

O/0418/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3649945
BY HANGZHOU YUEWO E-COMMERCE CO., LTD**

TO REGISTER:

Boresnake

AS A TRADE MARK IN CLASS 13

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 430439 BY
BUSHNELL INC.**

BACKGROUND AND PLEADINGS

1. On 2 June 2021, Hangzhou Yuewo E-Commerce Co, Ltd (“the applicant”) applied to register **Boresnake** as a trade mark in the United Kingdom in respect of the following goods:

Class 13

Apparatus for filling cartridge belts; Cartridge loading apparatus; Cartridge pouches; Gunstocks; Rifle cases; Sighting mirrors for rifles; Sights, other than telescopic sights, for artillery; Shoulder straps for weapons; Sprays for personal defence purposes.

2. On 21 January 2022, the application was opposed by Bushnell Inc. (“the opponent”). The opposition is based on section 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods in the application.

3. The opponent claims to have used the sign **BORESNAKE** throughout the UK since around 2011 for the following goods:

Gun cleaning bore brushes; cleaning brushes for firearms; Material for brush-making; cloths for cleaning; cleaning instruments, hand-operated pads for cleaning.

4. The opponent claims to have acquired substantial goodwill under this sign and that consumers in the UK would recognise the sign as being distinctive of goods originating from the opponent. It asserts that the applicant’s use and/or registration of the contested mark would constitute a misrepresentation to the relevant public that the applicant is connected to the opponent in some way or endorsed by it, when that is not the case. Such a misrepresentation would lead to damage to the opponent’s goodwill, including to the distinctiveness and repute of the sign.

5. The applicant filed a defence and counterstatement denying the claims made. In particular, it asserts that there is no evidence that the opponent has used the sign prior

to the filing date of the application.¹ It claims that it has a proven sales record for goods under the contested mark and states that it has successfully registered **Boresnake** in the EU and has a Registered Community Design for a Boresnake device.

EVIDENCE AND SUBMISSIONS

6. The opponent filed evidence in the form of a witness statement from David Leis, Vice President, Government and International Sales, of Bushnell Inc, dated 25 October 2022. The witness statement is accompanied by 14 exhibits and goes to the claim of goodwill associated with the sign.

7. The opponent also filed a witness statement from Tobias Sitch, Head of Purchasing at Frankonia Handels GmbH & Co KG, a distributor of hunting equipment, dated 26 October 2022. Mr Sitch states that his company distributes the opponent's goods in Germany, Austria, France and other EU countries. These include cleaning products for guns marked with the earlier sign, which it has distributed since 2003, selling €358,906 of products from 2018 to 2021.

8. No evidence was filed by the applicant. On 23 December 2022, the applicant requested an extension of time to file evidence. The Registry did not consider that the reasons given were sufficient to allow it to agree to the request and so it was refused. The applicant did not challenge the refusal.

9. Neither party requested a hearing and both filed written submissions in lieu on 13 February 2023.

REPRESENTATION

10. The opponent is represented by D Young & Co LLP, while the applicant is represented by Marcin Ociepka.

¹ The counterstatement here says that "There is no evidence that the applicant has made any use of the contested mark", but in the context of the rest of the counterstatement I take this to be a typing error.

PRELIMINARY POINT

11. I shall deal first with the applicant's claim that it owns an EU Trade Mark for the word "Boresnake" and a Registered Community Design for a Boresnake device. I agree with the opponent that the registration of these rights does not automatically entitle the applicant to trade mark protection in the UK, as this is a separate jurisdiction. I shall therefore say no more on this point.

DECISION

12. Section 5(4)(a) of the Act states that:

"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 or 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 4(A) is met

..."

13. Subsection 4(A) is as follows:

"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."

14. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off:

"First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by

association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."²

15. *Halsbury's Laws of England* Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception:

"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 reputation 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 source 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.

² Page 406.

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 are 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.”³

16. The relevant date in these proceedings is the date of the commencement of the conduct complained of: see *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 270, paragraph 165. That is the date of application for the contested mark, i.e. 2 June 2021. As the applicant has filed no evidence to substantiate the claim made in its counterstatement that it has used this mark before applying for it, there is no need for me to consider the position on any other date.

³ §636, with footnotes omitted.

Goodwill

17. The opponent must show that it had goodwill in a business at the relevant date and that the sign relied upon is associated with, or distinctive of, that business. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”⁴

18. I begin by reminding myself that the establishment of goodwill requires customers in the UK, see *Starbucks (HK) Limited & Anor v British Sky Broadcasting Group Plc & Ors* [2015] UKSC 31, paragraph 47. Therefore, the evidence of Mr Sitch relating to sales in Germany, France and Austria does not assist the opponent. I shall therefore focus on the evidence of Mr Leis.

