

O-198-20

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATION NO. 3246839

BY RICHARD BALDING

AND

OPPOSITION THERETO UNDER NO. 410773

BY HASU NO HANA LIMITED

AND

APPLICATION NOS 3271401 & 3271045

BY HASU NO HANA LIMITED

AND OPPOSITION THERETO UNDER NOS 411868 & 411870

BY RICHARD BALDING

Background and pleadings

Hasu no Hana's opposition to trade mark application number 3246839

1. The first case in these proceedings concerns application number 3246839, filed on 28 July 2017 by Richard Balding ("RB") for the trade mark shown below:



The application was published on 11 August 2017 for a range of goods in classes 25 and 28, shown in full in the annexe to this decision.

2. This application is opposed by Hasu no Hana Limited ("Hasu"). The notice of opposition was filed on 9 November 2017 and the grounds are based upon ss. 5(1), 5(2)(b) and 3(6) of the Trade Marks Act 1994 ("the Act"). The oppositions are under each of these grounds directed against all of the goods in the application.

3. Hasu relies upon three earlier trade marks, show below. Only the first is relied upon under s. 5(1); all three are relied upon under s. 5(2)(b):

(i) European Union Trade Mark ("EUTM") number 6676308:



HASU NO HANA

Filing date: 24 March 2008; date of entry in register: 3 April 2009;

(ii) EUTM 6555742 **nineplus**

Filing date: 9 February 2008; date of entry in register: 6 April 2009;

(iii) EUTM 6555775



Filing date 9 February 2008; date of entry in register: 6 April 2009.

4. The specifications for Hasu's earlier marks are identical and Hasu relies upon all of the goods for which the earlier marks are registered, namely:

Class 25: Clothing, footwear, headgear.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; including surfboards and skateboards.

5. Hasu claims under ss. 5(1) and 5(2)(b) that the marks are identical or similar, that the earlier marks are incorporated in the application and that the goods are identical or similar. It claims that the application therefore offends under s. 5(1) or that there will be a likelihood of confusion under s. 5(2)(b).

6. Under s. 3(6), Hasu claims that the application was made in the full knowledge of a prior agreement, whereby Hasu would own any trade marks and would license them to RB. The application is said to be in breach of that agreement.

7. RB filed a counterstatement denying the grounds of opposition and putting Hasu to proof.

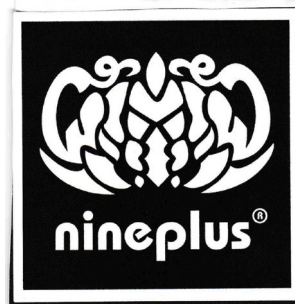
RB's oppositions to Hasu's trade mark applications

8. After the opposition proceedings were launched against RB's mark, Hasu filed two trade mark applications. The first, filed on 16 November 2017 under number 3271045, is for the trade mark **Nineplus**. The mark was published on 8 December 2017 in respect of the following goods:

Class 25: Clothing, footwear [presumably "footwear"], headgear.

Class 28: Games toys and playthings; gymnastic and sporting articles and equipment.

9. The second, under number 3271401, was filed on 17 November 2017 for the following mark:



This mark was also published on 8 December 2017 and registration is sought for:

Class 25: Clothing; footwear [again, presumably "footwear"]; headgear.

Class 28: Games; toys and playthings; gymnastics and sporting articles and equipment including surfboards and skateboards.

10. These trade mark applications were opposed on 8 March 2018 by RB. The grounds are substantially identical for both oppositions and are based upon ss. 5(2)(b), 5(3), 5(4)(a), 5(4)(b) and 3(6). As was the case for all of the pleadings in these proceedings, the notice of opposition against UK3271045 required amendment. The amended form

does not indicate whether all or only some of the goods are opposed under s. 3(6). However, the original form indicated that all, some and the goods in classes 25 and 28 were opposed. The form filed in respect of UK3271401 contained the same error and was subsequently amended to indicate all goods are opposed. Hasu has not at any point indicated that the notice was unclear, nor that it was operating on the basis that RB objected to only some goods. I therefore proceed on the basis that all of the goods are opposed under this ground, as they are under all of the other pleaded grounds.

11. Under ss. 5(2)(b) and 5(3), RB relies upon UK trade mark application number 3246839, the details of which are at paragraph 1, above. He relies upon all of the goods in the mark's specification. The claim under s. 5(2)(b) is that the marks are similar and the goods identical or similar, such that there would be a likelihood of confusion, including the likelihood of association.

12. Under s. 5(3), RB claims that the earlier mark has a reputation for all of the goods for which it is registered. He claims that the average consumer will wrongly assume an economic connection between the parties. He also claims that there would be an unfair advantage to Hasu because "I personally have used the trademark [sic] and brand value built up within the 'Nineplus' name for over 22 years. Anything bearing this name would be seeking to profit from this work".

13. Under s. 5(4)(a), RB relies upon the following sign ("the lotus circle sign"):



He claims that the sign was first used in the UK in October 1996 in St Agnes, Cornwall and throughout the UK. Use is claimed in respect of surfboards, wetsuits, apparel

(men's and women's), skateboards and surfboard fins. He claims that, due to the use which has been made of the sign, any use of the applications in classes 25 and 28 "seeks to use the historic benefits of this trading name" and to benefit from the goodwill with which the mark is associated.

14. Under s. 5(4)(b), RB asserts that he, a British citizen, is the creator and owner of five copyright works, as follows:





15. Under s. 3(6), RB claims that he founded the “Nineplus” surfing brand in 1996. Hasu is, he says, a non-trading company operated by his father, Peter Balding, which produces no goods under the name “Nineplus”. It is claimed that Peter Balding is attempting to register the brand name and to profit from doing so.

16. Hasu filed counterstatements denying the bases of the oppositions and pointing to its own opposition to UK3246839. It put RB to proof of the earlier mark’s reputation and disputes whether RB either created or owns the copyright works relied upon. Hasu also claims that, as any use is under licence, it would accrue to Hasu. Further, Hasu states that it owns the rights in the trade marks and that RB knew of the agreement.

17. Both parties filed evidence. RB also filed submissions during the evidence rounds, which I will bear in mind. Neither party requested a hearing but both filed written submissions in lieu, which I will take into account and refer to as appropriate. Neither party has had the benefit of professional representation.

Preliminary issue

18. In Hasu’s counterstatement and evidence, there is a request that, because RB did not tick the box for section 5(2) on the first page of the notice of opposition, the claim under s. 5(2)(b) be “waived”. I do not consider this reasonable. The notice of opposition as served clearly identified the grounds under s. 5(2)(b) at section A and there can be no question that Hasu did not understand RB to be pursuing that ground. That the front page is not ticked is a technical detail of no real significance.

Approach

19. As the outcome of Hasu's opposition to UK3246839 will have a material effect on RB's oppositions to UK3271401 and UK3271045, Hasu's opposition must be determined first. I will then turn to the oppositions lodged by RB.

Evidence

20. I have read all of the evidence but will summarise it only to the extent I consider necessary. Both parties' evidence also contains submissions, which I will take into account but do not summarise here.

Hasu's evidence

21. This consists of the two witness statements of Dr Peter Balding, dated 27 April 2019 ("P. Balding 1") and 28 June 2019 ("P. Balding 2").¹ Dr Balding is the Managing Director of Hasu as well as being RB's father.

22. Dr Balding states that RB's use of the mark is under licence from Hasu and that any goodwill would accrue to Hasu.² However, he accepts that there is no "formal document" to show the terms of the agreement.³ He also states that he cannot provide pre-contract correspondence because it has been lost by Yahoo and efforts to retrieve it have not been successful.⁴ Dr Balding states that Hasu's EU trade mark applications were filed "to secure the IP", in agreement with RB, on the basis that Hasu would hold the registration and RB would use the marks under licence, for which a licence fee and percentage of royalties would be paid.⁵

¹ In fact, Dr Balding filed three witness statements, the first being dated 12 September 2018. However, according to P. Balding 1, that statement incorporated all of the evidence from his previous statement. It does not, therefore, appear necessary for me to refer to the statement of 12 September 2018 separately.

² P. Balding 1, §11.

³ P. Balding 1, §17.

⁴ Ibid.

⁵ P. Balding 1, §15.

23. A selection of pages from RB's "2010 Business Report" are provided.⁶ A black-and-white version of UK3246839 is shown and the first copyright work relied upon by RB is visible on a photograph of the premises included in the report. The business is said to have started in 1996 and to have grown in the UK until 2000, when it opened a store in Truro. By 2003, "group turnover" is reported as £450,000. It is said to have opened a subsidiary in France and to have operated out of its Cornish premises for ten years, mainly in surfboards and clothing, adding wetsuits in 2005. In 2008, "the founder took back full control", the company was placed into administration "and bought for £130k to cover all trademarks, intellectual property and stock". It is acknowledged that a £250k "facility" comprising a loan and overdraft was obtained "using his Father's house as collateral". There is also a personal statement which appears to be from RB and includes the following: "Our brand logos, names and trademarks are held in a separate company that license the brand to the trading companies that operate. Our value is in the brand and this company only provides, it does not trade".

24. Dr Balding's evidence is that RB's original company, Nineplus Limited, was put into administration in 2008 and dissolved on 5 June 2009.⁷ The evidence is that RB's "current" company, Nineplus Limited (formerly Nineplus UK Ltd) was incorporated on 27 January 2009.⁸

25. A copy of an Australian trade mark registration is exhibited, which is a black-and-white version of UK3246839.⁹ The mark was registered on 29 April 2009 in classes 25 and 28 and the owner is Hasu. The address for service is Money Well Spent Pty Ltd (now said to be Shoshan Ltd); Dr Balding's evidence is that RB was, at the time of filing, a Director of that company and that "he would have attended to the filing".¹⁰ It appears that this trade mark has been allowed to lapse.¹¹

⁶ PB1.

