

O-380-19

TRADE MARKS ACT 1994

IN THE MATTER OF:

**TRADE MARK APPLICATION No. 3257574
BY ECO TRAIL TREKKER GLOBAL LIMITED
TO REGISTER THE FOLLOWING TRADE MARK
IN CLASSES 35 AND 41**



AND

**OPPOSITION THERETO (NO. 411572)
BY OXFAM**

Background and pleadings

1) On 19 September 2017, Eco Trail Trekker Global Limited (“the applicant”) applied to register the following trade mark in the UK:



2) It was accepted and published in the Trade Marks Journal on 3 November 2017 in respect of the following services:

Class 35: Preparing promotional and merchandising material for others.

Class 41: Arrangement of sports competitions; Arranging and conducting athletic competitions; Arranging and conducting of sports competitions; Arranging and conducting of sports events; Arranging of sporting events; Arranging of sports competitions; Competitions (Organising of sports -); Competitions (Organization of sports -); Conducting of sports competitions; Conducting of sports events.

3) On 12 April 2018, Oxfam (“the opponent”) opposed the trade mark under Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK trade mark registration. Pertinent details of the registration are as follows (“earlier mark”):

UK No. 2498772

Mark: TRAILTREKKER

Filing date: 29 September 2008

Publication date: 7 November 2008

Date of entry in register: 16 January 2009

Services: Class 36 - Charitable fund raising services; financial services; credit, debit and charge card services.

Class 41 - Sporting and cultural activities.

4) The opponent argues that given the similarity between the marks and the identity and/or similarity of services, there is a likelihood of confusion.

5) The opponent's section 5(3) claim is also based on its earlier mark. In particular the opponent argues that the applicant will benefit from its investment in advertising, leading to advantage. Further that the applicant will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier mark. The opponent also claims that the later use will be out of its control and that poor quality or offensive goods will cause detriment to its valuable reputation and business. It claims that use of the later mark will dilute the distinctive character and reputation of its marks.

6) In respect of the opponent's section 5(4)(a) claim, this is on the basis of its alleged earlier rights in TRAILTREKKER. It claims that since 2008 it has been providing charitable fund raising, financial plus credit, debit and charge card services; and sporting and cultural activities services has acquired goodwill under the sign. Use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

7) The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier trade mark relied upon. The counterstatement also made various submissions which I have read and shall take into account where necessary. These include references to websites which the applicant claims to demonstrate that the opponent's mark was last used in 2015.

8) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

9) Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful consideration of the papers.

EVIDENCE

Opponent's evidence

10) The opponent's evidence consists of a witness statement and accompanying exhibits from Ms Rachel Jones who is the Head of Events at Oxfam GB, a position she has held since December 2017. Prior to this she was the Events Manager for Oxfam GB since October 2015.

11) Oxfam is a well-known charity which was founded in Oxford in 1942. It works to prevent and alleviate poverty through humanitarian relief, development projects and campaigning. Oxfam is an affiliate of the Oxfam confederation, which works in more than 90 countries worldwide.

12) Ms Jones states that the opponent first created and began use of the TRAILTREKKER name in 2009 as a charitable fundraising endurance event to be held in the Yorkshire Dales. The event was created following the success of TRAILWALKER which was started in 1998 generating large income for the charity. TRAILTREKKER was created to provide a tough challenge to participants in the North of England and the most recent event was held in 2015.

13) TRAILTREKKER is a team challenge, where groups are made up of four people. There are three distances for participants to choose from (40, 60 or 100km). Participants are required to pay an entry fee for their team (ranging from £160 to £275 depending on when they sign up) and raise at least £1500 for charity.

14) The number of participants was provided in the following table:

Year	Teams signed up (consisting of 4 people in each team)
2009	178
2010	164
2011	199
2012	229
2013	386
2014	170
2015	179

15) Ms Jones states that between 2009 and 2015, TRAILTREKKER has raised £2.92m for Oxfam. An annual breakdown of the revenue generated has been provided as follows:

Year	Funds raised
2009	£382,000
2010	£342,000
2011	£382,000
2012	£461,000
2013	£671,000
2014	£335,000
2015	£350,000

16) Following a request from the opponent, the marketing expenditure is the subject to a confidentiality order of 7 November 2018. Therefore, it's details are redacted from the published version of this decision:

Year	Marketing expenditure
2009	
2010	
2011	
2012	
2013	
2014	
2015	

17) Exhibit RJ3 to the witness statement consists of examples of marketing materials produced for the TRAILTREKKER events. Many of the examples are dated before the relevant period. The evidence includes numerous YouTube screenshots relating to a "TrailTrekker" event which took place in May 2012, which is a few months prior to the relevant period. The only screenshots within the relevant period are of a

promotional video which includes pictures of participants, includes the mark Oxfam Trailtrekker and it has been viewed 1,237 times. A similar screenshot makes reference to an event in 2015 which was viewed 51,180 times.

