

O-331-20

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3359396
BY AMAZON EUROPE CORE S.À R.L.
TO REGISTER

FABI FUCHS

AS A TRADE MARK IN CLASS 25

AND

OPPOSITION THERETO
UNDER NO. 416018
BY FABI S.P.A.

Background and pleadings

1. On 07 December 2018, Amazon Europe Core S.à r.l. (“the applicant”) applied to register the trade mark shown below under number 3359396:

FABI FUCHS

2. The application was published for opposition purposes on 18 January 2019. Following the division of the application originally filed, the current application only covers the goods shown below:

Class 25 Clothing; footwear; headgear; athletic shoes; bandanas; baseball caps; beach cover-ups; beachwear; belts; bikinis; blazers; boots; bow ties; caps; cloaks; cloth bibs; coats; costumes for use in role-playing games; dresses; ear muffs; gloves; golf shirts; Halloween costumes; hats; head bands; headwear; hosiery; infantwear; jackets; jeans; jerseys; kerchiefs; leotards; leg warmers; lingerie; loungewear; mittens; neckties; night shirts; night gowns; overalls; pajamas; pants; polo shirts; ponchos; rainwear; robes; sandals; scarves; shirts; shoes; skirts; shorts; slacks; slippers; sleepwear; socks; stockings; sweaters; sweat pants; sweat shirts; swimsuits; t-shirts; tank tops; tights; underwear; vests; and wrist bands.

3. Fabi S.p.A. (“the opponent”) filed a notice of opposition on 16 April 2019 on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application. The opponent relies upon the below mentioned earlier trade marks:

Mark: FABI (“Word Mark”)

European Union trade mark (“EUTM”) registration no. 010258945

Filing date: 12 September 2011


Date of entry in register: 17 February 2012

Even though the opponent sought to rely on all goods in class 25, it provided a statement of use only for footwear. The opponent did not plead that there were proper

reasons for non-use of the remaining goods. Given that the opponent's class 25 specification does not contain the broad term footwear, it may, subject to proof of genuine use, rely on the specific items of footwear listed therein, namely:

Class 25 Shoes, Shoes of rubber, Boots, Lace boots, Ankle boots, Gymnastic shoes, Cleated shoes, Football boots and shoes, Beach shoes, Rain boots, Galoshes, Open-toed sandals, Sandals, Wooden shoes, Slippers.¹



Mark:  ("Figurative Mark")

European Union trade mark ("EUTM") registration no. 002063881

Filing date: 29 January 2001

Date of entry in register: 19 August 2005

Given that the opponent has claimed genuine use only for footwear, it may, subject to proof of genuine use, rely only on the goods for which it has claimed use, namely:

Class 25 Footwear

4. The opponent argues that there is a likelihood of confusion, including the likelihood of association because the competing marks and goods are identical or highly similar.

5. Given their dates of filing, the trade marks upon which the opponent relies qualify as earlier trade marks in accordance with section 6 of the Act.

6. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of both earlier marks.

7. The opponent is represented by Stratagem Intellectual Property Management Limited. The applicant is represented by Cooley (UK) LLP. Only the opponent filed evidence. I will summarise the evidence to the extent I consider appropriate. No

¹ The terms soles for footwear, heels and footwear upper in the specification are parts and fittings of footwear.

hearing was requested. Both parties filed written submissions in lieu. I make this decision after a careful reading of all the papers filed by the parties.

Evidence

Opponent's evidence

8. The evidence consists of the witness statement of Alessia Fabi, with eight exhibits. Ms Fabi states that she is the legal representative and Administrator of the opponent company.

9. Ms Fabi claims that the opponent has been selling footwear under the mark FABI to retailers in the UK since at least 2012 and directly to end-users in the UK through the opponent's website <http://www.fabishoes.it/en/>.²

10. According to Ms Fabi, the sales in the UK during the relevant period were as follows:³


2014	£90,011
2015	£40,136
2016	£797
2017	£14,835
2018	£6,277


11. Images of two different pairs of shoes referred to as IMAGE 1 and IMAGE 2 are provided as Exhibit FABI-1. The mark FABI is seen only on IMAGE 1. The Exhibit is undated.

