

O/0262/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION NO. UK00003700544
BY SANDERSON DESIGN GROUP BRANDS LIMITED
TO REGISTER:**

SANDERSON

**AS A TRADE MARK
IN CLASSES 3, 4, 5 & 25**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 432234
BY ANDERSON'S S.R.L.**

BACKGROUND AND PLEADINGS

1. On 24 September 2021, Sanderson Design Group Brands Limited (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods:¹

Class 3: Cosmetics; toiletries; Sanitary preparations being toiletries; hand cream; cosmetic hand cream; skin lotions; hand lotions; body lotions; skin cleansing lotion; soap; hand soap; shower soap; bath soap; body soap; bar soap; hand washes; body wash; bath and shower gel; reed diffusers; air fragrance reed diffusers; none of the aforesaid goods relating to oral healthcare.

Class 4: Candles and wicks for lighting; candles; candle wax; perfumed candles; scented candles; fragranced candles; table candles; tea light candles.

Class 5: Sanitary preparations and articles; Hand sanitiser; antibacterial hand sanitiser; alcohol-based antibacterial skin sanitiser gels.

Class 25: Clothing; not including belts; footwear; headgear; nightwear; sleep masks; eye masks.

2. By virtue of being a trade mark applied for in accordance of Article 59 of the Withdrawal Agreement between the UK and the European Union,² the applicant’s mark is deemed to have the same filing date and date of priority as the corresponding EUTM. In the present case, I note that the corresponding EUTM has a filing date of 5 October 2020.

¹ The applicant’s specification was amended by way of a Form TM21B dated 10 May 2022. The Tribunal subsequently wrote to the opponent requesting confirmation as to whether it wished to withdraw its opposition in light of the amended specification. No response was received and, in the absence of such, the opposition was deemed to be maintained.

² Article 59 of the Withdrawal Agreement between the UK and the European Union allowed for owners of pending EUTMs as at 31 December 2020 (“IP Completion Day”) to file a corresponding mark in the EU within nine months of IP Completion Day and, in doing so, they retain the priority date of the earlier EUTM.

3. The applicant's mark was published for opposition purposes on 28 January 2022 and, on 28 March 2022, it was opposed by ANDERSON'S S.R.L. ("the opponent"). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").
4. Under both grounds, the opponent relies on the following mark:

ANDERSON'S

UK registration no: 900691808³

Filing date 1 December 1997; registration date 26 April 1999

Priority date 24 October 1997

Relying on all goods, namely:

Class 18: Manufactured goods of leather, hemp, elastic and the like such as bags, handbags, travelling bags, pocket wallets.

Class 25: Manufactured goods of leather, hemp, elastic and the like such as belts, shoes, slippers, braces, garters.

5. The opposition is targeted at the applicant's class 25 goods only. Under its 5(2)(b) ground, the opponent claims that, due to the similarities between the marks and the identity of the goods at issue, there exists an unavoidable likelihood of confusion on the part of the public, including an inevitable association between the marks.
6. In respect of the 5(3) ground, the opponent claims that its mark enjoys a reputation in the goods relied upon and, as a result of the similarity between the marks, English-speaking relevant consumers would believe that there is an economic link between them. The opponent argues that use of the applicant's mark would, without due case, take unfair advantage of the opponent's mark or cause damage to its repute and distinctive character.

³ The opponent's mark is a comparable trade mark. It is based on the opponent's earlier EUTM, being registration number 000691808. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

7. The applicant filed a counterstatement denying the claims made and requested that the opponent provide proof of use for its mark.
8. The opponent is represented by Stobbs IP Limited and the applicant is represented by Haseltine Lake Kempner LLP. Only the opponent filed evidence. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
9. 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

10. As above, only the opponent filed evidence. This came in the form of the witness statement of Ms Giovanna Gorreri dated 12 September 2022. Ms Gorreri founded the opponent on 1 December 1966 and has been its the sole director since 30 June 1999. Ms Gorreri's statement is accompanied by five exhibits, being those labelled Exhibits GG1 to GG5.
11. I will refer to points from the evidence and the submissions filed where necessary.

DECISION

Proof of use

12. 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.”

13. The relevant statutory provisions are as follows:

“Section 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 relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

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

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

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.”

14. 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.”

15. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. The opponent’s mark completed its registration process over five years prior to the filing date of the applicant’s mark and, as set out above, the applicant requested that the opponent provide proof of use for its mark. As a result, the opponent’s mark is subject to a proof of use assessment in respect of the goods relied upon.

16. 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 Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

(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].”

17. 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 5-year period ending with the priority date of the applicant’s mark, being 5 October 2020. Therefore, the relevant period for this assessment is 6 October 2015 to 5 October 2020.

18. The opponent’s mark is a comparable mark based upon an earlier EUTM. This means that use of the mark in the EU prior to IP Completion Day (being 31

December 2020) is relevant to the present assessment.⁴ Given that the entirety of the relevant period falls prior to IP Completion Day, the relevant jurisdiction for the proof of use assessment is the EU. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

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

And

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

19. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”⁵ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

⁴ See paragraph 4 of Tribunal Practice Notice 2/2020

⁵ *Jumpman* BL O/222/16

Sufficient Use

20. I note that in response to the opponent's evidence, the applicant has filed detailed submissions wherein it raised a number of issues with the opponent's evidence of use. I do not intend to reproduce or comment on the submissions in full but note that, having reviewed them, the applicant's position is that the opponent's evidence is irrelevant, insufficient and unsubstantiated. As a result, the applicant submits that the opponent cannot rely on its mark. In the alternative, the applicant sets out that the opponent's evidence shows use in relation to 'belts' only and that the specification should be construed accordingly.

21. In giving her evidence, Ms Gorreri sets out that the opponent has been using the 'ANDERSON'S' trade mark as a brand for its goods in relation to belts, bags, wallets and as its company name since at least as early as 1966. Copies of the opponent's catalogues for the years 2014/2015 through to 2019/2020 have been provided which Ms Gorreri claims to clearly show the opponent's mark.⁶ Having reviewed the catalogues, I note that they show the range of goods offered by the opponent for a number of different collections and that those are entitled 'Autumn to Winter 2014/2015', 'Autumn to Winter 2015/2016', 'FW16-17' (presumably Fall/Winter 2016/2017), 'Fall Winter 17-18', 'Fall Winter 2018 – 2019' and 'Fall Winter 19-20'. Each of the catalogues bear the opponent's mark throughout. While I have no evidence to suggest how these catalogues were dispersed across the relevant territories, I accept that they are reflective of the opponent's goods during the relevant period. As for the products shown, I note that there is a wide range of different types of belts, however, there are no other goods shown.

22. There is a print-out provided from the 'story' page of the opponent's current version of its website, which can be found at 'www.anderson.it/story/'.⁷ Alongside this print-out (which is dated after the relevant date) are a number of print-outs taken from the online internet archive facility, 'The Wayback Machine'.⁸ I note that the first print-outs from the Wayback Machine are from 2022 and show current examples.

⁶ Exhibit GG1

⁷ Pages 1 to 14 of Exhibit GG2

⁸ Pages 15 to 20 of Exhibit GG2

Beyond this are ten print-outs from between 27 January 2017 to 14 August 2020.⁹ These pages do not show any products listed for sale; however, I note that the pages show the word 'ANDERSON'S' layered on top of a range of different photographs from what appears to be the manufacturing process of the opponent's goods.

23. Ms Gorreri goes on to discuss the UK retailers from which the opponent's goods are available. Print-outs from the retailers' websites are included in the evidence and I note that they include print-outs from Libertys, Selfridges, Matches Fashion, Mr. Porter, Stuarts and Atterley.¹⁰ I note that the print-outs show a wide range of belts, both made of leather and woven materials, and are offered in British pounds. However, all of the print-outs are dated after the end of the relevant period and it is not clear whether these retailers had stocked the opponent's products during the relevant period.

24. While the evidence points to belts only, Ms Gorreri confirms that the opponent's mark has been used since at least as early as 1966 in relation to belts, bags and wallets. In support of this, Ms Gorreri has provided a range of invoices between 2015 and 2020.¹¹ She points out that the invoices provided are examples and are not intended to show all sales that have been made in the UK. There are approximately 90 pages worth of invoices to retailers in the UK. I note that the invoices are addressed to various companies located in cities and towns across the breadth of the UK. Some of the invoices are from outside the relevant period so are not relevant to the present assessment. Having reviewed the entirety of the invoices (including those from outside the relevant period), I note that there are no entries in the invoices for any goods other than leather or textile belts.

