

O/0468/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003603587

BY MAHIR KILIC

TO REGISTER:

SCOUTS Without Borders

AS A TRADE MARK IN CLASSES 25, 26, 35 & 41

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 425850 BY

THE SCOUT ASSOCIATION

BACKGROUND AND PLEADINGS

1. On 2 March 2021, Mahir Kilic (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods and services:

Class 25: Clothing, footwear, headgear; t-shirts; polo shirts; jumpers; coats; hats; neckerchiefs; uniforms.

Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers; buttons; badges; rosettes.

Class 35: Advertising, the bringing together, for the benefit of others, of a variety of goods, namely apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, paper, cardboard, printed matter, photographs, stationery, instructional and teaching material, plastic materials for packaging, books, booklets, magazines, newspapers, catalogues, guides, phone cards, cards, postcards, notepads, envelopes, wrapping and packaging materials, stationery, writing instruments and drawing instruments, pens, pencils and crayons, erasers, pen and pencil cases, pencil sharpeners, rulers, stencils, adhesive tape, paper clips, boxes and holders, calendars, diaries, posters, photograph albums, educational material, printed matter for use with board games, leather and imitations of leather, umbrellas, parasols and walking sticks, whips, harness and saddlery, bags, rucksacks, backpacks, duffel bags, boot bags, holdalls, wallets, credit card holders, belts for luggage, shoulder belts, luggage tags, key fobs made of leather incorporating key rings, furniture, mirrors, picture frames, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, identity tags made wholly or

principally of plastic, key rings, trinkets, fobs, decorative plaques, not of metal, figurines, statues and statuettes, sleeping bags, glassware, porcelain, lunch boxes, flasks, tankards, mugs, pint glasses, lager glasses, wine glasses, champagne flutes, tumblers, whisky tumblers, chinaware, porcelain and paper cups, toothbrush holders, drink bottles, money boxes, tankards, tea pots, egg cups, trays, salt and pepper pots, napkin holders and napkin rings, clothing, footwear, headgear, t-shirts, polo shirts, jumpers, coats, hats, neckerchiefs, uniforms, lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, artificial flowers, buttons, badges, rosettes, placemats, games and playthings, enabling customers to conveniently view and purchase those goods from a general merchandise Internet website or store or via a television shopping channel or from a general merchandise catalogue by mail order or by means of telecommunications; information, consultancy and advisory services relating to all of the aforesaid services.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; camp and sport camp services; arranging and conducting conferences and congresses; organisation of competitions and awards; organising and conducting festivals; arranging of festivals for cultural, educational or recreational purposes; organising commemorative festivals; organising and conducting jamborees; organising and conducting large celebratory events for scouts; developing educational programs for scouts; provision of information relating to entertainment or education, provided on-line from a computer database or the Internet; provision of on-line electronic publication; publication of electronic books and journals on-line; information, consultancy and advisory services relating to all of the aforesaid services.

2. The applicant's mark was published for opposition purposes on 30 April 2021 and, on 29 July 2021, it was opposed by The Scout Association ("the opponent"). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").
3. In respect of the 5(2)(b) and 5(3) grounds, the opponent relies on the following registrations:



(Series of two)

UK registration no: 2252954

Filing date 15 November 2000; registration date 17 August 2001

Relying on all goods and services

("the opponent's first registration");



(Series of two)

UK registration no: 3310891

Filing date 15 May 2018; registration date 21 September 2018

Relying on all goods and services

("the opponent's second registration");



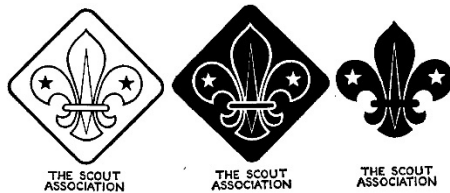
(Series of two)

UK registration no: 3152962

Filing date 3 March 2016; registration date 27 May 2016

Relying on all goods and services

("the opponent's third registration"); and



(Series of three)

UK registration no: 922056

Filing date 6 March 1968; registration date 6 March 1968

Relying on all goods

("the opponent's fourth registration");

4. The goods and services that the opponent relies on under these grounds are set out in the **Annex** to this decision.
5. Under its 5(2)(b) ground, the opponent pleads that the applicant's mark is similar to the opponent's registrations and given that the goods and services covered by both parties' marks are identical and/or similar, there exists a likelihood of confusion, which includes a likelihood of association.
6. In respect of the 5(3) ground, the opponent claims that its registrations enjoy a reputation for all of the goods and services for which they are registered. The opponent claims that the applicant's mark and its own registrations are similar and that as the opponent has established an extensive and significant reputation in the

UK, use of the applicant's mark would unfairly take advantage or ride on the coat tails of said reputation. Further, the opponent argues that use of the applicant's mark would also tarnish or otherwise cause detriment to the reputation and substantially reduce the distinctive character of its registrations.

7. Turning to the opponent's 5(4)(a) ground, it relies on the sign 'SCOUTS', which it claims to have used throughout the UK since 1907. The opponent claims that its sign has been used in respect of the following goods and services:

Class 16: Magazines; printed publications.

Class 25: Clothing; footwear; headgear.

Class 26: Embroidered patches; embroidered badges.

Class 28: Toys; games and playthings.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; camp and sport camp services; arranging and conducting conferences and congresses; organisation of competitions and awards; organising and conducting festivals; arranging of festivals for cultural, educational or recreational purposes; organising commemorative festivals; organising and conducting jamborees.

8. As a result of this use, the opponent claims to have acquired a significant level of goodwill. The opponent contends that use of the applicant's mark would constitute a misrepresentation to consumers in that they are likely to mistakenly believe that the applicant or his goods and services are in some way associated with the opponent. The opponent argues that this misrepresentation will lead to damage in the form of lost sales.

9. The applicant filed a counterstatement denying the claims made.

10. The opponent is represented by Forrester IP LLP and the applicant is unrepresented. Only the opponent filed evidence. No hearing was requested and only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

11. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

12. As above, only the opponent filed evidence. The opponent's evidence in chief came in the form of the witness statement of Steven John Wake dated 21 October 2022. Mr Wake is a Chartered Trade Mark Attorney at the opponent's representative firm and is, therefore, duly authorised to provide evidence on the opponent's behalf. The purpose of Mr Wake's evidence is to introduce written submissions into the proceedings, which he has done by including one exhibit, being that labelled Exhibit SJW1.

13. I have read all of the evidence and submissions and will refer to points from the same where necessary.

PRELIMINARY ISSUES

14. In his counterstatement, the applicant sets out that the application at issue is to register his existing trade mark in English. On this point, I note that his existing trade mark is registered under number UK00003502210 and is a series of the following marks:

The applicant goes on to discuss what he refers to as the ‘Scouts Sans Frontières movement’ and its purpose. Further, in discussing the comparison of the marks at issue, the above registration is included. While the presence of this mark is noted, there is no express reason as to why the applicant sought to raise it in the context of these proceedings. In any event, the above registration owned by the applicant has no impact on the present decision. This is because the present opposition has been raised against the applicant’s mark only meaning that the applicant’s above registration is not at issue here. The fact that the applicant may have a similarly registered mark on the UK trade marks register is not a factor that I am required to consider. I will, therefore, say no more about it.

DECISION

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

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

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

(a) ...

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

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

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

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

17. The trade marks relied on by the opponent qualify as “earlier trade marks” for the purposes of the claimed grounds since they were applied for at an earlier date than the applicant’s mark.¹ While some of the opponent’s registrations had completed their registration processes more than five years before the filing date of the applicant’s mark, the applicant did not request that the opponent provide proof of use for its registrations. Therefore, the opponent’s registrations are not subject to proof of use pursuant to section 6A of the Act. This means that the opponent can rely upon all of the goods and services for which its registrations are registered.

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

¹ See Section 6(1)(a) of the Act

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of goods and services

19. The applicant's goods and services are set out in **paragraph one** of this decision and the opponent's goods and services are set out in the **Annex**.

20. When making the comparison assessing the similarity of the goods or services, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"[...] Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

21. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

22. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if the goods specified in the contested trade mark application are included in a more general category covered by a term under the earlier mark (or vice versa).

