

**O/087/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK TRADE MARK REGISTRATION NO. 3400800  
IN THE NAME OF STEPHEN WEBSTER LIMITED FOR THE TRADE MARK**




**IN CLASSES 8 & 21**

**AND**

**THE OPPOSITION FILED THERETO UNDER NO. 418294  
BY SMITH & WESSON INC.**

## Background and pleadings

1. Stephen Webster Limited (the applicant) applied to register the trade mark no.

3400800 for the mark  in the UK on 20 May 2019. It was accepted and published in the Trade Marks Journal on 02 August 2019. On the 30 September 2020 the applicant filed a request to amend its specification, which now covers the following goods:

*Class 8: Hand tools and implements, hand-operated not being knives; cutlery; knives, namely chef knives, kitchen knives, cooking knives, carving knives, cheese knives; razors; parts and fittings for all the aforesaid goods.*


*Class 21: Household or kitchen utensils and containers; glassware; barware; chinaware; ceramics for household purposes and kitchen use; cookware and tableware, except forks, knives and spoons; combs and sponges; brushes, except paintbrushes; brush-making materials; articles for cleaning purposes; unworked or semi-worked glass, except building glass; glassware, porcelain and earthenware; parts and fittings for all the aforesaid goods.*

2. SMITH & WESSON INC. (the opponent) partially oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). Following the above limitation filed by the applicant, the goods which are the subject of the opposition by the opponent now stand as follows:

*Class 8: Hand tools and implements, hand-operated not being knives; cutlery; knives, namely chef knives, kitchen knives, cooking knives, carving knives, cheese knives; razors; parts and fittings for all the aforesaid goods.*

3. The opposition has been filed on the basis of the opponent's earlier European



Union trade mark no. 2730794 for the mark  <sup>1</sup>. The earlier registration was filed on 11 June 2002 and registered on 21 June 2005. The following goods are relied upon in this opposition:

*Class 8: Pocket knives - collector limited edition; knives, cutlery.*

*Class 13: Firearms, namely handguns and pistols; gun cases.*

4. The opponent submits that the respective goods are identical or similar and that the marks are similar both visually and phonetically to a high degree. The opponent argues that the distinctive character of the earlier mark has been enhanced due to the use made of the same. The opponent submits there is a likelihood of confusion directly, and that there is a likelihood of the consumer seeing the later mark as a sub brand of the earlier mark.
5. 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.
6. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
7. Both sides 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 perusal of the papers.

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.


8. Both sides are professionally represented in these proceedings. The opponent is represented by Marks & Clerk LLP, and the applicant is represented by Stobbs.

### **Evidence summary**

9. The opponent filed evidence by way of a witness statement in the name of Mr Tony Miele, and Exhibits TM1 – TM5. Mr Miele explains he has been with Smith and Wesson (which he refers to as “my company”), for nearly 45 years. Mr Miele explains he was appointed as “General Manager of Performance Center and Gemtech” in 2018, and has held the position of Senior Director of New Products since 14 November 2019.

10. Mr Miele explains that his company was founded as an industry leader in 1852 in the USA. He explains his company’s firearms were noted for innovation, quality and reliability, and that the business grew rapidly over the following decades, diversifying its product range and expanding overseas. Mr Miele explains that his company now employs roughly 1500 people and offers an expanded product range including, amongst other things, knives.

11. Mr Miele goes on to detail that his company has been exporting pistols, handguns and gun cases to distributors in the EU since at least 1993, and

knives since at least 2016, and that the mark  is used for the entire product range.


12. **Exhibit TM1** consists of a range of images from the website [www.smith-wesson.com](http://www.smith-wesson.com) provided using internet archiving website Wayback Machine. The images are as follows:

- A screenshot dated 18 December 2014 showing an image of two handguns;

- A screenshot dated 18 December 2014 showing an image of several handguns with prices displayed in USD;
- A screenshot dated 19 December 2014 showing a plastic handgun case;
- A screenshot dated 26 June 2014 displaying images of several knives described as “Special Tactical”, “Bullseye Search and Rescue”, “Black Ops” with prices displayed in USD;
- A screenshot dated 8 July 2014 showing an image of a knife described as Special Tactical Black ½ Serrated Blade Knife;
- A screenshot dated 2 January 2015 showing an image of an M&P 22 Contact handgun;
- A screenshot dated 3 March 2015 showing an image of a Plastic Handgun case;
- A screenshot dated 9 February 2015 displaying images of several knives described as “Special Tactical”, “Bullseye Search and Rescue”, “Black Ops” and “M&P” with prices displaced in USD;
- A screenshot dated 30 January 2015 showing an image of a knife described as Black Ops Black ½ Serrated Tanto Blade Knife;
- A screenshot dated 24 May 2016 showing an image of a Model 638 LaserMax Revolver;
- A screenshot dated 4 June 2016 showing an image of a Plastic Handgun case;
- A screenshot dated 31 March 2016 displaying images of a number of knives described as “Special Tactical”, “Bullseye Search and Rescue”, “Black Ops” and “M&P” with prices displaced in USD;
- A screenshot dated 31 March 2016 showing an image of a SWAT knife;
- A screenshot dated 29 January 2017 showing an image of a Pistol;
- A screenshot dated 29 January 2017 showing multiple images of Pistols;
- A screenshot dated 26 January 2017 showing an image of a revolver;
- A screenshot dated 26 January 2017 showing multiple images of revolvers;
- A screenshot dated 15 September 2018 showing an image of a handgun for sale with its price displayed in USD;
- A screenshot dated 15 September 2018 showing an image of part of an M&P handgun;

- A screenshot dated 5 November 2018 showing a M&P handgun available for sale in USD;
- A screenshot dated 5 April 2018 showing an image of a Swat knife and descriptions of further items including Black Ops knife, Bullseye Search & Rescue knife, Special Tactical Knife, Black Handle knife and First Response emergency tool, all showing prices in USD;
- A screenshot dated 2 February 2019 showing a pistol;
- A screenshot dated 2 February 2019 showing images of multiple pistols;
- A screenshot dated 29 January 2019 showing an image of a revolver;
- A screenshot dated 29 January 2019 showing multiple images of revolvers;
- A screenshot dated 11 February 2019 showing an image of a revolver;
- A screenshot dated 9 May 2019 showing multiple images of gun cases for sale with prices in USD;
- A screenshot dated 9 May 2019 showing multiple images of 'M&P' knives with prices in USD;



13. On all the screenshots provided above the trade mark  is shown at what appears to be the top of each page and/or on the product itself. Where this is at the top of the page it is often accompanied by the wording SMITH AND WESSON.


