthings, action figures and accessories therefor

61. At the hearing, Mr Galert said:

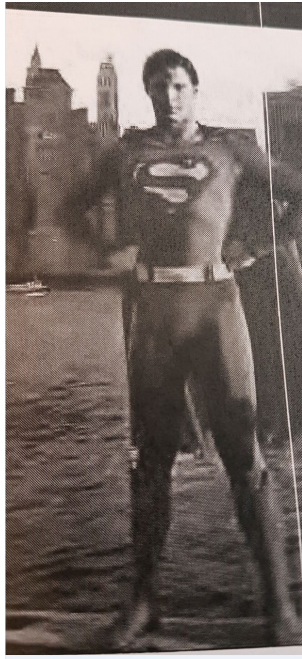
“Obviously, I do not deny that the opponent’s logo is famous and world famous. I totally agree with that, but, obviously, just to put it on record, Superman is not my cup of tea, and so I would not come up with a design that I did not really fancy.”

62. It is fair to surmise that Mr Galert’s statement relates to the goods and services upon which Mr Stone focused since it is a notorious fact that Superman is a famous fictional superhero, portrayed in print, film and toys and that the opponent’s mark(s) are the Superman emblem, worn on his costume.

63. The opponent’s evidence reveals an extensive reputation in most of the goods and services identified by Mr Stone in paragraph 60. As a flavour of the extent of that reputation, and because the reputation in the above goods and services is not in dispute, I pick out the following highlights from the evidence of Mr Kogan:⁹

- Superman was created in 1938 as a comic book character. There have been eight Superman motion pictures since the first, in 1978, starring Christopher Reeve:

⁹ Witness statement dated 7 January 2019.



- The latest three motion pictures, released in the UK in 2006, 2013 and 2016, grossed £23 million, £36 million and £40 million, respectively.
- The films feature Superman's ability to fly and his extraordinary strength; for example, catching and landing an out-of-control passenger jet plane in the film *Superman Returns*.
- The opponent's approximate revenue figures for Superman home entertainment sales in the UK from 2013 to 2018 amounted to \$121,200,000.
- The opponent's approximate revenue figures for Superman merchandise sales in the UK from 2013 to 2018 amounted to \$16,800,000.

64. Reliance upon this ground requires evidence of a reputation amongst a significant part of the relevant public. In *General Motors*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

65. I will, therefore, assess this ground on the basis that the opponent has an extensive reputation in the goods and services upon which Mr Stone focused, in the UK. The evidence does not support a qualifying reputation in relation to the other goods and services originally claimed.

66. The next question is whether the relevant public will make a link between the reputation in these goods and services and the services of the applicant. A link means will the earlier marks be brought to mind by the application. Although similarity of goods and services is not a requirement for section 5(3), the similarity or lack of similarity between goods and services is a factor in the assessment as to whether there is a link. The further the distance between them, the less it is likely that a link will be made.

67. There is clearly a gulf between the applicant's services and the goods and services which have a reputation. That said, one of the factors in determining whether there will be a link is the strength of the earlier marks' reputation and their degree of distinctive character, whether inherent or enhanced through use.¹⁰ In this instance, I agree with Mr Galert that the marks are "world famous". They have a strong reputation and, for the goods and services focused upon by Mr Stone, a high level of distinctive character acquired through use. In certain circumstances, where the earlier mark has a huge reputation, a link may still be made despite the different goods and services at

¹⁰ *Intel*, [2009] ETMR 13, Case C-408/01.

issue. An example of this is found in Case C-294/12 P, *You-Q BV v. Apple Corps Ltd*, CJEU. The contested mark was BEATLE, applied for in relation to vehicles and the opponent owned the mark BEATLES, for sound records, video records and films. The CJEU said:

“68. It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which they were registered and that, in such a case, the relevant section of the public as regards the goods or services for which the later mark is registered may make a connection between the marks at issue, even though that public is wholly distinct from the relevant section of the public as regards the goods or services for which the earlier mark was registered (see, to that effect, *Intel Corporation*, paragraphs 51 and 52).

69. The General Court was therefore right in holding that the publics overlapped in spite of a difference between the goods covered by the mark applied for and those covered by the earlier marks. Likewise, it could hold, without infringing Article 8(5) of Regulation No 40/94, that, while the goods are quite different, it is not altogether inconceivable that the relevant public could make an association between the signs at issue and that it could be led to transfer the values of the earlier marks to the goods covered by the mark applied for and, therefore, that it was likely that the appellant could take unfair advantage of the repute of the earlier trade marks.”

68. I consider that the present case falls into this category. The Superman logo is so iconic that it will be recognised almost regardless of the context of goods and services. It will be brought to mind and thus the link will be made.

69. Despite the finding of a link, the condition of one of the three types of damage must still be satisfied. The detriment to reputation claim is predicated upon the basis that the earlier marks will be harmed if there is a quality problem with the applicant's services. This is not a proper basis of a claim under section 5(3) which envisages

damage to repute because the image of the goods or services, or the mark itself, is inherently negative.¹¹

70. Nor do I consider that the opponent has made out its claim under detriment to distinctive character; i.e. that the applicant's mark will dilute the distinctive character of the earlier marks so that the opponent's customers will be less moved to buy the opponent's goods and services. The opponent's evidence shows that it engages in licensing its marks for various goods unconnected with the goods and services focused upon by Mr Stone. He drew my attention to paragraph 23 of Mr Kogan's witness statement:

“SUPERMAN'S appeal to licensees rests upon the character's continuing popularity and cross market appeal.”

71. Mr Kogan goes on to list a wide variety of goods which are licenced and available on Amazon. Mr Stone highlighted that the list includes Superman-branded DIY goods and tools, garden and outdoor goods and lighting. It seems to me that there is a tension between, on the one hand, saying that the use of a mark on different goods and services will lead to a dilution of the brand (Mr Stone called it “death by a thousand cuts”) but, on the other hand, saying that the opponent itself licences its mark for use in relation to mundane, unglamorous goods such as tools for DIY and gardening. Given the opponent's own trade in such goods via licensees, it is harder to gauge how the behaviour of the opponent's customers would be affected by the applicant's mark. Although the opponent is not required to show evidence of a change in behaviour of the average consumer for the earlier marks (i.e. the opponent's customers being less inclined to buy its goods and services), it must, at least, show evidence of a serious risk that this will happen in the future. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12 P, the CJEU stated that:

“34. According to the Court's case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires

¹¹ *Unite The Union v The Unite Group Plc*, Case BL O/219/13, Ms Anna Carboni sitting as the Appointed Person.

evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words '[i]t follows that', immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that 'the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes

between the signs and the goods at issue, which is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the proprietor of that mark'.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'."

