

BL O/480/16

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3082411

BY THE BSS GROUP LTD

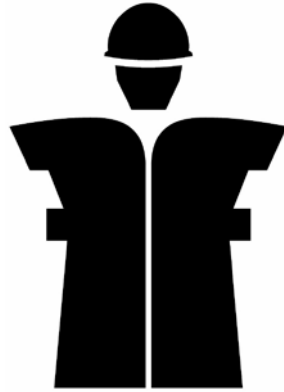
AND

OPPOSITION No. 403881

BY JIMLAR CORPORATION OF THE USA

Background and pleadings

1. This is an opposition by Jimlar Corporation (“the opponent”) of the USA to an application filed on 20th November 2014 (“the relevant date”) by The BSS Group Ltd (“the applicant”) to register a series of two trade marks, one of which is shown below.



2. The second mark in the series is the same as the one shown above, except in the colour tan. Nothing appears to turn on the presence or absence of a particular colour, so for the purposes of this opposition it is sufficient to consider the merits of opposition against the mark shown. The outcome will apply to both marks. However, for the sake of simplicity, from here on I will refer to the applicant’s mark in the singular.

3. The applicant’s mark is proposed to be registered for:

Class 9: Protective clothing, footwear and headgear; protective work clothing, footwear and headgear; clothing, footwear and headgear for protection against injury or accident; safety clothing, footwear and headgear; safety work clothing, footwear and headgear; clothing, footwear and headgear for prevention of injury or accident.

Class 25: Clothing, footwear, headgear; articles of workwear

4. The application was accepted and published in the Trade Marks Journal on 5th December 2014.

5. The opposition is based on earlier EU trade mark 4236865 (“the earlier mark”), which is shown below.



6. The earlier mark has a filing date of 11th January 2005. It is registered for goods in classes 18 and 25, as well as for services in class 35. However, the opponent relies on the earlier mark only insofar as it is registered for *articles of clothing, footwear and headgear* in class 25.

7. The opposition is directed at all of the applicant’s goods in class 25 and the following goods in class 9¹:

Protective footwear; protective work footwear; footwear for protection against injury or accident; safety footwear; safety work footwear; footwear for the prevention of injury or accident.

8. The opponent says that the above goods are identical or similar to the opponent’s goods in class 25. Further, the opponent claims that the applicant’s mark is similar to the earlier mark and that there is a likelihood of confusion. Consequently, the application should be partially refused under s.5(2)(b) of the Trade Marks Act 1994 (“the Act”).

¹ I note that the written document attached to the official TM7 lists all the applicant’s goods in class 9. However, in answer to the question on the official form “Which goods or services do you claim are identical or similar....[to the opponent’s goods]?, the opponent ticked the box entitled “Some goods..” (the other option being ‘All goods..’). Further, adjacent to this tick box the opponent provided a cut down version of the applicant’s specification in class 9. I therefore take this as representing the full scope of the opposition in class 9. This accords with the opponent’s written submissions dated 10th September 2016, and with the position of the applicant at the hearing.

9. The applicant admits the goods covered by class 25 of the application are identical to the goods in class 25 relied upon by the opponent. However, it seeks proof of use of the earlier mark. The applicant otherwise denies the grounds of opposition.

10. Both sides seek an award of costs.

Case management, representation and the hearing

11. The applicant is represented by Freeths LLP. The opponent is represented by Kilburn and Strode LLP.

12. The case has not run smoothly. The parties required four extensions of time to file their evidence, or to put it in order. Three of these applications were filed by the opponent, two of them retrospectively. Neither party managed to file any evidence in an acceptable form at the first attempt. Two case management conferences were required in order to try and keep the proceedings on an acceptable timetable and to deal with the problems with the form, length and/or content of the evidence. Given that both sides were professionally represented, it is hard to understand the reasons for this regrettable state of affairs. The significant delays and amendment of evidence has, without doubt, increased everyone's costs.

13. The matter (eventually) came to be heard on 20th September 2016 when the applicant's counsel was Mr Thomas St Quintin. At the last minute, the opponent filed written submissions in lieu of attendance. The applicant now claims off-scale costs for attending the hearing. The applicant says that it would not have required a hearing. It would have opted for a decision on the papers. I will return to that matter below.

The evidence

14. The opponent's evidence consists of witness statements by Mr David Moore and Ms Carollanne Lindley. Ms Lindley is a trade mark attorney working for Kilburn and

Strode. Mr Moore is the General Manager of The Frye Company, which he says is a division of the opponent.

