

BL O/0549/23

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
NO. WO0000001585808 IN THE NAME
OF TRANSPORTS CORDIER
FOR THE FOLLOWING TRADE MARK:**



IN CLASS 25

AND

**IN THE MATTER OF AN OPPOSITION
THERE TO UNDER NUMBER 428134
BY JUST HYPE LIMITED**

BACKGROUND AND PLEADINGS

1. Transports Cordier (“the applicant”) is the holder of the International Registration shown on the cover page of this decision (“the IR”). The IR was registered on 5 February 2021 and, with effect from the same date, the applicant designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR is derived from the applicant’s French trade mark, being that numbered 4710522, and enjoys a priority date of 9 December 2020. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 13 August 2021 in respect of the following goods:

Class 25: Clothing for men, women, young men, young women, boys and girls, babies; headbands [clothing]; overalls; teddies [underwear]; hosiery; boots; suspenders; boxer shorts; bathing trunks; caps; belts [clothing]; hats; socks; footwear; shirts; short-sleeve shirts; tights; combinations [clothing]; suits; neckties; sports tank tops; neckerchiefs; scarves; gabardines [clothing]; gloves [clothing]; jerseys [clothing]; skirts; leggings [trousers]; bathing suits; sports jerseys; rashguards; slippers, footwear, bedroom slippers; coats; trousers; overcoats; parkas; dressing gowns; pocket squares; ponchos; pullovers; pajamas; dresses; sandals; underwear; tee-shirts; knitwear [clothing]; uniforms; stuff jackets; jackets; clothing; outerclothing; cap peaks; sleeveless down vests; sweatshirts; hooded sweatshirts; teddies [undergarments]; long scarves; tap shoes; flip-flops; beach sandals; stocking caps; vests, stuff jackets, raincoats, gabardines, pea coats, overcoats, duffle coats, blousons.

2. On 12 November 2021, Just Hype Limited (“the opponent”) opposed the application in full. The opposition is based upon sections 5(1), 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and is reliant upon the following UK trade marks:

Hype

UK registration no. 911755113¹

Filing date 19 April 2013; registration date 18 November 2013

Registered for the following goods and services:

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas.

Class 25: Clothing, footwear, headgear.

Class 35: Advertising; business management; business administration; office functions; accountancy; provision of business information; retail services connected with the sale of watches, jewellery, costume jewellery, stationery, leatherwear, furnishings, textiles and textile goods, clothing, footwear and headgear, games and playthings, sports articles, perfume and cosmetics, clocks and sunglasses.

("the opponent's first mark")

The logo consists of the word "hype." written in a black, cursive, handwritten-style font. The letters are connected and have a fluid, dynamic feel. The period at the end is a simple dot.

UK registration no. 911514908

Filing date 24 January 2013; registration date 29 May 2013

Registered for the following goods and services:

¹ The opponent's marks are comparable trade marks based on its earlier EUTMs, being registrations numbered 011755113 and 011514908. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags; umbrellas.

Class 25: Clothing, footwear, headgear.

Class 35: Advertising; business management; business administration; office functions; accountancy; provision of business information; retail services connected with the sale of watches, jewellery, costume jewellery, stationery, leatherware, furnishings, textiles and textile goods, clothing and footwear, games and playthings, sports articles, services relating to the management of shops selling perfumery and cosmetics, clocks and watches, sunglasses, jewellery, costume jewellery, stationery, textiles and textile goods, clothing and footwear, games and playthings, sports articles.

("the opponent's second mark")

3. Under section 5(1), the opponent claims that the IR is identical to its first mark and, as it is to be registered for identical goods, there exists a likelihood of confusion. Under this ground, the opponent relies upon its goods in classes 18 and 25 only.
4. Under section 5(2)(b), the opponent claims that the IR is similar to both its first (in the alternative to section 5(1)) and second marks and, as it is to be registered for identical or similar goods, there exists a likelihood of confusion. Under this ground, the opponent relies upon its goods in classes 18 and 25 only.
5. Under section 5(3), the opponent claims that both its marks have a reputation in the UK for all the goods and services for which they are registered. The opponent claims that use of the IR would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

6. The applicant filed a defence and counterstatement denying the entirety of the grounds of opposition and requesting that the opponent provide proof of use for the marks relied upon.
7. The opponent is represented by Howes Percival LLP and the applicant by Mills & Reeve LLP. Only the opponent filed evidence in these proceedings. Neither party requested a hearing and only the opponent filed written submissions in lieu. The evidence will be summarised to the extent that it is considered necessary.

EVIDENCE

8. The opponent filed evidence in the form of the witness statement of Liam Reece Green dated 8 August 2022 and its corresponding nine exhibits (LRG1 – LRG9). Mr Green is a director of the opponent, having co-founded the company in 2011. I note that, during the evidence rounds, the opponent also filed written submissions.
9. I will refer to points from the evidence and the submissions where necessary.

DECISION

Proof of use

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

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

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

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

11. The relevant statutory provisions are as follows:

“Section 6A

“(1) This section applies where

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

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

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

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

12. When comparable marks are put to proof of use, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

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

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

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

13. Section 100 of the Act is also relevant. This reads:

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

14. Given their filing dates, the opponent’s marks qualify as earlier trade marks under the above provisions. Both marks completed their registration processes over five years prior to the priority date of the IR and, as above, the applicant has put the opponent to proof of use for its marks.

15. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch)

Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it

guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed

to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

16. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s marks is the 5-year period ending with the priority date of the IR, being 9 December 2020. Therefore, the relevant period for this assessment is 10 December 2015 to 9 December 2020.