14. Also included in this exhibit is seemingly undated promotional material displaying the above mark, referring to various handguns. In addition, this exhibit provides images of product catalogues and promotional material dated 2016, 2017, 2018 and 2019 showing images of various pistols, revolvers, knives and gun cases. The catalogue pages as well as many of the products themselves show the opponent's earlier mark. There does not appear to be an indication of the territory within which these were distributed on the material itself, but Mr Miele explains in his witness statement that this exhibit also represents a sample of the advertising material used in the EU.


15. Mr Miele provides annual sales figures for products sold into the EU as follows:


My Company's annual sales figures for products sold into the EU are the following:

- 2014: \$4,214,637USD
- 2015: \$7,846,619USD
- 2016: \$8,918,144USD
- 2017: \$8,711,715USD
- 2018: \$7,689,066USD
- 2019: \$4,396,590USD

16. Mr Miele goes on to breakdown the figures by category of product, identifying those products sold into the EU as follows:

8. My Company's sales figures in the EU relating to knives bearing the  mark from 23/08/2017 to 27/09/2019 are of \$254,783USD.

9. My Company's sales figures in the EU relating to gun cases bearing the  mark from 09/12/2016 to 27/09/2019 are of \$9,402USD.

10. My Company's sales figures in the EU relating to firearms bearing the  mark, namely, pistols and revolvers, from 20/05/2014 to 23/01/2019 are of \$22,933,530USD.

11. My Company's annual sales figures in the United Kingdom relating to firearms bearing the



mark and, including handguns, and firearm cases are the following:

- 2014: \$67,054USD
- 2015: \$121,593USD
  
- 2016: \$97,545USD
- 2017: \$152,703USD
- 2018: \$161,810USD

12. My Company's annual sales figures in the United Kingdom relating to knives bearing the



mark are the following:

- 2017: \$360USD
- 2018: \$490USD
- 2019: \$3,393USD

17. Mr Miele explains in his witness statement that the goods are sold in the EU via third party distributors. **Exhibit TM2** includes screenshots from what Mr Miele describes as third-party websites in the EU showing knives, firearms

and related items for sale under the earlier mark. These are shown via the web archiving website Wayback Machine, and details of these are as follows:

- Screenshots dated 2 July 2014 & 17 March 2015 from 'www.sportsgunman.co.uk' showing guns available using GBP. A larger image of one of the guns is provided displaying the earlier mark;
- Screenshots dated 28 June 2014, 4 April 2016, 22 August 2018 and 26 April 2019 from 'www.outdoorsmansupplies.co.uk' showing a pistol case displaying the earlier mark available for purchase in GBP;
- A screenshot dated 29 April 2014 from [www.surplusstore.co.uk](http://www.surplusstore.co.uk) displaying various knives including the Smith and Wesson Swat Lock knife displaying the earlier mark on the packaging;
- Screenshots dated 21 September 2015, 18 May 2016 and 14 April 2019 from [www.waffen-ferkinghoff.com](http://www.waffen-ferkinghoff.com) (labelled as "Germany distributor" on the exhibit). The first three screenshots show an image of a gun displaying the earlier mark and available for purchase in Euros. The mark is not clear on the screenshot dated 14 April 2019;
- Screenshots dated 17 June 2015, 22 February 2016 and 6 June 2017 from [www.hunters-knives.co.uk](http://www.hunters-knives.co.uk) showing various knives for sale under the earlier mark, with prices listed in GBP;
- Screenshots dated 3 August 2016 & 15 October 2017 from [www.fondrodukter.se](http://www.fondrodukter.se) (labelled on the exhibit as "Sweden Distributor") showing guns for sale under the earlier mark in a currency that is unclear from the exhibit;
- Screenshots dated 30 September 2017 from [www.kaliber.pl](http://www.kaliber.pl) showing a revolver for sale in the currency Polish Zloty under the earlier mark;
- Screenshots dated 26 November 2018 and 29 January 2019 from [www.borchers.es](http://www.borchers.es) (labelled "Spain Distributor" on the exhibit) showing a gun for sale in Euros. The mark is not clear on these images;
- A screenshot dated 16 July 2018 from [www.knifewarehouse.co.uk](http://www.knifewarehouse.co.uk) showing a frame lock knife under the earlier mark;
- A screenshot from [www.heinnie.com](http://www.heinnie.com) (labelled on the exhibit as "UK distributor") showing images of knives for sale in GBP displaying the earlier mark.



18. Also under this exhibit is a screenshot from [www.smith-wesson.com](http://www.smith-wesson.com) dated 19 March 2020 showing a list of “Europe” distributors including those in Austria, Belgium, Bosnia and Herzegovina, Bulgaria, Czech Republic, Denmark, Finland, France, Georgia, Germany, Greece, Ireland, Israel, Italy, Malta, Netherlands, Norway, Poland, Portugal, Slovakia, Slovenia, Spain, Sweden, Switzerland, United Kingdom.

19. **Exhibit TM3** includes various invoices. The first set appear to have been issued by the party Battenfeld Technology Inc. The mark is not shown on the invoices, which have been issued under a plain header. All billing and invoicing details have been redacted from the invoices other than reference to the country itself. The invoices date from 2017 – 2019 and show billing and invoicing addresses in Spain, France, Germany, UK, Austria, Czech Republic, Estonia, Romania, Sweden, Poland. A couple of the invoices have a shipping address located in the US whilst the billing address remains in one of the territories listed, however on most invoices the billing country corresponds with the shipping country.

20. The second set of invoices are marked as Commercial Invoices and show the banner below at the top of the same:



21. Again, the recipient details on the above invoices are redacted other than the country. These invoices date between 2014 – 2019 and the invoice and delivery addresses are located in the UK, France, Germany, Italy and Spain.

22. Within the invoices, a number of different codes have been highlighted. These match various product codes as shown within catalogue pages also provided under this exhibit. A helpful index has been provided relating to the product


codes as featured on the invoices, indicating where the codes match to products in the catalogue pages. These codes match to goods including various knives, guns and gun cases either displaying or sold under the earlier mark.

