

O-083-17

TRADE MARKS ACT 1994

IN THE MATTER OF THE FOLLOWING CONSOLIDATED PROCEEDINGS

REGISTRATION NO 3114410 IN THE NAME OF EVAQ8 LIMITED

AND

AN APPLICATION FOR CANCELLATION THEREOF UNDER NO 501160 BY
DUNCAN GRAY

AND

APPLICATION NO 3141792 IN THE NAME OF DUNCAN GRAY

AND

OPPOSITION THERETO UNDER NO 406473 BY EVAQ8 LIMITED

Background

1. This decision concerns two consolidated proceedings:

1. Registration No 3114410 for a series of four marks **Go-Bag**, **Go Bag**, **go bag** and **go-bag** which has a filing date of 22 June 2015 and was entered in the register on 23 October 2015. It stands in the name of EVAQ8 Limited (“EVAQ8”) and is registered for goods in classes 5, 8 10 and 11.

On 11 March 2016, Duncan Gray filed an application seeking to invalidate the registration under section 47 of the Trade Marks Act 1994 (“the Act”). He relies on a single ground under section 3(1)(d) of the Act and claims the marks consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

EVAQ8 filed a counterstatement denying the claims made and seeking to rely on the proviso to section 3 should its primary case be unsuccessful.

2. Application No 3141792 for the trade mark shown below and which has a filing date of 22 December 2015. It stands in the name of Duncan Gray and seeks registration for goods and services in classes 5, 8, 9, 11, 18, 22 and 35.



Following publication of the application in the *Trade Marks Journal* on 22 January 2016, EVAQ8 filed a notice of opposition. Its grounds of opposition are brought under sections 5(2)(b) and 5(3) of the Act based on its earlier mark No 3114410. There is also an objection under section 5(4)(a) of the Act based on use of the signs Go-Bag, Go Bag, go-bag and go bag throughout the UK since 15 July 2007.

Mr Gray filed a counterstatement indicating he rejected each of the claims made and challenging the validity of the earlier mark relied upon.

2. The two proceedings were consolidated. Both parties filed evidence with EVAQ8 also filing written submissions during the evidence rounds. Neither party sought a hearing nor did they file written submissions in lieu of attendance at a hearing. I therefore give this decision from the papers before me.

The evidence and submissions

3. This consists of:

EVAQ8's evidence and submissions

Written submissions dated 21 September 2016 and 14 November 2016 along with witness statements of Zaid Al-Mufti dated 14 September 2016 with exhibits ZAM1-ZAM10 and Monika Al-Mufti Nadig dated 27 October 2016 with exhibits MAMN1-MAMN2.

Mr Gray's evidence

A witness statement of Duncan Gray dated 11 September 2016 with exhibits DG1 to DG9.

4. I will refer to this material as necessary in this decision.

Decision

The application by Mr Gray to cancel registration 3114410

5. Mr Gray's application is based on a ground under section 3(1)(d) of the Act which states:

"3(1) The following shall not be registered –

(a) ...

(b) ...

(c) ...

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

6. Mr Gray sets out his claim as follows:

"The application is based on the fact that the registered terms "Go Bag" "Go-Bag" "go bag" "go-bag" have been widely in use for over a decade (2004 and earlier) and widely accessible to the UK population prior to their registration in June 2015. Therefore these terms are generic for the goods they describe. The term is used widely in reference to a bag or kit packed and ready to go for any specific application (not just emergency and disaster preparedness). My evidence proves that the term was already in use and widely accessible to the UK population since as early as 2004 and has merely been adopted by the party in question. Even should the term have been made popular by their use (as claimed) it is my belief that the terms would have been mismanaged to the extent that they became generic for the goods they are registered against."

7. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court (“GC”) summarised the case law of the Court of Justice under the equivalent of section 3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking

from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

8. In his witness statement Mr Gray states:

“I truly believe that the term “gobag” and [EVAQ8’s] variants of, are already generic for the goods of which they are registered against and have been prior to their registration, proven by the significant evidence provided from a wide variety of demographic.”