18) The exhibit also includes:

- An extract from Visit Skipton tourism website, which refers to Trailtrekker as being the “Ultimate Yorkshire Dales Challenge” taking place on 22-23 August 2015 and raising funds for Oxfam. It is also listed in the “Skipton Events” screenshot which is also exhibited.
- A train station poster (the specific train station is not identified) dated 2013 which refers to Trailtrekker.
- A poster advert dated 2013 which states “BE PART OF TRAILTREKKER” the ultimate challenge taking place on 1-2 June 2013 in the Yorkshire Dales.
- A promotional flyer and quarter page advertisement placed in the Metro newspaper in 2015. Both refer to the TRAILTREKKER challenge in the Yorkshire Dales on 22-23 August 2015.
- A bus rear advertisement, which the opponent claims to have been driven around Yorkshire (Leeds and Sheffield) and Manchester which advertises the event held on 22-23 August 2015.
- A rail 4-sheet also referring to the 22-23 August 2015 event which was place in Leeds, Sheffield, Manchester, Newcastle, Skipton, Liverpool, Nottingham, Chester, Chesterfield, York and Lancaster.

19) Exhibit RJ4 to the witness statement consists of press articles which the opponent claims to show use and recognition of the TRAILTREKKER event. Many of these are before the relevant period. Those that are not include an extract dated 20 February 2013 which is from the Oxford University Innovation website which states that the University took place in the 2013 Trailtrekker event. A similar extract is provided from the website of the company National Fan Suppliers Ltd which states that a team of 4 employees took place in the 2013 Oxfam Trail Trekker event.

20) Further examples of third party references to companies participating in the 2015 event include Walker Morris (a law firm) website, a blog called The Running Bug, a company called Abracs, Mitchell’s Accountants, Dryfix Preservation and online

newspaper publications from Telegraph & Argus (this article is dated 7 November 2014 and states that “Trailtrekker will return in 2015”), The Yorkshire Times and the online newspaper Craven Herald.

21) Ms Jones also provides copies of the participant brochures for the events held in 2013, 2014 and 2015¹. It states that the page was set up in April 2010 and that it had sent 3,139 Tweets and has 1,311 followers. It refers to Trailtrekker as “The ultimate team challenge – Join 300 teams in a once-in-lifetime, day and night trek through the rugged Yorkshire Dales – and do something extraordinary.” The only post shown in the “Tweets section” states “Thanks for all your hard work! Couldn’t do it without you.”, a reply to that Tweet reads “Gutted @Trailtrekker Yorkshire is no more. I’ve had the pleasure of being there for @BritishRedCross all 7 years”.

22) This concludes my summary of the opponent’s evidence.

Applicant’s evidence

23) The applicant’s evidence consists of a witness statement from Mr Paul Collins and nine accompanying exhibits. Mr Collins is the co-founder and director of the applicant.

24) Much of Mr Collins witness statement consists of submissions and assertions which I shall not summarise but refer to where necessary in this decision.

25) Exhibit PC1 to the witness statement is an extract from Oxfam’s Trailtrekker Twitter page. It is the same page provided in the opponent’s evidence². As previously described, it is clear from the posts that an event was due to take place in 2016 but was cancelled and therefore the last one was in 2015.

26) Mr Collins’ evidence also includes various Google searches which he conducted for the words “eco trail trekker” and “eco trail trekker global”. I am unclear from the explanation provided exactly what the searches demonstrate, but it is essentially

¹ Exhibit RJ6

² Ditto

argued that from the Google searches there is no confusion. I shall address this argument later in my decision. That concludes my summary of Mr Collins' evidence.

Proof of use

27) The earlier mark qualifies as an acceptable basis to oppose the application as defined in section 6 of the Act. Since the earlier mark was more than 5 years old at the date of publication of the application, and the applicant has requested proof of use, section 6A of the Act is applicable:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in

the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

Relevant period

28) The relevant period for proof of use is the five-year period ending on the date of publication of the application in the UK, namely 4 November 2012 to 3 November 2017. Under section 100 of the Act the onus is on the opponent to show genuine use of its mark during this period in respect of the services relied upon.

