

O/0338/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. WO000000159232

IN THE NAME OF NINGBO DELI TOOLS CO., LTD.

FOR THE TRADE MARK:

Steelite

IN CLASSES 7, 8, 9 AND 12

AND

THE OPPOSITION THERETO UNDER NO. 429183

BY PORTWEST UNLIMITED COMPANY

Background and pleadings

1. NINGBO DELI TOOLS CO., LTD. (“the applicant”) is the holder of the International Registration (“IR”) WO0000001592232 in respect of the mark shown on the front page of this decision. Protection in the UK was requested on 19 April 2021 with a priority date of 04 February 2021 based on the opponent’s Chinese trade marks nos. 53556623, 53571200, 53571613 and 53572810. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 15 October 2021 in respect of the following goods:

Class 7: *Lawnmowers [machines]; saws [machines]; shredders [machines] for industrial use; juice extractors, electric; wrapping machines; sealing machines for industrial purposes; mixing machines; blenders, electric, for household purposes; kitchen grinders, electric; stone-working machines; pneumatic jacks; electric hammers; cutting machines; metalworking machines; chain saws; cutting blow pipes, gas-operated; glaziers' diamonds [parts of machines]; electric hand drills; compressed air guns for the extrusion of mastics; glue guns, electric; nail extractors, electric; screwdrivers, electric; painting machines; spray guns for paint; dynamos; motors, electric, other than for land vehicles; compressed air pumps; compressed air machines; centrifugal pumps; bearing brackets for machines; door closers, electric; door openers, electric; welding machines, electric; soldering apparatus, gas-operated; electric arc cutting apparatus; washing installations for vehicles; waste disposal units; dust exhausting installations for cleaning purposes; parquet wax-polishers, electric; suction nozzles for vacuum cleaners; curtain drawing devices, electrically operated; shoe polishers, electric; 3D printing pens.*

Class 8: *Stropping instruments; pickhammers; beard clippers; manicure sets; awls; bow saws; nail extractors, hand-operated; hand drills, hand-operated; stone hammers; frames for handsaws; tap wrenches; axes; nail nippers; planes; taps [hand tools]; screwdrivers, non-electric; vices; tool belts [holders]; wire strippers [hand tools]; bench vices [hand implements]; emergency hammers; guns, hand-operated, for the extrusion of mastics; air pumps, hand-operated; palette knives; trowels; glaziers' diamonds [parts of hand tools];*

hobby knives [scalpels]; scissors; pruning scissors; box cutters; handles for hand-operated hand tools; table forks.

Class 9: *Money counting and sorting machines; counterfeit coin detectors; time recording apparatus; punched card machines for offices; scales; slide calipers; carpenters' rules; micrometers; vehicle breakdown warning triangles; rearview cameras for vehicles; slide projectors; projection screens; stands for photographic apparatus; video projectors; tape measures; surveying apparatus and instruments; barometers; telemeters; plumb bobs; plumb lines; gas testing instruments; hygrometers; clinometers; lasers, not for medical purposes; surveyors' levels; thermometers, not for medical purposes; azimuth instruments; infrared detectors; measuring devices, electric; microscopes; cables, electric; wires, electric; junction boxes [electricity]; electric plugs; connections for electric lines; video screens; electrical adapters; fire hose nozzles; fire hose; fire extinguishing apparatus; fire pumps; anti-theft warning apparatus; workmen's protective face-shields; protective helmets; safety nets; gloves for protection against accidents; life belts; reflective safety vests; anti-glare glasses; locks, electric; battery chargers; batteries, electric.*

Class 12: *Pumps for bicycle tyres; air pumps [vehicle accessories]; air pumps for automobiles; air pumps for motorcycles; air pumps for bicycles; pumps for bicycle tyres; drink holders for vehicles; back seats specially adapted for use in vehicles; upholstery for vehicles; vehicle covers [shaped].*

2. On 15 December 2021, Portwest Unlimited Company (“the opponent”) partially opposed the application under Sections 5(1), 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposed goods are those highlighted in grey.

3. Under Sections 5(1) and 5(2)(a) the opponent relies on the two trade marks set out below:

UK00003256833 ("the first earlier mark")

Steelite

Filing date: 14 September 2017; Registration date: 15 December 2017

Relying on all of the registered goods, namely:

Class 9: *Life-saving apparatus and instruments; Protective clothing, headwear and footwear; Protective work clothing, headgear and footwear for the prevention of accident or injury; reflective clothing for prevention of accidents; reflective safety vests; ready-made articles of clothing for protection against accidents or injury; fire resistant clothing; Clothing and footwear for protection against biological hazards; safety eyewear; protective glasses; safety or protective goggles; dust goggles; face-protection shields; face shields other than for medical purposes; workmen's protective face shields; protective helmets; safety helmets; flame-retardant balaclavas; boots [protective footwear]; safety gloves for protection against accident or injury; gloves for protection against accidents, irradiation and fire; fire resistant gloves; disposable gloves for laboratory use; asbestos screens, asbestos clothing and asbestos gloves for protection against fire; Static grounding systems and apparatus; Apparatus for controlling static electricity; respirators for filtering air; anti-pollution masks for respiratory protection; dust masks.*