9. The evidence to which Mr Gray refers is set out in exhibits to his witness statement. These are:

- DG2: an extract from urbandictionary.com. It shows the “top definition” for the term “go bag” along with an example of its use said to have been uploaded by “Jake January 19, 2004”. Mr Gray submits this dictionary is “widely accessible to the UK population” and shows “the terms are generic for the goods they describe”;
- DG3: an article said to have been published in *The Telegraph* on 2 July 2008. The article lists “new words in the Concise Oxford Dictionary” one of which is go-bag. The extract reads “go-bag –a bag packed with essential items, kept ready for use in the event of an emergency evacuation of one’s home”;
- DG4: A page said to have been downloaded from the Cheshire East Council website giving emergency planning advice. It encourages readers to “Prepare a “Go Bag” -a collection of items needed in an emergency”. The page is not dated;
- DG5: an article said to have been taken from an unidentified bodyguard’s training forum. The article is entitled “GO-BAG CHECKLIST”. Neither the article nor the page is dated (though at the end of it is a copyright date of 1995-2016 which suggests it is a document dating from 2016);
- DG6: an extract from Police UK Forum showing posts from May 2010. The thread is entitled “First ever shift...And go-bags?” and the poster asks

colleagues for information on what “they put in their go-bags?” as s/he is about to undertake his/her first night shift and wants to know what others suggest s/he should take with him/her. Two of the responses query the use of the term “go bag” asking what it is or commenting that they have never heard of such a thing;

- DG7: a page said to have been downloaded from the bennettcards.co.uk website, which Mr Gray says is a Jehovah’s Witness website. The page indicates it offers “premier Theocratic Products”. The page bears the heading “Go Bag” and offers readers the opportunity to download a “free printable 3 fold leaflet” and order some “essential items”. The page is not dated;
- DG8: this appears to be a copy of the 3 fold leaflet referred to in DG7. It is entitled “Do you have your Go Bag ready?” and, amongst other things, offers to supply a “Starter Go Bag + Survival Tin”. The leaflet is not dated;
- DG9: What Mr Gray states is a “preparedness booklet by The City of York and Harrogate Borough Council”. It is headed “R U Prepared?” and shows “step 5 –Go bag”. It lists items which the reader may wish to include in “a small, easy-to-carry bag” which it refers to as a “go bag”. The leaflet is not dated.

10. Leaving aside the dictionary references, to which I shall return, as can be seen from my summary above, most of the exhibits which Mr Gray has filed are not dated or are dated after the relevant date and do not establish what the position may have been at that relevant date (22 June 2015). The only remaining dated exhibit is the single post on a police forum and on which others have queried the use of the term “go bag”.

11. Mr Gray submits that the marks **Go-Bag**, **Go Bag**, **go bag** and **go-bag** are descriptive. The above case law makes it clear that marks are excluded from registration under section 3(1)(d) of the Act not on the basis that they are descriptive but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (or, as in this case, have become registered) and taking into account the target public’s perception. Whether or not dictionary or other references are “widely accessible to the UK population” is not the relevant test. The only evidence which Mr Gray has filed referring to any

trade in the relevant goods is the material he says refers to kits supplied by Bennettcards which describes itself as a theocratic supplies company. That material is not dated and so cannot be relied on to show what the position was at the relevant date. Taking all matters into consideration, I find that Mr Gray has not shown that **Go-Bag, Go Bag, go bag** and **go-bag** had, at the relevant date, become customary in the current language or in the *bona fide* and established practices of the trade in the relevant goods. The objection under section 3(1)(d) of the Act against registration No 3114410 fails. That being the case, there is no need for me to go on to consider EVAQ8's claim reliant on the proviso to section 3(1)(d).

The opposition by EVAQ8 to application no 3141792

The opposition under section 5(2)(b) of the Act

12. I intend to consider, first, EVAQ8's claim made under section 5(2)(b) of the Act which states:

“5(2) A trade mark shall not be registered if because-

(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 of association with the earlier trade mark”.

13. EVAQ8 relies on its registration no 3114410 under this ground. As can be seen from the dates set out above, it is an earlier trade mark within the meaning of section 6A of the Act. Given that it had not been entered in the register for a period of five years at the time Mr Gray's application was published, EVAQ8 is entitled to rely on it for each of the goods for which it is registered.

