

O/526/21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3409092
BY HUNTER-GATHERER LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:**

HUNTER-GATHERER

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 418696
BY HUNTER BOOT LIMITED**

BACKGROUND AND PLEADINGS

1. On 24 June 2019 (“the relevant date”), HUNTER-GATHERER LIMITED (“the applicant”) applied to register the trade mark displayed on the cover page of this decision. The application was accepted and published in the Trade Marks Journal on 06 September 2019 in respect of the following goods and services:

Class 3: *Soaps; perfumery, essential oils, cosmetics, hair lotions, shampoos; non-medicated bath preparations.*

Class 8: *Hand tools, implements, cutlery*

Class 14: *Jewellery and watches; precious metals and their alloys (other than for dental purposes); costume jewellery, precious stones; horological and chronometric instruments*

Class 16: *Paper, cardboard, photographs, printed matter, books and publications*

Class 18: *Leather and imitations of leather, trunks (luggage) and travelling bags; suitcases, rucksacks, wallets, briefcases, purses, key wallets, chequebook holders, handbags for men and women; umbrellas and parasols*

Class 20: *Furniture, tables, chairs, sofas, beds, futons, sofa beds, shelving cabinets, shelving, desks, hampers (baskets)*

Class 21: *Household or kitchen utensils and containers (including those made of paper); hand operated coffee grinders and coffee mills; insulated coffee and beverage cups; collapsible cup carriers and caddies; insulated vacuum bottles; coffee cups, tea cups and mugs; glassware; dishes, plates and bowls; trivets; storage canisters; non-electric drip coffee makers and non-electric plunger style coffee makers; coasters*

Class 22: *Tents, sacks and bags*

Class 25: *Articles of clothing (excluding footwear), headgear*

Class 29: *Meat, fish, shellfish, lobster, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; non-alcoholic mixed milk beverages (milk predominating), and food prepared from milk, whey, yoghurt, cream and/or containing cocoa; non-alcoholic beverages made from milk, whey and/or cream; soup, soup mixes and soup preparations; food products being meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats, food prepared from milk, whey, yoghurt, cream and/or containing cocoa, soup, soup mixes and soup preparations all sold in a hamper; salads*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, sandwiches, pretzels, cakes, tarts, pies, biscuits, cookies, muffins, crumpets, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments); spices; ice; rice and rice products; pasta and prepared entrees consisting primarily of pasta; snack foods; food products being sugar, rice, tapioca, flour and preparations made from cereals, bread and confectionery, sandwiches, pretzels, cakes, tarts, pies, biscuits, cookies, muffins, crumpets, ices, honey, treacle, yeast, baking-powder; salt, mustard, vinegar, sauces (condiments), spices, ice, rice and rice products, pasta and prepared entrees consisting primarily of pasta and snack foods all sold in a hamper*

Class 31: *Fresh fruit and fresh vegetables; lobster (live); shellfish (live)*

Class 32: *Non-alcoholic beverages; mineral and aerated waters; fruit drinks and fruit juices; syrups and other preparations for making beverages; beers*

Class 33: *Alcoholic beverages, except beer*

Class 35: *Retail services, wholesale services and online retail services connected with the sale of soaps, perfumery, essential oils, cosmetics, hair*

lotions, shampoos, non-medicated bath preparations, hand tools, implements, cutlery, jewellery and watches, precious metals and their alloys, costume jewellery, precious stones, horological and chronometric instruments, paper, cardboard, photographs, printed matter, books and publications, leather and imitations of leather, trunks (luggage) and travelling bags, suitcases, rucksacks, wallets, briefcases, purses, key wallets, cheque book holders, handbags for men and women, umbrellas and parasols, furniture, tables, chairs, sofas, beds, futons, sofa beds, shelving cabinets, shelving, desks, tents, sacks and bags, articles of clothing (excluding footwear), headgear, meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats, non-alcoholic mixed milk beverages (milk predominating), and food prepared from milk, whey, yoghurt, cream and/or cocoa and/or non-alcoholic beverages made therefrom, other non-alcoholic beverages, soup, soup mixes and soup preparations, food products sold in a hamper, salads, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, sandwiches, pretzels, cakes, tarts, pies, biscuits, cookies, muffins, crumpets, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice; rice and rice products, pasta and prepared entrees consisting primarily of pasta, snack foods, fresh fruit and fresh vegetables, non-alcoholic beverages, mineral and aerated waters, fruit drinks and fruit juices, syrups and other preparations for making beverages, beers and other alcoholic beverages

Class 39: *Arranging of travel tours*

Class 41: *Education, training, entertainment, sporting and cultural services*

Class 43: *Accommodation services for travellers; accommodation finding services for travellers; accommodation reservation services; arranging the reservation of accommodation for others; provision of the aforesaid services via the internet; information and advice relating to the aforesaid services; catering services; services for the provision of food and drink; restaurant services, bar services, café services, hotel services, snack bar services*

2. On 6 December 2019, the application was opposed by Hunter Boot Limited (“the opponent”). The opposition is based on Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and concerns the goods and services in classes 3, 14, 18, 25 and 35 in the application.

3. For the purpose of its opposition based upon Section 5(2)(b) of the Act, the opponent relies upon the marks shown below:¹

UK no. 2493452 (“the HUNTER word-mark”)

HUNTER

Filing date: 24 July 2008

Date of entry in register: 19 December 2008

Opposing all the goods and services in classes 3, 14, 18, 25 and 35 in the application and relying on some of the goods and services for which the mark is registered, namely:

Class 3: *Cleaning, polishing, scouring and abrasive preparations; shoe, boot and footwear polishes; boot cream, boot wax; shoe cream, shoe wax; cleaning preparations for shoes, boots and footwear.*

Class 18: *Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks and travelling bags; umbrellas, travel bags; wallets; purses; backpacks; boot and footwear bags.*

Class 21: *Boot and shoe jacks*

Class 25: *Clothing, footwear, headgear, boots; inner soles; insoles for boots and shoes; bags and pouches adapted to carry boots and shoes; socks, hats, gloves, scarves; waterproof footwear; jackets; jerseys; jumpers; outer clothing; overcoats;*

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

sandals; flip-flops; shirts; shoes; sweaters; t-shirts; top coats; waterproof clothing; sports clothing.