23. **Exhibit TM4** provides screenshots from the web archiving site WayBack Machine showing dated screenshots of the opponent's social media pages. The first screenshot shows the opponent's YouTube page on 16 April 2019. The page shows the earlier mark, images of handguns and the number 43,437 next to "subscribe". Mr Miele references this as the number of followers of the YouTube Channel within his witness statement.
24. The second screenshot provided is from 19 May 2019 and shows the opponent's Facebook page. The earlier mark is not shown on the page. It may feature on the image of the gun shown but it is small and difficult to see. There is reference to 1,423,388 people 'liking' the page, and 1,400,081 people 'following' the page. A second screenshot from 27 May 2020 is shown featuring the earlier mark and an increased number of likes and followers (1,440,669 & 1,425,779).
25. A screenshot from the opponent's twitter page is provided dated by the WayBack Machine dated 3 January 2019. The earlier mark is clearly shown, as are various images of guns. The page shows the opponent has 257k followers and that they have published 2,710 tweets. A further screenshot dated 25 May 2020 is provided showing the earlier mark, images of guns and an increased following at 293.7k.
26. A screenshot of the opponent's Instagram page dated by the WayBack Machine on 19 May 2019 has been provided, showing the earlier mark and that the page has 951k followers. The content of the Instagram page is not shown at that date. A second screenshot of the page is shown dated 25 May 2020 showing the earlier mark, a rise in followers to 1million, and images of handguns.

27. Mr Miele explains in his witness statement that **Exhibit TM5** includes invoices for products that are shipped out to trade shows and exhibitions in the EU, which the opponent attends to promote its products. Several of the invoices entitled 'commercial invoice' and show a consignee address in Germany. Invoices referencing the IWA outdoor are dated 10 February 14, 5 Feb 2015, 20 January 2016, 11 Feb 2016, 9 Feb 2017, 22 February 2018. The later four invoices specify that 'IWA Outdoor' is the name of the Exhibit. There are a further two documents called 'Commercial invoice/packing list' from 21 October 2015 and 9 November 2017 mentioning 'Milipol Paris' relating to France, and a further 'Commercial invoice/packing list' mentioning 'Defense Systems & Equipment Int'l – DESI 2019' with an address of the ExCel Convention & Exhibition Centre. The invoices relating to Germany state that all of the items will either be returned to the US after the show or given away for free during the show. Mr Miele confirms the shows are promoting products sold under the earlier mark has provided a breakdown of the value of the goods sent to the shows each year as follows:

18. My Company has attended various shows and exhibitions in the EU to promote its products



sold under the  mark. Shown to me and attached herewith as **Exhibit TM5** is a sample of invoices for products that were shipped out to the shows. The total value of the goods shipped by My Company for these shows is as follows:

- IWA OutdoorClassics International trade fair in Germany
  - 2014: \$55,722USD
  - 2015: \$59,118USD
  - 2016: \$72,788USD
  - 2017: \$69,911USD
  - 2018: \$41,799USD
  - 2019: \$59,777USD
- Milipol Paris in France
  - 2015: \$8,609USD
  - 2017: \$19,716USD
- Defence and Security Equipment International (DSEI) in the UK
  - 2015: \$20,742USD

## Proof of use

### 28. Relevant statutory provision: Section 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 relevant period .

(1A) In this section “the relevant period” means the period of 5 years ending  
with the date of the application for registration mentioned in subsection (1)(a)  
or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

29. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

30. In this instance it is for the opponent to show that genuine use of the mark has been in the relevant territory, namely the EU, in respect of the goods relied upon within this opposition, and during the relevant period, namely the five

years prior to the date on which the application was filed, that being 21 May 2014 – 20 May 2019.

### **Form of the mark**

31. The applicant has provided submissions relating to the opponent's proof of use, including submissions relating to how the mark is used. The applicant submits as follows:

“To the extent that the Opponent has provided evidence of use of the Earlier Mark in the relevant period in the UK/European Union in relation to knives, the Earlier Mark is not used as a mark in its own right, but rather in combination with the trading name, Smith & Wesson and the knives shown are an extension of the Opponent's business in firearms - the knives are all tactical/hunting/security/survival knives. They are certainly not knives for domestic use of the sort that you would find in a cutlery drawer or in the kitchen for food preparation/serving purposes.”

32. At this stage I will simply address the applicant's comments regarding the form of the mark, namely the use of the earlier mark in combination with the opponent's “trading name”, namely Smith and Wesson.

33. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”)<sup>2</sup> found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the

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<sup>2</sup> Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”.

34. I note firstly that it is not always the case that the opponent's earlier mark is used in conjunction with its trading name. However, even where this is the case, for example in the manner shown at the top of several of the invoices provided (as shown in the evidence summary), or on the top of the website as



, it is my view the earlier mark maintains its independent ability to indicate the economic origin of the goods to the consumer. I therefore find that where the mark has been used alongside the trading name, this use may still be considered use of the mark as registered for the purposes of my assessment.

35. I note that there is also use of the sign in various colourways, such as that above, or in bright or navy blue. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

36. The earlier mark has been registered in black and white, and I find the distinctive character in the earlier mark to be held in the logo itself, and not in the use of black and white in the same. I find the use of the earlier mark in



alternative colours does not alter the distinctive character of the mark<sup>3</sup>, and that the mark shown in varying colours is acceptable use in line with *Nirvana*.

## Use of the mark

37. As mentioned previously, the relevant timeframe within which the opponent must show use of the mark for the goods as registered is the five years up to the date on which the application was filed, namely 21 May 2014 – 20 May 2019.
38. The applicant has made several criticisms of the proof of use that has been provided by the opponent. The applicant claims firstly that the opponent's Exhibit TM1 shows use of the mark in a combined format. However, as I have addressed above, I find this to be acceptable use of the mark in this instance. The applicant also states that the use as shown relates primarily to the US. I agree with the applicant on this point, and I note that the website provides the price of the goods in US Dollars, and the contents of this exhibit does not appear to indicate the use of the mark within the relevant territory, namely that of the EU. However, I do find the exhibit shows use of the earlier mark in the relevant time period in respect of various types of knives including those which I find would be classed as pocket knives as the applicant has mentioned, as well as various knives that appear to be for protection and survival. In addition, it shows use of the mark in the relevant time period in respect of gun cases, and various handguns including revolvers and pistols. Whilst I find that alone, this exhibit is incapable of showing use within the territory, I will keep in mind its contribution to the picture that the sum of the evidence creates.
39. In respect of the evidence provided at Exhibit TM2, I note that many of the screenshots are from .co.uk websites and show use of the mark in respect of items for sale in GBP. Both of these factors indicate to me that the use is

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<sup>3</sup> See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47 confirming that registration of a trade mark in black and white covers use of the mark in colour.

intended for a UK audience, and I note that reference to these sites being a “UK Distributor” is made at the top of the exhibits. These pages are dated throughout the relevant timeframe, with the exception of the screenshot dated 29 April 2014 from [www.surplusstore.co.uk](http://www.surplusstore.co.uk) which predates this. The pages from the UK sites show knives, handguns and handgun cases for sale under the mark within the relevant timeframe.