15. According to Mr Moore, the opponent first used the earlier mark in the UK in 2004. The mark is used on “*footwear, snap cuffs, wristlets, wallets, billfolds, ring cuffs, and belts.*” *Wristlets, wallets and billfolds* appear to be types of bags that are proper to class 18, i.e. they are not covered by the goods in class 25 relied upon by the opponent for the purposes of this opposition. The same applies to ring cuffs, which appear to be items of jewellery in class 14. Mr Moore exhibits pictures of the mark embossed on what he claims are goods in class 25². The 40 pictures in evidence show numerous uses of the earlier mark embossed on boots, shoes and a belt, which is an item of clothing proper to class 25, but also use of the mark in relation handbags and wallets, which are classified in class 18. There is also one example of the mark embossed on an item called a *wrap cuff*, which may or may not be the same as the item Mr Moore calls a *snap cuff*. *Wrap cuffs* appear to be belt-like goods worn on the wrist as decoration. They may be proper to class 25, but I do not think that would naturally be described as *clothing*. Therefore, even if they are proper to class 25, they are not covered by the goods for which the earlier mark is registered.

16. Mr Moore says that the opponent sold between around £50k and £450k worth of goods per annum under the applied-for mark in the UK in the years 2009 to 2015. He exhibits 12 invoices, dated in 2011, and addressed to customers in the UK. The mark is not apparent on these invoices, which appear to cover shoes, boots, bags and wallets. Mr Moore says that these are examples of sales of goods bearing the earlier mark. I note that only the sales and invoices relating to shoes and boots marketed before the relevant date in 2014 are relevant for present purposes.

17. Exhibit XX3 consists of copies of pages from various well known UK magazines published in 2012 and 2013, which carried promotions for the opponent’s boots, shoes and (to a lesser degree) handbags. The opponent estimates that it spends around \$100k per annum advertising its products in the UK.

² See XX2

18. Mr Moore says that the parties have been in correspondence since September 2014 when the opponent became concerned that applicant had “*changed its area of focus*”. The applicant has been in the field of safety and work wear sold through builder’s merchants and DIY outfits. However, Mr Moore says that the applicant now produces combat boots, such as the model called Veronica, which he notes has rubber lug soles, and the Engineer 12R, which is “*welded for its durability and is made of leather with a rubber outsole for good weld construction*”.

19. Exhibit XX7 consists of an article dated December 2014 from a website called The Brick Castle, which covers the applicant’s goods. The writer states:

“I have never heard of Scruffs before but I know that clothing design for working generally lasts far longer than clothes designed for fashion. Scruffs sell work wear and safety footwear that even my fashion conscious 20 year old is happy to wear.”

20. The article ends:

“Scruffs have a huge range of work wear and safety boots that aren’t just for work.”

21. Mr Moore says that this emphasis on fashion is reflected on the applicant’s own website, which describes its goods as a “*stylish range of safety footwear*” which “*brilliantly combine comfort, style, safety and durability*”³. Further, the applicant’s goods are promoted on its website under the slogan “*Get the Look*”⁴.

22. Ms Lindley’s evidence consists of:

- Pictures showing how the marks at issue look when applied to footwear⁵;

³ See XX8

⁴ See XX9

⁵ See CAL1

- Pictures of the packaging of the applicant's goods showing that the applied-for mark is used (only) in place of the letters FF in the word mark SCRUFFS⁶;
- The results from Google images when a search is conducted on the words 'scruffs boots uk shoebox'. These include pictures of the applicant's boots and the opponent's boots⁷.

23. I understand that Shoebox is the name of a footwear retailer. I do not understand why the opponent used this retailer's name in the Google search or what its purpose is in showing that pictures of both parties' boots appear in Google images (if one searches on the word combination set out in the previous paragraph). It is common knowledge that the images displayed in Google images sometimes appear to be quite random. Although by filing these results of the internet search Ms Lindley appears to hint at it, I note that her evidence stops short of claiming in terms that Shoebox UK stocks the boots of both parties.

24. The applicant's evidence consists of a witness statement by Daniela Gould. Ms Gould is the Marketing Director of Birchwood Price Tools, which is a trading name of the applicant. According to Ms Gould, the applied-for mark and the mark shown below (which she calls SCRUFFS) have been used in the UK by the applicant, or its predecessors in business, since 2003 in relation to articles of clothing, footwear and headgear.



25. The trade marks are physically applied to the goods, to labels attached to the goods and/or the packaging. Ms Gould exhibits historical versions of the applicant's UK website, which she claims shows use of the marks⁸. The exhibit in question shows use of the Scruffs mark in relation to safety footwear and work wear. The only

⁶ See CAL2

⁷ See CAL3

⁸ See exhibit Scruffs 2

use I can see of the applied-for mark as such is where it is embossed onto the heel of protective boots⁹. There is also some use, from 2010 onwards, of the composite 'Man Tips' logo mark shown below.



