

O/133/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003463109

BY OPTIMUM BLUE LTD TO REGISTER THE FOLLOWING TRADE MARK  
(SERIES OF TWO):



IN CLASSES 21, 25 AND 28

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 420090 BY W.C. BRADLEY/ZEBCO HOLDINGS, INC.

## **Background and Pleadings**

1. On 31 January 2020, Optimum Blue Ltd ('the Applicant') filed an application to register the series of two trade marks shown on the cover page of this Decision, number UK00003463109. The application was published for opposition purposes in the *Trade Marks Journal* on 7 February 2020. Registration is sought in respect of the goods in classes 25 and 28.<sup>1</sup>
2. On 27 April 2020, the application was opposed by **W.C. Bradley/Zebco Holdings, Inc. ('the Opponent')** based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against the following of the Applicant's goods in class 28:

### **Class 28**

*Artificial baits for fishing; artificial chum for fishing; artificial fish bait; artificial fishing bait; artificial fishing worms; artificial flies for use in angling; bags adapted for fishing; bags for fishing; bait (artificial); bait (artificial fishing); bait bags for holding live bait; bait throwers; catapult bait pouches; decoys for hunting or fishing; electronic bite indicators for use in angling; Fish hook removers being fishing tackle; Fish hooks; Fish lures; Fishing bait [synthetic]; Fishing creels; Fishing equipment; Fishing floats; Fishing fly boxes; Fishing gaffs; Fishing ground baits; Fishing harnesses; Fishing hooks; Fishing leaders; Fishing line casts; Fishing lines; Fishing lure boxes; Fishing lures; Fishing plugs; Fishing plumbs; Fishing poles; Fishing reel cases; Fishing reels; Fishing rod cases; Fishing rod handles; Fishing rod holders; Fishing rod rests; Fishing rod supports; Fishing rods; Fishing sinkers; Fishing spinners; Fishing swivels; Fishing tackle; Fishing tackle bags; Fishing tackle boxes; Fishing tackle floats; Fishing tackle terminal; Fishing tackle terminal tackle; Fishing tippetts; Fishing weights; ground bait (artificial); gut for fishing; hooks (fish); hooks for fishing; inflatable fish float tubes; line casts for fly fishing; lines for fishing; lures (artificial) for fishing; lures for fishing; nets for use by anglers;*

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<sup>1</sup> The specifications are lengthy; and are, therefore, not reproduced in this Decision. Please refer to the Register: <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00003463109> for the full specifications.

*nets (landing) for anglers; paternosters (fishing tackle); rods for fishing; tackle (fishing).*

3. The Opponent relies on the following earlier trade mark registration for its section 5(2)(b) ground:

UK00001347868

QUANTUM

Filing date: 10 June 1988; Date registration completed: 27 March 1990

Relying on its registered goods in class 28:

*Fishing tackle and fittings therefor, all included in Class 28.*

4. The Opponent claims that the marks are similar and that the goods in class 28 at which the opposition is directed are identical and similar to the Opponent's goods, leading to a likelihood of confusion under section 5(2)(b) of the Act.
5. The Applicant filed a Defence and Counterstatement, denying the grounds and requesting that the Opponent proves evidence of genuine use of its mark in relation to the goods in respect of which it is registered.
6. The Opponent has filed evidence comprising a Witness Statement and Exhibits.
7. Written submissions have been filed by the Opponent only.
8. The Opponent is represented by Withers & Rogers LLP; the Applicant represents itself.
9. The following decision has been made after careful consideration of the papers before me.

**Relevant dates**

10. The Opponent's earlier mark had been registered for more than five years on the date on which the contested application was filed. It is, therefore, subject to the proof of use provisions under section 6A of the Act, and the Applicant has requested such proof. The Opponent has made a statement that it has made genuine use of all of the goods for which its mark is registered. The relevant time period for this purpose is the five years prior to and ending on the application date of the applied-for mark: 1 February 2015 to 31 January 2020.

### **Opponent's evidence**

11. The Opponent's evidence comes from Mr Jürgen Masuch, Senior Product and Sourcing Manager of the Opponent's Zebco Group. His Witness Statement is dated 25 September 2020.

12. Mr Masuch's evidence comprises a variety of material: UK revenue figures; prints from the Wayback Machine ('Wayback prints') of pages from the Opponent's website; a selection of invoices; excerpts from the Opponent's UK dealer catalogues; excerpts from the Quantum Fishing catalogue; print-outs, including Wayback prints, from websites of third party retailers of the Opponent's goods; reviews of the Opponent's products in angling magazines; and print-outs from the Opponent's social media accounts.

### UK Revenue figures

13. Mr Masuch states the following at paragraph [10] of his Witness Statement:

#### **UK Revenue**

10. My Company Group's sales of QUANTUM branded fishing tackle products has given rise to substantial revenue. The table below provides annual UK revenue figures, in Euro, in relation to QUANTUM branded fishing products for the years 2016 – 2020. For reasons of commercial sensitivity, the figures have been approximated. The actual figures are higher than those shown below.

2016*	2017	2018	2019	2020**	<b>Total</b>
60,000	76,000	66,000	79,000	51,000	<b>334,000</b>
<i>*figures for March – December, following implementation of new financial software in early 2016</i>					
<i>** figures for January – July, full year 2020 forecast approx. €95,000</i>					

14. As noted above, at paragraph [10], the relevant period to which proof of genuine use applies is the 5-year period 1 February 2015 – 31 January 2020. These figures do not cover the whole of the relevant period. I note that the figures for 2015 have not been provided. For 2020, neither the figures for January – July, nor for the full year forecast, can be taken into account because only the figures relating to the period 1-31 January 2020 would be relevant.

Exhibit JM1

15. This Exhibit comprises 12 prints of pages from the Opponent's websites, some of which are Wayback prints.

**W. C. Bradley Co web pages, dated 11 August 2020:**

16. Pages 1-2 are taken from the Opponent's website for W. C. Bradley Co. and are dated 11 August 2020. This date falls outside of the relevant period.

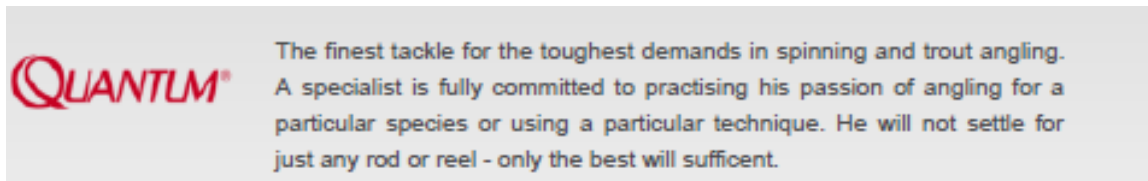
**'Zebco Europe' Wayback prints, dated 17 February 2016:**

17. Pages 3-5 are Wayback prints from the Opponent's website for Zebco Europe, dated 17 February 2016. 'Quantum' is included, alongside other brands, as one of 'seven global brands'. The information on the first of these pages, concerning the volume and frequency of parcel deliveries to dealers in Europe does not show the proportion of deliveries relating to the UK market.