40. Additional pages from .se and .pl sites are also provided, the first of which shows handguns for sale and is labelled as ‘Sweden Distributor’ and the latter of which shows showing a revolver for sale in the currency Polish Zloty and is labelled ‘Poland distributor’. These fall within the relevant timeframe and show that handguns were available for purchase under the relevant mark during the timeframe in these territories. Pages where some elements are less clear include [www.waffen-ferkinghoff.com](http://www.waffen-ferkinghoff.com) where although the pages are labelled ‘German Distributor’ and has prices shown in Euros does not explicitly relate to commercial activity in Germany. However, the price in Euros indicates the use is likely within the EU, and I have no reason to disbelieve the reference to Germany. The .es domain, although it appears intended for a Spanish audience, does not make clear use of the earlier mark and so it adds little to the picture of the evidence.

41. In addition to the evidence showing knives, handguns and gun cases available for sale via various EU distributors websites within the relevant timeframe under the mark, the invoices that have been provided by the opponent at Exhibit TM3 clearly show sales were made to parties within various territories around the EU<sup>4</sup>, including in Spain, France, Germany, UK, Austria, Czech Republic, Estonia, Romania, Sweden and Poland in the first set of invoices. I have noted that the details of the customers themselves have been redacted, and so I turn to the rest of the evidence for support that the use is likely external. The earlier mark is not displayed on this first set of invoices. The second set of commercial invoices are dated between 2014 – 2019 and are addressed to the UK, France, Germany, Italy and Spain, and

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<sup>4</sup> Or in the case of the UK, that were within the EU at the time the invoice was issued

show use of the earlier mark at the top of the same. Both sets match to items in the catalogues provided either sold under the earlier mark or bearing the earlier mark, including handguns, knives and gun cases. I note the first set of invoices were issued by Battenfeld Technology Inc rather than the opponent, but Mr Miele has explained that this was formerly the name of the opponent's sister company, and so it is my view that the use of the mark under this company is use with the consent of the opponent. I find the invoices combined with the catalogue provided by the opponent show sales of knives, handguns, pistols and gun cases under the mark within the relevant timeframe within the EU.

### **Genuine use**

42. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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].”

43. From the evidence above, I find it is clear the opponent has used the mark as registered (or an acceptable variant) within the relevant territory, within the relevant time frame and in respect of the most of the goods relied upon. Particularly I have found use in respect all of the class 13 goods, as well as pocket knives and knives within class 8. It is my view that the term “cutlery” relates to utensils for the serving and eating of food, and although I have found use of various knives by the opponent, it is my view that these do not fall within the meaning of “cutlery”. I therefore find there is no use, and as such no genuine use of “cutlery” by the opponent.
44. Before I move on to consider if I find the rest of the use made by the opponent to be genuine use for the purpose of enforcing its specification within this opposition, I find this an appropriate time to briefly consider the particular wording of the opponent’s specification.
45. Firstly, I have noted use of *Pocket knives* by the opponent. However, the opponent’s specification covers *Pocket knives - collector limited edition*. The language chosen appears to indicate that the protection for pocket knives is limited to those which are collector limited edition. It is difficult to establish from the evidence shown whether the pocket knives shown are “collector limited edition” as described, although I do note the opponent lists various knives under the “gifts and collectable” section of its website. However, I appreciate that evidencing that these items are “collector limited edition” will likely be more of a challenge than simply evidencing that they are pocket-knives bearing the mark, which as has been established in the case law should not be a burdensome task for the opponent. I find this particularly true as the idea that something is “collector limited edition” is, in my mind, often more of a subjective marketing concept than a tangible fact, and that to be “limited” or “collectable” seems to me entirely dependent on the context (a ‘limited’ run of an item may extend to 10 or 100,000 for example, dependent on the usual levels of production). However, for reasons that will become apparent below, I also find this is a point on which it is unnecessary for me to dwell to heavily, and so I simply note at this point that I find use of the opponent’s mark in respect of pocket-knives.

46. The second aspect of the specification that I wish to consider is the two possible interpretations of “knives, cutlery”. It is clearly the opponent’s submission that “knives” within the specification is a standalone term. I have considered that it is normal professional practice to separate individual terms with a semi-colon when drafting a specification of goods. However, I do not find that the use of a comma in this instance prevents the term “knives” from being viewed as a standalone term within the specification (as opposed to being limited to knives as cutlery), and for this reason I will continue on the basis that the opponent has registered coverage for “knives”, in addition to cutlery.

47. As set out in the case law above, for use of the earlier EU trade mark to be considered genuine, it is established that it must not be token use for sole purpose of maintaining rights in the territory. I also must remember that not every case of real commercial use will be sufficient to show that use is genuine, as the use must be warranted for the purpose of maintaining a market share in its particular sector.

48. Whether the use shown is sufficient for this purpose will depend on whether the opponent has shown there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant 5 year period. In making this assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods and the market(s) for them
- iv) The geographical extent of the use shown

49. It is clear from the evidence provided, as detailed in the evidence summary, that the scale of the use in respect of the opponent’s *Firearms, namely handguns and pistols* is significant. Over 22 million USD was given as the

sales figures for these items in the EU between 2014 – 2019, and I find it safe to assume at least a significant portion of these sales will be during the relevant time period, despite some of the period given falling outside of the same. The nature of the use is clearly in an acceptable format as a trade mark for the goods. In terms of the geographical extent of the use of the mark for these goods, I find it clear from the evidence, including the comments made in the witness statement of Mr Miele, the images of various EU websites offering the opponent's goods, and the invoices presented at Exhibit TM3 showing sales to a number of EU territories (although these have been heavily redacted), that these goods have at least been sold in at least several major territories in the EU. Whilst I am unaware of the size of the firearms market across the EU, and I do not find it appropriate to guess at its extent, from the figures provided in Mr Miele's witness statement it seems clear to me that the opponent's use is at least maintaining a genuine market share of this market in the EU. Considering the evidence as a whole, I find genuine use in respect of these goods is shown from the sum of the opponent's evidence.