23. I have submissions from the opponent in respect of the goods and services at issue. I do not intend to repeat those submissions here but will, if necessary, refer to them further below. I have no real comment from the applicant in respect of the goods and services comparison but note that his counterstatement sets out that he denies “all the objections”.

24. Before moving to consider the comparison of the goods and services, I wish to briefly discuss the class 16 and 25 goods in the opponent’s fourth registration’s specification, being the following:

Class 16: All goods in class 16

Class 25: All goods in class 25

25. These goods are, clearly, incredibly broad and if applied for today, registration of the same would not be permitted.² Despite this, the opponent’s fourth registration stands as validly registered on the UK trade marks register with the above goods and the UK IPO has never sought a narrower goods listing from the opponent. As a result, I have no alternative but to treat the specification as validly covering all

² The registration at issue was registered in 1968, prior to the introduction of the Act.

goods in class 16 and 25 of the Nice Classification³ and to compare them accordingly.

Class 25

26. “Clothing, footwear, headgear” in the applicant’s specification is present in the opponent’s first, second and third marks’ specifications. Following on from what I have said at paragraph 25 above, these goods can also be said to be goods covered by the opponent’s fourth registration also. These goods are, therefore, self-evidently identical.

27. “T-shirts”, “polo shirts”, “jumpers”, “coats”, “hats”, “neckerchiefs” and “uniforms” in the applicant’s specification are present in the second and third marks’ specifications. Again, following on from what I have said at paragraph 25 above, these goods can also be said to be goods covered by the opponent’s fourth registration. These goods are, therefore, self-evidently identical. The opponent’s first registration’s specification includes “clothing, footwear, headgear”, which is a sufficiently broad enough term that encompasses the applicant’s goods meaning that they are identical under the principle outlined in *Meric*.

Class 26

28. I note that the opponent’s first and second registrations include goods in class 26, however, its third and fourth do not. This does not mean that the goods in those registrations cannot be similar to the applicant’s class 26 goods but, for the purpose of this assessment, I will first consider a comparison with the opponent’s first and second marks’ registrations.

29. “Embroidery”, “ribbons and braid”, “buttons” (which appears twice) and “rosettes” in the applicant’s specification are also present in both the opponent’s first and

³ The Nice Classification was established by the Nice Agreement of 1957 and is the international classification of goods and services applied for the registration of trade marks.

second registrations' specifications (albeit categorised as "ribbons and braids" in the opponent's second registration). These goods are self-evidently identical.

30. "Badges" in the applicant's specification appears in the opponent's first registration's specification meaning that these goods are self-evidently identical. In addition, I note that the opponent's second registration's specification includes the terms "novelty buttons [badges]" and "ornamental novelty badges" which are goods that fall within the applicant's broader term. As a result, these goods are also identical on the principle outlined in *Meric*.

31. "Hooks and eyes, pins and needles" in the applicant's specification appears in the opponent's second registration's specification meaning that these goods are self-evidently identical. While this term has no direct counterpart in the opponent's first registration, I consider that there is some similarity between these goods and "embroidery" in that registration's specification. This is because, as far as I understand it, the term "embroidery" is so wide that, while it likely includes a finished embroidered product such as an embroidered badge, it may also cover different types of goods used in the course of creating embroidered goods that are sought by hobbyists such as fabrics and threads, for example. I am of the view that the goods overlap in user in that someone looking to buy general embroidery goods is also likely to use the applicant's goods which are accessories used in embroidery. I also consider that there is an overlap in trade channels as producers of general embroidery goods are also likely to sell the applicant's accessory goods. Further, the goods will be found in the same retailers and, in the case of larger general stores, are likely to be found in the same sections. While the nature, method of use and purposes of these goods differ, I am of the view that there is some degree of complementarity between them as I consider the accessories are likely to be considered as important to the embroidery goods and the average consumer is likely to believe that one undertaking is responsible for both.⁴ Overall, I consider that these goods are similar to a medium degree.

⁴ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

32. “Lace” in the applicant’s specification has no direct counterpart in the opponent’s specifications. While that may be the case, I consider that it is similar to the opponent’s “embroidery” goods in its first and second registrations’ specifications. This is because, as I have outlined above, embroidery goods can include the finished embroidered product such as an embroidered patch, for example. The same can be said for the term “lace” in that it can include a finished product such as a lace trim. While I appreciate that embroidered and laced goods are produced and created in different ways, they are both, at their core, types of knitted or woven fabrics, meaning that there is some overlap in nature. They also have similar purposes in that they can be decorative, worn or even adorned on a user’s clothing. The users are also likely to overlap but I also appreciate that there may be some competition between them as a consumer may wish to purchase a fabric that is embroidered over one that is laced, or vice versa. I do not consider the goods to be complementary. In respect of trade channels, I have nothing before me to suggest that a producer of laced goods also produces embroidered ones but I am of the view that they will be sold via the same retailers or, in larger stores, be found in the same sections. Overall, I consider that the goods are similar to a high degree.
33. “Artificial flowers” in the applicant’s specification has no direct counterpart in the opponent’s specifications. I note that the opponent considers that they are similar to its own class 26 goods but has provided no submissions as to why it considers this to be the case. Aside from a slight overlap in purpose in that artificial flowers may, like embroidered goods, be displayed for decorative purposes, I see no obvious level of similarity in the remaining factors. As a result, I consider that these goods are dissimilar.
34. I turn now to consider whether there is any level of similarity between the applicant’s class 26 goods and the goods in the opponent’s third and fourth registrations’ specifications. Firstly, the opponent’s third registration is registered for “clothing” in class 25 and while the applicant’s class 26 goods can be considered as covering decorative articles that can be worn on clothing and, likely purchased by the same user, I do not consider that this is sufficient to warrant a finding of similarity between them. I do not consider that “clothing” shares any

sufficient levels of overlap in nature, method of use, purpose or trade channels and neither is it in competition with or complementary to the applicant's class 26 goods. Therefore, I find these goods dissimilar. As for the opponent's fourth registration, I remind myself that its class 25 goods are simply "all goods in class 25". Such a term can be said to include goods such as "ready made linings [parts of clothing]", "pocket squares" and "sashes for wear", all of which appear in class 25. It is my view that these goods can be said to share a degree of similarity with "embroidery", "lace", "ribbons and braid", "buttons" and "rosettes" in the applicant's specification. While the nature and methods of use will differ as the opponent's goods are not embroidered, ribbons, braid, buttons or rosettes that will technically be used in different ways, both parties' goods cover adornments to clothing that can be worn for decorative purposes. As a result, there is an overlap in purpose between them. There is also likely to be an overlap in user as both parties' goods will be sought by members of the general public. As for trade channels, I do not consider that these overlap and, lastly, I do not consider that they are competitive or complementary to one another. Overall, I consider these goods to be similar to a low degree.

Class 35

35. I note that the service in the applicant's specification is not separated out in the ordinary way, namely via a semi-colon. Instead, the services are all listed together as one term, albeit separated by the use of a comma. On this point, it appears to me that the applicant's class 35 services include only two terms (notwithstanding the term "information, consultancy and advisory services relating to all of the aforesaid services" which sits at the end of the list of services). These are "advertising" followed by a wide range of retail services. I note that the opponent's submissions accept that its registrations do not cover these services but, all the items under the retail services are nonetheless covered within its registrations' specifications. While this submission is noted, it is clearly not the case that all of the items covered by the applicant's retail services are covered by the opponent's specifications. For example, the applicant's specification covers the following:

“The bringing together, for the benefit of others, of a variety of goods, namely, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, umbrellas, parasols and walking sticks, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, identity tags made wholly or principally of plastic, trinkets, fobs, decorative plaques, not of metal, figurines, statues and statuettes, glassware, porcelain, lunch boxes, flasks, tankards, mugs, pint glasses, lager glasses, wine glasses, champagne flutes, tumblers, whisky tumblers, chinaware, porcelain and paper cups, toothbrush holders, drink bottles, money boxes, tankards, tea pots, egg cups, trays, salt and pepper pots, napkin holders and napkin rings and artificial flowers, enabling customers to conveniently view and purchase those goods from a general merchandise internet website or store or via a television shopping channel or from a general merchandise catalogue by mail order or by means of telecommunications; information, consultancy and advisory services relating to all of the aforesaid services.”