17. As the opponent’s marks are comparable marks based upon earlier EUTMs, use of the marks in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.² Given that the entirety of the relevant period falls prior to IP Completion Day, the EU is the relevant territory for proof of use. On this point, I refer to the case of *Leno Marken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

² See paragraph 4 of Tribunal Practice Notice 2/2020

And

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

18. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”³ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the marks

19. I note the presence of ‘HYPE’ as a word only mark throughout the opponent’s evidence, however, the majority of the evidence shows that the branding used on the opponent’s goods is its second mark. On this point, I remind myself of the comments of Mr Philip Johnson who, sitting as the Appointed Person in the case of *Dreamersclub Ltd v KTS Group Ltd*,⁴ found that the use of the mark shown below qualified as use of the registered word only trade mark ‘DREAMS’. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

The word "dreams" is written in a black, cursive, handwritten-style font. The letters are connected and have a fluid, organic feel. The 'd' starts with a large loop, and the 's' ends with a small tail.

³ *Jumpman* BL O/222/16

⁴ Case BL O/091/19

I consider that a similar outcome applies here. This is on the basis that the opponent's second mark uses an identical (albeit stylised) word element as that of its first mark and I consider that use of the same is a valid expression of its first mark.

20. Another example of use that I am required to consider is the opponent's use of the following branding on a number of its goods:



21. While the wreath element is a point of difference between the example shown and the marks relied upon, I consider that it is acceptable use of the opponent's marks as registered or, in the alternative, an acceptable variant of the same. Firstly, I remind myself that use of a registered trade mark covers its use as part of another mark or as part of a composite mark.⁵ This is clearly the case here and, bearing in mind my findings at paragraph 19 above, I conclude that the above example is acceptable use of both of the opponent's marks as registered. Even if it is not, the difference is the simple addition of a non-distinct element which the average consumer will see as nothing but a border element, albeit stylised. As such, I see no reason why its addition would alter the distinctive character of either of the opponent's marks.⁶

22. Lastly, I note that throughout its evidence, the opponent has demonstrated use of the branding 'JUSTHYPE'. I do not consider it necessary to labour over this point in any great detail as use of this branding is limited and does not impact upon the majority of the use shown which is use of the 'HYPE' branding. However, I will say

⁵ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

⁶ See the case of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22 which sets out the correct approach for considering use in a differing form.

that I do not consider that use of the branding 'JUSTHYPE' is an acceptable variant of the opponent's marks. Briefly, I consider that the addition of 'JUST' before 'HYPE' creates a new phrase and this, in my view, alters the impression of the opponent's marks. Consequently, I find that the alteration in impression also alters the distinctive character of the opponent's marks. For the avoidance of doubt, the following assessment will not take this branding into account.

Sufficient Use

23. The opponent's evidence sets out that it began selling clothing goods in 2011. The business began as a self-funded project and quickly evolved into what Mr Green refers to as one of the United Kingdom's most recognisable brands. It opened a flagship store in London 2013 and has since opened two more stores, one in Leicester and another in Portsmouth (although it is not confirmed when so it is possible that these stores were not open during the relevant period). In addition to the physical retail stores, the opponent confirms that its main retail outlet is its website, being 'www.justhype.co.uk'.

24. The evidence pointing to use of the opponent's marks is extensive and I note, for example, it includes a wide array of print-outs taken from the opponent's website. I note that one of the print-outs provided is not dated but does refer to the opponent's 'AW19' collections.⁷ I do not consider it controversial to suggest that this is to be taken as meaning the Autumn/Winter 2019 collection. So while the print-out is undated, it does reflect the position regarding the goods sold by the opponent during the relevant period. This print-out shows goods such as t-shirts, jumpers, hoodies, backpacks, bum bags, bobble hats, beanies, suitcases, swimming suits, joggers, jackets, leggings and shorts.

25. In addition to the undated print-out discussed above, there are dated print-outs taken from the internet archive facility, the Wayback Machine.⁸ The print-outs show 'HYPE' branded products for sale on the opponent's websites between 10 January

⁷ LRG1

⁸ LRG3

2016 and 29 November 2020. I note that the goods shown on these print-outs overlap somewhat with the ones discussed in the preceding paragraph but also include additional goods such as baseball caps, a scarf, trousers, drawstring bags, sliders (which are, as I understand it, a type of sandal) and trainers.

26. I note that additional goods are shown in the evidence such as watches, sunglasses, travel mugs and various types of stationery, for example.⁹ While these goods are not relied on in these proceedings, retail services in relation to them are. Further, there are two print-outs taken from Argos and Next that show a faux-leather backpack and faux-fur slippers, respectively.¹⁰ However, these are undated and there is nothing before me to suggest the availability of these goods during the relevant period. Therefore, this evidence is of no assistance to the opponent.

27. In respect of the goods sold, the opponent has provided evidence of turnover figures for the years 2015 to 2021. These are as follows:

| Financial Year | Annual Turnover |
|--------------------------------|------------------------|
| 2015 – 2016 (18 month period) | £3,052,245 |
| 2016 – 2017 | £2,417,147 |
| 2017 – 2018 (14 month period) | £4,1341,439 |
| 2018- 2019 | £4,041,907 |
| 2019-2020 | £12,608,297 |
| 2020-2021 (draft figures only) | £17,721,121 |

28. These figures are noted and I accept that they are sizable, however, I note the following issues with the turnover evidence (all of which will be borne in mind going forward):

- a. There is no indication that these figures relate solely to the UK or EU markets and, as such, I shall take them as covering the opponent's global turnover;

⁹ Page 102 of LRG3 shows what appears to be cosmetic type goods but under the sub-category of 'gifting', however, it is not clear what actual goods this evidence shows.

¹⁰ Page 81 of LRG2

- b. There is no confirmation as to what goods these figures cover and while I note that the majority of the evidence focuses on clothing, I have discussed above that there are a range of goods covered by the evidence which are not relied upon in the present proceedings;
- c. The relevant period did not begin until 10 December 2015 but the figures for 2015 – 2016 cover a vague 18 month period. While I accept that some of those figures are from within the relevant period, some are not;
- d. The figures for 2017 to 2018 contain what appears to be a typographical error that I have not sought to amend as it is not clear where the error lies. I do not accept that this figure would be in the region of £41 million as this would be entirely inconsistent with the remaining figures. Based on the figures from the surrounding years, I accept that the turnover for this period is comfortably in the £4 million range (be that £4.1 or £4.3 million); and
- e. The most recent figures for 2020 to 2021 are 'draft figures only' and I note that the relevant period concludes on 9 December 2020 meaning that any figures from 2021 will not be relevant to this decision.

