

O/602/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3484776

BY

BEIJING HONGGUANG DONGYING SPORTS TRAINING CO., LTD

TO REGISTER THE FOLLOWING TRADE MARK

IN CLASSES 3, 9,16, 18, 25, 35 AND 41

*Sdeepo* 斯迪波

AND OPPOSITION THERETO UNDER NUMBER 421202

BY

SPEEDO HOLDINGS B.V.

## **Background and Pleadings**

1. On 28 April 2020, Beijing Hongguang Dongying Sports Training Co., Ltd (“the Applicant”) applied to register the UK trade mark number 3484776, as displayed on the front cover page, for goods and services in classes 3, 9, 16, 18, 25, 35 and 41 (as set out below). It was accepted and published on 15 May 2020.

Class 3: Soap; Scented water; Shining preparations [polish]; Ethereal oils; Lipsticks; Cleaning preparations; Cosmetics; Cosmetics for animals; Dentifrices; Incense.

Class 9: Cameras; Divers' masks; Diving suits; Breathing apparatus for underwater swimming; Ear plugs for divers; Gloves for divers; Nose clips for divers and swimmers; Computers; Sunglasses; Spectacles.

Class 16: Paper; Printed publications; Printed matter; Periodicals; Advertisement boards of paper or cardboard; Albums; Magazines; Newspapers; Bags [envelopes, pouches] of paper or plastics, for packaging; Posters.

Class 18: School bags; Shopping bags; Suitcases; Backpacks; Bags; Business card cases; Walking sticks; Trunks [luggage]; Pocket wallets; Handbags.

Class 25: Clothing; Clothing for gymnastics; Waterproof clothing; Bathing suits; Scarves; Shoes; Head wear; Hosiery; Girdles; Gloves [clothing].

Class 35: Advertising; Procurement services for others [purchasing goods and services for other businesses]; Provision of an online marketplace for buyers and sellers of goods and services; Publicity; Bill-posting; Business management of sports people; Commercial administration of the licensing of the goods and services of others; Sales promotion for others; Television advertising; Outdoor advertising.

Class 41: Teaching; Physical education; Instruction services; Coaching [training]; Organisation of competitions [education and/or entertainment]; Organisation of sporting competitions; Educational services; Health club services [health and fitness training]; Rental of skin diving equipment; Entertainer services.

2. On 14 August 2020, Speedo Holdings B.V. (“the Opponent”) filed an opposition to the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For its claim under s.5(2)(b) the Opponent opposes only some of the Applicant’s goods and services, relying on those trade marks as set out below. The relevant specifications can be found in full in the appendix to this decision.

(i) European Union Trade Mark<sup>1</sup> (“EUTM”) number 493445 ( “the first mark”)

SPEEDO

Filed: 20 March 1997

Registered: 14 June 1999

Registered in classes 3, 5, 9, 14, 18, 25, 28. Relying on all of the goods for which the mark is registered in classes 3, 9, 18 and 25. Opposing some of the Applicant’s goods and services in classes 3, 9, 18, 25 and 35.

(ii) UK trade mark (“UKTM”) number 1527334 (“the second mark”)

SPEEDO

Filed: 18 February 1993

Registered: 7 March 1997

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019.

Relying on all of the goods for which the mark is registered in classes 9 and 16.  
Opposing some of the Applicant's goods and services in classes 3, 16 and 35.

(iii) EUTM number 1063208 ("the third mark")

SPEEDO

Filed: 20 May 1976

Registered: 20 May 1976

Registered in classes 9, 18, 25, 28. Relying on all of the goods for which the mark is registered in classes 9, 18 and 25. Opposing some of the Applicant's goods and services in classes 9, 18, 25 and 35.

(iv) EUTM number 3386241 ("the fourth mark")

The logo consists of the word "SPEEDO" in a bold, sans-serif font, followed by a stylized arrow pointing to the right.

Filed: 7 October 2003

Registered: 21 February 2005

Relying on all of the goods for which the mark is registered in class 16.  
Opposing all of the Applicant's goods in class 16.

(v) UKTM no. 3271996 ("fifth mark")

SPEEDO

Filed: 21 November 2017

Registered: 23 February 2018

Relying on all of the goods for which the mark is registered in class 9. Opposing some of the Applicant's goods and services in classes 9 and 35.

vi. UKTM no. 3445905 (series of five) ( “sixth mark”)



Filed 21 November 2019

Registered 7 February 2020

Relying on all of the goods and services for which the mark is registered in classes 9, 14, 18, 25, 28 and 35. Opposing some of the Applicant’s goods and services in classes 9, 25 and 35.

4. The Opponent claims that under section 5(2)(b) there exists a likelihood of confusion on the part of the public to include a likelihood of association between the respective marks, given that the trademarks are visually and phonetically near identical with the word SPEEDO being the distinctive and dominant component of each of the Opponent’s earlier rights. Furthermore it claims that the application covers a range of goods and services identical with or similar to the goods and services relied upon.