12. Ms Fabi states that for record-keeping purposes, the opponent uses "style codes" on its invoices and that the goods sold under the mark FABI correspond to style codes with prefixes FU and FD. Ms Fabi further states that the invoices include descriptions such as SCARPA, STIVALE and POLACCO, which she confirms are all types of shoes

² See witness statement, para 3.

³ See witness statement, para 4.

(STIVALE being, specifically, a type of boot). Ms Fabi further provides two invoices, which she refers to as example invoices, as Exhibit FABI-2, both from November 2018.⁴ The invoices show the opponent's name and the sign . Ms Fabi claims that the pairs of shoes shown on IMAGES 1 and 2 in the Exhibit FABI-1 correspond to the style codes FD5755A00Z and FU914OA00P in the example invoices.

13. One hundred and twenty-one invoices are provided as Exhibit FABI-3. These invoices are dated between January 2015 to December 2018, and the total number of invoices from each year ranges between 26 to 37. All the invoices show the opponent's name and the sign . The recipients have addresses throughout the UK. The invoices identify the opponent's goods by style codes. Most of the invoices refer to style codes with prefixes FU/FD and descriptions such as SCARPA, STIVALE and POLACCO are seen throughout. The invoice amounts are shown in Euros. The quantities of the products sold vary, so do their prices.

14. Ms Fabi claims that the turnover figures filed in evidence as Exhibit FABI- 4 are the turnover of products sold under the mark FABI in the UK. The total turnover between December 2013 to December 2018 is Euro 109,229.51. Like the invoices, the Exhibit also identifies the goods by the opponent's style codes. There are references to codes with prefixes FU/FD. There are also numerous entries referring to SCARPA and POLACCO goods both with and without the style codes FU/FD.

15. At Exhibits FABI-5 and Exhibit FABI-6 are what Ms Fabi claims to be Google Analytics data relating to the opponent's website. Exhibit FABI-5 covers data relating to five locations in the UK, while Exhibit FABI-6 contains data for ten EU countries, including the UK. Even though the opponent claims that both Exhibits contain data for 2018, the year is visible only on Exhibit FABI-5. Although it is not legible what the figures in Exhibit FABI-5 relate to, Ms Fabi claims that there were 7,960 sessions resulting in 50 sales amounting to Euro 18,655.30. The evidence, however, does not indicate whether the sales were made in relation to footwear under the mark FABI.

⁴ The years are incorrectly provided in the witness statement as 2014 and 2018.

16. The mark is also used on social media. Pages from the opponent's Instagram and Twitter accounts and YouTube channel are in evidence as Exhibit FABI-7. The Instagram user name appearing on the profile and the URL is "fabishoes", and the profile photo is . The opponent has 50.8 thousand followers. The pages filed in evidence have several images of footwear which appear to have been posted in 2019. There is a reference to "Fabi Fall Winter 2019-2020 Collection" on the first page. The opponent's Twitter account has 1,032 followers. Even though the tweets appear to have been made in 2019, the account was created in February 2010 under the username "@Fabi_Shoes". The account displays the logo  on its profile. The opponent's YouTube account for "Fabi Shoes" was created in April 2010. The account has 2.31 thousand subscribers and 1,360,619 views.

17. Exhibit FABI-8 consists of a number of extracts from various websites showing what the opponent's claims are the current stock of footwear on sale. Ms Fabi claims that the Exhibit was filed to demonstrate the current use of the mark in the UK. The Exhibit contains extracts from YOOX website,⁵ print outs from the websites *Amazon.co.uk*, *www.farfetch.com*, and *www.fabiboutique.com*. Several images of footwear under the mark FABI are shown on all the pages. Some of those images refer to new arrivals 2019/2020.

Proof of Use

18. As the opponent's marks had completed their registration process more than 5 years before the date of application of the contested mark, they are both subject to proof of use pursuant to section 6A of the Act. The applicant has requested that the opponent provide proof of use of its marks.