36. The goods retailed under the above services have no counterpart in any of the opponent’s specifications and I see no reason why there would be any level of similarity between these services and the goods of the opponent. I, therefore, find them to be dissimilar. As for the remaining goods covered by the applicant’s retail services, I note that these are as follows:

“The bringing together, for the benefit of others, of a variety of goods, namely, [...] paper, cardboard, printed matter, photographs, stationery, instructional and teaching material, plastic materials for packaging, books, booklets, magazines, newspapers, catalogues, guides, phone cards, cards, postcards, notepads, envelopes, wrapping and packaging materials, stationery, writing instruments and drawing instruments, pens, pencils and crayons, erasers, pen and pencil cases, pencil sharpeners, rulers, stencils, adhesive tape, paper clips, boxes and holders, calendars, diaries, posters, photograph albums, educational material, printed matter for use with board games, leather and imitations of leather, [...] whips, harness and saddlery, bags, rucksacks, backpacks, duffel

bags, boot bags, holdalls, wallets, credit card holders, belts for luggage, shoulder belts, luggage tags, key fobs made of leather incorporating key rings, [...] furniture, mirrors, picture frames, [...] key rings, [...] sleeping bags, clothing, footwear, headgear, t-shirts, polo shirts, jumpers, coats, hats, neckerchiefs, uniforms, lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, [...] buttons, badges, rosettes, placemats, games and playthings, enabling customers to conveniently view and purchase those goods from a general merchandise internet website or store or via a television shopping channel or from a general merchandise catalogue by mail order or by means of telecommunications; information, consultancy and advisory services relating to all of the aforesaid services.”

37. In respect of retail services, when compared with the goods that they cover, I remind myself of the case of *Oakley, Inc v OHIM*, Case T-116/06, wherein the GC, at paragraphs 46-57, held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

38. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services versus goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark

applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

39. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*,⁵ and *Assembled Investments (Proprietary) Ltd v. OHIM*⁶, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*⁷, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

40. I appreciate that, for there to be similarity between the applicant’s goods and the opponent’s services, the goods being retailed by the applicant do not need to be

⁵ Case C-411/13P

⁶ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁷ Case C-398/07P

exactly the same as the opponent's goods. Therefore, I am able to find similarity in respect of the goods and services at issue even if the opponent's goods are not the same as those retailed by the opponent. However, there needs to be some level of similarity as such a finding would not apply to the retail of goods that are entirely unrelated to a different range of goods. It is my view that the above range of goods being retailed are either the same goods or those similar to the goods covered across all of the opponent's registrations' specifications.

41. As set out in the GC cases referred to above, although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore, similar to a degree. In my view, it is common for producers of the goods covered by the opponent's specification to also retail in those goods. For example, a producer of clothing may operate its own retail stores that exclusively sell that producer's goods and, further, it is common for large retailers to also produce and sell their own range of branded goods that may include various goods such as stationery and furniture (being those included in the applicant's range of retail services). In my view, the average consumer will be aware of the complementary relationship between the producer of these types of goods and the retailing of the same. It follows that a medium degree of similarity exists between the applicant's services and the opponent's goods.

42. I appreciate that I have not specified which of the opponent's registrations share this level of similarity with the applicant's retail services at this stage. This will become an issue if, for example, I find a likelihood of confusion between the opponent's third registration and the applicant's mark but not in respect of its first. This is because the opponent's first registration covers a broader range of goods (including goods in class 18 and 20 which, inevitably, form the basis for the present finding of a medium similarity between those goods and the retail services of the same) than its third. In such a scenario, it will be necessary to make a determination between which specific services are similar to the opponent's third registration. However, rather than make findings on this issue at the present stage, I will return

to consider it further upon the conclusion of the 5(2)(b) ground should it be necessary to do so.

43. As set out above, the applicant's specification also includes "advertising" and a secondary term relating to the "information, consultancy and advisory services" of the same. I note that I have no specific submissions from the opponent as to why they would share any degree of similarity. In the absence of such and, on balance, I see no obvious levels of similarity between these services and any of the opponent's goods or services. They are, therefore, dissimilar.

Class 41

44. As mentioned in the opponent's submissions, the class 41 services of the applicant and those in the opponent's second and third registrations are identical and that they have been "blatantly copied". While I cannot speak to whether the applicant intended to copy the opponent's services, they are clearly identical on a word-for-word basis. Therefore, all of the class 41 services in the applicant's specification are self-evidently identical to the class 41 services in the opponent's second and third marks' specifications. While the same word-for-word identity does not apply to the opponent's first registrations' class 41 services, I note that these include a range of education, training, entertainment and organisational services, being the type of services that are covered in the applicant's specification. I am of the view that where the services are not identical (be that self-evidently or under the *Meric* principle), they are highly similar on the basis that they overlap in nature, method of use, purpose, user and trade channels.

45. The opponent's fourth registration does not include any services in class 41 and I see no obvious reason why any of the goods for which it is registered are similar to the applicant's class 41 services.

46. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, this means that the opposition under section

5(2)(b) aimed against those goods and services will fail.⁸ However, the opposition against the remaining goods and services may proceed. For the avoidance of doubt, the dissimilar goods (being those against which the opposition must fail) are as follows:

Class 26: Artificial flowers.

Class 35: Advertising; the bringing together, for the benefit of others, of a variety of goods, namely, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, umbrellas, parasols and walking sticks, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, identity tags made wholly or principally of plastic, trinkets, fobs, decorative plaques, not of metal, figurines, statues and statuettes, glassware, porcelain, lunch boxes, flasks, tankards, mugs, pint glasses, lager glasses, wine glasses, champagne flutes, tumblers, whisky tumblers, chinaware, porcelain and paper cups, toothbrush holders, drink bottles, money boxes, tankards, tea pots, egg cups, trays, salt and pepper pots, napkin holders and napkin rings and artificial flowers, enabling customers to conveniently view and purchase those goods from a general merchandise internet website or store or via a television shopping channel or from a general merchandise catalogue by mail order or by means of telecommunications; information, consultancy and advisory services relating to all of the aforesaid services.

47. I remind myself that there are also findings of dissimilarity between some of the applicant's goods and services and the goods and services in some of the opponent's registrations. In the event I find a likelihood of confusion between some marks, but not others, I will return to consider this issue at that stage.

⁸ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

48. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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.”

49. The average consumer for the class 25 goods at issue will be members of the general public at large. These goods are ordinary clothing items that are relatively inexpensive and, while not typically purchased on a frequent basis, they will be sought somewhat regularly. As for the class 26 goods, the average consumer will also be made up of members of the general public at large but I appreciate that they will also be sought by a more specific subset of the general public, namely hobbyists (for “hooks and eyes, pins and needles” and for some goods under the broad term “embroidery”, for example). Again, these goods are relatively inexpensive and will be sought somewhat frequently. When selecting the goods at issue, the average consumer will consider general factors such as materials used, style and fit (the latter likely for the class 25 goods only). While the goods are not expensive, I consider they will still be selected with a medium degree of attention but I appreciate that for some goods, this may extend to low (goods such as pins and needles, for example). In physical retailers, the goods at issue will be displayed

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

50. Turning to the services at issue, I will consider these in turn. Starting with the class 35 services, I am of the view that the average consumer for these will be members of the general public at large. However, this may also include business users looking to have their goods retailed at department stores, for example. I consider the class 35 services at issue are most likely to be selected having considered, for example, promotional material (in hard copy or online) and signage appearing on the high street. While visual considerations will be an important part of the selection process, the services are also likely to be the subject of word-of-mouth recommendations meaning that aural considerations will not be an insignificant feature of the selection process. When selecting these services, members of the general public are likely to consider such things as stock, price of goods offered in comparison to other retailers and expertise/knowledge of staff. I am of the view that members of the general public are likely to pay a medium degree of attention during the selection process for the services. However, business users are likely to have other considerations such as footfall through the store, placement of products within the store itself and any potential percentage of sales that the retailer may take. As a result, I consider that the consumer will likely pay a higher than medium degree of attention (but not the highest).