Class 35: Retail services connected with the sale of cleaning, polishing, scouring and abrasive preparations, shoe, boot and footwear polishes, boot cream, boot wax, shoe cream, shoe wax, cleaning preparations for shoes, boots and footwear; key rings, leather and imitations of leather, trunks and travelling bags, umbrellas, travel bags, wallets, purses, backpacks, boot and footwear bags, boot and shoe jacks, clothing, footwear, headgear, boots, inner soles, insoles for boots and shoes, bags and pouches adapted to carry boots and shoes, socks, hats, gloves, scarves, waterproof footwear, jackets, jerseys, jumpers, outer clothing, sandals, flip-flops, shirts, shoes, sweaters, t-shirts, top coats, waterproof clothing, sports clothing.

IR no. 1219945 (“the HUNTER logo mark”)



Filing date: 21 February 2014; Date of entry in register: 28 August 2015

Priority date: 24 October 2013 claimed from UK00003027848

Opposing all the goods and services in classes 3, 14, 18, 25 and 35 in the application and relying on all the goods and services for which the mark is registered, namely:

Class 3: Cleaning, polishing, scouring and abrasive preparations; shoe, boot and footwear polishes; boot cream, boot wax; shoe cream, shoe wax; cleaning preparations for shoes, boots and footwear; soaps; fragrances, toilet waters and perfumery; essential oils; tea tree oil; cosmetics; non-medicated toilet preparations; sunscreen and sun tanning preparations; air perfuming preparations.

Class 9: Boots (protective footwear); outdoor boots for protection against accident or injury; safety boots for use in industry; clothing for protection against accident or injury; safety clothing; safety gloves; data storage devices; sunglasses; spectacles

and binoculars; covers, cases and stands for telephones, mobile telephones, computers, laptop computers, tablet computers and personal digital assistants.

Class 14: *Jewellery; wrist watches; cufflinks; boot and shoe ornaments of precious metal; alarm watches, digital watches with automatic timers, drivers' watches, dress watches, jewellery watches, pendant watches, sports watches, table watches, wristlet watches.*

Class 18: *Leather and imitations of leather; trunks and travelling bags; umbrellas, parasols and walking sticks; luggage; briefcases; travel bags; holdalls; handbags; suitcases; suit carriers; backpacks; rucksacks; wallets; purses; key cases; game bags; gun slings and cartridge bags; boot and footwear bags; bags and pouches; bags and pouches adapted to carry boots and shoes.*

Class 25: *Clothing; footwear; headgear; boots; Wellington boots; waterproof boots; waterproof footwear; galoshes; gaiters; waterproof clogs; shoes; shoes of rubber, leather or other materials; sandals; flip-flops; slippers; welts for boots and shoes; non-slipping devices for boots; inner soles; heels and soles for footwear; insoles for boots and shoes; liners for boots and shoes; socks for use with Wellington boots and waterproof boots; socks; hats; top hats; sun visors and caps; headbands; gloves, scarves; garters; waterproof clothing; outer clothing; outerwear; jackets; coats; overcoats; top coats; raincoats; jerseys; jumpers; knitwear; sweaters; gilets; waistcoats; neckties; overalls; pyjamas; pants; shirts; blouses; swimsuits; t-shirts; trousers; shorts; culottes; underclothing; underpants and underwear; fishing vests and waistcoats; sports clothing; sports footwear; after-sports footwear; belts and money belts; belts (made of leather).*

Class 35: *Retail, wholesale and on-line retail and wholesale services connected with the sale of cleaning, polishing, scouring and abrasive preparations, shoe, boot and footwear polishes, boot cream, boot wax, shoe cream, shoe wax, cleaning preparations for shoes, boots and footwear, soaps, fragrances, toilet waters and perfumery, essential oils, tea tree oil, cosmetics, non-medicated toilet preparations, sunscreen and sun tanning preparations, air perfuming preparations, boots*

(protective footwear), outdoor boots for protection against accident or injury, safety boots for use in industry, clothing for protection against accident or injury, safety clothing, safety gloves, data storage devices, sunglasses, spectacles and binoculars, covers, cases and stands for telephones, mobile telephones, computers, laptop computers, tablet computers and personal digital assistants, jewellery, wrist watches, cufflinks, boot and shoe ornaments of precious metal, printed matter and stationery, pens, pencils, writing instruments, leather and imitations of leather, trunks and travelling bags, umbrellas, parasols and walking sticks, luggage, briefcases, travel bags, holdalls, handbags, suitcases, suit carriers, backpacks, rucksacks, wallets, purses, key cases, wash bags, belts, game bags, gun slings and cartridge bags, boot and footwear bags, bags and pouches, bags and pouches adapted to carry boots and shoes, shoe racks, footwear racks, boot racks, wellington boot racks, stands for shoes, footwear, boots and wellington boots, sleeping bags, sleeping bags for camping, sleeping mats, camping mats, chairs, deckchairs, camping chairs, picnic chairs, folding chairs, picnic tables, picnic furniture, picnic hampers, picnic hamper baskets, household or kitchen utensils and containers, combs and sponges, brushes, articles for cleaning purposes, glassware, porcelain and earthenware, hip flasks, flasks, vacuum flasks, cool bags, cool boxes, picnic ware, fitted picnic baskets, picnic boxes, picnic crockery, picnic utensils, cooking utensils for use with barbecues, hand implements for use in barbecue cooking, watering cans, mugs, cups, crockery, oven gloves, oven gauntlets, boot and shoetrees, boot and shoe shapers, boot and shoe scrapers, boot and shoe scrapers incorporating brushes, boot and shoe jacks, boot and shoe horns, boot and shoe brushes, cloths for cleaning boots and shoes, tents, awnings, tarpaulins, textiles and textile goods, bed and table covers, handkerchiefs, travel rugs, blankets, liners for sleeping bags, fabric for boots and shoes, tablecloths, tea towels, towels, picnic rugs, clothing, footwear, headgear, boots, Wellington boots, waterproof boots, waterproof footwear, galoshes, gaiters, waterproof clogs, shoes, shoes of rubber, leather or other materials, sandals, flip-flops, slippers, welts for boots and shoes, non-slipping devices for boots, inner soles, heels and soles for footwear, insoles for boots and shoes, liners for boots and shoes, socks for use with Wellington boots and waterproof boots, socks, hats, top hats, sun visors and caps, headbands, gloves, scarves, garters, waterproof clothing, outer clothing, outerwear, jackets,

coats, overcoats, top coats, raincoats, jerseys, jumpers, knitwear, sweaters, gilets, waistcoats, neck ties, overalls, pyjamas, pants, shirts, blouses, swimsuits, t-shirts, trousers, shorts, culottes, underclothing, underpants and underwear, fishing vests and waistcoats, sports clothing, sports footwear, after-sports footwear, belts and money belts, mats, doormats, matting, rugs, toys, games, playthings, outdoor games, outdoor puzzles, gymnastic and sporting equipment; information, advisory and consultancy services relating to all the aforesaid services.

