

**O-113-21**

**INTERIM DECISION**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3381620**

**BY BERKELEY VINCENT**

**TO REGISTER:**

**Black Prince**

**AS A TRADE MARK IN CLASSES 9, 16, 28 & 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 417321 BY**

**PRINCE SPORTS, INC.**

## BACKGROUND & PLEADINGS

1. On 8 March 2019, Berkeley Vincent (“the applicant”) applied to register the words **Black Prince** as a trade mark for goods and services in classes 9, 16, 28 and 41.

The applicant seeks registration for the following goods in class 28:

Games, playing cards, toys, playthings, action figures, figurines, models and jig saw puzzles. Electronic games for personal use and arcades, pin ball games or machines, and video games apparatus. sporting articles for use in cricket, fencing, boxing, gymnastics, athletics, badminton, squash, golf, grass and ice hockey, polo, football, lacrosse, fives, table tennis, baseball, basketball, netball, bowls, lawn tennis, croquet, clock golf, quoits and petanque; decorations for Christmas trees

2. On 14 August 2019, the application was opposed, in part, by Prince Sports, Inc. (“the opponent”). The opposition, which is only directed against the goods in class 28 shown above, is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). In relation to both grounds of opposition, the opponent relies upon all the goods in the United Kingdom registrations shown below:

(1) No. 1369242 for the trade mark **PRINCE**, which was filed on 5 January 1989 and registered on 7 February 1992. It stands registered for the following goods:

Tennis ball throwing machines; tennis rackets and parts and fittings therefor; tennis balls; all included in Class 28.

(2) No. 1476474 for the trade mark shown below which was filed on 13 September 1991 and registered on 22 July 1994. It stands registered for the goods shown below:



Racquets for sports; balls and shuttlecocks, all for racquet sports; racquet strings, bags adapted to carry gymnastic and sporting articles; tennis ball throwing machines; parts and fittings for all the aforesaid goods; all included in Class 28.

3. Insofar as its objection based upon section 5(3) of the Act is concerned, the opponent states that its trade marks enjoy a reputation for all the goods for which they stand registered, adding that it considers all of the goods in class 28 for which registration is sought would take unfair advantage of, or be detrimental to, the distinctive character or reputation of its trade marks. Having answered “Yes” to question 3 in the Notice of opposition which states:

“Is it claimed that the similarity between the [trade marks being relied upon] and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?”,

the opponent further states:

“the use of the mark applied for will cause the relevant public to believe that the Earlier Trade Marks are used by the same undertaking or think that there is an economic connection between the users of the mark applied for and the Earlier Trade Marks.”

4. In relation to questions 4, 5 and 6 in the Notice of opposition which begin “Is there any other basis for your claim other than your answer to Q3”, the opponent states:

### **Unfair advantage**

“the use of the mark applied for will free-ride on the coattails of the reputation associated with the Earlier Trade Marks and the Applicant will thereby derive an illegitimate benefit from it and/or exploit the marketing efforts expended by the Opponent in creating and maintaining the Earlier Trade Marks' reputation and image.”

## **Detriment to reputation**

“the use of the mark applied for will tarnish the reputation of the Earlier Trade Marks because the Opponent will be unable to control the manner in which the Applicant (or others) uses the mark applied for and which may be used in a manner adverse to the reputation of the Earlier Trade Marks...”

## **Detriment to distinctive character**

“the use of the mark applied for will dilute the distinctive character of the Earlier Trade Marks because the presence of a similar mark in the market will reduce the capacity of the Earlier Trade Marks to create an immediate association with the Opponents' goods and services for which they are registered and thus dilute their value and reputation.”

5. The applicant filed a counterstatement which consists, in essence, of a denial of the grounds upon which the opposition is based. The applicant states:

“1. I admit the Opponent owns "arguably" similar Earlier Trade Marks (ETMs) but deny that they are "highly" similar.

2. I admit there exists a "possibility" of confusion on the part of the Relevant Public (RP). However, I deny "likelihood", and rather think it "unlikely". Ditto RP's "likelihood of association" of BLACK PRINCE with Opponent's ETMs.

3. I deny that BLACK PRINCE is either visually, aurally, or conceptually(?) similar to the ETMs, but rather maintain that it is 'distinguishable". I deny that the RP might consider that BLACK PRINCE goods are provided by the Opponent or by an economically linked undertaking...”

6. In these proceedings, the opponent is represented by Potter Clarkson LLP; the applicant represents himself. Both parties filed evidence. At the conclusion of the evidence rounds the parties were asked if they wished to be heard, failing which, a decision from the papers would be issued. Both parties filed written submissions. I

shall keep all of these submissions in mind, referring to them to the extent I consider it appropriate to do so.

7. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **EVIDENCE**

### **The opponent's evidence**

8. This consists of a witness statement, dated 12 February 2020, from Tyler Herring, the opponent's VP of Brand & Marketing, Active & Street, a position he has held since July 2016. Mr Herring states that the opponent's trade marks:

“8...have been used in the United Kingdom for many years, since at least as early as 1980...in relation to a range of goods categorised in class 28...”

9. Mr Herring explains that the “PRINCE” trade mark was coined in the 1970s for use in connection with a ball machine marketed as the “LITTLE PRINCE”, shortly after which, the trade mark “PRINCE” was used in connection with a racquet engineered by Howard Head. By the 1980s, a range of footwear was also being sold under the “PRINCE” trade mark, with Mr Herring adding:

“9...Today a wide range of goods are offered under the [trade marks being relied upon] throughout the world, including the UK.”

