

O/632/22

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL

REGISTRATION 1587104

IN THE NAME OF SONDORS LIMITED

ROCKSTAR

AS A TRADE MARK IN CLASS 12

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 425607 BY

SCOTT SPORTS SA

BACKGROUND AND PLEADINGS

1. Sondors Limited (“the holder”) is the holder of the international registration shown on the cover page of this decision (“the IR”). The IR was registered on 9 March 2021. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The priority date for the IR is 15 September 2020. The holder seeks protection for the following goods:

Class 12: *Bicycles; electric bicycles.*

2. The IR was published for opposition purposes on 25 June 2021 and, on 16 July 2021, it was opposed by Scott Sports SA (“the opponent”). The opponent relies upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition was directed at all the goods in the IR’s specification. The opponent relies on the following mark:

ROXTER

Registration no. UK00912574083

Registration date 7 February 2014; date entered in the register 18 June 2014.

Relying on all the goods, namely:

Class 12: *Bicycles, bicycle parts and accessories, in particular frames, saddles, seats, mudguards, gearshifts, chains, forks and suspensions for bicycles, bicycle wheels, rims, spokes and tyres, including tubes and tyre systems similar to tubes, luggage carriers for bicycles, bicycle stands, bicycle protectors, air pumps and bottle cages for bicycles; Bicycle racks for vehicles; Child carrying trailers; Electric bicycles; Bags for bicycles; Saddlebags adapted for bicycles.*

3. The opponent submits that there is a likelihood of confusion because the marks are similar and the respective goods are either identical or similar. The holder filed a counterstatement denying the claim and, in doing so, requested that the opponent provide proof of use for its mark. However, I note that within its counterstatement, the applicant did accept that there is an overlap of the letters at the beginning and end of both marks but that is the extent of any similarity between the marks. Further, the

holder admitted that the respective specifications both cover bicycles and electric bicycles but that all of the other goods are different.

4. The holder is represented by Tomkins & Co; the opponent is represented by Mitchiners. No hearing was requested. Only the opponent filed evidence in chief and evidence in reply. The holder filed written submissions during the evidence round. Both parties filed written submissions in lieu of a hearing. This decision is taken following a careful reading of all the papers.

5. 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 Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Evidence

6. As set out above, only the opponent filed evidence in chief and evidence in reply. The opponent filed evidence in the form of the witness statements of Dave Rainsford dated 26 November 2021 and 24 March 2022. Mr Rainsford is the General Manager of Scott Sports, a position he has held for five and a half years. Mr Rainsford's statement sets out that the opponent markets the products under the ROXTER brand in the United Kingdom. His statements are accompanied by 23 exhibits and 2 exhibits respectively.

7. I do not propose to summarise the evidence or the parties' submissions in full at this stage. However, I have taken them all into consideration in reaching my decision and will refer to them below, where necessary.

Proof of use

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. As above, the holder sought to put the opponent to proof of use of its mark because the earlier mark is older than five years from the priority date of the IR. Therefore, it is subject to proof of use pursuant to section 6A of the Act.

10. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A-(1) This section applies where –

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form (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 Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.”

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

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

12. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

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

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use:

Ansul at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

13. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s mark is the five year period ending with the priority date of the IR i.e. 16 September 2015 to 15 September 2020.

14. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”¹ because the use would not be “viewed as warranted in the economic section concerned to maintain or create a share in the mark for the goods and services provided by the mark”² is, therefore, not genuine use.

15. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use. [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if,

¹ Jumpman BL O/222/16

² *Ibid*

notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

16. I also note Mr Alexander Q.C.’s comments in *Guccio Gucci SpA v Gerry Weber International AG*, Case BL O/424/14. He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”” [original emphasis]

17. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to

be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

Form of the mark

18. In *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, the Court of Justice of the European Union (“CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its

independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

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

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

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

19. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

20. The opponent's mark is 'ROXTER'. The mark has been used as registered throughout the evidence. In addition, the opponent also used the mark in the following ways:

e- ROXTER
(Example 1)

ROXTAR/Roxtar
(Example 2)

21. Example 1 is shown in a standard font and presented as displayed above. As per the case of *Colloseum* (cited above), use of a mark generally encompasses both its independent use and its use as part of another mark as a whole or in conjunction with that other mark. In my view, the addition of the letter 'e' before the mark will be perceived by the average consumer as being an indicator of something being electric/electronic. Despite this, I consider that the 'ROXTER' element will be perceived independently and continue to be viewed as indicative of the origin of the goods at issue. The word 'ROXTER' remains the primary indication of the origin of the goods, as a result, in accordance with *Colloseum*, I consider this example to be use of the opponent's mark as registered.