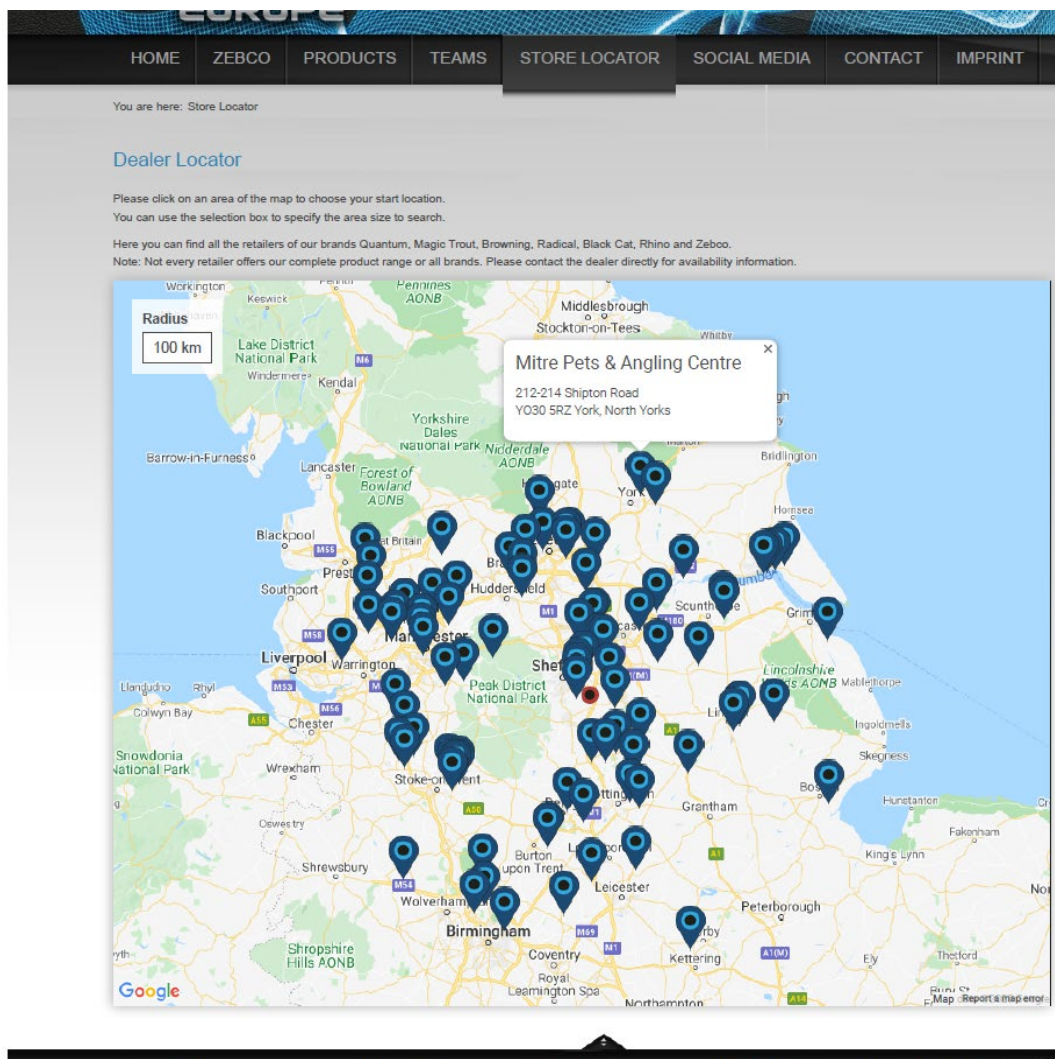
18. The information on the second and third of these 'Zebco Europe' pages on the history of the company as a purveyor of fishing equipment is irrelevant to the matter of genuine use of the mark in the relevant period. However, the 'QUANTUM' mark is listed, alongside a number of other marks relating to other brands under 'Zebco Brands', at the bottom of the page.

**'Zebco Europe' Wayback prints, dated 11 December 2018:**

19. These two pages provide information on the brands sold by Zebco Europe. There is a list of eight brands, including 'Quantum', with accompanying text. Information on 'Quantum' is set out as follows:



20. The second page is headed 'Dealer Locator' and displays a map of part of the UK on which the locations of retailers of Zebco Brands, including 'Quantum', are marked:



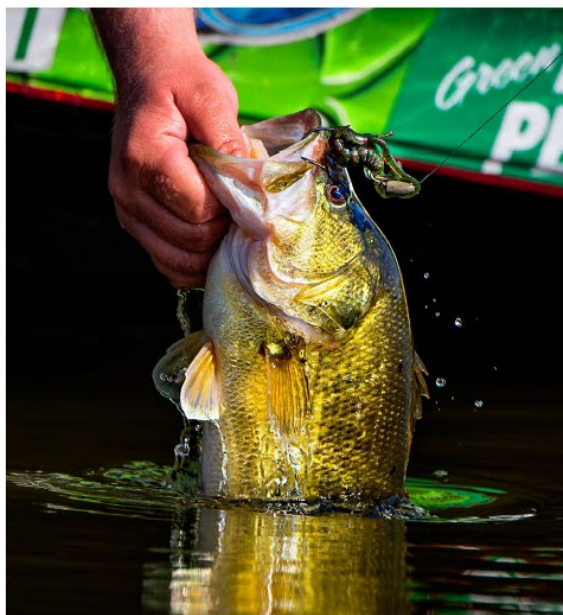
21. The 'Quantum' mark is also featured in the 'footer' of the web page, along with other brands. Various tabs or menus are visible at the top of these 'Zebco

Europe' pages, including one for 'Products'; though the Opponent has not supplied any prints of pages detailing products.

**'Quantumfishing.com' Wayback prints, dated 15 May 2017:**

22. These two pages feature a photograph of a fish attached to a hook and line accompanied by laudatory text about Quantum products in general, in which a fishing professional is mentioned:

**The never-ending quest for fishing excellence.**



Since 1984, Quantum's mission has been quite simple: to give serious anglers the gear they need to outfish their competition – whether it's for big paychecks on the bass tour, or big fish photos on the local tackle shop wall.

Combining the latest, high-performance materials with angling and engineering know-how, we've always strived to make the most reliable fishing gear for your money.

It's why Kevin VanDam, pro bass fishing's all-time top money winner, has fished Quantum his whole career. It's why our innovative products consistently win industry honors and high praise from outdoor writers. And it's why hard-core weekend anglers and saltwater guides across the country trust our rods and reels to put more (and bigger) fish in the boat year after year.

23. The footer of the web page features the 'Quantum' mark. None of the prints provided give details of specific products under the Quantum mark.

**'Quantum Fishing EU' website pages, dated 11 August 2020:**

24. These are the final three pages of the Exhibit. The heading on the page is partly in German: 'Herzlich Willkommen – Quantum Fishing EU'. The following products with accompanying text are shown:



## By anglers, for anglers!

The finest accessories for the highest demands of spinning and trout anglers. A specialist doesn't fish just any rod or reel - he wants the best tackle!