⁷ P. Balding 1, §36 and PB5. The date of incorporation of the company in PB5 is given as 1999 but nothing turns on this.

⁸ PB6.

⁹ PB2.

¹⁰ P. Balding 1, §13.

¹¹ P. Balding 2, §31.

26. A chain of emails between RB and a firm of professional representatives in Korea dated September 2012 is in evidence.¹² The correspondence concerns a watching notice originally sent to Dr Balding and forwarded by him to RB; Dr Balding is copied on the subsequent correspondence. RB confirms to the Korean representatives that the offending application, which appears to be the same as UK3246839 but in black and white, is “our more recent logo”. He asks for their assistance in making sure that the mark is registered in the name of “HASU NO HANA LTD”, confirms that transfer of the ownership to Hasu has been agreed with the (unnamed) owner and enquires about the cost of recording the assignment using the firm’s services.

27. Dr Balding states that:

“RB failed to reimburse the costs [of registration] (and to pay the agreed royalty) – if he had, the registrations would have been transferred to him. [Hasu] does not refute the claim that when it had been reimbursed, the registrations would be transferred but [...] it would like to point out that there was no agreed date for when this should happen, and that it has not yet happened”.¹³

28. Dr Balding’s evidence is that in an email dated 6 January 2013, RB said “For the Trademarks, this will be covered by a percentage of sales as we agreed originally and once repaid maybe we can pass them back to me as currently you own them”.¹⁴ The email itself is not exhibited.

29. Dr Balding also states that, in January 2016, he offered to sell Hasu, with the trade marks, to RB for £10,000, an offer which was refused.¹⁵ Further offers to sell are said to have been made in 2016 and throughout 2017.¹⁶

¹² PB4. RB waived privilege at a Case Management Conference held on 29 May 2019.

¹³ P. Balding 2, §8.

¹⁴ P. Balding 1, §16.

¹⁵ P. Balding 2, §9.

¹⁶ P. Balding 2, §§10, 28.

30. There are in evidence emails dated July 2017 between Dr Balding and RB.¹⁷ On 12 July 2017 Dr Balding gave RB a final two weeks to decide whether he wanted to buy Hasu No Hana and how much he would pay. He also raises the issue of apparent non-payment of debts with his son and threatens legal proceedings for recovery. Further, he asserts that “you agreed to pay [Hasu] a royalty on the use of each trade mark, calculated on the sales”. RB’s response refers to various payments. He also states: “Trademarks as per below belong to you at the moment, you cannot insist on a debt here and offer to sell them? no agreement for royalty anywhere, will consider position”. Dr Balding repeats his claim regarding a royalty in an email of 28 July 2017, saying that he paid all the costs of registering the NinePlus and Hasu marks in 2008 because RB could not afford to, and adding the comment that “[y]ou said that this would provide a source of funds to supplement my pension”.

31. There are in evidence emails dated 18 and 19 September 2017 between RB and Dr Balding.¹⁸ Dr Balding refers to his discovery of RB’s application (UK3246839) and confirms that he has filed a notice of intention to oppose. In response, RB says that he advised Dr Balding of the application around two months earlier “as the UK Trademark office said they cannot guarantee that a European Trademark will be accepted within the UK after Brexit takes place”. He also refers to the trademark needing updating “as the branding and logo has changed and is being sold commercially”. RB says:

“I have already agreed to pay £10k to you for the expenses and upcharge you have added to the filing made on my behalf. I have said this will be the last to be settled as it was given as security against my loans. But things must be kept updated as otherwise the branding is not protected.

What I have agreed for the trademarks will be paid but it has to be afforded as has remained the case all the way through. If I was to pay this any earlier (if that were possible) based on your track record you would put the funds

¹⁷ PB7.

¹⁸ PB3.

against something else, misallocate the funds to your advantage and continue to hold me to ransom with threats of selling trademarks elsewhere.

I have and am doing all I can to settle matters but after now settling what has been £112,000 this year I cannot so [sic] more until cashflow allows it”.

32. Dr Balding states that RB has failed to pay all of the agreed payments, that he did not inform Hasu of his intention to apply for UK3246839 and that it is a clear breach of the verbal agreement between the parties.¹⁹

RB’s evidence

33. This consists of the witness statement of Richard Balding (i.e. RB), who says that he is the creator, designer and founder of the surfing brand “Nineplus”.

34. RB’s evidence is that “I personally am the creative copyright” for all of the copyright works relied upon. He states that UK3246839 is the logo being used “currently” in the marketplace and that, although it was created by both him and a collaborator, he is the sole owner of the copyright.

35. RB states that he started the Nineplus brand and company in 1996 and that the various logos have been used in connection with the sale of surfboards, skateboards, apparel, surfing accessories, other sporting equipment, men’s and women’s wetsuits and other neoprene products.

36. Various photographs are in evidence which show the signs at paragraph 14 (i)-(iii) on goods and on premises.²⁰ The same exhibit is said to show images of the lotus circle mark on goods and in the marketplace from 2009. There is a photograph of the sign on a surfboard bag dated 2014. The remaining images show wetsuits (2011, 2014), t-shirts

¹⁹ P. Balding 1, §22.

²⁰ RB02.

(2016), surfing leashes (2013) surfboards (2011 and an unspecified date) and surfboard fins (2012 and an unspecified date) but the images are far from clear.

37. Advertising material is in evidence, with the lotus circle mark visible.²¹ Advertisements said to have been in surf magazines in 2012 and 2014 show surf suits and neoprene, while there are also what appear to be advertising proofs for a wetsuit, dated November 2012, and a shirt dated January 2015. The other advertisements are not dated but show wetsuits, fins and surfboards. RB estimates that the total spent on the promotion and use of the trade marks is £500,000 over the past 22 years.

38. RB's evidence is that Dr Balding used Hasu, a non-trading company, to file for the EU trade marks in 2008. It was, he says, to protect RB and assist RB's business, and meant as a preventive measure against a potential takeover from another shareholder. RB's evidence is that he agreed to this as he was led to believe that the trade marks would be transferred back into his ownership once the cost of registration had been reimbursed. RB says that "[t]he situation became apparent to me during a meeting between myself and my father whereby it was suggested that I personally made a 'highest offer' to buy them back from him thus trying to profit from the assistance and goodwill I had been led to believe was being offered in 2008". RB's evidence is that when the EU trade marks were renewed in 2018, Dr Balding indicated that, should RB wish to purchase them, there might be royalties and/or licence fees due. RB's evidence is that at no time did he agree to a licence or royalty agreement.

39. In addition, a sales agreement is in evidence which relates to the sale of Nineplus Limited (in administration) to Money Well Spent Limited.²² The agreement appears to have been drawn up in March 2008, though the document before me has not been executed and there is no narrative evidence about the agreement. It concerns the sale of the business carried out by Nineplus and includes its goodwill as well as all trade marks and copyrights.

²¹ RB02.

²² RB04.

40. RB also exhibits a letter dated 12 February 2019 from an individual (“AN”) at [NBUFFALO]. It appears to be a response to an email from RB “regarding confirmation of the design work we developed together”.²³ The lotus circle mark and a single lotus flower device are shown and identified as one of the “main” logos being discussed. AN states:

“We both worked on a number of Nineplus Projects over the 2008-09 period (approx.. dates, including [...] the development of the Nineplus logo, and a number of sub-brand versions). Specifically, I was commissioned by you to update the original Nineplus logo in 2008, and this involved a period of creative exploration (with a wide variety of different marques that were trialled, and we both contributed ideas to that process). This centred around the removal of the old ‘crab’ element, and the addition of the ‘lotus flower’ and this was at your direction.

The process was ultimately finalised in 2009 when the current version was agreed together as the most appropriate, and ownership of the final work produced was passed to you on receipt of the payment of my design fee”.

41. That concludes my summary of the evidence, to the extent I consider it necessary.

Proof of use

42. The relevant statutory provisions are as follows:

“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,

²³ RB05.

(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 Community 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.

(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”.

43. Section 100 of the Act is also relevant, which reads:

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

44. Given their dates of filing, the marks relied upon by the parties qualify as earlier marks in accordance with s. 6 of the Act. RB’s trade mark has not yet been registered and is, therefore, not subject to the use provisions at s. 6A of the Act.²⁴ However, as Hasu’s marks had been registered for five years by the date on which UK3246839 was published, they are subject to the use conditions. Hasu provided a statement of use in respect of all of the goods relied upon. RB’s initial request for evidence of use was unclear and the tribunal wrote to him on 29 June 2018 asking for clarification in the following terms:

“Please state the goods you wish the opponent to provide proof of use for. If you wish the opponent to file proof of use for all goods you can state this in the box provided at point 7”.

²⁴ The relevant legislation is the Act as it stood at the filing date of the oppositions (i.e. prior to the amendments which came into force of 14 January 2019).

45. RB responded as follows: “We would like to see proof of use on Goods Class 25 to include apparel, mens and womens clothing. We would like to see proof of use on Goods Class 28 to include sporting goods including Surfboards, Wetsuits and Skateboards”.

46. It appears, therefore, that RB does not seek proof of use on all of the earlier goods, only those which have been specified (i.e. apparel and sporting goods). I will proceed on that basis. Hasu may rely upon the remaining goods without showing that it has used them. The relevant period for demonstrating use of the earlier marks is 12 August 2012 to 11 August 2017.

47. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use has been subject to a number of judgments. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J 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 Bunderversammlung Kameradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei*

GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

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

of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

48. In *Awareness Limited v Plymouth City Council*, BL O/236/13, 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 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”.