Proof of use case-law

29) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods

or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark

or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

30) I begin by reminding myself that the relevant period is between 4 November 2012 to 3 November 2017. Further, the services which the opponent must demonstrate genuine use are:

Class 36: Charitable fund raising services; financial services; credit, debit and charge card services

Class 41: Sporting and cultural activities

Sufficient use

31) Proven use of a mark which fails to establish *that “the commercial exploitation of the mark is real”* because the use would not be *“viewed as warranted in the*

economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark” is therefore not genuine use.

32) An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³

33) The opponent’s evidence includes uncontested, consistent UK turnover figures for the first three years of the relevant period as being £671k for 2013, £335k for 2014 and £350k for 2015. The opponent also provides figures for the number of attendees being around 1500 per event. Further, the opponent has provided marketing spend, third references to businesses participating in the event and examples of the mark being used to promote its services, i.e. press articles.

34) Mr Collins repeatedly states that the opponent’s mark has not been used since 2015 and if the mark is not used by 2020 then it could be susceptible to a non-use revocation action. However, I must assess whether there is genuine use of the mark for the services relied upon solely during the relevant period, 4 November 2012 to 3 November 2017. Use up to and including 2015 is a significant proportion of the relevant period and such use can be considered to be genuine use so that the opponent may rely upon its earlier mark.

35) I agree that the evidence is not without its deficiencies. For example, it does not include invoices and it does not explain the geographical extent and intensity of the advertising material provided. However, I find that the evidence does demonstrate that the mark has been used during the relevant period.

Form of use

36) The earlier mark has been registered as the word only TRAILTREKKER. There are numerous examples in the evidence (for example, many of marketing examples

³ *New Yorker SHK Jeans GmbH & Co KG v OHIM T-415/09*

in exhibit RJ3 and Twitter references) of the mark being used in this manner. Therefore, there is no doubt that the mark has been used as registered.

Fair specification

37) I must now consider whether, or the extent to which, the evidence shows use for all or only some of the relied upon goods. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

38) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

39) The earlier mark's list of relied upon services are broad and it is clear to me that they have not used the mark in relation to all these services. In Ms Jones' witness statement, she describes the opponent's use of Trailtrekker as a team endurance challenge event. This is supported by the evidence and promotional material. It is essentially an endurance challenge where participants endeavour to complete a difficult and long trek, as a team, in order to raise money. It is a specific endurance event.

40) Taking all of the above into account, I find a suitable and fair specification to be: Class 36 “Charitable fundraising services in the form of endurance events” and Class 41 “Sporting and cultural activities in the form of endurance events”.

DECISION

Section 5(2)(b)

41) Section 5(2)(b) of the Act is as follows:

“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”.

Case law

42) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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

43) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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”.

44) 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 of its judgment 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”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

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

46) The respective services are as follows:

Opponent's services	Applicant's services
Class 36: Charitable fundraising services in the form of endurance events	Class 35: Preparing promotional and merchandising material for others.
Class 41: Sporting and cultural activities in the form of endurance events	Class 41: Arrangement of sports competitions; Arranging and conducting athletic competitions; Arranging and conducting of sports competitions; Arranging and conducting of sports events; Arranging of sporting events; Arranging of sports competitions; Competitions (Organising of sports -); Competitions (Organization of sports -); Conducting of sports competitions; Conducting of sports events.

47) Endurance events are activities aimed at athletes who are able to remain active and participate in sports such as running, swimming, cross-country skiing, etc for long periods of time. They are generally undertaken by people who can exert themselves to long, sustained periods without fatiguing. Nowadays there are a number of endurance type events, ranging from Iron Man events (swim for 2-3 miles, cycle for around 112 miles and then complete a marathon) to marathons and hikes

(such as those carried out by the opponent). They are carried out in competition format or for recreational purposes.

48) The applicant does not provide any specific analysis in respect of whether the services are identical or similar. However, in Mr Collins' witness statement he does state: "Whilst the services covered by these two marks are very similar in nature it must be stated that these are not unusual services in the sector and this should not be a reason for confusion by the general public at large."