25. The 'Quantum' mark is just about visible on the fishing reel shown in the first photograph; the mark cannot be seen on the fishing rods in the second picture; the mark is clearly visible on the long-sleeved 'top' in the far-right photograph. There are no product details to accompany the photographs, nor any information on how to purchase them.
26. The bottom of the page features what might be described as a 'show-reel' of fishing products. The presence of the arrows at either side of the two products, i.e. fishing reels, visible indicates that this is an interactive feature of the webpage according to which the purchaser, or potential purchaser, scrolls across to view the various products. The nature of the print-out is such that only a 'snap-shot' of this can be seen. From what can be seen on the print-out, there are no product details or prices to accompany the photographs of the products. It may well be that one needs to 'click' on, or 'hover the mouse over', each product in order to view the details; however, such details cannot be discerned from the pages of the exhibit.
27. The second of the 'Quantum Fishing EU' pages is headed 'Quantum Quality' and features what appear to be links to 4 videos referred to as 'the latest Quantum sessions'. On the final page, the 'Quantum' mark features prominently. Beneath the mark are a number of links, the majority of which are in German:





ÜBER UNS	SERVICE	INFORMATION	NEWS
Feinstes Zubehör für höchste Ansprüche von Spinn- und Forellenanglern. Ein Spezialist verschreibt sich bei der Ausübung der Leidenschaft "Angeln" mit Haut und Haaren einer Fischart oder Technik. Er will nicht irgendeine Rute oder Rolle - das Beste ist ihm gerade gut genug.	FAQ SERVICE CENTER PT-PERFORMANCE TUNED HÄNDLERSUCHE KALENDER	ÜBER UNS KONTAKT IMPRESSUM DATENSCHUTZ COMPETITIONS/PRICE-CONTESTS	06. August 2020 Catch Me Softly  July 29, 2020 Active In Summer  June 30th, 2020 Zander - Towed Away At Night!  June 12, 2020 King Of The Street
MEHR ÜBER QUANTUM >			

Exhibit JM2 (redacted)

28. According to Mr Masuch's Witness Statement, this Exhibit 'contains a small selection of invoices relating to sales of Quantum products to UK retailers ... by way of example'. Mr Masuch states that these examples 'demonstrate that significant sales of QUANTUM fishing tackle products have been made in the UK'. There are 40 invoices in total; with dates ranging from 8 March 2016 to 16 January 2020. The invoices in this selection relate to orders placed by 23 UK retailers. The orders comprise several Zebco brands, including QUANTUM (except in the case of one invoice where only QUANTUM products have been ordered).

29. The QUANTUM products are indicated by the letters 'QUA' in the column headed 'Brand', as shown in the following extract from an invoice dated 29 March 2016:

Art.Nr.	Description	Brand	Quant.	B/order	Price	Disc. %	Amount £	VAT %
Delivery Number: 80002623    Delivery Date:29.03.2016								
Requested Delivery Date: 21.03.2016								
Delivery address :112169, Barnsley Angling*, Tony Peel, 48 Sheffield Road, Hoyland Com, Barnsley, S74 0DQ								
<b>P.O. Number: 02-203-100041</b>								
22-0308050	Browning Black Viper MK FD 850	BRO	1	0	76.00			20.00
22-1498005	60cm Browning Sphere Feeder Quiver Tip C	BRO	0	2	10.95			0.00
22-1498361	3,60m 12' Browning Sphere Feeder M 80g	BRO	0	1	184.00			0.00
22-1498391	3,90m 13' Browning Sphere Feeder MH 100g	BRO	1	0	206.00			20.00
22-1935210	2,10m Quantum Perch 3g 18g	QUA	2	0	27.00			20.00
22-1935240	2,40m Quantum Perch 3g 18g	QUA	1	0	28.00			20.00
22-1935270	2,70m Quantum Perch 3g 18g	QUA	2	0	30.00			20.00
22-1936240	2,40m Quantum Zander 20g 50g	QUA	1	0	34.00			20.00
22-1936270	2,70m Quantum Zander 20g 50g	QUA	1	0	37.00			20.00
22-1936300	3,00m Quantum Zander 20g 50g	QUA	1	0	40.00			20.00

30. Some data have been redacted: the figures from the columns headed 'Disc %', which I presume to relate to discounts on the prices shown, and 'Amount', which I presume to be the amounts payable. The final amounts shown on the invoices relate to goods from several brands, including QUANTUM. In view of the redactions made, the proportion of the 'final amount' referable to QUANTUM products cannot be discerned.

31. However, this selection of invoices shows that sales to UK retailers are fairly frequent and regular. All of the QUANTUM goods are equipment relating to fishing. The price range (i.e. prices for retailers as opposed to the general public) of products sold under the QUANTUM brand varies greatly in view of the range of fishing equipment sold: fishing hooks and lures/artificial bait start at pence or just a few pounds per item<sup>2</sup>; whereas the price of fishing reels, of various models and types, ranges from several tens of pounds to well over £100<sup>3</sup>.

32. The amounts payable in respect of QUANTUM products therefore vary from one invoice to the next. Several orders include fairly large sums relating to QUANTUM goods, for example:

<sup>2</sup> Exhibit JM2, at page [41]: Invoice no. 04007824, dated 5 September 2018, item: 5g Quantum Cast Jig 50 Degree 5-9 cm; at page [28]: Invoice no. 94003224, dated 18 May 2017, item: 8g 7cm firetiger Quantum Spinner Bait.

<sup>3</sup> Exhibit JM2, at page [65]: invoice no. 94011272, dated 1 August 2019, item: Quantum Iron PT IR25PTS; at page [27]: invoice no. 94003145, dated 11 May 2017, item: Quantum Cabo PT CSP40PTS.E.

- Invoice number 94000403 to West Cornwall Angling, dated 9 September 2016 – approximately £1640;
- Invoice number 94003145 to Anglesey Bait Centre, dated 11 May 2017 – approximately £3,900;
- Invoice number 94012302 to Anglesey Bait Centre, dated 22 November 2019 – approximately £3,400.

33. Some invoices include smaller sums relating to QUANTUM products, for example: Invoice number 90011515 to Rogers Tackle Shop, dated 30 May 2016 – approximately £160.

34. QUANTUM goods are listed on invoices at least as frequently as other Zebco brands; in some cases, more frequently. Some invoices relate exclusively to QUANTUM products. .

Exhibit JM3

35. Mr Masuch states the following at paragraph [12] of his Witness Statement:

[2. My Company issues and distributes annual catalogues to its dealers, featuring QUANTUM branded fishing products. **Exhibit JM3** hereto contains excerpts from My Company's UK dealer catalogues for the years 2015 – 2020, from which it can be seen that the trade mark QUANTUM has been used both on and in relation to a variety of fishing tackle products and fittings therefor. In particular, the QUANTUM trade mark has been used in relation to fishing reels, rods, lines, lures, hooks, floats, bait, nets, bags and clothing, among other things.

36. This Exhibit comprises prints of pages from 'Zebco Europe' dealer catalogues for the years 2015, 2016, 2017, 2018 and 2019. The catalogues have the same format and share the following features:

- At the foot of the cover page are displayed various brands, including QUANTUM;
- The 'Contents' page indicates that the catalogue is divided into sections according to brand. Brand marks are displayed adjacent to page references.

The location of the QUANTUM sections is indicated as follows, this example being from the 2015 catalogue:

QUANTUM

Specialist  
Q3-Q111

Sea  
Q112-Q137

Radical  
Q138-190

QUANTUM  
SPECIALIST

QUANTUM  
Sea

QUANTUM  
RADICAL

QUANTUM®

- Although the UK is not explicitly mentioned in the catalogues, the prices of goods are expressed in '£';
- The QUANTUM mark is displayed in the top right-hand corner of each double-page spread on which QUANTUM branded products are featured, the following example being from the 2016 catalogue:



QUANTUM®

- All of the Quantum products featured are fishing equipment including: reels, rods, fishing line, lures, bait, fishing hooks, receptacles for fishing equipment, leaders, spinners (lures with metal blades), fishing hooks, nets, miscellaneous fishing tackle, bags and boxes for fishing equipment;
- Contact details for UK sales representatives are provided on the final page of the catalogue.