49. It should be noted that RB appears to be claiming that he has traded. However, I do not consider that this can be regarded as a tacit acceptance that there has been genuine use of any or all of the marks relied upon by Hasu during the relevant period. The marks, signs and goods relied upon by RB are not identical to the corresponding grounds in Hasu’s claim. RB explicitly requested proof of use. It seems to me that a separate determination as to proof of use must be made, particularly in light of the following comments of Geoffrey Hobbs Q.C. in *CORGI Trade Mark* [1999] RPC 549:

“Objections to registration under sections 5(1), 5(2), 5(3) and 5(4)(a) (passing off) appear to have this much in common; they are directed to situations in

which use of a mark by one trader is liable to shape and determine the perceptions of people exposed to use of the same (or a similar) mark by another. However, they differ *inter se* as to the particular conditions which must be satisfied before objections of the kind they permit can be regarded as well-founded. For the reasons given above I think that the differences are likely to affect the scope of the evidence that an objector relying on sections 5(2), 5(3) or 5(4) will need to adduce in order to substantiate his objection(s). I therefore consider that in a case where more than one objection has been put forward under section 5 of the Act it is necessary to test each objection separately by measuring the evidence offered in support of it against the requirements of the statute”.

50. The burden of proving use lies with Hasu. There is no evidence at all that Hasu has itself used the marks in relation to any of the goods for which evidence of use is required. Hasu’s case is that any use by RB would accrue to Hasu under the terms of a licence agreement. No licence agreement is in evidence but, as the earlier marks are EUTMs, there is no need for a licence to be in writing. The exhibited Business Report contains a statement by RB that there is a separate company which owns and licenses the trade marks to the trading company. Whilst I acknowledge that this report dates from 2010, it indicates that at least at that date RB’s understanding was that there was a licence of some description through which Hasu permitted his use of the marks. In light of such a statement, RB’s assertion that he at no time agreed to a licence is not credible. The correspondence between RB and the Korean representatives also suggests that, at least at September 2012 (in the relevant period), Hasu was the agreed entity for ownership of any trade marks, though it is not clear whether this arrangement continued or to what date. RB’s evidence is that he became aware of “the situation” when he was invited to make the highest offer to buy the trade marks. The only documentary evidence of such an invitation is dated 28 July 2017 but relations appear to have been deteriorating for some time and it does not appear to be disputed that there was a meeting between the parties in January 2016.²⁵ Even had there been a

²⁵ PB7.

breakdown at the earliest of these dates, it is still well into the proof of use period. The matter I am required to determine is whether, on the balance of probabilities, any use was with the consent of Hasu. I find that it was.

51. The next step is to determine whether the evidence establishes genuine use of the marks. There is no evidence at all of EU6676308 having been used in the relevant period. There is also no evidence that EU6555775 has been used. I would point out in this regard that the device is an important distinctive element of the mark and that use of the word “nineplus” alone would not constitute use of this mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (s. 6A(4)(a) refers).²⁶ That is to say, “nineplus” on its own is not an



acceptable variant of the mark .Genuine use is not made out for these marks.

52. Use which is not sham or token (i.e. solely to preserve a registration) may still be insufficient to qualify as genuine if it is not shown to be “warranted in the economic sector”. In *Naazneen Investments Ltd v OHIM*, Case T-250/13, the General Court (“GC”) upheld a decision by the OHIM Board of Appeal that the sale of EUR 800 worth of non-alcoholic beverages under a mark over a 5 year period, which had been accepted was not purely to maintain the trade mark registration, was insufficient, in the economic sector concerned, for the purposes of maintaining or creating market share for the goods covered by that Community trade mark.²⁷ The use was, therefore, not genuine use. The judgment of the GC was upheld on further appeal to the Court of Justice of the European Union (“CJEU”): see Case C-252/15 P.

53. RB has provided evidence that the company has been operating since 1996 and that it has sold various sporting goods and clothing. The word-only form “nineplus” is visible in magazine advertisements dated 2012 and 2014; the lotus circle mark is also present. RB estimates advertising spend to have been £500,000 over 22 years.

²⁶ See *Nirvana Trade Mark*, BL O/262/06 at [33]-[34].

²⁷ See, in particular, [46]-[52].

However, there is no indication of how much of this spend was in the relevant period. Nor is it explained which magazines bore the advertisements or what their reach was. There is no evidence at all of either actual sales or turnover in the relevant period. I acknowledge that the reliance by Hasu on RB's use may have made providing evidence of use rather more complicated than if it had used the marks itself. However, whilst it is not entirely clear when relations between the parties worsened, they do not appear to have been poor for the entire period. There is no evidence from Hasu regarding the level of any use made by RB, what royalties it considers are due and how it might have calculated such sums, and no explanation as to why precisely nothing has been filed. The evidence before me is insufficient to establish that there has been genuine use of any of Hasu's earlier marks.

54. As genuine use has not been shown, Hasu may not rely on the goods for which evidence of use was sought. It may rely on its earlier marks only in respect of those goods for which evidence of use was not required, namely:

Class 25: Footwear, headgear.

Class 28: Games and playthings; gymnastic articles.

Hasu's opposition to UK3246839 based upon s. 5(1)

55. Section 5(1) of the Act reads as follows:

"5. - (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".

56. In order to get an objection under s. 5(1) off the ground, the competing trade marks must be identical. 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”.

57. I have no doubt that the presence of different words in the two marks and the repeated pattern in the lotus circle mark are differences which will not only be noticed by the average consumer but which are likely to be considered significant. The marks are not identical and the opposition under s. 5(1) is dismissed accordingly.

Hasu's opposition to UK3246839 based upon s. 5(2)(b)

58. The relevant section of the Act reads as follows:

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

(a) [...]

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

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

59. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-*

Goldwyn-Mayer Inc, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

60. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

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

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

61. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

62. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, EU:T:2006:247, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für 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”.

63. In *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2009:428, the GC stated that “complementary” means:

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

64. I also bear in mind the comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13, where he warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I

therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

65. The parties have not made any particular submissions concerning the similarity or otherwise of the goods at issue. I note that Hasu questioned whether RB’s use matched the goods in its own applications but that is not the correct test under s. 5(2)(b). Under this ground, the respective specifications must be considered on a “notional” basis, across the full width of the terms in the specifications as they appear on the register, regardless of how the marks may have been used in reality.²⁸

Class 25

After ski boots; Anglers' shoes; Ankle boots; Après-ski boots; Apres-ski shoes; Aqua shoes; Army boots; Athletic footwear; Athletic shoes; Athletics footwear; Athletics shoes; Baby boots; Baby sandals; Ballet shoes; Ballet slippers; Ballroom dancing shoes; Baseball shoes; Basketball shoes; Basketball sneakers; Bath sandals; Bath shoes; Bath slippers; Beach footwear; Beach shoes; Bootees (woollen baby shoes); Booties; Boots; Boots for motorcycling; Boots for sport; Boots for sports; Boots (Ski -); Bowling shoes; Boxing shoes

66. All of the above are items of footwear, defined in the *Oxford English Dictionary* (“*OED*”) as “Outer coverings for the feet, such as shoes, boots, etc.”.²⁹ These goods are included within the broader term “footwear” in the earlier specification and are identical on the principle outlined in *Meric*.

Articles of clothing; Articles of clothing for theatrical use; Articles of clothing made of hides; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Athletic clothing; Athletic uniforms; Babies' outerclothing; Babushkas; Baby

²⁸ See *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) at [22], *Roger Maier v ASOS* ([2015] EWCA Civ 220 at [78] and [84] and *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06) at [66].

²⁹ <https://www.oed.com/view/Entry/36744325?redirectedFrom=footwear#eid> [accessed 17 March 2020].

clothes; Babies' clothing; Baby layettes for clothing; Balaclavas; Bandanas; Baseball caps; Baseball caps and hats; Baseball hats; Baseball uniforms; Bathing caps; Beach hats; Beachwear; Beanie hats; Beanies; Berets; Boaters; Bobble hats; Bonnets; Bonnets [headwear]; Bucket caps

67. Hats and other headwear are items of clothing and are, therefore, either specified or included within the terms above. These goods are, as a consequence, identical to “headwear” in the earlier specification on the basis identified in *Meric*.

American football socks; Ankle socks; Anklets [socks]; Anti-perspirant socks; Anti-sweat underclothing; Anti-sweat underwear; Articles of underclothing; Athletic tights; Athletics hose; Babies' undergarments; Bed socks

68. My understanding of the term “underclothing” is that it includes any items worn under other items of clothing, typically next to the skin. My view is reinforced by the definition in the *OED* of underclothing as clothing worn below the upper or outer garments, esp. next to the skin”.³⁰ I see no reason why underwear would not be construed in the same way, or why socks would not be articles of underclothing or underwear. “Clothing” at large includes underwear. Accordingly, all of the above goods are or include socks. On that basis, these goods have some similarity of purpose with “footwear”, both covering the feet, they share channels of trade and users and may have a complementary relationship. They are similar to a reasonably high degree.

Boot cuffs

69. As I understand it, boot cuffs are attached by users to the tops of their boots, presumably for warmth or comfort, a purpose which they share, at least to a degree, with boots themselves. They are likely to be sold with or alongside boots, share users

³⁰ <https://www.oed.com/view/Entry/211511?rskey=axmTJN&result=2&isAdvanced=false#eid> [accessed 17 March 2020].

and to have a strong complementary relationship. These goods are similar to a reasonably high degree.

Bibs, not of paper

70. The earlier specifications include headgear, which includes hats for babies. The nature of the goods differs. Although both are worn on the person, bibs are ordinarily worn over other clothing to protect it from damage, whilst babies' headwear is for warmth. However, not only are both accessories for babies and likely to be sold in close proximity but they are also commonly worn and sold together as part of a bib/hat set, resulting in a clear complementary relationship. These goods are similar to a medium degree.

Albs

71. I have no evidence on the manner in which these goods are sold but it seems likely that they are sold through specialist retailers. Given the specialist nature of the goods, it also seems likely that the goods will be sold through the same outlets as headwear for the clergy (such as bishops' mitres). It seems to me that complementarity is likely. These goods are similar to a medium degree.