Class 10: *Protective clothing for medical or surgical purposes; articles of outer clothing for medical, surgical and veterinary use; footwear and headwear for medical, surgical and veterinary use; disposable clothing, footwear and headwear for medical, surgical and veterinary use; medical and surgical gloves; disposable gloves for medical use; face shields for medical purposes; orthopaedic footwear and insoles; protective ear plugs; ear defenders.*

Class 25: *Clothing, footwear, headgear; clothing for leisure or workwear; overalls; working overalls; gloves; ear muffs; articles of clothing for outdoor activities; articles of clothing having water-resistant properties; rainwear; articles of protective clothing for use in inclement weather conditions; waders; thermally insulated clothing, footwear and headgear; breathable clothing; shoes, slip on shoes; sandals; clogs; trainers; shoe and heel inserts; boots, work boots; wellington boots; protective metal*

members for shoes and boots; non-slipping devices for footwear; shoe and boot covers other than for medical purposes; socks; thermal socks; non slip socks; workwear; uniforms; chefs whites, chefs hats, paper hats for use by chefs; aprons; headwear; hats; scarves; high visibility clothing, headwear and footwear; disposable articles of clothing; laboratory coats.

UK00914425334¹ (“the second earlier mark”)

Steelite

Filing date: 30 July 2015; Registration date: 11 November 2015

Relying on some of the registered goods, namely those highlighted in grey:

Class 9: *Boots [protective footwear]; Safety footwear for protection against accident or injury; Protective footwear for the prevention of accident or injury; Shoes (Protective -); Protective industrial shoes; Shoes for protection against accidents, irradiation and fire; Protective shoes [against accident or injury]; Shoes for protection against accidents and fire; Divers' boots; Protective headgear; Protective visors; Protective goggles; Protective masks; Protective eyeglasses; Helmets (Protective -); Visors [protective]; Masks [Protective -]; Protective helmets; Protective industrial boots; Protective face-shields for protective helmets; Protective clothing [body armour]; Sports (Protective helmets for -); Helmets (Protective -) for sports; Aviators (Protective suits for -); Protective suits [against accident or injury]; Protective headgear for the prevention of accident or injury; Safety headgear; Eyewear; Protective eyewear; Socks, electrically heated; Wind socks for indicating wind direction.*

Class 10: *Orthotic footwear; Orthopedic footwear; Orthopaedic footwear [shoes]; Footwear (Arch supports for -); Soles for footwear [orthopaedic]; Exercise boots [orthopaedic footwear]; Shoes (Orthopaedic -); Pads for shoes [orthopaedic]; Inserts for shoes [orthopaedic]; Boots for medical purposes; Exercise boots for medical rehabilitative purposes; Protective clothing for surgical purposes; Protective gloves for veterinary use; Protective gloves for medical use; Disposable protective gloves*

¹ On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the opponent's earlier mark was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

for medical purposes; Protective gloves for use by persons working in the dentistry; Hearing protectors; Hearing aids; Medical clothing.

Class 25: *Footwear; Golf footwear; Infants' footwear; Ladies' footwear; Sneakers [footwear]; Trainers [footwear]; Casual footwear; Leisure footwear; Uppers (Footwear -); Footwear soles; Athletics footwear; Sports footwear; Pumps [footwear]; Athletic footwear; Climbing footwear; Footwear [excluding orthopedic footwear]; Beach footwear; Footwear (Tips for -); Footwear (Welts for -); Heelpieces for footwear; Welts for footwear; Footwear for men; Insoles for footwear; Soles for footwear; Wooden shoes [footwear]; Tips for footwear; Inner socks for footwear; Footwear made of vinyl; Footwear not for sports; Footwear made of wood; Footwear (Non-slipping devices for -); Footwear (Fittings of metal for -); Non-slipping devices for footwear; Fittings of metal for footwear; Footwear for men and women; Flip-flops for use as footwear; Footwear for track and field athletics; Shoes; Work shoes; Basketball shoes; Jogging shoes; Hiking shoes; Walking shoes; Deck shoes; Snowboard shoes; Dress shoes; Bath shoes; Athletics shoes; Yoga shoes; Flat shoes; Wooden shoes; Aqua shoes; Running shoes; Leisure shoes; Rugby shoes; Riding shoes; Golf shoes; Baseball shoes; Handball shoes; Dance shoes; Canvas shoes; Athletic shoes; Ballet shoes; Football shoes; Rubber shoes; Cycling shoes; Beach shoes; Leather shoes; Gymnastic shoes; Hockey shoes; Tap shoes; Soccer shoes; Boxing shoes; Volleyball shoes; Training shoes; Tennis shoes; Skiing shoes; Stiffeners for shoes; High-heeled shoes; Slip-on shoes; Shoes for infants; Shoes for leisurewear; Shoes soles for repair; Shoes for casual wear; Esparto shoes or sandals; Track and field shoes; Esparto shoes or sandals; Sandals and beach shoes; Tongues for shoes and boots; Insoles for shoes and boots; Pullstraps for shoes and boots; Insoles [for shoes and boots]; Protective metal members for shoes and boots; Shoes with hook and pile fastening tapes; Boots; Climbing boots; Army boots; Walking boots; Wellington boots; Rugby boots; Fishing boots; Desert boots; Boots (Ski -); Work boots; Polo boots; Hunting boots; Riding boots; Football boots; Mountaineering boots; Ankle boots; Rain boots; Half-boots; Hiking boots; Ladies' boots; Climbing boots [mountaineering boots]; Lace boots; Motorcyclist boots; Soccer boots; Snowboard boots; Gym boots; Winter boots; Trekking boots; Snow boots; Ski boots; Stiffeners for boots; Sports [Boots for -]; Après-ski boots; Rubber*