37. I note that page 18 of the Exhibit (page Q62 of the 2015 catalogue) features fishing lure sets clearly marked with the words 'NOT AVAILABLE IN THE UK'. The inclusion of such information indicates that the retailers to which this catalogue is aimed include UK dealers; the fact that the catalogue has indicated that these particular goods are not available in the UK implies that other goods in the catalogue *are* so available.

38. The QUANTUM mark can be seen clearly on many of the goods themselves. In the following example, from the 2015 catalogue, the mark is shown on a reel of fishing line:



14

39. In many cases where the QUANTUM mark cannot be seen on the product itself, an accompanying description makes it clear that the item is from the QUANTUM brand; the following example being from the 2018 catalogue:



**MINNOW GIPSY DD SU**

New Minnow Wobbler from Quantum. The Minnow Gipsy is available in three sizes, each with three different depths, covering a huge range of modern angling techniques. From fishing on very light tackle in streams for orfe to deep trolling for zander, this series covers it all. Eight attractive designs ensure optimal visibility of the lure in any water colouration, any weather and at all times of day. Supplied with two ultra-sharp treble hooks as well as two single hooks with a large eye, giving the angler the option of switching to a single-hook rig. Equipped with balls for directional stability, the wobbler flies straight and far without rotating on the cast. The Minnow Gipsy is a floating wobbler, available in three different depths. FD SU = Flat Diver SUSpending D SU = Diver SUSpending DD SU = Deep Diver SUSpending

Length	Weight	Content	Diving Depth	Action	perch	snow	tuna	goldfish	ayu	peacock	koi	sardine	RRP £
49 mm	4 g	1 pcs	-0,8 m	suspender	3257 001	3257 002	3257 003	3257 004	3257 005	3257 006	3257 007	3257 008	H9415 7.45
62 mm	5 g	1 pcs	-1,2 m	suspender	3257 101	3257 102	3257 103	3257 104	3257 105	3257 106	3257 107	3257 108	H1435 7.75
108 mm	18 g	1 pcs	-5 m	suspender	3257 201	3257 202	3257 203	3257 204	3257 205	3257 206	3257 207	3257 208	H9715 12.95

Trade Pack 5 Pieces

**Exhibit JM4**

40. Mr Masuch states the following at paragraph [13] of his Witness Statement:

13. **Exhibit JM4** hereto contains excerpts from the 2020 Quantum Fishing catalogue. This was published on 26 August 2019, as shown by the print out from the website [issuu.com](http://issuu.com), an online publishing platform, which is also contained in the exhibit.

41. The first page of the exhibit shows a print out of the Zebco Europe webpage from which the online 2020 Quantum Fishing catalogue can be accessed. The subsequent pages of the exhibits are prints of pages from that catalogue. Unlike the catalogues exhibited at JM3, this catalogue appears to relate exclusively to QUANTUM branded products. As with the catalogue excerpts exhibited at JM3: the QUANTUM mark is displayed in the top right-hand corner of each double-page spread. The QUANTUM branded products are listed on the Contents page as follows:

<b>REELS</b>	<b>Q 3</b>	<b>RODS</b>	<b>Q 22</b>	<b>ACCESSORIES</b>	<b>Q 52</b>	<b>4STREET</b>
Exo TI	Q 3	Smoke S3 Spin	Q 22-23	Smoke Braid Jigging Line	Q 52	
Smoke S3	Q 4	Vapor US-Baitcaster	Q 26-27	Lines Smart XTR Braid	Q 53-54	<b>RODS</b>
Smoke S3 Inshore	Q 5	Vapor US-Spin	Q 26-27	Quattron Mono Leader	Q 54	4Street Thinking Q 92-93
Cabo PT	Q 6	Vapor Detector Extr. Jigg.	Q 28-29	Lines Exofil	Q 55	4Street Travel King Q 92-93
Vapor	Q 7	Vapor Detector Micro Jigg.	Q 28-29	Lines Quattron	Q 56-57	
Accurist Spinning	Q 8	Vapor Finesse Lure & Jig	Q 30-31	Line Predator	Q 58	<b>ACCESSORIES</b>
Ultrax FD	Q 9	Vapor Fin. Lure & Jig Trav.	Q 30-31	Shads	Q 60-69	Shads, Accessories Q 94-95
Trax II	Q 10	Vapor Aggr. Med. Lure	Q 32-33	Plugs	Q 70-82	Jig Heads Q 96
Vantex	Q 11	Vapor Aggr. Med. Lure Trav.	Q 32-33	Accessories	Q 83	Hooks Q 97
Drive	Q 12	Vapor Aggr. Heavy Lure	Q 34-35	Shads	Q 84-90	Special Leads Q 98-99
Throttle	Q 13	Vapor Aggr. X-Heavy Lure	Q 34-35	Hooks, Spinner,		Rig Material, Accessories Q 100-101
Centex RD	Q 14	G-Force X-Tra	Q 36-37	Jig Heads	Q 124-129	Carryall Q 102-103
Mr. Pike The Releaser	Q 15	G-Force Shad	Q 36-37	Wire traces, Leader, Snaps		Lamp, Sunglasses,
Exo Baitcaster	Q 16	G-Force Jigging Inline	Q 38-39	Accessories	Q 130-133	Cap, Sticker Q 104
Smoke S3 LH 101 HPT	Q 17	G-Force Shad & Swimbait	Q 38-39	Accessories, Landing nets	Q 134-136	
Smoke Inshore	Q 18	Throttle Spin	Q 40-41	Carryall, Accessories	Q 137	<b>MR. PIKE</b>
Vapor 101 SPT	Q 19	Throttle Zander Jig	Q 40-41	Clothing	Q 138-139	<b>RODS</b>
Nova	Q 20	Throttle Pike Lure	Q 42-43	Accessories, Boxes	Q 140-141	Mr. Pike Standard Boat Q 106-107
Ultrax Cast	Q 21	Throttle Jerk	Q 42-43	Measuring Mats, Accessories		Mr. Pike Classic Boat Stand. Q 106-107
		Zanderkant	Q 44-45	Rod Stands, Promotional Items	Q 142-144	Mr. Pike Old School Zander Q 106-107
		Drive Spin	Q 44-45			Mr. Pike Classic Bank Q 108-109
		4Street Thinking	Q 46-47			Mr. Pike Classic Master Q 108-109
		4Street Travel King	Q 46-47			
		Mr. Pike Standard Boat	Q 48-49			<b>REELS</b>
		Mr. Pike Classic Boat Stand.	Q 48-49			Mr. Pike The Releaser Q 110
		Mr. Pike Old School Zander	Q 48-49			
		Mr. Pike Classic Bank	Q 50-51			<b>ACCESSORIES</b>
		Mr. Pike Classic Master	Q 50-51			Floats Q 111-113
						Wire traces Q 113-115
						Swinger, Accessories Q 116-120
						Clothing, Carryall,
						Accessories Q 121-123

42. The QUANTUM mark is visible on many of the products. Prices are expressed in '£'.

### Exhibit JM5

43. Mr Masuch states the following at paragraph [14] of his Witness Statement:

14. QUANTUM branded fishing tackle products are and have been sold by a wide range of third party retailers, including online. **Exhibit JM5** hereto contains a small selection of internet print outs from the websites of such third party retailers, including print outs taken using the internet archive service Wayback Machine.

44. Prints from the pages accessed 28 August 2020 fall outside of the relevant period.

**Prints of webpages from retailer, Anglesey Bait Centre:**

45. The Wayback print shows that the QUANTUM mark was displayed, alongside other brands, on this retailer's web pages on 13 September 2017. However, this print does not display the mark in relation to any products.