25. In discussing the level of sales, Ms Gorreri has provided turnover for the relevant period and I note that this covers 2015 to 2020. These are provided in euros and show a turnover of €602,162 in 2015, €491,187 in 2016, €318,283 in 2017, €623,828 in 2018, €577,413 in 2019 and €347,587 in 2020. This represents a total

⁹ There are additional print-outs but these fall outside the relevant period.

¹⁰ Exhibit GG3

¹¹ Exhibit GG4

turnover of €2,960,460. Given where the beginnings and ends of the relevant period falls, it is reasonable to assume that some of the figures for 2015 and 2020 fall outside of this. This is something that I will bear in mind when making my final assessment.

26. Before proceeding to consider the remainder of the evidence, I consider it necessary to address the applicant's submissions in respect of the aforementioned turnover evidence. The applicant argues that it is not specified whether the turnover figures relate to the UK only or whether they are sales in the EU at large. Firstly, the EU is the relevant market to the present assessment so if it were EU figures then they remain relevant. Secondly, even if the turnover did cover the EU as a whole, I note that the invoice evidence discussed at paragraph 24 above show a consistent level of sales to UK retailers, thereby indicating that at least a portion of the EU turnover figures during the relevant period will have been from UK sales.

27. Lastly, Ms Gorreri goes on to discuss the publicity that the opponent and its mark have received. This is presented in the form of articles from GQ, GotStyle Man and 2015 and 2016.¹² Having reviewed the articles, I note that the GotStyle Man publication appears to be one that is neither aimed at the UK or EU markets. This is on the basis that the products shown are in dollars and the website referred to is 'gotstyle.ca', which is a Canadian domain. As for the GQ articles, these are from 'GQ Deutschland', being Germany's version of GQ magazine. As above, the relevant territory for the present assessment is the EU, of which Germany is a Member State. I note that the first article shows a belt from the opponent but the edition is dated February 2015, being before the start of the relevant period. The second is from June 2016 and also shows one of the opponent's belts.

28. The above represents the entirety of the evidence filed by the opponent. I have nothing before me to suggest the size of the markets at issue in the UK or the EU. Even without such, I am content to conclude that the relevant markets are likely to be very large and the size of the turnover provided, when compared to these markets, is, in my view, low. Having said that, I remind myself that use need not

¹² Exhibit GG5

always be quantitatively significant for it to be deemed genuine and that even minimal use may qualify as genuine if it is deemed to be justified in the economic sector. I also note that the use has been consistent throughout the relevant period and, as set out above, the invoice evidence covers sales across the entirety of the UK. Taking this into account and bearing in mind that, throughout the entirety of the relevant period, the UK was substantial part of the EU, I am content to conclude that the turnover provided is sufficient to demonstrate that the opponent has made a genuine attempt to preserve itself a market share for its goods in the relevant jurisdiction during the relevant period.

Fair Specification

29. I must now consider whether, or the extent to which, the evidence shows use of the opponent's mark in relation to all of the goods relied upon. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (although it equally applies to the issue of a fair specification for proof of use assessments).

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

30. I remind myself that the goods relied upon by the opponent are as follows:

Class 18: Manufactured goods of leather, hemp, elastic and the like such as bags, handbags, travelling bags, pocket wallets.

Class 25: Manufactured goods of leather, hemp, elastic and the like such as belts, shoes, slippers, braces, garters.

31. I will first deal with the opponent's class 25 goods as I can deal with this relatively briefly. It is clear that the opponent has not used its mark on shoes, slippers, braces or garters. This leaves belts only and given the evidence summarised above, I have no hesitation that the use is sufficient in relation to such goods. The evidence relating to belts clearly shows use of both leather and textile belts. Thanks to the

use of “and the like”, I consider that the way in which the opponent’s term is phrased is broad enough to cover belts made of a wide range of materials which inevitably covers materials that have not been used. On this point, I remind myself that the case law above suggests that the assessment I must make at present is not to restrict the opponent’s term in the narrowest possible way unless that is what the average consumer would do. In the present case, I do not consider it necessary to labour over the point of what materials are shown in the evidence in any great detail as I do not consider that is what the average consumer would do. Instead, they would assess the range of belts offered by the opponent and simply accept that they have used it on belts, generally. I do not consider that the average consumer would seek to identify the use using any type of sub-category of belts. Taking all of this into account, I consider that, for the purpose of a fair specification, the opponent’s class 25 goods should be limited to “belts”.