22. I turn now to consider example 2. The opponent's mark consists of the word 'ROXTER' presented in capital letters and standard black font. It is my view that the distinctive character of the opponent's mark lies in the word 'ROXTER' as a whole. It is my view that the alteration to the mark shown in example 2 above changes the word entirely and affects the visual, aural and conceptual impressions and, therefore, alters the distinctive character of the mark completely. As per *Lactalis McLelland Limited*, this is not an acceptable variant of the opponent's mark.

Genuine use

23. I note that in its defence and counterstatement, the holder states that it does not consider the evidence to show use of the mark in relation to the goods relied upon. 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.³

³ *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

24. The opponent has provided evidence of invoices, website print outs, turnover figures and workbooks. I note the following in regard to the evidence:

- a. Extracts from the opponent's 2017, 2018, 2019 and 2020 workbooks of mechanical bicycles and electric bicycles which, the opponent states, are used to market the opponent's goods. The extracts display use of the opponent's mark throughout.⁴ The workbooks display the Bergamont brand. Mr Rainsford explains in his witness statement that the 'ROXTER' trade mark was part of the business of Bergamont Fahrrad Vertrieb GmbH ("Bergamont) and in June 2015 the opponent purchased the shares and assets of Bergamont. I note this was not opposed by the holder. Bearing this in mind, I am content to accept that use demonstrated by Bergamont can be relied upon by the opponent in these proceedings.
- b. Print outs from the opponent's website displaying mechanical and electric bicycles that display the opponent's mark throughout.⁵
- c. A print out from the opponent's website which demonstrates that 40 stores within 50 miles of London sell its bicycle products.⁶
- d. 37 invoices that pertain to the sale of mechanical and electric bicycles. The invoices display the opponent's mark throughout.⁷ The invoices are dated between 22 November 2016 and 30 October 2020. I note that the latter date falls outside the relevant period.

25. As set above, the evidence contains a number of sample invoices. The addresses on the invoices are partially redacted, however, it can be identified the invoices were for the sale of goods to customers in Yorkshire, Barnsley, Birmingham, Staffordshire, Merseyside, Lincolnshire, Kent, Glamorgan, Inverness-Shire, Leicestershire, Monmouthshire, Middlesbrough, Lancashire, Oxfordshire, Berkshire and Merthyr Tydfil. The witness statement of Mr Rainsford indicates that the sale of both mechanical and electric bicycles is demonstrated by the invoices. In cross referencing the workbooks to the invoices, I can identify that the goods covered by

⁴ Exhibits 9 – 14 of the witness statement of Dave Rainsford

⁵ Exhibit 7 of the witness statement of Dave Rainsford

⁶ Exhibit 8 of the witness statement of Dave Rainsford

⁷ Exhibits 14A – 23 of the witness statement of Dave Rainsford

the invoices show the sale of mechanical and electric bicycles all bearing the opponent's mark.

26. The opponent has also provided evidence regarding its turnover. Mr Rainsford states that the turnover figures of £35,885 in 2016 and £132,385 in 2017 are turnover figures for the mark 'ROXTAR' which was used by Bergamont. Further, he states that this is demonstrated by the sample invoices in exhibits 5A and 5B. Whilst the invoices provided in exhibits 5A and 5B support the sale of bicycles under the mark 'ROXTAR', as discussed above in paragraph ##, this is not an acceptable variant of the mark that the opponent can rely on as evidence of use. Despite this, exhibit 5B in the invoice dated 12 September 2017 references "Bike Roxter 2.0" in relation to the sale of 7 bicycles for the total amount of £1,160.36. While it may be possible to take from this that a proportion of the turnover figures can be attributed to the "ROXTER" brand, I have no breakdown to indicate the level of sales that relate to "ROXTER" branded goods or how these goods are broken down. As a result, it is not possible for me to make an assessment of the level of turnover that is attributable to 'ROXTER' branded goods beyond those included in the invoice at exhibit 5B.