**Prints of webpages from retailer, Bobco Tackle:**

46. The Wayback prints show that the QUANTUM mark was displayed on this retailer's web pages on 2 July 2016. The mark appears in listings for products including fishing rods, reels, lures/artificial bait, bags and boxes for fishing tackle, nets and fishing line.

**Prints of webpages from retailer, Uttings:**

47. The Wayback prints show that the QUANTUM mark was displayed on this retailer's web pages on 6 August 2017. A number of fishing reels are listed; the text accompanying each listing makes clear that the products are from the QUANTUM brand.

**Prints of webpages from retailer, Veals Mail Order:**

48. The Wayback prints show that the QUANTUM mark was displayed on this retailer's web pages on 17 July 2017. Fishing reels are listed; the text accompanying each listing makes clear that the products are from the QUANTUM brand.

Exhibit JM6

49. Mr Masuch states the following at paragraph [15] of his Witness Statement:

15. Articles and reviews relating to QUANTUM products have featured in UK specialist media and on fishing-related websites. By way of example, **Exhibit JM6** hereto contains various articles/reviews from the Angling Times, a UK weekly magazine for anglers, as well as an online review of the "5 best fishing rods by Quantum Fishing" from the website myfishingrod.com.

50. This Exhibit includes 4 reviews of QUANTUM fishing equipment dated: 3 March 2015; 28 April 2015; 25 June 2015; 1 Feb 2017, respectively. In each case, it is clear that the product being reviewed is QUANTUM branded; however, the QUANTUM mark is not displayed. The print-out from 'myfishingrod.com' displays the QUANTUM mark in relation to its 21 July 2017 review of 'the best fishing rods by Quantum Fishing'.

#### Exhibit JM7

51. Mr Masuch states the following at paragraph [17] of his Witness Statement:

16. The QUANTUM brand has been promoted to UK consumers via social media. **Exhibit JM7** hereto contains print outs taken from My Company Group's "Quantum Fishing United Kingdom" Facebook page showing posts dating from January 2019 – January 2020, as well as a small number of examples of posts made by My Company Group's "Quantum Fishing – Official" Instagram account.

52. Web print-outs of Instagram posts from an account named 'quantumfishing\_official' show 3 posts in which a quantum product or Quantum catalogue is promoted and the QUANTUM mark is prominently displayed. The pages were accessed 28 August 2020 and show that the account had 21.6k followers at that date. The posts are dated: 9 November 2019, 14 June 2019 and 7 September 2018, respectively.

53. Web print-outs of Facebook posts from an account named 'Quantum Official Site UK' accessed 28 August 2020, show various posts, published on various dates between 24 January 2019 and 16 August 2020, promoting QUANTUM fishing products. The QUANTUM mark is visible in relation to each post; in each case, it identifies QUANTUM as the publisher of the posts.

## **Decision**



## Genuine Use

54. Section 6A of the Act provides that:

“(1) This section applies where

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

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

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

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

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

Arnold J summarised the law relating to genuine use as follows<sup>4</sup>:

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

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

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

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

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<sup>4</sup> 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.

(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].”

56. The onus is on the Opponent, as the proprietor of the earlier mark, to show use because Section 100 of the Act states:

“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.”

57. 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<sup>5</sup>.

58. The Opponent's submissions on the issue of genuine use, set out at paragraphs [7] – [18] of its written submissions, can be summarised as follows:

That the Opponent's evidence demonstrates genuine use of its mark, in the UK, during the relevant period, by proving 'substantial and geographically widespread sales' of a diverse range of goods within the term '*Fishing tackle and fittings therefor, all included in Class 28*'.

59. My global assessment has determined that the totality of the evidence presented succeeds in establishing that the Opponent has made genuine use of its mark during the relevant period. The range of material adduced is such that where an individual piece of evidence, taken in isolation, has evidential shortcomings, other pieces of evidence are able to 'fill in the gaps'.

60. As noted above, at paragraphs [13] – [14], the revenue figures are incomplete, by reason of omitting the figures for 2015 and failing to refine the figures for the relevant part of January 2020. However, the evidence provided by way of dealer catalogue excerpts, summarised above at paragraphs [35] – [39], *does* cover the entire relevant 5-year period. In any event, the turnover figures are for four of the five years; a substantial proportion of the 5-year period. In a similar vein, Exhibit JM2 (redacted) includes invoices at fairly regular intervals to cover the period March 2016 to January 2020; where it fails to provide invoices for 2015, the excerpts from dealer catalogues demonstrate clear use of the mark for that year. The various pieces of evidence 'interlock' to provide a satisfactory picture of the extent of the Opponent's use of its mark.

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<sup>5</sup> Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, GC.

61. For the years 2016 – 2019, the revenue figures show fairly substantial sales; although the figures fluctuate somewhat, the lowest figure, £60,000 for March – December 2016, nevertheless demonstrates that a significant amount of stock has been sold.
62. Of the prints of web pages provided by way of Exhibit JM1, summarised above at paragraphs [15] – [27], the ‘Zebco Europe’ Wayback prints carry the most weight. There is clear use of the QUANTUM mark, alongside other Zebco brands, in relation to the ‘Dealer Locator’ map which shows an extensive geographical spread of retail outlets, across England, Wales and Scotland, where QUANTUM products are sold.
63. The geographical extent of sales of QUANTUM products is also reflected in the selection of 40 invoices Exhibited at JM2 (redacted). The selection includes invoices for retailers based in: Cornwall, Anglesey, London, Leeds, Birmingham, Bristol, Stirling and Swansea, to name but a few. These invoices demonstrate that a wide array of goods under the QUANTUM brand, falling within the term *‘Fishing tackle and fittings therefor’, all included in Class 28*, have been sold. QUANTUM products are listed on the invoices at least as frequently as products from other Zebco brands, therefore demonstrating that ‘QUANTUM’ occupies a place in the UK market for fishing products.
64. As noted, no invoices have been provided for 2015. The Dealer catalogue excerpts, however, cover the duration of the relevant 5-year period and, to my mind, reveal ‘real commercial exploitation of the mark’ in relation to the goods in question. The excerpts provided show use of the QUANTUM mark in respect of a broad range of fishing tackle and related goods. I am satisfied that the range of goods is sufficiently broad to allow the Opponent to rely on the full width of the term *‘Fishing tackle and fittings therefor’, all included in Class 28*. The excerpts from the 2020 Quantum Fishing Catalogue, which appears to contain products exclusive to the QUANTUM brand; together with the Wayback prints from third-party retailers, bolster my view.
65. The web print-outs of posts from the Opponent’s Facebook account named ‘Quantum Official Site UK’ provide additional evidence of the marketing of

QUANTUM products to UK consumers. In my view, the Opponent has availed itself of a variety of channels through which to market its goods in the UK, i.e. its own websites; websites of third-party retailers; publications specifically targeted at fishing enthusiasts (e.g. myfishingrod.com); social media (Facebook and Instagram); dealer catalogues.

66. Consequently, I find that the Opponent has succeeded in establishing genuine use of its mark for the relevant period in respect of the term “*Fishing tackle and fittings therefor*”, all included in Class 28’.

#### Variant use of the mark

67. In reaching my conclusion I have borne in mind the provision laid down by Section 6A(4)(a) of the Act according to which ‘use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered....’.