UK no. 3148584 ("the HUNTER ORIGINAL mark")

HUNTER ORIGINAL

Filing date: 8 February 2016; Date of entry in register: 6 May 2016

Opposing all the goods and services in classes 18, 25 and 35 in the application and relying on all the goods and services for which the mark is registered, namely:

Class 18: *Leather and imitations of leather; trunks and travelling bags; umbrellas, parasols and walking sticks; luggage; briefcases; travel bags; holdalls; handbags; suitcases; suit carriers; backpacks; rucksacks; wallets; purses; key cases; game bags; gun slings and cartridge bags; boot and footwear bags; bags and pouches; bags and pouches adapted to carry boots and shoes.*

Class 25: *Clothing; footwear; headgear; boots; Wellington boots; waterproof boots; waterproof footwear; galoshes; gaiters; waterproof clogs; shoes; shoes of rubber, leather or other materials; sandals; flip-flops; slippers; welts for boots and shoes; non-slipping devices for boots; inner soles; heels and soles for footwear; insoles for boots and shoes; liners for boots and shoes; socks for use with Wellington boots and waterproof boots; socks; hats; top hats; sun visors and caps; headbands; gloves, scarves; garters; waterproof clothing; outer clothing; outerwear; jackets; coats; overcoats; top coats; raincoats; jerseys; jumpers; knitwear; sweaters; gilets; waistcoats; neck ties; overalls; pyjamas; pants; shirts; blouses; swimsuits; t-shirts; trousers; shorts; culottes; underclothing; underpants and underwear; fishing vests and waistcoats; sports clothing; sports footwear; after-sports footwear; belts and money belts; belts (made of leather).*

UK no. 3148587 ("the HUNTER FIELD mark")

HUNTER FIELD

Filing date: 8 February 2016; Date of entry in register: 6 May 2016

Opposing all the goods and services in classes 18, 25 and 35 in the application and relying on all the goods and services for which the mark is registered, namely:

Class 18: *Leather and imitations of leather; trunks and travelling bags; umbrellas, parasols and walking sticks; luggage; briefcases; travel bags; holdalls; handbags; suitcases; suit carriers; backpacks; rucksacks; wallets; purses; key cases; game bags; gun slings and cartridge bags; boot and footwear bags; bags and pouches; bags and pouches adapted to carry boots and shoes.*

Class 25: *Clothing; footwear; headgear; boots; Wellington boots; waterproof boots; waterproof footwear; galoshes; gaiters; waterproof clogs; shoes; shoes of rubber, leather or other materials; sandals; flip-flops; slippers; welts for boots and shoes; non-slipping devices for boots; inner soles; heels and soles for footwear; insoles for boots and shoes; liners for boots and shoes; socks for use with Wellington boots and waterproof boots; socks; hats; top hats; sun visors and caps; headbands; gloves, scarves; garters; waterproof clothing; outerclothing; outerwear; jackets; coats; overcoats; top coats; raincoats; jerseys; jumpers; knitwear; sweaters; gilets; waistcoats; neck ties; overalls; pyjamas; pants; shirts; blouses; swimsuits; t-shirts; trousers; shorts; culottes; underclothing; underpants and underwear; fishing vests and waistcoats; sports clothing; sports footwear; after-sports footwear; belts and money belts; belts (made of leather).*

4. The opponent claims under Section 5(2)(b) that the contested mark is similar to the earlier marks and that the goods and services are identical or similar. It also refers to the marks HUNTER FIELD and HUNTER ORIGINAL creating a family of marks. These factors are said to give rise to a likelihood of confusion.

5. Given their dates of filing, the opponent's marks qualify as earlier marks in accordance with Section 6 of the Act. The HUNTER word-mark had completed its registration procedure more than five years before the date the application was filed and is, as a consequence, subject to the proof of use provisions contained in Section

6A of the Act. As the other marks had not been registered for five years when the application was filed, the opponent may rely upon all of the goods and services identified without showing that the marks have been used.

6. Under Section 5(3) of the Act, the opponent relies upon the same earlier marks relied upon under Section 5(2)(b) and attack (under each of the earlier marks) all of the goods and services in classes 3, 14, 18, 25 and 35. In respect of the HUNTER word-mark, HUNTER ORIGINAL mark and HUNTER FILED mark, the opponent claims reputation for the same goods and services which are relied upon under Section 5(2)(b). However, in respect of the HUNTER logo mark the opponent seems to claim reputation for a more limited specification since it refers to the goods and services listed in a 'continuation sheet'. Insofar the continuation sheet lists the goods and services for which the opponent claims reputation under the HUNTER word-mark, there is a discrepancy because the specification of the HUNTER word-mark is slightly different from that of the HUNTER logo mark (and also more limited). However, nothing turns on this point and I will say no more about it.

7. Under Section 5(3) of the Act, the opponent claims that it enjoys a significant goodwill and reputation in the UK which has been built through extensive use and that its brand has become iconic in the UK in relation to wet weather clothing and footwear in particular. It is said that the opponent's brand features heavily in the media and it is often worn by celebrities and influencers and that use of the contested mark is clearly an attempt to create a connection with the opponent in order to take advantage of the enhanced distinctiveness and reputation of the mark HUNTER. It is said that use of the contested mark in relation to inferior goods or goods which do not conform with the latest trend and popular design would have a significant detrimental effect on the opponent's reputation as a British icon and discourage the relevant public from purchasing the opponent's goods. Lastly, it is asserted that use of the contested sign would be detrimental to the opponent, as it would not only create confusion on the part of the public but also mislead the opponent's legitimate licensee and collaborators into believing that there is an economic connection between the applicant and the opponent causing disputes with current parties or putting off future potential collaborators from working with the opponent.

8. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the HUNTER word-mark.

9. Only the opponent filed evidence during the evidence rounds. The applicant filed written submissions dated 21 December 2020. I shall refer to the evidence and submissions to the extent I consider necessary.