10. Exhibit 1 consists of pages obtained using the waybackmachine Internet archive from: pdhsports.com (dated March and November 2014, February and December 2015, March and August 2016, June and October 2017 and March 2019), racketworld.co.uk (dated April and October 2016, April and December 2017, February and July 2018 and January and June 2019), sportsdirect.com (dated March

and December 2014, April and November 2015, February and October 2016 and April and July 2017), stringersworld.com (dated July 2014 and February and June 2015) and tennis-point.com (dated January and July 2017, March 2018 and April 2019). The pages provided either show prices in £ sterling or there is an option to select same. The goods shown are, broadly speaking, a range of tennis, squash and badminton rackets, tennis and squash balls and shuttlecocks, ancillary goods such as racket strings, grips etc., items of clothing and footwear and bags adapted for carrying, inter alia, rackets. Although when used on the goods or their packaging the opponent's trade mark no. (2) can be seen, the word "Prince" can be seen throughout the exhibit in product descriptions and promotional text.

11. Mr Herring explains that Framework Sports is a UK distributor of Prince products and accessories. Exhibit 2 is a page from frameworksports.com (bearing a copyright date of 2020) confirming the above in which both of the opponent's trade marks can be seen. Exhibit 3 consists of Framework's trade price lists for "prince accessories" from 2013, "racquet accessories" from 2014 and "SQUASH ACCESSORIES CATALOGUE 2014/2015." Mr Herring points to the references to badminton racquets and shuttlecocks in the 2013 and 2014 price lists. Both of the opponent's trade marks can be seen.

12. Mr Herring explains that exhibits 4A to 4C consist of "dealer catalogues", adding that these documents show use:

"18...of various tennis related products such as....these documents contain products targeted at consumers around the world, including the UK..."

13. The catalogues are dated January 2014, 2015 and 2016. Both of the opponent's trade marks can be seen. Insofar as exhibit 4A is concerned, Mr Herring points to photographs of professional tennis players Taylor Townsend and John Isner, both of which he states are using a "Prince branded racket." Under the heading "INTERNATIONAL MARKETS", "PRINCE UK/IRELAND" are mentioned.

14. Exhibits 4B and 4C are similar in nature, with Mr Herring pointing to photographs of professional tennis players: David Ferrer, the Bryan Brothers, Daniela

Hantuchova, Jelena Jankovic, Lucas Pouille, James Ward and John Peers, all of which are, I note, using Prince branded tennis rackets.

15. Exhibits 5A to 5D are, explains Mr Herring, “Brand Books” from 2016 to 2019. Both of the opponent’s trade marks can be seen. While I have read these documents, I do not intend to summarise their contents here. In relation to exhibit 5D, Mr Herring states:

“19d...Notably, it shows that a number of household names have played with **prince**/PRINCE branded rackets, including Andre Agassi, Monica Seles and Michael Chang, Patrick Rafter, Jenifer Capriate (sic), Maria Sharapova, John Isner and Lucas Pouille.

...show the number of successes by those that use PRINCE/**prince** branded rackets, which will have been viewed around the world, including 24 Wimbledon Champions, 17 US Open Champions, 17 French Open Champions and 15 Australian Open Champions.”

16. The exhibit also contains references to a number of social media “influencers” and to the opponent’s social media activity across multiple platforms including Facebook and Instagram.

17. Exhibit 6 consists of a “Wimbledon Press Recap” for the Prince brand from 2018. Mr Herring states:

“20...It was calculated that in terms of online penetration, Prince-related online content generated over 162 million 'impressions'. It can be seen that PRINCE/**prince** branded products appeared in news articles by Esquire, Vogue, Yahoo, ESPN and CNN. Notably, the final page lists several celebrity endorsements, including by Kourtney Kardashian who shared Prince/**prince** branded products with her 65.4 million followers.”

18. Mr Herring explains that Ms Kardashian generated over 101m “press impressions for Prince by displaying [its] branded rackets.” Exhibit 7 consists of a

press summary including an extract from Daily Mail.com (1,288,889 impressions) in which Ms Kardashian can be seen holding a Prince tennis racket. The date of all the articles is said to be “25 Sep” which, I assume, is a reference to 2018.

19. Mr Herring states:

“22. My company has made significant sales of PRINCE and *prince* branded goods in the United Kingdom and, more broadly, across the EMEA region. Not all of our internal records which could be located, and, which relate to the sales of PRINCE and *prince* branded products during the relevant period, had been recorded in a country-specific format...”