68. I note that the mark, as registered, comprises the word ‘QUANTUM’ rendered in plain text in block capitals. In many instances, the mark appears as registered (albeit either in upper or lower case) i.e. without any stylisation or embellishment of any kind. Examples include, but are not limited to:

- The contents pages of each dealer catalogue;
- In the descriptions of many of the QUANTUM products, both in the catalogues and on invoices;
- On the Zebco web page in relation to the Quantum Fishing catalogue:



**zebco-europe-OFFICIAL**  
Published on Aug 26, 2019

#### **2020 Quantum Fishing catalogue english**

- On the web pages of third-party retailers of QUANTUM products;



e.g. BobCo Fishing Tackle:



[Quantum Escalade Drop Shot Rod](#)

Available in: 7ft, 8ft,



[Quantum Vantex Multiplier](#)

RRP £71.95  
**You Save 17%!**  
£59.00



[Quantum Escalade Spinning Reel](#)

Available in: 10, 20,

NOW FROM ~~£104.99~~



[Quantum Smart Motion Beach Reel](#)

Available in: 660, 670,

Uttings.co.uk:

Quantum Fishing

SUBSCRIBE TO OUR FISHING EMAILS and get 10% off your

Order by

35 products

**Quantum World Champion Fixed Spool Surf Reel - FD1270**  
Ideal for Beach Fishing

SAVE £20



RRP £119.95  
**£99.00**  
IN STOCK

**Quantum World Champion Fixed Spool Surf Reel - FD1280**  
Ideal for Beach Fishing

SAVE £20



RRP £119.95  
**£99.00**  
IN STOCK

69. The mark also appears, in many instances, with a stylised 'Q' and coalesced 'U' and 'M' as follows:

**QUANTUM**<sup>®</sup>

70. Furthermore, in some instances, the slightly stylised version appears in combinations with other elements to designate particular lines of products under the QUANTUM brand; for example, as set out in the 2015 Dealer catalogue:

QUANTUM

Specialist

Q3-Q111

Sea

Q112-Q137



71. The test for whether variant use of a mark constitutes genuine use under s46(2), which is the equivalent of section 6A(4(a) of the Act, was summarised by Mr Richard Arnold Q. C. (as he then was) in *Nirvana Trade Mark*, BL O/262/06:

"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."

73. The mark is frequently used on its own, but with stylisation to the 'Q' and coalescence of the 'U' and 'M'. In my view, despite the differences between this iteration of the mark, shown above at paragraph [69], and the mark as registered, the variation does not prevent the mark from functioning as an indicator of the origin of the goods in respect of which it is registered. The distinctive character of the registered mark resides in the word 'QUANTUM'. The stylisation of the 'Q' and the coalescence of the 'U' and 'M' do not prevent immediate recognition of the word 'QUANTUM'. Even though, strictly speaking, the letter 'U' is not displayed in its entirety due to be 'absorbed' into the letter 'M', the 'mind's eye' is able to register the

word 'QUANTUM'. I therefore find that use of this iteration of the mark constitutes 'genuine use'.

75. If my conclusions set out above are incorrect, I am nevertheless satisfied that the Opponent's use of the mark, without stylisation or embellishment, as described above at [68], amounts to 'genuine use' of the mark as registered.

### **Opposition under s5(2)(b)**

#### **Section 5(2)(b) of the Act and related case law**

76. Section 5(2)(b) of the Act states:

"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."

77. The following principles are derived from the decisions of the Court of Justice of the European Union ("CJEU")<sup>6</sup> 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*

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<sup>6</sup> 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.

*Klijsen Handel B.V. Case C-342/97; Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98; Matratzen Concord GmbH v OHIM, Case C-3/03; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C120/04; Shake di L. Laudato & C. Sas v OHIM, Case C-334/05P; and Bimbo SA v OHIM, Case C-591/12P*

The principles:

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

### **Comparison of goods and services**

78. The General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 held that:

“29. ... 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”.

79. It follows that goods can also be considered identical when the goods designated by the *applied-for* mark are included in a more general category of goods in respect of the which the *earlier mark* is registered.

80. The goods and services to be compared are as follows:

Opponent's mark:

Applied-for mark:

**Class 28**

*Fishing tackle and fittings therefor, all included in Class 28*

**Class 28**

*Artificial baits for fishing; artificial chum for fishing; artificial fish bait; artificial fishing bait; artificial fishing worms; artificial flies for use in angling; bags adapted for fishing; bags for fishing; bait (artificial); bait (artificial fishing); bait bags for holding live bait; bait throwers; catapult bait pouches; decoys for hunting or fishing; electronic bite indicators for use in angling; Fish hook removers being fishing tackle; Fish hooks; Fish lures; Fishing bait [synthetic]; Fishing creels; Fishing equipment; Fishing floats; Fishing fly boxes; Fishing gaffs; Fishing ground baits; Fishing harnesses; Fishing hooks; Fishing leaders; Fishing line casts; Fishing lines; Fishing lure boxes; Fishing lures; Fishing plugs; Fishing plumbs; Fishing poles; Fishing reel cases;*

*Fishing reels; Fishing rod cases; Fishing rod handles; Fishing rod holders; Fishing rod rests; Fishing rod supports; Fishing rods; Fishing sinkers; Fishing spinners; Fishing swivels; Fishing tackle; Fishing tackle bags; Fishing tackle boxes; Fishing tackle floats; Fishing tackle terminal; Fishing tackle terminal tackle; Fishing tippets; Fishing weights; ground bait (artificial); gut for fishing; hooks (fish); hooks for fishing; inflatable fish float tubes; line casts for fly fishing; lines for fishing; lures (artificial) for fishing; lures for fishing; nets for use by anglers; nets (landing) for anglers; paternosters (fishing tackle); rods for fishing; tackle (fishing).*

81. Applying the above *Meric* principle, all of the Applicant's goods to which the opposition is directed are identical to the Opponent's *Fishing tackle and fittings therefor, all included in Class 28* by virtue of being included in that more general category.

### **Average consumer and the purchasing act**

82. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

83. In *Hearst Holdings Inc*<sup>7</sup> Birss J. described the average consumer thus:

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

84. The Opponent submits, at paragraphs [22] to [24] of its written submissions, that:

- The average consumer is a fishing enthusiast, whether amateur or professional;
- The goods in question would be purchased from physical or online stores, usually specialist retailers;
- The purchasing act will in most instances be visual, while aural considerations are important, e.g.: consumers of fishing tackle will likely discuss prospective purchases with their peers and make recommendations;
- The lower-priced items, e.g. hooks and lures, would be purchased with a lesser degree of attention than the more expensive products such as reels and rods, in which case a higher degree of attention may be paid.

85. The Applicant has not addressed the matter of the average consumer and the purchasing act in its Defence and Counterstatement.

86. I accept the Opponent’s submissions on this matter. I find that the level of attention paid by the average consumer would vary depending on whether an item such as a lure, at a few pounds, or a rod, at several tens of pounds to over £100, were to be purchased. In my view, the average consumer would display an



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<sup>7</sup> *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).



average level of attention when purchasing a lure; whereas a reel or rod, for instance, would be a more carefully considered purchase, with the consumer paying a medium-high level of attention. I consider that the competitive nature of angling is such that, even when purchasing an inexpensive item such as a lure, the level of attention paid is unlikely to be in the low range. I consider that the average consumer of *fishing tackle and fittings therefor* would consider factors such as: whether the item is suitable for the type of fishing that they wish to practise; whether the item is compatible with their existing equipment; and its durability. I therefore find that the attention level of the average consumer will be in the medium-high range.