Class 35

49) The opponent argues in its written submissions that there is a close connection between the provision of "charitable fund raising" services *per se* and "preparing promotional and merchandising material for others" since the latter is an essential activity in the operation of a successful charity. The opponent goes on to state that "As charities are frequently engaged in the promotion of their services to the general public, an average consumer upon seeing the Application featured in this way, would be led to believe that the responsibility for the respective services lies within the same undertakings or economically-linked undertakings." I do see some merit in this argument. Charitable fund raising is the process of gathering contributions, typically money, by either requesting donations from individuals, businesses, crowd funding, etc or by carrying out a task or activity to raise money. Despite the earlier services being limited to relating to endurance events, they are nevertheless in class 36 and therefore a financial type service for such events. The applied for "preparing promotional and merchandising material for others" is more of an administrative type service, but it is intended at raising awareness to generate funds, potentially for endurance events. Therefore, they are similar in nature and may have the same end users but I do not consider them to be in competition or complementary. They are similar to a low degree.

Class 41

50) Applying the principle set out in *Meric*, I consider all of the applied for Class 41 to be sufficiently broad to include the opponent's services. Therefore, they are identical.


Comparison of marks

51) 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.”

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

53) The respective trade marks are shown below:

Application	Earlier mark
 The application logo features the text 'Eco TRAIL TREKKER' in green and black, with 'Eco' in a smaller font. To the right is a circular emblem containing a stylized landscape with a tree and a path. Below the text is a green and yellow wavy graphic. At the bottom, the website 'WWW.ECOTRAILTREKKER.COM' is written in small green letters.	TRAILTREKKER

54) The earlier mark is comprised of the words TRAIL and TREKKER which are conjoined. When marks comprise of conjoined words, consumers will naturally

dissect the words into ones that it recognises. In other words, the average consumer would view the mark as two separate words: TRAIL and TREKKER, conjoined. It is in the combination of these words where its overall impression rests.

55) The application is a combination of words and devices. Despite the word ECO being placed vertically to the left of the words TRAIL and TREKKER, which are placed above one another, they would be viewed as a whole (since English speakers read from left to right, even when words are positioned like this): ECO TRAIL TREKKER. To the right of these words is a circle containing stylised silhouettes of people holding their arms in the air which creates an image of them running through a sash, which includes the words ECO TRAIL TREKKER GLOBAL. All of the aforementioned are present above two differing shades of green semi circles at the base of the mark which would be perceived as hills. Within the "hills" is the domain name www.ecotrailtrekker.com. Mr Collins points out that the application includes "a significant symbol absolutely different from the oppositions [sic] Mark⁴". I do agree that the application contains elements which are not present in the earlier mark. However, since the words ECO TRAIL TREKKER are in a prominent position, in thick font and are repeated in the mark, I consider these to make the greatest contribution to the overall impression. I acknowledge that the device does add distinctive character to the mark but just to a lesser degree. The hills contribute even less (if at all) to the overall impression of the mark.

56) Visually, the respective marks coincide with the words TRAIL and TREKKER. Whilst in the application they are conjoined, as previously stated, consumers will naturally dissect them as two well know words in the English language. The marks differ insofar that the application includes the devices, domain name and the inclusion of ECO at the beginning. Given the prominence of the words ECO TRAIL TREKKER in the application and TRAILTREKKER being the only element in the earlier mark, I consider the respective marks to be similar to a degree below medium but not low.

⁴ Paragraph 5.3 of the witness statement

57) Aurally, the earlier mark will be pronounced as TRAIL and TREKKER. Despite the various additional elements in the application, it is likely to be referred to as ECO TRAIL TREKKER. Therefore, I consider the respective marks to be aurally similar to a high degree.

58) With regard to the conceptual comparison, the opponent argues that the respective marks are highly similar because:

“The distinctive combination of words TRAILTREKKER is composed of two words TRAIL and TREKKER. The word ‘TRAIL’ can mean “a path through a countryside, mountain, or forest area, often made or used for a particular purpose” (Cambridge Dictionary). The word ‘TREKKER’ means “A person who makes a long arduous journey, especially on foot” (Oxford Dictionary). Again, the word ‘ECO’ has a limited effect on the on the conceptual identity between the marks. As both the Application and the Earlier Mark share the dominant and distinctive element TRAILTREKKER, the relevant consumer will readily make a link between the Opponent.”

59) I agree with the opponent’s assessment that the marks are conceptually similar to a high degree. The inclusion of the word ECO before TRAIL TREKKER merely qualifies that the TRAIL may be more ecologically friendly. Further, the devices present in the application do not alter the high level of conceptual similarity between the respective marks. They reinforce the central message provided by the words. They are conceptually similar to a high degree.

Average consumer and the purchasing act

60) 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*.

