

O-0496-23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3687282

BY

MUST BE GROUP LTD

TO REGISTER

Must Be Stolen

AS A TRADE MARK IN CLASSES 18 & 26

AND

OPPOSITION THERETO (UNDER NO. 430599)

BY

REVELL BIKES LIMITED T/A STOLEN BIKES

BACKGROUND

1) On 27 August 2021, Must Be Group Ltd ('the applicant') applied to register the words Must Be Stolen as a trade mark in the UK. As matters stand, the application covers the following goods¹:

Class 18: Bags; Luggage, bags, wallets and other carriers.

Class 26: Accessories for apparel, sewing articles and decorative textile articles.

2) The application was published in the Trade Marks Journal on 29 October 2021 and notice of opposition was later filed by Revell Bikes Limited (T/A Stolen Bikes) ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) In support of its ground under section 5(2)(b) of the Act, the opponent relies upon the following trade mark registration and some of the goods and services covered by the same, as shown below:

- **UKTM 2648950**

STOLEN

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses.

Class 25: Clothing, footwear, headgear.

Class 35: Retail services connected with the sale of bicycles, racing bicycles, parts and fittings for bicycles and racing bicycles, clothing, footwear, headgear; information, advice and consultancy in relation to the aforesaid services.

¹ The application also originally included goods and services in classes 25 and 35. Those goods and services were successfully opposed by a different opponent in another opposition case. That decision was not appealed and therefore classes 25 and 35 no longer form part of the application.

Filing date: 22 January 2013

Date of entry in register: 05 July 2013

4) It is claimed that the respective goods and services are either identical or similar and that the respective marks are similar, such that there exists a likelihood of confusion under Section 5(2)(b).

5) The trade mark relied upon by the opponent under section 5(2)(b) of the Act is an earlier mark, in accordance with section 6 of the Act. As it completed its registration procedure more than five years prior to the application date of the contested mark, it is, in principle, subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods and services relied upon.

6) Under section 5(4)(a) of the Act, the opponent relies upon the use of the following signs since 2002 throughout the UK:

- i) STOLEN BRAND in relation to 'clothing, face masks, decals and badges'.
- ii) STOLEN BIKES in relation to 'clothing'



It is claimed that use of the applicant's mark, in respect of the goods applied for, will lead to misrepresentation and damage to the opponent's goodwill associated with its earlier signs.

7) The applicant filed a counterstatement in which it denies the grounds of opposition. It does not request that the opponent provide proof of use of the earlier mark relied upon under Section 5(2)(b)². Accordingly, the opponent is not required to provide

² As per Question 7 of Form TM8, where the applicant has ticked 'NO'.

proof of use in relation to its earlier registered mark and can therefore rely upon all of the goods and services for which it made a statement of use.

8) The opponent is represented by Trade Mark Direct. The applicant is represented by Daniel Dimov. Only the opponent filed evidence; the applicant has filed nothing beyond the counterstatement. The opponent's evidence consists of a witness statement from Anthony Revell with 10 exhibits thereto. That evidence was also accompanied by written submissions³. Neither party requested a hearing. The opponent filed written submissions in lieu⁴. I now make this decision after careful consideration of the papers before me.

DECISION

9) Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. As the provisions of the Act relied upon in these proceedings are derived from an EU Directive, I will, therefore, take account of trade mark case law of the EU courts.

Section 5(2)(b)

10) This section of the Act states:

“5. - (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,

³ Dated 25 July 2022

⁴ Dated 16 February 2023

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

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

11) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

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

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

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

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

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

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

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

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

Comparison of goods and services

12) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

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

13) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

(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.

14) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Meric’*), where the General Court held that:

“29 In addition, the goods can be considered as identical when the goods

designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

15) The goods to be compared are:

Opponent's goods	Applicant's goods
<p>Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses.</p> <p>Class 25: Clothing, footwear, headgear.</p> <p>Class 35: Retail services connected with the sale of bicycles, racing bicycles, parts and fittings for bicycles and racing bicycles, clothing, footwear, headgear; information, advice and consultancy in relation to the aforesaid services.</p>	<p>Class 18: Bags; Luggage, bags, wallets and other carriers.</p> <p>Class 26: Accessories for apparel, sewing articles and decorative textile articles.</p>

16) I will first consider the applicant's goods in class 18. The applicant's 'wallets' share the same purpose and method of use as the opponent's 'purses'. They are

also very similar in nature and the trade channels will be same. The applicant's 'wallets' are highly similar to the opponent's 'purses'. The rest of the applicant's goods in class 18 are identical to the opponent's 'trunks and travelling bags' and 'rucksacks' (at least) on the *Meric* principle.

17) Turning to the applicant's goods in class 26, the opponent's best case lies with its 'clothing'. The applicant's 'Accessories for apparel' and 'decorative textile articles' includes goods such as ribbons, bows, feathers, embroidered badges and trimmings for clothing. As well as being used by dressmakers and the like, those goods may also be purchased by the general public to compliment or enhance items of clothing. The respective goods may be sold in the same outlets, or at least share trade channels. There is some similarity in nature (both being made of textiles). Whilst the main purpose of the opponent's 'clothing' is to attire the body and keep a person warm etc., clothing is also used to enhance one's appearance. The applicant's goods may also be used to enhance one's appearance. To that extent, there is, therefore some shared purpose. Indeed, there is, in my view, a certain degree of aesthetic complementarity as the respective goods may be used together to create an overall 'look' or outfit. I find that there is a low degree of similarity between the opponent's 'clothing' and the applicant's 'Accessories for apparel' and 'decorative textile articles'.

18) As regards the applicant's 'sewing articles', this term includes items such as sewing needles, sewing boxes/baskets and thimbles and pin cushions. I can see no overlap between these kinds of goods and any of the opponent's goods and services. Their respective nature, purpose, and methods of use are entirely different and there is no competitive or complementary relationship in play. I find no similarity between the applicant's 'sewing articles' and the opponent's goods and services. As there cannot be a likelihood of confusion where there is no similarity of goods/services⁵, the opposition under Section 5(2)(b) of the Act must fail against the applicant's 'sewing articles'.

⁵ See, for example, *Waterford Wedgewood v OHIM* Case C-398/07

Average consumer and the purchasing process

19) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

20) The average consumer for the goods at issue is the general public. The purchasing act will be primarily visual on account of the goods being commonly purchased based on their aesthetic appeal; they are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs on Internet websites or in catalogues. That is not to say though that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with retail staff, for example. The cost of the goods is likely to vary. However, factors such as size, material, aesthetic appeal or suitability for purpose are likely to be taken account of by the consumer in relation to all the goods, even those at the more inexpensive end of the spectrum. Generally speaking, I find a medium degree of attention is likely to be paid during the purchase.

Comparison of marks

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

impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take account of their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

22) The marks to be compared are:

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The opponent's mark consists of the single word 'STOLEN' without any stylisation. The overall impression lies simply in the word itself. The applicant's mark consists of the three words 'Must Be Stolen' without any embellishments or stylisation. The overall impression lies in the combination of those three words.

23) Both marks contain the word STOLEN. That word constitutes the entirety of the opponent's mark and the third word in the applicant's mark. The first two words in the applicant's mark are absent from the earlier mark. Overall, I find a medium degree of visual similarity between the marks.

24) Aurally, the opponent's mark will be pronounced STOLE-UN and the applicant's mark as MUST-BEE-STOLE-UN. The applicant's mark therefore consists of four syllables, the last two of which are identical to the earlier mark. However, the first two

syllables of the applicant's mark are absent from the earlier mark. I find a medium degree of aural similarity between the marks.