Trading under the earlier sign

19. The product that is sold under the **BORESNAKE** sign is a device for cleaning the bore of a gun. Mr Leis states that it was created by Frank Hoppe in 1903 in the United States and first sold in the UK in 2011.⁵ The goods are distributed to UK retailers such as Amazon and specialist shooting suppliers through a company called Edgar Brothers Limited (“Edgar”). Website print-outs from UK retailers are available in Exhibit DL5, but are undated.

⁴ At [224].

⁵ Witness statement, paragraph 6.

20. Exhibit DL7 contains sample invoices from the opponent and Edgar's trade price list from March 2015. The invoices are dated 19 October 2012, 12 February 2013 and 2 January 2014 and show sales of around 7,500 items at just over \$40,000 (2012 and 2013) and £3,200 (2014). The only UK total sales figures that are given date from 2021 and 2022 are \$50,956.94 and \$18,552.94 respectively.⁶ As the relevant date for these proceedings is 2 June 2021, only a proportion of the first figure can be taken into account. However, elsewhere, the opponent states that around 6,000-7,000 units are sold per year and estimates that this amounts to around 26% of the market for "pull-through" bore cleaning devices.⁷

21. Mr Leis states that the sign has been advertised through TV advertising, social media and public relations. In Exhibit DL9, he shows some brief information about advertisement that appeared on Facebook and YouTube since April 2019. However, the reach, in terms either of numbers of viewers or their locations, of the advertisement is not stated. It is also not clear how many social media followers were based in the UK.

22. Mr Leis states that the sign has been widely promoted in "*mainstream UK media*".⁸ The articles in Exhibit DL12 appear to me to be taken from the specialist press, aimed at hunting and shooting enthusiasts. While some are undated, those that have dates were published between 2011 and 2016. Mr Leis also draws my attention to a selection of reviews and blog posts in Exhibit DL13, but as many of the prices are in dollars I infer that at least some of these are US-based.

23. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with

⁶ Exhibit DL6.

⁷ Exhibit DL8.

⁸ Paragraphs 19 and 20.

evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s. 11 of the 1938 Act (see *Smith Hayden & Co Ltd's Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

24. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."⁹

25. Although I do not have total sales figures for a number of years, there is, in my view, sufficient evidence to show that gun cleaning devices were being sold under the

⁹ Paragraph 8.

sign from 2011 to the relevant date. Furthermore, the applicant appears to accept that the earlier sign has been present on the UK market for some time.¹⁰ Where there are sales figures, these are not huge, but I must bear in mind that the product is a specialist one, for which the market itself is relatively small. As at 31 March 2021, 585,929 people held a firearm or shotgun certificate, which was a 3% decrease on the previous year.¹¹ I am satisfied that the level of trade is such as to establish a protectable goodwill for gun cleaning bore brushes. There is no evidence relating to any of the other goods on which the opponent seeks to rely.

Is the sign distinctive of the opponent's business?

26. The applicant submits that the term “boresnake” has become the recognised term in the trade for a tool used to clean the inside of the barrel of a gun. It draws my attention to the opponent’s Exhibit DL2, which contains a short extract from Military Wiki, which is as follows:

“Bore snake

A **cleaning cord** is a tool used to clean the inside (bore) of the barrel of a gun, such as Hoppe’s BoreSnake. It resembles a short section of rope with a smaller, weighted cord attached to one end to help feed the cleaning cord through the barrel. A cleaning cord often has one or more integrated brushes to help clean the barrel, and may also be used to apply lubricant. It is an alternative to using a cleaning rod and patches to clean the barrel of a gun. Cleaning cords are made in different sizes for different calibers and gauges of guns.”

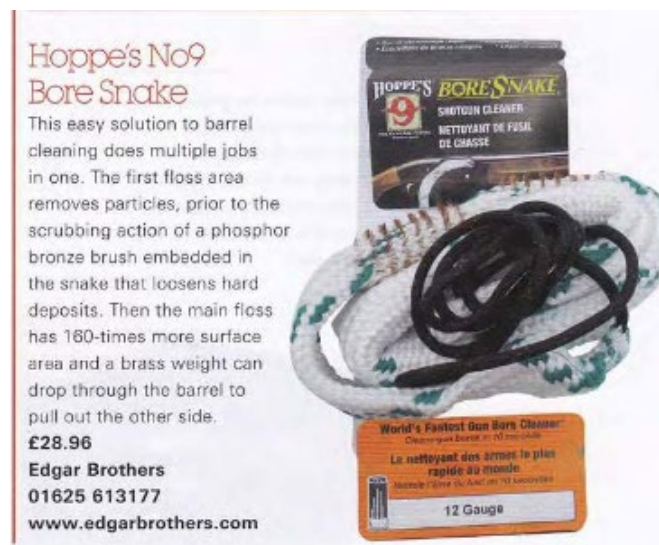
27. This entry is undated, but even if it were it does not by itself convince me that “boresnake”, rather than “cleaning cord”, is the term used to describe the product in question.