51. Lastly, I find that the average consumer for the majority of the class 41 services at issue will be a member of the general public at large. However, I consider that services such as “arranging and conduction conferences and congresses” and “organising and conducting festivals” are the types of services that will be sought by business users. The class 41 services at issue are most likely to be selected having considered promotional material (in hard copy and online). While visual considerations will be an important part of the selection process, such services are

also very likely to be the subject of word-of-mouth recommendations. Additionally, I do not discount the fact that the average consumer may seek advice in person or via telephone from an organiser of such services. This means that aural considerations will not be an insignificant feature of the selection process. The selection of the majority of these services is likely to be infrequent and the cost associated with them is likely to be fairly inexpensive. Having said that, I appreciate that some organising services (for festivals, for example) are likely to be expensive. When selecting the services, the average consumer is likely to consider a variety of factors that are likely to range from consideration as to the qualifications of the provider (for education related services) to previous testimonials of the services provided (for various organisational services). I consider that, for the most part, the average consumer is likely to pay a medium degree of attention during the selection process of the services but appreciate that this may extend to a higher than medium degree (but not the highest) for those services that are selected by business users.

Comparison of the marks

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

53. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

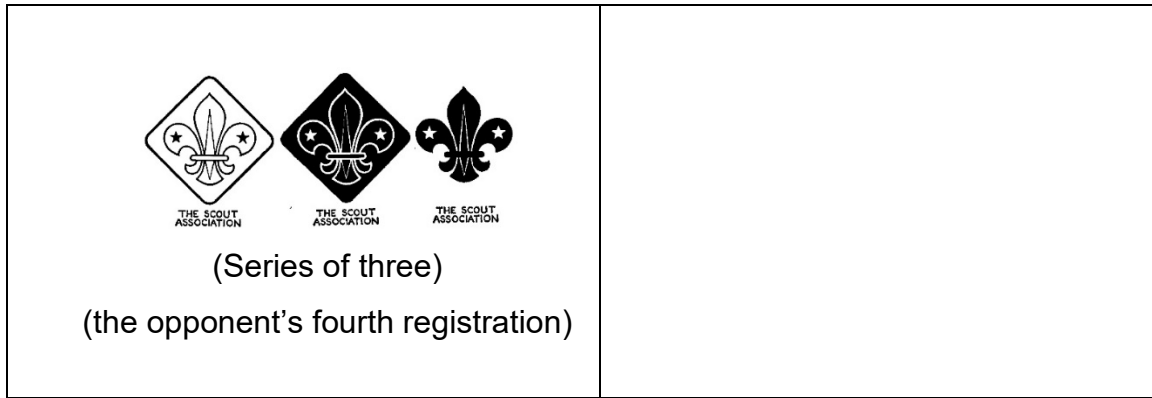
“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the

light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

54. 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.

55. The respective trade marks are shown below:

The opponent's registrations	The applicant's mark
<div style="text-align: center;">   (Series of two) (the opponent's first registration) </div> <div style="text-align: center; margin-top: 20px;">  Scouts Scouts (Series of two) (the opponent's second registration) </div> <div style="text-align: center; margin-top: 20px;">  (Series of two) (the opponent's third registration) </div>	<div style="text-align: center; margin-top: 200px;"> SCOUTS Without Borders </div>



56. I have detailed submissions from the opponent in respect of the comparison of the marks at issue. As for the applicant's position, I note that his written submissions set out that "the logo of Scouts Without Borders is unique and distinct from the logo(s) of The Scout Organisation, and does not cause confusion for consumers". While I do not intend to reproduce the submissions of the opponent here, I confirm that I have taken them into account and will only refer to them below where necessary.

Overall Impression

The applicant's mark

57. The applicant's mark is a figurative mark that consists of the words 'SCOUTS Without Borders' in a fairly standard typeface. The words 'SCOUTS' and 'Borders' are presented in blue whereas 'Without' is presented in red. For reasons that I will come to discuss when considering the conceptual comparison, I consider that 'SCOUTS' plays the greater role in the overall impression of the mark with 'Without Borders' playing a lesser role and the colours used having a very minimal impact.

The opponent's registrations

58. The opponent's first registration is a series of two marks. The marks both consist of the word 'scouts' presented in their centres and in a standard typeface. This word is placed above smaller words, being 'be prepared' in the same typeface (these words are followed by '...' in the first mark but sit alone in the second).

Surrounding the left hand side of these words is a sweeping swoosh device. At the top of the mark is a small fleur-de-lis. The first mark has these elements in black on a white background whereas the second mark has the elements in white on a black background. Being the largest and central element, I find that the word 'scouts' plays a greater role in the marks with the words 'be prepared' playing a lesser role. I consider that the remaining elements (the swoosh, the fleur-de-lis and the '...' in the first mark only) play an even lesser role with the background having a negligible impact.

59. The opponent's second registration is also a series of two marks, both of which consist of the word 'Scouts' in a standard typeface. Above this sits a stylised fleur-de-lis. The first mark in the series is purple whereas the second is black. Given its size and the fact that it is the only element of the marks that can be read, 'Scouts' plays the greater role in the overall impression of the marks, with the stylised fleur-de-lis playing a lesser role.

60. The opponent's third registration is also a series of two marks. The marks both consist of the word 'SCOUT' in a white standard typeface. Below this is the word 'ADVENTURES'. This is also presented in a white standard typeface, albeit smaller. Above these elements is a white fleur-de-lis. These elements all sit on a background which is black in the first mark and red in the second. Given its central placement and the fact it is the largest element that can be read, the word 'SCOUT' will play a greater role in the overall impression of the marks with the word 'ADVENTURES' and the fleur-de-lis both playing lesser roles. The background, while noticed, will just be seen as a banal background device and its impact will, therefore, be negligible.

61. The opponent's fourth registration is a series of three marks. Each mark in the series consists of a large fleur-de-lis device that sits above the words 'THE SCOUT ASSOCIATION' which is presented in standard black typeface. The marks in the series differ slightly in the way in which their device elements are presented. The fleur-de-lis in the first mark is white with a black border and is surrounded by a black, curved diamond border. In the second mark, it is presented in black with a

white border and surrounded by a black curved diamond shape. In the third mark, it is presented in black with no border or background. Ordinarily, consumers' eyes are drawn to the parts of marks that can be read, however I do not consider that is necessarily the case here given that the words are presented considerably smaller than the fleur-de-lis. That being said, the words will still have a significant impact and I, therefore, find that the word and device element contribute equally to the overall impression of the mark.

Visual Comparison

The applicant's mark and the opponent's first registration

62. The common element in all of these marks is their use of the word 'SCOUTS' (albeit presented differently). This sits at the beginning of the applicant's mark and, by virtue of it being the central element and the first one that is going to be read, it is also likely to be considered as the first element of the opponent's registration also. This means that it is on this word that the average consumer is likely to focus.⁹ The remaining elements of the marks, being the applicant's use of the words 'Without Borders' and the opponent's use of device elements and the words 'be prepared' all differ. While I appreciate that 'SCOUTS' is the dominant element of each mark, the remaining elements cannot be ignored and, in my view, all impact considerably upon the visual impression of the marks. Overall, I consider that these marks are visually similar to between a low and medium degree.

The applicant's mark and the opponent's second registration

63. As was the case above, these marks also share the word 'Scouts', being each marks' first (and most dominant) elements. However, as was also the case above, all of the other elements differ. While these different cannot be overlooked, it is my view that the differences between these marks are not as pronounced as the marks assessed in the preceding paragraph. This is because the opponent's second

⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

registration consists of no other word elements and only one additional device (being the stylised fleur-de-lis). Taking all of this into account, I consider that these marks are visually similar to a medium degree.

The applicant's mark and the opponent's third registration

64. Unlike the marks assessed above, these marks cannot be said to share an identical element as the opponent's use of 'SCOUT' is not the same as the applicant's use of 'SCOUTS'. However, I appreciate that they are still highly similar from a visual perspective and sit at the beginnings of the marks at issue (again, on the basis that the word 'SCOUT' will be encountered first in the marks of the third registration as consumers are naturally drawn to elements that can be read). As was the case with the other marks in this comparison, all other elements in these marks differ. The points of differences are, in my view, more in line with the assessment made at paragraph 62 above in that the opponent's marks include additional word elements that, despite their lesser roles, have a visual impact on the marks. As a result, I consider that these marks are visually similar to between a low and medium degree.