29. When discussing the above turnover figures, I note that Mr Green's narrative evidence sets out that the opponent is a very successful company and has a substantial market share. While the latter point is noted, there is no evidence provided that demonstrates the opponent's actual market share in the relevant markets within which it operates. The only evidence I can find that remotely supports such a claim is a reference to it being placed at 26 on the 'Sunday Times Fast Track 100' list. The opponent states that this is a list of up and coming businesses based on their annual turnover. While noted, only the front cover of the magazine is provided¹¹ and there is no indication of what year this article was published. Further, I am not convinced that a high ranking amongst other 'up and coming' businesses is a testament to a substantial market share.

30. Marketing figures are provided for the same periods covered by the turnover figures reproduced above. These are as follows:

¹¹ LRG7

| Year | Marketing Outlay |
|-------------------------------|-------------------------|
| 2015 – 2016 (18 month period) | £426,000 |
| 2017 | £392,843 |
| 2018 (14 month period) | £634,212 |
| 2019 | £1,696,844 |
| 2020 | £2,371,016 |
| 2021 (draft figures only) | £6,263,152 |

31. I accept that these figures are sizable but, as was the case with the turnover figures provided above, there is no confirmation that these figures relate to UK or EU spend and the totality of this evidence is bookended with figures that inevitably fall outside of the relevant period.

32. I note that there is some evidence before me in these proceedings that is from 2015, which is prior to the relevant period. This includes a promotional brochure by which makes reference to a number of celebrities such as Jay Z, 50 Cent and Cara Delevingne wearing 'HYPE' products.¹² While this evidence is noted, it is from prior to the relevant period so is of no relevance to the issue of genuine use.

33. The evidence makes reference to a number of collaborations with other brands and that, for these, the opponent hosts a range of parties in the UK and overseas (in locations such as Ibiza). Evidence of these events is provided¹³ and I note that they include UK-based events during the relevant period for crossovers with Budweiser, Specsavers, PlayStation, Call of Duty, Jurassic Park and Star Wars, amongst others. Of the evidence provided, I note that the events show clear representations of the opponent's HYPE branding and, while no attendee numbers are provided, it is clear from the photographic evidence of the events that there were many people in attendance at the events. On the point of this evidence, I note that Mr Green claims that it serves as evidence that the opponent provides advertising services to these other brands.

¹² LRG4

¹³ Pages 187 to 250 of LRG6

34. In respect of sponsorships, I note that the opponent confirms that since 2016, it has sponsored Leicester City Football Club. The evidence in support of this point shows the opponent's branding on a pitch-side advertising board at a Leicester City match.¹⁴ On the point of sponsorships, I note that the opponent sponsored the Eastern Electrics Festival in both 2018 and 2019, the Strawberries & Cream Festival in 2019 and the Love Box Festival in 2019.¹⁵ While these are UK based festivals, there is no evidence as to the level of attendance at these events. Additional international festivals are discussed¹⁶ and, of these, I note that some (but not all) are events within the EU such as the Ibiza Rocks Festival in Ibiza in 2016, the Fresh Island Festival in Croatia in 2017 and the Bread & Butter Trade Show in Germany in 2017. Again, no attendance figures are provided for these events so it is unclear the reach that any sponsorship efforts would have had.

35. Social media accounts are then discussed and evidence of those accounts is provided.¹⁷ While the accounts and their follower numbers are noted, the print-outs appear to have been captured in August 2022, almost two years after the conclusion of the relevant period. Further, the print-outs show no posts from within the relevant period. It is, therefore, not possible to determine whether these figures are accurate for the relevant period. Further, as is commonly the case with social media evidence, there is nothing suggesting that the followers are UK or EU based and, in the present case, this is particularly an issue given the opponent's reliance on international evidence which suggests a presence outside of the relevant territory.

36. In making a global assessment of the evidence, I note that in total, the figures provided show a turnover of approximately £43 million¹⁸ and a marketing spend of approximately £11 million. These are not insignificant figures but I must bear in mind that they are likely include turnover and marketing spend from outside the relevant territory, from outside the relevant period and from goods that are not at issue in the present proceedings. Even taking all of these points into account, I am

¹⁴ LRG5

¹⁵ Pages 250 to 255 of LRG6

¹⁶ Pages 258 to 265 of LRG6

¹⁷ Pages 269 to 271 of LRG8

¹⁸ This approximation is made whilst bearing in mind my comments at paragraph 28(d) regarding the typographical error in the 2017 to 2018 figures.

content to conclude that the majority of these figures will relate to the EU sales of clothing goods within the relevant period. I make this finding on the basis that the evidence has a particular focus on clothing goods and is targeted at the opponent's presence in the EU.

37. While there is no way for me to determine the precise level of turnover (or marketing spend, for that matter) for the relevant goods in the relevant territory over the relevant period, I am of the view that it will still be in the region of multiple millions of pounds. In respect of market share, I note that the opponent's narrative evidence set out that it has a substantial market share. While such a claim is noted, no supporting evidence has been provided. On this point, I am of the view that the relevant markets for the goods that the opponent sells are likely to be enormous. When compared against such markets, the opponent's turnover in the EU for the relevant period was, in my view, low. Having said that, I remind myself that use of a mark need not always be quantitatively significant for it to be deemed genuine and that minimal use may qualify as genuine if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods. Lastly, in respect of geographical spread of the opponent's use, I refer to the evidence's reach across the UK (and specific focus on '.co.uk' websites) and its presence in a number of EU member states.