61) 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.”

62) The services in question are charitable services aimed at raising money through endurance events, the broader preparation of promotional and merchandising material for others and the arranging of sports events and competitions. The average consumers for such services are likely to be charitable organisations who are looking to raise funds for different purposes, businesses seeking promotional assistance and the general public looking to organise or participate in sporting events. They are also likely to be sought following a perusal of websites, advertisements, magazines, etc. Therefore, they are likely to be purchased following a visual inspection. However, I do not discount aural recommendations through sales advisors, friends, family and business associates. The level of attention paid by businesses is generally higher but not to a great extent over the general public who will also pay a normal degree of care and attention.

Distinctive character of the earlier trade mark

63) 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)."

64) The level of distinctive character of a trade mark can vary, depending on the particular services at issue: a mark may be more distinctive for some services than it is for others. Distinctiveness can also be enhanced through use of the mark. There has been no explicit claim of enhanced distinctiveness but evidence of use has been filed in support of its section 5(3) of the Act claim. This evidence has been summarised above and I am required to assess whether, at the date the application was filed (19 September 2017), the opponent has demonstrated that it has an enhanced degree of distinctive character.

65) Mr Collins is critical of the opponent's evidence stating that it has not used its mark since 2015. This assessment does appear to be accurate since 1) turnover and marketing figures are provided up to and including 2015 but no later, 2) the Twitter pages filed by both parties which include statements that the 2016 event was cancelled and 3) there is no marketing or additional material for 2016 or 2017 (up to the relevant date in September 2017). The opponent has not indicated the size of the market nor what proportion of such market it enjoys. Moreover, as correctly highlighted by Mr Collins, the events organised by the opponent all appear to be in the Yorkshire Dales. There is no evidence that an event has taken place elsewhere

and this, therefore, limits the geographical scope and intensity of the services being provided.

66) Taking all of the above into account, I do not consider that the opponent has used the mark sufficiently to warrant its distinctive character being enhanced.

67) From an inherent perspective, the mark consists of TRAILTREKKER, which is a combination of two dictionary defined words that would be naturally dissected. The services in question relate to charitable and sporting events involving endurance trekking. Given the suggestive nature of the earlier mark, I find it to be inherently distinctive to a low degree.

Conclusions on Likelihood of Confusion and other arguments

Other arguments

68) The applicant argues that a likelihood of confusion does not exist since “the Opponent’s event is an endurance event organised in conjunction with the Queens Gurkha Signals with the sole aim of raising money for Oxfam whereas the Applicant’s operates local community-based events raising money for numerous charities.⁵” I do not accept this argument for two reasons: firstly, when determining whether there is a likelihood of confusion under section 5(2)(b), I must assess only the earlier mark as registered for the services which I have found use against the application for the services that it covers. It is essentially an abstract exercise that does not take into account the existing market conditions or particular proposed use. Notwithstanding this, whilst the opponent may currently use its mark in the Yorkshire Dales, there is nothing in the registration which limits its future use which may be throughout the country. In other words, it can use the mark for the services registered throughout the UK. Secondly, even if I were to accept the applicant’s argument that the parties raise funds for differing charities, I do not accept that those participating in endurance events would be able to differentiate between them based on the charities that they raise funds for. Participants are likely to assume that the

⁵ Applicant’s counterstatement

same entity organises the endurance events under the marks ECO TRAILTEKKER or TRAILTREKKER but may be for different causes.

69) The applicant also argues that since the Google searches for the words “eco trail trekker” and “eco trail trekker global” do not indicate confusion, then this reflects the marketplace and there being an unlikelihood of confusion. I must assess the position from the perspective of whether the average consumer (as identified above) of the services would be confused, not Google. I appreciate that if a party were to search for one mark (for example, Trailtrekker) and the other mark does not appear in the results this may lessen the likelihood of real marketplace confusion. However, I must look at the position from the average consumer who has already encountered mark X for various services and whether when they encounter mark Y for the same or similar services would be confused into believing they are the same, or economically linked. Therefore, I dismiss this argument.

70) Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). To determine whether there is a likelihood of confusion I now draw together my earlier, keeping in mind the factors I set out in paragraph 42.

71) I have found that the respective services are either identical or similar to a low degree. I have found that the marks are visually similar to a below medium but not low degree, aurally similar to a high degree and conceptually highly similar. The average consumer will either be businesses or the general public who will purchase the goods following a visual inspection, though I do not discount aural recommendations. The level of attention paid is generally normal. I have also found that the earlier mark has a low degree of distinctive character which has not been enhanced by virtue of the use made of it.