10. In these proceedings, the opponent is represented by HGF Limited and the applicant by Ansons. Neither party requested a hearing, but the opponent filed submissions in lieu. This decision has been taken following a careful consideration of the papers.

11. Although the UK has left the EU, section 6(3)(a) of the European Union (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.

The opponent's evidence

12. The opponent's evidence consists of a witness statement (with 10 exhibits) by Mark Reed dated 25 August 2020. Mr Reed is the opponent's Chief Financial Officer.

13. Mr Reed states that HUNTER was founded in 1856 and it is well known for its iconic boots which were introduced in 1956. Hunter is the owner of two Royal Warrants, by appointment to her Majesty the Queen and His Royal Highness the Duke of Edinburgh as supplier of waterproof footwear.

14. Mr Reed states that *"total sales for all products sold under the HUNTER brand to customers in the UK for the period 2015-2019 have exceeded £48 million"* and provides a breakdown of sales by year:

| Year | Approx. Sales |
|------|---------------|
| 2019 | £11,525,364 |
| 2018 | £10,320,977 |
| 2017 | £9,892,194 |
| 2016 | £9,132,197 |
| 2015 | £7,891,006 |

15. Mr Reed also states that Hunter's goods are sold in the UK via the retail website www.hunterboots.com and a store in London and through third party retailers throughout the UK. He also states that the mark HUNTER features on the product itself or on packaging and provides the following examples:



16. Approximate marketing spend for the period 2015-2019 is £8 million. The breakdown of marketing spend by year is set out below:

| Year | Approx. expenditure |
|-------------|----------------------------|
| 2019 | £2,748,369 |
| 2018 | £2,184,842 |
| 2017 | £1,958,832 |
| 2016 | £1,848,938 |
| 2015 | £3,730 |

17. Mr Reed states that the HUNTER's brand has gained significant recognition by consumers in the UK and globally and regularly features on well-known magazines including Vogue, The Times and Marie Clare. In recent years HUNTER have undertaken a number of collaborations with other well-known brands, such as Disney (2019), Peppa Pig (2019), The National Trust (2017), the BNY Mellon Boat Race (2015) and Harlequin Rugby Club (2018) which, according to Mr Reed, have allowed the brand to become *"even more synonymous with iconic outdoor clothing and accessories"* and to reach a wider audience.

18. The evidence also includes the following exhibits to Mr Reed's witness statement:

- MR1: consists of screenshots confirming the history of the brand HUNTER and the iconic design of HUNTER's wellington boots;
- MR2: consists of screenshots confirming that HUNTER boots received two Royal Warrants;
- MR3: consists of Hunter Boot Limited Annual Report and Financial Statements for 2018. It states that *"the Group's principal activities are the design and distribution of footwear, apparel, bags and accessories under the Hunter brand name"*;
- MR4: consists of a copy HUNTER's trade line lists for 2018. Most of the products shown are boots, but the lists also include articles of footwear, bags, backpacks, umbrellas, keyrings, insoles, coats, jackets, fleeces, socks, gloves, hats, scarves, ponchos;

- MR5: consists of archive screenshots from the website www.hunterboots.com obtained using the Wayback Machine dated on various dates in 2016 and 2017 and displaying items belonging to the same categories as those shown in MR4. The goods are shown to be available for sale and are branded HUNTER;
- MR6: consists of a selection of invoices from 2015 to 2019. The HUNTER logo mark features on the top of the invoices. The goods include items of footwear, as well as items of clothing, including, socks, cardigans, parkas, jackets and fleeces;
- MR7: consists of screenshots about an advertising campaign which it is said was run in 2018 and involved a hot air balloon shaped like the iconic original boot which flew above the UK and a number of locations around the world;
- MR8: consists of a selection of articles showing HUNTER branded goods advertised on UK press, all dated prior to the relevant date. Goods include boots, articles of footwear, bags, backpacks, parkas, waterproof jackets, coats, umbrellas;
- MR9 - 10: consists of a selection of online articles confirming the history, fame and reputation of HUNTER boots and the details of collaborations between HUNTER and other brands.

Proof of use

19. Although the HUNTER word-mark is subject to proof of use, the opponent also relies on the HUNTER logo mark which is not (and the applicant decided not to) subject to proof of use and which is registered for a wider specification in respect of the relevant classes of goods and services (i.e. those which are opposed). The difference between the HUNTER word-mark and the HUNTER logo mark is minimal, consisting in a rectangular background, which is unlikely to make any difference in terms of comparison between the marks. What I mean is that if the opponent were to succeed under the HUNTER word-mark it would also be likely to succeed under the HUNTER logo mark and, that being so, it is unnecessary for me to consider the issue of proof of use in relation to the HUNTER word-mark.

Section 5(2)(b)

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

“A trade mark shall not be registered if because-

[...]

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

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

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

(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

22. The goods and services to be compared are:

| The applicant's goods and services | The opponent's goods and services |
|---|--|
| <p>Class 3: <i>Soaps; perfumery, essential oils, cosmetics, hair lotions, shampoos; non-medicated bath preparations.</i></p> | <p>The HUNTER logo mark Class 3: <i>Cleaning, polishing, scouring and abrasive preparations; shoe, boot and footwear polishes; boot cream, boot wax; shoe cream, shoe wax; cleaning preparations for shoes, boots and footwear; soaps; fragrances, toilet waters and perfumery; essential oils; tea tree oil; cosmetics; non-medicated toilet preparations; sunscreen and sun tanning preparations; air perfuming preparations.</i></p> |
| | <p>The HUNTER logo mark Class 9: <i>Boots (protective footwear); outdoor boots for protection against accident or injury; safety boots for use in industry; clothing for protection against accident or injury; safety clothing; safety gloves; data storage devices; sunglasses; spectacles and binoculars; covers, cases and stands for telephones, mobile telephones, computers, laptop computers, tablet computers and personal digital assistants.</i></p> |
| <p>Class 14: <i>Jewellery and watches; precious metals and their alloys (other than for dental purposes); costume jewellery, precious stones; horological and chronometric instruments</i></p> | <p>The HUNTER logo mark Class 14: <i>Jewellery; wrist watches; cufflinks; boot and shoe ornaments of precious metal; alarm watches, digital watches with automatic timers, drivers'</i></p> |