32. Turning now to the class 18 goods, I note that the narrative evidence from Ms Gorreri sets out that the opponent has used its mark in relation to belts, bags and wallets since as early as 1966. I also note that there are examples in the evidence provided of a bag,¹³ two wallets¹⁴ and a card holder.¹⁵ While these examples are noted, they are provided via print-outs of retailers’ websites that were taken after the relevant date. As for the invoices provided, I appreciate that they are only example invoices but they show no goods outside of belts. Lastly, I refer to the catalogue evidence of the opponent which also shows belts only. While I do not doubt the narrative evidence that the opponent has traded in these goods since 1966, I am of the view that if it was the case that the opponent did trade in these goods during the relevant period, it should have filed evidence of such. On this point, I refer to the case of *Awareness Limited v Plymouth City Council*, Case BL O/236/13, wherein Mr Daniel Alexander Q.C., sitting as the Appointed Person, stated that the burden in proving use lies on the proprietor of the mark in question and that, if it was likely that such material would exist and little or none is provided, then a Tribunal will be justified in rejecting the evidence as insufficiently solid.¹⁶ Applying this case to the current situation, I am of the view that it is reasonable to

¹³ See page 25 of Exhibit GG3

¹⁴ See pages 49 and 53 of Exhibit GG3

¹⁵ See page 63 of Exhibit GG3

¹⁶ See paragraph 22

expect the filing of evidence that shows goods such as wallets and bags being sold during the relevant period by the opponent. Without such, I am not willing to accept that the opponent has shown any use for its class 18 goods.

33. For the sake of completeness and the avoidance of doubt, I consider that a fair specification of the opponent's goods is as follows:

Class 25: Belts.

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

34. Section 5(2) 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.”

35. Section 5A of the Act states as follows:

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

36. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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

37. The competing goods are as follows:

The opponent's goods	The applicant's goods
<u>Class 25</u> Belts.	<u>Class 25</u> Clothing; not including belts; footwear; headgear; nightwear; sleep masks; eye masks.

38. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

39. 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.

40. I note that I have submissions from both parties in respect of the goods comparison. I do not intend to reproduce those submissions here but will refer to them below, if necessary.

“Clothing; not including belts”

41. The applicant’s submissions refer to the fact that it amended its specification to limit the above goods to expressly exclude belts and, therefore, there cannot be any similarities between these goods and the opponent’s. I do not agree that this is the case. While I appreciate that the applicant’s term can no longer be interpreted to cover belts, they are still capable of being similar. I note the above goods will all be purchased by the same consumer that purchases the opponent’s goods, being members of the general public at large thereby resulting in an overlap in user. I also consider that there is an overlap in trade channels on the basis that it is common in the trade for producers of clothing to also produce belts, and vice versa. Further, they are likely to be available via the same retailers and, even in larger stores (such as supermarkets), these goods are likely to be displayed in the same sections. As for complementary, I accept that clothing is important to belts (in that belts are accessories to trousers or jeans, for example) and also that the average consumer will consider that the same undertaking is responsible for them.¹⁷ As for nature, I appreciate that the opponent’s goods are accessories to clothing and may be made from the same materials, however, I do not consider that this is sufficient to find that they overlap here. Lastly, I consider that there is some overlap in purpose, albeit not a particularly pronounced one. I appreciate that the goods’ core purposes differ and that belts are generally worn to hold the user’s other clothing in place, however, this does not mean that they cannot also be worn for style purposes, being something that can also be said to be a purpose of clothing in general. Overall, I consider that these goods are similar to an above medium degree.

“Footwear” and “headgear”

42. The above terms clearly do not cover belts; however, they are still similar to a degree. I make this finding on the basis that I consider them to overlap in user, purpose and trade channels for the same reasons as discussed in respect of the goods assessed in the preceding paragraph (albeit I do not accept that the same

¹⁷ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

outcome applies regarding complementarity). As was the case above, the overlap in purpose is not particularly pronounced on the basis that the core purposes of footwear and headgear differ from belts but, generally, they are goods worn on the body that can be worn for style purposes. Overall, I consider that these goods are similar to a medium degree.