19. The relevant statutory provisions are as follows:

"6A. Raising of relative grounds in opposition proceedings in case of non-use

⁵ The web address and most of the texts are not legible.

(1) This section applies where –

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

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

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

(3) The use conditions are met if –

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

(4) For these purposes –

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

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

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

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

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

20. 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.”

21. 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 Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the

control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].
- (7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of

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

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

22. As the earlier marks are all EUTMs, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, are relevant. The court noted that:

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

And:

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

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A de minimis rule, which would not allow the national court to appraise 13 all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

At paragraphs 57 and 58, the court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

23. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the Leno case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant’s challenge to the Board of Appeal’s conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant’s argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guilford, and thus a finding which still left open the possibility of conversion of the community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that “genuine use in the Community will in general require use in more than one Member State” but “an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State.” On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand

it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multifactorial one which includes the geographical extent of the use."

24. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

25. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTMs, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them; and
- e. The geographical extent of the use shown.

26. In *Awareness Limited v Plymouth City Council*,⁷ 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.”

Relevant period

27. Pursuant to section 6A of the Act, the relevant period for assessing whether there had been genuine use of the earlier marks is the 5-year period ending with the date of application of the contested mark, i.e. 8 December 2013 to 7 December 2018.

Form of the Mark

28. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of

registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.






35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added).

29. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...


34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

30. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

31. The evidence shows the use of the registered mark FABI and the sign . Even though the sign  appears on most of the opponent’s evidence, it is a settled law that the use in conjunction with another sign falls within the ambit of genuine use.⁶ The opponent can, therefore, rely on the use of the variant form . I also consider that the registered mark FABI⁷ and the sign  are acceptable variants of the opponent’s second earlier mark . This is because this mark derives its distinctive character from the word element “FABI”. The square bracket in the background adds nothing to the distinctive character of the mark. Accordingly, neither the omission of the bracket

⁶ See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12.

⁷ Trade mark in the variant form can also be a registered mark. See Section 6A(4) of the Act.

nor the addition of the device  as a separate element would alter the mark's distinctive character.

Sufficient Use

32. The applicant claims that the opponent's evidence is insufficient for various reasons. I will consider the applicant's criticism of the opponent's evidence to the extent it is necessary to do so.

33. The applicant argues that there is no use of the opponent's mark in relation to footwear in Exhibits FABI-2, FABI-3 and FABI-4. I disagree. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁸ I bear in mind that it is common to identify the goods in the invoices/turnover figures with reference codes. Accordingly, the Exhibits must be assessed in conjunction with the opponent's statement that the style codes identified in those Exhibits with prefixes FU/FD correspond to footwear sold under the mark FABI. For illustration purpose, Ms Fabi filed images of footwear where the mark FABI is seen as stamped on them.⁹ She claims that those footwears correspond to FU/FD codes in the invoices issued in 2018.¹⁰ In the absence of cross-examination, I accept Ms Fabi's statement on the point. Exhibits FABI-3 and FABI-4 contain numerous entries spanning the entire relevant period for items which I am satisfied are items of footwear that are likely to have been sold under the mark FABI. In particular, I note that there are many entries for goods described as SCARPA, STIVALE and POLACCO which Ms Fabi has confirmed are types of shoes and boots. These entries appear throughout Exhibits FABI-3 and FABI-4 both with and without the codes FD/FU. All the invoices bear the mark FABI on the top. Considering the evidence as a whole, I am satisfied that the Exhibits FABI-2, FABI-3 and FABI-4 demonstrates the use of the mark in relation to items of footwear.

⁸ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

⁹ Exhibit FABI-1

¹⁰ Exhibit FABI-2 and FABI-3

34. The applicant further contends that the opponent's invoices should be considered to have low evidential value because of their internal nature.¹¹ It is clear that the opponent's invoices are addressed to end consumers based in several locations across the UK. The invoices display the mark FABI and identify footwear sold under the mark FABI by reference to style codes. This clearly constitutes external use of the mark in relation to footwear, and I, therefore, dismiss the applicant's arguments that the invoices are internal invoices.