72) Taking all of these factors into consideration I do not consider that the respective marks will be directly confused, i.e. mistake one mark for another. In other words, I find that the visual differences, for a mark which is low in distinctive character will not

go unnoticed. However, merely mistaking one mark for another is not the only condition for a successful claim under section 5(2)(b) of the Act. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Mr Iain Purvis Q.C., as the Appointed Person:

“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 recognised 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.

73) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

74) In my view, the presence of TRAIL TREKKER (conjoined or not) is sufficient for consumers to recognise that there is something in common to the extent that there is an economic link between them. The addition of the word “ECO” together with various devices would be perceived as logical and consistent with a brand extension of the existing TRAILTREKKER mark. Therefore, I find that there is a likelihood of indirect confusion, even for the services which I find to be similar to a low degree.

75) The section 5(2)(b) claim succeeds.

76) As the opposition is successful in its entirety based upon this ground I am not required to consider the remaining grounds as they do not materially improve the opponent's position. However, for the sake of completeness, I shall deal with the claims briefly.

SECTION 5(3)

77) Section 5(3) states:

“(3) A trade mark which-

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

Case law

78) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls

the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

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

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

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

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

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

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

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

80) The relevant date for the assessment under section 5(3) is the application date, namely 19 September 2017.

Reputation

81) The first hurdle that the applicant must overcome is that it has the requisite reputation. The relevant case law can be found in *General Motors*, Case C-375/97, whereby the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

82) His Honour Judge Hacon, in *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) stated “Reputation constitutes a knowledge threshold”. It is a question of how many of the potential consumers of the services know of the earlier marks. The list of factors set out by the CJEU in *Intel*, to be taken into account in determining whether there is a link, includes, as separate factors, the strength of the earlier mark’s reputation and the degree of distinctive character, whether inherent or acquired by use. I have already said that the earlier mark has not had its inherent level of distinctive character enhanced through use. I also consider that it has not been shown that, at the relevant date, the earlier mark had a sufficiently strong reputation to cause a link to be made with the application. Even in relation to identical services, the evidence of use in the UK is too weak in the years leading up to the relevant date to bring the earlier marks to the mind of the relevant UK public. Therefore, I find that its TRAILTREKKER mark had not acquired a reputation for its services and it therefore falls at the first hurdle.

83) The section 5(3) ground fails.

SECTION 5(4)(a)

84) I shall now assess the opponent's section 5(4)(a) claim. The claim is based on its alleged earlier rights in the sign TRAILTREEKER which it claims to have been providing charitable fundraising services, financial services, credit, debit and charge card services plus sporting and cultural activities since 2008.

85) Section 5(4)(a) of the Act 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.”

Case law

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

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

a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

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

87) Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 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.”

Relevant date

88) Since the applicant has not filed any evidence to support that it has used its mark, the date at which I must assess the section 5(4)(a) claim is the date of the UK application,⁶ i.e. 19 September 2017.

Goodwill

89) In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 the House of Lords defined goodwill as:

“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

⁶ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person

which distinguishes an old-established business from a new business at its first start.”

90) I am satisfied for the reasons given above when assessing the proof of use requirements for section 5(2)(b) that the opponent had a protectable goodwill in respect of charitable fundraising services in the form of endurance events plus sporting and cultural activities in the form of endurance events. I am also satisfied that the sign was distinctive of the opponent’s business at that date.

Misrepresentation

91) 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.”

92) In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

93) Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously 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. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

94) I am satisfied that “a substantial number” of the opponent’s customers or potential customers will be deceived. I consider the opponent to be in the same position to successfully argue that there would be misrepresentation (or likelihood thereof) as well as there being a likelihood of confusion, as concluded above. The legal tests differ, but the outcome would be the same. Therefore, the section 5(4)(a) ground of opposition succeeds.

OVERALL CONCLUSION

95) The opposition has succeeded. Subject to appeal, the application shall be refused registration.

COSTS

96) The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £800 as a contribution towards the cost of the proceedings. This takes into account that the evidence filed by the respective parties was relatively light. The sum is calculated as follows:

Official fee	£200
Preparing evidence and considering and commenting on the other side's evidence	£500
Written submissions	£100
Total	£800

97) I therefore order Eco Trail Trekker Global Limited to pay Oxfam the sum of £800. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated 9 July 2019

Mark King

For the Registrar

The Comptroller-General