27. I note that the opponent has not provided any other annual turnover figures other than those mentioned above in 2016 and 2017. The opponent did provide 37 invoices but no summary of the invoices was provided. Despite this, I have calculated that the relevant invoices demonstrate evidence of sales in the UK of 77 units for a total of £30,472.42 over the entirety of the relevant period in relation to the opponent's mark. I relied upon the net figure on the invoices in making this calculation, as it is unclear what 'price/disc' means on the opponent's invoices.

28. The opponent submits that its workbooks are evidence of marketing. While I accept the workbooks to be of assistance in determining what goods have been sold, other than stating that about 350 workbooks are created each season, the opponent has provided no indication to demonstrate how widely the workbooks reach consumers or how the workbooks are distributed. I also note that the invoices and workbooks bearing the unacceptable variant 'ROXTAR' cannot be relied upon in these proceedings. As a result, I do not consider it to be valid evidence of marketing. Further, I note that no further evidence of marketing or advertising has been provided.

29. Although I do not have any evidence or submissions from either party to assist me on the matter of the size of the UK market for the goods concerned, I believe the market to be substantial, numbering in billions of pounds per annum. In my view, when compared to the size of the relevant market, the total sales figures of £30,472.42 is very low. While the case law (cited above) states that use of a mark need not always be quantitatively significant for it to be deemed genuine, it does set out that the use must be justified in the economic sector concerned for the purpose of creating or preserving a market share in the goods at issue. It does not follow that every proven commercial use of a mark is automatically deemed genuine.

30. I appreciate that the evidence has demonstrated sales of the opponent's goods to various customers throughout the UK who are distant from one another, which is in the opponent's favour. However, as noted above genuine use requires a global assessment of the evidence as a whole. Whilst the use of the mark is geographically widespread across the UK, the scale and frequency of the use, namely 77 products over 5 years, is far from intensive. I have formed this view with the consideration of the size of the market, being billions of pounds per annum, and in light of the nature of the goods at issue. I note that the 77 products sold are bicycles, electric bicycles and bicycle forks; the cost of each good ranges from £43.32 to £1,570.29. The low sales figures may be indicative of genuine use for goods that are more specialist in nature, however, I do not consider this to be the case in the context of the nature of the goods at issue, being bicycles and e-bicycles. I also note that there is a lack of evidence in relation to marketing and advertising evidence and its distribution. Taking all the above evidence into account, I am of the view that it is not clear that the opponent has attempted to create and maintain a market for the goods under its mark. Therefore, I am not satisfied that the opponent has demonstrated genuine use of its mark during the relevant period.

31. As it is my view that there is no genuine use of the mark as registered, the opposition fails. However, even if I am wrong to make such a finding and the opponent was able to provide proof that it put its mark to genuine use for those goods included in its evidence (namely "*bicycles*", "*electric bicycles*" and "*bicycle parts and accessories, in particular forks*"), the opposition would have failed in any event. My reasons follow.

Section 5(2)(b): legislation and case law

32. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

33. 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 impression created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of the goods

34. The goods to be compared are as follows:

Holder's goods	Opponent's goods
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<u>Class 12</u> <i>Bicycles; electric bicycles.</i>	<u>Class 12</u> <i>Bicycles; electric bicycles; bicycle parts and accessories, in particular forks.</i>
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35. I note that the holder, in its defence and counterstatement, admits that both marks cover bicycles and electric bicycles. I accept this admission and find the goods at issue to be identical.

The average consumer and the purchasing process

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

37. The average consumer for the goods at issue will be a member of the general public. The goods at issue are likely to be purchased visually from the in store displays of a retail shop (or its online equivalent), catalogues, websites or the premises of a specialist. I do not discount aural considerations in the form of, for example, advice received from a sales assistant or word-of-mouth recommendations.

38. The cost of the goods can vary from moderate to expensive and the goods will be purchased infrequently. In my view, the amount of care when purchasing the goods will vary in relation to the sum of money being spent on the goods. Generally, the level of attention for the average consumer who purchases bikes for recreational purposes

to improve fitness or as a mode of transportation will be medium. However, for members of the general public with a particular interest in biking, the level of attention may extend to high (but not the highest). It is my view that, regardless of the degree of attention, the average consumer will consider factors such as size, fitness for purpose (for example mountain or road bicycles), features and durability when selecting the goods.