38. Taking all of the above into account, I am content to conclude that the opponent has used its marks in the UK and across the EU during the relevant periods. That being said, I do not consider that the opponent has demonstrated use for all goods and services for which its marks are registered and I will now consider a fair specification in respect of the above.

Fair Specification

39. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (although it equally applies to the issue of a fair specification for proof of use assessments):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been

used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

40. While the opponent’s marks have slightly different specifications, I believe that I can deal with them together. I will begin with the class 25 goods as this is the class of goods upon which the evidence focuses.

Class 25 goods

41. I remind myself that the evidence shows the opponent’s marks on a wide range of clothing goods such as t-shirts, trousers, jackets, hoodies and shorts. While it does not cover *all* clothing goods, it is not necessary that it does so. On this point, I remind myself of the case law cited above which sets out that a proprietor cannot reasonably be expected to provide evidence for all possible goods under broad terms. Instead, the question I must consider here is how would the average consumer fairly describe the goods? Given the range of clothing goods shown in the evidence, I am satisfied that the average consumer would not look to subcategorise the types of clothing shown and would, instead, categorise it as covering “clothing” at large. Consequently, I consider that stripping the goods down to the precise goods shown in the evidence would unfairly strip the opponent of protection for all goods which the average consumer would consider as belonging to the same category of goods as those for which the marks have been used.

42. In addition to clothing, I note the presence of trainers, slider sandals, baseball caps, bobble hats and beanies in the evidence. However, despite what I have found above, I do not consider that the use of these goods would cover the broad terms “footwear” and “headgear” at large. In my view, such a categorisation after only showing evidence of two types of footwear and only three types of hats would offer an unfair monopoly to the opponent when it has only shown use for a very limited range of footwear and headgear. For example, “footwear” would cover goods such as ballet shoes, boots and slippers and “headgear” would cover anything that is worn on the head such as balaclavas, snoods, bandanas and turbans. Instead, I consider that, in the present case, a fair specification of “footwear” and “headgear” would be “trainers [footwear]”, “sandals” and “hats”. I do not consider that such a

distinction would unfairly restrict the protection offered to the opponent by its marks.

43. As an additional point, I note that the evidence shows an example of one scarf but I do not consider that this is a type of clothing good (it is, instead, an accessory) and as the opponent does not have a term that would ordinarily cover such a good, it cannot proceed to rely on the same.

Class 18 goods

44. As I have set out above, the evidence shows use of backpacks, bum bags, suitcases and drawstring bags (which are a subcategory of backpacks). These are, in my view, different types of travelling bags and, on this point, I note that the opponent's class 18 goods include the term "trunks and travelling bags" which inevitably includes goods for which no evidence has been provided such as, amongst others, trunks, briefcases and holdalls. While I have found the various clothing goods in the opponent's evidence sufficient to cover "clothing" at large, I do not consider the same applies here on the basis that the goods shown in the evidence are their own types of sub-categories of travelling bags and, upon being confronted with such use, the average consumer will use those individual terms rather than look to categorise them as "trunks and travelling bags". As such, I conclude that a fair specification of the goods shown in the evidence is "backpacks and bum bags" and "suitcases".

45. In respect of the remaining goods in class 18, I note that there is no evidence of these goods and, therefore, there can be no genuine use of the same.

Class 35 services

46. I have discussed above that the opponent operates its own physical and online retail service in relation to all of its goods, with the online retail being its main outlet. Given the sales figures provided, I am satisfied that a significant proportion of the same would have stemmed from the opponent's own retail services opponent. Consequently, I accept that the opponent has demonstrated use of the same. On

this point, I note that the opponent's services include the retail of goods that are not present in the list of goods that the opponent relies on. So while the opponent may not rely on those goods in other classes, it may rely on the retail of some of them, namely watches and stationery goods. Having said that, the goods covered by the opponent's retail services are still broader than the goods it has demonstrated that it has sold. Therefore, I consider it necessary to limit the opponent's retail services as follows:

“Retail services connected with the sale of watches, stationery, clothing, trainers [footwear], sandals, hats and sunglasses.”

47. Neither of the opponent's specifications cover the retail of the opponent's backpacks, bum bags, drawstring bags or suitcase goods so no allowance can be made for the retail of these goods.

48. In respect of advertising, I remind myself that the opponent claims that by promoting its collaborations, it provides advertising services to its collaborators. While this is noted, I do not agree that it covers the actual provision of advertising services to third parties. Firstly, there is no evidence of any actual agreement for the provision of advertising services with these collaborators and, second, it is my view that the promotion of a collaboration is a mutually beneficial endeavour for the parties involved and is, in essence, the promotion of the opponent's own brand. Just because a company seeks to promote its own brand, it does not equate to the provision of advertising services to actual customers.

49. I note that the opponent's second mark's specification includes services relating to the management of shops but, following the same reason when discussing advertising above, just because the opponent operates its own shops, it does not mean that it provided 'services for the management of shops' to customers. As such, I do not consider that there is any genuine use of this service. As far as the remaining services go, I note that the evidence does not cover these and, therefore, there can be no genuine use of the same.

50. To confirm, my fair specification assessment for the opponent's marks has resulted in them sharing the same specification, which I confirm is as follows:

Class 18: Backpacks and bum bags; suitcases.

Class 25: Clothing; trainers [footwear]; sandals; hats.

Class 35: Retail services connected with the sale of watches, stationery, clothing, trainers [footwear], sandals, hats and sunglasses.

Section 5: legislation and case law

51. Section 5 of the Act reads as follows:

“(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

(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 or association with the earlier trade mark.”

52. Section 5A of the Act states as follows:

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

Section 5(1)

53. The 5(1) opposition is based on the opponent’s first mark only, being a word only mark.

Identity of the marks

54. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

55. Additionally, Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14 stated that:

“21... It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks [...] A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

56. In its submissions, the opponent argues that despite the presence of the applicant’s device element, the marks are identical. In support of this argument, the opponent

relies on two cases, namely *Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG v OHIM*, Case T-356/02 and *THINK PINK*, Case BL O/484/02. I note that the mark comparisons in these cases were VITAKRAFT against KRAFFT (fig.) and two figurative marks consisting of the same words, being 'THINK PINK'.