35. The sales are spread over the entire five-year period with sales at regular intervals every year from 2013-2018. The use, therefore, appears to be stable and consistent. The evidence also indicates that the use was directed, geographically, at the whole of the UK. Although the EU footwear market is vast and the opponent's sales are modest, I am satisfied that the use of the opponent's earlier marks is sufficient to create and maintain a market within that sector in the EU over the relevant five-year period.

Fair Specification

36. The next step is to decide whether the extent of use entitles the opponent to rely upon all the goods for which it has claimed use.

37. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To

¹¹ See para 35 of the applicant's written submission dated 9 December 2019.

my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

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

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently

then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

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

38. I also bear in mind the law summed up by Mr Geoffrey Hobbs Q.C. as Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

39. The product description that appears on the invoices and turnover figures are “SCARPA”, “STIVALE” and “POLACCO”, which according to Ms Fabi refer to “shoes”, “a type of shoe” and “boots”, respectively. The items that are, therefore, identifiable from the evidence as having been shown as sold are shoes and boots. The opponent has not, however, shown the use of the mark in relation to certain sub-categories of footwear such as sandals or slippers. I consider that the average consumer would

describe the category of goods upon which the use has been shown as “shoes and boots”. I, therefore, consider the fair description of the opponent’s goods under both earlier marks to be:

Class 25: Shoes, boots

Section 5(2)(b)

40. Section 5(2)(b) of the Act is as follows:

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

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

Case law

41. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

(b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make

direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) The average consumer normally perceives the 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 greater 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 to mind the earlier mark, 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.

The average consumer and the nature of the purchasing act

42. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer.

43. 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”.

44. The average consumer of the competing goods is a member of the general public. The goods are likely to be purchased fairly frequently. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural element to the purchase, particularly when advice is sought from a sales representative or a purchase is made further to a word-of-mouth recommendation. When making a purchase, factors such as size, material, colour, cost (which will vary according to the item) may be considered. These factors suggest that the average consumer will pay a medium level of attention when making their selection.

Comparison of goods

45. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“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”.

46. 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.

47. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was)

stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

48. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“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”.

49. 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. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] 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”.

50. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

51. 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”.

52. The applicant submits:

“The Applicant highlights that confusion cannot exist in a factual vortex, without consideration of the commercial realities of the marketplace. The Applicant’s use of FABI FUCHS, as the name of a fox cartoon character, is used for a German language children’s playlist on Amazon Music. The Applicant reiterates that its use of FABI FUCHS for clothing or footwear would be related to this character and would be for children only, children that listen to the German playlist which is a very specific consumer. The opponent does not offer any children’s clothing or footwear under its FABI mark. The parties therefore occupy different sectors and are therefore not in direct competition with each other.”

53. The applicant’s actual use of the mark in the marketplace is irrelevant to the decision I have to make. This is because I must consider the notional and fair use of the applied-for mark in all the circumstances in which it may be used if it were registered.¹² I must then assess any potential conflict of the applicant’s goods as they appear on the register with the goods upon which the opponent is entitled to rely.

Contested goods in Class 25

Footwear; athletic shoes; boots; shoes; sandals, slippers, socks

¹² see *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84 and *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06) at paragraph 66.

54. The terms boots and shoes are identically contained in the opponent's specification. Footwear, athletic shoes and sandals are identical to shoes in the opponent's specification under the *Meric* principle (sandals being a type of light shoe). In relation to slippers, I consider that there is a high degree of similarity with the opponent's shoes and boots given their similarity in nature, purpose and method of use and that the users are the same, and the goods share the distribution channels. As to the term socks, I find there to be a medium degree of similarity between these and the opponent's shoes and boots. This is because, although the nature of socks and shoes differs (bearing in mind the quite different materials of which they are likely to be made), the respective goods share a similar purpose in that they will all be worn on the feet and they are likely to share trade channels.

Clothing; beach cover-ups; beachwear; belts; bikinis; blazers; cloaks; coats; costumes for use in role-playing games; dresses; ear muffs; gloves; golf shirts; Halloween costumes; hosiery; infantwear; jackets; jeans; jerseys; kerchiefs; leotards; leg warmers; mittens; overalls; pants; polo shirts; ponchos; rainwear; robes; scarves; shirts; skirts; shorts; slacks; sweaters; sweat pants; sweat shirts; swimsuits; t-shirts; tank tops; tights; vests; and wrist bands.