The applicant's mark and the opponent's fourth registration

65. These marks share the same point of similarity as discussed in the preceding paragraph, namely the use of the words 'SCOUT' and 'SCOUTS'. While I appreciate these elements are similar, I bear in mind that (1) the word 'SCOUT' in the opponent's mark is not the singular dominant element and (2) it is preceded by the word 'THE' so will not be viewed as the first element in the opponent's marks (even taking into account the limited impact that the word 'THE' has from a trade mark perspective). Bearing in mind the overall impression of the marks and the differences across them, I consider that these marks are visually similar to a low degree.

Aural Comparison

The applicant's mark and the opponent's first and second registrations

66. The applicant's mark consists of five syllables that will be pronounced in the ordinary way. In considering the opponent's first registration, I do not consider that the words 'be prepared' will be pronounced. While I bear in mind the case of *Purity Hemp Company Improving Life as Nature Intended*¹⁰ wherein Mr Phillip Harris, sitting as the Appointed Person, stated that descriptiveness does not of itself render an element negligible or aurally invisible, I do not consider the same applies here. This is because 'be prepared' is not descriptive but, as I will come to discuss below, will be seen as a strapline or marketing phrase that the consumer will not articulate. As a result, I consider that the opponent's first registration will simply consist of one syllable, being 'SCOUTS', pronounced in the ordinary way. The same applies to the second registration as 'SCOUTS' is its only verbal element. In comparing 'SCOUTS' against 'SCOUTS WITHOUT BORDERS', the first syllables are identical and, as I have set out above, the first element is the point of marks that consumers typically focus on. However, all other syllables in the applicant's mark are points of difference and result in the applicant's mark being considerably longer than the opponent's. Taking all of this into account, I consider that the applicant's mark is aurally similar to a medium degree with both the opponent's first and second registrations.

The applicant's mark and the opponent's third registration

67. The opponent's third registration consists of four syllables that will be pronounced in the ordinary way. The applicant's mark will be pronounced as above. 'SCOUT' in the opponent's marks is, aurally, very highly similar to 'SCOUTS' in the applicant's. That being said, the word 'ADVENTURES' in the opponent's marks and the words 'Without Borders' in the applicant's mark are entirely different. While the marks are of similar lengths and have a very highly similar first syllable, I

¹⁰ Case BL O/115/22

consider that the differences are significant. Therefore, I find that these marks are aurally similar to between a low and medium degree.

The applicant's mark and the opponent's fourth registration

68. Aurally, the opponent's fourth registration consists of seven syllables that will be pronounced in the ordinary way. The applicant's mark will be pronounced as above. The second syllable of the opponent's mark is very highly similar to the first syllable of the applicant's mark. All of the other aural elements of these marks are entirely different and will, in my view, result in them being aurally similar to only a low degree.

Conceptual Comparison

69. The opponent submits that both parties' marks are all based on the word 'SCOUT'. The opponent states that this has more than one meaning but it includes just one definition in its submissions which is that a 'SCOUT' is a member of the 'SCOUTS', which is an organisation for children and young people which teaches them to be practical, sensible and helpful. It includes a print-out from Collins Dictionary in its evidence confirming this definition.¹¹ I note that this print-out also includes other definitions such as '*a person, ship or aircraft send out to gain information*' or '*a person employed by a [sports] club to seek new players*'. Given its other meanings, I see no reason why 'SCOUT' or 'SCOUTS', solus, would immediately be perceived as relating to the scout organisation itself. Instead, it is necessary to consider the word in the context of the marks as wholes and the goods or services upon which they will be confronted.

70. First, the applicant's mark is the words 'SCOUTS Without Borders'. Generally, I consider that 'SCOUTS' may be perceived by the consumer as having any of the meanings set out in the preceding paragraph. I note that some services at issue relate specifically to 'scouts' ("organising and conducting large celebratory events for scouts" and "developing educational programs for scouts"). While these are

¹¹ Annex 2 of Exhibit SWJ1

noted, they do not expressly confirm which meaning of 'scouts' is applicable. The words 'Without Borders' will, in my view, qualify the meaning of the word 'SCOUTS' in that they will allude to the fact that 'SCOUTS' (regardless of its perceived meaning) is an entity that operates without national boundaries, i.e. on a global scale.

71. The concept of the opponent's first and second registrations will be dominated by the word 'SCOUTS' which, as discussed in the preceding paragraph, will be seen as having one of a number of dictionary meanings regardless of whether any goods or services at issue may refer to scouts. While the fleur-de-lis emblems will be noticed, I see no obvious meaning that would be associated with this. As for the words 'be prepared' in the opponent's first registration, this will be seen as a promotional strapline instructing the consumer to 'be prepared'. It does not indicate what the consumer should be prepared for and, as such, it doesn't have any obvious meaning. Therefore, I consider that its conceptual impact of the marks is extremely limited. Comparing the concept of these marks, I am of the view that both parties' marks will be dominated by their reference to 'SCOUTS'. The average consumer will understand the same meaning across the marks regardless of what meaning they attribute to it. As above, the words 'Without Borders' simply qualifies the nature of the 'SCOUTS' entity (in that it operates internationally) so, while it is a point of conceptual difference, its impact will be slight. Overall, I consider that these marks are conceptually similar to a high degree.

72. As for the opponent's third registration, I consider that the reference to 'SCOUT' will share the same concept as the word 'SCOUTS' in the applicant's mark, albeit I appreciate that the use of the word in the singular and in the plural may be noticed. The addition of the word 'ADVENTURES' will be assigned its ordinary dictionary meaning and will qualify the word 'SCOUT' to a degree as it will be viewed as a reference to a scout on an adventure. While the words 'ADVENTURES' and 'Without Borders' will combine with 'SCOUT' and 'SCOUTS', respectively, to create different concepts in their respective marks as wholes, I do not consider they will negate the dominance of the 'SCOUT'/'SCOUTS' concept, which will be understood as carrying the same meaning across the marks (albeit one singular

and one plural). Overall, I consider the marks to be conceptually similar to between a medium and high degree.

73. The opponent's fourth registration will, in my view, be understood as a direct reference to an association of scouts and, therefore, in line with the primary definition provided at paragraph 69 above. I make this finding on the basis that, as far as I am aware (and there is nothing before me to suggest otherwise), there is no association for the other types of scouts covered by the alternative definitions that were also provided at paragraph 69 above. Given that this reference can also be taken from the applicant's mark, I still consider that the reference to 'SCOUTS' is capable of being the same across all marks. Given the slight point of difference created by 'Without Borders' in the applicant's mark, I consider that these marks are conceptually similar to a high degree.

Distinctive character of the opponent's registrations

74. 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).”

75. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up 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. The opponent has claimed that its registrations enjoy an enhanced degree of distinctive character through use and has filed evidence to that effect.

76. Before considering the position in respect of enhanced distinctiveness through use, it is necessary to consider the inherent position. I note that the opponent's submissions argue that the distinctiveness of its marks is high. The reasons given in support of this argument appear to relate to the use made of 'The Scouts' and the fact that the dictionary definition (referred to at paragraph 69 above) specifically references the opponent. While noted, use of 'The Scouts' does not point to the inherent position. Further, I appreciate that being in the dictionary may be a good sign of an organisation's success and awareness amongst the public, it does not necessarily tell us anything about how distinctive a word is inherently. On this point, the definition relied upon by the opponent is not scout's sole meaning (as discussed when considering a conceptual comparison above). Instead, I simply consider that 'SCOUTS'/'SCOUT' (as used in the opponent's registrations) is a well-known dictionary word that has a number of meanings. Aside from the opponent's fourth registration, I see no reason why the specific meaning of the scouts organisation would be the sole association made when the average consumers views the registrations. I do not consider that the registrations are descriptive or allusive for a majority of the goods and services at issue. That being said, I appreciate that some services at issue relate specifically to scout activities. For those services, there is likely to be a lessened degree of distinctive character attributed to 'SCOUTS'/'SCOUT'. Even so, this will not be considerable as, in my

view, it is not sufficiently clear as to what events or programs for scouts precisely relate to. Overall, I consider that the reference to 'SCOUT' or 'SCOUTS' in the opponent's registrations has a medium degree of distinctive character but, for those services that specifically relate to scouting activities, it will be between low and medium.