5. Under section 5(3) the opposition is directed towards all of the Applicant’s goods and services relying on the following three trade marks, two of which are as identified at paragraph 3(i) and (vi) above. The Opponent claims that the earlier marks have a reputation for the following goods and services within the UK:

(i) The first mark for:

Nautical, life-saving apparatus and instruments, divers suits and gloves, swimmers and divers earplugs, wetsuits for diving, swimming jackets, bathing floats, life buoys, life belts, breathing apparatus for underwater swimming, goggles, spectacles, spectacle glasses; sunglasses; bags,<sup>2</sup> clothing, footwear and headgear, gymnastic and sporting articles not included in other classes.

(ii) The sixth mark for:

Swimming goggles; sunglasses, swimmer and diver earplugs, diving suits and diving gloves; nose clips; swimming snorkels; diver masks: swimming masks; life buoys; life belts; bags; clothing; footwear; headgear; swimwear;

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<sup>2</sup> Whilst claiming a reputation for the broad term bags its registration is limited to “trunks and travelling bags”

sportswear, triathlon wear; swimming and fitness apparatus;<sup>3</sup> retail services for all products in connection with swimwear, clothing, footwear, headgear and swimming and fitness apparatus.

(iii) UKTM no. 1422588 (“seventh mark”)



Filed: 21 March 1990

Registered: 11 August 1995

Registered in classes 9, 12, 18, 25 and 28 but claiming a reputation for:

Suits and gloves, all for divers, earplugs for swimmers and for divers, wetsuits for diving and for underwater swimming, swimming jackets, bathing floats, life buoys and goggles; bags, knapsacks; articles of sports clothing; bathing caps, vests, shorts, tracksuits, jackets, wet suits for water skiing; articles of underclothing; socks for wear, swimwear and footwear; gymnastic and sporting articles (other than clothing); hand paddles and flippers, all for use as swimming aids.

6. The Opponent claims under s.5(3) that the similarity between the earlier marks and the application is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between them. In particular the Opponent submits that:

“The later trade mark incorporates the dominant and distinctive word SDEEPO, which is the only term within it that would be readily articulated by the English-speaking consumer. The Applicant is seeking to register a sign that is virtually identical to the Opponent's earlier right SPEEDO. As will be shown in evidence, SPEEDO represents the world's largest swimwear brand and the business was originally founded in 1910. The first use of SPEEDO in relation to swimwear was recorded in 1928. The Applicant is seeking to register goods and services

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<sup>3</sup> Whilst claiming a reputation for the broad term *swimming and fitness apparatus* its registration is not drafted in those terms but rather specifies the individual items as set out in the appendix.”

that are both core to the Opponent's business and allied to the business. For example, the Applicant's class 41 services cover, inter alia, sporting events and coaching. The Opponent's SPEEDO brand has a strong connection with these services on account of its sponsorship of major sporting events and athletes over many years.

The Applicant is seeking to register a mark that is without due cause. It is clear the letters "D" and "P" within the SPEEDO mark have been deliberately transposed to create "SDEEPO" in an effort to create a new identity. However, the word SDEEPO has a clear an[sic] obvious similarity to SPEEDO and there is a real danger that use of SDEEPO would tarnish the SPEEDO brand that has been carefully cultivated for almost 100 years. There can be little doubt the Applicant is seeking to piggy-back on the reputation of SPEEDO for their own commercial gain and free-ride on the extensive marketing of the SPEEDO brand which takes place year on year.

The purpose of the Applicant's sign is designed to seek an economic advantage and benefit from the extensive sales and marketing of products for the SPEEDO brand undertaken by the Opponent over many decades. The Applicant's sign is a deliberate attempt to manipulate the Opponent's mark and to borrow its core distinctive element. There is no logical reason as to why the Applicant has adopted such a sign, having regard to the Opponent's own marks of longstanding repute."

7. Under section 5(4)(a) of the Act the opposition is directed towards all of the Applicant's goods and services relying upon the following four unregistered signs claiming that they have been used throughout the UK for the following goods and services:

(i) SPEEDO used throughout the UK since 1960

(ii)  used throughout the UK since 1990

(iii)  used throughout the UK since 1960



(iv)

used throughout the UK since 1960

Swimwear, clothing, footwear; headwear; swimming apparatus, fitness apparatus, bags, towels, swimming goggles, eyewear, diving apparatus, watches, mobile apps, media players, measuring and timing apparatus, sports clocks, swimming tuition services, coaching services, sporting events, retail services.