26. Ms Gould states that the applied-for mark “and/or” the Scruffs mark has been promoted in publications, including newspapers, including The Sun, in magazines, including Bella and Take-a-Break, as well as special interest publications, such as Professional Electrician and DIY Weekly. The applicant’s goods are also the subject of discussion in various independent blogs. According to Ms Gould, the publications in which the marks have been advertised has not changed significantly since 2003.

27. Exhibit Scruffs 3 is said to show use of the marks in advertisements/promotions for clothing and footwear. There are numerous examples of the applicant’s advertisements between 2008 and 2014, but it is not clear where many of these were placed. Further, nearly all the advertisements are under the Scruffs mark, in word or logo form, rather than the mark applied-for. Having said that, I note that there are advertisements dated 2003, 2012 and 2014 showing use of the mark applied-for embossed onto the heel of safety boots¹⁰. I also note that there a couple of further examples of use of the ‘Man Tips’ mark shown in paragraph 25 above. Finally, I note that there are two examples of the mark applied-for integrated into the toggle of a zip on a jacket¹¹. However, it is not clear where these advertisements were placed, or when.

⁹ See, for example, the boot shown on page 11 of exhibit Scruffs 2

¹⁰ See pages 4, 16 and 55 of exhibit Scruffs 3

¹¹ See pages 47 and 58 of Scruffs 3

28. I note that in exhibit Scruffs 4¹² there is a further example of the use of the applied-for mark on the toggle of a zip for a jacket, and use of the mark on the leg of a pair of work trousers. However, this appears to date from the applicant's Autumn/Winter 2015/16 catalogue. This is after the relevant date and is therefore irrelevant.

29. Ms Gould provides approximate UK turnover figures for goods sold under the applied-for mark "and/or" the Scruffs mark for the years 2003 to 2015. The turnover was £752k in 2003, rising to £2.4m in 2008, and to £16.1m in 2013. Ms Gould also provides advertising expenditure figures showing that £90k was spent promoting the marks in 2010, rising sharply to £450k in 2013.

30. Ms Gould concludes that:

"Notwithstanding that I do not consider the Trade Mark and the trade mark of the Opponent to be confusingly similar I am of the firm opinion that by virtue of the use that has been made of the Trade Mark and the Scruffs Trade Mark over the years that there is no likelihood of confusion occurring in the minds of the relevant public."

Proof of use of the earlier mark

31. I will start by determining a fair specification for the earlier mark for the purposes of these proceedings. Section 6A of the Act states that:

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

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

¹² See pages 27 and 28.

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

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

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

(5) In relation to a 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 Union.

(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.”

32. The relevant period is therefore 6th December 2009 to 5th December 2014.

33. The applicant accepts that the opponent has shown genuine use of the earlier mark in relation to *casual boots and shoes*. The question for me is therefore whether this is a fair description of the use shown in the evidence. Other than listing the evidence filed by the opponent, the opponent’s written submissions do not expressly identify an appropriate specification that fairly reflects the use shown. I find it hard to believe that this is because the opponent considers that the evidence justifies the wide registered specification in class 25 - *articles of clothing, footwear and headgear*. Indeed, the opponent’s witness does not claim any use of the earlier mark in relation to items of *headgear*, and the only item of clothing he mentions is *belts*. However, although Mr Moore provides a picture of the earlier mark in use on a belt, this is not dated, and there are no invoices or advertisements showing use of the earlier mark in relation to belts during the relevant period.

34. In *Awareness Limited v Plymouth City Council*¹³, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly

¹³ Case BL O/230/13

well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

35. In my judgment, the opponent’s evidence of use of the earlier mark in relation to *belts* is no more than an assertion. The only relevant and substantiated use of the mark shown in the opponent’s evidence during the relevant period is use in relation to boots and shoes.

36. In *Roger Maier and Another v ASOS*¹⁴, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average

¹⁴ [2015] EWCA Civ 220

consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that 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 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. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

37. The opponent has not shown use of the mark in relation to certain sub-categories of *footwear* such as slippers and socks. It is therefore necessary to identify the sub-categories of *footwear* for which use has been shown. I accept the applicant’s submission, to the extent that it identifies the appropriate sub-categories as boots and shoes. I am not convinced that these categories should be further sub-divided so as to identify the opponent’s goods as *casual boots and shoes*. Although the goods shown in the opponent’s evidence do not appear to be intended for wear on formal occasions, the dividing line between formal and casual boots and shoes is rather imprecise. If the purpose of the proposed restriction is to distinguish between *casual boots and shoes* for leisure purposes, and those boots and shoes that might be regarded as suitable (or also suitable) for work, I find the proposed distinction too subjective. Counsel for the applicant suggested, as a fall-back position, that an appropriate specification should at least exclude protective footwear. I accept that *protective footwear* is a distinct sub-category of footwear for which no use of the earlier mark has been shown. However, as protective footwear is not proper to class 25, it is not necessary to add an exclusion to the notional class 25 specification for the purpose of these proceedings.