Comparison of the marks

39. The respective trade marks are shown below:

ROCKSTAR	ROXTER
The IR	The opponent's mark

40. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural, and conceptual similarities of trade marks must be assessed by reference to all the overall impressions created by the trade 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.”

41. 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.

42. The opponent's mark is a word only mark that consists of the text 'ROXTER'. There are no other elements that contribute to the overall impression of the mark. The IR is a slightly stylised word mark that consists of the text 'ROCKSTAR'. Despite the typeface on the IR being slightly stylised, it is still a standard typeface. I consider the text 'ROCKSTAR' to have a greater impact on the overall impression of the mark, with the stylisation playing a negligible role.

43. Visually, the holder accepts in its defence and counterstatement that there is an overlap of letters at the beginning and end of the marks. However, the holder submits that is the extent of any similarity between the marks. The marks are made up of 8 and 6 letters respectively, of which they share the letters R, O, T and R and their placement in both marks. However, the marks differ in that the penultimate letter 'E' in the opponent's mark is in place of the letter 'A' in the IR and vice versa. Further, I note that following the RO in both marks there are different letters towards the middle of the marks; the IR is followed by the letters 'CKS' and the opponent's mark is followed by an 'X'. Bearing the above in mind, overall, I consider the marks to be visually similar to a higher than medium degree.

44. Aurally, the opponent mark will be pronounced ROK-STUR and the IR will be pronounced ROK-STAR. Both marks have two syllables. The first syllables of the marks are identical. Whilst the suffixes of the marks differ slightly, overall, I find the marks to be aurally similar to a high degree.

45. Conceptually, ROCKSTAR will be perceived as a combination of two ordinary dictionary words, being ROCK and STAR. When used in combination, it will be given its ordinary meaning of a successful/famous rock musician. The opponent submits in its submissions in lieu that the word ROXTER alludes to a person being an individualistic and independent thinker. I disagree, in my view, ROXTER will be perceived as being a made up word that will not convey any obvious conceptual meaning to the average consumer. As a result, the conceptual position is dissimilar.

The distinctive character of the opponent's mark

46. 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 1-2779, paragraph 49).

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

47. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

48. The opponent has pleaded that its mark has acquired enhanced distinctive character through use as it has operated in the same market over a number of years and is recognisable by the public as a badge of origin. I have considered the evidence in support of a claim of enhanced distinctiveness and do not consider the evidence is sufficient to demonstrate such a claim in regard to the opponent’s mark in the UK. Enhanced distinctiveness must be established in relation to the UK market because the test for confusion will be assessed by reference to the average consumer who is a member of the UK general public. Whilst I note that evidence has been provided by the opponent indicating that there are 40 stores that sell their goods within a 50 mile

radius of London⁸ and of credit accounts with the opponent created for customers⁹; no evidence has been provided indicating the proportion of the relevant class of people who identify the goods as originating from the opponent's undertaking. Further, I note that the credit account evidence has no reference to the opponent's mark or its goods. There is also no evidence of the market share of the opponent's mark and neither is there evidence of marketing or advertising expenditure to support such a claim. The opponent's evidence does not point to its mark having acquired any enhanced distinctiveness in the UK through use. I have, therefore, only the inherent position to consider.

49. The opponent submits that the mark is inherently distinctive but does not comment on the degree of distinctiveness it assigns to the mark. To my mind, the average consumer will perceive the word 'ROXTER' as an invented term. For the average consumer, the mark would be neither descriptive nor allusive in relation to the goods at issue. Taking the above into account, I find the mark enjoys a high degree of inherent distinctive character.

Likelihood of confusion

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. 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 trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

⁸ Exhibit 8 of the witness statement of Dave Rainsford

⁹ *Ibid* exhibit 24

51. I have found the marks to be visually similar to a higher than medium degree, aurally similar to a high degree and conceptually dissimilar. I have found the opponent's mark to be inherently distinctive to a high degree. I have found the average consumer to be a member of the general public, who will purchase the goods at issue via visual means (although I do not discount an aural component). I have concluded that the average consumer's degree of attention will vary from a medium to a high degree (but not the highest) when selecting the goods at issue. I have found the goods to be identical.