8. The Opponent claims that by virtue of their use the marks have:

“[...] acquired a very high level of reputation and recognition by the public as denoting exclusively the goods and services of the Opponent. The Opponent therefore enjoys the benefit of the goodwill that has accrued to its business by virtue of the use of its mark and should therefore be entitled to any damage suffered on account of the misrepresentation of a third party. As a consequence, given the strong similarity of the Applicant's sign "SDEEPO" with SPEEDO, the Applicant's sign offends under Section 5(4)(a) of the Act since it is liable to deceive the relevant public into the mistaken belief they are purchasing the Opponent's products or otherwise that there is an economic connection of the Applicant's goods and services with those of the Opponent. This would result in the inevitable loss of sales for the Opponent and damage to its business. Accordingly, use of the Applicant's sign is liable to be prevented by virtue of the law of passing off.”

9. The Applicant filed a defence and counterstatement denying all the grounds of opposition. In addition, it put the Opponent to strict proof for those goods as listed in the appendix in relation to its first, second, third and fourth trade marks. It denies identity/similarity between the respective goods and services and trade marks which would give rise to a likelihood of confusion. It requests that the Opponent provide evidence of its reputation and goodwill with regards to all the goods and services as relied upon, only accepting that it has a reputation for “swimming costumes, swimming trunks and swimming goggles”. It denies that use of the later mark would take unfair advantage of the distinctive character or reputation of the earlier marks. In addition

since the contested marks are so different it is claimed that there can be no misrepresentation which would give rise to the Opponent suffering damage.

10. The Applicant is represented by IPEY Ltd, whereas the Opponent is represented by Stevens Hewlett & Perkins. Only the Opponent filed evidence. Neither party requested to be heard, however, the Opponent filed submissions in lieu of hearing. This decision is taken following a careful reading of the papers.

## **Evidence**

11. The Opponent's evidence consists of the witness statement of Mr Andrew Long, dated 26 January 2021, accompanied by 24 exhibits marked AL1-AL24. Mr Long is the Company Director of both the Opponent company and its parent company, Speedo International Limited, a position he has held since 1 December 2005. Mr Long's responsibilities include the day to day operational running of the Opponent company and he confirms that he is authorised to make the statement on the Opponent's behalf.

12. Mr Long provides a history of the Opponent and its predecessors since it was founded in 1914 and the origins of the Speedo brand which first began in 1928. In support, he provides a copy of the Opponent's "Brand Book"<sup>4</sup> and an extract taken from Wikipedia,<sup>5</sup> last edited on 26 November 2020. Mr Long confirms that the Opponent began distributing goods to the UK in 1964, when it established its British headquarters in London under the name Speedo (Europe) Ltd. In 1964 and 1969, the Opponent was awarded an export award by the UK Government's Department of Trade and Industry. It is said that Speedo has grown to become the world's biggest swimwear brand with products bearing the mark being available for sale in almost 170 countries worldwide with a large focus on the UK sportswear and leisurewear market.<sup>6</sup>

13. Mr Long states that the Speedo brand covers a wide range of products to include *"Swimwear, leisure wear, footwear, headwear, sunglasses, sports goggles, swim accessories, snorkel equipment, electronic timer equipment and trackers, bags, towels, sports and fitness articles and equipment and toys, as well as retail services for all these products."*<sup>7</sup> The majority of these products it is said are sold from

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<sup>4</sup> AL1

<sup>5</sup> AL2

<sup>6</sup> Para 10

<sup>7</sup> Para 13

www.speedo.com which services all UK-based consumers. An extract taken from the archive website “www.archive.org” showing a screen shot of the website as at 1 August 2018, is produced. I note that the website has been saved 7,000 times between 27 December 1996 and 9 November 2020. The screenshots include photographs of the following products: women’s swimsuits, men’s swim briefs, men’s swim shorts, goggles swimming caps, towels and bottles all bearing the Speedo (figurative) trade mark.<sup>8</sup>

14. Mr Long produces a table showing the minimum UK sales figures for each year said to cover the full list of Speedo products as set out in paragraph 13 of his statement (as reproduced in the preceding paragraph). The actual sales figures are said to be in excess of those produced.<sup>9</sup>

Year	Min UK Sales Figures / £
2014	25,000,000
2015	24,000,000
2016	27,000,000
2017	29,000,000
2018	28,000,000
2019	27,000,000

15. AL8 consists of copies of “some sales invoices issued in the last few years” to Wiggle Ltd, Amazon EU Sarl UK Branch, JD Sports Fashion PLC, Alison Black Ltd (t/a Sportmax) and Cenpac (AIS) Ltd all located in the UK, for various Speedo products. No explanation has been given as to the abbreviations listed in the description column of the invoices, however, I am able to identify the following products: “tech paddles, snorkels, bags (mesh, duffel and pool) and arm bands. There are several references to products abbreviated as “gog” which I will assume refers to goggles. The invoices are headed with the logo  , are issued by Speedo International Ltd, are in pounds sterling and are dated 5 February 2014, 5 November 2015, 5 January 2017, 14 January 2017 and 31 January 2017.