14. In determining what constitutes a likelihood of confusion, I bear in mind the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

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 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

15. For ease of reference, and noting that Mr Gray's specification in class 18 contains a typographical error but reproducing it as published, the goods and services to be compared are as follows:

EVAQ8's specification	Mr Gray's specification
Class 5 First aid, emergency and disaster preparedness supplies in a back-pack type bag	Class 5 Complete First Aid Kits to be sold separately or as part of bushcraft & emergency kits
Class 8 First aid, emergency and disaster preparedness hand tools	Class 8 Knives, Axes, Saws, Shovels, Sharpeners to be sold separately or as part of bushcraft and emergency kits
Class 10 First aid, emergency and disaster preparedness supplies namely, medical equipment in a back-pack type bag	Class 9 Fire Extinguishers to be sold separately or as part of bushcraft and emergency kits; Vehicle breakdown warning triangles to be sold

<p>Class 11 First aid and emergency preparedness wind-up torches</p>	<p>separately or as part of bushcraft and emergency kits; Compasses (directional) to be sold separately or as part of bushcraft and emergency kits</p> <p>Class 11 Water filtration apparatus to be sold separately or as part of bushcraft and emergency kits; Torches to be sold separately or as part of bushcraft and emergency kits.</p> <p>Class 18 Bags either sold separately or as "ready made" bushcraft and emergency kits.</p> <p>Class 22 Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes) to be sold separately or as part of bushcraft and emergency kits;Tarpaulins to be sold separately or as part of bushcraft and emergency kits;Ropes (car towing) to be sold separately or as part of bushcraft and emergency kits.</p> <p>Class 35 Retail services in relation to outdoor and emergency equipment in the form of ready made bushcraft kits containing first aid and survival equipment or emergency kits for the vehicle and home containing first and safety equipment.</p>
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16. 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:

“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”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated 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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

20. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

21. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC 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.

22. 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 v 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.”

23. On the basis of the European courts’ judgments in *Sanco SA v OHIM* Case C-411/13P, and *Assembled Investments (Proprietary) Ltd v. OHIM* (Case T-105/05), upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd* (Case C-398/07P), 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).

24. In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the GC held that a registration for 'retail services', which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.

25. Some of the terms within EVAQ8's specification are somewhat vague e.g. "emergency and disaster preparedness supplies in a back-pack type bag". In *Chartered Institute of Patent Attorneys v Registrar of Trade Marks*, Case C-307/10 the CJEU held that:

"64. Therefore, the answer to the questions referred is that:

– Directive 2008/95 must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark;"

26. In *Advance Magazine Publishers, Inc. v OHIM*, Case T-229/12, the GC held that 'accessories' is a vague term and the OHIM Board of Appeal therefore erred in law in comparing it with 'umbrellas'. It therefore appears that where a term is not sufficiently precise to identify the characteristics of the goods (or services) at issue, that term cannot be the subject of a finding that it covers goods/services which are similar to other goods/services.

27. In *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA) the Court stated:

“It is permissible to take into account the class number specified by the applicant when assessing the meaning of the descriptions of goods/services included in the application.”

28. Whilst both parties' specifications cover goods for inclusion into e.g. an emergency kit, this fact does not mean, of itself, that the respective goods and services are similar or identical. It is necessary to compare each of the goods and services separately.

29. Mr Gray's application in class 5 is for first aid kits which are goods covered by the earlier mark in the same class. These are therefore identical goods.

30. The same is true as regards the respective specifications in class 8. Each item within Mr Gray's specification is a hand tool. EVAQ8's specification in this class is also for hand tools. Identical goods are therefore involved.

31. Mr Gray's goods in class 9 are fire extinguishers, vehicle breakdown warning triangles and compasses, whether sold separately or as part of e.g. an emergency kit. Whilst I accept that the earlier mark is registered in two classes for what are somewhat vaguely specified as being emergency supplies in a back-pack type bag (and which could therefore also be described as an emergency kit), it is not registered for any goods in class 9 and the “kits” for which it is registered are limited to those which are medical supplies (in class 5) or medical equipment supplies (in class 10). Mr Gray's goods in class 9 are not medical supplies or medical equipment. I find these are dissimilar goods to those covered by EVAQ8's registration.

32. Mr Gray's application in class 11 includes torches which would encompass wind-up torches as are included within EVAQ8's registration in the same class. These are therefore identical goods. Mr Gray's application in this class also includes water filtration apparatus. EVAQ8's earlier mark is not registered for any such apparatus in this class. Again, I acknowledge that the earlier mark is registered for “kits” in classes 5 and 10, however, I do not consider that apparatus for filtering water has

any similarity to medical (equipment) supplies. The users, nature and purpose of the respective goods are different and they are not complementary within the meaning of the case law set out above. These are dissimilar goods.