“Nightwear”, “sleep masks” and “eye masks”

43. I appreciate that the above goods and the opponent’s goods are purchased by the same average consumer, being the general public at large. Additionally, I accept that there is a limited degree in overlap in trade channels in that some larger clothing retailers will sell belts, sleep masks and eye masks. As for the remaining factors, I see no reason why they would overlap. Firstly, the nature of the goods is different. Secondly, I do not consider that it can be said that these goods are worn for stylistic purposes in the same way the goods assessed above are. Lastly, the goods are not complementary or in competition with one another. Taking all of this into account, I do not consider that an overlap in user and a limited overlap in trade channels are sufficient enough to warrant a finding of similarity. Therefore, I consider that these goods are dissimilar.

44. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition against “nightwear”, “sleep masks” and “eye masks” fails.¹⁸ As a result, the opposition based on the 5(2)(b) ground may only proceed in respect of some of the applicant’s goods, namely “clothing; not including belts”, “footwear” and “headgear”.

The average consumer and the nature of the purchasing act

45. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Insc v A.V.E.L.A. Inc*,

¹⁸ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA and *Waterford Wedgwood PLC v OHIM* - C-398/07 P

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.”

46. The applicant submits that the goods are directed at the public at large and that they are often sold in the luxury retail section meaning that they can be of a high price and of a specialist nature. I agree that the average consumer consists of members of the general public at large. Further, I accept that while the majority of the goods will be relatively inexpensive, they can include those that are of a higher price range. In respect of the level of attention paid, the applicant submits that this will be higher than normal. While noted, I do not agree. This on the basis that average consumers will consider factors such as materials used, style and fit regardless of the price of the goods. I see no reason as to why the average consumer who, upon selecting more expensive goods, would give consideration to additional factors that could be said to extend the level of attention paid beyond medium. To confirm, I consider that the average consumer will pay a medium degree of attention when selecting the goods at issue.

47. The goods at issue are most likely to be sold through a range of retailers and their online or catalogue equivalents. In physical retailers, the goods at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the consumer. A similar process will apply to websites and catalogues, where the consumer will select the goods having viewed an image displayed on a webpage or in a catalogue. The selection of the goods at issue will, therefore, be primarily visual. That being said, I do not discount aural considerations in the form of advice sought from sales assistants or word of mouth recommendations.

Comparison of the marks

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

49. 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.”

50. 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.

51. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
ANDERSON'S	SANDERSON

52. Both parties have provided detailed submissions as to the comparison of the marks. I do not intend to reproduce them here but will, where necessary, address them below.

Overall Impression

53. Both parties' marks are word only marks with the opponent's mark being 'ANDERSON'S' and the applicant's being 'SANDERSON'. As there are no other elements that contribute to either mark, they are both dominated by their respective words.

Visual Comparison

54. In its submissions, the opponent's position in respect of this assessment is that the marks at issue are visually similar to at least an average degree but then, in summarising its position in respect of visual similarity, states that they are similar to between a medium and high degree. The applicant, in its submissions, accepts that there is some degree of similarity between the marks but points out that they differ in their respective first letters.

55. Visually, the marks share the identical letter string of 'A-N-D-E-R-S-O-N'. This letter string forms almost the entirety of both parties' marks with the only visual differences coming at the end of the opponent's mark end (being the apostrophe and the letter 'S') and the first letter of the applicant's mark (being the letter 'S'). While I appreciate that the differences are the same letter, their placements in the respective marks couldn't be further apart and, therefore, I do not consider it a point of similarity. While I appreciate that the majority of both marks consist of the identical letter string (being eight of the nine letters in each party's mark), I note that there is a point of difference at the beginning of the marks, being where the average consumer tends to focus.¹⁹ Taking all of this into account, I agree with the opponent's position and therefore find that the marks are visually similar to between a medium and high degree.

¹⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Aural Comparison

56. The opponent's use of an apostrophe at the end of its mark will not alter the pronunciation of that mark meaning that it will simply consist of three syllables that will be pronounced 'AN-DUR-SUHNS'. As for the applicant's mark, this will also consist of three syllables that will be pronounced as 'SAN-DUR-SUHN'. While I appreciate that the first and last syllables across the marks are not the same, they are still aurally very similar and differ only by virtue of the inclusion of the letter 'S' in both the applicant's first syllable and the opponent's last. Overall, I consider that the marks are aurally similar to a high degree.