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<sup>8</sup> AL3

<sup>9</sup> Para 14

16. Mr Long states that a significant volume of Speedo's sales are made via Amazon. Various extracts of screen shots taken from the Amazon UK platform are produced all of which are dated during the relevant period and are said to show the official Speedo store and some of the many products that are being offered for sale.<sup>10</sup> Only a selection of the key Speedo products are produced but these include swimming goggles, baby wetsuits, men's and women's swimwear, swimming caps, sandals, nose clips, kickboards, pull buoys, earplugs, training snorkel masks, swim bags, paddles, training fins, swimming flippers, arm bands and towels. The speedo products displayed are all ranked highly in the Best Sellers list with several products (men and women's swimwear, swimming caps, goggles) ranked number one. The word only SPEEDO mark is displayed within the text of the screen shots and the marks *speedo*  and  are displayed on the products themselves.

17. Mr Long states that the Opponent's "Speedo products" are available from various major UK retail outlets (both online and offline) to include Next, Sports Direct, Amazon, Wiggle, Very, Decathlon, House of Fraser, JD Sports and Argos.<sup>11</sup> A Google search result list for the term "buy speedo UK" is produced dated between 2 December 2018 and 2 December 2019.<sup>12</sup> The majority of the results refer to swimwear and goggles but there are also references to Speedo surfwear and wetsuits. There are a number of entries relating to "Speedo launching an AR app". One entry dated Sept 2019 refers to Speedo launching a 3D face scanning app allowing shoppers to interact with the products before purchase.<sup>13</sup>

18. Mr Long states that "over the last 15 years" (which taking account of the date of the statement would be approximately from 2006) the Opponent has owned and operated a number of dedicated Speedo retail outlets around the UK to include the Designer Outlet in York, Ponds Forge International Sports Centre in Sheffield and its Covent Garden store in London which operated from the mid 2000s to 2019. As at 15 November 2016 there were 52 outlets selling speedo merchandise in London or within a 20 mile radius thereof.<sup>14</sup> AL6 consists of a blog article review (dated 10 August

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<sup>10</sup> AL9

<sup>11</sup> Para 15

<sup>12</sup> AL5

<sup>13</sup> Page 76 AL5

<sup>14</sup> AL7

2005) and photographs of the Covent Garden store taken by individuals and uploaded to Google maps. The photographs produced display the following marks on the shop

signage  and  and show the following products - goggles, swimwear, swimming caps, swim floats, sports bags and drink bottles.

19. Exhibits AL10 and AL11 consist of the Opponent's UK marketing activities for 2018 and 2019, which include the annual marketing spends, press and magazine coverage, PR activities and social media influencers engagement. For example page 196 includes the following information for 2018

“Total number of pieces of coverage to date (including print, digital & social) - 442

Total Reach - 916,342,414

Total AVE - £1,363,748.”

20. References are made to several UK publications, in which the products bearing the marks (in its figurative form) have been promoted, to include The Daily Express, Women's Health, Stylist, The Independent, Metro, Daily Mail. Photographs are produced of the Speedo display stands showcased in the UK Decathlon and Harrods stores circa 2018. Due to the quality and the size of the images it is difficult to identify the range of products on display within the screenshots, but I am able to identify images of swimwear.

21. Mr Long produces several sources supporting the Opponent's claim that Speedo is “the world's leading swimwear brand.”<sup>15</sup> Mr Long produces an extract taken from the YouGov website which states that “Speedo is the 23<sup>rd</sup> most popular fashion and clothing brand and the 26<sup>th</sup> most famous” following 1229 interviews amongst UK consumers between July 2020 and October 2020. It is stated that the You Gov rating is indicative of the brand's popularity in the UK.<sup>16</sup> An extract taken from “The Superbrand's directory Volume 1” (published in 1995) is produced where Speedo is confirmed as a Superbrand.<sup>17</sup> Participation is said to be by invitation only where a

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<sup>15</sup> AL13

<sup>16</sup> AL14

<sup>17</sup> AL15

Superbrand status is only offered to the most outstanding brands in their field.<sup>18</sup> Mr Long states that selection for Superbrand status is evaluated by a range of voters each year from British consumers, business professionals, business to business industry leaders and leading consumer marketing experts. Within this publication a number of key headline facts are made as at 1995, namely:

- Speedo is said to be “the world’s number one performance swimwear brand and the market leader in both the world market(with a share of 5%) and the UK market (with a share of 9%).
- In relation to the UK performance swimwear market Speedo has a 70% market share.
- In 1994 speedo sold 10 million swimsuits, 3 million pairs of water shorts 6 million pairs of goggles and 4 million swim caps around the world.
- Over 250 million Speedo costumes have been sold worldwide.
- Olympic medal winners have worn speedo swimwear products more than any other brand.
- Research conducted by Latham Associates, confirms that 94% of 16 to 19 year old males in the UK recognise the Speedo brand.