57. In respect of the *VITAKRAFT* case, the conclusion was simply that the marks were similar on the visual and phonetic levels. In the *THINK PINK* case, the Hearing Officer concluded that the marks at issue were highly similar. In the present case, I am unsure as to how either case supports the argument that the marks at issue are identical. On the contrary, I find that they are not. As it is a pre-requisite of section 5(1) oppositions that the trade marks are identical, the opponent's reliance on this ground must, therefore, fail.

Section 5(2)(b): case law

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

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

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of goods

59. Subject to my findings in respect of genuine use and a fair specification thereof, the competing goods of the parties are as follows:

| The opponent's goods | The applicant's goods |
|--|---|
| <p><u>Class 18</u> Backpacks and bum bags; suitcases.</p> <p><u>Class 25</u> Clothing; trainers [footwear]; sandals; hats.</p> | <p><u>Class 25</u> Clothing for men, women, young men, young women, boys and girls, babies; headbands [clothing]; overalls; teddies [underwear]; hosiery; boots; suspenders; boxer shorts; bathing trunks; caps; belts [clothing]; hats; socks; footwear; shirts; short-sleeve shirts; tights; combinations [clothing]; suits; neckties; sports tank tops; neckerchiefs; scarves; gabardines [clothing]; gloves [clothing]; jerseys [clothing]; skirts; leggings [trousers]; bathing suits; sports jerseys; rashguards; slippers, footwear, bedroom slippers; coats; trousers; overcoats; parkas; dressing gowns; pocket squares; ponchos; pullovers; pajamas; dresses; sandals; underwear; tee-shirts; knitwear [clothing]; uniforms; stuff jackets; jackets; clothing; outerclothing; cap peaks; sleeveless down vests;</p> |

| | |
|--|---|
| | sweatshirts; hooded sweatshirts; teddies [undergarments]; long scarves; tap shoes; flip-flops; beach sandals; stocking caps; vests, stuff jackets, raincoats, gabardines, pea coats, overcoats, duffle coats, blousons. |
|--|---|

60. When making the comparison assessing the similarity of the goods or services, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“[...] 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”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

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

62. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

63. In its counterstatement, the applicant denies any identity of similarity between the parties' class 25 goods. This is clearly not the case as "hats" and "sandals" appear in both parties' specifications and are, therefore, self-evidently identical. Further, the opponent's marks' specifications include the terms "clothing", "hats" and "sandals" that will encompass a majority of the applicants' goods, namely:

"Clothing for men, women, young men, young women, boys and girls, babies; overalls; teddies [underwear]; hosiery; boxer shorts; caps; bathing trunks; socks; shirts; short-sleeve shirts; tights; combinations [clothing]; suits; sports tank tops; gabardines [clothing]; jerseys [clothing]; skirts; leggings [trousers]; bathing suits; sports jerseys; rashguards; coats; trousers; overcoats; parkas; dressing gowns; ponchos; pullovers; pajamas; dresses; underwear; tee-shirts; knitwear [clothing]; uniforms; stuff jackets; jackets; clothing; outerclothing; sleeveless down vests; sweatshirts; hooded sweatshirts; teddies [undergarments]; flip-flops; beach sandals; stocking caps; vests, stuff jackets, raincoats, gabardines, pea coats, overcoats, duffle coats, blousons."

Under the principle outlined in *Meric*, the above goods of the applicant are identical to that of the opponent, be that either "clothing", "hats" or "sandals".

64. “Footwear” (which appears as its own term and within the term “slippers, footwear, bedroom slippers”), in the applicant’s specification covers goods that can be said to include the narrower terms of the opponent, being “trainers [footwear]” and “sandals”. These goods are, therefore, identical under the principle outlined in *Meric*.
65. “Boots” and “slippers [and] bedroom slippers” are types of footwear and while not identical to the opponent’s “trainers [footwear]” or “sandals”, they are similar. These goods overlap in nature and method of use in that they are all footwear goods that are worn on the foot. As for purpose, I consider that there is some difference in that the applicant’s goods have different purposes to trainers or sandals. Having said that, the core purpose is the same in that all goods are worn for the purpose of protecting or covering the user’s foot. In respect of the remaining factors, being user and purpose, I consider that these will overlap also in that all of the goods are aimed at members of the general public, will be produced by the same undertakings and are likely to be available via the same retailers. I do not consider that they are competitive goods as I do not suspect that a user will necessarily look to buy trainers or sandals over boots or slippers, or vice versa. Overall, I consider that these goods are similar to a high degree.
66. In considering “tap shoes” in the applicant’s specification, I consider this will overlap in nature and method of use with the opponent’s “trainers [footwear]”. The purpose of these goods will differ but, as was the case above, there is some overlap here but I consider this to be somewhat superficial due to the specific purpose of tap shoes. As for user, I consider that someone looking to buy tap shoes will also be a user of the opponent’s goods. However, when considering trade channels, I have nothing before me to suggest that the producer of tap shoes would also produce trainers or sandals (or vice versa) and neither is there anything to suggest that the goods would be available via the same retailers. On the contrary, I consider that the trade channels will be distinct as the applicant’s goods are likely to be more specialist. Taking all of this into account, I consider that these goods are similar to a medium degree.

67. “Headbands [clothing]” is a type of headgear and, therefore, similar to the opponent’s “hats”. While the nature of these goods differs slightly in that one is a band and the other cover hats, they overlap in method of use, purpose, user and trade channels. As a result, I consider that these goods are similar to a high degree.