fishing boots; Boots for sports; After ski boots; Boots for sport; Boots for motorcycling; Valenki [felted boots]; Horse-riding boots; Football boots (Studs for -); Waterproof boots for fishing; Studs for football boots; Clothing; Gloves; Headgear; Socks; Rainwear; Leisurewear; Oilskins [clothing]; Weatherproof clothing; Gloves [clothing]; Jackets [clothing]; Bottoms [clothing]; Clothing for fishermen.

4. The first earlier mark is relied upon under both Sections 5(1) and 5(2)(a), whereas the second earlier mark is relied upon under Section 5(2)(a) only.

5. By virtue of their earlier filing dates, the above registrations constitute earlier marks within the meaning of Section 6 of the Act. Only the second earlier mark had completed its registration process more than five years before the priority date of the contested mark and is therefore subject to the proof of use provisions contained in Section 6A of the Act. Since the use provisions at Section 6A of the Act do not apply to the first earlier mark, the opponent can rely on this mark for all of the goods it has identified in its notice of opposition without demonstrating that it has used them.

6. Under Sections 5(1) and 5(2)(a), the opponent claims that because the marks are identical and the goods are identical or similar, there is a likelihood of confusion.

7. Under Section 5(3), the opponent relies on the same two earlier marks. It claims that the first earlier mark has a reputation for the following goods:

Class 9: *Protective clothing, headwear and footwear; Protective work clothing, headgear and footwear for the prevention of accident or injury; Clothing and footwear for protection against biological hazards; boots.*

Class 25: *footwear; rainwear; waders; thermally insulated footwear; shoe and heel inserts; boots, work boots; wellington boots; protective metal members for shoes and boots; non-slipping devices for footwear; shoe and boot covers other than for medical purposes; workwear; high visibility footwear.*

8. It also claims that the second earlier mark has a reputation for all of the goods it relies upon under Section 5(2)(a).

9. Under Section 5(3) the opponent claims that it has built up a reputation through over 15 years of use of the earlier marks in the workwear/building sector and that use of the contested mark will result in the applicant taking advantage of the earlier marks' reputation, with the damage arising from the likelihood of confusion. It states:

“A third party now entering that market, offering products with the same target purchaser, would result in an assumption that this is product from the Opponent, therefore allow the Applicant to benefit from the reputation that the Opponent has established over a significant period of time”.

10. Under Section 5(4)(a), the opponent claims to have used the unregistered sign 'Steelite' throughout the UK since 2006 in relation to *Footwear; protective footwear; safety footwear; parts and fittings for footwear* and to have acquired substantial goodwill. The opponent claims that in relation to the goods of the application against which the opposition is directed, it is considered that these are related goods to the goods of the opponent which might lead to a misrepresentation that the applicant's goods are in some way authorised by, or associated with, the opponent. Consequently, use of the contested mark would be contrary to the law of passing off.

11. The applicant filed a counterstatement wherein it admits that the opposition should be upheld under Section 5(1) and 5(2) in relation to some of the contested goods in class 9 which it considers to be similar to the opponent's goods, namely: *workmen's protective face-shields; protective helmets; gloves for protection against accidents; reflective safety vests; anti-glare glasses*. However, the applicant denies any similarity between the opponent's goods and the remaining goods in the application and puts the opponent to proof of use, reputation and goodwill.

12. Only the opponent filed evidence in these proceedings. The evidence will be summarised to the extent that it is considered necessary.

13. The applicant represent itself; the opponent is represented by Indelible IP Limited. Neither party requested a hearing, but the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EU Law

14. 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.

The evidence

15. The opponent filed evidence in the form of two witness statements, one by Henry Sylvester Hughes who is the opponent's director and the other by Michelle Anne Ward, who is a chartered trade mark attorney and the founder and director of the firm representing the opponent in these proceedings. Mr Hughes' witness statement is dated 6 July 2022 and is accompanied by six exhibits (HH1 - HH6). Ms Ward's witness statement is dated 11 July 2022 and is accompanied by two exhibits (MAW1 – MAW2).

My approach to the proof of use

16. In the present opposition, the opponent relies on two earlier marks. As I have said above, the first earlier mark is not subject to proof of use, however, the second earlier mark is.² The first and the second earlier marks are identical. Although the marks' specifications cover similar goods, the specification of the second earlier mark is more limited and does not provide a stronger case for finding that the goods are similar, compared to the first earlier mark which has a broader specification and is not subject to proof of use. Consequently, I will carry out my assessment of the likelihood of confusion based on the first earlier mark (which is not subject to proof of use).

² Although the applicant put the opponent to proof of use in relation to both earlier marks, the request in relation to the first earlier mark is invalid because it is not subject to proof of use.

DECISION

Section 5(1)/5(2)(a)

17. Section 5 of the Act is as follows:

“Relative grounds for refusal of registration.