| | |
|--|---|
| | <p>watches, dress watches, jewellery watches, pendant watches, sports watches, table watches, wristlet watches.</p> |
| <p>Class 18: <i>Leather and imitations of leather, trunks (luggage) and travelling bags; suitcases, rucksacks, wallets, briefcases, purses, key wallets, chequebook holders, handbags for men and women; umbrellas and parasols</i></p> | <p>The HUNTER logo mark, the HUNTER ORIGINAL mark and the HUNTER FIELD mark (identical specifications)</p> <p>Class 18: <i>Leather and imitations of leather; trunks and travelling bags; umbrellas, parasols and walking sticks; luggage; briefcases; travel bags; holdalls; handbags; suitcases; suit carriers; backpacks; rucksacks; wallets; purses; key cases; game bags; gun slings and cartridge bags; boot and footwear bags; bags and pouches; bags and pouches adapted to carry boots and shoes.</i></p> |
| <p>Class 25: <i>Articles of clothing (excluding footwear), headgear</i></p> | <p>The HUNTER word mark, the HUNTER ORIGINAL mark and the HUNTER FIELD mark (identical specifications)</p> <p>Class 25: <i>Clothing; footwear; headgear; boots; Wellington boots; waterproof boots; waterproof footwear; galoshes; gaiters; waterproof clogs; shoes; shoes of rubber, leather or other materials; sandals; flip-flops; slippers; welts for boots and shoes; non-slipping devices for boots; inner soles; heels and soles for footwear; insoles for boots and shoes; liners for boots and shoes; socks for use</i></p> |

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| | <p><i>with Wellington boots and waterproof boots; socks; hats; top hats; sun visors and caps; headbands; gloves, scarves; garters; waterproof clothing; outer clothing; outerwear; jackets; coats; overcoats; top coats; raincoats; jerseys; jumpers; knitwear; sweaters; gilets; waistcoats; neckties; overalls; pyjamas; pants; shirts; blouses; swimsuits; t-shirts; trousers; shorts; culottes; underclothing; underpants and underwear; fishing vests and waistcoats; sports clothing; sports footwear; after-sports footwear; belts and money belts; belts (made of leather).</i></p> |
| <p>Class 35: <i>Retail services, wholesale services and online retail services connected with the sale of soaps, perfumery, essential oils, cosmetics, hair lotions, shampoos, non-medicated bath preparations, hand tools, implements, cutlery, jewellery and watches, precious metals and their alloys, costume jewellery, precious stones, horological and chronometric instruments, paper, cardboard, photographs, printed matter, books and publications, leather and imitations of leather, trunks (luggage) and travelling bags, suitcases, rucksacks, wallets, briefcases, purses, key wallets, cheque book holders, handbags for men and women, umbrellas and parasols, furniture, tables, chairs, sofas, beds, futons, sofa beds,</i></p> | <p>The HUNTER word mark Class 35: <i>Retail, wholesale and on-line retail and wholesale services connected with the sale of cleaning, polishing, scouring and abrasive preparations, shoe, boot and footwear polishes, boot cream, boot wax, shoe cream, shoe wax, cleaning preparations for shoes, boots and footwear, soaps, fragrances, toilet waters and perfumery, essential oils, tea tree oil, cosmetics, non-medicated toilet preparations, sunscreen and sun tanning preparations, air perfuming preparations, boots (protective footwear), outdoor boots for protection against accident or injury, safety boots for use in industry, clothing for protection against accident or injury, safety clothing, safety gloves, data storage devices, sunglasses,</i></p> |

shelving cabinets, shelving, desks, tents, sacks and bags, articles of clothing (excluding footwear), headgear, meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats, non-alcoholic mixed milk beverages (milk predominating), and food prepared from milk, whey, yoghurt, cream and/or cocoa and/or non-alcoholic beverages made therefrom, other non-alcoholic beverages, soup, soup mixes and soup preparations, food products sold in a hamper, salads, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, sandwiches, pretzels, cakes, tarts, pies, biscuits, cookies, muffins, crumpets, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice; rice and rice products, pasta and prepared entrees consisting primarily of pasta, snack foods, fresh fruit and fresh vegetables, non-alcoholic beverages, mineral and aerated waters, fruit drinks and fruit juices, syrups and other preparations for making beverages, beers and other alcoholic beverages.

spectacles and binoculars, covers, cases and stands for telephones, mobile telephones, computers, laptop computers, tablet computers and personal digital assistants, jewellery, wrist watches, cufflinks, boot and shoe ornaments of precious metal, printed matter and stationery, pens, pencils, writing instruments, leather and imitations of leather, trunks and travelling bags, umbrellas, parasols and walking sticks, luggage, briefcases, travel bags, holdalls, handbags, suitcases, suit carriers, backpacks, rucksacks, wallets, purses, key cases, wash bags, belts, game bags, gun slings and cartridge bags, boot and footwear bags, bags and pouches, bags and pouches adapted to carry boots and shoes, shoe racks, footwear racks, boot racks, wellington boot racks, stands for shoes, footwear, boots and wellington boots, sleeping bags, sleeping bags for camping, sleeping mats, camping mats, chairs, deckchairs, camping chairs, picnic chairs, folding chairs, picnic tables, picnic furniture, picnic hampers, picnic hamper baskets, household or kitchen utensils and containers, combs and sponges, brushes, articles for cleaning purposes, glassware, porcelain and earthenware, hip flasks, flasks, vacuum flasks, cool bags, cool boxes, picnic

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| | <p><i>ware, fitted picnic baskets, picnic boxes, picnic crockery, picnic utensils, cooking utensils for use with barbecues, handimplements for use in barbecue cooking, watering cans, mugs, cups, crockery, oven gloves, oven gauntlets, boot and shoetrees, boot and shoe shapers, boot and shoe scrapers, boot and shoe scrapers incorporating brushes, boot and shoe jacks, boot and shoe horns, boot and shoe brushes, cloths for cleaning boots and shoes, tents, awnings, tarpaulins, textiles and textile goods, bed and table covers, handkerchiefs, travel rugs, blankets, liners for sleeping bags, fabric for boots and shoes, tablecloths, tea towels, towels, picnic rugs, clothing, footwear, headgear, boots, Wellington boots, waterproof boots, waterproof footwear, galoshes, gaiters, waterproof clogs, shoes, shoes of rubber, leather or other materials, sandals, flip-flops, slippers, welts for boots and shoes, non-slipping devices for boots, inner soles, heels and soles for footwear, insoles for boots and shoes, liners for boots and shoes, socks for use with Wellington boots and waterproof boots, socks, hats, top hats, sun visors and caps, headbands, gloves, scarves, garters, waterproof clothing, outer clothing, outerwear, jackets, coats, overcoats, top coats, raincoats, jerseys,</i></p> |
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| | <p><i>jumpers, knitwear, sweaters, gilets, waistcoats, neck ties, overalls, pyjamas, pants, shirts, blouses, swimsuits, t-shirts, trousers, shorts, culottes, underclothing, underpants and underwear, fishing vests and waistcoats, sports clothing, sports footwear, after-sports footwear, belts and money belts, mats, doormats, matting, rugs, toys, games, playthings, outdoor games, outdoor puzzles, gymnastic and sporting equipment; information, advisory and consultancy services relating to all the aforesaid services.</i></p> |
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23. 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 of its judgment that:

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

24. 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.