¹⁰ Written submissions in lieu of a hearing, paragraph 5.

¹¹ Exhibit DL8, page 3.

28. The applicant then submits that the term has been used by other traders in the UK, and that this is demonstrated in the opponent Exhibit DL5. It also submits that, if the opponent had rights in the earlier sign, it would have challenged the use by these other parties. I accept that the listings in this exhibit show that the term has been used by other companies.¹² However, none of this use by other undertakings is dated, so I am unable to discern what the position might have been at the relevant date of 2 June 2021. The evidence falls short of what would be required to show that the term had become commonly used in the trade by the relevant date.

29. Finally, the applicant submits that the sign is always preceded by another sign: **Hoppe's**. Hoppe, it will be recalled, was the name of the originator of this type of gun-cleaning device. I have provided an example below, which shows the product packaging at some point during the period 2012-2018 and is indicative of the way the product is described throughout the evidence:¹³



30. The image below is taken from what appears to be promotional literature from Edgar dated 2013. It shows a point of sale display, with both a Hoppe's logo and a larger stylised **BORESNAKE** sign.¹⁴

¹² See, for example, pages 2-4.

¹³ Exhibit DL12, page 12. The image is taken from *Clay Shooting*.

¹⁴ *Ibid*, page 18.

FREE HOPPES GUN CARE SELECTION!
WITH EVERY BORE SNAKE DISPLAY
ALL FOR ONLY £479

DISPLAY CONTAINS...
 HOPP-24010 BORE SNAKE .17HMR x 6
 HOPP-24011 BORE SNAKE .22 Cal x 6
 HOPP-24012 BORE SNAKE 6mm x 6
 HOPP-24014 BORE SNAKE .270/7mm x 6
 HOPP-24015 BORE SNAKE .30 Cal x 6
 HOPP-24031 BORE SNAKE .410 x 6
 HOPP-24033 BORE SNAKE 20ga x 6
 HOPP-24035 BORE SNAKE 12ga x 6
 FREE HOPP-904G No.9 SOLVENT SYNT BLEND 5oz X 6
 FREE HOPP-1003G No.9 LUBE OIL SYNT BLEND 2.5oz X 8
 FREE HOPP-1605 No.9 LUBE OIL AEROSOL 4oz X 6
 FREE HOPP-MDL No.9 MDL AEROSOL 4oz X 6
 FREE BORE SNAKE DISPLAY STAND

BORE SNAKE USUAL TRADE £535.86 +VAT / HOPPES GUN CARE SELECTION USUAL TRADE £72.40 +VAT / TOTAL TRADE PRICE £608.26 +VAT

31. There are two examples in the evidence that show use of the opponent's name "Bushnell" in connection with the goods in a way that would be seen by the end-consumer. The first is shown below and is taken from material published by Edgar in 2016:¹⁵

Bushnell® **BUY 2 GET 1 FREE**

Hoppe's BoreSnake quickest, three-step bore shine. One pass loosens large particles, scrubs out the remaining residue with a bronze brush, then swabs it all spotless with a cleaning area 160x larger than a standard patch. Add a few drops of Hoppe's No. 9 Lubricating Oil and your gun's ready for storage. Packable, available for rifles, shotguns and pistols, brass weight on the pull cord is stamped with the size, machine washable, Patented one-piece design.

***£6.66 EACH**

HOPP-240** BORE SNAKES ALL CALIBRES, NEW LOWER TRADE £9.99 +VAT EACH (*2+1 FREE PRICE £6.66 SAVE £3.33 EACH) OFFER EXCLUDES VIPER

32. The second is a print out from www.brownells.co.uk, a specialist retailer.¹⁶ It is, however, undated.

¹⁵ *Ibid*, page 4.

¹⁶ Exhibit DL5, page 17.