20. I note that collinsdictionary.com defines “EMEA” as an “abbreviation for Europe, Middle East, and Africa.” Exhibit 8 consists of a redacted spreadsheet showing sales to Sports Direct of goods under the trade marks being relied upon. These are as follows:

Year	Sales (€)
2014	184,664,
2015	754,186
2016 (ytd)	214,342

21. Mr Herring states that exhibit 9 consists of a:

“b...redacted copy of a spreadsheet, detailing sales figures (in USD) of PRINCE and *prince* branded products during all four financial quarters of 2015, throughout the EMEA region. The data splits out sales by product categories, namely, 'Non Ball Sales' and 'Ball Sales' and shows that the total sales in each quarter are as follows:



<b>Financial Quarter</b>	<b>Non Ball Sales</b>	<b>Ball Sales</b>
Q1	2,741,160	487,193
Q2	3,064,785	276,564
Q3	3,018,322	508,991
Q4	2,216,501	216,444
<b>TOTAL</b>	<b>11,040,768</b>	<b>1,489,192”</b>

22. Exhibit 10 consists of what Mr Herring describes as:

“22c...a spreadsheet extract of a “statement of certification” relating to sales made to Sports Direct in the UK, during 2018...In summary, the spreadsheets show 2018 sales of [branded goods bearing the trade marks relied upon] into the UK...”

<b>Financial Quarter</b>	<b>Sales (USD)</b>
Q1	771,950
Q2	530,733
Q3	209,264
Q4	456,293
<b>TOTAL</b>	<b>1,968,870”</b>

### **The applicant’s evidence**

23. This consists of a witness statement, dated 1 September 2020, from Mr Vincent. Mr Vincent begins his statement by explaining the origins of his trade mark. While I have noted his comments, I do not need to include them here as they are not relevant to the matters I have to decide. The following appears in the statement:

“18. To recap, my “Black Prince” brand is set to provide a cultural matrix of audio-visual media including music, traditional book publishing, recreational activities, and live events and shows, as well as internet services in the spirit of progress for all humanity ever envisaged by Emperor Haile Selassie I the Great or RasTafari.”

24. In relation to his request for proof of use, Mr Vincent states:

“31...I do not accept that my “proof of use” request in the word “PRINCE” in UK 1369242 to have been answered. As to my “proof of use” request in the image *prince* in UK 1476474, I am happy to accept that this has been answered, bar the last item, which overlaps with the first mark and is therefore not accepted for the same reasons.”

25. Exhibit 1 to Mr Vincent’s statement looks like this:

Exhibit 1 (a)



Exhibit 1 (b)



26. Of this exhibit, Mr Vincent states:

“35. By way of illustrating one element of my defence, I am supplying Exhibit 1 (attached). This is a random image of a Nike duffle bag, its famous tick logo replaced by an off-the-cuff plain version of my mark “Black Prince” in monochrome (a) and colour (b).

Comparing these image with any number of the Opponent’s Prince products, beginning the Prince bags, I do not believe anyone would be either deceived or confused. The “Black Prince” brand is eminently distinguishable from the strong and coherent Prince brand in reality...

I feel that this disposes of the Opposition to my Application with the image mark *prince* in UK 1476474, covering the majority of Prince products protected in the UK.”

27. Mr Vincent explains that “the other element” of his defence can be found in the 16<sup>th</sup> edition of *Kerly’s Law of Trade Marks* relating to “compound marks”; I shall return to this point later in this decision.

28. That concludes my summary of the evidence filed to the extent I consider it necessary.

## **DECISION**

29. The opposition is based upon sections 5(2)(b) and 5(3) of the Act which read 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.

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

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

30. In these proceedings the opponent is relying upon the two trade marks shown in paragraph 2, both of which qualify as earlier trade marks under the provisions of section 6 of the Act. Given the interplay between the date on which the opponent’s trade marks were entered in the register and the application date of the trade mark being opposed, the earlier trade marks are subject to the proof of use provisions contained in section 6A of the Act.

31. In its Notice of opposition, the opponent states that it has used its trade marks in relation to all the goods upon which it is relying and, in his counterstatement, the applicant asked the opponent to provide proof of use of trade mark no. (1) in relation to “tennis ball throwing machines” and of trade mark no. (2) in relation to: “badminton racquets and shuttlecocks; for racquets for sports other than tennis and squash” and for “tennis ball throwing machines.”

### **My approach to the request for proof of use**

32. The terms “tennis rackets and parts and fittings therefor; tennis balls; all included in Class 28” in trade mark no. (1) are not the subject of the applicant’s request for proof of use nor are the terms “balls...all for racquet sports”, “racquet strings”, “bags

adapted to carry gymnastic and sporting articles” and “parts and fittings for all the aforesaid goods; all included in class 28” in trade mark no. (2). As I mentioned earlier (paragraph 24 refers), in his witness statement Mr Vincent accepts that with the exception of “tennis ball throwing machines”, the opponent has, to the extent he sought proof, made genuine use of its trade mark no. (2) in relation to all the goods for which it stands registered.

33. In its written submission, the opponent states:

“8. For the reasons explained below, it is respectfully submitted that the Opponent has satisfactorily discharged its duty to prove genuine use of its Earlier Rights except for tennis ball throwing machines and its claim to use in respect of such items is withdrawn...” (original emphasis)

34. Given the interplay between the scope of the applicant’s original request for proof of use, his admission in his witness statement and the opponent’s withdrawal of its reliance on “tennis ball throwing machines”, it is not necessary for me to conduct a proof of use assessment. The opposition will now proceed with the opponent relying upon the following goods:

**Trade mark no. (1)** - Tennis rackets and parts and fittings therefor; tennis balls; all included in Class 28.

**Trade mark no. (2)** - Racquets for sports; balls and shuttlecocks, all for racquet sports; racquet strings, bags adapted to carry gymnastic and sporting articles; parts and fittings for all the aforesaid goods; all included in Class 28.