52. Taking all of the above into account and even considering the principle of imperfect recollection, I do not consider that the average consumer will mistake one mark for the other. While there are similarities between the marks, the level of visual and aural similarities are not so high to the point where the average consumer would overlook them and mistakenly recall or misremember the marks. This is particularly the case considering the difference in an overall conceptual hook that may be created by the conceptual impressions of the marks, as the IR carries a clear meaning that will be grasped immediately by the average consumer. As for the opponent's mark, it is my view that the mark will be perceived as having no obvious meaning. Consequently, I consider that there is no likelihood of direct confusion between the marks, even considering that I have found the goods to be identical. I make this finding taking into account that the average consumer's level of attention will vary from medium to high (but not the highest) when purchasing the goods.

53. It now falls to me to consider whether there is a likelihood of indirect confusion. Indirect confusion involves recognition by the average consumer of the difference between the marks. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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 recognised 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).”

54. Whilst I note that the examples set out by Mr Purvis are not exhaustive, I note the recent case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,¹⁰ wherein Arnold LJ referred to the comments of James Mellor QC sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he stated that a finding of a likelihood of indirect confusion is not a consolidation prize and that there needs to be a reasonably special set of circumstances in order to get indirect confusion where there is no likelihood of direct confusion. Arnold LJ agreed, pointing out that

¹⁰ [2021] EWCA Civ 1207

there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

55. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. This is on the basis that it is not sufficient that a mark merely calls to mind another mark;¹¹ this is mere association and not indirect confusion. I bear in mind that I must consider the level of distinctiveness in the earlier mark as a whole as well as the distinctiveness of the common element. This is because in assessing the likelihood of confusion it is not enough to simply consider the level of the distinctive character possessed by the earlier mark; it is also important to consider ‘in what part of the earlier mark does the distinctive character lie?’.

56. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically. 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.”

57. While I have found that ‘ROXTER’ enjoys a high degree of inherent distinctive character, being a factor in the opponent’s favour, this does not automatically give rise to a finding of indirect confusion between the marks. The distinctive character of the opponent’s mark lies in the entirety of the word ‘ROXTER’ as a whole and not in the shared letters ‘R,O,T and R’ and their shared positioning in the marks. I am of the view

¹¹ *Duebros Limited v Hierler Cenovis GmbH*, BL O/547/17

that while there are similarities between the marks, any similarity that average consumers are able to identify from the shared elements will be considered to be purely coincidental and no more than bringing to the mind the other parties' mark, in a situation as envisaged by Mr James Mellor QC in *Duebros* (cited above). It is not my view that the average consumer will be of the view that a provider using the letters R, O, T and R in relation to bicycles combined with other letters would be connected to the same or related undertaking. This is particularly the case given the conceptual hook of the IR which carries a clear and specific meaning that will be grasped immediately by average consumers. As for the opponent's mark, it has no obvious meaning and it is my view that the conceptual differences observed between the marks will counteract any visual/aural similarities between them.¹² When confronted with both marks, I do not consider that there is any basis for the average consumer to believe that an undertaking ROXTER would rebrand itself as or create the sub-brand or a brand extension of ROCKSTAR or vice versa. I make this finding particularly taking into account that the average consumer will pay between a medium to high (but not the highest) degree of attention during the purchasing process of the goods. Whilst the *L.A Sugar* examples cited above are not exhaustive of a finding of indirect confusion; I am unable to identify any obvious circumstance where a finding of indirect confusion may occur. Bearing all of the above in mind, I do not consider there to be a likelihood of indirect confusion between the marks. This is the case in the context of the identical goods.

Conclusion

58. The opposition has failed. As a result, the IR may proceed to protection in the UK for all goods.

Costs

59. The holder has been successful and is entitled to a contribution towards its costs based on the scale published in Tribunal Practice Note 2/2016. In the circumstances, I award the holder the sum of £200 as a contribution towards its costs. The sum is calculated as follows:

¹² *The Picasso Estate v OHIM*, Case C-361/04 P

Preparing a counterstatement and considering the opponent's statement	£200
Total	£200

60. I, therefore, order Scotts Sports SA to pay Sondors Limited the sum of £200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 26th day of July 2022

A Klass

For the registrar