50. On the other hand, I note the figures provided in respect of the *gun cases* sold in the EU by the opponent are considerably more limited. A figure of \$9,402USD has been given within the witness statement of Mr Miele, spanning between 9 December 2016 – 27 September 2019, of which several months fall outside of the relevant period. I find the figures provided to be of such a low volume that it is very possible that a large percentage of these sales may fall outside of the relevant timeframe. I note from the evidence provided, particularly Exhibit TM1, that approximate sale price of the gun cases offered by the opponent may range from between \$11 and \$61. I note also from the invoices that sometimes these units may be priced lower, with one invoice issued to Spain dated 13 March 2018 showing unit prices of \$6.04. However, without further evidence on the contrary I find on the basis of the sales figures provided in respect of the firearms market, that the market for gun cases in EU cannot be so niche that these sales are significant, even considering the low unit prices. Even if I am to give the opponent the benefit of the doubt and assume all the sales referenced were made within the relevant timeframe, and that there has been a higher number of the low value



cases sold in the EU, I find this to be only several hundred sold in total (confined to a two and a half year period) during the relevant five year timeframe. Although I acknowledge there is no threshold which the opponent is required to meet, it is my view that this use is insufficient for maintaining a genuine market share over a five year period throughout the EU territory. I do not suggest that the use in respect of gun cases is token, as it appears entirely consistent with the opponent's wider business, but rather that it is trivial, having failed to establish real commercial exploitation of the mark for these goods in the EU, with reference to the picture that the sum of the evidence creates as a whole.

51. In respect of use shown of the mark in relating to knives, the total sales into the EU was given by Mr Miele as \$254,738USD between 23 August 2017 – 27 September 2019. Again, roughly four months of this period fall outside of the relevant timeframe, but I find in this instance it is safe to assume that on balance, particularly with consideration of the additional evidence including invoices, and images of the goods for sale by UK distributors within the timeframe, it is likely that at least a significant portion of these sales fall within the relevant timeframe. It is my view that the use of the mark in relation to knives is clearly use as a trade mark to designate the commercial origin of the goods. It is also clear from the sum of the evidence provided that a portion of the sale of knives by the opponent into the EU will relate to pocket knives (which I find will relate to relatively small knives often which fold away and may be safely and comfortably stowed within a pocket), as well as what are described as “tactical knives”, “search and rescue” knives and “extreme ops” knives.

52. Again, I am unaware of the size of the market for these types of knives in the EU, and I am unable to speculate if this will be larger or smaller than the market for firearms. However, I find it likely that it is at least a reasonable size across the territory, and in the absence of further evidence on this point I find the proportion of market share the opponent held for these goods within the EU and within the relevant time frame is undoubtedly small. I note also that the sale of goods within the market are limited to roughly a 21 month period

during the latter part of the relevant timeframe. The evidence in TM2 is limited, only showing knives on the pages of UK distributors. However, the invoices provided within at Exhibit TM3 shows that knives have been sold (and the sales billed) to other territories across the EU in addition to the UK, including in Czech Republic, Austria, Poland, Spain, Estonia, Romania and Sweden. Considering all of these factors, it is my view that on balance, the sum of the evidence shows there has been real commercial exploitation of the mark within the EU in respect of knives and pocket knives, for the purpose of creating a market share, and I therefore find genuine use has been made of the mark in respect of the same.

### **Fair specification**

53. I must now consider the extent to which I find the opponent's use justifies the enforcement of the earlier mark within these opposition proceedings in relation to the goods covered by the registration.

54. Within its written submissions, the applicant submits:

“...the Opponent cannot rely on “knives” in the broadest sense since it has not proven use on a wide range of knives. The knives illustrated in the evidence of Tony Miele on behalf of the Opponent are all survival/hunting knives. Even if the Opponent has proven use of the Earlier Mark for these goods in the UK/European Union, and we submit that it has not for the reasons provided above, in particular at paragraph 12, we contend that the Opponent cannot rely on such use to maintain its reliance on the broad term “knives” covered by the Earlier Mark and the Opposition basis should be restricted as shown at paragraph 19 above.”

55. Instead, the applicant has proposed that if the opponent has shown proof of use, this should be limited in class 8 to *survival knives, hunting knives*. The applicant has not made submissions that the opponent's class 13 goods should be limited further if genuine use is shown.

56. 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.”

57. 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."

58. Considering the above, it is my view that one set of goods for which I have found use of the opponent's mark would be fairly described by the consumer as handguns. I note it is possible to break "handguns" down further, but I find it unlikely the average consumer would do so. As allowing the opponent protection for "handguns" covers protection for "pistols" I find it appropriate in this case to allow the opponent to enforce its protection in class 13 in respect of the following goods:

*Class 13: Firearms, namely handguns and pistols*

59. In respect of the class 8 goods, I acknowledge that the opponent has not shown use of every type of knife possible, and that instead they have shown

use in respect of a range of small knives, tactical knives and foldable pocket knives in the field of security, protection, survival, hunting, and search and rescue. Whilst I find that for something to be a knife it is already subject to a fairly specific set of criteria, I do also acknowledge that the applications of knives vary, and the design accordingly. I note that on this basis, that the category of knives may be broken down further by application, as is suggested by the applicant. However, with consideration to the case law as set out above, I find it would be inappropriate to narrow the opponent's specification to only the particular types of knives that have been shown. I believe that the consumer would fairly describe the goods offered by the opponent in class 8 as "knives", and that knives in general all belong to the same category of goods. I do not find the consumer would narrow these further when giving a fair description down to *survival knives*, *hunting knives* as suggested by the applicant. I therefore find the opponent may enforce the following class 8 goods within the opposition:

Class 8: *Knives, including pocket knives.*

## **DECISION**

### **Section 5(2)(b)**

60. 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".

### **Section 5A**

61. Section 5A of the Act is as follows:

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

## **The principles**

62. The following principles are gleaned from the decisions of the CJEU 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**

### **Similarity of goods and services – Nice Classification**

63. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

64. In the judgment of the 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”.



65. In addition, it was established by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, that the following additional criteria are also relevant for an assessment of similarity of goods and services:

- (a) The respective users of the respective goods or services;
- (b) The respective trade channels through which the goods or services reach the market;
- (c) 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;

66. The case law provides further guidance on how the wording of goods and services as registered and filed should be interpreted within the comparison. 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."

67. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

*“...the applicable principles of interpretation are as follows:*

- (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*
- (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*
- (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*
- (4) A term which cannot be interpreted is to be disregarded.”*

68. With these factors in mind, the goods and services for comparison are below:

Class 8: <i>Knives, including pocket knives.</i> Class 13: <i>Firearms, namely handguns and pistols</i>	Class 8: <i>Hand tools and implements, hand-operated not being knives; cutlery; knives, namely chef knives, kitchen knives, cooking knives, carving knives, cheese knives; razors; parts and fittings for all the aforesaid goods.</i>
<b>Opponent's goods</b>	<b>Applicant's goods</b>

69. The opponent has provided me with decisions issued by the EU Intellectual Property Office (EU IPO) Opposition Board, as well as decisions from the EU IPO Board of Appeal and Third Board of Appeal. The decisions have been filed in support of a finding of similarity of various goods either included within these proceedings, or with which a comparison has been drawn. Whilst I have reviewed and considered the decisions filed, I am not bound by the findings of the EU IPO Opposition Board, and my own conclusions on the similarity of the goods in the current proceedings have been drawn below.

**cutlery; knives, namely chef knives, kitchen knives, cooking knives, carving knives, cheese knives; parts and fittings for all the aforesaid goods.**

70. I find that “knives” within the opponent’s specification either includes, or is included within all of the applicant’s goods as listed above, except for the parts and fittings. I therefore find these goods to be identical: see *Gérard Meric v OHIM*, Case T-133/05. In respect of the parts and fittings of the goods, I find these may possibly include fresh blades, handles or grips that may be swapped out in the goods. I find these will be complimentary to the opponent’s *knives* in the sense that the knives are likely indispensable to the parts and fittings for the same. In addition, I find that where these goods are sold directly to the public, the consumer will be likely to believe that the goods stem from the same economic undertaking, and they will share trade

channels. I find *parts and fittings* for knives to be similar to knives to a high degree.

**Hand tools and implements, hand-operated not being knives; parts and fittings for all the aforesaid goods.**

71. It is my view that the above goods filed by the applicant includes a broad range of hand tools and implements covering those in many fields. These will include those for use in food preparation such as tools for grating or slicing, or can openers and pizza cutters, without being knives themselves. This may also include tools such as files, chisels and saws in the field of woodwork, and as the opponent has suggested, it may also include general household items such as scissors. I find all of these tools have a broadly similar intended purpose to knives (some closer than others), for severing or cutting, or for reducing the size or amending the shape of an object. In some cases, the specific intended purpose will also overlap, such as for dividing up food items into smaller pieces. I also find the nature of items such as scissors and graters and saws to be similar to knives. Further, these items are likely to share the same trade channels as knives and in some instances, where these are items within the same field, they will be placed, if not on the same shelves, then near to each other within retail establishments. For example, kitchen knives will be near food graters, and knives for whittling will likely be near small saws for woodwork. Whilst it is possible that there may be competition between knives and some items covered by this broad term, I find this less plausible, and I find it unlikely they will be complimentary. However, overall, I find the applicant's goods *Hand tools and implements, hand-operated not being knives* to be similar to the opponent's "knives" to a high degree.

72. Despite the limitation of *not being knives* in respect of the applicant's *hand tools and implements* above, I find that the parts and fittings for this broad category may include items such as interchangeable blades and saws. In my view the items covered by this category may be similar in nature and intended

purpose to the opponent's knives, and they may share trade channels, but there will be no complementarity or competition with the opponent's goods. Overall, I find parts and fittings for the applicant's goods above to be similar to the opponent's *knives* to a medium degree.

**Razors; parts and fittings for all the aforesaid goods.**

73. I find the nature of razors to be at least highly similar to the nature of knives, on the basis that they both include a sharp blade made of metal. Types of razor, for example those often used by barbers, will, like a knife and particularly like a pocket or foldable knife, be attached a handle into which the blade may fold for safety. Further, I find the broader intended purpose of razors to be highly similar or identical to knives, namely for cutting and slicing, although in my view the specific purpose of cutting hair will generally be completed only by a razor (or scissors) and not by a knife. Due to the highly similar nature of these goods I find it likely they will share trade channels. On occasion these items may be in competition with each other, due to the shared purpose of cutting, but I find more often that a razor will be purchased for a specific task and a knife for another, rather than either or. I do not find knives and razors to be complementary. However, over all I find *razors* to be similar to *knives* to a high degree. In addition, in respect of parts and fittings for razors, which in my view includes interchangeable blades, I find the cross over in nature and trade channels means they are similar to the opponent's knives to a medium degree.

**Comparison of marks**

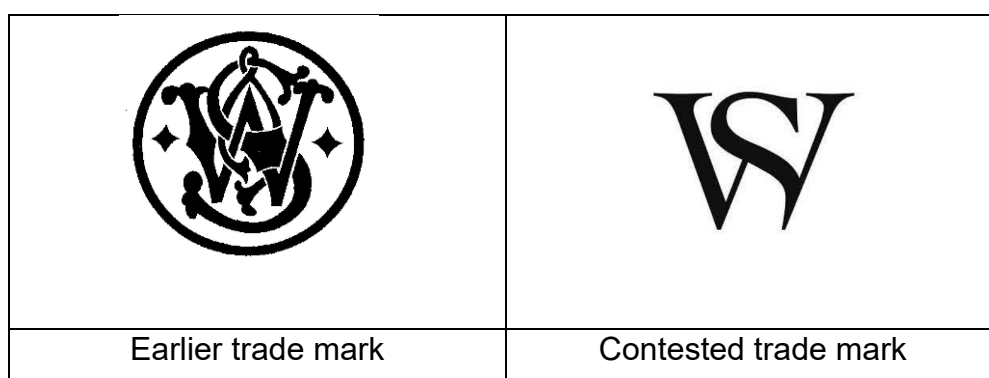
74. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference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

European Union 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.”

75. 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.

76. The respective trade marks are shown below:



77. The earlier mark consists of a highly stylised overlapping S and W within a circle, with two almost diamond shapes either side of the SW (or WS). The S and W appears to be tangled with another element that is difficult to distinguish, and appears to simply be additional stylisation seemingly hanging from the S. It is only from reading the parties submissions that I know this is an ampersand, and I do not believe this would be viewed as such by the consumer. The applicant has submitted that there is an anchor like element to the earlier mark which make the letters barely discernible, but whilst I find it

the earlier mark may allude to an anchor to a very small number consumers, to most I find the SW will simply look like it is in a highly stylised font, and I find to all consumers, or at least the vast majority, the SW will remain obvious within the mark itself. I find the overlapping stylised letters SW to be the most dominant and distinctive element of the mark itself. I find the circle and diamond shapes to be of little distinctiveness individually, but I still find they add to the overall impression of the mark on the consumer.