72. Mr Stone gave an example of Trampoline, Escalator and Cellophane: he said that if a proprietor does not enforce its trade mark, eventually, it becomes generic and of no value. I think that is a different point. The examples of Trampoline, Escalator and Cellophane morphed into the new noun for the goods. They are word marks and apt to become descriptions if genericised. The opponent's earlier marks are device marks. It would be difficult to genericise them.

73. I do not consider that the opponent's claim to this type of damage has been made out. It is seated too far within the realm of mere suppositions rather than logical deductions.

74. The third type of damage is unfair advantage. This is somewhat different because it is about the economic effect upon the relevant public for the applicant's services, whereas detriment to distinctive character and repute concerns damage caused to the earlier marks' reputation because of the change in economic behaviour of the relevant public for the opponent's goods and services. In *Sky v SkyKick* [2018] EWHC 155 (Ch), at [315], Arnold LJ observed that unfair advantage is directed at a particular form of unfair competition, and it was described by the CJEU in *L'Oreal v Bellure* in the following way:

“Article 5(2) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.”

75. The image portrayed by the earlier marks, the Superman logo, is synonymous with Superman himself, who is known for his superhuman strength. Strength is a quality which would be desirable in the product fitted by the applicant's services, windows and doors. Not only does the applicant's mark contain an almost identical element to the Superman logo, but it also contains the word Super, describing the superior gliding qualities of the bi-fold doors.

76. For a finding of unfair advantage, it is not necessary to prove that there was an intention by the applicant to ride on the coat-tails of the earlier marks' reputation. Unfair advantage may be inferred where the later trade mark would gain a commercial

advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited and Anor*, [2019] EWHC 2003 (IPEC). In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

77. In *Planetart LLC and anor v. Photobox Limited and anor* [2020] EWHC 713 (Ch), a finding of unfair advantage was made because the Mr Daniel Alexander QC, sitting as a Deputy Judge of the Chancery Division, found that the later mark benefitted from the reputation and goodwill of the earlier mark, even though he did not find that this was specifically the defendants' intention.

78. Given the presence of both the highly similar device and the word Super, there is a question over the intention of the applicant. As set out earlier in this decision, Mr Galert, at the hearing, said that Superman is not his cup of tea and that he designed the applicant's mark himself. 'Not his cup of tea' implies that the applicant positively did not want an association with the Superman logo. Mr Galert, in his witness statement, states that he designed the mark. If so, the high level of similarity between the devices, with their arbitrarily arranged top-heavy letter S, with the bulbous end and uptick inside a diamond/gemstone-shaped border is a surprising co-incidence.

79. Leaving to one side Mr Galert's submissions and looking at the facts objectively, the noted similarities between the marks, reinforced by the word Super, lead me to infer an intention at least to bring the earlier marks to mind. The question is then, why would such a step be taken? It could be for reason of satire or parody, but this is a trade mark application and the purpose of a trade mark is to differentiate the goods and services of one trader from another. This is about trade, so the intention behind causing a link to be made must involve the applicant's trade. As parody is not the intention, it must be inferred that the intention was for the applicant's trade to benefit from its customers bringing to mind the earlier marks. I think it unlikely that the benefit would be that customers who are fans of Superman might be more inclined to buy the applicant's services. Any benefit is likely to be a transfer of the image associated with Superman; i.e. strength.

80. It is easier to see an unfairness in cases where there is a transfer of an image such as prestige, luxury or quality, as in *Claridges*. However, the transfer of an image of a fictional superhero to services which are very far away from those in which the opponent has a reputation is less convincing; particularly when those services have no connection with superheroes and are quite utilitarian in character. In *BEATLE*, the image transfer was of the youthful, counter-culture qualities of The Beatles to vehicles. I consider that there is an extra step involved here – the transfer of the quality of the superhero which wears a costume bearing the mark is a step further than a transfer of the qualities associated with trade marks in a conventional sense.

81. I come to the conclusion that there must have been an intention on the part of the applicant to reference the earlier marks because the devices are so very similar, and Super is also contained in the applicant's mark. That intention is connected to trade because this is a trade mark application. Despite the utilitarian nature of the services, if there is an intention, it is to derive a benefit from what the opponent had hitherto done with its marks. Even without an image transfer, the applicant has made its mark more instantly familiar to the relevant public without having to undertake as much marketing to achieve such familiarity. The applicant's mark will be more memorable because of its clear nod to a mark of high repute. When the opponent promotes its own marks, which it does on a substantial scale, it contributes, effectively, to the promotion and exposure of the applicant's mark. This is unfair.

82. The applicant's business is a new one and it did not plead a defence of due cause. It has not shown that it has due cause to use the mark. The section 5(3) ground succeeds in respect of all of the applicant's services under the claim to unfair advantage.

Section 5(3) outcome

83. The ground of opposition under section 5(3) of the Act succeeds.

Section 5(4)(a) and the well-known mark claim

84. The opponent is not in any better a position under these grounds. It has not shown any use in relation to similar goods or services to those of the application which means the claim to passing off would have to be assessed on the basis of goods and services far removed. Since the goods and services assessed under the section 5(2) claim are similar and that ground has succeeded, I decline to consider the section 5(4)(a) ground. Furthermore, the opponent has succeeded in claims based upon registered trade marks which cover the UK, so it is difficult to see how its position can be improved by a claim to a well-known mark.