68. It is my understanding that the plain reading of the term “cap peaks” in the applicant’s specification is not that of an item of headgear but something that is attached to an item of headgear, such as a hat without a peak. While not identical, it is similar to the opponent’s “hats”. I see no reason why the nature or methods of use for these goods will overlap but I do consider that the user and trade channels will. Further, I consider that there is an overlap in core purpose as both items will be worn on the head and may be worn to shield the user’s eye from the sun regardless of whether they are part of the hat or attached to it in some other way. The goods are not complementary but there is some degree of competitiveness between them because a user may choose to buy peaked cap in its finished form or simply a peak to attach to a hat that they may already own. Overall, I consider that these goods are similar to a medium degree.

69. “Suspenders”, “neckties”, “neckerchiefs”, “scarves”, “gloves [clothing]”, “pocket squares”, “long scarves” and “belts [clothing]” in the applicant’s specification are not, in my view, items of clothing despite two of them being categorised as such. Instead, I consider that they are accessories to clothing (if I am wrong on this point then the goods are clothing goods and, therefore, identical under the principle outlined in *Meric* with the opponent’s “clothing” goods). So while they are not identical to the opponent’s “clothing” goods, they are similar. This is on the basis that the goods overlap in user and trade channels on the basis that they are all likely to be bought by members of the general public, produced by the same undertakings and sold via the same retailers (and for larger retailers, are likely to be displayed in the same sections). Further, I consider that the goods are complementary in that clothing is important and indispensable to the applicant’s goods. For example, belts and suspenders are used to hold up items of clothing. It is my view that as a result of the close association between these goods, the average consumer is likely to consider that one undertaking is responsible for both

sets of goods.¹⁹ Overall, I consider that these goods are similar to a medium degree.

The average consumer and the nature of the purchasing act

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

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

71. In my view, the average consumer for the goods at issue will be members of the general public at large. The goods at issue will be available via retail stores and their online equivalents, be that specialist (for tap shoes, for example) or general. In physical stores, the goods will be displayed on racks or shelves and self-selected by the consumer. A similar process will apply to selections made on websites in that the goods will be selected by the consumer after having viewed an image on a webpage. In my view, the visual aspect will dominate the selection process, however, I do not discount the aural component playing a role by way of word of mouth recommendations or after discussions with sales persons.

¹⁹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

72. The price and frequency of purchase of the goods at issue may vary. Even where the goods are of low cost and purchased relatively frequently, a number of factors will still be considered by the average consumer during the purchasing process. For example, the consumer may consider current fashion trends, price, quality and suitability. With this in mind, I consider that the average consumer will pay a medium degree of attention during the purchasing process. I appreciate that some goods may attract additional or alternative considerations, such as the applicant's "tap shoes" for example, however, I do not consider that this will result in anything higher than a medium degree of attention being paid.

Comparison of the marks




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

74. 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."

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

76. The respective trade marks are shown below:

| The opponent's marks | The IR |
|---|--|
| <p data-bbox="352 472 740 562">HYPE ("the opponent's first mark")</p>  <p data-bbox="323 846 772 882">("the opponent's second mark")</p> |   |

77. The opponent submits that that marks are visually, aurally and conceptually identical. While I made no comment on the aural and conceptual similarity when considering the 5(1) ground, I did set out that the marks are not visually identical. As for the applicant's position, it denies any degree of similarity with the opponent's marks. The position of the parties are noted and I will bear them in mind whilst making the following comparisons.

Overall Impression

78. The IR is a figurative mark consisting of a word element, being 'HYPE', presented in a black standard typeface. After the word sits a small red and white '®'. Sitting above these is a large red square with six vertical white lines within it. While the square device is the largest element of the mark, I cannot ignore the fact that average consumers' eyes tend to focus on elements that can be read. Therefore, I find that the word element and the square device play equally dominating roles in the overall impression of the IR. As for the ®, I consider that this will have very little impact as it will be understood as a simple reference to a registered trade mark.

79. The opponent's first mark is the word 'HYPE' only. There are no other elements that contribute to its overall impression, which lies in the word itself. The opponent's second mark is the same word, albeit presented in a conjoined stylised typeface and followed by a period. While the stylisation and period will be noticed, it is the word 'HYPE' that dominates the overall impression of that mark.

Visual Comparison

80. In considering the IR and the opponent's first mark, they both coincide with their use of the word 'HYPE' but differ in the presence of the two device elements in the IR. The opponent's first mark is a word only mark so may be used in any standard typeface which includes the one used by the applicant. While the marks share an identical word element, the impact of the red square device element is significant. While the ® device is of less significance due to its size, it will still be noticed. Overall, I find that these marks are visually similar to between a medium and high degree.

81. As for the comparison with the opponent's second mark, the same similarities and differences discussed in the preceding paragraph also apply. That being said, there are additional points of difference due to the typeface used by the opponent and the presence of a period at the end. While these points reduce the level of visual similarity when compared to the preceding comparison, it will not be to a considerable degree. Overall, I find that these marks are visually similar to a medium degree.

Aural Comparison

82. Aurally, I can deal with both comparisons together on the basis that the only aural component in the marks at issue is the word 'HYPE' which will be pronounced in the ordinary way. As a result, the marks are aurally identical.

Conceptual Comparison

83. I do not consider that the device elements in the IR or the stylisation of the opponent's second mark have any conceptual impact upon those marks meaning that their concepts are dominated by the word 'HYPE'. As a word only mark, the same applies to the opponent's first mark. 'HYPE' is a well-known dictionary word with multiple meanings. I do not intend to set out all of those meanings but note that they include '*the person or thing so publicised*' (when considered as a noun) and '*to market or promote a product using exaggerated or intensive publicity*' (when considered as a verb).²⁰ Regardless of what meaning the average consumer attributes to the word, that same understanding will be applicable across all of the marks at issue. Therefore, I find that the marks are conceptually identical.

Distinctive character of the opponent's marks

84. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

²⁰ <https://www.collinsdictionary.com/dictionary/english/hype>

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).”

85. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent’s submissions state that ‘HYPE’ is distinctive because it is not descriptive of the goods for which the marks are registered. The opponent goes on to state that, notwithstanding its natural distinctiveness, its marks have acquired distinctiveness. However, before considering the position in respect of this claim, it is necessary to consider the inherent position.