22. Mr Long states that Speedo is listed as one of the world’s greatest brands in Interbrand’s “The World’s Greatest Brands” directory (undated) published by Macmillan Business.<sup>19</sup>

23. Mr Long states that the Speedo brand has been associated with a number of sporting events and has sponsored a number of national teams and individual athletes (to include those competing for Great Britain and Team UK). He states that at the 1972 Munich Olympics, 52 nations were supplied with Speedo swimwear. In 1976 Speedo was appointed the official swimwear sponsor of the 1976 Montreal Olympic games.<sup>20</sup> In more recent years the company has sponsored the London Olympic Games 2012, Glasgow Commonwealth Games 2014, Invictus Games (Team UK) 2018, British Universities and College Sport (BUCS) Swimming Series 2019, FINA Swimming World Cup 2015-2019, London World Triathlon Championships 2010, Special Olympics

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<sup>18</sup> Para 25

<sup>19</sup> AL16

<sup>20</sup> AL2

National Games, Sheffield 2017. A number of high profile athletes have been brand ambassadors for Speedo, to include Rebecca Adlington OBE ( a British multiple gold medal swimmer) and Michael Phelps (most decorated Olympian of all time).<sup>21</sup> Mr Long states that 57% of all swimming medals won at the 2012 London Olympic Games were awarded to swimmers wearing Speedo attire to compete. The Opponent has also been involved in various community projects throughout the UK to include collaborating with BelievePerform in support of World Mental Health Day in 2020, partnership with the Black Swimming Association in 2020, Free Swim Passes at Tinside Lido, Plymouth 2018, Hope 4 Youth Charity Swim Gala 2015 (and other years - not specified) and the British Gas Big Dip 2011.<sup>22</sup>

24. In January 2013 the Opponent launched a fitness campaign called Get Speedo Fit with the dual purpose of encouraging participation in swimming as well as exposure for the Speedo brand. The campaign attracted media coverage from various UK publications.<sup>23</sup>

25. In 2017 the Opponent launched a joint venture with Samsung, for a free downloadable swimming and fitness activity tracking mobile app called “Speedo On” which was featured on Samsung’s Gear Sport and Gear Fit2 Pro “wearables”. As at 30 November 2020 the app had been downloaded over 50,000 times.<sup>24</sup>

26. This concludes the summary of the evidence in so far as it is relevant. The Opponent also filed submissions in lieu of hearing. Whilst I have read and noted the contents of these submissions, I do not propose to summarise them here but will refer to them as appropriate in my decision.

### **Proof of use**

27. In these proceedings, the Opponent is relying upon its UK and EU trade marks as shown above, which, given their filing dates, qualify as earlier trade marks under section 6 of the Act. As its fifth and sixth earlier marks have been registered within the five-year period ending on the date of filing of the Applicant’s mark, they are not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the

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<sup>21</sup> AL17/18

<sup>22</sup> AL20

<sup>23</sup> AL22

<sup>24</sup> AL21

Opponent is entitled to rely upon all the goods and services of these registrations without having to establish genuine use. In relation to its first, second, third, fourth and seventh marks, however, they have been registered for more than five years ending on the filing date of the application and therefore ordinarily for the Opponent to rely upon these marks under sections 5(2)(b) and 5(3) it must meet the use conditions for each and every specification it intends to rely upon.

28. The Applicant, however, only requested proof of use for those marks and goods as outlined in the appendix specifically excluding *bathing floats, divers' masks, floats for swimming, swimming belts, swimming and diving goggles* in class 9; *Bags and knapsacks* in class 18 and *swimming costumes, swimming trunks, swimming shorts, swimming suits, swimming caps, flip flops, sliders (footwear) and footwear adapted for use in the water* in class 25. I also note that the Applicant did not require the Opponent to provide proof of use of its seventh mark.

## **My Approach**

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

29. The Opponent's first, second, third and fifth marks are all for the identical word only SPEEDO, whereas, its fourth and sixth marks consist of the same word (albeit in different casing) combined with an arrow device presented either underneath or after the word. I note that there is a significant overlap between the respective marks and goods subject to proof of use (namely those goods in classes 9,18 and 25 covered by the first, second and third earlier marks) which are covered by the fifth and sixth marks which are not subject to proof of use. Consequently, for the purposes of its claim under section 5(2)(b) I will proceed initially by assessing the opposition based on the Opponent's fifth and sixth marks for those goods as relied upon. If reliance on marks one to four for those remaining goods and services becomes critical to my decision, I will formally consider if the use conditions are met for these goods later in my decision.

## **Decision**

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

30. Section 5(2)(b) of the Act states as follows:

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

(a) ....

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

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

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

32. 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 greater 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 to mind the earlier mark, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison on the goods and services**

33. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where 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”.

34. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

35. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

36. As set out earlier in my decision, the Opponent relies upon its fifth mark for all its goods in class 9 and opposes the Applicant's goods/services in classes 9 and 35. In relation to its sixth mark it relies on all of the goods and services of its registration and opposes the Applicant's goods and services in classes 9, 25 and 35. I also note that it opposes the Applicant's goods in class 18 relying on its first mark which are also covered by the Opponent's sixth mark and therefore I shall include these goods in my assessment. The Applicant's goods and services as opposed under section 5(2)(b) are as outlined below:<sup>25</sup>

Class 9: Cameras; Divers' masks; Diving suits; Breathing apparatus for underwater swimming; Ear plugs for divers; Gloves for divers; Nose clips for divers and swimmers; Computers; Sunglasses; Spectacles.

Class 18: School bags; Shopping bags; Suitcases; Backpacks; Bags; Business card cases; Walking sticks; Trunks [luggage]; Pocket wallets; Handbags.

Class 25: Clothing; Clothing for gymnastics; Waterproof clothing; Bathing suits; Scarves; Shoes; Head wear; Hosiery; Girdles; Gloves [clothing].

Class 35: Procurement services for others [purchasing goods and services for other businesses]; Provision of an online marketplace for buyers and sellers of goods and services; Sales promotion for others.

37. I note that a number of the Applicant's goods are identical to the Opponent's goods as outlined in the appendix either because the identical wording is used or because they are covered by the other's broader term and therefore will be regarded as identical according to the principles in *Merix*. These are as follows:

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<sup>25</sup> In answer to question 4 in form TM7 of its pleadings, the Opponent did not oppose all of the Applicant's services in class 35 or any of its class 41 services. I shall return to the Applicant's class 3 and class 16 goods later.

Class 9: Cameras; Divers' masks; Diving suits; Breathing apparatus for underwater swimming; Ear plugs for divers; Gloves for divers; Nose clips for divers and swimmers; Sunglasses; Spectacles.

Class 18: School bags; Shopping bags; Suitcases; Backpacks; Bags; Business card cases; Walking sticks; Trunks [luggage]; Pocket wallets; Handbags.

Class 25: Clothing; Clothing for gymnastics; Waterproof clothing; Bathing suits; Scarves; Shoes; Head wear; Hosiery; Girdles; Gloves [clothing].

### **Class 9**

38. The contested *computers* is similar to a medium degree to the Opponent's *computer software; mobile application software* in that whilst differing in nature, they are complementary having a close relationship one to the other, share purpose, end user and trade channels.

### **Class 35**

39. The Applicant's *sales promotion for others* is identical under *Meric* to the Opponent's *marketing.. promotion services*.

40. The Applicant's *procurement services for others [purchasing goods and services for other businesses]* are akin to arranging of contracts for the purchase and sale of goods and services for others or the acquiring of goods and services for third parties and are in my view similar to a medium degree to the Opponent's *retailing, wholesaling, advertising, marketing and business promotion services provided online or via a communications network*. I consider that the Applicant's procurement services would be offered by the same undertaking as those offering retail services, to the same relevant public, through the same distribution channels and may have the same purpose if they related to the same goods and services.

41. The contested *provision of online marketplaces for buyers and sellers of goods and services* is the provision of an e-commerce platform where the seller can display and offer its goods for sale to the buyer without the platform operator necessarily being involved in the process or what is being sold. The provider of such a platform has a

more passive role in the purchasing/selling process than perhaps a standard retailer, however, I consider that these services are similar to a medium degree to the Opponent's retail services as the purpose, channels of trade and end user of both services would overlap.

### **Average Consumer**

42. When considering the opposing trade marks I must determine first of all who the average consumer is for the goods and services and the method of selecting these goods and services. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.

43. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

44. No submissions were provided by the Applicant regarding the average consumer or the purchasing/selection process, however, the Opponent submitted that:

“..the average consumer for the goods and services at issue are members of the general UK public at large who are likely to give a normal degree of attention to the products at issue, none of which are “specialist” products which warrant very careful selection. Visual considerations are likely to dominate the selection process.”

45. The average consumer of the goods will be members of the general public who in my view will select the goods paying an average level of attention because considerations such as aesthetic qualities, suitability, cost and fit will be taken into account. I accept that the level of attention may increase slightly for the more technical goods such as breathing and diving apparatus but not considerably so. I consider that

the purchase of the goods are unlikely to be daily or particularly infrequent. In so far as the services they will in the main be directed towards the general members of the public (particularly the retail services) with the same level of attention as the goods. The services that relate to sales promotion and advertising, however, are more likely to be directed towards the business user who will pay a slightly higher level of attention than the general member of the public but not a particularly high level. Factors such as exposure, cost and reputation will play a part in the considerations.

46. The goods and services are likely to be self-selected from shelves of retail outlets or their online equivalents or signage at the actual venue. The selection process will therefore be predominantly visual but with aural considerations not being discounted,<sup>26</sup> given that advice may be sought from sales representatives or following word of mouth recommendations.

### **Comparison of the marks**

47. 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.”

48. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider 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 trade marks.

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<sup>26</sup> *New Look Limited v OHIM* joined cases T-117/03 to T-119/03 and T-171/03 at [50]

49. In light of my approach, I shall compare the Applicant's mark with the Opponent's fifth and sixth marks which are represented as follows:

Opponent's marks	Applicant's mark
<p>SPEEDO and  (series of five)</p>	

50. The Applicant in its original counterstatement submitted that:

“All 6 of the earlier marks relied upon by the Opponent comprise the pronounceable word SPEEDO, being a word which is short for the word speedometer and provides the general allusion of something that exhibits or is connected with speed. The Opponent's 1st, 2nd, 3rd and 5th earlier marks comprise the word SPEEDO alone, whereas the Opponent's 4<sup>th</sup> and 6th earlier marks comprise the word SPEEDO in a non-distinctive font disposed adjacent the device of an arrowhead that is directed upwardly and to the right.

The Applicant's later mark comprises the word sdeepo in lowercase in a highly distinctive font, the word sdeepo being an invented word which is practically unpronounceable and has no meaning in English. The word sdeepo is merely a phonetic representation of the adjacent Chinese characters 斯迪波 pronounced “si di bo”.

51. The Opponent submitted that:

“ ..the word elements within the respective marks are highly similar. Each word is composed of six letters, each begins with the letter “s” and each end with letter “o”. Verbal articulation by the English-speaking consumer would render both words “speedo” and “sdeepo” to the extent that they would be virtually indecipherable from one another in speech given the common pronunciation “sp-ee-do” and sd-ee-po”, with no room to argue that either word could be pronounced any differently. It is clear that “sdeepo” is visually and phonetically

near identical to “speedo” and that the stylised aspects of the later mark are de minimis and do nothing to distinguish it from “speedo”. Taking into account opponent’s rights showing the word SPEEDO (and “speedo”) in combination with an “arrow” device it is clear that the word is the dominant and visually arresting aspect within each mark as a whole, and that they up both “SPEEDO” marks.

...the Applicant argues that the word SPEEDO could be taken by some consumers to be a shortened version of the word “speedometer” but has offered no evidence to support this view. Even so any such evidence would be immaterial because the visual and phonetic similarities of SDEEPO and SPEEDO are so great that no level of conceptual “dissimilarity” would counteract those.”

### **Overall impressions of the trade marks**

#### **SPEEDO**

52. The Opponent’s mark is for the word only SPEEDO presented in upper case. There are no other elements to contribute to the mark and therefore the overall impression of the mark resides in the totality of this word.



(series of five)

53. Whilst the Opponent relies on its sixth mark as a series of five, the only difference between them is the colour combination which has not been claimed at registration. Nothing turns on the use of colour since despite being registered in black and white, the Applicant’s trade mark could be used in any colour including the same one as the Opponent<sup>27</sup> and therefore for the purposes of the mark comparison I shall refer to them in the singular relying on the first in the series which is presented in black and white.

54. The Opponent’s sixth mark is the combination of the word speedo, presented in lower case, in combination with an arrow device underneath. The combination of the

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<sup>27</sup> *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2014] C-252/12

arrow device and the word contribute to the overall impression of the mark, although weighted in favour of the word speedo, since consumers will focus on the word element rather than the device.



55. The Applicant's mark is the word "Sdeepo" in a stylised font in combination with Chinese characters.<sup>28</sup> Whilst both elements contribute to the overall impression of the mark, I consider that it is the word which dominates, due to its size and position within the mark relative to the Chinese characters. Given that the majority of UK average consumers will not be able to read or are unlikely to understand the meaning of the characters, less weight will be afforded to them. I do not accept that the stylisation is "highly distinctive" as argued by the Applicant and whilst the stylisation contributes to the overall impression of the mark it plays a lesser role in the mark as a whole.

### Visual considerations

56. The difference in casing between the contested marks will have no bearing on the visual comparison assessment since notional and fair use allows marks to be presented in any font or type case.



57. The word element in both marks is six letters in length and includes the letter structure S\*EE\*O. Both include the letters D and P but differ in so far as the positions of these letters are transposed in each mark. As stated, nothing turns on the different font or casing of the respective marks although the Applicant's mark is slightly stylised. The Applicant's mark includes Chinese characters, there being no counterpart in the Opponent's mark. Weighing up the differences and the similarities and taking that the word element in the Applicant's mark is more dominant, I consider that the marks are similar to at least a medium degree.

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<sup>28</sup> Both parties submit that the characters are Chinese.



58. Both marks include the word speedo/ Sdeepo (the differences in which have been outlined above) in combination with an additional element. In the Opponent's case the additional element is an arrow device presented underneath the word, whereas in the Applicant's case it is a series of Chinese characters both of which give rise to a point of visual difference. I have already found that the marks coincide in the letter structure S\*EE\*O only differing with the transposition of the letters d and p, stylisation and the devices, but that I consider that the word in both is the more dominant element. I consider overall that there is a medium degree of similarity between the marks.