(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

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

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

18. Section 5A of the Act is as follows:

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

19. The following principles (which are relevant to the opposition based upon Section 5(2)(a)) are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany &*

Austria GmbH, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

20. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

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

21. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

(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.

22. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

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

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

may think that the responsibility for those goods lies with the same undertaking.”

24. The applicant accepts that the following goods are similar and that the opposition should succeed against them:

workmen's protective face-shields; protective helmets; gloves for protection against accidents; reflective safety vests; anti-glare glasses

25. The goods to be compared are therefore as follows:

The applicant's goods	The opponent's goods
<p>Class 7: <i>Lawnmowers [machines]; saws [machines]; shredders [machines] for industrial use; wrapping machines; sealing machines for industrial purposes; mixing machines; stone-working machines; pneumatic jacks; electric hammers; cutting machines; metalworking machines; chain saws; cutting blow pipes, gas-operated; glaziers' diamonds [parts of machines]; electric hand drills; compressed air guns for the extrusion of mastics; glue guns, electric; nail extractors, electric; screwdrivers, electric; painting machines; spray guns for paint; dynamos; motors, electric, other than for land vehicles; compressed air pumps; compressed air machines; centrifugal pumps; bearing brackets for machines; door closers, electric; door openers, electric; welding machines, electric;</i></p>	

<p><i>soldering apparatus, gas-operated; electric arc cutting apparatus; waste disposal units; dust exhausting installations for cleaning purposes.</i></p>	
<p>Class 8: <i>Stropping instruments; pickhammers; awls; bow saws; nail extractors, hand-operated; hand drills, hand-operated; stone hammers; frames for handsaws; tap wrenches; axes; nail nippers; planes; taps [hand tools]; screwdrivers, non-electric; vices; tool belts [holders]; wire strippers [hand tools]; bench vices [hand implements]; emergency hammers; guns, hand-operated, for the extrusion of mastics; air pumps, hand-operated; palette knives; trowels; glaziers' diamonds [parts of hand tools]; pruning scissors; box cutters; handles for hand-operated hand tools.</i></p>	
<p>Class 9: <i>carpenters' rules; micrometers; tape measures; surveying apparatus and instruments; barometers; telemeters; plumb bobs; plumb lines; gas testing instruments; hygrometers; clinometers; lasers, not for medical purposes; surveyors' levels; thermometers, not for medical purposes; azimuth instruments; infrared detectors; measuring devices, electric; microscopes; cables, electric; wires, electric; junction boxes [electricity]; electric plugs; connections for electric lines; fire hose nozzles; fire</i></p>	<p>Class 9: <i>Life-saving apparatus and instruments; Protective clothing, headwear and footwear; Protective work clothing, headgear and footwear for the prevention of accident or injury; reflective clothing for prevention of accidents; reflective safety vests; ready-made articles of clothing for protection against accidents or injury; fire resistant clothing; Clothing and footwear for protection against biological hazards; safety eyewear; protective glasses; safety or protective goggles; dust goggles; face-</i></p>

<p><i>hose; fire extinguishing apparatus; fire pumps; safety nets; life belts.</i></p>	<p><i>protection shields; face shields other than for medical purposes; workmen's protective face shields; protective helmets; safety helmets; flame-retardant balaclavas; boots [protective footwear]; safety gloves for protection against accident or injury; gloves for protection against accidents, irradiation and fire; fire resistant gloves; disposable gloves for laboratory use; asbestos screens, asbestos clothing and asbestos gloves for protection against fire; Static grounding systems and apparatus; Apparatus for controlling static electricity; respirators for filtering air; anti-pollution masks for respiratory protection; dust masks.</i></p>
	<p>Class 10: <i>Protective clothing for medical or surgical purposes; articles of outer clothing for medical, surgical and veterinary use; footwear and headwear for medical, surgical and veterinary use; disposable clothing, footwear and headwear for medical, surgical and veterinary use; medical and surgical gloves; disposable gloves for medical use; face shields for medical purposes; orthopaedic footwear and insoles; protective ear plugs; ear defenders.</i></p>
	<p>Class 25: <i>Clothing, footwear, headgear; clothing for leisure or workwear; overalls; working overalls; gloves; ear muffs; articles of clothing for outdoor activities;</i></p>

	<p><i>articles of clothing having water-resistant properties; rainwear; articles of protective clothing for use in inclement weather conditions; waders; thermally insulated clothing, footwear and headgear; breathable clothing; shoes, slip on shoes; sandals; clogs; trainers; shoe and heel inserts; boots, work boots; wellington boots; protective metal members for shoes and boots; non-slipping devices for footwear; shoe and boot covers other than for medical purposes; socks; thermal socks; non slip socks; workwear; uniforms; chefs whites, chefs hats, paper hats for use by chefs; aprons; headwear; hats; scarves; high visibility clothing, headwear and footwear; disposable articles of clothing; laboratory coats.</i></p>
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26. With the exception of the goods listed at paragraph 24 above, the applicant denies that the goods are similar. It states:

“The reasoning of opponent that the goods would be used in the building, landscaping, gardening trades or domestic gardening works is too vague and the basis for comparison is too wide and unclear. Therefore, the opposition against class 7 and 8 and all goods in class 9 except for “workmen's protective face-shields; protective helmets; gloves for protection against accidents; reflective safety vests; anti-glare glasses” shall be rejected.”