33. Mr Gray's application in class 18 covers bags at large. The earlier mark is not registered in class 18 or for bags. Whilst some of the goods of the earlier mark (i.e. its supplies in classes 5 and 10) are specified as being sold in a back-pack type bag, this does not make them similar to bags; they are first aid or medical equipment supplies. That said, Mr Gray's application also includes bags being ready-made emergency kits. A "bag containing an emergency kit" and an "emergency kit in a bag" are alternative ways of describing the same thing and to this extent I find that these respective goods are highly similar if not identical.

34. In respect of Mr Gray's specification in class 22, again, EVAQ8's registration does not cover any such goods in this class. To the extent that both specifications cover "emergency kits" those of the earlier mark are limited to being medical (equipment) supplies. I find that Mr Gray's goods as specified in class 22 are dissimilar to any of the goods covered by EVAQ8's registration.

35. Mr Gray's application in class 35 include retail services in relation to goods which I have found to be similar or identical to those for which the earlier mark is protected. As the case law above makes clear, this is not sufficient, of itself, to find that the retail services are similar to the goods. The goods at issue here are, essentially items and kits for emergency purposes. On that basis, they are goods which will be bought infrequently and most likely in the hope that they will not need to be used. But given that they will be bought with the intention of providing a back-up for particular, if rarely-met situations in which the purchaser may find himself, it is likely that the purchaser will seek advice and guidance on the merits of various items and on what to include in a particular kit. The complementary relationship between the goods and services is such that I find that they are similar.

Average consumer and the nature of the purchasing process

36. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

37. 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.”

38. Mr Gray’s specification covers a range of goods sold as separate items as well as being included in kits for bushcraft or emergency purposes. Each of the goods and services at issue is such as may be purchased by the general public as well as professionals such as e.g. carpenters (saws) or builders (shovels). Bushcraft kits will be purchased by those who enjoy outdoor leisure pursuits whilst emergency kits are such as may be purchased by the general public or by businesses or organisations such as local authorities or companies each seeking to protect or provide assistance to themselves, their family, staff or the public in a particular situation. The specifications of the respective parties are such as to cover goods and associated services which vary widely in their complexity from e.g. a single tool or simple first aid kit for use in a domestic setting to kits for emergency use where there are multiple casualties in a public setting. All will be bought with a reasonable, though not necessarily the highest, degree of care. The purchasing process is likely to be primarily visual with items bought from a shelf, catalogue or webpage, though aural

considerations will also come to the fore where advice is sought from staff regarding recommendations for the most appropriate product for certain jobs or situations.


Comparison of marks

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

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

40. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account 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 them.

41. For ease of reference, the marks to be compared are as follows:

EVAQ8's marks	Mr Gray's mark
<p style="text-align: center;">Go-Bag Go Bag Go bag Go-bag</p>	

42. EVAQ8's earlier marks are a series of four each including the two separate words GO and BAG. In each case the word GO is presented in title case. In two of the marks the word BAG is presented in title case (one being separated from the word GO by a hyphen) and in two the word BAG is presented in lower case (again one being separated from the word GO by a hyphen). In each case, the distinctiveness of the mark rests in the whole. The differences between the four marks are not material and I intend to refer to them (as the parties have done) in the singular.

43. Mr Gray's mark is a composite mark made up of a number of elements. In the centre of the mark is the element UKGOBAGS presented in white in an unremarkable font. Whilst the tops of each of the letters are in line, the lower limb of the letter K extends further than the other letters. Underneath this, and in a much smaller and green font, and extending from the lower limb of the letter K and ending in line with the letter S, are the words "THE BEST EQUIPMENT FOR THE WORST SITUATION". These latter words are hard to make out given their size and lack of colour contrast but to the extent they may be seen, they are likely to be given little, if any, trade mark significance. To the right of these elements is the outline of what appears to me to be the profile of a person facing towards the left and wearing a backpack which is not a particularly distinctive element in the context of the goods and services. The whole is presented on a dark rectangular background. Whilst the person in profile is more than twice the height of the letters, the respective colours, size and positioning of the various elements mean that it is the element UKGOBAGS which dominates the mark. The fact that the letter K extends further than the other

letters within this element serves to separate the UK from the remainder and whilst presented as a single word, this separation reinforces my view that this element naturally breaks down to, and will be seen as being made up of, the words UK GO BAGS. The other elements are not negligible so still play a role within the mark albeit a lesser one.