Conceptual Comparison

57. I consider that both parties' marks will be immediately understood by the average consumer in the UK as surnames. As for the opponent's mark, I consider that the use of an apostrophe will be noticed meaning that it will be understood as possessive, thereby indicating that the goods at issue were created by or belong to someone named 'ANDERSON'. On the point of concepts of surnames, I refer to the case of *Luciano Sandrone v EUIPO*²⁰ wherein the General Court ("GC") stated that:

"85. [...] a first name or a surname which does not convey a 'general and abstract idea' and which is devoid of semantic content, is lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.

86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.

²⁰ Case T-268/18

87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM— McKenzie (McKENZIE)*, T502/07, not published, EU: T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM— Cortefiel (PEDRO)*, T38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, *ANTONIO RUBINI, T707/16*, not published, EU:T:2018:424, paragraph 65).”

58. In addition to the above, I also note that the GC has also found that names will not be conceptually similar unless they are recognised as being linked with the same family.²¹ While ‘SANDERSON’ and ‘ANDERSON’ are similar, I do not consider that they will be viewed as being linked with the same family.

59. Following on from the findings of the GC and aside from the fact that the marks will be understood as different surnames, I do not consider it possible to make a conceptual comparison between the marks on the basis that neither surname is particularly well known as the name of a famous person. Therefore, I find that the marks are conceptually neutral.

Distinctive character of the opponent’s mark

60. 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

²¹ *Lidl Stiftung v OHIM*, Case T-715/13

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).”

61. Registered trade marks possess various 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 high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. I note that, in the present case, the opponent has submitted that its evidence shows that there is an enhanced distinctive character in its mark in relation to ‘belts’ and ‘bags’ in particular.²² In respect of the goods claimed, I refer to the fact that I have limited the opponent to use of ‘belts’ only. Before considering the position in respect of the claim to enhanced distinctiveness, I will first consider the inherent position.

62. I have set out above that the opponent’s mark will be understood as a surname. I have also found that the use of the apostrophe indicates that the goods at issue were created by or belong to someone with the name ‘ANDERSON’. From a trade mark perspective, I do not consider that the use of a readily recognised surname is particularly remarkable. Having said that, it is neither allusive or descriptive of

²² See the fourth paragraph on page 2 of the opponent’s submissions

the goods at issue. Overall, I consider that the opponent's mark enjoys no more than a medium degree of inherent distinctiveness.

63. Turning to consider the position in respect of enhanced distinctiveness, I refer to the evidential summary I have provided at paragraphs 21 to 28. While that summary was provided in respect of the issue of genuine use, it represents the entirety of the evidence filed and I consider it is also relevant to the present assessment I must make. I do not intend to reproduce the evidence here but remind myself of the fact that the opponent's turnover between 2015 and 2020 was €2,960,460. Given that the relevant date for this assessment is 5 October 2020, some of the 2020 figures provided will inevitably fall after that date, however I appreciate that the majority of them will remain relevant. I also remind myself that, in light of the nature of the evidence as a whole, I was only willing to accept that the use was in relation to belts only. I have found above that while I have no evidence of the size of the market, I am of the view that this turnover, when compared against the market at issue, represents a low market share. Lastly, the remaining evidence is of no assistance to the present issue on the basis that (1) the evidence of the opponent's goods for sale via online retailers' websites in the UK was all dated after the relevant date and (2) the presence of the mark in fashion publications was either in publications from Canada or Germany and the issue of distinctiveness is one that is based on the assessment of the knowledge of the UK consumer. Taking this into account, I am not satisfied that the opponent has used its mark to the extent that its distinctiveness has been enhanced by any degree.

Likelihood of confusion

64. 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 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods 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 trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

65. I have found the parties' goods to be either similar an above medium or medium degree. I have found that the average consumer for the goods is made up of members of the general public at large who will select the goods through primarily visual means, although I do not discount an aural component. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods at issue. In regard to the similarity of the marks, I have found them to be visually similar to between a medium and high degree, aurally similar to a high degree and conceptually neutral. I have found that the opponent's mark is inherently distinctive to no more than a medium degree.