### **The objection based upon section 5(2)(b) of the Act**

#### **Case law**

35. The following principles are gleaned from the decisions of the courts of the European Union 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*

*Klijnsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.*

The principles:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 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

36. The goods to be compared are as follows:

Opponent's goods	Applicant's goods
<p><b>Trade mark no. (1)</b> - Tennis rackets and parts and fittings therefor; tennis balls; all included in Class 28.</p> <p><b>Trade mark no. (2)</b> - Racquets for sports; balls and shuttlecocks, all for racquet sports; racquet strings, bags adapted to carry gymnastic and sporting articles; parts and fittings for all the aforesaid goods; all included in Class 28.</p>	<p><b>Class 28</b> - Games, playing cards, toys, playthings, action figures, figurines, models and jig saw puzzles. Electronic games for personal use and arcades, pin ball games or machines, and video games apparatus. sporting articles for use in cricket, fencing, boxing, gymnastics, athletics, badminton, squash, golf, grass and ice hockey, polo, football, lacrosse, fives, table tennis, baseball, basketball, netball,</p>

	bowls, lawn tennis, croquet, clock golf, quoits and petanque; decorations for Christmas trees.
--	--

37. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

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

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



39. 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."

40. 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".

41. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the 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 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”.

The applicant’s goods are shown below in bold.

**Sporting articles for use in badminton, squash, table tennis, lawn tennis**

42. As the above goods encompass the opponent’s goods, the competing goods are to be regarded as identical on the principles outlined in *Meric*.

**Sporting articles for use in cricket, fencing, boxing, gymnastics, athletics, golf, grass and ice hockey, polo, football, lacrosse, fives, baseball, basketball, netball, bowls, croquet, clock golf, quoits and petanque**

43. In its written submissions, the opponent states:

“30. Further, the wider term...covered by the Application covers sporting articles, such as those covered by the Opponent’s Earlier Rights, only in relation to different sports. However, it is commonly understood that a provider of sports equipment is likely to provide equipment in relation to a number of different sports, rather than provide products for a single specialist sporting market. Therefore, insofar as the sporting articles relate to sports that are not directly covered by the Opponent’s Earlier Rights, they are complementary. Such goods relating to non-racquet sports are still likely to be purchased by similar consumers who are interested in sports, in sports retail outlets (whether online or bricks and mortar stores) and are therefore highly similar.”

44. The users of the opponent’s “Tennis rackets and parts and fittings therefor; tennis balls” and “Racquets for sports; balls and shuttlecocks, all for racquet sports; racquet strings; parts and fittings for all the aforesaid goods” and those listed above will be the same i.e. members of the general public with an interest in sports. While there may be some overlap in the nature of the goods, their intended purpose and method of use are likely to differ and there is, at least as far as I aware, no meaningful competitive relationship between them. While I accept that the goods

under consideration will be sold by, inter alia, retailers who conduct a trade in relation to a range of sporting goods (both on the high street and on-line), there is no evidence that the competing goods are sold in the same areas of such a store or website or in close proximity to one another.

45. The opponent further states that it is “commonly understood that a provider of sports equipment is likely to provide equipment in relation to a number of different sports, rather than provide products for a single specialist sporting market”. Beyond, broadly speaking, racket sports, it has, however, filed no evidence in support of this assertion. As in my view this is not a matter of which I am entitled to take judicial notice, absent evidence, I am not prepared to accept that the average consumer will be familiar with the state of the market to which the opponent refers.

46. Finally, the opponent states that “insofar as the sporting articles relate to sports that are not directly covered by the Opponent’s Earlier Rights, they are complementary.” To be complementary in the sense outlined in the case law, “there must be 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” i.e. it is a two part test. In my view, the opponent’s “Tennis rackets and parts and fittings therefor; tennis balls” and “Racquets for sports; balls and shuttlecocks, all for racquet sports; racquet strings; parts and fittings for all the aforesaid goods” are not “indispensable or important for the use of...” the applicant’s goods for use in the sports mentioned. Considered overall, there is, in my view, no meaningful degree of similarity between the opponent’s goods mentioned above and the applicant’s goods shown above in bold. However, even if I am wrong in that regard and the overlap in, inter alia, the users, nature and intended purpose (i.e. for use in sports which may involve hand-held equipment and balls) is sufficient to create any similarity, it would, in my view, be of a low degree.

47. That, however, is not the end of the matter, as the opponent’s trade mark no. (2) also contains the phrase “bags adapted to carry gymnastic and sporting articles; parts and fittings for all the aforesaid goods”, in relation to which the applicant did not request proof of use. As the opponent’s “bags...” is unlimited (for example, by

reference to a particular sport), it would include bags adapted to carry all of the sporting articles itemised in the applicant's specification above. In those circumstances, although the nature, intended purpose and method of use will differ, there is an overlap in the users and trade channels and there is also a complementary relationship in the sense outlined in the case law. Considered overall, the opponent's "bags adapted to carry gymnastic and sporting articles; parts and fittings for all the aforesaid goods" are similar to the applicant's sporting articles for use in the sports identified to at least a medium degree.