38. In my view, the average consumer would consider the opponent's goods as *boots and shoes*. I will therefore treat the opponent's mark as entitled to protection in relation to these goods. In doing so, I will keep in mind that the earlier mark is not registered in class 9 and therefore the words should not be understood as covering protective footwear¹⁵.

Section 5(2)(b)

39. Sections 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods and services

40. The necessary comparison is between:

<i>The goods covered by the application at which the opposition is directed</i>	<i>The goods for which the opponent is entitled to protection</i>
Class 9 Protective footwear; protective work footwear; footwear for protection against injury or accident; safety footwear; safety work footwear; footwear for the prevention of injury or accident.	
Class 25 Clothing, footwear, headgear; articles of workwear	Class 25 Boots and shoes

¹⁵ See *Caremix Trade Mark* EWCA [2001] Civ 1928

41. In *Gérard Meric v OHIM*¹⁶, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

42. Applying this approach, I find that the opponent’s goods are identical to *footwear* and *articles of workwear* in class 25 (in the case of the latter, to the extent that it covers footwear).

43. The remaining goods are not identical. It is therefore necessary to assess whether, and to what extent, they are similar. In the judgment of the CJEU in *Canon*¹⁷, the court stated at paragraph 23 of its judgment that:

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

44. I will start by considering the similarity between the applicant’s goods in class 9 (which for the sake of brevity I will call ‘protective footwear’) and the opponent’s *boots and shoes*. The applicant does not dispute that there is a degree of similarity between its protective footwear and the opponent’s goods, even if the latter is limited to casual *boots and shoes*. However, on this premise, the applicant submits that the degree of similarity is “quite low”. In this connection, the applicant submits that the purposes or uses of the goods are dissimilar. I accept that a key purpose of protective footwear is to protect the feet from injury or accident. ‘Ordinary’ boots and

¹⁶ Case T- 133/05

¹⁷ Case C-39/97

shoes also provide some protection for the feet, but not specifically from accident or injury in potentially dangerous environments. The purpose of the respective goods is different to this extent. However, protective footwear also serves the same purpose as ordinary boots and shoes, i.e. they protect the feet from general wear and tear and help to keep the feet warm. I therefore find that the general purpose of the respective goods is the same, but the specific purpose of the applicant's goods is absent from the opponent's goods.

45. According to the applicant, the users of protective footwear may also wear (casual) *boots and shoes*, but the former will be worn at work whilst the latter will be worn outside work. This submission appears to recognise that the users of the goods may overlap.

46. The applicant accepts that the respective goods are similar in nature.

47. The method of use of the respective goods is plainly the same: they are worn on the feet.

48. The respective goods are not complementary and, in general, I think it unlikely that protective footwear competes with ordinary footwear.

49. The applicant submits that protective footwear is only sold through specialist stores, such as tool or building materials stores, and therefore will not be available through the same channels as 'ordinary' *boots and shoes*. At first sight, this submission does not seem to sit easily with the applicant's evidence that it has promoted its goods through mainstream publications, such as *Bella*, *The Sun* and *Take-a-Break*. However, on close inspection of the relevant promotions in evidence I note that they relate to clothing and (in some cases) footwear for outdoor use "*to ensure your man looks good whether he is hiking a mountain, working outdoors, or simply taking the dog for a walk*". It is therefore possible that the goods promoted through these channels were not protective footwear, but 'ordinary' clothing and footwear of the general purpose kind covered by class 25 of the opposed application. Therefore, on balance, I am inclined to accept the applicant's submission that protective footwear is generally sold through specialist outlets.

50. Taking all these factors together, I find that there is a medium degree of similarity between 'ordinary' *boots and shoes* and protective footwear.

51. Counsel for the applicant was disposed to accept that *clothing, headgear and articles of workwear* (other than footwear) in class 25 are more similar to the opponent's *boots and shoes* in class 25 than they are to protective footwear in class 9.

52. Considering the usual factors, I find that the purposes of the respective goods is similar in that all the goods are intended to protect the body from the elements and/or wear and tear, and to keep the body warm. Admittedly, this will vary by degree according to the type of goods. Footwear is more important for protecting the body against casual abrasion or sharp objects than (say) a coat, but a coat will be just as important for keeping the weather out and keeping the body warm. It might also be said that all the goods are usually intended to help the wearer look good.