25. 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 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”.

26. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

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

Class 3

27. Soaps; perfumery, essential oils, cosmetics, hair lotions, shampoos; non-medicated bath preparations. The HUNTER logo mark covers a range of goods in class 3. The contested *soaps; perfumery, essential oils, cosmetics* are identically contained in both specifications, whilst the rest of the contested terms, i.e. *hair lotions, shampoos; non-medicated bath preparations*, are encompassed by the broad term *cosmetics* in the opponent's specification. These goods are either self-evidentially identical or identical on the principle outlined in *Meric*.

Class 14

28. Jewellery and watches; precious metals and their alloys (other than for dental purposes); costume jewellery, precious stones; horological and chronometric instruments. The contested *jewellery and watches, costume jewellery* and *horological and chronometric instruments* are identical to the opponent's *jewellery* and to the variety of *watches* covered by the opponent's specification.

29. The contested precious metals and their alloys (other than for dental purposes) and precious stones encompass the opponent's *boot and shoe ornaments of precious metal* and so are identical.

Class 18

30. Leather and imitations of leather, trunks (luggage) and travelling bags; suitcases, rucksacks, wallets, briefcases, purses, key wallets, chequebook holders, handbags for men and women; umbrellas and parasols. Nearly all of the terms in the contested specification in this class are identically contained in the opponent's specification in the same class, the only exception being the term *chequebook holders* which is encompassed by the opponent's *leather and imitations of leather*. These goods are either self-evidentially identical or identical on the principle outlined in *Meric*.

Class 25

31. Articles of clothing (excluding footwear), headgear. As the opponent's specification includes *clothing* and *headgear*, these goods are self-evidently identical.

Class 35

32. Retail services, wholesale services and online retail services connected with the sale of soaps, perfumery, essential oils, cosmetics, hair lotions, shampoos, non-medicated bath preparations, hand tools, implements, cutlery, jewellery and watches, precious metals and their alloys, costume jewellery, precious stones, horological and chronometric instruments, paper, cardboard, photographs, printed matter, books and publications, leather and imitations of leather, trunks (luggage) and travelling bags, suitcases, rucksacks, wallets, briefcases, purses, key wallets, cheque book holders, handbags for men and women, umbrellas and parasols, furniture, tables, chairs, sofas, beds, futons, sofa beds, shelving cabinets, shelving, desks, tents, sacks and bags, articles of clothing (excluding footwear), headgear, meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats, non-alcoholic mixed milk beverages (milk predominating), and food prepared from milk, whey, yoghurt, cream and/or cocoa and/or non-alcoholic beverages made therefrom, other non-alcoholic beverages, soup, soup mixes and soup preparations, food products sold in a hamper, salads, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, sandwiches, pretzels, cakes, tarts, pies, biscuits, cookies, muffins, crumpets, ices, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices, ice; rice and rice products, pasta and prepared entrees consisting primarily of pasta, snack foods, fresh fruit and fresh vegetables, non-alcoholic beverages, mineral and aerated waters, fruit drinks and fruit juices, syrups and other preparations for making beverages, beers and other alcoholic beverages.

Both specifications in class 35 cover retail services-type services associated with various goods. Although some of the goods to which the respective retail services are associated are different, the services in themselves have the same nature and purpose, i.e. retail services, and target the same consumers. The services range from identical (for retail services connected with the sale of identical goods) to similar to a medium degree (for services connected with the sale of non-identical goods).

Average consumer

33. 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.

34. 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.”

35. The average consumer of the competing goods in classes 3, 14, 18, 25 and services in class 35 is a member of the general public.

36. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural element to the purchase, particularly when advice is sought from a sales representative or a purchase is made further to a word-of-mouth recommendation. The goods are neither an infrequent nor a daily purchase. When making a purchase, the average consumer will pay a medium level of attention to ensure that they select the correct product, taking into account various factors. Similar considerations apply to the parties' retail services in class 35.


Comparison of marks

37. 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.”

38. 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.

39. The respective marks are shown below:

| The applicant's mark | The opponent's earlier marks |
|----------------------|--|
| HUNTER-GATHERER |  |
| | HUNTER ORIGINAL |
| | HUNTER FIELD |

40. The applicant's mark consists of the two words HUNTER and GATHERER separated by a hyphen. The overall impression is dominated by the words. Although the hyphen has a weak impact, it contributes to the perception of HUNTER-GATHERER as a composite term.

41. The opponent's HUNTER logo mark consists of the word HUNTER written in bold capital letters and placed within a rectangular background. The word HUNTER has the greatest relative weight, and although the rectangular background is not completely negligible, it is a banal shape and has a minimal impact in the overall impression.

42. The opponent's HUNTER ORIGINAL mark consists of the word HUNTER and ORIGINAL written in standard capital letters. Dictionary.cambridge.org defines HUNTER as a noun meaning "*a person or an animal that hunts animals for food or for sport*". As the word ORIGINAL will be well known to the average consumer as meaning: "*of or relating to an origin or beginning*" or "*fresh and unusual, novel*", it has little distinctive character. The overall impression created by the opponent's mark stems, in my view, from the presence in it of the word HUNTER.

43. The opponent's HUNTER FIELD mark consists of the word HUNTER and FIELD also written in standard capital letters. The overall impression of the mark lies in the combination of these two elements, with neither word dominating.

Visual similarity

HUNTER-GATHERER versus 

44. The applicant denies that the marks are similar and that the addition of the word GATHERER is not sufficient to distinguish between the marks. It states that the marks are visually different and that the word GATHERER is longer than the shared element HUNTER. It also states that the marks are different by virtue of the bold font used in the opponent's mark and the presence of the "visually striking" rectangular background.