American football bibs; American football pants; American football shirts; American football shorts; Athletics vests; Ballet suits; Baselayer bottoms; Baselayer tops; Bib overalls for hunting; Bib shorts; Bib tights; Body warmers; Bottoms [clothing]; Boxing shorts; Boys' clothing; Breeches; Breeches for wear

72. These goods are or include clothing for specific sporting purposes or other specialist activities. All of the goods may be sold in the same places as footwear for the corresponding activity (covered by footwear at large in the earlier specifications) and there may be a complementary relationship, as they may be worn together and be produced by the same undertaking. There is some similarity of purpose as they are

intended to cover the feet and body respectively, though footwear also has a protective role. The goods are similar to a medium degree.

Baby doll pyjamas; Bath robes; Bathrobes; Bathwraps; Bed jackets

73. All of the above are sleepwear items and as such are liable to be sold in the same areas as, or near to, slippers, covered by “footwear” in the earlier specifications. There is a complementary relationship between these goods and they are similar to a medium degree overall.

Ball gowns; Bridal gowns; Bridesmaid dresses; Bridesmaids wear

74. Although specialist clothing, it seems to me that these goods will be sold in the same retail outlets as evening/wedding shoes and that, as above, there is a degree of similarity in purpose between the clothing and the footwear. There is also clear potential for complementarity. These goods are similar to a medium degree.

Boot uppers

75. Although not complete items of footwear, there is clearly an important relationship between these goods and the finished article and there is complementarity as defined in the case law. It is also possible that channels of trade will overlap. These goods are similar to a medium degree.

Belts [clothing]; Belts for clothing; Belts made from imitation leather; Belts made of leather; Belts made out of cloth; Belts (Money -) [clothing]; Belts of textile

76. Although some money belts are essentially pouches for carrying and concealing money, my understanding is that money belts may also appear and function as ordinary belts. All of the above goods have some limited similarity in purpose with footwear, given that they are for wearing on the person. Users will coincide, though at a general

level. These clothing accessories may be found reasonably close to or alongside footwear in retail premises. The goods may be worn together and may be the responsibility of the same producer, resulting in complementarity. They are similar to a fairly low degree.

Aloha shirts; Anoraks; Anoraks [parkas]; Babies' pants [clothing]; Baby bodysuits; Baby bottoms; Baby pants; Baby tops; Bandeaux [clothing]; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Beach clothes; Beach clothing; Beach cover-ups; Beach robes; Beach wraps; Bermuda shorts; Bikinis; Blazers; Blouses; Blouson jackets; Blousons; Board shorts; Boardshorts; Bodies [clothing]; Body linen [garments]; Body suits; Bodysuits; Boiler suits; Boleros; Bomber jackets; Bushjackets; Bustiers; Button down shirts; Button-front aloha shirts; Caftans; Cagoules; Camouflage gloves; Camouflage jackets; Camouflage pants; Camouflage shirts

77. All of the above are items of clothing which have some similarity of purpose to footwear and/or headgear, given that they are worn to cover parts of the body, and are potentially complementary. These goods all strike me as liable to be sold in the same shops, albeit perhaps not in very close proximity. They are similar to a fairly low degree.

Ascots; Ascots (ties); Bandanas [neckerchiefs]; Boas; Boas [clothing]; Boas [necklets]; Bolo ties; Bolo ties with precious metal tips; Bow ties; Bowties

78. These goods are all neckwear of various types which are worn on the person either to cover the neck or for decorative purposes. The earlier marks' "headwear" has some similarity of purpose with these goods, though it is the head, rather than the neck that is covered or adorned. The nature and the method of use of the goods will differ but their users will be the same. There may some overlap in channels of trade, as such goods are likely to be sold in the same shops, or in the same areas of larger shops and department stores. There may also be a complementary relationship between the

respective goods, though this is not a particularly strong point of similarity. These goods are similar to a fairly low degree.

Braces for clothing; Braces for clothing [suspenders]; Braces [suspenders]

79. Insofar as these are accessories for clothing, it seems to me that they are likely to be sold in reasonably close proximity to footwear and headgear. There is an obvious though superficial overlap in users and there may be a complementary relationship. These goods are similar to a low degree.

Adhesive bras; Babies' pants [underwear]; Bloomers; Bodices; Bodices [lingerie]; Bodies [underclothing]; Body stockings; Boxer briefs; Boxer shorts; Boy shorts [underwear]; Bralettes; Bras; Brassieres; Bridal garters; Briefs; Briefs [underwear]; Camiknickers; Camisoles

80. Although these goods may be sold in the same outlets as footwear and headgear, they are all items of lingerie/underwear and are therefore likely to be in distinct areas, even from slippers, which are generally found with nightwear. There is no real complementarity and though there is an overlap in users, it is at the very general level of members of the public. Overall, these goods are not similar.

Aikido suits; Aikido uniforms; Aprons; Aprons [clothing]; Barber smocks; Basic upper garment of Korean traditional clothes [Jeogori]; Bra straps; Bra straps [parts of clothing]; Burnouses; Bustle holder bands for obi (obiage); Bustles for obi-knots (obiage-shin)

81. I can see no meaningful similarity between the above goods and those of the earlier marks. Their only similarity is that they may be worn on the person but, on the one hand, the earlier goods are worn on the head and feet and, on the other hand, the above goods, insofar as they are complete articles, are worn on the body. In the absence of any evidence to the contrary, none of the above goods strikes me as likely to be sold or worn in conjunction with footwear or headwear in a meaningful way for the

assessment of similarity; I am not aware that either Jeogori or kimonos (with which obi are worn) typically incorporate headwear. There is no similarity.

Class 28

Action figure toys; Action figures [toys or playthings]; Action skill games; Action toys; Aerosol actuator guns [playthings]; Air mattresses for recreational use; Air pistols [toys]; American footballs; Animal replicas as playthings; Arcade games; Arcade games (electronic -) [coin or counter operated apparatus]; Articles for playing jokes; Articles of clothing for dolls; Articles of clothing for toys; Automatic coin-operated games; Baby gyms; Baby playthings; Baby rattles; Baby rattles incorporating teething rings; Baby swings; Automatic mahjong tables; Backgammon games; Backgammon sets

82. The earlier specifications include “games” and “playthings”. All of the above are types of game or plaything and are identical to the earlier goods based on the principle in *Meric*.

Amusement apparatus adapted for use with television receivers only; Amusement apparatus being coin-operated; Amusement apparatus for use in arcades; Amusement game machines; Amusement machines, automatic and coin-operated; Apparatus for archery; Apparatus for Corinthian games; Apparatus for games; Apparatus for games adapted for use with television receivers; Arcade game machines; Arcade video game machines; Arcade video game machines with multi-terminals; Automatic gaming machines

83. Although these goods are machines or apparatus, they do not exclude complete games (such as amusement machines which only require a power supply to work, or apparatus which includes the whole set for a game). They are, therefore, identical to games in the earlier specifications under the principle in *Meric*.

Appliances for gymnastics

84. These goods are identical to “gymnastic articles” in the earlier specification, the two terms being different ways of describing the same goods or being identical under *Meric*.

Ankle and wrist weights for exercise

85. These goods are not restricted to any particular sport and I see no reason why they may not be used as part of gymnastic training, including specially adapted weights for gymnastics. “Gymnastic articles” is itself a very wide term, covering any type of equipment used in gymnastics. These goods are identical.

Athletic protective sportswear

86. This term is very broad and will include hand guards for gymnastics. The same goods are covered by “gymnastic articles” and they are, therefore, identical.

Archery bow cases; Archery bows; Archery implements; Archery implements [of Japanese and western styles]; Archery quivers; Archery sets; Archery targets; Arrows [for archery]; Articles for use in archery

87. All of the above may be used for sport but it is also common for archery equipment to be sold as toys, particularly in sets. Accordingly, these goods are identical under *Meric* to “playthings” in the earlier specifications.

Ammunition for paintball guns; Ammunition for paintball guns [sports apparatus]

88. These goods are likely to be used with games and playthings, as well as being perceived as the responsibility of the same producer, resulting in complementarity. They will share distribution channels and users. There is some similarity of purpose (i.e.

entertainment through paintball games) though the specific purposes of the ammunition and the game at large are not identical. They are similar to a reasonably high degree.

Archery finger tabs

89. Like hand guards, covered by the earlier “gymnastic articles”, these goods protect the hands and fingers from friction injuries and there is overlap in purpose to that extent. There may be a degree of similarity in their nature but they are not in competition and any overlap in users is at a fairly high level (the sporting public). These goods are not complementary but they may reach the market through similar channels. They are similar to a medium degree.

Abdomen protectors for athletic use; Abdomen protectors for Taekwondo; Archery arm guards; Arm guards for sports use; Arm pads adapted for use in sporting activities; Arm protectors for athletic use; Athletic protective arm pads for cycling; Athletic protective arm pads for skateboarding; Athletic protective arm pads for skating; Athletic protective elbow pads for cycling; Athletic protective elbow pads for skateboarding; Athletic protective elbow pads for skating; Athletic protective knee pads for cycling; Athletic protective knee pads for skateboarding; Athletic protective knee pads for skating; Athletic protective wrist pads for cycling; Athletic protective wrist pads for skateboarding; Athletic protective wrist pads for skating

90. It is not, to my knowledge, usual for gymnasts to use guards or pads other than hand guards. While the above goods coincide in purpose (protection) with gymnastic articles, the goods are not used in the same sports and their particular purpose differs. There is unlikely to be a marked similarity in nature and they are not in competition or complementary. Users will intersect at the level of the sporting public. The goods may be sold through the same retailers and it is possible that they will all be grouped together because they are protective equipment. These goods have a fairly low degree of similarity.