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Wheeler
ARMORER TOOLS

SALE
20% OFF! INFO

BUSHNELL VIPER BORE SNAKE

BUSHNELL VIPER BORE SNAKE, 12 GA.
Braided nylon, pull-through cleaning cord scrubs, cleans, and lubricates in a single step, just like the original Bore Snake, with 50% more scrubbing surface for those extra-tough cleaning jobs. Apply bore cleaner to the front of the cord, oil to the end, drop the weighted end down the bore, and pull through. More...
Product no.: 593000098



Bushnell

593000098
BUSHNELL VIPER BORE SNAKE, 12 GA.
Mr Part: 24035V

£33.25 *
10+ In stock, delivery from Brownells USA within 7-10 days

Specs:
Caliber: 12 Gauge
Style: Shotgun

Details

Attributes
Caliber: 12 Gauge
Style: Shotgun
Delivery weight: 0.045kg

Description

Heavy-Duty, All-in-One, Pull-Through Cleaning System
Braided nylon, pull-through cleaning cord scrubs, cleans, and lubricates in a single step, just like the original Bore Snake, with 50% more scrubbing surface for those extra-tough cleaning jobs. Apply bore cleaner to the front of the cord, oil to the end, drop the weighted end down the bore, and pull through. Repeat as needed. Cone-shaped, nylon bore guide on lead end protects your gun's rifling. Extra, built-in bronze brushes and braided cord clean and oil the bore in a few passes. Washable and reusable.

SPECS: Braided nylon cord, embedded phosphor-bronze bristle brushes, brass weight.

33. I note that a Google search for uses of “boresnake” in the UK before 30 June 2021 produces as its first result a page from the same retailer dated 28 January 2017. This also refers to “Bushnell”. However, it is the only one of around 50 hits to do so.¹⁷

34. While the evidence shows that the earlier sign is most often used with “Hoppe’s” or the Hoppe’s logo, I am satisfied that the term “Hoppe’s”, the Hoppe’s logo, and the **BORESNAKE** sign all form part of the attractive force that brings in custom.

Ownership of the goodwill

35. Article 2 of the Trade Marks (Relative Grounds) Order 2007, SI 2007 No. 1976, states that:

“The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.”

¹⁷ Exhibit DL3.

36. As I have found that the earlier sign has been frequently used together with the term “Hoppe’s”, I must consider whether the opponent owns the goodwill. This is ultimately a question of fact. The editors of *Wadlow on the Law of Passing-Off*, 6th edition, set out the following questions as relevant in determining the ownership of any goodwill:

“(1) Are the goods bought on the strength of the reputation of an identifiable trader? (2) Who does the public perceive as responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory? (3) Who is most responsible in fact for the character or quality of the goods? (4) What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill? For example, goodwill is more likely to belong to the manufacturer if the goods are distributed through more than one dealer, either at once or in succession. If more than one manufacturer supplies goods to a dealer and they are indistinguishable, the dealer is more likely to own the goodwill.”¹⁸

37. The opponent submits that the evidence of Mr Leis explains the relationship between the opponent and the Hoppe’s brand:

“Bushnell was created in 1948 in Pasadena, California (US) by Dave Bushnell as a small photographic shop before growing into a worldwide sports optics company. In 1972, Dave Bushnell sold Bushnell to Bausch and Lomb. In 1995, Bausch & Lomb sold Bushnell to Wind Point Partners that was purchased by MidOcean Partners. MidOcean Partners sold Bushnell to Alliant Tech Systems (ATK) in 2013. In 2014, ATK spun-off into Vista Outdoor. Today, Bushnell is a part of a family of brands under the Vista Outdoor brand alongside Hoppe’s. Documents detailing the history of Bushnell Inc and the relationship between Bushnell, Vista Outdoor and Hoppe’s, including the Vista Outdoor webpage that lists the entirety of Bushnell’s affiliates, are attached thereto as Exhibit DL1.”¹⁹

¹⁸ §3-295.

¹⁹ Witness statement of David Leis, paragraph 4.