Section 3(6)

85. Section 3(6) states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

86. The law in relation bad faith was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and further summarised by Mr Thomas Mitcheson QC as the Appointed Person in *Loch Employment Law Limited V Philip Adamson Hannay*, BL O/786/18 as follows:

“1) The relevant date for assessing bad faith is the application date;

2) Later evidence may be relevant if it casts light backwards on the position as at the application date;

3) A person is presumed to have acted in good faith unless the contrary is proved – given that an allegation of bad faith is a serious allegation, it must be distinctly proved;

4) Bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined";

5) The provisions against bad faith are intended to prevent abuse of the trade mark system, either via the relevant office or via third parties;

6) The tribunal must make an overall assessment, taking into account all the factors relevant to the particular case;

7) The tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people i.e. objectively.

8) Consideration must be given to the applicant's intention."

87. Additionally, in *Sky v Skykick*, Case C-371/18, the CJEU stated that while in everyday language the concept of 'bad faith' involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade.

88. The pleading is predicated upon the fame of the earlier mark and that the applicant's intentions were, therefore, dishonest when the application was made. The applicant's response to the allegation of bad faith in its counterstatement was:

“I utterly refute this allegation as there are no goods similar or identical to the opponents [sic] and our logo is bright orange with orange and white text plus the words “SUPERGLIDE BI-FOLDS LTD”. I, personally, designed my logo for our business and am very protective of it, hence the trade mark application.”

89. Mr Galert’s witness statement is focussed upon his view of there not being any likelihood of confusion between the parties’ marks. There is a short statement about the design of the applicant’s mark:

“After registering our company with companies house it then became superglide bi-folds ltd. Secondly we wanted to design a 3 fold meaning to our logo:

1. The ‘S; and the ‘G’ needed to be in the logo with the ‘G’ being in a diamond shape to depict the diamond class service that we would offer our customers.”

90. Mr Galert also states:

“The superman logo letter ‘S’ apparently means ‘SUPERMAN’ but I am led to believe that it is also the symbol for ‘HOPE’.

91. There is no confirmatory evidence from the applicant about the symbol for HOPE. However, I note within the opponent’s evidence the following, as described by Mr Kogan:

“Exhibit JK-29 is the website of the third party Fandom page relating to the S-Shield [the earlier marks; website address omitted]. Fandom is a third party website unconnected to DC Comics. I understand that the content is created by fans. The website states:

“The symbol is the Kryptonian symbol for hope; it is also the family insignia for the house of El. In some versions, it was designed for Martha Kent as a symbol for her son Clark Kent to wear.”

92. It is clear from this as well as elsewhere in the opponent's evidence (and is likely to be known to many people who have seen Superman films) that Krypton is the fictitious planet from where Superman hails and that his alias on Earth is Clark Kent (when he is not being Superman). The so-called symbol of hope is therefore a creation by the writers of the Superman stories. It is not a generic, universally recognised symbol for hope (compare, for example, a dove being a universally recognised symbol for hope and peace).

93. Mr Stone characterised the explanation for the mark's design as a convenient *ex post facto* justification, submitting that a 'diamond-class service' sounded old-fashioned. He submitted that I should infer that the device had been copied. There was no request from the opponent to cross-examine Mr Galert about his explanation for the design of the applicant's mark, nor a request to file evidence in reply. For his part, at the hearing, Mr Galert submitted:

Obviously, I do not deny that the opponent's logo is famous and world famous. I totally agree with that, but, obviously, just to put it on record, Superman is not my cup of tea, and so I would not come up with a design that I did not really fancy. That is my side of things.

94. This information was not provided in Mr Galert's evidence and was not as a result of being questioned in the witness stand. I cannot treat it as evidence, not least because Mr Galert was not under oath and he may not have said this if he had been.

95. It appears from the thrust of the counterstatement denial and Mr Galert's evidence that the applicant/Mr Galert bases the denial of bad faith upon there being no confusion between the marks because of the applicant's belief that the opponent was not in the same line of business as the applicant. No likelihood of confusion can sometimes be relevant to a claim of bad faith, but it is not always determinative. All facts and circumstances must be taken into account. Subjectively, the applicant/Mr Galert knew of the Superman logo/earlier mark(s) because Mr Galert conceded at the hearing that the opponent's mark is "world famous". I accept that the applicant intended the device to contain an S and a G, as the border around the S. However, it is a considerable coincidence that the devices are so very similar. The applicant has

provided no corroborative evidence about the S being the symbol for hope and the opponent's evidence shows that it is a creation by the writers of the Superman stories. Since the S is intrinsically linked to the Superman story and was spawned by it, I am inclined to agree that Mr Galert's statement that he is led to believe that the S is a symbol for 'hope' is an *ex post facto* justification, and was not part of the applicant's plans at the relevant date for assessing this ground of opposition, which is the date on which the application was filed.

96. As observed by Arnold J in *Skykick*, the assessment of bad faith in trade mark law must be understood in the context of trade. Bad faith is not confined to a dishonest state of mind but also includes some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. In this particular area, at best, it might be considered naive of the applicant to apply for a mark which contains a dominant and distinctive element which is so closely similar, to what it has conceded is a world famous logo, on the basis that the business areas are different. However, applying for a trade mark is a commercial decision and in this particular area there is a responsibility upon applicants. Given that the devices are almost identical, with the additional word 'Super', and a weak, nigh-on implausible (given the degree of similarity), explanation for including in the application the almost identical device, I find that the opponent's claim succeeds because the application fell short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the area of trade marks.