53. The goods may be similar in nature, for example, leather goods, but the degree of similarity of nature is less pronounced than when I was considering *boots and shoes* against protective footwear.

54. At a high level of generality, the method of use is the same: the goods are worn on the body. However, the goods under consideration here are worn on different parts of the body, except for socks which I consider to be covered by the applicant's term 'clothing' (as well as by 'footwear'). So the degree of similarity under this heading is quite low, except for socks where the method of use is highly similar.

55. The goods are not in competition, but they are complementary to a degree in that *boots and shoes* are frequently displayed in clothing catalogues, on websites or on models so as to complement items of outerclothing (or vice versa) as part of a complete outfit.

56. The respective goods are likely to be sold through the same trade channels. However, I accept that, except when displayed together as an outfit, they will usually

be found in different areas of a clothing store, or on different pages of a clothing catalogue or website.

57. I can see that slightly different considerations may arise as regards *articles of workwear*. However, for the reasons given earlier, I do not accept that there is a clear distinction between goods falling under this description and clothing in general. In any event, the earlier mark is protected for *boots and shoes* and therefore covers goods that could be used for multiple purposes such as “...*hiking a mountain, working outdoors, or simply taking the dog for a walk*”.

58. Overall, I find that there is a medium degree of similarity between the applicant's *clothing, headgear and articles of workwear* (other than footwear) in class 25 and the opponent's *boots and shoes*.

Global comparison

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of

them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

The respective trade marks are shown below:

	
Earlier trade mark	Contested trade mark

61. The applicant submits that, particularly given the helmeted head at the top of its mark, the contested mark will be perceived as a stylised workman whereas the opponent's mark looks more like a stylised stag's head, a variation on a cross, or a downward pointing rocket.

62. The opponent denies that its mark will be perceived as any of these things. Instead it contends that the impression created by its mark, and that of the contested mark, is of back-to-back letters F. In support of this submission, the opponent points out that the applicant actually uses the contested mark in place the letters FF in the logo version of the SCRUFFS mark.

63. The applicant denies that this is how the mark would be seen when the contested mark is used as applied for.

64. I agree with the applicant that the contested mark is unlikely to be perceived as FFs if used in the form applied for, i.e. when not used in place of the letters FF in a word where those letters would normally appear. However, I agree with the opponent that the public are unlikely to analyse the details of the earlier mark sufficiently to extract non-obvious concepts, such as a stag's head, a cross or a rocket. In my view, the earlier mark has no conceptual meaning. I agree with the applicant that its mark is likely to be recognised as a highly stylised workman. This is mainly because of the helmeted head at the top of the mark. Consequently, there is a degree of conceptual disparity between the marks.

65. These are visual marks. Neither mark is likely to be verbalised. Therefore there is neither aural similarity nor dissimilarity.

66. Visually, there is a degree of similarity between the earlier mark and the 'body' of the highly stylised workman in the contested mark. It is somewhat easier to see than to describe. If I had to find a way to describe the similarity, I would say (as the opponent has done) that the devices (or part of the device in the case of the contested mark) could be described as stylised back-to-back letters F, with a space between them. However, the stylisation in the contested mark is angular with thick vertical sections, whereas the earlier mark has more curves and thinner vertical sections. My initial impression was that the marks as a whole were visually similar to only a low degree. However, upon examining the marks embossed onto the heels of the parties' footwear, it strikes me that they look significantly more similar in use than they do on paper¹⁸. The similarity between the earlier mark and the 'body' of the applicant's mark is immediately noticeable. These are plainly examples of the marks applied to the goods, which is a paradigm case of the marks in normal and fair use. I therefore find that there is a medium degree of overall similarity between the marks.

¹⁸ See CAL1 and the physical boots in evidence

The average consumer and the means of selecting the goods

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

68. Counsel for the applicant submitted that because clothing is a discretionary purchase, average consumers would pay a medium to high degree of attention when selecting 'ordinary' clothing, footwear etc. Because of its importance, he submitted that average consumers would pay a high degree of attention when selecting protective footwear.

69. I agree that, because of its importance to their safety, average consumers are likely to pay a relatively high degree of attention when selecting protective footwear in class 9. However, I do not accept that such consumers are likely to pay a medium to high degree of attention when selecting clothing, headgear, articles of workwear and 'ordinary' footwear in class 25. I see no merit in the general proposition that consumers are more attentive than usual when it comes to discretionary purchasers. Indeed, the example often used to illustrate when consumers are likely to pay a low degree of attention – the proverbial bag of sweets – is in fact an example of a discretionary purchase. It is true that some brands of clothing may require a considerable outlay in order to purchase them, but there are other brands which are relatively cheap and therefore bought without an exceptional degree of attention. In *Bang & Olufsen A/S v OHIM*¹⁹, the General Court stated that:

“According to the case-law, the price of the product concerned is also immaterial as regards the definition of the relevant public, since price will also not be the subject of the registration (Joined Cases T-324/01 and T-110/02 *Axions and Belce v OHIM* (Brown cigar shape and gold ingot shape) [2003] ECR II-1897, paragraph 36).”