### Comparison of the marks

<p>QUANTUM</p>	<p>i)</p>  <p>ii)</p> 
<p>Opponent's (earlier) mark</p>	<p>Applicant's (contested) mark (series of two).</p>

87. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to

analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

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

89. The Opponent has made the following points in paragraphs [27] – [32] of its written submissions:

- That the respective marks are visually similar ‘to at least a medium degree’ by virtue of having the common element ‘QUANTUM’ and the fact that this element appears at the beginning of the Applicant’s mark, ‘to which consumers are likely to pay greater attention’ [30];
- That the respective marks are aurally similar to a high degree by virtue of: the first two syllables of each mark being identical; and the second mark being articulated as ‘QuantumBlue’, without vocalising the ‘QB’ or ‘Unleash your true potential’ elements [31]; and
- That there is ‘at least a medium degree of conceptual similarity’ between the respective marks [32].

90. The Applicant's Counterstatement is as follows:

I disagree with the opponent. My trademark is different from the one of the opponent. The logo and colors are different. I have the right to use the word "Quantum" in conjunction with any other word as long as the final wording is not the exact match of an existing trademark. The opponent has a trademark on "Quantum" and certainly not on any other trademark around the world that contains the word "Quantum". I registered a trademark for "Quantum BLUE" which is different from "Quantum". On these grounds, I do not see why my trademark should be prevented from being registered.

91. The Opponent's mark consists of a single word 'QUANTUM' in plain type with all letters in upper case. The overall impression of the mark therefore resides in the mark in its entirety.

92. The Applicant has applied for a series of two marks. The Applicant's marks comprise several elements. The word element 'QuantumBlue' appears at the centre of the mark in a plain font; the letters 'Q' and 'B' being in upper case with the remaining letters in lower case. There is slight stylisation to the 'Q' to the extent that the 'tail' is curved and somewhat elongated. Above 'QuantumBlue' is a circle containing the letters 'QB' in upper case. The letters 'QB' are stylised to the extent that the 'Q' appears to overlap the 'B' giving a 3-dimensional appearance; the 'B' appears as if elevated and set back from the 'Q'. Below the 'QuantumBlue' element are the words 'Unleash your true potential' in a plain font, with the 'U' in upper case. A faint figurative element, which might be described as a wave-like flourish with a sprinkling of squares and dots of various sizes, can be seen on close inspection of the mark. The 'QuantumBlue' element, and the 'QB' within the circle element, are emboldened relative to the 'Unleash your true potential' element. The overall impression resides in the entirety of the mark, with the 'QuantumBlue' word element having visual dominance over the other elements of the mark owing to its size and central position.

93. Visual comparison

The fact that the word 'Quantum' is wholly incorporated into the Applicant's mark is uncontroversial. In the Applicant's mark, however, 'Quantum' has been 'run together', or conjoined, with the word 'Blue'. In my view, 'QuantumBlue' is the

element to which the eye will be drawn first, by virtue of the weaker visual impact of the remaining elements.

94. Courts have been willing to find similarity of marks where there is an identical verbal element that is shared by the respective marks, even though the remaining letters are different. The General Court in the case of *Lancome v OHIM*<sup>8</sup> considered the word marks 'ACNO FOCUS' and 'FOCUS' and concluded that there was a certain visual similarity between them by virtue of both marks containing the common element 'FOCUS'.

95. In *El Corte Inglés, SA v OHIM*, the General Court observed that the attention of the consumer is *usually* [my emphasis] directed to the beginning of a word mark<sup>9</sup>, but I am mindful that this is not an absolute rule.

96. The encircled 'QB' element will be noticed, although it plays lesser visual role owing to its much smaller size relative to the 'QuantumBlue' element below it. The 'Unleash your true potential' element has a weak visual impact due to the small size of the lettering. The large and emboldened lettering of 'QuantumBlue', as compared to the small lettering of 'Unleash your true potential', will result in these word elements being perceived visually as two separate units within the mark.

97. The figurative element, described above in paragraph [92], is so faint that it is only discernible upon very close inspection of the mark.

98. Although the encircled 'QB' and 'Unleash your true potential' elements will have less visual prominence than 'QuantumBlue', the presence of those weaker elements will nevertheless be discerned by the eye of the average consumer. The figurative element is, in my view, less likely to be noticed.

99. Consequently, I find that there is a low-medium level of visual similarity between the respective marks.

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<sup>8</sup> Case T-466/08 *Lancôme Parfums et Beauté & Cie v OHIM* EU:T:2011:182, para [63].

<sup>9</sup> Cases T-183/02 and T-184/02 at para [83].

100. Aural comparison

The Opponent's mark will be articulated as 'kwon-tum', with the emphasis on the first syllable. The Applicant's mark, in my view, will be articulated as 'Kwon-tum-blue' with the emphasis on the final syllable. I consider that neither the encircled 'QB' element nor the words 'Unleash your true potential' will be articulated by the average consumer. The encircled 'QB' will be perceived by most as an abbreviation of 'QuantumBlue'. The *visual* perception of 'QuantumBlue' and 'Unleash your true potential' as two separate word elements, with 'QuantumBlue' having greater prominence, will, to my mind, mean that, *aurally* speaking, the focus will be on 'QuantumBlue'.

101. There is aural similarity between the respective marks to the extent that the first two syllables of the Applicant's mark are identical to the Opponent's word mark in its entirety. On the other hand, the difference in the lengths of the respective marks, i.e. the earlier mark's 2 syllables as compared to the contested mark's 3 syllables (if 'QB' and 'Unleash your potential' are not articulated) will be discerned aurally.

102. I therefore find that, if 'QB' and 'Unleash your potential' are not articulated, the degree of aural similarity between the marks is no more than medium. If 'QB' and 'Unleash your potential' are articulated, the marks will be aurally similar to a low degree.

103. Conceptual comparison

Dealing with the Opponent's mark first, 'QUANTUM' would be recognised by the average consumer as a word used in the English language. The dictionary definition of 'QUANTUM'<sup>10</sup> is 'the smallest amount or unit of something, especially energy' or 'an amount of something'. In my view, the average consumer would be familiar with the word 'QUANTUM' as a scientific concept, even if they did not appreciate the precise dictionary definition of the word. I

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<sup>10</sup> <https://dictionary.cambridge.org/dictionary/english/quantum> accessed 25 February 2021 at 11:14.

consider that most average consumers will have encountered the word in references to 'Quantum Theory' or 'Quantum Physics', even if they have little or no knowledge of those subjects. A smaller proportion of average consumers will be familiar with the term 'quantum of damages' meaning the measure of compensation received in a legal action. To my mind, 'QUANTUM', as a mark for fishing tackle and related goods, would invoke the idea of the goods having the quality of scientific precision or reliability.

104. I now turn to the Applicant's mark. The 'Quantum' portion of the 'QuantumBlue' element would be understood to have the meaning underlined above, at [103]; 'Blue' would be understood as referring to the colour and might be taken to allude to water. I find that 'QuantumBlue' will conjure the same idea of the goods having the quality of scientific precision or reliability. I consider that the majority of average consumers would assume the 'QB' element to be an abbreviation of 'QuantumBlue'. The less prominent word element 'Unleash your potential' conveys the idea of the goods enabling the user to perform at their optimal level.

105. Consequently, I find that the level of conceptual similarity between the respective marks is at least medium.

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

106. *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).”

107. The Opponent has submitted the following at paragraph [33] of its written submissions:

Although the term QUANTUM is a dictionary word, it has no meaningful relationship with the goods at issue and is of at least normal inherent distinctiveness.

108. The Applicant’s counterstatement is reproduced in its entirety above, at paragraph [90]; it does not address the matter of the distinctive character of the earlier mark.