Overall outcome

97. The opposition succeeds. The application is refused.

Costs

98. The opponent has been successful and is entitled to a contribution towards the costs of the proceedings, based upon the scale of costs published in Tribunal Practice Notice 2/2016. The opponent's evidence was high in volume and could have been more concisely marshalled. The breakdown of the cost award is as follows:

Official fee	£200
Filing the opposition and considering the defence and counterstatement	£300
Filing evidence and considering the applicant's evidence	£1200
Attendance at a hearing	£800
Total	£2500

99. I order Superglide bi-folds ltd to pay DC Comics (partnership) the sum of **£2500**. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of July 2020

Judi Pike

**For the Registrar,
The Comptroller-General**

Annex

EUTM 3429354:

Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; non-medicated toilet preparations; cosmetic and toilet preparations for use in the bath; preparations for the hair, shampoo and conditioners; liquid bath soap, gel soap, bar soap; bubble bath; shower gel; toothpaste; mouthwash; sun-tanning preparations; sunscreen preparations, namely cream and lotion; pre-shave and after-shave cream and lotions; cleansing, toning, moisturising and exfoliating preparations and substances; emollient preparations and substances; body cream and lotion; hand cream and lotion; skin cleanser and non-medicated body soaks; deodorant and anti-perspirant preparations; body deodorant, cologne and perfume; bath powder and perfumed body powder; bath oil, bath gel and non-medicated bath salts; baby oil, baby powder, baby gel and baby lotion; cosmetics all for sale as part of a kit; make-up preparations; lipsticks, lip gloss, non-medicated lip balm; mascara; face powder, face cream; nail enamel; nail care and manicure kits; false nails; sachets for perfuming linen; essential oils, massage oils and lotions all for sale as part of a kit; aromatherapy preparations; incense; abrasive cloth; abrasive paper; adhesives for affixing false hair; adhesives for cosmetic purposes; alum stones [antiseptic]; antiperspirants [toiletries]; antistatic preparations for household purposes; bath salts, not for medical purposes; breath freshening sprays; cobblers' wax; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; denture polishes; emery cloth; emery paper; eyelashes (adhesives for affixing false-); eyelashes (false-); false eyelashes; false hair (adhesives for affixing -); false nails; false nails; fumigation preparations [perfumes]; glass cloth; glass paper; incense; incense; lacquer-removing preparations; linen (sachets for perfuming -); mouth washes, not for medical purposes; nails (false-); paint stripping preparations; pets (shampoos for-); polishes (denture-); polishing paper; potpourris [fragrances]; pumice stone; sachets for perfuming linen; sachets for perfuming linen; sandcloth; sandpaper; scented wood; shampoos; shampoos for pets; shaving stones, antiseptic; shoemakers' wax; smoothing stones; sprays (breath freshening -); swabs [toiletries]; tailors' wax;

toiletries; transfers (decorative-) for cosmetic purposes; tripoli stone for polishing; varnish-removing preparations; wax (cobblers' -); wax (tailors'-).

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin, fungicides, herbicides; food for babies; air fresheners; vitamins; drinks predominantly of vitamins; health food supplements made principally of vitamins; pharmaceutical preparations containing vitamins; vitamin and mineral supplements; preparations consisting of mixtures of vitamins and minerals; adhesive plastic and cloth bandages for skin wounds; alcohol for topical use; baby aspirin; abrasives (dental-); adhesives (fly catching-); adhesives for dentures; air freshening preparations; air purifying preparations; anti-rheumatism bracelets; anti-rheumatism rings; antiparasitic collars for animals; bacteriological cultures (bouillons for -); bacteriological cultures (media for -); blood plasma; bouillons for bacteriological cultures; bracelets for medical purposes; caustic pencils; cedar wood for use as an insect repellent; cement for animal hooves; cigarettes (tobacco-free-) for medical purposes; cleaning preparations (contact lens-); collars for animals (antiparasitic -); contact lens cleaning preparations; contact lenses (solutions for use with -); dental abrasives; dental cements; dental impression materials; dental lacquer; dental mastics; dentures (adhesives for -); deodorants, other than for personal use; diagnostic preparations for medical purposes; dogs (repellents for -); eyepatches for medical purposes; first-aid boxes, filled; fly catching adhesives; fly catching paper; fly glue; fumigating sticks; glue (fly-); headache pencils; herbs (smoking -) for medical purposes; hooves (cement for animal-); implants (surgical -) [living tissues]; incense (insect repellent-); insect repellent incense; insect repellents; insecticides; insemination (semen for artificial -); lacquer (dental -); leeches for medical purposes; mastics (dental -); media for bacteriological cultures; medicine cases, portable, filled; milking grease; molding wax for dentists; mothproofing paper; mothproofing preparations; moulding wax for dentists; nutritive substances for microorganisms; oils (anti-horse-fly-); paper (mothproof -); plasma (blood -); porcelain for dental prostheses; repellents (insect-); repellents for dogs; rings (anti-rheumatism-); rubber for dental purposes; semen for artificial insemination; smoking herbs for medical purposes; solutions for contact lenses; solvents for removing adhesive plasters; starch for dietetic

or pharmaceutical purposes; sterilising (soil--) preparations; sticks (fumigating -); surgical implants [living tissues]; tobacco extracts [insecticides]; tobacco-free cigarettes for medical purposes; blood for medical purposes; soil-sterilising preparations.

Class 9: Photographic, cinematographic and optical apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computers, computer hardware and computer software, parts and fittings for all the aforesaid goods; electronic publications (downloadable); interactive computer software; apparatus for searching electronic information from a global computer network or the Internet; computer programs, namely, software linking digitised video and audio media to a global computer information network; arcade games adapted for use with television receivers only; CD-ROM games; video and computer game programs; video game discs, cartridges and cassettes; digital music (downloadable) provided from the Internet; digital music (downloadable) provided from MP3 Internet web sites; MP3 players; motion picture films featuring comedy, drama, action, adventure and/or animation, and motion picture films for broadcast on television featuring comedy, drama, action, adventure and/or animation; pre-recorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs; audio tapes (all being sold together with booklets); digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation; stereo headphones; batteries; cordless telephones; mobile telephones; parts and accessories for mobile telephones; mobile telephone covers; mobile telephone cases; mobile telephone cases made of leather or imitation of leather; mobile telephone covers made of cloth or textile materials; telephone and/or radio pagers; hand-held calculators; hand-held karaoke players; short motion picture film cassettes featuring comedy, drama, action, adventure and/or animation to be used with hand-held viewers or projectors; audio cassette recorders and players; video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players, electronic diaries; radios; mouse pads; eyeglasses, sunglasses and cases therefore; encoded magnetic cards, phone cards, credit cards, cash cards, debit cards and magnetic key cards; decorative magnets; swimming floats;