**Games, playing cards, toys, playthings, action figures, figurines, models and jig saw puzzles. Electronic games for personal use and arcades, pin ball games or machines, and video games apparatus**

48. In its written submissions, the opponent states:

"32. Further, it is common for goods such as *"games, playing cards, toys, playthings, action figures, figurines, models and jigsaw puzzles"* to feature or be based upon sporting figures, personalities or images. *"Electronic games for personal use and arcades, pin ball games or machines, and video games apparatus"* also commonly employ a sports theme or are based on sporting celebrities or sporting events. It is, therefore, likely that use of the mark BLACK PRINCE in respect of such class 28 goods might give rise to confusion, or at least a likelihood of association such that consumers may believe the products sold under the BLACK PRINCE mark to come from the same trade origin as the Opponent's goods, or that such goods are authorised or permitted by the Opponent."

49. Once again, while the users may be the same, for the majority of the goods mentioned above, the nature, intended purpose and method of use are likely to differ as are the trade channels and there is no competitive or complementary relationship between such goods. In my view, there is no meaningful degree of similarity between the opponent's goods and the applicant's goods with the exception of "toys" and "playthings" which may be in the form of, for example, racquets and balls. In relation to such goods the users may be the same as may the nature, intended purpose,

method of use and trade channels. Although there is unlikely to be any meaningful competitive or complementary relationship between such goods, the applicant's "toys" and "playthings" are, for the reasons explained, similar to the opponent's goods to at least a medium degree; I shall return to this point when I consider the likelihood of confusion.

50. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

51. Having found no meaningful degree of similarity between the opponent's goods and the goods shown below (including "decorations for Christmas trees" in relation to which the opponent made no submissions), the opposition against these goods fails and is dismissed accordingly:

Games, playing cards, action figures, figurines, models and jig saw puzzles.  
Electronic games for personal use and arcades, pin ball games or machines, and video games apparatus; decorations for Christmas trees

### **The average consumer and the nature of the purchasing act**

52. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods I have found to be identical or similar i.e.

Toys, playthings, sporting articles for use in cricket, fencing, boxing, gymnastics, athletics, badminton, squash, golf, grass and ice hockey, polo,

football, lacrosse, fives, table tennis, baseball, basketball, netball, bowls, lawn tennis, croquet, clock golf, quoits and petanque.

53. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. 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.”

54. In its written submissions, the opponent states:

“36. The average consumer of all of the goods at issue in class 28 is an ordinary adult or child member of the general public. The goods will be sold either in specialist sports or activity retailers or generalist shops or online (in particular through general retailers such as Amazon.com) and where the mode of selection will primarily be visual. The purchasing process is therefore largely a visual one with a representation of a product and the brand name and a written description of the product and brand. Nevertheless, the selection process is bound to also involve word-of-mouth recommendations and verbal enquiries.

37. The degree of care and attention paid in the selection process will vary slightly but will generally be made by an inattentive purchase making a quick decision at a shop or in an online retail environment. Some expensive sporting products such as tennis racquets for more advanced players might require relatively careful selection, but goods in this category as a whole are

more likely to be impulse purchases or gifts for others (particularly children) and therefore increase the scope for imperfect recollection. Generally speaking, given the cost and frequency of purchase, it is submitted that the degree of care and attention overall for the goods at issue to be average, neither higher nor lower than the norm.”

55. In his written submissions, Mr Vincent states:

“5...but as [the opponent’s customers] are likely to be amongst the best educated of the population...”

56. The average consumer of the goods at issue is a member of the general public. I agree with the opponent that while the goods at issue will be selected by predominantly visual means, aural considerations of the type mentioned must not be ignored. As to the degree of care the average consumer will deploy when selecting the goods at issue, as the opponent’s evidence shows, the cost of its goods can vary considerably. While the average consumer may only pay an “average” degree of attention to, for example, a racket for play or recreational use, the degree of attention will, as the opponent accepts, rise markedly when selecting the same product for competitive use. I shall return to this point when I consider the likelihood of confusion later in this decision.


### **Comparison of trade marks**

57. 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by

means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

58. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

Opponent’s trade marks	Applicant’s trade mark
(1) PRINCE  (2)  	Black Prince

**Overall impression**

59. The opponent’s trade marks consist of the well-known word “PRINCE”/“*prince*” presented in block capital letters and in bold in lower case letters in a slightly stylised but unremarkable font. Although the presentation of trade mark no. (2) will make a small contribution to both the overall impression it conveys and its distinctiveness, the overall impression conveyed by both trade marks will be dominated by the words “PRINCE”/“*prince*”.

60. The applicant’s trade mark consists of the well-known words “Black” and “Prince” presented in title case. In my view, the words form a unit, in which the word “Black” qualifies the word “Prince”. It is in that unit the overall impression and distinctiveness lies.



61. I shall conduct the visual, aural and conceptual comparison with those conclusions in mind.

### **Visual similarity**

62. The opponent's trade marks consist of a single word consisting of six letters presented in block capital letters and in bold stylised lower case letters respectively. The second word in the applicant's trade mark is the same as the opponent's trade marks, albeit presented in title case. The first word in the applicant's trade mark is alien to the opponent's trade marks. Weighing the similarities and differences, including the stylisation present in the opponent's trade mark no. (2), results in what I regard as a medium degree of visual similarity between the applicant's trade mark and both of the opponent's trade marks.