45. In my view, the rectangular shape within which the word HUNTER is incorporated has very little distinctiveness and the font and thickness of the letters do not create any visual difference because notional use of the contested mark (which is a word-mark) covers use of that mark in the same font and thickness as that used in the opponent's mark.

46. The marks coincide in respect of the word HUNTER which is the primary element of the opponent's mark and the first element of the contested mark. The marks differ in the rectangular background which appear in the opponent's mark and in the additional element - GATHERER which appear in the contested mark. Even bearing in mind that the beginnings of marks are more focused upon than their endings, the word GATHERER is the longest element in the contested mark. I consider these marks to be visually similar to a medium degree.

HUNTER-GATHERER versus HUNTER ORIGINAL

47. Here the marks share the first word HUNTER but both marks contain a second word which is completely different, i.e. -GATHERER and ORIGINAL. Although the word ORIGINAL has little distinctiveness, it has a visual impact. I consider these marks to be also similar to a medium degree.

HUNTER-GATHERER versus HUNTER FIELD

48. Although the word FIELD in the opponent's mark is more distinctive than the word ORIGINAL, it is also shorter. I do not think that the difference between ORIGINAL and FIELD materially alter the degree of visual similarity between the marks, which I also consider to be medium.

Aural similarity

49. Similar considerations to those outlined under the assessment of the visual similarity apply to the aural comparison of the marks, the only difference being that the hyphen in the applicant's mark and the square background in the opponent's HUNTER logo mark will not be spoken – which, again, does not materially increase (or decrease)

the similarity between the marks. The marks are also aurally similar to a medium degree.

Conceptual similarity

50. The applicant argues that the word HUNTER in the opponent's mark will be perceived as a surname and that the contested mark conveys an association with the original nomads of pre-history, namely the hunters and gatherers who would survive by engaging in those two methods of obtaining food, namely hunting and gathering. The applicant also argues that the inclusion of the words ORIGINAL and FIELD in the opponent's marks will be seen as implying the original version of a product sold by the opponent and a version of a product which is used outdoors or in the field, respectively.

51. Collinsdictionary.com contains a definition of "hunter-gatherer" as follows:

"Hunter-gatherers were people who lived by hunting and collecting food rather than by farming. There are still groups of hunter-gatherers living in some parts of the world".

52. The composite term HUNTER-GATHERER has therefore a particular conceptual significance as it refers to early humans (or people still living like early humans). The opponent states that consumers are unlikely to notice the hyphen and will read the sign as HUNTER GATHERER. It is not clear what is the point the opponent is trying to make, but I think what it is saying is that because the hyphen will go unnoticed, consumers will not read HUNTER-GATHERER as a composite term but will see HUNTER and GATHERER as two separate words. Although the hyphen is smaller than the letters, it is perfectly visible, and I do not accept the argument that the average consumer will disregard it. Further, I am not aware of any case-law which establishes that, as a matter of principle, hyphens or other symbols will always be immaterial.

53. Although there is no evidence that the term HUNTER-GATHERER is well-known, the opponent conceded in its submissions in lieu that *"the definition of 'Hunter Gatherer' is well known to the general public in the United Kingdom as referring to people who hunt and collect wild food"* and argued that *"the addition of the word*

‘GATHERER’ to the [mark] merely confirms a conceptual meaning which is identical or at least highly similar to HUNTER alone”.

54. Though I agree with the applicant (and the opponent has accepted) that the specific meaning of HUNTER-GATHERER will be understood by the public, in the absence of evidence as to how common the surname HUNTER is in the UK, I have to proceed with caution. Whilst I accept that some consumers might identify HUNTER as a surname, I think that most people will see it as a dictionary word. On this basis, there is only a limited (low) degree of conceptual similarity between the significance the public will attribute to the composite term HUNTER-GATHERER and the significance the same public will attribute to the single term HUNTER. The first is very specific as it refers to early humans (or humans) living by hunting and foraging (rather than by agriculture and animal husbandry), whilst the second is much more general as it refers to a person or an animal who hunts. For those consumers who see the word HUNT as a surname, the marks are conceptually different.

55. The same goes for the HUNTER ORIGINAL mark, given that the concept introduced by the word ORIGINAL has little distinctiveness.

56. As regards the HUNTER FIELD mark, it can be read in two ways: the words HUNTER and FIELD could be seen as either a unit referencing to an area of grass or a region of space used for hunting or a reference to the field of activities of the brand HUNTER. In the first scenario, the word FIELD is distinctive and introduces an additional concept reducing the level of conceptual similarity from low to very low; in the second scenario, the term FIELD is seen as subordinate to the brand name (and less distinctive) and, for similar reasons to those outlined above, the degree of conceptual similarity is still low.

Distinctive character of earlier mark

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

58. The words HUNTER, HUNTER ORIGINAL and HUNTER FIELD are ordinary dictionary words. The marks are neither descriptive nor allusive of the goods and services for which they are registered and are inherently distinctive to a medium degree.

59. The opponent evidence establishes that HUNTER is an established British brand and that the company has an historical heritage - it was commissioned to design boots suitable for protecting soldiers during the two World Wars and has received two Royal Warrants, one in 1977 and one in 1986. The original green wellington, which is now the symbol of the brand HUNTER, was launched in 1939 and members of the Royal Family and celebrities have been photographed wearing them. The brand HUNTER has worked in collaboration with other big brands and fashion designers and has generated a turnover of nearly £50 million in the period 2015-2019 with a promotional spend of over £8 million for the same period. Examples have been provided of the

mark HUNTER being used on products, packaging, invoices and advertising material; the mark mostly appears written in bold capitals within a black or coloured rectangular background.

60. In its submission, the applicant conceded that the evidence shows that the opponent has a reputation in its HUNTER logo mark but argues that the evidence does not show any use of the other marks, i.e. HUNTER ORIGINAL and HUNTER FIELD



marks. Although there are few examples of 1) use of the marks and



on trade line lists; 2) use of the words FIELD and ORIGINAL in the description of the products on invoices and 3) use of the words HUNTERORIGINAL in connection with a promotional campaign, the evidence is very vague (as there is no indication of circulation figures, intensity of use or geographical spread) and is far from establishing that the distinctiveness of the marks HUNTER ORIGINAL and HUNTER FIELD has been enhanced through use. Consequently, I agree with the applicant that the evidence is not sufficient to demonstrate that the distinctiveness of the marks HUNTER ORIGINAL and HUNTER FIELD has been enhanced through use.