77. As for the additional word elements in the opponent's registrations, being 'be prepared' in its first, 'ADVENTURES' in its third and 'THE' and 'ASSOCIATION' in its fourth, I see no reason why any of these will materially contribute to the distinctiveness of those respective marks beyond what is created by the word 'SCOUT' or 'SCOUTS'. The same finding applies to the decorative elements used across all of the opponent's registrations. Firstly, any simple background or border element is unlikely to have any impact whatsoever on the distinctiveness of the registration. Secondly, the use of a fleur-de-lis across all marks will be seen as a fairly standard stylistic addition. While it may contribute to the overall distinctiveness of the marks, I do not consider its impact will be significant enough to take the distinctiveness of the marks beyond the level created by the word 'SCOUTS'. Therefore, I consider that the inherent distinctiveness of the opponent's registrations is in line with that created by the word 'SCOUT' or 'SCOUTS', namely that they enjoy a medium degree of distinctive character but, for some specific scouting related services, this will be between low and medium.

78. I turn now to consider the opponent's evidence in support of its claim that the distinctiveness of its registrations has been enhanced as a result of the use made of them. I note that the evidence provided has been separated out under different sections, one of which deals with enhanced distinctiveness and, the other, with reputation (under the 5(3) ground). While that may be the case, evidence in support of a claim to the existence of a reputation is also relevant to a claim of enhanced distinctive character. As a result, I will consider all of this evidence together.

79. The evidence sets out that the Scout Association was formed in 1910 and was incorporated in 1912 by a Royal Charter. A copy of the Royal Charter is included

within the evidence.¹² The evidence sets out that the opponent is the largest national Scout organisation in Europe, representing 35% of the members of the European Scout Region. While noted, this claim was put forward in the narrative evidence which was in the form of submissions from the opponent's legal representative. As this claim is not accompanied by any supporting evidence of fact, I do not consider it appropriate to accept this as relevant evidence in the present case as it is not confirmed.

80. There is a range of evidence that points to how the applicant is referred to simply as 'The Scouts'. This is mainly supported by print-outs from various websites, including those taken from nationwide news publications such as the Daily Mail, the Sun and The Guardian but also includes websites such as Amazon, Vodafone and Water Aid.¹³ I do not intend to discuss each and every article provided but note that they all reference the Scouts and are dated prior to the relevant date, being the date of the application at issue, 2 March 2021. Most notably amongst these print-outs is a print-out from 'ScoutSHOPS' that appears to be the official Scout shop. There are no specific goods shown but I note that there are categories present for 'Adult Clothing', 'Kids Clothing', 'Accessories' and 'Rucksacks & Bags'.¹⁴ In addition, there are a number of pages from third-party websites such as BigGreenField.com which show a range of goods for sale in pounds.¹⁵ All of these goods refer to scouting but none bear any of the registrations at issue.

81. The evidence goes into detail regarding a number of high profile individuals and celebrities that are involved in and support the opponent's organisation. I note that reference is made to television personality Bear Grylls being the opponent's Chief Scout.¹⁶ Reference is also made to the Duchess of Cambridge (as she then was) and the Duke of Kent being the opponent's presidents and Queen Elizabeth II being its patron.¹⁷

¹² Annex 6 of Exhibit SJW1

¹³ Annex 4

¹⁴ Page 110

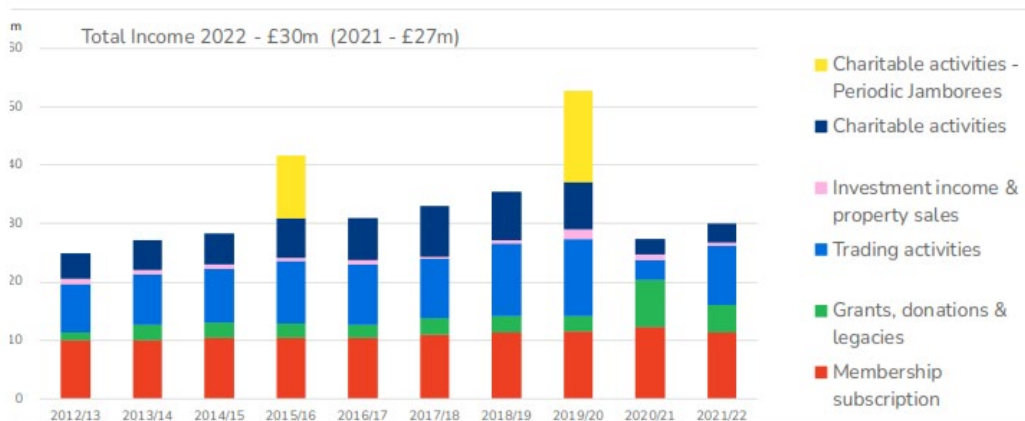
¹⁵ Pages 114 to 121

¹⁶ Annex 7

¹⁷ Annex 8 and 9

82. Included in the evidence is a copy of the opponent’s annual report for the year 2021 to 2022.¹⁸ The entirety of the report has been provided and I note that it totals 75 pages and includes, what appear to be, detailed mission and financial statements. Save for the narrative evidence’s reference to the membership figures (561,379 members) and turnover (£30 million) for the year ending 31 March 2022 (being statements that are supported by the report), no explanation has been provided as to why it has been included in its entirety.

83. Having reviewed the report, I note that it includes a vague breakdown of this turnover for the years 2012/13 to 2021/22. This is set out below:



84. Based on the above graph, the turnover figures provided clearly all stem from different revenue streams. The ones that I consider relevant to the present assessment of use are those figures associated with membership fees and ‘trading activities’. While I note that the turnover for these categories appears to be in the region of £10m per year, the issue I have is that there is no indication as to precisely what goods or services that these categories cover. For example, the only indication as to what is meant by ‘trading activities’ can be found in the financial statement which refers to ‘other trading activities’ as being ‘retail sales’, ‘hotel and conference income’ and ‘sponsorship, promotions and royalties’.¹⁹ On this point, I note that there is reference in the report to entities such as ‘Scout Services Limited’ and ‘Scout Products Limited’ but there is no reference to what goods or services are sold. So while the turnover is noted and I appreciate its significance, it is

¹⁸ Annex 11

¹⁹ Page 247

imprecise and I have some difficulty in being able to associate it to any specific goods or services for which the opponents' registrations are registered. Lastly in respect of this report, I consider it reasonable to expect that, if the opponent wished for me to take anything specific away from this report (such as any use of the registrations for the relevant goods and services), it should have precisely confirmed what that was. It is not enough to simply append the entirety of a report without further comment.

85. Lastly, I note that included in the evidence is a list of the opponent's partners. I note that this includes a number of large nationwide businesses such as B&Q, NatWest and Rolls-Royce. The opponent claims that the fact that such a large number of high profile entities have partnered with the opponent demonstrate that it has an excellent reputation with which third parties wish to associate.

86. Taking all of the evidence into account, it is clear to me that the opponent has operated a large organisation for a very long period of time (being founded in 1910) and that it has a significant membership base and has generated a substantial annual turnover since 2012. Further, I accept that the press coverage is extensive. That being said, I have significant issues with the evidence provided. Firstly, the evidence has only limited reference to the actual registrations at issue and, on this point, there is nothing demonstrating the registrations in relation to actual goods or services provided. Instead, the evidence appears to mainly focus on 'The Scouts' as an organisation rather than use of the relevant registrations. Secondly, the opponent appears to have simply appended a wide range of different documents to its evidence with no real explanation as to the purpose they serve in precisely supporting the opponent's case. For example, the aforementioned turnover makes no specific reference to what goods and services it relates to, a particular issue for the opponent given the varying nature of the specifications relied upon. On this point, I remind myself of the case of *Awareness Limited v Plymouth City Council*, Case BL O/236/13 ("*Plymouth Life*"). While I appreciate that this case relates to the nature and standard of evidence in proof of use, I consider that its principles are equally applicable here. For example, I note that Mr Daniel Alexander Q.C., in that case, set out at paragraph 22 that:

“By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken”

Further, at paragraph 28, he also stated that:

“The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification.”