86. I agree with the opponent that ‘HYPE’ is not descriptive of the goods for which its marks are registered. That being said, this does not automatically mean that the distinctiveness of its marks is high. On this point, I have discussed above that ‘HYPE’ is a well-known dictionary word with multiple meanings. Use of such is not, from a trade mark perspective, particularly remarkable. I, therefore, conclude that ‘HYPE’ is distinctive to a medium degree. As the opponent’s first mark consists solely of the word ‘HYPE’. The same outcome will apply to the inherent distinctiveness of that mark as a whole. As for its second mark, I find that while the stylised typeface contributes to the distinctiveness of the mark, this is only to a very small degree. In my view, the contribution of the stylisation is not enough to take the distinctiveness of the mark as a whole to that beyond which is created by the word ‘HYPE’. Therefore, I find that the inherent distinctiveness of the opponent’s second mark is also medium.

87. In respect of the enhanced distinctiveness claim, I rely on the summary of the opponent's evidence that I provided at paragraphs 23 to 35 above. I note that under that summary, I did not include evidence that pre-dated the relevant period on the basis that it was not relevant to that assessment. For the avoidance of doubt, that evidence is relevant here. While that may be the case, I do not consider that it is of any real assistance. The bulk of the additional evidence relates to a promotional brochure that shows a number of celebrities wearing the opponent's goods. These celebrities include Jay Z, 50 Cent, Harry Styles and Tom Hardy, amongst others. I appreciate that these are well-known celebrities with large followings, however, the evidence is not of advertising campaigns but what appears to be celebrities wearing 'HYPE' branded goods at unrelated events or during their everyday lives. I am not convinced that evidence of celebrities having worn 'HYPE' goods in the past is necessarily reflective of the understanding of the opponent's branding by the relevant public. On this point, I have no evidence to suggest how much attention, if any, average consumers tend to pay in relation to what clothes are worn by celebrities.

88. I remind myself that the totality of the opponent's turnover and marketing spend evidence equates to approximately £43 million and £11 million, respectively. While on the face of it, these figures appear significant, I have found them to be low when compared to the relevant markets at issue. Further, I remind myself that I had several issues with these figures when considering genuine use above. Save for the fact that the 2015 figures are now of assistance,²¹ those issues are also applicable here. I do not intend to repeat these issues in full but I will say, briefly, that the lack of specificity regarding the territories covered by these figures is a greater problem for the opponent under the present assessment. This is because the assessment I must now make is based on the understanding of the UK consumer meaning that any evidence of use outside the UK is of no assistance. As I have set out above, there is no indication the proportion of the figures cover the UK (or even the EU, for that matter). Given the international presence of the

²¹ The present assessment is not restricted by the same relevant period meaning that the 2015 are of assistance here. However, the relevant date for this assessment is 9 December 2020 so the issues with the 2021 evidence remain.

opponent, I cannot simply infer that the figures solely relate to the UK market and this, ultimately, gives me further difficulty in attempting to assess the accuracy of the turnover and marketing spend of the opponent.

89. In respect of longevity of use, I appreciate that the figures provided are from 2015 onwards only. However, the evidence does confirm that it began using its 'HYPE' branding in 2011 meaning that it had used its marks for approximately 10 years prior to the relevant date. While this is not an insignificant period of time, it is not particularly longstanding use, especially when I have nothing before me to assess the actual level of use pre-2015.

90. While the evidence provided was sufficient to demonstrate genuine use of the opponent's marks, I remind myself that the test for enhanced distinctiveness is considerably more onerous. Taking my above issues into account regarding the turnover and marketing spend, I am not willing to find that the distinctiveness of the marks has been enhanced beyond the inherent position. Even taking the evidence at its highest, when compared to the size of the relevant markets for the goods at issue, I do not consider that it is significant enough to warrant such a finding. To confirm, the inherent position applies, namely that the opponent's marks are distinctive to a medium degree.

Likelihood of confusion

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

mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

92. I have found the parties' goods range from being identical to similar to a medium degree. I have found the average consumer for the goods to be members of the general public who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods at issue. I have found that the opponent's marks are inherently distinctive to a medium degree. In respect of the similarity of the marks at issue, I have found that the IR is visually similar to between a medium and high degree and aurally and conceptually identical with the opponent's first mark and visually similar to a medium degree and aurally and conceptually identical with the opponent's second mark.

93. Taking all of the above into account, particularly the aural and conceptual identity between the marks, I am of the view that the common use of the word 'HYPE' will result in the average consumers misremembering or inaccurately recalling which mark was which. While I bear in mind the visual differences between the marks at issue, they are still visually similar to a sufficient degree. Further, I remind myself of the principle of imperfect recollection and, in the present case, I am of the view that the average consumer will misremember the visual differences, i.e. they will forget which mark had a square device element or which had a stylised typeface and which did not. Consequently, I consider that there is a likelihood of direct confusion between the marks at issue regardless of whether the marks are viewed on goods that are identical or similar to a medium degree.

94. Turning now to consider a likelihood of indirect confusion, I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

95. The marks at issue all include the word 'HYPE' as their only verbal element. In addition, this element is either the dominant element of each mark or is an equally dominant element. If the differences in typeface and the presence of device elements in the IR are noticed, I consider it likely that average consumers will still consider that the marks originate from the same or economically linked undertakings. It is my view that the marks at issue may be used as alternatives to one another, albeit in different contexts such as use of the applicant's figurative mark on product packaging and the use of the opponent's first mark, being word only, in promotional texts. Even if confronted with the opponent's second mark, I consider that the same outcome will apply in that the differences are consistent with a re-branding of the same undertaking's logo. Consequently, I consider that there is a likelihood of indirect confusion between the marks at issue. As was the case above, I find that this finding applies regardless of the level of similarity of the goods on which the marks at issue are viewed.