kickboard flotation devices; swim boards; global positioning systems; navigation apparatus for vehicles (on-board computers); parts and fittings for all of the aforementioned goods.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments; clocks; alarm clocks; desk clocks; watches; alarm watches; sporting watches; jewellery; costume jewellery; bracelets, ankle bracelets; brooches; chains; charms; cuff-links; earrings; lapel pins; tie pins; tie clips; necklaces; ornamental pins; pendants; rings; key rings; belt buckles of precious metal for clothing; action figures (decorative) of precious metals; figurines of precious stones; figurines coated with precious metal; adhesive wall decorations of precious metal; amulets; cases for clocks, watches or jewels; cases and containers of precious metal; coins; agates; anchors [clock and watch making]; barrels [clock and watch making]; cases for clock-and watchmaking; cases for watches [presentation]; chains (watch-); clock cases; clock hands [clock and watch making]; clockworks; coins; coins; copper tokens; dials [clock and watch making]; gold (objects of imitation-); hands (clock-) [clock and watch making]; imitation gold (objects of-); jet (ornaments of-); jet, unwrought or semi-wrought; key rings [trinkets or fobs]; medals; movements for clocks and watches; olivine [gems]; ormolu ware; ornaments of jet; pearls made of ambroid [pressed amber]; pendulums [clock and watch making]; semi-precious stones; spinel [precious stones]; springs (watch-); straps for wristwatches; watch bands; watch cases; watch chains; watch crystals; watch glasses; watch springs; watch straps.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; printed matter and paper goods, namely, books featuring characters form animated; action, adventure, comedy and/or drama features, comic books, children's books, magazines featuring characters from animated, action adventure, comedy and/or drama features, colouring books, children's activity books; booklets (all being sold together with audio tapes); stationery, writing paper,

envelopes, notebooks, diaries, note cards; greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, coloured pencils, painting sets, chalk and chalkboards, decals, heat transfers; posters; mounted and/or unmounted photographs; book covers, book marks, calendars, gift wrapping paper, paper party decorations, namely, paper napkins, paper doilies, paper place mats, crepe paper, invitations, paper table cloths, paper cake decorations; printed transfers for embroidery or fabric appliqués; printed patterns for costumes, pyjamas, sweatshirts and t-shirts; adhesive tapes for stationery or household purposes; aquaria (indoor-); aquarium hoods; architects' models; babies' diapers of paper and cellulose, disposable; babies' napkin-pants [diaper-pants]; bags (garbage-) of paper or of plastics; bags for microwave cooking; balls for ball-point pens; chaplets; checkbooks [cheque books] (holders for-); composing frames [printing]; composing sticks; diaper-pants (babies'-); engraving plates; galley racks [printing]; garbage bags of paper or of plastics; graining combs; hand labelling appliances; holders (passport-); holders for checkbooks , [cheque books]; house painters' rollers; indoor aquaria; indoor terrariums [vivariums]; marking chalk; microwave cooking (bags for -); models (architects' -); mounting photographs (apparatus for-); napkin-pants (babies' -); packaging material made of starches; passport holders; photograph stands; photographs (apparatus for mounting -); printers' blankets, not of textile; printers' reglets; rollers (house painters' -); rosaries; sheets of reclaimed cellulose for wrapping; starches (packaging material made of-); steatite [tailor's chalk]; tailors' chalk; tanks [indoor aquaria]; terrariums (indoor-) [vivariums]; trays for sorting and counting money; vignetting apparatus; wristbands for the retention of writing instruments; chalk (marking -); selfadhesive tapes for stationery or household purposes.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; athletic bags; bath bags; beach bags; book bags; diaper bags; duffel bags; leather bags; school bags; shoe bags; shopping bags; tote bags; toiletry bags; suit carriers being travelling bags; waist bags; weekend bags; work bags; backpacks; knapsacks; fanny packs; waist packs; wallets; purses; chain mesh purses, not of precious metal; clutch purses; coin purses; cosmetic purses; evening purses; leather purses; purses, not of precious metal; parts and accessories for all of the aforementioned; attaché cases; backpacks;

backpacks; bags (net-) for shopping; bags (nose-) [feed bags]; bandoliers; beach bags; beach bags; briefcases; card cases [notecases]; chain mesh purses, not of precious metal; chain mesh purses, not of precious metal; clothing for pets; collars for animals; covers (umbrella-); covers for animals; dog collars; frames (handbag -); frames for umbrellas or parasols; game bags [hunting accessories]; gold beaters' skin; gut for making sausages; handbag frames; handbags; handles (suitcase-); handles (walking stick-); haversacks; horse blankets; knee-pads for horses; music cases; muzzles; net bags for shopping; nose bags [feed bags]; pets (clothing for-); pocket wallets; purses; purses; purses, not of precious metal; purses, not of precious metal; ribs (umbrella or parasol-); rucksacks; satchels (school-); sausages (gut for making-); school bags; school bags; school satchels; shopping bags; shopping bags; skates (straps for-); skin (goldbeaters' -); sling bags for carrying infants; soldiers' equipment (straps for -); straps for skates; straps for soldiers' equipment; suitcase handles; umbrella covers; umbrella handles; umbrella or parasol ribs; umbrella rings; umbrella sticks; vanity cases, [not fitted]; walking cane handles; walking stick handles; walking stick seats; wallets (pocket -); wheeled shopping bags; bags (game-) [hunting accessories].

Class 20: Furniture; office furniture; mirrors; picture frames; photograph frames; photograph frames of metal, wood or paper; wall plaques; key cards (not encoded); curtain holders, hooks, rails, rings, rods, rollers and tie-backs; bamboo, bamboo curtains and bamboo blinds; bead curtains; blinds; jewellery boxes; storage containers; trunks and chests; cabinets; chairs; desks and tables; dressing tables; easy chairs; beds and waterbeds; bedding (not including linen); bed fittings not of metal; bedsteads; furniture screens; clothes hooks and coat hangers; coat stands; garment covers; cushions; divans; mats; mattresses; pillows; support pillows for use in baby car safety seats; support pillows for use in baby seating; sleeping bags; door fittings and door furniture; drinking straws; flower stands; footstools; hat stands; display boards; bottle caps not of metal; bottle casings of wood; bottle racks; magazine racks; plate racks; mirror tiles; trays not of metal; containers of wood and of plastic; high chairs for babies; playpens for babies and walkers for infants; mobiles; cots; cradles and cribs; chimes; inflatable publicity objects; statuettes and figurines of wood, wax, plaster and of plastic; works of art of wood, wax, plaster and of plastic.