Back supports [belts] for weightlifters

91. My understanding is that back supports may be used by gymnasts in the course of their training. There is, therefore, some overlap in nature and purpose with gymnastic articles, though clearly there are also differences. They are neither in competition nor complementary but may be in the same general area of sports stores. There is a low degree of similarity.

Aerobic step machines; Aerobic steps; Apparatus for use in training for the game of rugby [sporting equipment]; Backboards for basketball; Badminton equipment; Badminton nets; Badminton rackets; Badminton racquets

92. Although the above goods are all types of sporting equipment, they are not items which would ordinarily be used in gymnastics. Their nature is likely to be different and there is no competition or complementarity. However, there will be a degree of overlap in both users and channels of trade. These goods are similar to a low degree.

Archery arrow points; Archery bow stringers; Archery bowstrings

93. Although I have indicated, above, that archery implements may include toy versions of the same, these goods strike me as specialist sporting goods which are unlikely to be toys or used with toys. I do not think that there is any similarity with the earlier “games; playthings”: the channels of trade will be entirely different and the nature, purpose and users (save at a very superficial level) differ and there is no competition. These goods are not similar.

Amusement park rides

94. Although these goods are for entertainment, as are games and playthings, and despite the overlap in users being members of the public, such points of similarity are so superficial that they are insufficient in my view to engage overall similarity. The

nature of these goods will be different. They are also unlikely to share channels of trade, are not in competition and are not used with games and playthings. There is no overall similarity. Hasu is in no better a position with gymnastic articles.

Angling bank stick supports; Angling nets; Apparatus for launching clay pigeons; Apparatus for launching clay plates; Aquarium fish nets; Artificial baits for fishing; Artificial Christmas trees; Artificial chum for fishing; Artificial climbing walls; Artificial fish bait; Artificial fishing bait; Artificial fishing worms; Artificial flies for use in angling; Artificial snow for Christmas trees; Ascenders [mountaineering equipment]; Audible indicating apparatus for use in fishing

95. I can see no real similarity between these goods and the earlier goods. They have a different nature and purpose, are not in competition, are unlikely to be used together and will only share users at a general level.

The average consumer and the nature of the purchasing act

96. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 services in question: *Lloyd Schuhfabrik*.

97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably

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

98. The average consumer of the similar goods will be a member of the public. The purchasing act is likely to be mainly visual for all of the goods, following selection from websites, shelves of retail premises and perusal of catalogues and advertisements both in print and online. I do not, however, rule out that there may be an aural element to the process.

99. Although various, none of the goods strikes me as liable to attract either a particularly high or low degree of attention in their selection. Some care will be taken to ensure, for example, fit, colour, suitability for purpose or for the age of any child who will use them. However, they are not particularly infrequent, unusual items or considered purchases. A medium level of attention will be paid.

Distinctive character of the earlier trade marks

100. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public: *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, 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-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in 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)".

101. There is no evidence showing use of either EU6676308 or EU6555742. As for EU6555742, there is no evidence of actual sales, their level or any impact on the marketplace. The advertising is spread over too long a period and the evidence is without sufficient detail for me to conclude that it has had a material effect on the mark's distinctive character.

102. Turning to the inherent distinctiveness of the marks, the words "HASU NO HANA" in EU6676308 are likely to be perceived as foreign words whose meaning is unknown. The device does not weaken the distinctiveness of the words. The mark is distinctive to a high degree.

103. The word "nineplus" is the entirety of EU6555742 and is present in EU6555775. The average consumer is likely to identify the words "nine" and "plus" within the mark. Where it is used in relation to goods for children, it may be seen as suggesting an age range, though it would not be typical for an age range to be written in full, as opposed to numeric characters, and the joining together of the words is itself somewhat unusual. It has a low level of distinctiveness in such circumstances. Where there is no such

connection, the word strikes me as having a medium level of distinctive character. EU6555742 is therefore inherently distinctive to a low or medium degree. EU6555775 contains a complex and distinctive device in addition to the word “nineplus” and this mark is inherently distinctive to a medium degree.

Comparison of trade marks

104. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

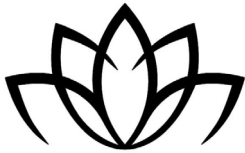
“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

105. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier marks	Contested mark
<div data-bbox="396 428 639 577" data-label="Image"> </div> <div data-bbox="391 598 644 630" data-label="Text"> <p>HASUNOHANA[®]</p> </div> <div data-bbox="344 630 378 665" data-label="Text"> <p>(i)</p> </div> <div data-bbox="414 737 584 774" data-label="Text"> <p>(ii) nineplus</p> </div> <div data-bbox="376 852 672 1142" data-label="Image"> </div> <div data-bbox="318 1123 367 1161" data-label="Text"> <p>(iii)</p> </div>	<div data-bbox="972 415 1260 705" data-label="Image"> </div>

106. There are a number of elements in the contested mark. The words “NINE” and “PLUS” are presented in a stylised bold typeface at the centre of a circular device, one above the other. There are additional swirling decorative elements above the letter “I” and within the “U”. Around the words is a repeating pattern of a stylised lotus flower and the whole is surrounded by a circle border. The mark is all a brownish red colour. I consider that the words “NINE PLUS” are the most dominant elements of the overall impression, given their bold stylisation and appearance at the centre of the mark. The repeating pattern will have some impact while the other elements are likely to be seen as purely decorative. I am not at all certain that the words “NINE PLUS” will be perceived as such by all average consumers. The word “NINE” is clear enough but the heavy stylisation of the word “PLUS” renders it much more difficult to make out. That said, I consider that some consumers, in sufficient numbers to be a relevant group for

the assessment, will perceive both “NINE” and “PLUS” as the verbal elements of the contested mark.



(i) **HASU_{NO}HANA[®]**

107. This earlier mark contains both a stylised lotus flower device and the words “HASU NO HANA” in capitals. I doubt that the device will be perceived as a lotus flower specifically, though it may be seen as a flower device. Given the size and positioning of the device above the words, I consider that the device and words make a roughly equal contribution to the overall impression of the mark.

108. The only point of visual similarity between the marks is the flower device, which is identical in both marks. It is, however, much more prominent in the earlier mark than in the contested mark. There are clear differences because of the different words and because of both the particular presentation of the lotus device and the inclusion of other presentational elements in the contested mark. There is a very low degree of visual similarity.

109. The stylistic elements of the contested mark are unlikely to be verbalised and, therefore, the only parts of the respective marks which are likely to be articulated are the words “HASU NO HANA” and “NINE PLUS”. These verbal elements have different numbers of syllables, and the syllables themselves are different. I have already indicated that not all consumers will identify both words of the contested mark but whether the consumer verbalises the mark as “NINE PLUS” or “NINE” alone there is an aural difference with the words “HASU NO HANA”.

110. “HASU NO HANA” has no clear concept. RB indicated in his notices of opposition that “the name ‘Nineplus’ comes from the length of a longboard surfboard needing to be

nine feet or longer”. However, without the specific context of use in relation to surfboards, the mark is likely to be perceived as meaning “more than nine”. The absence of an ellipsis makes it unlikely, in my view, that it would be construed as an incomplete statement “nine plus [something]”. Even for those consumers who do not recognise the second verbal element of the contested mark as the word “PLUS”, the word “NINE” is readily identifiable. As one mark has a meaning and the other does not, these marks are conceptually different.

(ii) nineplus

111. The overall impression of this earlier mark is contained in the word “nineplus”, though I have already indicated that the consumer is likely to identify the words “nine” and “plus” within the mark.

112. There are a number of visual differences between the marks, namely the lotus pattern, border and the stylisation of the words “NINE PLUS” in the contested mark. There is some similarity because of the shared words “NINE” and “PLUS”. There is a medium degree of visual similarity for those consumers who identify both “NINE” and “PLUS” in the contested mark. For those consumers who do not see the word “PLUS”, there is a fairly low degree of visual similarity.

113. The earlier mark will be articulated entirely predictably, with both “nine” and “plus” being verbalised. For those consumers who verbalise the later mark as “nine plus”, there is aural identity. For those who articulate only the word “NINE”, there is a medium degree of aural similarity.

114. Conceptually, any meaning attributed to “nineplus” in the earlier mark will also apply to the later mark. The decorative border does not add a clear concept. In such circumstances, the marks will be conceptually identical. If the consumer only sees the word “NINE” in the contested mark, there is a medium degree of similarity, as both share the number “nine” but “plus” in the earlier mark introduces an additional meaning.



(iii)

115. The overall impression of this mark is derived from the word “nineplus” and the device which appears above it. The registered trade mark symbol, if it is noticed, will be given no distinctive significance. Notwithstanding the rule of thumb that words speak louder than devices, my view is that, given their relative size and position, the word and device will have roughly equal weight in the overall impression.

116. There are a number of visual differences between the respective marks. There is a prominent device in the earlier mark which has no counterpart in the contested mark, whilst the contested mark includes both a patterned and a plain border as well as heavy stylisation of the words “NINE PLUS”. Where those words are both recognised in the contested mark, there is a fairly low degree of visual similarity. Where only “NINE” is seen in the later mark, there is no more than a low degree of visual similarity.

117. As the devices and stylistic flourishes in the respective marks will not be articulated, and neither conveys a clear conceptual meaning, my findings regarding the aural and conceptual similarities at paragraphs 113 and 114, above, also apply to these marks.

Likelihood of confusion

118. As grounds under s. 5(2)(b) can only succeed where there is some similarity between the goods, the opposition under this ground against the following goods is hereby dismissed:³¹

³¹ See, for example, *Waterford Wedgwood*.