27. For the sake of completeness, I should say that I consider the goods in relation to which the applicant accepts similarity, namely, *workmen's protective face-shields; protective helmets; gloves for protection against accidents; reflective safety vests; anti-glare glasses* to be identical to the opponent's *workmen's protective face shields*;

protective helmets; protective clothing, headwear and footwear; gloves for protection against accidents, irradiation and fire; safety eyewear; protective glasses.

28. The opponent states that the applicant wrongly concluded that simply because the earlier marks do not cover classes 7 and 8, it does not mean that the opposition cannot succeed. With regard to the overlap between the opponent's goods and the contested goods, the opponent argues that the goods on which it relies are protective workwear, headgear and footwear and that the contested goods, which are protective goods or tools, machines, hand tools and protective equipment in classes 7, 8 and 9, overlap with its earlier goods in terms of users and trade channels. It states:

“For the purposes of considering the issue of likelihood of confusion, the relevant public needs to be considered. In respect of the Opponents goods there are two sectors of relevant public. The first is professional trades, such as builders, gardeners, carpenters, who work on construction sites or in environments and with tools that present a potential hazard to health. They, or their employers, will purchase protective clothing, footwear and headgear to provide protection when in those work environments. But they will also purchase tools, both hand tools and power tools, to use in those work environments. Indeed, it is notable that the Applicant has sought to cover both tools and protective garments and headgear in the Application, demonstrating that those in the field of manufacturing tools recognise the need for such protective items by those potentially using the tools.

There is also however the home DIY enthusiast and keen gardener who may use slightly less heavy-duty versions of the tools used in the trade, but nevertheless also need some protective wear when using such tools. They will usually seek to purchase these goods at the same time/alongside each other as part of their DIY project.

The public, building trade and tradesmen have become accustomed to large DIY and trades goods outlets, such as B&Q (both trade and consumer) and Screwfix (directed at trade but also used by the consumer), offering a wide range of parts, equipment and tools relevant to trades such as plumbing,

carpentry and building, as well as home DIY, and it has become commonplace for the same brand to be seen across multiple aisles. The example screenshots attached to Exhibits MAW1 and MAW2 demonstrate this point. There is therefore a real possibility that a consumer or tradesman, seeing a brand used on tools, and then also on protective garments/footwear, bearing an identical trade mark, will make an assumption that those goods come from the same or a related manufacturer. The fact that the precise nature of the goods differ is not necessarily the only factor in deciding whether or not there is similarity. Both the opposed goods of the Applicant, and the goods of the Opponents Earlier Registrations are going to be used in the same fields, when constructing/building/gardening/decorating. For instance, protective boots and trousers might be worn by a builder or gardener using a chainsaw, to protect against splinters of wood and against the risk of the saw blades accidentally coming into contact with the body. And a welder will wear a protective face shield, gloves and clothing when using a welding or soldering machine to protect against sparks. Protective metal toe capped boots are commonplace on a construction site to protect the feet from items being inadvertently dropped. When such complementary goods bear identical names there is a real risk of an assumption or association, and therefore confusion. The goods of both the Opponent and the Applicant will both be sold by building merchants, tool specialists, and DIY outlets, whether online or in store. Both the goods of the Applicant and the goods of the Opponent might be used and/or marketed and offered to the same tradesmen. The goods are therefore sufficiently similar, and certainly closely related, in many respects, increasing substantially the likelihood of confusion, including the likelihood of association”

29. Section 60 of the Act states:

“60A Similarity of goods and services

(1) For the purposes of this Act goods and services—

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.[...]"

Class 9

30. The contested *fire hose nozzles; fire hose; fire extinguishing apparatus; fire pumps; safety nets and life belts* are in my view encompassed by the opponent's broad term *Life-saving apparatus and instruments*. Alternatively, if not identical, these goods are similar to a medium degree to the opponent's goods because they belong to the same category of safety equipment and have at least a similar purpose.

31. The remaining applied-for goods in class 9, namely *carpenters' rules; micrometers; tape measures; surveying apparatus and instruments; barometers; telemeters; plumb bobs; plumb lines; gas testing instruments; hygrometers; clinometers; lasers, not for medical purposes; surveyors' levels; thermometers, not for medical purposes; azimuth instruments; infrared detectors; measuring devices, electric; microscopes; cables, electric; wires, electric; junction boxes [electricity]; electric plugs; connections for electric lines*; are measuring devices, or goods used by electricians and plumbers in the construction of plumbing and electrical systems, or specialised goods such as microscopes, lasers and infrared detectors which may have a variety of applications. Aside from the fact that some of these goods may sometimes share trade channels, for example, DIY stores may offer the opponent's protective workwear, headgear and footwear, as well the contested *cables, electric; wires, electric; junction boxes [electricity]; electric plugs; connections for electric lines*, these goods have nothing in common. Their nature, purpose and method of use is different, and the goods are neither complementary, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking, nor in competition. Even considering the potential coincidence in trade channels, in my view these goods are not similar overall. These goods are dissimilar.