61. As regards the position in relation to the HUNTER logo mark, although the sale figures are not broken down and are said to relate to all products sold under the HUNTER brand, it is clear that the core products in relation to which the opponent has developed its extensive reputation are wellington boots and items of footwear. My finding is therefore that the distinctiveness of the HUNTER logo mark has been enhanced through use to a high degree, but only in relation to wellington boots and footwear.

Likelihood of confusion

62. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

63. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where 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.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

64. Earlier in this decision I found that the goods and services range from identical to similar to a medium degree. The respective marks are visually and aurally similar to a medium degree and conceptually similar to (at best) a medium degree. The goods and services will be purchased primarily by visual means with an average degree of attention. The distinctive character of the opponent’s HUNTER logo mark has been enhanced to a high degree in relation to wellington boots and footwear.

65. Even factoring in imperfect recollection, the element -GATHERER in the contested mark will not go unnoticed by the average consumer (who is reasonably circumspect and observant) and the differences between the contested mark and the opponent’s earlier marks are such that the relevant public is unlikely to directly mistake the marks. **There is no likelihood of direct confusion.**

66. As regards indirect confusion, I bear in mind that the word HUNTER is not fanciful or invented and that none of the goods or services in the contested specification are identical to the core products in the context of which the opponent’s HUNTER logo mark is well-known and has acquired an enhanced degree of distinctive character, i.e. wellington boots and footwear. Further, and most significantly, the conceptual differences between the marks are such that it is in my view fanciful to think that the average consumer would, confronted with the HUNTER-GATHERER mark, perceive it as a kind of brand extension of the opponent’s HUNTER logo mark or assume that the users of the marks are economically connected. **There is no likelihood of indirect confusion.**

67. As I have mentioned above, I would have also reached the same conclusion (on both direct and indirect confusion) on the basis of the HUNTER word-mark.

Family of marks argument

68. As regards the opponent's claim to confusion being more likely on account of a family of marks, an essential element for a family of marks to be established is that they have been in use. The essence of the argument for a family marks is that the public will see a common element as indicating a particular origin. If the marks are not in use the public cannot make any such connection. For a family of marks to be considered in relation to these proceedings the opponent has to substantiate use at the relevant date - 24 June 2019.

69. The opponent has given no turnover figures in relation to the HUNTER ORIGINAL and the HUNTER FIELD marks and I do not consider that use of the words ORIGINAL and FIELD in the description of some of the goods listed on the invoices is use of the




marks as registered. Further, I am not prepared to accept that use of



and on a number of trade line lists is sufficient to establish the existence of these marks in the marketplace, in the absence of any explanation as to the context in which those documents are used (for example, it is not clear whether the trade line lists are internal documents or whether they are used by the opponent in dealing with traders or end-consumers). Finally, even if I were to accept that use of the words 'HunterOriginal' as shown on the flying wellington boots is sufficient to establish use of the HUNTER ORIGINAL mark in the marketplace, it would not be enough to establish a sufficient number of marks capable of constituting a family or a series of marks.² But, even if I am wrong on this, the only example of use of the mark

² *Il Ponte Finanziaria SpA v OHIM* Case C234/06



HUNTER FIELD is in the form of  which would reinforce the perception of HUNTER as a house mark and FIELD as a descriptive element.

70. My primary finding is therefore that the opponent has not established the existence of a family of marks. Alternatively, my secondary finding is that if the opponent has established the existence of a family of marks, the marks the average consumer would be familiar with fall squarely within the type of sub-brand or brand-extension which adds a non-distinctive element to main brand, which would not improve the likelihood of confusion with the contested mark. This is because contrary to the opponent's other marks, the contested mark is a composite term that brings in a new distinctive concept.

71. The opposition based on Section 5(2)(b) fails.

Section 5(3)

72. Section 5(3) states:

“(3) A trade mark which-

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

73. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

74. 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* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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 Salomon*, 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* and *Environmental Manufacturing, paragraph 34*.

(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*).

75. The relevant date for the assessment under Section 5(3) is the date of the application, namely 24 June 2019.

Reputation

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

“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.”

77. For similar reasons to those outlined at paragraphs 56-59, I find that the opponent’s HUNTER logo mark had, at the relevant date, the necessary reputation in relation to wellington boots and footwear.

Link

78. As I noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks. I found the earlier HUNTER logo mark and the contested mark to be visually and aurally similar to a medium degree and conceptually similar to (at best) a low degree.

The nature of the goods or services for which the conflicting 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. I found the contested goods and services to range from identical to similar to a medium degree. Although the contested goods in class 25 are similar to a medium degree to the goods for which the opponent has a reputation, i.e. wellington boots and footwear, the contested specification explicitly excludes footwear.

The strength of the earlier mark's reputation. The earlier HUNTER logo mark has a strong reputation for wellington boots and footwear.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use. I found the HUNTER logo mark to be inherently distinctive to a medium degree, with the distinctiveness of the mark being enhanced to high in respect of wellington boots and footwear.

Whether there is a likelihood of confusion. I found that there is no likelihood of confusion.

79. Overall, my finding is that the conceptual difference between the marks is such that, even in combination with the other factors mentioned above, is insufficient to cause the relevant public to link the applicant's mark with the HUNTER mark (being it the logo mark or the plain word-mark). Consumers will see HUNTER-GATHERER as a composite term and are very unlikely to be reminded of the HUNTER mark, especially if one considers that the contested specification do not cover the goods for which the opponent has a reputation. If a link were made it would be so fleeting as to be incapable of leading to any damage.

80. The opposition based on Section 5(3) fails.

Overall outcome

81. The opposition fails in its entirety and the contested application may proceed to registration.

Costs

82. The applicant having been successful, is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. I assess this as follows:

| | |
|---|------|
| Filing a counterstatement and considering a notice of opposition: | £250 |
| Filing submissions and considering the opponent's evidence: | £500 |
| Total: | £750 |

83. I therefore order Hunter Boot Limited to pay HUNTER-GATHERER LIMITED the sum of £750. This sum to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of any appeal proceedings.

Dated this 12th day of July 2021

T Perks

**For the Registrar,
the Comptroller-General**