Class 25: Adhesive bras; Aikido suits; Aikido uniforms; Aprons; Aprons [clothing]; Babies' pants [underwear]; Barber smocks; Basic upper garment of Korean traditional clothes [Jeogori]; Bloomers; Bodices; Bodices [lingerie]; Bodies [underclothing]; Body stockings; Boxer briefs; Boxer shorts; Boy shorts [underwear]; Bralettes; Bra straps; Bra straps [parts of clothing]; Bras; Brassieres; Bridal garters; Briefs; Briefs [underwear]; Burnouses; Bustle holder bands for obi (obiage); Bustles for obi-knots (obiage-shin); Camiknickers; Camisoles

Class 28: Amusement park rides; Angling bank stick supports; Angling nets; Apparatus for launching clay pigeons; Apparatus for launching clay plates; Aquarium fish nets; Archery arrow points; Archery bow stringers; Archery bowstrings; Artificial baits for fishing; Artificial Christmas trees; Artificial chum for fishing; Artificial climbing walls; Artificial fish bait; Artificial fishing bait; Artificial fishing worms; Artificial flies for use in angling; Artificial snow for Christmas trees; Ascenders [mountaineering equipment]; Audible indicating apparatus for use in fishing.

119. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]). Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion involves the consumer recognising that the marks are different but nevertheless concluding that the later mark is another brand of the earlier mark owner. This difference was explained by Iain Purvis

Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, as follows:

“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”.

120. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

121. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark

contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors”.

122. I will begin by considering the position in respect of EU6676308. This mark has a very low degree of visual similarity with the contested mark and the marks are both conceptually and aurally different. In terms of direct confusion, I am satisfied that the

differences between the marks far outweigh any similarities and that there is no risk of one mark being misremembered for the other. As for indirect confusion, I acknowledge that the lotus flower element is identical in both marks. However, whilst it has a much more prominent position in the earlier mark it is not more dominant than the words. In the later mark, whilst a distinctive element, the use of the device in a repeating pattern lessens the impact of each individual flower device and the patterned border is itself subordinate to the words in the mark. In my judgement, the presence of the same flower device in these marks, even where the goods are identical, may not result in the average consumer making any type of connection at all but, even if that is not the case and a connection is made, it will be at most mere association, not indirect confusion. The opposition based on this mark fails.

123. Turning next to EU6555742, for one group of average consumer there is a below medium degree of visual similarity and both aural and conceptual identity with the contested mark. I do not think that there is a likelihood of direct confusion: the additional elements in the contested mark are sufficient to avoid one mark being mistaken for the other, even allowing for imperfect recollection. However, the common element of the marks is “nineplus”/“NINE PLUS”, which is the only element of the earlier mark and is dominant in the contested mark. My view is that there is a likelihood of indirect confusion for those consumers who recognise the words “NINE” and “PLUS” within the contested mark, including where the goods are similar only to a limited extent and where the earlier mark has a low degree of distinctiveness. This is because the other elements in the contested mark do not create adequate distance between the marks to prevent the contested mark from being perceived as a variant mark used by the same or an economically linked undertaking. Where the goods are more similar or the earlier mark distinctive to a medium degree, confusion is only more likely. I should make it clear that this group of consumers is, in my view, likely to constitute a sufficiently significant proportion of consumers to warrant intervention.³² Confusion amongst this group of consumers will, therefore, suffice for the application to be refused for all of the similar goods.

³² See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at [34].

124. In respect of EU6555775, the position is similar to that of EU6555742. There is no likelihood of direct confusion because the device elements in both marks will prevent the consumer from simply mistaking one mark for the other. I bear in mind that there is rather less visual similarity between these marks. However, even where there is only a low degree of similarity between the goods, those consumers who see “NINE PLUS” in the contested mark (and I again consider these to be a significant proportion of consumers) are likely to believe that these are variant marks used by the same or a related undertaking. There is a likelihood of indirect confusion.

Hasu’s opposition to UK3246839 based upon s. 3(6)

125. Section 3(6) of the Act states:

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

126. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for

example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

127. I begin by reminding myself that bad faith is a serious allegation which must be distinctly proved and it is not enough for an opponent to prove facts which are also consistent with good faith. The burden, and it is a heavy one, is on Hasu to show that RB acted in bad faith.

128. The parties appear to agree that, in 2008, there was an agreement that Hasu would own the trade marks, which would be used by RB. This is supported by RB's own comments in his 2010 Business Report and by the evidence concerning the Australian (2009) and Korean (2012) applications, all in the name of Hasu. The agreement appears to have been that the marks would be transferred to RB on repayment of the application fees but the actual terms (primarily whether other monies were due) are disputed.

129. It also appears to be agreed (Hasu asserts and RB has not seriously disputed) that, in January 2016, father and son met and Dr Balding invited RB to buy Hasu. That offer was refused. On 12 July 2017 (16 days before the application), Dr Balding gave RB a final two weeks to make an offer for the company. In September 2017, Dr Balding wrote to RB stating that he had discovered, and opposed, RB's application. RB's response the following day was that he had told his father some two months earlier about the application, which was necessary because of concerns over protection post-Brexit.

130. Whilst I have held, above, that there was a licence agreement of some description, the terms of any such agreement are disputed and there is no documentary evidence to assist me. The fact that Dr Balding repeatedly asserts the terms as he understood them does not prove that those were the terms any more than RB's denials do the opposite: it is a case of one man's word against the other. The burden is on Hasu to prove its case. I am unable to find on the evidence before me that RB made the applications in breach of a licence agreement.

131. Hasu also claims that RB made the applications without informing it. This appears to be an allegation that RB's behaviour fell below acceptable commercial standards. However, the evidence shows that when accused of not informing Dr Balding of the application, RB's response was emphatic. He states that he advised Dr Balding of the need to apply two months previously (i.e. July 2017, when the application was made). Dr Balding's response is not in evidence. Further, RB asserts that there was a need to protect the new branding and logo, which he was using. The terms of those emails are not, in my view, sufficient to establish bad faith. It is entirely plausible that RB did, in fact, advise his father some months earlier that he was about to apply for the trade marks to preserve the business's position. It is also clear that RB was the trading party: there is no suggestion that Hasu intended to enter the market on its own account. At most, RB was preventing Hasu from owning the new version of the mark, which was apparently in use. There is nothing in the evidence to suggest that such agreement as there was extended to all future trade marks, particularly as it is accepted that

ownership of the EUTMs would have passed to RB on payment of the (disputed) sums and that the EUTMs were purchased by Hasu solely because RB was in financial difficulty. It is a reasonable inference that, should RB be solvent when future trade mark applications were required, the applications would be in his name or that of his company.

132. I note that the application appears to have been made shortly after Dr Balding's ultimatum that if RB failed to buy Hasu the company would be offered on the open market. Again, I am not persuaded that filing the application amounted to an of bad faith: it would not be unreasonable for a company, faced with the potential sell-off of its trade marks, to attempt to protect the version currently in use.

133. I should note that Hasu, in its evidence, questions whether there was a bona fide intention to use the mark. This point should have been distinctly pleaded in the notice of opposition if it were to be relied upon. In any event, there is no evidence going to this point and, although the specification appears a little odd, that is not, without more, sufficient for a finding of bad faith. The ground based upon s. 3(6) fails.

Overall outcome of Hasu's opposition to UK3246839

134. The ground under s. 3(6) has failed. The ground under s. 5(2)(b) has been partially successful. The application will proceed to registration for the following goods:

Class 25: Adhesive bras; Aikido suits; Aikido uniforms; Aprons; Aprons [clothing]; Babies' pants [underwear]; Barber smocks; Basic upper garment of Korean traditional clothes [Jeogori]; Bloomers; Bodices; Bodices [lingerie]; Bodies [underclothing]; Body stockings; Boxer briefs; Boxer shorts; Boy shorts [underwear]; Bralettes; Bra straps; Bra straps [parts of clothing]; Bras; Brassieres; Bridal garters; Briefs; Briefs [underwear]; Burnouses; Bustle holder bands for obi (obiage); Bustles for obi-knots (obiage-shin); Camiknickers; Camisoles.

Class 28: Amusement park rides; Angling bank stick supports; Angling nets; Apparatus for launching clay pigeons; Apparatus for launching clay plates; Aquarium fish nets; Archery arrow points; Archery bow stringers; Archery bowstrings; Artificial baits for fishing; Artificial Christmas trees; Artificial chum for fishing; Artificial climbing walls; Artificial fish bait; Artificial fishing bait; Artificial fishing worms; Artificial flies for use in angling; Artificial snow for Christmas trees; Ascenders [mountaineering equipment]; Audible indicating apparatus for use in fishing.

RB's opposition to UK3271401 & UK 3271045 based upon s. 5(2)(b)

Comparison of goods

135. The goods upon which RB may rely are those which have survived Hasu's opposition, listed at paragraph 134, above.

Class 25

Clothing

136. The earlier mark's specification includes various items of clothing such as underwear and aikido clothing. These goods are included within "clothing" at large in the contested specification and are identical under the principle outlined in *Meric*.

Footwear

137. I earlier found that there was no similarity between the goods in RB's application and footwear in Hasu's earlier mark. For the same reasons, these goods are not similar.

Headgear

138. I held, above, that there is no similarity between the earlier goods and headgear. By parity of reasoning, these goods are not similar.

Class 28

Games; toys and playthings

139. I also adopt my reasoning, above, in relation to the absence of any meaningful similarity between these goods and the goods in RB's specification (toys are synonymous with playthings and the reasoning applies equally to these goods).

Gymnastics articles and equipment

140. As above, I have already found there to be no similarity between these goods and those of RB's specification and I adopt my reasoning here.

Sporting articles and equipment including surfboards and skateboards.