109. I find that ‘QUANTUM’ is neither descriptive of, nor allusive to, the goods in respect of which the Opponent’s mark is registered. Although ‘QUANTUM’ is a dictionary word, I consider that it is a fairly unusual choice of word for a mark to identify a purveyor of fishing tackle and related goods. Consequently, I find that the earlier mark is inherently distinctive to at least a medium degree.

### **Likelihood of confusion**

110. Confusion can be direct or indirect. Mr Ian Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*<sup>11</sup>. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*<sup>12</sup>, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that he has in his mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark before him but mistakenly matches it to the imperfect image of the earlier mark in his ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the later mark is indeed different from the earlier mark, but, concludes that the later mark is economically linked to the earlier mark by way of being a ‘sub brand’, for instance.

111. Before arriving at my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at [77].

112. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.

113. I have determined that:

- The Applicant’s class 28 goods to which the Opposition is directed are identical with the Opponent’s goods;
- There is a low-medium level of visual similarity between the respective marks;

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<sup>11</sup> Case BL O/375/10 at [16].

<sup>12</sup> *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].



- There is no more than a medium level of aural similarity between the marks if ‘QB’ and ‘Unleash your potential’ are not articulated; if those elements *are* articulated, then aural similarity will be low;
- The level of conceptual similarity between the respective marks is at least medium.

114. In *New Look Limited v OHIM*<sup>13</sup> the General Court stated that:

“49. ...it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market...”

115. In *Quelle AG v OHIM*<sup>14</sup>, the General Court held that:

“68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs.”

116. As noted above, at paragraph [86], the purchasing act will, in most instances, be visual in nature. The visual aspect of the marks will play a more prominent role because the selection of, or decision to purchase, the goods will usually be made after visual exposure to the mark either by way of information on a website or catalogue, or after seeing the products in a shop. In my view, even where the purchasing act is aural, e.g. where the goods are purchased after recommendation or advice, I consider that the competitive nature of angling and,

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<sup>13</sup> Joined cases T-117/03 to T-119/03 and T-171/03.

<sup>14</sup> Case T-88/05.

therefore, the importance of the technical specification of the goods, entail that the purchaser would 'look up' the product themselves online/in a catalogue in the course of, or after, receiving the advice or recommendation. Consequently, I consider that the weight to be accorded to the aural similarity of the marks is somewhat diminished.

117. I have found that the Opponent's mark is inherently distinctive to at least a medium degree. The CJEU held in *Sabel*<sup>15</sup> that:

"24. The more distinctive the earlier mark, the greater will be the likelihood of confusion."

118. This principle was given an important qualification by Mr Iain Purvis Q.C, as the Appointed Person, in the decision of *Kurt Geiger v A-List Corporate Limited*<sup>16</sup>:

"39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it."

119. In my view, the visual differences between the marks, together with my finding at [116] concerning the weight to be accorded to the visual comparison, are sufficient to rule out the likelihood of direct confusion. I find this to be the case even though the respective goods are identical. As noted above, at [86], the purchaser will display a medium-high level of attention when making their purchase.

120. However, the following observations lead me to conclude that there is a likelihood of *indirect* confusion in respect of all goods to which the Opposition is directed:

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<sup>15</sup> *Sabel BV v Puma AG* (C-251/95), [1998] E. T. M. R. 1 (1997) at [24].

<sup>16</sup> BL O-075-13.

- The respective goods are identical.
- The respective marks are conceptually similar to at least a medium degree.
- The dominant and distinctive element of the earlier mark, i.e. 'QUANTUM', is wholly incorporated into the dominant aspect of the applied-for mark, i.e. 'QuantumBlue'. The encircled word element 'QB', in the Applicant's mark, will likely be seen as an abbreviation of 'QuantumBlue' rather than as part of the brand name; 'Unleash your potential' will likely be perceived as a tag-line or laudatory statement about the goods. I find that the presence of these elements, together with the conjoining of 'Blue' to the word 'Quantum' give rise to a likelihood of *indirect* confusion.
- In *Whyte and Mackay*<sup>17</sup> it was held that where an average consumer perceives that a composite mark consists of two or more elements, one of which has a distinctive significance independent of the mark as a whole, confusion may occur as a result of the similarity/identity of that element to the earlier mark. In the instant case, the 'Quantum' element of the Applicant's mark 'QuantumBlue' has retained its independent distinctive role leading the average consumer to presume that 'QuantumBlue' is related to the brand 'QUANTUM'. I find that the average consumer would likely presume 'QuantumBlue' to refer to a sub-brand or designate a particular range of products, e.g. the 'Blue' range.
- In my view, the culmination of these factors will result in the average consumer discerning the visual differences between the respective marks but concluding that the marks relate to economically-linked undertakings.

## Final Remarks

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<sup>17</sup> *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271.

121. The Opposition is directed at the class 28 terms enumerated at paragraph [2] only. The remainder of the class 28 specification was unopposed; classes 21 and 25 were also unopposed.

122. The Opposition has succeeded in full. The Application is therefore *refused only* in respect of the following terms:

**Class 28**

*Artificial baits for fishing; artificial chum for fishing; artificial fish bait; artificial fishing bait; artificial fishing worms; artificial flies for use in angling; bags adapted for fishing; bags for fishing; bait (artificial); bait (artificial fishing); bait bags for holding live bait; bait throwers; catapult bait pouches; decoys for hunting or fishing; electronic bite indicators for use in angling; Fish hook removers being fishing tackle; Fish hooks; Fish lures; Fishing bait [synthetic]; Fishing creels; Fishing equipment; Fishing floats; Fishing fly boxes; Fishing gaffs; Fishing ground baits; Fishing harnesses; Fishing hooks; Fishing leaders; Fishing line casts; Fishing lines; Fishing lure boxes; Fishing lures; Fishing plugs; Fishing plumbs; Fishing poles; Fishing reel cases; Fishing reels; Fishing rod cases; Fishing rod handles; Fishing rod holders; Fishing rod rests; Fishing rod supports; Fishing rods; Fishing sinkers; Fishing spinners; Fishing swivels; Fishing tackle; Fishing tackle bags; Fishing tackle boxes; Fishing tackle floats; Fishing tackle terminal; Fishing tackle terminal tackle; Fishing tippetts; Fishing weights; ground bait (artificial); gut for fishing; hooks (fish); hooks for fishing; inflatable fish float tubes; line casts for fly fishing; lines for fishing; lures (artificial) for fishing; lures for fishing; nets for use by anglers; nets (landing) for anglers; paternosters (fishing tackle); rods for fishing; tackle (fishing).*

123. The Application may *proceed* in respect of the following goods only:

Class 21 – all goods applied for;

Class 25 – all goods applied for;

Class 28 – *only* those goods *not* included in paragraph [122] above.

## **COSTS**

124. I award the Opponent the sum of **£1500** as contribution towards its costs, calculated as follows<sup>18</sup>.

Preparation of statement and consideration of the Applicant's statement:	£200	
Official fee for 5(2)(b) only:	£100	
Preparation of evidence	£800	
Written Submissions	£400	
<b>Total:</b>		<b>£1500</b>

125. I therefore order Optimum Blue Ltd to pay to W.C. Bradley/Zebco Holdings, Inc. the sum of £1500. This sum is to be paid within twenty-one days 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 3rd day of March 2021**

**Mx N. R. Morris**  
**For the Registrar,**  
**the Comptroller-General**

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<sup>18</sup> Based upon the scale published in Tribunal Practice Notice 2/2016.