25) STOLEN is a very well-known word with an immediately graspable meaning i.e. something which has been the subject of a theft. That is the sole concept of the earlier mark. The words 'Must Be' in the contested mark merely serve to put more emphasis on, and intensify, the concept of something 'Stolen' such that the overall concept is of something that is certainly or definitely the subject of a theft. I find a high degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

26) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

27) As I have already noted, STOLEN is an everyday word in the UK with a well-known meaning. The applicant contends that it has no distinctive character because, in its submission, it can mean ‘bargain’ and, as such, it is merely a promotional word used by many traders all over the world which should be free for all to use. This submission does not assist the applicant. Firstly, as the earlier mark is registered, it is not open to me to find that it has no distinctiveness at all. The fact that the earlier mark is registered is prima facie evidence of the validity of that registration and that the mark STOLEN therefore has the necessary distinctiveness to satisfy the requirements for registration, as per Section 72 of the Act⁶. In the absence of any application by the applicant to invalidate the earlier mark, I am therefore bound to find that it has at least some distinctiveness. Secondly, the applicant’s contention that STOLEN is commonly used to denote a ‘bargain’ in trade is unsupported by any evidence and it is no obvious to me, without such evidence, that the average consumer is likely to perceive that word in that way. In my view, the immediate conceptual message sent by the word STOLEN will merely be something that is the subject of theft but that is not, to my mind, a meaning which is likely to be immediately perceived as descriptive or allusive in relation to the earlier goods. Inherently, I find that it has a normal degree of distinctive character.

28) I must now consider whether the evidence before me from the opponent shows that the inherent distinctiveness of STOLEN has been enhanced as a consequence of use. Mr Revell provides, inter alia, the following information:

- The opponent is the corporate vehicle for the trade of products under the marks ‘STOLEN’, ‘STOLEN BIKES’ and ‘STOLEN BRAND’. Such trade is said to have been carried on since 2002. (Mr Revell also refers to other marks which are not relied upon in the notice of opposition, namely ‘STLN’, ‘STLN

⁶ That section of the Act states that: ‘In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.’

BMX' and 'STLN BIKES'. As those marks have not been pleaded, any use in relation to them is irrelevant.)

- Undated photographs of, what is said to be, goods currently offered for sale in the UK⁷. The mark STOLEN is present on a pair of socks and a cap. STOLEN BIKES is present on a rucksack. (There are also other goods bearing the 'STLN' marks.)
- The opponent's accounts are provided which are said to relate to trade under the STOLEN marks and the STLN marks.⁸
- Undated screenshots from the opponent's website, stolenbmx.com, showing t-shirts, tank tops and bags bearing the marks, STOLEN, STOLEN BRAND and STOLEN BIKES⁹. Prices of the goods are shown in American Dollars.
- Maps pinpointing the locations of the opponent's distributors in the UK¹⁰.
- A 'To whom it may concern' letter¹¹ from an individual stating that they are the managing director of Hotlines Europe Ltd. The individual confirms that they have 'actively distributed [the stolen brand] since 2015' and currently sell to a network of UK dealers including national retailers such as Wiggle.com. Undated screenshots¹² of the websites of such retailers and the aforementioned distributor are provided, showing STOLEN branded bikes and parts thereof.
- Invoices¹³ for the purchase of stock for the opponent's business dated April and March 2021. The goods listed in the invoices are described as 'STOLEN' t-shirts, bags, hoodies, socks, beanies and caps. One invoice amounts to over \$9,000, the other to over \$10,000.
- Screenshots from the STOLEN brand's social media pages on Twitter, Facebook, Instagram and YouTube¹⁴. The Twitter page has just over 2,000 followers, the Instagram page has 73.8 thousand followers, the Facebook page has over 57,000 followers, a video on YouTube from 2011 entitled 'Stolen Bikes' had over 76,000 views.

⁷ Exhibit 6

⁸ Exhibit 2

⁹ Exhibit 8

¹⁰ Exhibit 8

¹¹ Exhibit 3

¹² Exhibit 7

¹³ Exhibits 4 & 5

¹⁴ Exhibit 10

29) The relevant date for assessing whether the earlier mark enjoys enhanced distinctiveness through use is the filing date of the contested mark, namely 27 August 2021. I remind myself that the relevant goods covered by the opponent's registration for the purposes of my assessment under section 5(2)(b) of the Act are 'clothing', 'trunks and travelling bags', 'rucksacks' and 'purses'.