96. As a result of the above, the opposition reliant upon the 5(2)(b) ground succeeds in full. While it may not be necessary to proceed to consider the 5(3) ground, I will do so for the sake of completeness.

Section 5(3)

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

"5(3) A trade mark which –

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 European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

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

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

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

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

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

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

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

goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder 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*).

99. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the opponent must also show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. The opponent must also establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of

damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods 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.

100. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 9 December 2020.

Reputation

101. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

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

102. Under its 5(3) ground, the opponent relies on the same marks as it did under the 5(2)(b) ground. However, under the present ground, the opponent relies on additional services, namely those in class 35 of its specifications.

103. Before proceeding, it is necessary to point out that as the opponent's marks are comparable marks based on a pre-existing EUTMs, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the assessment of the existence of a reputation. As the relevant date for this assessment is 9 December 2020, the only relevant territory is the EU at large. On this point, I am reminded of the case of *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, which set out that an EU trade mark may be considered to have a reputation if it is known by a substantial part of the territory of the European Community and that the territory of a single Member State alone may be considered as satisfying that requirement. Further, I note the case of *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), wherein Geoffrey Hobbs Q.C. confirmed that when assessing reputation in the EU, the UK is a substantial part of the same. While these cases were determined prior to the UK's departure from the EU, they remain relevant insofar as use in the EU is a relevant factor.

104. I have produced a summary of the opponent's evidence at paragraphs 23 to 35 and paragraphs 88 to 90 above. While these summaries were for the purpose of assessing whether there was genuine use of the opponent's marks and enhanced distinctiveness, respectively, the same evidence is relevant to this assessment. I do not intend to reproduce it here save to remind myself that between 2015 and 2021, the opponent's turnover was approximately £43 million and its marketing spend was approximately £11 million. I also accept that the longevity of use covers a period of 10 years, however, I appreciate that there are no figures showing the level of use during the earlier years of the opponent's business operation. While I repeat here the issues I have with the specificity of these figures, this assessment is based on the EU territory meaning that the criticisms of the turnover and market spend are less impactful on the issue of the existence of a reputation. Even taking these issues into account, I am of the view that the opponent operated a sizeable

clothing brand for 10 years and I am satisfied that a significant part of the relevant public would be aware of the opponent's marks. That being said, the issues I have with the evidence cannot be overlooked and I, therefore, conclude that the opponent's marks enjoy no more than a moderate reputation in the same goods and services for which I have found there to be genuine use which, for the sake of completeness, are as follows:

Class 18: Backpacks and bum bags; suitcases.

Class 25: Clothing; trainers [footwear]; sandals; hats.

Class 35: Retail services connected with the sale of watches, stationery, clothing, trainers [footwear], sandals, hats and sunglasses.

Link

105. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

106. As the marks at relied upon under the present ground are the same as those assessed under the 5(2)(b) ground above, I rely on the same findings, namely that the IR is visually similar to between a medium and high degree and aurally and conceptually identical with the opponent's first mark and visually similar to a medium degree and aurally and conceptually identical with the opponent's second mark.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

107. My assessment under 5(2)(b) above was made in respect of more limited specifications than those relied upon here (because the opponent did not rely on its class 35 services for that ground). In any event, I found that the goods at issue ranged from being identical to similar to a medium degree. Those same findings apply here. In considering the inclusion of the class 35 services to this ground, I do not believe that they bring the applicant's goods any closer to the goods and services of the opponent.

The strength of the earlier mark's reputation

108. The opponent enjoys no more than a moderate reputation in its marks.

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

109. The opponent's marks enjoy a medium degree of inherent distinctive character that has not been enhanced through use.

Whether there is a likelihood of confusion

110. I have found above that there is a likelihood of both direct or indirect confusion.

Conclusion on link

111. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's marks to mind when confronted with the IR, thereby creating the necessary link. Taking all of the above into account, I am of the view that the relevant public will consider that the marks share an economic connection. Further, even if such a connection is not made, the average consumer would still make a link between the parties' marks thanks to the shared used of 'HYPE'.

Damage

112. The opponent has pleaded that use of the IR would, without due cause, take unfair advantage of the reputation of the opponent's marks and/or be detrimental to the distinctive character or reputation of the opponent's marks. I will deal with each head of damage in turn below.

Unfair Advantage

113. 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.”

114. The level of reputation enjoyed by the opponent is of no more than a moderate degree. While this is not on the higher end of the spectrum, I remind myself that the marks at issue are similar (with an identical word element) and the goods for which the opponent enjoys a reputation in are identical or similar to the applicant's. It is my view that it is quite clear that there is potential for the applicant to gain an unfair advantage by using the IR. Regardless of how the applicant displays the

word 'HYPE', I consider that its presence in the IR would achieve instant familiarity in the eyes of the average consumers, be that by way of the consumer being caused to wonder if they are linked or if they believe there to be an economic connection between them. This would result in the applicant securing a commercial advantage and benefitting from the opponent's reputation without paying financial compensation. Such commercial advantage would not exist were it not for the reputation of the opponent's marks, even taking into account the limited size of said reputation. Therefore, I find it likely that the IR takes unfair advantage of the opponent's marks.

115. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. Therefore, the opposition based upon section 5(3) succeeds in its entirety.

CONCLUSION

116. The opposition succeeds in full and, subject to any appeal, the applicant's request to designate the IR for protection in the UK is refused.

COSTS

117. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,200** as a contribution towards its costs. The sum is calculated as follows:

| | |
|-----------------------------------|---------------|
| Preparing a notice of opposition: | £200 |
| Preparing evidence: | £500 |
| Preparing written submissions | £300 |
| Official fees: | £200 |
| Total: | £1,200 |

118. I hereby order Transports Cordier to pay Just Hype Limited the sum of £1,200.
The above sum should be paid within 21 days of the expiry of the appeal period or,
if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 13th day of June 2023

**A COOPER
For the Registrar**