78. In respect of the later mark, I find this is also discernible as an overlapping SW or WS. Although it may take a little work from the consumer to make out the W, it is my view that consumers will look for recognisable elements within a mark, and that as such this will be recognised as SW (or WS). I find there is no element of the later mark that is more dominant or distinctive than another element, and that the overall impression of the mark is held in its entirety.

### **Visual comparison**

79. Visually, the marks both include the overlapping letters SW (or WS) in a similar layout. The marks appear to be the same length, with the middle elements a similar shape, although the earlier mark is far more heavily stylised, and its additional elements including the circle and diamond shapes detract from some of the visual similarity shared. Overall, I find the marks to be visually similar to between a low to medium degree.

### **Aural comparison**

80. The applicant submits that as the SW is barely discernible within the earlier mark, it will be verbalised as “Smith and Wesson” or “the Smith and Wesson logo”. I disagree entirely. I find that the SW or WS can be made out within the mark, particularly as consumers will naturally look for pronounceable elements within the same, and there is nothing in the mark itself that will make the consumer pronounce this “Smith and Wesson”.

81. The elements that may be verbalised in the earlier mark are both SW or WS. I find these may be verbalised in either order in respect of both marks. Where these are verbalised in the same order, I find that the marks will be verbally identical. I acknowledge there may be the possibility that the marks will be pronounced by the consumer as SW for the first mark and WS for the second (or vice versa), but I see no logical reason the consumer would choose one order in the first mark and the opposite in the second. Instead it is my view that the consumer would likely choose the identical pronunciation in respect of each mark, but I acknowledge the lower aural similarity between the marks on the occasion that this is not the case.

### **Conceptual comparison**

82. The applicant submits the marks have no meaning in isolation, and when used in combination with trading names they simply denote the names. The applicant submits on this basis that I cannot consider the marks conceptually similar. On the contrary, the opponent submits the marks are conceptually identical as they comprise of the same letter combination SW.

83. I find the letters SW (or WS) will have no particular meaning to the consumer, and although they may assume this is an acronym, there is no indication from either mark what it will stand for. As such, I find neither mark it will create a particular concept in the mind of the consumer. I therefore find the marks to be conceptually neutral. I acknowledge the reference to an anchor like appearance of the earlier mark, but in my view there will not be a significant enough portion of consumers to whom the earlier mark will convey the concept of an anchor to consider this within the conceptual comparison.

### **Average consumer and the purchasing act**

84. 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.

85. 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.”

86. Before deciding on the likelihood of confusion, I must first identify the relevant consumer of the goods.

87. The average consumer of the applicant’s goods will comprise, at least partially, of members of the general public. I found that *Hand tools and implements, hand-operated not being knives* is broad, and will cover a wide range of goods. However, I find it is likely there will be some consideration of the practicality and suitability of all the items covered by this term, although some items will receive more consideration than others. I find that the level of attention is likely to range from slightly below average for the everyday lower value items that may be replaced more frequently, to slightly above average in respect of the items bought less often and to last. I find this also to be true in respect of the parts and fittings of these goods, but that generally at least an average degree of attention will be paid to ensure these are a suitable match for the item already owned or being purchased separately. It is also true that the parts and fittings may be sold directly to the companies producing the

goods, in which case the consumers will be professionals paying an above average degree of attention.

88. In respect of the applicant's *cutlery; knives, namely chef knives, kitchen knives, cooking knives, carving knives, cheese knives; razors; parts and fittings for all the aforesaid goods*, I also find the general public will consider the aesthetics, style, practicality and suitability of these items. However, I find that the level of attention will range from below average for items such as disposable razors, to average in respect of the knives and cutlery. I also find the opponent's goods in class 8 will receive at least an average degree of attention from the consumer. I note all of these goods may also be purchased by professional consumers, in which case I find the level of attention paid will be raised to between slightly above average to high, due to the extra responsibility, liability and importance of the purchase. For example, professionals purchasing knives for search and rescue teams or other dangerous situations will be likely to take a higher level of care to ensure those purchased will be up for the task. In addition, the purchase of chef's knives by professional chefs will likely require more care and attention than the purchase of kitchen knives by the average consumer that requires these for everyday cooking.

89. I find all the goods will most likely be purchased following visual inspection, either online or in retail establishments. However, I note that verbal recommendations and assistance may be sought from retail staff, particularly (but not exclusively) in respect of the more specialist types of knives, razors or hand tools and their parts and fittings. It may also be that some of these items will be locked away in a retail setting and will therefore require the verbal assistance of retail staff to make a purchase, although these will likely still be visible prior to purchase. I will therefore not disregard the aural comparison.

### **Distinctive character of the earlier trade mark**

90. 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).”

91. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

92. Although I consider the letter combination SW (or WS) to be neither allusive or descriptive of the goods themselves, I find the use of a two letter combination to be very common and generally inherently weak, when compared with longer marks<sup>5</sup>. However, I recognise that another common feature of both these marks is that they do not just contain the letters SW, but the letter S overlapped and intertwined with the letter W. In my view, whilst the letters SW will be viewed as no more than the most basic of acronyms, allowing for only a low level of inherent distinctiveness, the layering of these letters raises the inherent distinctiveness of the SW element in the earlier mark, although this remains in my view at a below average level. The overall stylisation of the earlier mark, which is not present in the later mark, raises its inherent distinctiveness at best to an average degree.