30) There is very little evidence before me that clearly emanates from before the relevant date showing use in relation to any of the relevant goods. The screenshots and the photographs provided are, for example, undated and Mr Revell does not state that those images are representative of the goods that were sold prior to the relevant date. The photographs, for example, are said to represent the kinds of goods 'currently' for sale (i.e. at the date of Mr Revell's witness statement, being 25 July 2022) rather than those which were for sale before 27 August 2021. Furthermore, the evidence that does clearly relate to the period before the relevant date sheds little light on the matter and is lacking in specificity. For example, the letter from the distributor confirming that they have distributed the opponent's goods since 2015 gives no indication of the volumes distributed or the exact goods that were distributed prior to the relevant date and the screenshots of the websites which are said to sell such goods are, again undated and, in any event, they only show 'parts and fittings for bikes' which are not the relevant goods for the purposes of my assessment of the likelihood of confusion under Section 5(2)(b). Further, although the opponent provides invoices showing that they purchased STOLEN branded stock 4-5 months prior to the relevant date, this is not evidence of sales by the opponent of those goods prior to the relevant date. There are also no turnover figures provided for the various goods relied upon and it is impossible to tell how many of any such sales (if, indeed, there were any) related to goods bearing the mark STOLEN, as opposed to the various STLN marks shown in the evidence (any sales or promotion under the latter marks are not relevant in establishing that the mark STOLEN has enhanced distinctiveness). The social media pages also shed little light on the position.

31) Whilst I remind myself that I must take a collective view of the evidence rather than focusing on each individual piece in isolation, even when standing back and

viewing it as a whole, the deficiencies are such that I am not persuaded that the evidence is sufficiently solid to satisfy me that that the earlier mark enjoyed enhanced distinctiveness for any of the relevant goods at the relevant date of 27 August 2021.

Likelihood of confusion

32) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

33) Some of the respective goods in class 18 are identical, others are similar to a high degree and some of the goods in class 26 of the applicant are similar to a low degree to the earlier goods. The marks are visually and aurally similar to a medium degree and the conceptually highly similar. The earlier mark also has a normal degree of distinctiveness. Taking all of these factors together, and bearing in the mind the potential for imperfect recollection, I find that a significant proportion of average consumers paying a medium degree of attention, are likely to mistake one mark for the other. There is therefore a likelihood of direct confusion.

34) In case I am wrong about the consumer being directly confused, and the average consumer does recognise that the marks are not the same, I will consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10¹⁵, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

¹⁵ The opponent's submissions in lieu, at paragraph 36.

“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)”.

35) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [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.

36) Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

37) Weighing all relevant factors, I come to the view that, when faced with the applicant's mark on the goods at issue, the similarities between the respective marks and, in particular, the high degree of conceptual similarity between them, is such that the average consumer is likely to believe that the applicant's mark is another brand belonging to the owner of the earlier mark. It seems to me that a significant proportion of consumers are likely to believe that the applicant's mark 'Must Be' a 'STOLEN' branded product. I reach this conclusion in respect of all the goods at issue, even where the similarity between them and the opponent's goods is low. **The opposition under Section 5(2)(b) of the Act succeeds against all of the contested goods with the exception of 'sewing articles'.**

Section 5(4)(a)

38) I can deal with this ground relatively briefly. As I have already noted, the evidence before me has numerous deficiencies and is lacking in specificity such that I do not consider that it is sufficiently solid to show that the opponent had the requisite goodwill in a business providing any of the pleaded goods and services prior to the relevant date. Without establishing goodwill, there can be no misrepresentation or damage. Further, even if I had found the evidence sufficient to establish the necessary goodwill, any such goodwill would, on the evidence before me, be modest, and would, notwithstanding the similarities between the mark and the earlier signs, be in a field of activity too far removed from the applicant's field of activity in 'sewing articles' to result in misrepresentation or damage. **The opposition under Section 5(4)(a) fails.**

OVERALL OUTCOME

39) **The opposition succeeds against all of the contested goods except ‘sewing articles’.**

COSTS

40) As the opponent has been very largely successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing a statement and considering the other side’s statement	£300
Official fee (Form TM7)	£200
Preparing and filing evidence and submissions	£500
Total:	£1000

41) I order Must Be Group Ltd to pay Revell Bikes Limited the sum of **£1000**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of May 2023

**Beverley Hedley
For the Registrar,
the Comptroller-General**