38. Exhibit DL1 contains the following items:

- i) An article entitled “Your Hometown Outdoor Tech Company. Bushnell Distance-Finding Devices Make Golf Fun Again” from *Tee Times Golf Guide*, dated November 2019. It is an interview with the Store Manager of the Bushnell Factory Outlet who set out the history of the company. He says “*Today, Bushnell is part of a ‘house of brands’ under the Vista Outdoor brand*” and “*Most people think of binoculars when they hear the name Bushnell*”.²⁰
- ii) An undated print-out from the opponent’s website which says that “*Bushnell has been the industry leader in high-performing sports optics for more than 65 years.*”²¹
- iii) A print-out from zippia.com showing a timeline of the company history of Vista Outdoor.²²
- iv) A print-out from vistaoutdoor.com which lists Bushnell and Hoppe’s among its brands.²³

39. These documents do not entirely explain the relationship between the various brands and the corporate structure of the opponent and its affiliates could have been presented more clearly. I have also considered whether there is any other evidence that sheds a light on the ownership of the goodwill. The 2012, 2013 and 2014 invoices to Edgar in Exhibit DL7 come from Bushnell Outdoor Products, and I have already referred in paragraph 31 above to the advertisement from a 2016 publication by Edgar. Finally, a review of the “Hoppes BoreSnake Viper” on the website letstalksurvival.com dated 17 July 2013 states that Bushnell Outdoor Products is the parent company of Hoppe’s.²⁴ As Hoppe’s is one of the Vista family of brands, as is the opponent, I am satisfied as to the relationship between Bushnell Outdoor Products and Bushnell Inc.

40. I remind myself that a decision taker should not resort to the burden of proof unless, having striven to do so, they find it impossible to make a decision on the weight of the

²⁰ Page 2.

²¹ Page 3.

²² Pages 4-5.

²³ Pages 6-7.

²⁴ Exhibit DL13, page 32.

evidence: see *Cooke v Watermist* [2014] EWHC 125 (Pats), paragraph 35. I consider that there is sufficient evidence for me to infer that the opponent owns the goodwill. I also note that the applicant's submissions that the opponent did not own any goodwill related to the earlier sign focused on the question of the distinctiveness (or otherwise) of the sign. It did not make any submissions challenging the statements made about the corporate structure of the opponent and its related companies.

Misrepresentation

41. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473:

"There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

'is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product].

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101."²⁵

42. The applicant submits that there would be no misrepresentation as the term "Boresnake" is seen by the relevant consumers as denoting a type of product. I have already found that there is no evidence to support this view.

²⁵ Page 493.

43. The opponent submits that misrepresentation is highly likely given the identity of the contested mark to the earlier sign and the close similarity between the goods. If it were to be registered, the contested mark would protect the word “Boresnake” regardless of capitalisation, typeface or colour: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16. Therefore, I agree with the opponent that the contested mark and sign are identical.

44. The goods for which registration is sought are all accessories for use with guns. They therefore share a common field of activity with the opponent’s *Gun cleaning bore brushes*. The courts have been clear that an important consideration in deciding on the likelihood of misrepresentation is “*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*”: see *Annabel’s (Berkeley Square) Ltd v G Schock (t/a Annabel’s Escort Agency)* [1972] RPC 838 at page 844.

45. In *Neutrogena*, Morritt LJ stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgement which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff’s customers or potential customers had been deceived for there to be a real effect on the plaintiff’s trade or goodwill.”²⁶

46. The opponent’s customers are gun users and, given the identity of the mark and sign and the closeness of the field of activity, it is my view that a substantial number of them are likely to be misled into purchasing the applicant’s goods in the belief that they are those of the opponent. Misrepresentation is therefore made out.

Damage

47. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett LJ described the requirements for damage in passing off cases as follows:

²⁶ Page 493.

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff’s goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff’s reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant’s plastic irrigation equipment might be dissuaded from buying one of the plaintiff’s plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”²⁷

48. While the applicant’s and opponent’s goods share a common field of activity, I do not consider that the applicant’s goods are substitutable for the opponent’s. A customer seeking a gun cleaning device will not have their needs met by any of the applicant’s goods. Therefore, I cannot see how there is a risk of diverted sales.

49. In *Ewing v Buttercup Margarine Company Limited* [1917] 2 Ch 1 (COA), Warrington LJ stated that:

“To induce the belief that my business is a branch of another man’s business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

50. I consider that the damage would take the form of injurious association and the loss of control over the opponent’s goodwill and reputation.

²⁷ Page 715

OUTCOME

51. The opposition is successful and Application No. 3649945 is refused.

COSTS

52. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice No. 2/2016. I therefore award the opponent the sum of £1900, which is calculated as follows:

<i>Preparing a statement and considering the other side's statement:</i>	£300
<i>Preparing evidence:</i>	£1000
<i>Preparing written submissions in lieu of a hearing:</i>	£400
<i>Official fees:</i>	£200
TOTAL:	£1900

53. I therefore order Hangzhou Yuewo E-Commerce Co., Ltd to pay Bushnell Inc the sum of £1900. This sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of May 2023

Clare Boucher
For the Registrar,
Comptroller-General