44. Visually, there are some differences between the respective marks due to the additional elements in Mr Gray's mark which are not present in the earlier mark. There are also clear similarities in that the words making up the earlier mark are included within Mr Gray's mark and in the same order. The respective marks are visually similar to a medium degree.

45. Aurally, the presentation of Mr Gray's mark will have no effect. The mark will be referred to as "UK Go Bags" and is highly similar to the earlier mark.

46. Each of the words UK, GO and BAG(S) are everyday words well-known in the English language. Given that both refer to GO BAG(S), whatever image is brought to mind will be the same in each case albeit that in the case of Mr Gray's mark, that meaning will be directed towards the UK.

Distinctive character of the earlier mark

47. As I have indicated above, Mr Gray has made submissions to the effect that the earlier mark is descriptive though he did not raise any such objection in his application to cancel the earlier registration. As per the finding of the CJEU in *Formula One Licensing BV v OHIM*, Case C-196/11P, the fact that a mark is registered means that it must be assumed to have at least some distinctive character. In terms of the level of inherent distinctive character in the earlier mark, whilst both parties have referred to the entry for "go-bag" in the Concise Oxford Dictionary, neither has submitted the entry in evidence. It is well established that I am entitled to refer to dictionary references. Having done so, it is clear that the entry defines "go-bag" as a North American term (as well as a UK trade mark). Whilst it could be said to be allusive of the goods for which it is registered, I consider the mark to have no clear meaning in the UK. I find some support for my view in Mr

Gray's exhibit at DG6 where a number of posters, presumably police officers, make it clear they are unaware of the term or its meaning. In my view it is a mark with an average degree of inherent distinctive character.

48. EVAQ8 has filed evidence of its use of the mark. In his witness statement, Mr Zaid Al-Mufti states that goods have been sold under the mark since 2007, both through its own website and via the Amazon UK website. At ZAM-1 and ZAM-2, he exhibits printouts from both websites which show emergency kits for sale under the mark. None of the printouts are dated. Mr Al-Mufti provides the following details of sales made of products in the UK bearing the mark:

Year	GO-BAG emergency kit sales
2009	£10,254.34
2010	£5,920.57
2011	£5,399.16
2012	£48,813.45
2013	£35,895.26
2014	£34,674.52
2015	£24,951.83

49. At ZAM-4, Mr Al-Mufti exhibits a selection of invoices, purchase orders and related order acknowledgements relating to five transactions, two from November/December 2007 and the remainder dated between February 2010 and May 2010. Whilst on some of these a number of goods are listed, they relate to the supply of a total of some 56 x GO BAG emergency kits. None show any address details although one is said to be for export. At ZAM-3, Mr Al-Mufti exhibits a list of what he refers to as "large organisations that have bought GO-BAG branded emergency kits". Whilst the list includes e.g. local authorities in the UK, governmental departments, hotels, charities and utility providers, no information is given as to when any of them may have made any purchases or what, specifically, they may have purchased.

50. At ZAM-5, Mr Al-Mufti exhibits a copy of part of an article which appeared in the October 2012 edition of *Bushcraft* magazine and which he says reviewed a range of “72 hour emergency kits” including one of EVAQ8’s GO-BAG kits which is offered as a competition prize. He states that this magazine has an average circulation of 53,000 physical copies in the UK and is for sale through W H Smith stores, independent newsagents and outdoor retailers as well as being available to download electronically, with a further 53,000 electronic issues being circulated worldwide. In addition, he states that in April 2014, one of his company’s GO-BAG emergency kits was used as part of an exhibition in the Volcanoes and Earthquake Gallery of the Natural History Museum in London. He goes on to state that the museum had 5.6 and 5.4 million visitors in 2013/14 and 2014/15 respectively though he does not state how many of these may have visited the particular gallery and saw the exhibition. At ZAM-6 he exhibits a copy of a photograph showing the exhibit which contains a backpack and states that the mark appears “beneath” the bag. Whilst I can see a backpack has the words *Emergency Kit* stamped on it, the quality of the photograph and print is such that I cannot see any other words which may be “beneath” it.

51. In her evidence, Ms Monika Al-Mufti-Nadig states that EVAQ8:

“...works in conjunction with the North Yorkshire Emergency Planning Office and has been since 2015. The Council use my Company’s emergency kit bags branded GO BAG as demonstration models on their stands when exhibiting to the public”.