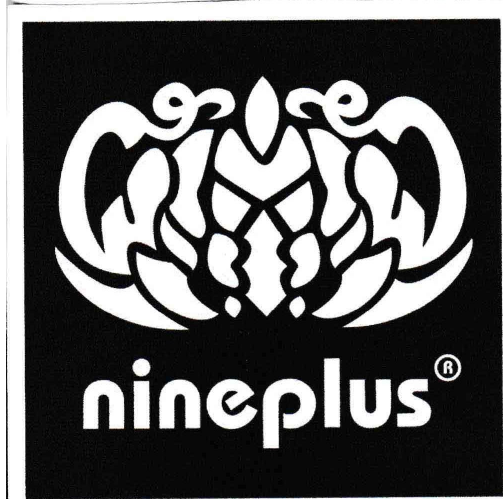
141. This is a broad term and will include goods such as angling equipment, which is included in RB's specification. These goods are identical under *Meric*.

Average consumer and the nature of the purchasing act

142. Whilst the relevant goods here include clothing and sporting articles, these goods do not strike me as having materially different average consumers or purchasing processes from those considered earlier in this decision. Accordingly, the average consumer for these goods will, for the same reasons as given above, be a member of the public who pays a medium degree of attention. The purchase will be mainly visual but I do not discount an aural component.

Comparison of trade marks

143. The marks to be compared are:

RB's earlier mark	Hasu's contested applications
	<p data-bbox="1045 527 1208 562">(i) Nineplus</p>  <p data-bbox="854 1163 894 1199">(ii)</p>

144. I have assessed the overall impressions and levels of similarity between these marks at paragraphs 106 and 111 to 117. I adopt those findings here.

Distinctive character of the earlier mark

145. The evidence filed, which includes no evidence of sales or market share, and only turnover from 2003, is insufficient to establish enhanced distinctiveness at the dates of application. Where both words are recognised, the mark is distinctive to a medium degree. I have already given my views on the distinctiveness of the word “nineplus” relative to children’s and other goods. “Nine” is not a particularly distinctive word, being a simple number. However, whether only one or both verbal elements of the mark are

identified, there is a significant degree of stylisation in the earlier mark. This will result in a medium degree of distinctive character.

Likelihood of confusion

150. The opposition under this ground cannot succeed against dissimilar goods and is dismissed insofar as it concerns, in class 25, “footwear; headgear” and in class 28, “games; toys and playthings; gymnastics articles and equipment”.

151. As for the remaining goods, there are important visual differences between these marks which will avoid the consumer directly confusing or mistaking the marks for one another even bearing imperfect recollection in mind.

152. As I indicated above, a significant proportion of consumers will perceive the earlier mark as including the words “NINE PLUS”. For the same reasons given above, that will lead to a likelihood of indirect confusion: even taking into account that the common element has in certain circumstances only a low level of distinctiveness, given the identity of the goods, the other elements in the marks are insufficient to offset the inclusion of the same words in the marks (or, indeed, in the case of the applied-for word mark, where that is the whole of the mark). The consumer is likely to think that the contested applications are different marks used by the same or economically connected undertakings. There is a likelihood of confusion for all of the identical goods.

RB’s opposition to UK3271401 & UK 3271045 based upon s. 5(3)

153. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United

Kingdom (or, in the case of a 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 the repute of the earlier trade mark”.

154. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07, EU:C:2008:655 *Intel*, [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Salomon*, [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L’Oreal v Bellure* [2009] ETMR 55; and Case C-323/09, EU:C:2011:604, *Marks and Spencer v Interflora*. The law appears to be as follows:

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

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

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

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there

is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact 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 proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and*

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

155. In *General Motors*, the CJEU considered the assessment of reputation as follows:

“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”.

156. I have no hesitation in holding that the evidence is insufficient to establish that RB's mark had a reputation at the relevant dates. There is next to no evidence at all of any trade; it certainly falls far short of the kind of evidence which is needed to establish that the mark is known to a significant part of the relevant public. The opposition under this ground is dismissed.

RB's opposition to UK3271401 & UK 3271045 based upon s. 5(4)(a)

157. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

158. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a Deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)”.

159. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s. 5(4)(a) of the Act and concluded:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made’.

160. RB must show that he had a protectable goodwill at least by the dates of application for the contested marks, i.e. 16 and 17 November 2017. As earlier use by Hasu (by virtue of goodwill accrued to Hasu through RB’s use) might make it the senior user and defeat the claim of passing off, I will return to this point.

Goodwill

161. The House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing

which distinguishes an old-established business from a new business at its first start”.

162. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation”.³³

163. Hasu claims variously that it applied for the EUTMs as an act of goodwill as between father and son, and that it was an arrangement where all use accrued to Hasu, with royalties and licence fees to be paid by RB in exchange for the use. Again, the terms of any agreement are one man’s word against the other. I am not satisfied on the evidence that the agreement extended to all goodwill in the business run by RB accruing to Hasu. It is, of course, possible for goodwill to be owned by a party other

³³ A small business which has more than a trivial goodwill can protect signs which are distinctive of its business, even if its reputation is small: see, for example, *Stacey v 2020 Communications* [1991] FSR 49 and *Stannard v Reay* [1967] FSR 140 (HC).

than the business actually trading. It is equally possible that the goodwill was retained by the trading entity and that licence fees or royalties satisfied its debt. More likely, in my view, is that being without professional representation the parties did not discuss where the goodwill would accrue. Given that the parties appear to agree that the trade marks were held by Hasu only until such time as RB made sufficient reparation, it would be an inference too far for me to hold that the goodwill in the business all accrued to Hasu. The relevant public's perception, notwithstanding the admission of a licence in the 2010 business plan, is likely to have been that the goodwill inured to the trading entity. The evidence does not establish that the position was otherwise.

164. In any event, this finding does not improve RB's position. I held above that the use which has been shown is insufficient to qualify as genuine use. I also find that, for essentially the same reasons, the evidence does not establish that RB had a protectable goodwill at the relevant date. The evidence of advertising is vague in the extreme. There are no invoices or evidence of sales to UK customers and, while there is a turnover figure of £450,000, it is from 2003. There is nothing to establish that any goodwill which had been generated by 2003 was extant some fifteen years later, particularly as the business went into administration in the intervening period. Any reputation which the business may have had is, on the evidence before me, too trivial to amount to a protectable goodwill. The passing off claim fails accordingly.

RB's opposition to UK3271401 & UK 3271045 based upon s. 5(4)(b)

165. The relevant section of the Act is as follows:

“5 (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a)[...]

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs”.

166. Section 1 of the Copyright, Designs and Patents Act 1988 (“CDPA”) provides for copyright to subsist in original artistic works. Section 4 CDPA further provides:

“4. —Artistic works.

(1) In this Part “*artistic work*” means—

(a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,

[...]

(2) In this Part—

[...]

“*graphic work*” includes—

(a) any painting, drawing, diagram, map, chart or plan [...].”

167. I accept that, in principle, the works identified by RB qualify for copyright protection as graphic works under the above provisions. Given the dates on which it is claimed that the works were created, if they qualify for copyright protection in the UK the relevant dates in these proceedings would fall within the terms of copyright protection.

168. RB’s pleaded case is that he created all of the works himself. In his submissions in reply, RB states that:

“All logos have been designed with by myself [sic] or in collaboration with designers (multiple) who have either worked for the companies I have owned and therefore their contracts are such that any work done while under employment is owned by the company or alternatively designed by myself. Intellectually all direction and artistic logo work has originated from myself”.

169. Hasu disputes whether RB is the owner of the copyright works relied upon and put him to proof of his ownership. Hasu claims that two graphic designers created the works.³⁴

170. There is limited evidence as to the ownership of any copyright. RB has provided no evidence of any drawings, sketches or other material which would indicate that he was responsible for the creation of the copyright works. There is, however, a sales agreement which appears to have been drawn up in March 2008 and which transfers all copyright ownership from Nineplus Limited to Money Well Spent Limited. It is not clear whether this agreement was ever signed, though as both parties agree the company was put into administration it seems likely. If it were executed, all copyrights would have passed to Money Well Spent Limited, not RB personally; there is no evidence of any further transfer of the pre-2008 rights to RB. The only evidence explaining RB's relationship with Money Well Spent Limited is that he was a director of that company in 2009.³⁵ A directorship of a company would not automatically result in a given director owning the company's IP, including copyrights. As the first three copyright works relied upon are dated between 1997 and 2003, they appear to have formed part of Nineplus Limited's IP portfolio, which was transferred to Money Well Spent Limited. In the absence of any evidence that RB was responsible for the creation of these works and/or that the copyright was assigned to him personally, I am not satisfied that RB is the owner of these works. His claim insofar as it is based on these works is dismissed.

171. RB asserts in his evidence that he created the fifth work relied upon jointly with a collaborator, AN, but that he, RB, owns 100% of the copyright. He has filed a letter from AN which states that the ownership of that work, and a single lotus flower device (which corresponds to the device in the fourth copyright work), passed to RB on payment of AN's fee. Strictly, this is hearsay evidence but in accordance with ss. 1 and 4 of the Civil Evidence Act 1995, I may give hearsay evidence the weight it deserves. Whilst I bear in mind that the information is not contemporaneous and has been provided to RB for the

³⁴ R. Balding 1, §40.

³⁵ P. Balding 1, §13.

purpose of these proceedings, AN has no obvious motive to conceal or misrepresent matters. I will give the evidence reasonable weight.

172. The ownership of copyright in a work depends on the circumstances in which it was created. The CDPA makes no specific provision for commissioned works, with the result that the copyright stays with the artist who created the work unless it is assigned elsewhere. If a work is created by an employee, however, the copyright would ordinarily remain with the employer (s. 11 CDPA). Whilst I note that RB claims in his submissions that the designers were his employees, this is not in evidential form and has less weight. RB's evidence that he worked with "collaborators" does not suggest that there was an employee relationship; had there been, it would have been easy enough to be explicit in evidence. AN's indication that the copyright was transferred on payment of his fee points in the other direction, i.e. that he was commissioned to produce the work. The copyright would, therefore, vest in AN. Any transfer of copyright must be in writing: s. 90(3) CDPA. RB has filed no evidence that there was a written transfer of rights; AN's statement that there was a transfer on payment of his design fee does not confirm that there was a written assignment to RB. I am unable to conclude that RB is entitled to rely upon either of the later two works as owner of the copyright.