87. Taking into account the above criticisms as to the imprecise nature of the opponent’s evidence and the comments of Mr Alexander Q.C. in *Plymouth Life*, I conclude that the opponent has failed to provide sufficient evidence in order to demonstrate that its registrations have achieved an enhanced degree of distinctiveness. As a result, the inherent position applies, namely that they are distinctive to a medium degree but, where the services relate specifically to ‘scout activities’, they are distinctive to between a low and medium degree.

Likelihood of confusion

88. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer

for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

89. In my goods and services comparison above, I found the parties' goods and services to range from being identical to similar to a medium degree. However, it was the goods and services in the opponent's first and second registrations that represented the stronger degree of similarity with the applicant's goods and services. I have found the average consumer for the goods and services to be either members of the general public or business users who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods and services at issue but this may be lower for some goods but may also extend to a higher than medium degree (but not highest) for some services. I have found that the opponent's registrations are inherently distinctive to a medium degree but, for some specific scout related services, this will be between a low and medium degree. In respect of the similarity of the marks at issue, I have found the applicant's mark to be:

- a. visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to a high degree with the opponent's first registration;
- b. visually and aurally similar to a medium degree and conceptually similar to a high degree with the opponent's second registration;
- c. visually and aurally similar to between a low and medium degree and conceptually similar to between a medium and high degree with the opponent's third registration; and
- d. visually and aurally similar to a low degree and conceptually similar to a high degree with the opponent's fourth registration.

90. On the basis that they represent the opponent's best case (bearing in mind the level of similarity of not only the marks but the goods and services), I consider it

appropriate to focus my assessment of a likelihood of confusion on the opponent's first and second registrations. A finding of a likelihood of confusion between these marks offers the opponent the best outcome that it can achieve under the present ground. Alternatively, if no likelihood of confusion is found then there will be no likelihood of confusion in respect of the remaining registrations as they are similar to lesser degrees with the applicant's mark.

91. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am not convinced that the marks would be mistakenly recalled or misremembered for one another. While I appreciate that the marks at issue all contain of the word 'SCOUTS', I am of the view that the differences between the marks, particularly the words 'Without Borders' will allow the average consumer to correctly recall and remember the marks. I make this finding whilst taking into account the lessened role that the different elements play in the parties' marks. Consequently, I do not consider there to be any likelihood of direct confusion.

92. Turning now to consider a likelihood of indirect confusion, I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

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

94. In considering indirect confusion, I remind myself that 'SCOUTS' is the dominant and distinctive element of the opponent's registrations. While I have found that, for some services, the word 'SCOUTS' will be distinctive to between a low and medium degree, this is not fatal to the opponent's case on the basis that an earlier mark's

weak distinctive character does not preclude a likelihood of confusion.²⁰ In any event, I do not consider that the inherent distinctiveness of 'SCOUTS' is particularly weak. Turning to the applicant's mark, I have found that the addition of the words 'Without Borders' qualifies the word 'SCOUTS', thereby giving the mark as a whole its own meaning. That being said, the meaning created by the words 'Without Borders' does not alter the perception of the word 'SCOUTS' itself and I consider that the additional words will be viewed as an indicator that the 'SCOUTS' undertaking has expanded its business by creating an international branch that operates across the globe, i.e. 'without borders'. When the word 'SCOUTS' is viewed on both parties' marks, I see no reason why the average consumer would consider its shared use to be merely coincidental. This applies even when viewed on services relating to scout activities on the basis that, as I have set out above, it is not particularly precise what actual services these terms cover. Lastly, in considering indirect confusion, I acknowledge that the additional differences between marks, being their differing presentations, the strapline 'be prepared' (in the opponent's first registration only) and the decorative elements in the opponent's registrations, will all be noticed. While that may be the case, I consider that these points of difference will simply be attributed as being consistent with alternative marks used by the same or economically linked undertakings that just so happen to use different stylisations and non-distinctive straplines across their portfolio of marks. Taking all of the above into account and bearing in mind the comments of Arnold LJ in the case of *Liverpool Gin*, I find that the average consumer would consider that the marks all belong to the same or economically connected undertakings. Consequently, I find that there exists a likelihood of indirect confusion between the marks at issue. Additionally, I find that the common element of 'SCOUTS' will be viewed as the indicator of origin for consumers regardless of the level of attention paid during the selection process. Therefore, it is my view that this finding applies even where the average consumer pays a higher degree of attention during the selection process of the goods or services at issue.

²⁰ *L'Oréal SA v OHIM*, Case C-235/05 P

95. As a result of my findings above, I do not consider it necessary to proceed to consider the existence of a likelihood of confusion between the applicant's mark and the opponent's third and fourth registrations. I also note that the opponent raised a 'family of marks' argument in support of a claim for a likelihood of confusion. Given my above findings (and the issues I have expressed with the evidence), I do not consider that it is necessary to consider the family of marks argument.

96. The opposition under section 5(2)(b) hereby succeeds in relation to a majority of the goods and services against which it is aimed. For the avoidance of doubt, it fails against the following goods and services:

Class 26: Artificial flowers.

Class 35: Advertising; the bringing together, for the benefit of others, of a variety of goods, namely, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, umbrellas, parasols and walking sticks, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, identity tags made wholly or principally of plastic, trinkets, fobs, decorative plaques, not of metal, figurines, statues and statuettes, glassware, porcelain, lunch boxes, flasks, tankards, mugs, pint glasses, lager glasses, wine glasses, champagne flutes, tumblers, whisky tumblers, chinaware, porcelain and paper cups, toothbrush holders, drink bottles, money boxes, tankards, tea pots, egg cups, trays, salt and pepper pots, napkin holders and napkin rings and artificial flowers, enabling customers to conveniently view and purchase those goods from a general merchandise internet website or store or via a television shopping channel or from a general merchandise catalogue by mail order or by means of telecommunications; information, consultancy and advisory services relating to all of the aforesaid services.

97. I will now proceed to consider the remaining grounds of the opposition.

Section 5(3)

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

“5(3) A trade mark which –

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

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

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

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

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

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

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails

of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

100. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its registrations and the applicant's mark are similar. Secondly, the opponent must show that its registrations have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier registrations being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

101. I can deal with this ground relatively swiftly. For similar reasons as set out above, I do not consider the opponent's evidence to be sufficiently clear to justify a finding of reputation in the UK market. Consequently, the opposition based upon section 5(3) falls at the first hurdle. However, even if there were a reputation, I do not consider that this ground would put the opponent in any stronger position than it is under section 5(2)(b). This is because the distance between the remaining goods and services in the applicant's specification (i.e. those that would not give rise to confusion under 5(2)(b)) and the services for which the opponent would have a reputation (which would, at best, be limited to class 41 services on the basis that the evidence does not show use of the registrations on any goods), would be

sufficient to offset the opponent's reputation and the similarity between the marks. I do not consider that there would be a link or damage for the remaining goods and services.

55. The opposition based upon section 5(3) fails.

Section 5(4)(a)

102. Section 5(4)(a) of the Act reads as follows:

“(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.”

103. 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.”

104. Again, I can deal with this ground relatively swiftly. I found above that the opponent's evidence is insufficiently clear, however, even if I were to consider it

sufficient to establish a protectable goodwill on the basis that the threshold for the existence of a goodwill is lower than that for a reputation and enhanced distinctiveness, it would likely be limited to class 41 services only. In those circumstances, I do not consider that this ground would extend the opponent's success any further than its 5(2)(b) ground. This is because the distance between the goods and services in the applicant's specification that survived the 5(2)(b) ground and the services for which the opponent may enjoy a goodwill in would be sufficient to offset the similarity of the marks and to avoid a misrepresentation and damage arising. On this point, I remind myself that while the test for misrepresentation is different to that for likelihood of confusion (because misrepresentation requires "a substantial number of members of the public are deceived" rather than considering whether the "average consumer is confused"), it is doubtful whether the difference between the legal tests will produce different outcomes.²¹ I believe that to be the case here.