93. The opponent has claimed that due to the use made of its mark, the distinctiveness of the earlier mark has been enhanced. I have considered this submission, and whilst I note that the opponent has filed evidence of use in the EU, which appears at least in respect of its class 13 goods to be fairly significant, the evidence relating to the UK market is minimal. Where evidence relating specifically to the UK has been filed, the sales figures are relatively modest. Further, there is no evidence showing how these figures interact with the UK market for the goods. Although the opponent appears to have a reasonable social media presence, it is not clear whether those following the opponent are based in the UK or elsewhere. No information has been

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<sup>5</sup> See paragraphs 29-30 in the decision of the Appointed Person Mr Iain Purvis QC in BL O-085-14 *KARTELL UK LIMITED v KUNZE FOLIEN GMBH*, in which Mr Iain Purvis QC reiterated the findings of the Fourth Board of Appeal of OHIM in the case of *Alfa-Beta Vissilopoulos AE v Agro de Bazan* Case R 82/2011-4 stating that letter combinations of two or three letters are inherently weak due to the frequency of encounters, and the great number of meanings attributed to acronyms and letter combinations, by the consumer.

provided by the opponent in respect of marketing expenditure particularly in relation to the UK, and there is little indication that there has been any press surrounding the SW mark and the goods sold under it in the UK, although I note the opponent's presence at a UK trade show. Overall, it is my view that the evidence provided by the opponent is insufficient to show that distinctiveness of the mark has been increased to an above average level in respect of the UK consumer.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

94. Prior to reaching a decision on this matter, I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 62 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that a likelihood of confusion may be increased where the earlier mark holds a high degree of distinctive character, either inherently, or due to the use made of the same, and that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks. I must also consider that both the degree of attention paid by the consumer and how the goods or services are obtained will have a bearing on how likely the consumer is to be confused.

95. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. Direct occurs where the consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the consumer notices the differences between the marks, but due to the similarities between the common elements,

they believe that both products derive from the same or economically linked undertakings<sup>6</sup>.

96. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), 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.

97. I found the marks to be visually similar to a between a low to medium degree, and aurally identical. I found the conceptual position to be neutral. I found that the opponent had proven genuine use for the goods *Knives, including pocket knives* in class 8, and *Firearms, namely handguns and pistols* in class 13. I found the applicant's class 8 goods to range from identical to similar to a medium degree to the opponent's class 8 goods. I found the earlier mark to be inherently distinctive to an average degree, but that the elements common in both marks, namely the overlapping SW (or WS) were inherently distinctive to a below average degree. I disagreed with the opponent's submission that the distinctiveness of the mark had been enhanced through use. I found the consumer will consist of both the general public and professionals, with the general public paying between a below average and slightly above average level of attention to the goods. I find that the professional public will likely pay a higher level of attention, ranging from above average to high. I found that the purchasing process for the goods will be predominantly visual, but that aural considerations should not be disregarded.

98. In respect of direct confusion, I have considered carefully the factors set out above, including that the marks are aurally identical, and that the goods are also often identical. I consider that verbal elements may play a part in the purchasing process of these goods, and I have considered if I find direct confusion likely on this basis. However, it is my view that although verbal

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<sup>6</sup> L.A. *Sugar Limited v Back Beat Inc*, BL O/375/10,

assistance may be sought in respect of a number of the goods, I find it very unlikely that the goods would be purchased without the consumer firstly also visually inspecting the same. I find the occasions on which this may occur to be so few and far between that they do not warrant a finding of direct confusion on this basis, and it is my view that a finding on this basis alone would be wrongly ignore the visual differences between the marks<sup>7</sup>. I have considered also that in some instances the level of attention paid by the consumer may fall below average. However, it is my view that despite this, the differences in the overall visual impression of the marks would not go unnoticed by the consumer. Even considering the consumers imperfect recollection, I find the visual impression created by the addition of the circle and diamond shapes, and the particularly the heavy stylisation of the letters in the earlier mark would not be forgotten. Overall, I do not find a likelihood of direct confusion between the marks.

99. In respect of indirect confusion, I consider the common elements between the marks, namely the overlapping letters SW (or WS). I have found a below average level of distinctiveness held in respect of these overlapping letters. However, I also found this element to be the most dominant element of the earlier mark, and that it makes up the entirety of the later mark. I note the differences between the stylisation of the two sets of SW in this instance. I also note the referenced addition of the ampersand in the earlier mark, but I found this will be unrecognisable to most consumers. As mentioned above, it is my view that the considerably higher level of stylisation in the first mark would not go unnoticed by the consumer. I therefore consider whether I find that the consumer, recalling the overlapping SW in the earlier mark, may find the existence of an overlapping SW without its diamonds, surrounding circle and high level of stylisation to be an indication that the highly similar and identical goods come from the same economic undertaking as the applicant's mark.

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<sup>7</sup> See the comments of Mr Iain Purvis QC sitting as the Appointed Person *The Royal Academy Of Arts V Errea Sport S.P.A.* BL O-010-16, in which he states that to a finding of aural identity alone should not be determinative of finding a likelihood of confusion without a global assessment considering the visual and conceptual elements.

100. As mentioned, I find the circle and diamonds including within the earlier mark to be of very little distinctiveness, and it is my view that surrounding a trade mark with a circle on some occasions and not on others is fairly common. I find neither of these elements themselves will do much to persuade or dissuade the consumer that the origin of the marks is shared.

101. I consider that the existence of the same two letters, even within two two-letter marks will not determine a finding of likelihood of confusion between the same, simply on the basis that the subject of those marks is the same<sup>8</sup>. However, I note at this stage that I am not simply considering two marks with alternatively stylised lettering, but instead alternatively stylised, but similarly overlapped lettering. I also consider that I found the overlapping nature of the letters to raise the distinctiveness of this common element slightly in the earlier mark, although it remained below average. With these considerations in mind, there is no doubt in my mind that for some consumers, when coming across the later mark in respect of identical and highly similar goods, the earlier mark will be brought to mind, and vice versa. However, after careful consideration of all of the factors above, it is my view that this will not go as far as to cause confusion that the goods derive from the same economic undertaking, due primarily to the significant visual differences in the stylisation and the below average level of distinctiveness of the common elements. I find on this basis, that if the shared elements of the marks are noticed by the consumer, they will be put down to coincidence, even with consideration of the identity of the goods and in some cases, below average level of attention of the consumer. I therefore find no likelihood of indirect confusion between the marks.

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<sup>8</sup> See paragraphs 10-13 containing comments of Mr Iain Purvis QC sitting as the Appointed Person in BL O/010/16 *Errea Sports SPA v The Royal Academy* (“RA”)



## Final Remarks

102. The opposition has failed in its entirety, and the application will proceed to registration in respect of the all the goods as filed.

## COSTS

103. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £750 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering TM7 and preparing the counterstatement	£300
Preparing and filing the written Submissions	£450
<b>Total</b>	<b>£750</b>

104. I therefore order SMITH & WESSON INC to pay Stephen Webster Limited the sum of £750. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 5th day of February 2021**

**Rosie Le Breton**  
**For the Registrar**