173. I should also say that it is possible for copyright to be shared, resulting from a collaboration. However, the evidence in this regard is thin. RB asserts that he is the "creative copyright" and that the works are the result of "a creative expression I personally created with [AN]". AN's evidence is simply that both contributed ideas to the development process. An idea does not attract copyright protection: it is the expression of that idea which is protected: *Designers Guild Ltd v Russell Williams (Textile) Ltd* [2001] FSR 11 HL. Simply stating that he had creative input is not enough on its own to establish that RB's contribution was a substantial part of the skill and contribution which went into the work. In the absence of any explanation of the parties' respective roles, I am unable to conclude that RB jointly owned the copyright.

174. The claim under s. 5(4)(b) fails.

RB's opposition to UK3271401 & UK3271045 based upon s. 3(6)

175. An applicant for a trade mark is assumed to have acted in good faith unless the contrary is proven. RB's claim under this ground is that Hasu is trying to register the brand name RB uses and to profit from doing so. This is expanded in submissions, where the applications are said to be attempts to prevent RB from trading.³⁶

176. No explanation is given by Hasu of its motivation in filing the applications. It is clear that the parties were, by the application dates, in dispute over payments due in respect of the EUTMs. However, RB does not explain how Hasu intends to profit from the applications. I accept that a trade mark registration is an exclusive right and allows the owner of such a registration to prevent others from using the same or similar marks but it has not been established that Hasu had any such intentions. It is of course relevant that the applications are or contain the word "nineplus" and that they are for goods in which RB appears to have an interest. However, they are also identical to two of the EUTMs, to the registration of which RB consented. He says that the renewal of these EUTMs was in breach of an agreement but there is no evidence to that effect and no evidence (and no entry on the official record) that any of the marks are under challenge at the EUIPO. There is also no evidence that the existence of the EUTMs has prevented RB from trading or that Hasu has ever taken any steps to prevent him from doing so. RB has filed nothing which establishes that such an intention lies behind these applications.

177. In circumstances where the parties are in dispute, Hasu is not the trading entity and there is no suggestion that that will change, there are certainly questions over what Hasu's intentions were in applying for the marks. However, the evidence falls a long way short of distinctly proving that Hasu acted in bad faith. The oppositions under s. 3(6) fail.

³⁶ Submissions dated 12 February 2019.

Overall outcome of RB's opposition to UK3271401 & UK 3271045

178. The oppositions have succeeded in part. The marks will proceed to registration for the following goods and will be refused for the remainder:

Class 25: Footwear; headgear.

Class 28: Games; toys and playthings; Gymnastics articles and equipment

Conclusion

179. UK trade mark application number 32468389 will proceed to registration for the goods listed at paragraph 134, above.

180. UK trade mark application numbers 3271401 and 3271045 will proceed to registration for the goods listed at paragraph 178, above.

181. The applications will be refused in respect of the other goods for which registration was sought.

Costs

182. The parties have both had a measure of success and I order that they bear their own costs.

Dated this 30th day of March 2020

**Heather Harrison
For the Registrar
The Comptroller-General**

ANNEXE

UK trade mark application number 3246839

Class 25: Adhesive bras; After ski boots; Aikido suits; Aikido uniforms; Albs; Aloha shirts; American football bibs; American football pants; American football shirts; American football shorts; American football socks; Anglers' shoes; Ankle boots; Ankle socks; Anklets [socks]; Anoraks; Anoraks [parkas]; Anti-perspirant socks; Anti-sweat underclothing; Anti-sweat underwear; Après-ski boots; Apres-ski shoes; Aprons; Aprons [clothing]; Aqua shoes; Arm warmers [clothing]; Army boots; Articles of clothing; Articles of clothing for theatrical use; Articles of clothing made of hides; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Ascots; Ascots (ties); Athletic clothing; Athletic footwear; Athletic shoes; Athletic tights; Athletic uniforms; Athletics footwear; Athletics hose; Athletics shoes; Athletics vests; Babies' clothing; Babies' outerclothing; Babies' pants [clothing]; Babies' pants [underwear]; Babies' undergarments; Babushkas; Baby bodysuits; Baby boots; Baby bottoms; Baby clothes; Baby doll pyjamas; Baby layettes for clothing; Baby pants; Baby sandals; Baby tops; Balaclavas; Ball gowns; Ballet shoes; Ballet slippers; Ballet suits; Ballroom dancing shoes; Bandanas; Bandanas [neckerchiefs]; Bandeaux [clothing]; Barber smocks; Baseball caps; Baseball caps and hats; Baseball hats; Baseball shoes; Baseball uniforms; Baselayer bottoms; Baselayer tops; Basic upper garment of Korean traditional clothes [Jeogori]; Basketball shoes; Basketball sneakers; Bath robes; Bath sandals; Bath shoes; Bath slippers; Bathing caps; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Bathrobes; Bathwraps; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear; Beach hats; Beach robes; Beach shoes; Beach wraps; Beachwear; Beanie hats; Beanies; Bed jackets; Bed socks; Belts [clothing]; Belts for clothing; Belts made from imitation leather; Belts made of leather; Belts made out of cloth; Belts (Money -) [clothing]; Belts of textile; Berets; Bermuda shorts; Bib overalls for hunting; Bib shorts; Bib tights; Bibs, not of paper; Bikinis; Blazers; Bloomers; Blouses; Blouson jackets; Blousons; Board shorts; Boardshorts; Boas; Boas [clothing]; Boas

[necklets]; Boaters; Bobble hats; Bodices; Bodices [lingerie]; Bodies [clothing]; Bodies [underclothing]; Body linen [garments]; Body stockings; Body suits; Body warmers; Bodysuits; Boiler suits; Boleros; Bolo ties; Bolo ties with precious metal tips; Bomber jackets; Bonnets; Bonnets [headwear]; Boot cuffs; Boot uppers; Bootees (woollen baby shoes); Booties; Boots; Boots for motorcycling; Boots for sport; Boots for sports; Boots (Ski -); Bottoms [clothing]; Bow ties; Bowling shoes; Bowties; Boxer briefs; Boxer shorts; Boxing shoes; Boxing shorts; Boy shorts [underwear]; Boys' clothing; Bra straps; Bra straps [parts of clothing]; Braces for clothing; Braces for clothing [suspenders]; Braces [suspenders]; Bralettes; Bras; Brassieres; Breeches; Breeches for wear; Bridal garters; Bridal gowns; Bridesmaid dresses; Bridesmaids wear; Briefs; Briefs [underwear]; Bucket caps; Burnouses; Bushjackets; Bustiers; Bustle holder bands for obi (obiage); Bustles for obi-knots (obiage-shin); Button down shirts; Button-front aloha shirts; Caftans; Cagoules; Camiknickers; Camisoles; Camouflage gloves; Camouflage jackets; Camouflage pants; Camouflage shirts.

Class 28: Abdomen protectors for athletic use; Abdomen protectors for Taekwondo; Action figure toys; Action figures [toys or playthings]; Action skill games; Action toys; Aerobic step machines; Aerobic steps; Aerosol actuator guns [playthings]; Air mattresses for recreational use; Air pistols [toys]; American footballs; Ammunition for paintball guns; Ammunition for paintball guns [sports apparatus]; Amusement apparatus adapted for use with television receivers only; Amusement apparatus being coin-operated; Amusement apparatus for use in arcades; Amusement game machines; Amusement machines, automatic and coin-operated; Amusement park rides; Angling bank stick supports; Angling nets; Animal replicas as playthings; Ankle and wrist weights for exercise; Apparatus for archery; Apparatus for corinthian games; Apparatus for games; Apparatus for games adapted for use with television receivers; Apparatus for launching clay pigeons; Apparatus for launching clay plates; Apparatus for use in training for the game of rugby [sporting equipment]; Appliances for gymnastics; Aquarium fish nets; Arcade game machines; Arcade games; Arcade games (electronic -) [coin or counter operated apparatus]; Arcade video game machines; Arcade video game machines with multi-terminals; Archery apparatus; Archery arm guards; Archery

arrow points; Archery bow cases; Archery bow stringers; Archery bows; Archery bowstrings; Archery finger tabs; Archery implements; Archery implements [of Japanese and western styles]; Archery quivers; Archery sets; Archery targets; Arm guards for sports use; Arm pads adapted for use in sporting activities; Arm protectors for athletic use; Arrows [for archery]; Articles for playing golf; Articles for playing jokes; Articles for use in archery; Articles of clothing for dolls; Articles of clothing for toys; Artificial baits for fishing; Artificial Christmas trees; Artificial chum for fishing; Artificial climbing walls; Artificial fish bait; Artificial fishing bait; Artificial fishing worms; Artificial flies for use in angling; Artificial snow for Christmas trees; Ascenders [mountaineering equipment]; Athletic protective arm pads for cycling; Athletic protective arm pads for skateboarding; Athletic protective arm pads for skating; Athletic protective elbow pads for cycling; Athletic protective elbow pads for skateboarding; Athletic protective elbow pads for skating; Athletic protective knee pads for cycling; Athletic protective knee pads for skateboarding; Athletic protective knee pads for skating; Athletic protective sportswear; Athletic protective wrist pads for cycling; Athletic protective wrist pads for skateboarding; Athletic protective wrist pads for skating; Audible indicating apparatus for use in fishing; Automatic coin-operated games; Automatic gaming machines; Automatic mahjong tables; Baby gyms; Baby playthings; Baby rattles; Baby rattles incorporating teething rings; Baby swings; Back supports [belts] for weightlifters; Backboards for basketball; Backgammon games; Backgammon sets; Badminton equipment; Badminton nets; Badminton rackets; Badminton racquets.