¹⁹ Case T-460/05

70. Overall, I find that average consumers are likely to pay a medium or normal degree of attention when selecting the applicant's goods in class 25.

Distinctive character of the earlier trade mark

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

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

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

72. The earlier mark is not descriptive or allusive of characteristics of the goods. It is therefore inherently distinctive to at least a normal degree. Taking account of the use made of the mark over the 10 years prior to the relevant date, I find that the earlier was distinctive of the opponent's *boots and shoes* to an above average degree.

Likelihood of confusion

Applicant's footwear in class 25

73. Taking into account the medium degree of visual similarity between the marks, the identity between the applicant's footwear in class 25 and the opponent's *boots and shoes*, the above average level of distinctiveness of the opponent's mark, and the normal level of attention paid by average consumers of 'ordinary' footwear, I find that there is a *prima facie* likelihood of confusion amongst average consumers. The visual differences that are noticeable when the marks are compared side by side are likely to be much less evident when the marks are seen on different occasions. There is therefore a likelihood of confusion through imperfect recollection. The presence of a conceptual meaning in the applicant's mark, and the absence of such a meaning in the opponent's mark does not exclude a likelihood of confusion²⁰. In my view, the conceptual difference is unlikely to be sufficient to avoid confusion in this case.

Applicant's protective footwear in class 9

74. I further find that average consumers of the protective footwear who have come across the opponent's mark for 'ordinary' *boots and shoes* are likely to believe that the applicant's mark designates a range of protective footwear produced by the same undertaking. I again note that the visual differences which are noticeable when the marks are compared side by side are likely to be much less evident when the marks are seen on different occasions. Taking into account the medium degree of visual similarity between the marks, the medium degree of similarity between the applicant's protective footwear in class 9 and the opponent's *boots and shoes* in class 25, and the above average level of distinctiveness of the opponent's mark, I therefore find that there is a *prima facie* likelihood of confusion amongst average consumers. This is despite the high degree of attention likely to be paid when selecting the applicant's protective footwear and the generally distinct channels through which the goods are likely to reach the market.

²⁰ See, for example, the judgment of the General Court in *Nokia Oyj v OHIM*, Case T-460/07

75. In particular (and leaving aside the applicant's concurrent use of its mark for protective footwear), there is, in my judgment, a *prima facie* likelihood that average consumers of protective footwear will believe that the applicant's mark designates a range of protective footwear produced by the same undertaking that uses the opponent's mark. In this connection, I note that the most noticeable difference between the marks – the presence of a helmeted head in the applicant's mark – is liable to be seen as descriptive of protective footwear that is suitable for workmen. This is consistent with the applicant's goods being seen as a spin-off range of protective footwear marketed by the opponent.

Applicant's clothing, headgear and articles of workwear (other than footwear) in class 25

76. Taking into account the medium degree of visual similarity between the marks, the medium degree of similarity between the applicant's clothing, headgear and articles of workwear (other than footwear) in class 25 and the opponent's *boots and shoes*, and the above average level of distinctiveness of the opponent's mark, I find that there is a *prima facie* likelihood of confusion amongst average consumers.

77. In particular, average consumers of clothing, headgear and articles of workwear (other than footwear) are likely to regard the applicant's mark as designating a range of goods that are complementary to the *boots and shoes* marketed under the opponent's mark. There is therefore a likelihood that average consumers will believe that the goods marketed under the applicant's mark are those of the opponent, or an undertaking which is economically connected to the opponent. In this connection, I note that the opponent's mark is entitled to protection in respect of 'ordinary' boots and shoes, which includes casual footwear, training shoes as well as multi-purpose boots and shoes, which are also suitable for use as workwear. The distinction between fashion clothing and workwear is therefore a weak and porous one. Further, to the extent that there is at least a marketing distinction between workwear and clothing and headgear, those average consumers who spot the most noticeable difference between the marks – the presence of a helmeted head in the applicant's mark – are liable to regard the additional elements as indicating that the applicant's

goods are suitable as workwear. This is consistent with the applicant's goods being seen as a spin-off range of workwear marketed by the opponent.

Evidence of confusion

78. Counsel for the applicant submitted that I should attach no weight to the opponent's evidence of actual confusion at trade shows. I agree. The evidence of confusion is hearsay and so non-specific as to be of no evidential value. I have come to my findings of a *prima facie* likelihood of confusion without relying on this evidence.