Class 7 and 8

32. Whilst I accept that goods in different classes can be similar, I do not accept that the opponent's protective clothing and equipment in class 9 are necessarily similar to the applicant's tools and machines in classes 7 and 8 simply because the applied-for specification includes both protective clothing and equipment in class 9 (which are covered by the opponent's registration) as well as tools and machines in classes 7 and 8 (which are not covered by the opponent's registration). The fact that the applicant has applied for these goods does not demonstrate that the goods are usually produced by the same manufactures and/or that they have converged on the market in such a way that they should be considered to be complementary. I therefore reject the argument.

33. When comparing the opponent's goods in classes 9, 10 and 25 - which are protective workwear, headgear and footwear - with the contested goods in classes 7 and 8 – which are different kinds of tools and machines for, *inter alia*, industrial use, office use, gardening use and use on building sites - it is clear that these goods have a very different nature, purpose and method of use. The evidence filed by Ms Ward introduces copies of webpages (undated) from the websites www.screwfix.com and www.tradepoint.co.uk showing that these retailers offer both hand tools and power tools, and safety workwear.³ Whilst I accept that the goods may share trade channels, this fact alone does not render these goods similar, and they are not necessarily complementary in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods lies with the same undertaking. Therefore, I consider these goods to be dissimilar.

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

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by

³ MW1-MW2

holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

35. Accordingly, the opposition under Section 5(1) and 5(2)(a) fails in relation to the goods which I found to be dissimilar, namely:

Class 7: *Lawnmowers [machines]; saws [machines]; shredders [machines] for industrial use; wrapping machines; sealing machines for industrial purposes; mixing machines; stone-working machines; pneumatic jacks; electric hammers; cutting machines; metalworking machines; chain saws; cutting blow pipes, gas-operated; glaziers' diamonds [parts of machines]; electric hand drills; compressed air guns for the extrusion of mastics; glue guns, electric; nail extractors, electric; screwdrivers, electric; painting machines; spray guns for paint; dynamos; motors, electric, other than for land vehicles; compressed air pumps; compressed air machines; centrifugal pumps; bearing brackets for machines; door closers, electric; door openers, electric; welding machines, electric; soldering apparatus, gas-operated; electric arc cutting apparatus; waste disposal units; dust exhausting installations for cleaning purposes.*

Class 8: *Stropping instruments; pickhammers; awls; bow saws; nail extractors, hand-operated; hand drills, hand-operated; stone hammers; frames for handsaws; tap wrenches; axes; nail nippers; planes; taps [hand tools]; screwdrivers, non-electric; vices; tool belts [holders]; wire strippers [hand tools]; bench vices [hand implements]; emergency hammers; guns, hand-operated, for the extrusion of mastics; air pumps, hand-operated; palette knives; trowels; glaziers' diamonds [parts of hand tools]; pruning scissors; box cutters; handles for hand-operated hand tools.*

Class 9: *carpenters' rules; micrometers; tape measures; surveying apparatus and instruments; barometers; telemeters; plumb bobs; plumb lines; gas testing instruments; hygrometers; clinometers; lasers, not for medical purposes;*

surveyors' levels; thermometers, not for medical purposes; azimuth instruments; infrared detectors; measuring devices, electric; microscopes; cables, electric; wires, electric; junction boxes [electricity]; electric plugs; connections for electric lines.

Average consumer

36. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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. (as he then was) 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 of the parties' goods in class 9 will be a member of the general public, workmen/women, or a business user purchasing safety equipment for use in a commercial context. The goods at issue are likely to be selected visually from the shelves of a retail shop (or its online equivalent), catalogues or the website or premises of a specialist. However, 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 average consumers will pay a degree of attention ranging from medium (e.g. safety nets, reflective safety vests) to above medium (e.g. protective helmets),

depending on the cost of the item and taking into account that the goods at issue are goods that are used for safety and/or protection of the user.

Comparison of marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

40. 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.

41. The respective marks are shown below:

The applicant's mark	The opponent's mark
Steelite	Steelite

42. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

43. The marks are identical, and the applicant seems to implicitly accept it in its counterstatement as it does not explicitly deny it. I note that there are gaps between the letters ‘l’, ‘i’, ‘t’ and ‘e’ which are fractionally larger than the gaps between the letters ‘S’, ‘t’, ‘e’ and ‘e’. However, these differences are so insignificant that they will go unnoticed by an average consumer, and I consider the marks to be identical. Given my findings that the goods are identical, and that the marks are identical, the ground under Section 5(1) succeeds. However, given that I have made a back-up finding that the goods would be similar to a medium degree even if not identical, I will continue with the Section 5(2)(a) assessment.

Distinctive character of earlier mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

45. 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.

46. I will begin by assessing the inherent distinctiveness of the earlier mark. The earlier mark consists of the word ‘Steelite’, presented in title case. Although the word ‘Steelite’ is an invented word, the average consumer is likely to recognise that it is made up of the words ‘Steel’ and ‘lite’ which will be taken to refer to a characteristic of the goods, namely that they incorporate some components made of steel and are lightweight in the sense that they use lightweight materials or are comfortable to wear. This is borne out by the opponent’s evidence which shows use of the mark in relation to footwear having protective steel toecaps and/or steel midsoles and a lightweight rubber outsole. For these reasons, I consider that the mark ‘Steelite’ is distinctive to only a low to medium degree.