Class 21: Small domestic utensils and containers (not of precious metals, or coated therewith); combs and sponges; brushes (other than paint brushes); brush-making materials; instruments and material for cleaning purposes; steel wool; unworked or semi-worked glass (excluding glass used in building); glassware, ceramic, porcelain and earthenware, not included in other classes; beverage glassware; cutting boards; bottles sold empty; jugs; bowls; mugs; plastic water bottles; bottle openers; lunch boxes; cookie cutters; pans; kettles; dishes; non-electric waffle irons; non-electric coffee pots not of precious metal; plates not of precious metal; buckets; plastic buckets; ice pails buckets; champagne buckets; shower caddies, not of precious metal; tea caddies, not of precious metal; soap boxes; vacuum bottles; hair combs; cleaning combs; powder compacts sold empty; non-metal decorative boxes; dusting brushes; hair brushes; brushes for clothes; bathroom pails; cake molds; plastic coasters; coffee cups; all purpose containers; drinking glasses; demitasse sets consisting of cups and saucers; plastic coasters; cocktail shakers; thermal insulated containers for food or beverages; cork screws; corn cob holders; decanters; drinking flasks; sugar and creamer sets; infant cups; cookie jars; napkin holders; towel holders; toothpicks; toothpick holders; paper cups; paper plates; non-metal piggy banks; plastic cups; salt shakers; pepper pots; shoe horns; window dusters; toothbrushes; toothbrush cases; wash basins; waste baskets; incense pots; baby bath tubs; bird cages; serving trays not of precious metal; serving utensils, namely, pie servers, cake turners, spatulas, scrapers and cake servers; vases not of precious metal; cases for personal hygiene products; toilet cases; candlestick holders not of precious metal; statues and figurines made of china, ceramic, earthenware, glass and porcelain chopsticks; gardening gloves; rubber household gloves; parts and accessories for all of the aforementioned.

Class 24: Textiles and textile goods, not included in other classes; bed and table covers; rugs; travelling rugs; lap rugs; towels; bed linen, blankets, bedspreads, quilts, canopies, bed pads, bed sheets, pillow cases, comforters, duvet covers, mattress covers, crib bumpers, mosquito nets, pillow shams; sleeping bags (sheeting); cloth; fabric, table covers and table linen; place mats; napkins, serviettes and table runners; kitchen linens, namely, barbecue mitts, cloth doilies, cloth napkins, dish cloths, fabric table cloths, kitchen towels, fabric place mats, oven mitts, washing mitts, fabric table runners, pot holders, cloth coasters; curtains; draperies; curtain holders of cloth;

banners; handkerchiefs; bath linen; bath towels and wash cloths; household linen; mats of linen; coverings of textile and of plastic for furniture; covers for toilet lids of fabric; covers for cushions; loose covers for furniture; textile wall hangings; shower curtains; cotton, polyester and/or nylon fabric, fabric of imitation animal skins; upholstery fabrics; lingerie fabric; golf towels; banners; banners; bunting; coverings of plastic for furniture; curtains of textile or plastic; flags [not of paper]; plastic material [substitute for fabrics]; shower curtains of textile or plastic.

Class 25: Clothing, footwear, headgear; clothing for men, women and children, namely, shirts, t-shirts, sweatshirts, jogging suits, trousers, jeans, pants, shorts, tank tops, rainwear, cloth bibs, skirts, blouses; dresses, suspenders, sweaters, jackets coats; raincoats, snow suits, ties, robes, hats, caps, sunvisors, belts, scarves, sleepwear, pyjamas, lingerie, underwear, boots, shoes, sneakers, sandals, booties, slipper socks, swimwear and masquerade and halloween costumes, babies' diapers of textile; babies' napkins of textile; boot uppers; boots (heelpieces for-); boots (iron fittings for-); boots (non-slipping devices for-); boots (welts for-); cap peaks; diapers (babies'-) of textile; dress shields; fittings of metal for shoes and boots; footwear (tips for-); footwear uppers; frames (hat-) [skeletons]; hat frames [skeletons]; heelpieces for boots and shoes; heelpieces for stockings; heels; inner soles; linings (ready-made-) [parts of clothing]; napkins (babies'-) of textile; non-slipping devices for boots and shoes; peaks (cap); pockets for clothing; ready-made linings [parts of clothing]; shields (dress-); shirt fronts; shirt yokes; shoes (heelpieces for-); shoes (iron fittings for-); shoes (non-slippings devices for-); shoes (welts for-); soles for footwear; stockings (heel pieces for-); studs for football boots[shoes]; tips for footwear; uppers (footwear-); visors [hatmaking]; welts for boots and shoes; yokes (shirt-).

Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; sewing thimbles; artificial flowers; buttons; badges for wear not of precious metal; adhesive patches; articles and ornaments for the hair; hair bands; hair pins; barrettes; bows for the hair; decorative brooches (clothing accessories); sewing boxes; cosies for beverages or food; cushions for pins; decorative bows, ribbons and tapes; embroidery; haberdashery; shoe laces; artificial fruit; badges [buttons] (ornamental novelty-); badges for wear not of precious metal; badges for wear, not of precious metal; bags (zip fasteners for-); bands (expanding-) for holding sleeves; barrettes