### **Aural similarity**

63. As I mentioned earlier, the words the subject of the trade marks at issue will be well known to the average consumer. As a consequence, the manner in which they will be articulated is predictable, i.e. the opponent's trade marks as a one syllable word and the applicant's trade mark as two one syllable words. The fact that the opponent's trade marks and the second word in the applicant's trade mark will be pronounced in an identical fashion results in a medium degree of aural similarity between them.

### **Conceptual similarity**

64. While I am aware that "PRINCE" is a surname, collinsenglishdictionary.com defines "prince" as "a male member of a royal family, especially the son of the king or queen of a country"; I am satisfied that it is the definition the vast majority of average consumers will attribute to the word. In his witness statement, Mr Vincent states:

"5 Edward, the Black Prince (1330-1376), Prince of Wales and heir to the throne of England, was one of my childhood heroes, as he has ever been for

generations of British children. Thus he is a major icon in British historical culture...”

65. As the status of Edward, the Black Prince in the UK consumer’s consciousness is not a matter I am entitled to accept on judicial notice, absent evidence, I am not in a position to judge whether the average consumer would be familiar with the historical figure to which Mr Vincent refers. While some may, in my view, there are likely to be many average consumers who will not. For those in both groups, the opponent’s trade marks will evoke the concept of a male member of a royal family, whereas for those in the latter group, the applicant’s trade mark will evoke the concept of a non-specific male member of a royal family who is associated with the colour black, for example, because of the colour of his skin or clothing. The fact that for many average consumers both parties’ trade marks will evoke the concept of a male member of a royal family, results in a fairly high degree of conceptual similarity between them.

#### **Distinctive character of the earlier trade mark**

66. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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 determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

67. In its written submissions, the opponent states that its earlier trade marks are:

“59...inherently distinctive and have acquired enhanced distinctiveness through use...”

## **Inherent distinctive character**

68. Although both of the opponent's trade marks consist of, inter alia, a well-known English language word, as far as I am aware, that word is neither descriptive of nor non-distinctive for the goods upon which the opponent relies. As the degree of stylisation adds little to trade mark no. (2), considered absent use, the earlier trade marks are, in my view, inherently distinctive to a medium degree. That is not an end to the matter, as I also have to consider the opponent's claim to acquired distinctiveness.

## **Acquired distinctiveness**

69. This can, of course, only be considered in relation to the goods in class 28 upon which the opponent relies in these proceedings. This is important, because the evidence shows that the opponent has used its trade marks for a range of other goods, for example, clothing and footwear. The opponent's sales data is also problematic. I say this because although Mr Herring provides sales figures, these figures either relate to the EMEA as a whole (exhibit 9 from 2015) or are in relation to sales to Sports Direct (exhibits 8 and 10) in relation to which no indication (or even estimates) have been provided as to what percentage of the sales figures relate to the goods relied upon in these proceedings.

70. However, other than challenging the opponent's evidence to the extent mentioned earlier, there is nothing to suggest that the applicant takes any issue with the opponent's evidence. In fact, in his statement, Mr Vincent states:

“32. On a positive note, I have learnt that the opponent has a very admirable brand. I appreciate it very much from both an aesthetic and practical point of view, as it appears across a range of products, and is easily identifiable.”

71. Although that comment was more likely directed at the opponent's trade mark no. (2), it is clear from the evidence that prior to the date of filing of the application, the opponent had used its earlier trade marks in relation to the goods it now relies upon. Although the evidence also relates to, inter alia, squash and badminton rackets and

associated goods in class 28, I think it is fair to say that the evidence is dominated by the opponent's trade in relation to a range of tennis rackets, tennis balls and accessories for tennis such as string for rackets and bags adapted to carry such goods. In those circumstances, it is, in my view, a reasonable inference that a not insignificant percentage of the sales to Sports Direct in 2014, 2015, 2016 and 2018 would have been in relation to such goods. The evidence further attests to the number of professional tennis players (many of whom I am prepared to accept are household names) who use or have used the opponent's rackets and the number of Grand Slam tournaments that have been won using the opponent's rackets. The opponent's social media activity will, I have no doubt, also have assisted in this regard. However, without even an estimate of what percentage of the sales to the EMEA in 2015 related to the UK, I am not in a position to make an inference in relation to such sales.

72. Although the opponent's evidence has obvious shortcomings, when considered as a whole, I think it would be unrealistic for me not to conclude that by the material date in these proceedings (i.e. 8 March 2019), the use the opponent had made of its earlier trade marks in the UK in relation to the goods upon which it relies will, on the balance of probabilities, have built upon the medium degree of inherent distinctiveness its trade marks enjoy. In relation to its trade in tennis rackets and related goods for tennis proper to class 28, its earlier trade marks are likely to have acquired a high degree of distinctive character.

### **Likelihood of confusion**

73. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade marks as the more distinctive they are, the greater the likelihood of confusion. 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 and must instead rely upon the imperfect picture of them he has retained in his mind.

74. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

75. Having concluded that it was not necessary for me to conduct a proof of use assessment, I further concluded that:

- “sporting articles for use in badminton, squash, table tennis, lawn tennis” are identical to the opponent’s goods, whereas “sporting articles for use in cricket, fencing, boxing, gymnastics, athletics, golf, grass and ice hockey, polo, football, lacrosse, fives, baseball, basketball, netball, bowls, croquet, clock golf, quoits and petanque” and “toys” and “playthings” are similar to the opponent’s goods to at least a medium degree;
- the average consumer of such goods is a member of the general public who, while not ignoring aural considerations, will select the goods at issue by predominantly visual means whilst deploying a varying degree of attention during that process;
- the competing trade marks are visually and aurally similar to a medium degree and conceptually similar to a fairly high degree;
- the earlier trade marks relied upon are inherently distinctive to a medium degree and, as a consequence of the use made of them in relation to tennis rackets and related goods for tennis proper to class 28, the earlier trade marks are likely to have acquired a high degree of distinctive character.