55. The nature of the above goods is not the same as the opponent's goods and they are not in competition. However, these goods have similarity in purpose with the opponent's shoes and boots, given that they are worn to cover parts of the body. The users are the same, and the goods reach the market through the same distribution channels and are likely to be found in the same retail outlets. Considered overall, I find that competing goods are similar to a medium degree.

Headgear; bandanas; baseball caps; caps; hats; head bands; headwear.

56. These goods are items of clothing.

Therefore, the same reasoning as above applies to these goods. The applicant's goods are similar to the opponent's boots and shoes to a medium degree.

Loungewear; night shirts; night gowns; pajamas; sleepwear; lingerie; underwear

57. These goods are casual/sleepwear items or underwear. Similar considerations apply to these goods as for the items of clothing addressed at paragraph 55. Considered overall, I find that the competing goods are similar to a medium degree.

Cloth bibs

58. These are items for babies. They are different in nature to the opponent's goods and, although intended to be worn on the body, serve a different specific purpose to the opponent's goods. That said, the users are the same, and they are likely to share the distribution channels. However, the goods do not compete. Considered overall, I find that the goods are similar to a low degree.

Bow ties; neckties

59. These are neckwear worn around a collar for decorative purpose. Their nature and method of use will differ from shoes in the opponent's specification, but their users will be the same. There is likely to be an overlap in the channels of trade. Considered overall, I find that the competing goods are similar to a low degree.

Comparison of marks

60. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the 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 in paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

62. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
FABI	FABI FUCHS

63. The opponent's mark is comprised of the word "FABI" presented in capital letters without any stylisation. The overall impression of the mark lies in the word "FABI".

64. The applicant's mark is comprised of the words "FABI" and "FUCHS", both presented in capital letters without any stylisation. In my view, the components will not form a unit with meaning, and both words will, therefore, retain an independent distinctive role in the mark. Given that the words are nearly of the same length and presented in an identical typeface and size, both words make an equal contribution to the overall impression of the mark.

65. Concerning the visual comparison, the applicant submits:

“Visually, the Application Mark and the Opponent's Marks differ in length, rhythm and composition resulting from the presence of the FUCHS element in the Applicant Mark. Whilst both marks coincide to the extent, they comprise the FABI element, the relevant consumer is able to visually distinguish the two marks because the additional element of the Application Mark creates a sufficiently different impression. These differences offset the low degree of

similarity between the marks, and the Opponent's Marks and the Application Mark are therefore overall visually dissimilar."

66. Visually both marks coincide in the word "FABI" which is the only element in the opponent's mark. In terms of differences, the applicant's mark contains the additional word "FUCHS". Weighing up the similarities and differences, and bearing in mind that it is usually the first word/part of a mark that tends to have the greatest impact upon the consumer's perception,¹³ I find that the marks are visually similar to a medium degree and not dissimilar as argued by the applicant.

67. The opponent's mark will be pronounced as a single two-syllable word whereas the applicant's mark will be pronounced as two separate words consisting of two-and one syllables each. The marks coincide in the pronunciation of the word "FABI". The aural difference between the marks is introduced by the second word in the applicant's mark which does not have a counterpart in the opponent's mark. Considering these factors, I find that the marks are aurally similar to a medium degree.

68. As regards the conceptual comparison, the marks coincide in the word "FABI". The opponent submits that the mark "FABI" will be seen by the relevant consumer as the name of a designer. I do not discount the possibility that some consumers may perceive "Fabi" as a name. However, given that "Fabi" is not a commonly used name in the UK, in my view, it is more likely that the average consumer of the category of goods in question will see it as an invented word. The applicant's mark also contains the word "FACHS" and the applicant contends that this word will be perceived as the German word for "fox".¹⁴ It is well established that for a conceptual meaning to be relevant, it must be one capable of immediate grasp.¹⁵ In the absence of evidence, it does not seem to me that the meaning of the German word for "fox" can be assumed for the average UK consumer. In my view, the average consumer is more likely to see the second word in the applicant's mark also as an invented word. Considered overall, I find that the competing marks are conceptually neutral.