66. I note that I have submissions from both parties in respect of the point of a likelihood of confusion and while I do not intend to reproduce these here, I confirm that I have taken them into account when making the following assessment.

67. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I do not consider that the parties' marks will be mistakenly recalled or misremember for one another. I appreciate that the visual and aural similarities between the marks are on the higher end, however, the beginnings of the marks are different and I am of the view that this would not be overlooked. Additionally, while no conceptual comparison can be made between the marks, this does not prevent the fact that the consumer would immediately recognise them as being two different and common surnames, thereby assisting the average consumer in accurately recalling and remembering which mark was which. Further, I wish to point out that the marks at issue are not simply alternate spellings of the same surname (for example, ANDERSON and ANDERSEN or ANDERSSON) that may be overlooked and neither is there anything to suggest that these names have

the same origin or that they are linked to the same family.²³ Again, they are different surnames and I do not consider that the average consumer will overlook this, particularly given that the first letter of the marks differ. Consequently, I do not consider there to be a likelihood of direct confusion. I will now proceed to consider a likelihood of indirect confusion.

68. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.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’.

17. 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).

²³ See *Lidl Stiftung*, cited above.

(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)".

69. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor K.C (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

70. In the present case, I have found that the marks at issue will both be recognised as different (albeit similar) surnames by the average consumer in the UK. In light of this and bearing in mind the categories set out in *L.A. Sugar* (being categories (a) to (c) as reproduced above), I see no reason as to why, upon recognising this, the average consumer would believe that the applicant's mark was a brand extension, sub-brand or alternative mark used by the opponent, or vice versa. I do not consider the use of surnames as the basis of trade marks in the UK to be particularly remarkable and the average consumer will be aware of such and, upon identifying the differences between the marks, would understand that they are owned by different and economically unconnected undertakings, one being presumably owned by someone named Anderson and the other owned by someone named Sanderson. While the categories in *L.A. Sugar* are not exhaustive, I see no other reason as to why a likelihood of indirect confusion exists. Taking this into account and bearing in mind the comments of Arnold LJ in *Liverpool Gin* (being those reproduced above), I find that there is no likelihood of indirect confusion in the present case.

71. As a result of the above, the opposition reliant upon the 5(2)(b) ground fails. I will now proceed to consider the 5(3) ground.

Section 5(3)

72. Section 5(3) of the Act states:

“5(3) A trade mark which –

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

73. 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*, Case C-323/09, *Marks and Spencer v Interflora*, 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 holder 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*).

74. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the opponent must also show that its registration has achieved a level of knowledge, or reputation, amongst a significant part of the public. The opponent must also establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

75. The relevant date for the assessment under section 5(3) is the priority date of the applicant's mark, being 5 October 2020.

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. Under its 5(3) ground, the opponent relies on the same mark as it did under its 5(2)(b) ground and claims to have obtained a reputation in the same set of goods that were relied upon under that ground.

78. I can deal with this ground relatively swiftly. For similar reasons as set out when considering enhanced distinctiveness above, I do not consider the opponent's evidence to be sufficiently clear to justify a finding of reputation in the relevant market for belts. Consequently, the opposition based upon section 5(3) falls at the first hurdle. However, even if there were a reputation, I do not consider that this ground would further the opponent's position. This is because any reputation would be moderate at best and I do not consider that average consumers in the UK would make a link between the marks at issue on the basis that they are immediately recognisable as two different surnames. While I appreciate that those surnames are similar, I do not consider that the average consumer will be caused to wonder if the use of similar but different surnames from a trade mark perspective is linked.

CONCLUSION

79. The opposition has failed in its entirety and the applicant's mark may, therefore, proceed to registration for all goods applied for.

COSTS

80. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While the applicant did not file evidence, it was required to consider the evidence filed by the opponent and I will, therefore, make a costs award in respect of the same. However, given that the opponent's evidence was not particularly extensive, I consider it appropriate to reduce the evidence accordingly.

81. In the circumstances, I award the applicant the sum of **£800** as a contribution towards its costs. The sum is calculated as follows:

Considering the notice of opposition and filing a counterstatement:	£200
Considering the opponent's evidence:	£300
Filing written submissions:	£300
Total:	£800

82. I hereby order ANDERSON'S S.R.L. to pay Sanderson Design Group Brands Limited the sum of £800. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 9th day of March 2023

A COOPER
For the Registrar