76. In reaching the conclusions which follow, I have taken into account the comments in *Kerly’s* in relation to compound marks (paragraph 27 above refers). I begin by reminding myself that where not identical, the competing goods are similar

to at least a medium degree. In reaching a conclusion, I shall proceed on the basis most favourable to the applicant i.e. that the average consumer will pay a high degree of attention during the selection process (thus making him or her less prone to the effects of imperfect recollection). Having concluded that the two words in the applicant's trade mark create a unit (a point to which I shall return shortly), appearing as it does as the first word in the applicant's trade mark, the word "Black" is unlikely to go unnoticed by the average consumer. As a consequence, there is unlikely to be direct confusion.

77. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

79. I begin by reminding myself that in relation to tennis rackets and related goods for tennis proper to class 28, the opponent's trade marks are possessed of a high

degree of acquired distinctiveness. I shall first consider the matter in relation to those goods in the application which I have found to be identical and also in relation to “toys” and “playthings” (which may be in the form of rackets and balls) and are similar to at least a medium degree. The competing trade marks are visually and aurally similar to a medium degree and conceptually similar to a fairly high degree, the latter resulting from the fact that the word “Black” in the applicant’s trade mark merely qualifies the word “Prince”, with the word “Prince” evoking a concrete concept which, in my view, will fix itself in the average consumer’s mind and act as a “hook” to aid their recall. As that combination of factors is, in my view, likely to lead even a consumer paying a high degree of attention to conclude that the applicant’s goods originate from the opponent or an undertaking linked to the opponent, it will lead to a likelihood of indirect confusion. Although the opponent’s trade marks only enjoy a medium degree of inherent distinctiveness in relation to “bags adapted to carry gymnastic and sporting articles; parts and fittings for all the aforesaid goods” which are not for use in, broadly speaking, racket sports, the at least medium degree of similarity in the goods combined with the degree of visual, aural and conceptual similarity mentioned above leads to the same conclusion in relation to the remaining sporting articles in the application.

### **Interim conclusion under section 5(2)(b) of the Act**

80. As matters stand, the application will be refused in relation to:

Toys, playthings, sporting articles for use in cricket, fencing, boxing, gymnastics, athletics, badminton, squash, golf, grass and ice hockey, polo, football, lacrosse, fives, table tennis, baseball, basketball, netball, bowls, lawn tennis, croquet, clock golf, quoits and petanque

### **The applicant’s fall-back specification**

81. In his written submissions, the applicant stated:

“2. However, I am hereby submitting a fall-back specification omitting one or more, but not necessarily all, of the following words: “badminton”, “squash”, and “lawn tennis” from Class 28 of the Application...”

82. Having reached the conclusions I have, the above does not assist the applicant. However, the terms “toys” and “playthings” are broad and would include a wide range of goods, for example, building blocks and train sets, that are unlikely to be regarded as similar to the opponent’s goods. The applicant may, therefore, be able to retain a range of goods which would fall within the terms “toys” and “playthings” if he were to itemise the toys and playthings in which he is interested.

### **An opportunity for the applicant to file a revised specification**

83. The applicant is allowed 14 days from the date of this decision to consider providing the Tribunal with a revised specification on the basis indicated above. If he wishes to do so, he should copy any revised specification to the opponent. The opponent will then be allowed a period of 14 days from the date that it receives a copy of any revised specification from the applicant to provide comments. At the conclusion of that period, I will review the proceedings and issue a supplementary decision, in which I will also deal with costs and in which a period will be set for appeal.

### **What happens if the applicant elects not to file a revised specification?**

84. If the applicant does not wish to file an amended specification he should, within the period allowed, write to the Tribunal (copied to the opponent) providing an indication to that effect. On receipt of such an indication, I will issue a supplementary decision in which I will refuse the application in relation to the goods mentioned in paragraph 80 and in which I will deal with costs and appeal.

### **The objection based upon section 5(3) of the Act**

85. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-*



*Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

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

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

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

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

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

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

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

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

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

“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.”

87. In Case C-408/01, *Adidas-Salomon*, the CJEU held:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

88. As the opponent has already succeeded under section 5(2)(b) of the Act in relation to the goods in paragraph 80 of this decision, it is only strictly necessary for me to consider this ground of opposition in relation to the following goods in the application:

Games, playing cards, action figures, figurines, models and jig saw puzzles.  
Electronic games for personal use and arcades, pin ball games or machines,  
and video games apparatus; decorations for Christmas trees

89. However, in the event my conclusion under section 5(2)(b) of the Act is considered to be wrong, I shall also consider this ground of opposition insofar as it relates to those goods.