¹³ See, for example, *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 [81] - [83].

¹⁴ The applicant's written submissions dated 11 February 2020, para 18.

¹⁵ See Case C-361/04 *P Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29.

Opponent's Figurative Mark

69. Visually, the competing trade marks coincide in the word "FABI". In terms of differences, the applicant's mark has an additional word element FUCHS, and the opponent's mark has a square bracket that forms the background for the word element. Considering the similarities and the differences, in my view, the visual similarity between the competing trade marks is slightly less than medium.

70. My findings as set out at paragraphs 67 and 68 apply for the aural and conceptual similarities between the contested marks. The competing marks are aurally similar to a medium degree and conceptually neutral.

Distinctiveness of the earlier marks

71. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

72. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the marks.

73. The word “FABI” is neither allusive nor suggestive of the goods at issue. It is most likely to be perceived as an invented word. Therefore, the distinctiveness of the marks is already high. Although the evidence filed by the opponent demonstrates the use of the marks in relation to shoes and boots, the opponent has not claimed enhanced distinctiveness of its marks. Given the size of the UK market for footwear, the use on the scale shown by the opponent is insufficient to establish the acquired distinctiveness of the marks in relation to shoes and boots. Moreover, there is no information regarding the market share held or third-party evidence of recognition. Taking the evidence into account, I am unable to conclude that the distinctiveness of the earlier marks has been enhanced through its use.

Likelihood of Confusion

74. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the trade marks (Canon at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent’s trade marks, as the more distinctive those trade marks are, the greater the likelihood of confusion (Sabel at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (Lloyd Schuhfabrik at [26]).

75. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertaking being the same or related).

76. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

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

77. 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 another mark to mind. This is mere association not indirect confusion.

78. 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.”

79. In my view, the word “FUCHS” in the applicant’s mark is sufficiently prominent to avoid direct confusion. That leaves only the indirect confusion to be considered.

80. I will begin by considering the position in relation to the opponent's Word Mark first. I have found the respective marks to be visually and aurally similar to a medium degree and conceptually neutral. The goods will be selected primarily by visual means, with a medium degree of attention paid by the general public. The goods are either identical or similar to varying degrees (high, medium or low, as identified earlier). I also concluded that the shared component "FABI" is most likely to be perceived as an invented word and is highly distinctive.

81. I bear in mind that the distinctiveness of the common element is key¹⁶ and in the case before me, the common element is highly distinctive. This is an important factor weighing in the opponent's favour. I do, however, remind myself that it is still a whole mark comparison that must be made. Bearing in mind the medium degree of both visual and aural similarity between the marks overall, together with the high degree of distinctive character of the shared component and the independent distinctive role this shared component plays in the applicant's mark, I consider that these factors, in particular, will lead the average consumer to think that the identical or similar goods at issue are from the same or economically linked undertakings. In the absence, also, of a conceptual hook that can aid in differentiating between the respective marks, I conclude there is a likelihood of indirect confusion in respect of all of the goods, even those which are similar only to a low degree.

82. Following my findings as given above, I consider that there is a likelihood of confusion in respect of the opponent's Figurative Mark as well. This is because the similarity between the word elements in the marks will counteract any differences and the consumer will think that the later mark is a brand extension or variant mark being used by the owner of the earlier trade marks.

Conclusion

83. The opposition has succeeded in full. The application will be refused.

Costs

¹⁶ Kurt Geiger v A-List Corporate Limited, BL O/075/13

84. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. I note the opponent filed evidence in these proceedings as well as written submissions in lieu of a hearing. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Preparing and filing evidence:	£500
Preparing written submissions:	£300
Total:	£1,100

85. I order Amazon Europe Core S.à r.l. to pay Fabi S.p.A. the sum of **£1,100**. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19th day of June 2020

Karol Thomas
For the Registrar
The Comptroller-General