47. I will now consider whether the distinctiveness of the earlier marks has been enhanced through use.

48. Mr Hughes’ evidence is very brief. He states that the opponent is a global manufacturer and distributor of work wear, safety footwear and personal protective equipment, that the company was founded in 1904 in Ireland and that the ‘Steelite’ range of products was launched in 2006.

49. Mr Hughes says that “for the UK it is estimated that sales of products under the ‘Steelite’ brand for the past five years” are as follows:

Year	UK Sales (Euros)
2018	3,038,645
2019	4,820,718
2020	3,888,559
2021	5,103,688
2022 to date	2,576,380

50. According to Mr Hughes, sales of ‘Steelite’ products are made via the opponent’s website at www.portwest.com, as well as through distributors and third-party retailers, including workwear specialists and retailers of building products. Images of ‘STEELITE’ branded products from catalogues (2017), social media (2019) and websites (undated) are provided. The only goods in relation to which the mark ‘STEELITE’ appears to be used are items of footwear/safety footwear. There is no evidence whatsoever that the mark has been used in relation to other goods.

51. Although the opponent has provided sale figures, they are not corroborated by any invoices; ordinarily, this would not be fatal, however, given that the figures provided are described as ‘estimates’ I would expect to see something to back them up or some explanation as to how the estimates have been reached or calculated. Further, since the sales figures are quite significant (amounting to nearly 20million euros in the period 2018-2022), one would expect to find that the opponent has made significant investment efforts, however, no marketing figures have been provided. Further, although Mr Hughes says that the opponent is a global manufacturer and distributor of work wear, safety footwear and personal protective equipment, the evidence only shows use in relation to footwear and Mr Hughes does not explain what type of goods have been sold under the brand ‘STEELITE’. Consequently, although the evidence includes some significant estimated sale figures, in the absence of any evidence about (a) what type of goods have been sold under the mark and whom they have been sold to, (b) the amount spent in promoting the mark, (c) the market share held by the mark and (d) how geographically widespread the use of the mark has been, I am not prepared to conclude on the basis of estimated sales figures alone and extracts from product catalogues, that the distinctiveness of the mark has been enhanced though

use. In any event, as the evidence only appears to relate to footwear/protective footwear, and those goods are dissimilar to the contested goods in issue, enhanced distinctiveness in relation to protected footwear would not assist the opponent.

Likelihood of confusion

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

53. Earlier in this decision I have concluded that some of the contested goods are identical, (or at least similar to a medium degree), and some are dissimilar to the opponent's goods. As I have said above, for the goods that are dissimilar the opposition necessarily fails. The average consumer of the goods at issue is a member of the general public, workmen/women, or a business user purchasing safety equipment for use in a commercial context. The goods will be selected visually, although I do not discount aural considerations and the degree of attention paid during the purchase will range from medium to above medium. The marks are identical. The earlier mark is distinctive to a low to medium degree.

54. Given the identity between the competing marks, it is my view that the average consumer will be directly confused, even if the goods were similar to a medium degree (rather than identical), due to the interdependency principle. There is a likelihood of direct confusion. The opposition under Section 5(2)(a) partially succeeds for the goods which I have found to be (if not identical) similar.

Section 5(4)(a)

55. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

56. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

57. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

58. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

Goodwill

59. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

60. In the present case there is no evidence of use of the contested mark⁴ so the relevant date for the assessment under Section 5(4)(a) is the priority date of the applied-for mark being 04 February 2021.

61. Given my criticism of the opponent's evidence, my primary finding is that despite the large turnover figures, the gaps in the opponent's evidence are such that the most I can find is that the opponent has used the sign 'Steelite' in relation to footwear and safety footwear and that the sign 'Steelite' is distinctive of the opponent's goodwill. However, given the absence of exact figures about the type of goods sold, the absence of invoices and the lack of details about the opponent's customers, I can only find that if the opponent had any goodwill in the sign at the relevant date, it was small.

⁴ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

62. The opponent's best case is therefore that it has a small goodwill for footwear/protective footwear. As the opposition has partially succeeded under Section 5(1) or 5(2), I will consider the claim under Section 5(4)(a) only in relation to the goods that I found to be dissimilar to the opponent's goods under Section 5(1) or 5(2), namely those in classes 7 and 8 plus the following goods in class 9:

Class 9: *carpenters' rules; micrometers; tape measures; surveying apparatus and instruments; barometers; telemeters; plumb bobs; plumb lines; gas testing instruments; hygrometers; clinometers; lasers, not for medical purposes; surveyors' levels; thermometers, not for medical purposes; azimuth instruments; infrared detectors; measuring devices, electric; microscopes; cables, electric; wires, electric; junction boxes [electricity]; electric plugs.*

63. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

"There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although "the plaintiff and the defendant were not competing traders in the same line of business". In the *Lego* case *Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the

plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

64. Comparing these goods with the opponent's footwear/protective footwear, I find that given the distance between the goods - which are far removed from each other - the size of the opponent's goodwill - which is small - and the descriptive connotation of the earlier sign, the relevant public will not be misled into purchasing the applicant's goods in the belief that they are the opponent's goods. Hence, the claim for passing off fails in relation to the same goods for which the opposition based upon Section 5(1) and 5(2)(a) has been failed.