She does not say when in 2015 the two started working together though at MAMN-1 she exhibits a copy of a blog taken from the EVAQ8 website which refers to this collaboration. The post is dated 2 October 2015. She gives no further information about when or where any such exhibitions may have taken place or who or how many people may have attended them. At MAMN-2 she exhibits extracts from the North Yorkshire Emergency Planning Office’s Twitter account. Three of the four pages show the use of “Emergency kit” whilst a fourth refers to the opportunity to win an “EVAQ8 grabbag” at #whitbyregatta this weekend. This latter post is dated 21 August 2016.

52. The evidence filed by EVAQ8 has a number of flaws as set out above. I have no evidence of the size of the relevant market or EVAQ8's share of it at any particular point. Although I consider it likely to be a relatively niche market, the sales figures, which range from around £5,000 to £49,000 are not particularly high, more especially so when taking into account that the material at ZAM-1 shows emergency kits being offered for sale at well over £200. Whilst it has shown it has traded for a number of years under the mark, I have no evidence from customers or the trade. The evidence showing any advertising before the relevant date is extremely limited, taking the form of a single review of one of its emergency bags which is offered as a prize in an edition of *Bushcraft* magazine. Whilst it is also said to have had a presence on social media at the relevant date, the extent of its reach in this regard in the UK at that date is not provided. Taking the evidence as a whole, whilst it is clear the mark has been used over a number of years, I am unable to find that the distinctive character of the mark has been enhanced to any material extent through the use made of it.

Likelihood of confusion

53. In determining whether there is a likelihood of confusion, 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 also necessary for me to keep in mind the distinctive character of the opponent's trade mark.

54. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 (s)he has retained in mind.

55. Earlier in this decision I determined that certain of the respective goods were dissimilar. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

56. As a consequence, I find that there is no likelihood of confusion in respect of the following goods as are included within Mr Gray’s application:

Class 9

Fire Extinguishers to be sold separately or as part of bushcraft and emergency kits;
Vehicle breakdown warning triangles to be sold separately or as part of bushcraft and emergency kits; Compasses (directional) to be sold separately or as part of bushcraft and emergency kits

Class 11

Water filtration apparatus to be sold separately or as part of bushcraft and emergency kits

Class 18

Bags sold separately

Class 22

Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes) to be sold separately or as part of bushcraft and emergency kits;
Tarpaulins to be sold separately or as part of bushcraft and emergency kits; Ropes (car towing) to be sold separately or as part of bushcraft and emergency kits.

57. As regards the remaining goods and services in Mr Gray’s application, I have found them to be similar or identical to those specified in EVAQ8’s registration and I go on to consider the position in respect of these.

58. I have to consider both direct and indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted 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).”

59. Whilst I do not consider the average consumer will mistake one mark for the other (i.e. I do not consider there will be direct confusion), I do consider there will be indirect confusion on the basis of point (c) above. That being so, the opposition under section 5(2)(b) succeeds in respect of the following goods and services:

Class 5

Complete First Aid Kits to be sold separately or as part of bushcraft & emergency kits

Class 8

Knives, Axes, Saws, Shovels, Sharpeners to be sold separately or as part of bushcraft and emergency kits

Class 11

Torches to be sold separately or as part of bushcraft and emergency kits

Class 18

Bags sold as ready made bushcraft and emergency kits

Class 35

Retail services in relation to outdoor and emergency equipment in the form of ready made bushcraft kits containing first aid and survival equipment or emergency kits for the vehicle and home containing first and safety equipment.

60. Given my findings that the opposition under section 5(2)(b) has failed in respect of the goods set out at paragraph 56 above, I go on to consider EVAQ8's opposition under section 5(4) of the Act.

The opposition under section 5(4)(a) of the Act

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

“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, or

(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.”

62. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of

passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

63. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

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

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

64. The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP)

65. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C. as the Appointed Person considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-

registered national mark before the date of filing, in this case 11 March 2000.'

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;

- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

66. I have no evidence of the use of his mark by Mr Gray. That being the case, I will consider the position at the date the application was made (22 June 2015).

67. The first hurdle for EVAQ8 is to show that it has the necessary goodwill. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) the court stated:

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

68. In its notice of opposition, EVAQ8 claim to have used the mark on “first aid, emergency and disaster preparedness supplies in a back-pack type bag, first aid, emergency and disaster preparedness hand tools, first aid, emergency and disaster preparedness supplies namely, medical equipment in a back-pack type bag, first aid and emergency preparedness wind-up torches.”