105. Consequently, the 5(4)(a) ground would, at best, succeed to the same extent as the 5(2)(b) ground.

CONCLUSION

106. The opposition is successful in relation to the following goods and services, for which the application is refused:

Class 25: Clothing, footwear, headgear; t-shirts; polo shirts; jumpers; coats; hats; neckerchiefs; uniforms.

Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; buttons; badges; rosettes.

Class 35: The bringing together, for the benefit of others, of a variety of goods, namely, paper, cardboard, printed matter, photographs, stationery, instructional and teaching material, plastic materials

²¹ As recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501

for packaging, books, booklets, magazines, newspapers, catalogues, guides, phone cards, cards, postcards, notepads, envelopes, wrapping and packaging materials, stationery, writing instruments and drawing instruments, pens, pencils and crayons, erasers, pen and pencil cases, pencil sharpeners, rulers, stencils, adhesive tape, paper clips, boxes and holders, calendars, diaries, posters, photograph albums, educational material, printed matter for use with board games, leather and imitations of leather, whips, harness and saddlery, bags, rucksacks, backpacks, duffel bags, boot bags, holdalls, wallets, credit card holders, belts for luggage, shoulder belts, luggage tags, key fobs made of leather incorporating key rings, furniture, mirrors, picture frames, key rings, sleeping bags, clothing, footwear, headgear, t-shirts, polo shirts, jumpers, coats, hats, neckerchiefs, uniforms, lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, buttons, badges, rosettes, placemats, games and playthings, enabling customers to conveniently view and purchase those goods from a general merchandise internet website or store or via a television shopping channel or from a general merchandise catalogue by mail order or by means of telecommunications; information, consultancy and advisory services relating to all of the aforesaid services.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; camp and sport camp services; arranging and conducting conferences and congresses; organisation of competitions and awards; organising and conducting festivals; arranging of festivals for cultural, educational or recreational purposes; organising commemorative festivals; organising and conducting jamborees; organising and conducting large celebratory events for scouts; developing educational programs for scouts; provision of information relating to entertainment or education, provided on-line from a computer database or the

Internet; provision of on-line electronic publication; publication of electronic books and journals on-line; information, consultancy and advisory services relating to all of the aforesaid services.

107. The opposition is unsuccessful in relation to the following goods and services, for which the application may proceed to registration:

Class 26: Artificial flowers.

Class 35: Advertising; the bringing together, for the benefit of others, of a variety of goods, namely, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, umbrellas, parasols and walking sticks, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, identity tags made wholly or principally of plastic, trinkets, fobs, decorative plaques, not of metal, figurines, statues and statuettes, glassware, porcelain, lunch boxes, flasks, tankards, mugs, pint glasses, lager glasses, wine glasses, champagne flutes, tumblers, whisky tumblers, chinaware, porcelain and paper cups, toothbrush holders, drink bottles, money boxes, tankards, tea pots, egg cups, trays, salt and pepper pots, napkin holders and napkin rings and artificial flowers, enabling customers to conveniently view and purchase those goods from a general merchandise internet website or store or via a television shopping channel or from a general merchandise catalogue by mail order or by means of telecommunications; information, consultancy and advisory services relating to all of the aforesaid services.

COSTS

108. As the opponent has enjoyed the greater degree of success, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice

Notice 2/2016. In the circumstances, I consider it appropriate to reduce the costs award to a small degree to reflect the applicant's success. I hereby award the opponent the sum of **£830** as a contribution towards its costs. The sum is calculated as follows:

Preparing the notice of opposition:	£200
Preparing evidence/submissions:	£500
Sub-total:	£700
<i>Reduction of 10%:</i>	<i>-£70</i>
Official fees:	£200
Total:	£830

109. I hereby order Mahir Kilic to pay The Scout Association the sum of £830. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 18th day of May 2023

A COOPER
For the Registrar

ANNEX

The opponent's first registration

Class 18

Bags; knapsacks; rucksacks; haversacks; holdalls; travelling bags; suitcases; wallets; leather and imitations of leather, and goods made of these materials and not included in other classes.

Class 20

Sleeping bags; camping mats; groundsheets; furniture; picture frames; tent pegs, not of metal.

Class 25

Clothing; footwear; headgear.

Class 26

Embroidery; ribbons and braid; buttons; badges; rosettes.

Class 28

Games and playthings; gymnastic and sporting articles; footballs; plastic discs for throwing; balloons; toy action figures; hand-held games units; masks.

Class 41

Sporting and cultural activities; education and training services in relation to scouting; entertainment services; arranging and conducting conferences and congresses; organisation of competitions and awards; information relating to the aforesaid services provided on line from a computer database or the Internet.

The opponent's second registration

Class 16

Paper; cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; books; booklets; magazines; newspapers; catalogues; guides; phone cards; cards; postcards; notepads; envelopes; wrapping and packaging materials; stationery; writing instruments and drawing instruments; pens, pencils and crayons; writing chalk; erasers; pen and pencil cases; pencil sharpeners; rulers; stencils; adhesive tape; paper clips; boxes and holders; calendars; diaries; posters; photograph albums; educational material; printed matter for use with board games; place mats of paper.

Class 25

Clothing, footwear, headgear; t-shirts; polo shirts; jumpers; coats; hats; neckerchiefs; uniforms.

Class 26

Embroidery; embroidered patches; novelty buttons [badges] for wear; embroidered badges; ornamental novelty badges; ribbons and braids; buttons, hooks and eyes, pins and needles; rosettes; hair decorations.

Class 28

Toys; games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; camp and sport camp services; arranging and conducting conferences and congresses; organisation of competitions and awards; organising and conducting festivals; arranging of festivals for cultural, educational or recreational purposes; organising commemorative festivals; organising and conducting jamborees; organising and conducting large celebratory events for scouts; developing educational programs for scouts; provision of information relating to entertainment or education, provided on-

line from a computer database or the Internet; provision of on-line electronic publication; publication of electronic books and journals on-line; information, consultancy and advisory services relating to all of the aforesaid services.

The opponent's third registration

Class 16

Paper; cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; books; booklets; magazines; newspapers; catalogues; guides; phone cards; cards; postcards; notepads; envelopes; wrapping and packaging materials; stationery; writing instruments and drawing instruments; pens, pencils and crayons; writing chalk; erasers; pen and pencil cases; pencil sharpeners; rulers; stencils; adhesive tape; paper clips; boxes and holders; calendars; diaries; posters; photograph albums; educational material; printed matter for use with board games; place mats of paper.

Class 25

Clothing, footwear, headgear; t-shirts; polo shirts; jumpers; coats; hats; neckerchiefs; uniforms.

Class 28

Toys; games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees.

Class 41

Education; providing of training; entertainment; sporting and cultural activities; camp and sport camp services; arranging and conducting conferences and congresses; organisation of competitions and awards; organising and conducting festivals; arranging of festivals for cultural, educational or recreational purposes; organising commemorative festivals; organising and conducting jamborees; organising and

conducting large celebratory events for scouts; developing educational programs for scouts; provision of information relating to entertainment or education, provided on-line from a computer database or the Internet; provision of on-line electronic publication; publication of electronic books and journals on-line; information, consultancy and advisory services relating to all of the aforesaid services.

Class 43

Services for providing food and drink; temporary accommodation; arrangement of temporary accommodation for others; accommodation reservation services; reservation and provision of camping holidays; provision of camp accommodation; provision of campground facilities; hotel and catering services; hostel, hotel, camp and private accommodation reservation and booking services; services to aid others find temporary board and lodgings; management of restaurants, self-service restaurants, snack-bars, canteens, cafes and cafeterias; restaurant, cafe, bars, canteen and catering services.

The opponent's fourth registration

Class 16

All goods included in Class 16.

Class 25

All goods included in Class 25.

Class 28

Games (other than ordinary playing cards), play things; and gymnastic and sporting articles (other than clothing)