90. Notwithstanding my various criticisms of the opponent's evidence, I am satisfied that by the material date in these proceedings, the opponent's trade marks had the necessary qualifying reputation in relation to, at least, the trade the opponent had conducted in relation to tennis rackets and related goods for tennis proper to class 28. Having reached that conclusion, I must now go on to consider whether having taken account of all relevant factors, the public will make the required mental 'link' between the competing trade marks. The factors identified in *Intel* in this regard are:

#### **The degree of similarity between the conflicting trade marks**

91. In paragraphs 62, 63 and 65, I concluded the competing trade marks are visually and aurally similar to a medium degree and conceptually similar to a fairly high degree.

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

92. As I mentioned earlier, the average consumer of the goods at issue is a member of the general public. Insofar as the goods at paragraph 80 are concerned, where not identical I found them to be similar to at least a medium degree. I found no meaningful degree of similarity between the opponent's goods and those of the applicant shown in paragraph 88 above.

### **The strength of the earlier trade mark's reputation**

93. Insofar as its tennis rackets and tennis related goods in class 28 are concerned, the opponent has a strong reputation.

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

94. The opponent's trade marks possess a medium degree of inherent distinctiveness and, when considered in relation to the opponent's tennis rackets and tennis related goods proper to class 28, enjoy a high degree of acquired distinctive character.

### **Whether there is a likelihood of confusion**

95. Under section 5(2)(b) of the Act, I concluded there is a likelihood of indirect confusion in relation to the goods in paragraph 80 and no likelihood of confusion in relation to the goods in paragraph 88.

### **Will a link be established?**

96. In reaching a conclusion on whether the public will make a link, I remind myself of the identity/at least medium degree of similarity between the opponent's goods and the applicant's goods in paragraph 80, the degree of visual, aural and conceptual similarity between the competing trade marks and the strength of the opponent's reputation in relation to its tennis rackets and tennis related goods proper to class 28.

97. I shall first consider the matter in relation to the applicant's "toys" and "playthings" (which may be in the form of, for example, racquets and balls) and "sporting articles for use in cricket, fencing, boxing, gymnastics, athletics, badminton, squash, golf, grass and ice hockey, polo, football, lacrosse, fives, table tennis, baseball, basketball, netball, bowls, lawn tennis, croquet, clock golf, quoits and petanque." Insofar as "sporting articles for use in badminton, squash, table tennis, lawn tennis"

and “toys” and “playthings” (of the type mentioned above) are concerned, the opponent’s rackets sold under its trade marks have been used by a wide range of, inter alia, professional tennis players (a number of which are household names) and have been used to secure a significant number of Grand Slam wins. In those circumstances, I am satisfied that the public will make the necessary link and, having done so, it is likely to result in the transfer of the image associated with the opponent’s trade mark (i.e. of professional approval and success) to the applicant’s trade mark. Such a connection is, in my view, likely to make it easier for the applicant to market identical and similar goods under his trade mark and is, in the absence of a claim by the applicant to “due cause”, likely to result in the applicant’s trade mark gaining an unfair advantage of the type envisaged by the opponent (paragraph 4 refers). As it is only necessary for the opponent to succeed under one of the heads of damage, it is not necessary for me to deal with the alternative claims based upon detriment to reputation/distinctive character and I decline to do so.

98. Although the opponent has the necessary qualifying reputation in relation to “tennis rackets and related goods for tennis proper to class 28” (including, broadly speaking, bags adapted to carry rackets), there is no evidence that the public are aware that undertakings such as the opponent conduct a trade in a disparate range of sporting goods. Consequently, notwithstanding the degree of similarity in the competing trade marks and the strength of the opponent’s reputation, I see no reason why in relation to sporting articles other than for badminton, squash, table tennis and lawn tennis, the opponent’s trade marks would be called to mind, without which, for the reasons explained above, the opposition fails.

99. Finally, the lack of proximity between the opponent’s goods and the applicant’s: “Games, playing cards, action figures, figurines, models and jig saw puzzles. Electronic games for personal use and arcades, pin ball games or machines, and video games apparatus; decorations for Christmas trees” is, in my view, more than sufficient for me to conclude that the opponent’s trade marks are most unlikely to be called to mind. Without a link there can be none of the adverse consequences contemplated by this section of the Act and the opposition to the above goods fails accordingly.

## **Conclusion under section 5(3) of the Act**

### **Interim conclusion**

#### **100. The opposition has succeeded in relation to:**

Toys, playthings, sporting articles for use in badminton, squash, table tennis, lawn tennis

#### **101. And failed in relation to:**

Games, playing cards, action figures, figurines, models and jig saw puzzles. Electronic games for personal use and arcades, pin ball games or machines, and video games apparatus; Sporting articles for use in cricket, fencing, boxing, gymnastics, athletics, golf, grass and ice hockey, polo, football, lacrosse, fives, baseball, basketball, netball, bowls, croquet, clock golf, quoits and petanque; decorations for Christmas trees

102. As mentioned above in relation to the opposition based upon section 5(2)(b) of the Act, the applicant may be able to retain a range of goods which would fall within the terms “toys” and “playthings” if he were to itemise the “toys” and “playthings” in which he is interested.

### **Next steps**

103. Classes 9, 16 and 41 are not opposed and may, in due course, proceed to registration. **The applicant now has 14 days from the date of this decision to consider availing himself of the opportunity indicated in paragraph 83; failure to do so will result in the consequences outlined in paragraphs 84 and 100.**

**Dated this 22nd day of February 2021**

**C J BOWEN  
For the Registrar**