Section 5(3)

65. Section 5(3) states:

"(3) A trade mark which-

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

66. Section 5(3A) states:

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

67. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and*

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

68. The relevant date for the assessment under Section 5(3) is the priority date of the applied-for mark being 04 February 2021.

Reputation

69. 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.”

70. Under its Section 5(3) ground, the opponent relies on the same registrations as it did under its Section 5(1) and 5(2)(a) ground and claims to have obtained a reputation in relation to, *inter alia*, *footwear*.

71. The general rule is that in order to establish the reputation of the earlier mark it is not sufficient to show that the earlier mark has been used in the UK on particular types of goods, but the evidence must satisfy the criteria laid down by the CJEU for establishing the reputation of the mark among the relevant public. Whilst the opponent's evidence may be capable of establishing that the earlier mark was used in the UK between 2018 and 2022, that the goods were included in product catalogues and were available for sale in some shops or online, and that a large amount of goods were estimated to be sold, there is no information about the amount and types of goods sold, how the goods were marketed, how much the opponent invested in promoting the mark, the areas in which the goods were marketed and sold and the market share held by the mark. Hence, my conclusion is that the opponent has come nowhere near to proving that the earlier mark has acquired a reputation in the UK at the relevant date, not even in relation to the goods which appear in the catalogues or on the websites, all of which are items of footwear/protective footwear.

72. The opposition based upon Section 5(3) fails at the first hurdle.

CONCLUSIONS

73. The opposition succeeds for the following goods which will be refused registration:

Class 9: *fire hose nozzles; fire hose; fire extinguishing apparatus; fire pumps; workmen's protective face-shields; protective helmets; safety nets; gloves for protection against accidents; life belts; reflective safety vests; anti-glare glasses.*

74. For the goods which I found to be identical, the opposition succeeds under Section 5(1); however, if I am wrong and some of the above goods are only similar, the opposition succeeds under Section 5(2)(a).

75. The application will proceed for the following goods because they have not been opposed or because the opposition has failed in relation to them:

Class 7: *Lawnmowers [machines]; saws [machines]; shredders [machines] for industrial use; juice extractors, electric; wrapping machines; sealing machines for industrial purposes; mixing machines; blenders, electric, for household purposes; kitchen grinders, electric; stone-working machines; pneumatic jacks; electric hammers; cutting machines; metalworking machines; chain saws; cutting blow pipes, gas-operated; glaziers' diamonds [parts of machines]; electric hand drills; compressed air guns for the extrusion of mastics; glue guns, electric; nail extractors, electric; screwdrivers, electric; painting machines; spray guns for paint; dynamos; motors, electric, other than for land vehicles; compressed air pumps; compressed air machines; centrifugal pumps; bearing brackets for machines; door closers, electric; door openers, electric; welding machines, electric; soldering apparatus, gas-operated; electric arc cutting apparatus; washing installations for vehicles; waste disposal units; dust exhausting installations for cleaning purposes; parquet wax-polishers, electric; suction nozzles for vacuum cleaners; curtain drawing devices, electrically operated; shoe polishers, electric; 3D printing pens.*

Class 8: *Stropping instruments; pickhammers; beard clippers; manicure sets; awls; bow saws; nail extractors, hand-operated; hand drills, hand-operated; stone hammers; frames for handsaws; tap wrenches; axes; nail nippers; planes; taps [hand tools]; screwdrivers, non-electric; vices; tool belts [holders]; wire strippers [hand tools]; bench vices [hand implements]; emergency hammers; guns, hand-operated, for the extrusion of mastics; air pumps, hand-operated; palette knives; trowels; glaziers' diamonds [parts of hand tools]; hobby knives [scalpels]; scissors; pruning scissors; box cutters; handles for hand-operated hand tools; table forks.*

Class 9: *Money counting and sorting machines; counterfeit coin detectors; time recording apparatus; punched card machines for offices; scales; slide calipers; carpenters' rules; micrometers; vehicle breakdown warning triangles; rearview cameras for vehicles; slide projectors; projection screens; stands for photographic apparatus; video projectors; tape measures; surveying apparatus and instruments; barometers; telemeters; plumb bobs; plumb lines; gas testing instruments; hygrometers; clinometers; lasers, not for medical purposes;*

surveyors' levels; thermometers, not for medical purposes; azimuth instruments; infrared detectors; measuring devices, electric; microscopes; cables, electric; wires, electric; junction boxes [electricity]; electric plugs; connections for electric lines; video screens; electrical adapters; anti-theft warning apparatus; locks, electric; battery chargers; batteries, electric.

Class 12: *Pumps for bicycle tyres; air pumps [vehicle accessories]; air pumps for automobiles; air pumps for motorcycles; air pumps for bicycles; pumps for bicycle tyres; drink holders for vehicles; back seats specially adapted for use in vehicles; upholstery for vehicles; vehicle covers [shaped].*

COSTS

76. Both parties have achieved a level of success in these proceedings. However, on balance, the applicant has been more successful than the opponent, and would ordinarily be entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds, the Tribunal invited the applicant to indicate whether it wished to make a request for an award of costs and, if so, to complete the attached pro-forma including a breakdown of its actual costs. The applicant failed to return the pro-forma. As it incurred no official fees in the defence of its application, I make no award of costs in this matter.

Dated this 4th day of April 2023

**Teresa Perks
For the Registrar**