Honest concurrent use

79. The applicant relies on honest concurrent use of its mark as a defence to the opposition under s.5(2). In *IPC Media v. Media 10*²¹ Kitchin L.J. discussed the decision of the CJEU in *Budvar v. Budweiser*²². He said this:

“46 The [CJEU] then explained (at [75]) that it was to be noted that the use by Budvar of the Budweiser mark had not had and was not liable to have an adverse effect on the essential function of the Budweiser mark owned by Anheuser-Busch. It proceeded to point out that the facts of the case were exceptional in five respects.

“77. First, the referring court states that Anheuser-Busch and Budvar have each been marketing their beers in the United Kingdom under the word sign ‘Budweiser’ or under a trade mark including that sign for almost 30 years prior to the registration of the marks concerned.

78. Second, Anheuser-Busch and Budvar were authorised to register jointly and concurrently their Budweiser trade marks following a judgment delivered by the Court of Appeal (England &

²¹ [2014] EWCA Civ 1439

²² Case C-482/09

Wales) (Civil Division) in February 2000.

79. Third, the order for reference also states that, while Anheuser-Busch submitted an application for registration of the word 'Budweiser' as a trade mark in the United Kingdom earlier than Budvar, both of those companies have from the beginning used their Budweiser trade marks in good faith.

80. Fourth, as was stated in para.10 of this judgment, the referring court found that, although the names are identical, United Kingdom consumers are well aware of the difference between the beers of Budvar and those of Anheuser-Busch, since their tastes, prices and get-ups have always been different.

81. Fifth, it follows from the coexistence of those two trade marks on the United Kingdom market that, even though the trade marks were identical, the beers of Anheuser-Busch and Budvar were clearly identifiable as being produced by different companies.”

47 The [CJEU] reiterated (at [82]) that, in circumstances such as these, a long period of honest concurrent use of two identical marks designating identical products neither had nor was liable to have an adverse effect upon the essential function of the mark. It then answered the referred question in these terms:

“84. In the light of the foregoing, the answer to the third question is that Art.4(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest concurrent use of those two trade marks where, in circumstances such as those in the main proceedings, that use neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.”

48 Now it is entirely true to say that the facts of the present case are different from those of *Budweiser*. Moreover, the circumstances of *Budweiser* were clearly exceptional. However, I do not understand the reasoning or guidance of the Court of Justice to be limited to only those cases which share all five characteristics of that case. To the contrary, it seems to me that the Court has made it clear that the fundamental question to be asked and answered in any particular case is whether the impugned use does or does not have an effect upon the functions of the trade mark.

49 Further and importantly in the present context, the Court has not ruled that honest concurrent use cannot avail a trader if the impugned use is liable to cause some confusion. Indeed, this court was required to consider that very question in deciding the ultimate outcome of that case, for Anheuser-Busch argued that, in the light of the guidance given by the Court, the doctrine could only apply where the level of confusion was *de minimis*. It continued that if there was a level of confusion above that, then the essential function of the trade mark relied upon would be impaired and a case of permissible honest concurrent use would not be made out.

[....]

51 I respectfully agree that there may well be more than *de minimis* confusion in a case of honest concurrent use. No doubt many consumers will recognise that the marks are used by different businesses, but others will not. In other words, once honest concurrent use is established, the mark does not solely indicate the goods or services of just one of the users. As Sir Robin Jacob explained, in such a case the guarantee given by the mark is different.”

80. It is clear from this that the CJEU's preliminary ruling in *Budweiser* does not mean that honest concurrent use is a self-standing defence under s.5(2). Rather

Budweiser is a further application of the rule that trade mark rights cannot be used to prohibit uses which do not affect the functions of the trade mark. The *Budweiser* judgment represents an application of this rule to the law concerning the registration of conflicting trade marks.

81. So how does this apply (if at all) to the facts in this case? The opponent's case is that the applicant has used the SCRUFFS mark for protective footwear and only in recent years started to use the mark separate from the SCRUFFS logo. Further, according to the opponent, the applicant has started selling goods suitable for the fashion market and not just the specialist market for protective footwear.

82. The applicant denies this. According to the applicant, its market has not changed and it has used the applied-for mark since 2003. Counsel for the applicant drew my attention to an example of such use from that year²³. As I noted before, the use in question is the applicant's mark embossed onto the heel of protective boots. I accept that such use goes back to 2003. There is no evidence of any other use of the applied-for mark as such.