[hair-slides]; beards (false-); belt clasps; birds' feathers [clothing accessories]; blouse fasteners; bodkins; boxes (sewing-); boxes, not of precious metal, for needles; braces (fastenings for-); brassards; brooches [clothing accessories]; buckles (shoe-); buckles [clothing accessories]; busks (corset-); cases (needle-), not of precious metal; clasp (belt-); clothing (fastenings for-); clothing (shoulder pads for-); collar supports; competitors' numbers; corset busks; cosies (tea-); curlers (hair-) [other than hand implements], non-electric; cushions (needle-); cushions (pin -); cyclists (trouser clips for-); darning lasts; decoration of textile articles (heat adhesive patches for-) [haberdashery]; dress body fasteners; dress fastenings; expanding bands for holding sleeves; false beards; false hair; false moustaches; fasteners (shoe-); fasteners (slide-) [zippers]; fastenings for clothing; fastenings for suspenders; feathers [clothing accessories]; fruit (artificial-); haberdashery, except thread; hair (false-); hair (plaited-); hair (tresses of-); hair bands; hair bands; hair coloring caps; hair curlers, [other than hand implements], non- electric; hair curling papers; hair curling pins; hair grips [slides]; hair nets; hair ornaments; hair pins; hair pins; hat ornaments [not of precious metal]; heat adhesive patches for repairing textile articles; laces (shoe-); laces (woollen-); lasts (darning-); letters for marking linen; linen (letters for marking-); marking linen (numerals or letters for -); mica spangles; monogram tabs for marking linen; moustaches (false-); needle cases, not of precious metal; needle cushions; nets (hair-); numbers (competitors' -); numerals for marking linen; ornaments (hair-); ornaments (hat-), [not of precious metal]; ornaments (shoe-), [not of precious metal]; ostrich feathers [clothing accessories]; papers (hair curling -); patches (heat adhesive -) for decoration of textile articles [haberdashery]; patches (heat adhesive -) for repairing textile articles; pin cushions; plaited hair; reins for guiding children; sewing boxes; sewing boxes; sewing thimbles; sewing thimbles; shoe buckles; shoe fasteners; shoe laces; shoe laces; shoe ornaments, [not of precious metal]; shoulder pads for clothing; shuttles for making fishing nets; slide fasteners [zippers]; slide locks for bags; slides [hair grips]; spangles for clothing; supports (collar-); suspenders (fastenings for-); tabs (monogram-) for marking linen; tea cosies; thimbles (sewing-); top-knots [pompoms]; toupees; tresses of hair; trouser clips for cyclists; whalebones for corsets; wigs; woollen laces; zip fasteners; zippers; Pin cushions; linen (numerals for marking-); hair colouring caps; brooches (clothing accessories).

Class 27: Carpets, rugs, mats and matting; floor coverings; linoleum and other materials for covering existing floors; vinyl floor coverings; wall hangings (non-textile); tapestry (wall hangings), not of textile; wallpaper; vinyl and linoleum floor coverings; ceiling coverings; bath mats; door mats; reed mats; gymnasium mats; artificial turf; mats of woven rope for ski slopes; ski slopes, (mats of woven rope for -); turf (artificial -); wallpaper; wallpaper.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; toys and sporting goods, namely, action figures and accessories therefor; plush toys; balloons; bathtub toys; ride-on toys; playing cards; equipment sold as a unit for playing card games; toy vehicles; dolls; flying discs; amusement apparatus for use in arcades; stand alone video output game machines; coin or counter operated arcade games; pinball game machines; electronic hand-held games unit; game equipment sold as a unit for playing a board game, a card game a manipulative game, a parlor game, a parlor-type computer game, an action type target game; jigsaw and manipulative puzzles; paper party favors; paper hats; paper face masks, masquerade and Halloween masks; skateboard; ice skates; water squirting toys; balls, namely, playground balls, soccer balls, baseballs, basketballs; baseball gloves; surfboards; swimming floats for recreational use; kickboard flotation devices for recreational use; swim boards for recreational use; swim fins; toy zip guns; toy bakeware and toy cookware; toy banks; toy snow globes; Christmas tree ornaments.

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and milk products; edible oils and fats; processed and dried vegetables; processed and dried fruits; processed ginseng; raisins; nuts; food products made from nuts; fruit salads; fruit jellies; dairy puddings; dessert puddings; marmalade; yoghurt; preserved onions, preserved olives; crystallized fruits; vegetable and fruit juices for cooking; jams, chocolate nut butter, cocoa butter and peanut butter; canned pasta foods; canned fruits and vegetables; pickles; soybean-based food beverages used as a milk substitute; frozen fruits and vegetables; processed and dried meat; sea food; margarine; foodstuffs in the form of snack foods; snack foods made from meat; snack foods made from pre-cooked vegetables: snack foods made from eggs; corn snacks (other than confectionery); potato snacks; potato chips; potato crisps; cheese; cheese in the form of dips, spreads

and sticks; milk shakes; dairy products for making milk shakes; preparations for making milk shakes; prepared meals, prepared cooked meals, prepared frozen meals, all included in class 29.

Class 30: Sugar, rice, tapioca, sago, artificial, coffee, flour and preparations made from cereals, ices; pasta; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, fruit sauces, sauces (condiments); spices; ice; cookies, breakfast cereal, bubble gum, cake decorations made of candy, chewing gum, frozen confections, crackers; frozen yoghurt, ice cream, pretzels, peanut butter, confectionery chips, malt for food; soybean malt; malt biscuits; sugar confectionery; candy, candy bars, candy mints; chocolate; chocolate confectionery; chocolate decorations for Christmas trees; cakes; cake preparations; edible decorations for cake; popcorn; flavoured popcorn; cereal based snack foods; rice cakes; crisp snack food products; crispbread snacks; prepared savory foodstuffs in the form of snack foods; flour based savory snacks; corn chips; tortillas; pastilles; pastries; custard; custard mixes and powder; coffee beverages with milk; cocoa beverages with milk, chocolate-based beverages, coffee and coffee-based beverages, cocoa and cocoa-based beverages; tea, namely, ginseng tea, black tea, oolong tea, barley and barley-leaf tea; meat tenderisers for household purposes; binding agents for ice-cream; prepared meals, prepared cooked meals, prepared frozen meals, all included in class 30.

Class 32: Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; vegetable juice for beverages; sweet drinks prepared with rice and malt, fruit powder, fruit syrup, concentrated fruit juice; lemonades and syrup for lemonade; cola syrup; powders for effervescing beverages; pastilles for effervescing beverages; non-alcoholic beverages, namely soft drinks, fruit nectars; fruit juices, fruit drinks, fruit flavoured soft drinks, fruit punch, seltzer water, soda water, drinking water and sports drinks; preparations for making aerated water and juice; mineral and spring water.