69. Earlier in this decision, I summarised the evidence filed by EVAQ8. That evidence shows that emergency kits under the mark GO-BAG have been offered for sale since 2007. Sales figures for these are provided from 2009 to 2015. I cannot be sure how much of the 2015 figure relates to a period before the relevant date but the figures range from just over £10,000 in 2009 to just over £34,500 in 2014. Mr Zaid Al-Mufti states that EVAQ8 supply two general types of emergency kit “one intended for use during an evacuation, and one for sheltering-in-place”. Invoices, orders and order acknowledgements to or from a number of purchasers and dating from before the relevant date show the purchase of “Go Bag Emergency Kits” with some of them describing the kits as evacuation or survival supplies.

70. Promotional material, in the form of the article in the September/October 2012 edition of *Bushcraft* is also exhibited. The article reviews one of EVAQ8’s less expensive Go Bag Emergency Kits and offers one as a competition prize. The review lists the contents of this particular evacuation kit and shows it to contain food, drink, blanket, sleeping bag, mask, whistle, wind-up radio and torch, light sticks, water purification tablets, first aid kit, notebook and pencil. Mr Zaid Al-Mufti states that EVAQ8 has had a Facebook page since 2010 on which it “regularly provides advice in relation to disaster and emergency preparedness and reference its products bearing the Mark”.

71. None of this evidence has been challenged by Mr Gray and, when taken as a whole, I am satisfied that it shows EVAQ8 has the necessary goodwill and I go on to consider the second element of passing off, misrepresentation.

72. In relation to misrepresentation, in *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

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

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

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

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

73. In my consideration of the opposition under section 5(2)(b) of the Act, I considered the likelihood of confusion between the respective marks. In *Marks and*

Spencer PLC v Interflora, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

74. In my consideration of the grounds of opposition brought under section 5(2)(b), I found that whilst the respective marks are unlikely to be directly confused one with the other, there is a likelihood of indirect confusion on the basis set out above. There is a common field of activity in that both parties trade in emergency kits. The evidence shows that the contents of EVAQ8’s kits vary but the goods for which use is claimed are shown and it is clear that there is at least some overlap in the contents of those kits with those for which Mr Gray seeks registration. Even where the contents differ, the fact that they are in the same field of activity coupled with the similarities between the marks lead me to find that a substantial number of the relevant public will be deceived into purchasing Mr Gray’s products in the belief that they are EVAQ8’s products such that there is misrepresentation.

75. In light of the above, I consider there is an obvious risk of damage to EVAQ8’s business by substitution. Customers and potential customers will be lost to it if they transfer their custom to Mr Gray in the belief that they are dealing with EVAQ8. The opposition brought on grounds under section 5(4)(a) of the Act therefore succeeds in full.

Summary

76.

(i) Mr Gray’s application to invalidate registration No 3114410 fails.

(ii) EVAQ's opposition to Mr Gray's application No 3141792 succeeds under section 5(2)(b) of the Act in respect of the following goods and services:

Class 5

Complete First Aid Kits to be sold separately or as part of bushcraft & emergency kits

Class 8

Knives, Axes, Saws, Shovels, Sharpeners to be sold separately or as part of bushcraft and emergency kits

Class 11

Torches to be sold separately or as part of bushcraft and emergency kits

Class 35

Retail services in relation to outdoor and emergency equipment in the form of ready made bushcraft kits containing first aid and survival equipment or emergency kits for the vehicle and home containing first and safety equipment.

(iii) EVAQ8's opposition to Mr Gray's application No 3141792 succeeds under section 5(4) of the Act in full and, subject to any successful appeal, the application will be refused registration.

Costs

64. EVAQ8 has succeeded and is entitled to an award of costs in its favour.

Filing notice of opposition:	£300
Reviewing notice of opposition and filing counterstatement:	£300
Fee:	£200
Filing/reviewing evidence:	£500
Written submissions:	£300
Total:	£1600

65. I order Mr Duncan Gray to pay EVAQ8 Ltd the sum of £1600 as a contribution towards its costs. This sum is to be paid within fourteen days or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22ND day of February 2017

A handwritten signature in black ink, appearing to be 'A Corbett', written in a cursive style.

**Ann Corbett
For the registrar
The Comptroller-General**