83. I accept that there is also some use, from 2010 onwards, of the composite 'Man Tips' logo mark shown in paragraph 25 above. However, this does not amount to use of the applied-for mark because the banner bearing the words MAN TIPS obscures a significant section of the mark. Further, MAN TIPS is plainly an additional distinguishing element which is absent from the applied-for mark. In any event, the use in question is not specified by the applicant's witness and appears to have been sporadic.

84. The applicant's witness conflates use of the SCRUFFS logo with use of the applied-for mark. However, use of the former mark plainly does not represent normal and fair use of the applied-for mark. The applicant implicitly concedes as much by submitting that the applied-for would not be recognised as an FF device in normal and fair use. I therefore find that the applicant's use of the SCRUFFS logo is irrelevant to the issue before me.

²³ See paragraph 27 above

85. The volume of sales under the applied-for mark between 2003 and 2014 is not clear. This is because the applicant has provided composite sales figures covering goods sold under the applied-for mark and/or the SCRUFFS logo. However, looking at the evidence as a whole it is clear that protective footwear has been a major part of the applicant's business since 2003. I therefore accept that there has been substantial and longstanding use of the applied-for mark since 2003, and that this has been concurrent with the opponent's use of its mark for, inter alia, boots and shoes.

86. There is no suggestion that the applicant's use of its mark in relation to protective footwear was in bad faith. Indeed, as such use pre-dated the opponent's first use of its mark there can be little doubt that the applicant used its mark in good faith.

87. I therefore find that there has been honest concurrent use of the applicant's mark in relation to protective boots. It would be pernicky to distinguish between protective boots and protective shoes. I therefore find that there has been honest concurrent use of the applicant's mark in relation to *protective footwear*. All the opposed goods in class 9 are descriptions of *protective footwear*. I therefore find that the opposition fails insofar as it is directed at registration of the applicant's mark in relation to the opposed goods in class 9.

88. It follows from what I have said that I find that there has been no concurrent use of the applied-for mark and the opponent's mark in relation to the sorts of goods proper to class 25. This includes non-protective clothing suitable for wearing to work. Consequently, the applicant's use of the applied-for mark does not assist its case as regards the registrability of the mark in class 25.

89. I recognise that in some circumstances honest concurrent use in relation to one of class of products might assist in overcoming an objection to the registration of the mark for very similar products. For example, this may have been a relevant factor if the opposition had been directed at registration of the applicant's mark in relation to protective clothing in class 9. However, the sort of workwear that is proper to class 25 is really just ordinary clothing targeted at a particular market. In my view, such

goods are closer to the opponent's established goodwill under its mark than that established by the applicant under the applied-for mark.

90. As there is no honest concurrent relevant to the opposition against the registration of the applicant's mark in class 25, it follows from my earlier findings that there is a *prima facie* likelihood of confusion, that the opposition under s.5(2)(b) succeeds in class 25.

Outcome

91. The opposition succeeds in class 25, but fails in class 9. Subject to appeal, the applicant's mark will be registered in class 9 (only).

Costs

92. As I mentioned in paragraph 13 above, the applicant seeks off-scale costs in relation to the hearing, as well as on-scale costs for the remainder of the proceedings. In a written submission filed after the hearing, the applicant elaborated on the basis and scale of its claim for off-scale costs. The applicant asks for £4035.97 in off-scale costs, which includes counsel's fee, and the cost of its attorney reviewing the skeleton argument and attending the hearing.

93. The applicant's written submission recognises that the applicant filed its own request to be heard on 26th July. However, the applicant says that it did so after receiving a letter from the IPO dated 22nd July giving notice that a hearing would be held on 20th September. The applicant understood from this that the opponent had requested a hearing. It seems odd to respond to the appointment of a hearing date by asking to be heard. The applicant says that it did so to ensure that it was represented at the hearing. However, the IPO's letter of 22nd July was sent to both parties and made it quite clear that both sides were invited to attend the hearing.

94. I note that the applicant's letter of 26th July purported to be in response to the IPO's earlier letter of 12th July, which asked the parties whether they wished to be heard. This is confirmed by the final sentence of the applicant's letter of 26th July,

which ended “*we look forward to receiving notification of the proposed hearing date in due course*”. Quite clearly the writer of that letter had not seen the IPO’s letter of 22nd July appointing a hearing date in September. It therefore appears that the applicant’s letter of 26th July was indeed a response to the IPO’s letter of 12th July.

95. The applicant complains that it did not receive a copy of a request from the opponent to be heard. However, this means that the opponent’s position could not have been the reason for the applicant’s request to be heard dated 26th July. I find that the basis for the applicant’s request for off-scale costs does not stand scrutiny and I reject it.

96. I therefore turn to the matter of on-scale costs. Both sides have achieved a measure of success. Consequently, I direct that each side should bear its own costs.

Dated this 12th day of October 2016

**Allan James
For the Registrar**