Class 41: Education; providing of training; entertainment sporting and cultural activities; entertainment services in the nature of live-action, comedy, drama and/or animated television programmes; production of live-action comedy, drama and/or animated television programmes; entertainment services in the nature of live-action

comedy, drama and/or animated motion picture theatrical films; production of live-action comedy, drama and/or animated motion picture theatrical films; and theatrical performances both animated and live action; video and audio recording production and recitals; education and entertainment services provided via a global computer network; information relating to education and entertainment provided on-line from a computer database or the Internet; electronic games services provided via a global computer network; providing on-line publications (non-downloadable); on-line publication of electronic books and journals (non-downloadable) publication and distribution of printed media and recordings; publication of sheet music organising of entertainment and social events; booking of entertainment; entertainer services; club entertainment services; provision of dancing facilities; nightclub, discotheque, music hall, concert, dance hall, ballroom, cabaret services; circuses; provision of live entertainment; production of live entertainment; arranging of visual and musical entertainment; audio-visual display presentation services for entertainment purposes; organising of events, exhibitions and shows for entertainment purposes; production of audio entertainment; production of entertainment shows featuring dancers and singers; music competition services; organisation of balls; organisation of shows; providing karaoke services; management of entertainment services; training and management of performance artists; provision of entertainment services on cruise ships; video arcade services; providing amusement arcade services; amusement arcade machine rental services; theme park services; amusement park services with a theme of films; amusement park services with a theme of radio productions; amusement park services with a theme of television productions; education and training services relating to the establishment, operation, administration, management and conduct of amusement and theme parks; movie studios; recording studio services; television entertainment; cinema services; providing cinema and theatre facilities; booking agency services for cinema tickets; rental and leasing of movie projectors and accessories; rental of cinematographic and motion picture films; distribution of cinematographic and motion picture films; editing of cinematographic and motion picture films; showing of cinematographic and motion picture films; organisation and management of cinemas and theatres; education and training services relating to the establishment, operation, administration, management and conduct of cinemas and theatres; training services for cinema technicians; providing of sports facilities; providing of recreation facilities, services and amenities; leisure centre and boating

lake services; provision of swimming facilities, services and amenities; tenpin bowling alley and bowling green services; providing of golf facilities; providing of tennis court facilities; health and fitness club services; providing of casino and gaming facilities; booking of seats for shows; organisation of quizzes, games and competitions; organisation of beauty competitions; organisation of sporting competitions; rental of diving equipment; rental of sports equipment; arranging, planning and conducting of conferences, seminars, exhibitions and banquets; information, advice and consultancy relating to all the aforesaid services; booking of seats for shows; booking of seats for shows; books (publication of-); digital imaging services; diving equipment (rental of skin-); education information; electronic desktop publishing; entertainment information; information (education -); information (entertainment-); information (recreation-); interpretation (sign language -); microfilming; modelling for artists; movie projectors and accessories (rental of-); providing on-line electronic publications [not downloadable]; publication of books; publication of electronic books and journals on-line; publication of texts [other than publicity texts]; radio and television sets (rental of-); recorders (rental of video cassette -); recreation information; rental of audio equipment; rental of camcorders; rental of lighting apparatus for theatrical sets or television studios; rental of movie projectors and accessories; rental of radio and television sets; rental of show scenery; rental of skin diving equipment; rental of sports equipment (except vehicles); rental of stage scenery; rental of video cameras; rental of video cassette recorders; show scenery (rental of-); sign language interpretation; sports equipment (rental of-) [except vehicles]; sports events (timing of-); stage scenery (rental of-); television sets (rental of radio and-); texts (publication of-), other than publicity texts; timing of sports events; translation; videotaping.

EUTM 38299:

Class 3: Soaps; perfumery; essential oils; cosmetics; lip balm; talcum powder; shower gel; bubble bath; hair shampoo; make-up for the face; toothpaste.

Class 9: Cinematographic films; sound and/or video recordings, all in the form of the records, tapes, discs or cassettes; prescription and non-prescription eyeglasses;

eyeglass cases; film strip viewers; computer games and video games; magnets included in this class.

Class 14: Jewelry; coins; watches and clocks.

Class 16: Printed matter; printed periodical publications; books, including coloring books; stationery articles; calendars; note cards, greeting cards and trading cards; lithographs; posters; paper napkins, plates and mats; paper stickers; printed transfers for embroidery or fabric appliques; printed patterns for costumes, pajamas, sweatshirts and t-shirts; pens and pencils, all the foregoing goods being goods included in this class.

Class 21: Cookery molds and cooking pots; mugs, pitchers; tumblers; bottles; bowls and boxes, all the foregoing goods being goods included in this class.

Class 24: Textile fabric piece goods; towels, linens, duvets (bed covers), bed spreads, sheets, pillowcases; textile curtains (all the foregoing goods being goods included in this class).

Class 25: Hats and caps; shorts; jackets; shirts; sweatshirts; t-shirts; tank tops; bathrobes; gloves and mittens; jogging outfits; trousers; jeans; rainwear; swimwear; underwear; pajamas; costumes; suspenders; slippers; slipper socks; hosiery; sneakers; thongs; sandals; shoes and boots; fabric belts.

Class 28: Toys, games and playthings; parts and fittings for all of the aforesaid goods; masks (except for sports); novelty buttons, novelties and party hats.

Class 30: Cocoa, sugar, cereals, bread, pastry and confectionery, ices.

Class 32: Mineral and aerated waters and non-alcoholic beverages all in liquid and powdered form; fruit drinks and fruit juices.

Class 41: Entertainment services all relating to the production and distribution of films, video tapes, cassettes, tapes, records and compact discs.

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Class 9: Game cartridges, video and computer game programs, cartridges and cassettes.

Class 28: Toys and sporting goods, games and playthings, action figures and accessories therefor; plush toys; balloons; bathtub toys; ride-on toys; card game equipment; toy vehicles; dolls; flying discs; electronic hand held game units; game equipment sold as a unit for playing a board game, a card game, a manipulative game, a parlour game, a parlour-type computer game and an action type target game; video output game machines; puzzles; paper face masks; costumes; costume masks; skateboards; ice skates; water-squirting toys; balls, playground balls, soccerballs, sportballs, baseballs, basketballs; baseball gloves.