### **Aural Considerations**

59. The Applicant submits that "its word sdeepo ...is merely a phonetic representation of the adjacent Chinese characters pronounced as "si di bo" ...and that the later mark is relatively unpronounceable in English except as the 3 sounds ess dee poh" which renders the marks "aurally different." The Opponent on the other hand submits that "the verbal articulation by the English speaking consumer would render both words "speedo" and "sdeepo" to the extent they would be virtually indecipherable from one another in speech given the common pronunciation."

60. I disagree with the Applicant's submissions regarding the pronunciation of the later mark. The average UK consumer will pronounce the Applicant's mark following normal English phonetic paradigms, namely as two syllables SDEEP-OH. This word will not be pronounced as three sounds nor by reference to the Chinese characters by the majority of UK consumers. In relation to the Opponent's marks, no pronunciation will be afforded to the arrow device and therefore both earlier marks will be pronounced as the two syllable word SPEED-OH. Although the letters "d" and "p" are substituted one for the other in the Applicant's mark, these letters are similar sounding and therefore will be misheard and swallowed up by the remaining letters. On this basis aurally the marks are similar to a high degree, both starting and ending with the same letters and sharing the same S-EE-OH sound.

## **Conceptual considerations**

61. Conceptually the later mark will not give rise to any meaning as it will be regarded as an invented word. I do not consider that the earlier marks will be regarded by the majority of average consumers as an abbreviation for speedometer, as argued by the Applicant, although I accept that a small proportion may see it as such. Whilst the word SPEEDO is itself a made-up word, I consider that consumers will regard it as being based on the word Speed and so will evoke the concept of speed. On this basis the marks are conceptually dissimilar.

## **Distinctive character of the earlier marks.**

62. 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).”

63. Registered trade marks possess varying degrees of inherent distinctive character; descriptive words tend to have a low level of inherent distinctiveness, whereas invented words are regarded as possessing a high level of distinctive character and dictionary words that are neither descriptive nor allusive are somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion and the stronger it measures the marks' identity with its goods and services.

64. I will assess the mark's inherent distinctiveness firstly, bearing in mind my assessment of the overall impression, where the word Speedo is the more dominant element of the sixth mark. I consider that the use of this word in both marks whilst unique will be regarded as based on the word speed. Whilst not descriptive of the goods and services this word is somewhat allusive of a characteristic of the goods relating to their performance in the water. On this basis, overall, I consider that the marks' inherent distinctive character is between medium and high.

65. The Opponent, however, has filed evidence and claimed that its marks have acquired an enhanced distinctive character as a result of the use made of them. The evidence shows it sells vast quantities of products every year in the UK, which Mr Long specified as *"Swimwear, leisure wear, footwear, headwear, sunglasses, sports goggles, swim accessories, snorkel equipment, electronic timer equipment and trackers, bags, towels, sports and fitness articles and equipment and toys, as well as retail services for all these products"*. The sales figures produced are presented as minimum figures and whilst extensive are not broken down by product. Mr Long states that they represent those products as outlined above, however, whilst there is clear evidence that the marks have been used for some swimming related products, it does not support all the products as listed.

66. Notwithstanding that a number of the references to its associations with the Olympic games fall outside the relevant period and in part relate to non UK countries (for example the Montreal Olympics and a USA swimmer Michael Phelps) I take into account that the Olympic games take place only every four years but it is televised worldwide and therefore the reach to UK consumers through this medium would be

extensive. Such is the sponsorship and associations with high profile athletes and sporting events shown in evidence, that I have no hesitation in accepting that it is the world's leading swimwear brand as claimed and accept that this will also apply to the UK. The extensive advertising, annual marketing spends, press and magazine coverage in UK publications, PR activities and social media influencer engagement produced for 2018 and 2019 demonstrates the geographical extent and how strongly the Opponent's goods identify with the marks. The market share figures for the UK, act as an indication of the marks' appeal and although this evidence was extracted from the Superbrand directory dated in 1995, when coupled with the sales figures which have increased year on year rather than diminished, it nevertheless demonstrates a long-standing awareness of the brand with UK consumers for swimwear going as far back as 1964. I note the associations and sponsorships referred to, span decades. The products bearing the marks, referred to by Mr Long, have been offered for sale at major retail outlets and online throughout the UK, between 2000 and 2019. I have no hesitation in finding that as a result of the extensive use made of its marks since 1928, in both its word only form and figurative form, that the marks have acquired a high degree of distinctive character for swimming products but only in so far as "*men's and women's swimwear, swimming goggles, wetsuits, swimming caps, sandals, nose clips, kickboards, pull buoys, earplugs, training snorkel masks, sports bags, paddles, training fins, swimming flippers, arm bands, towels, mobile app software and retail services for all of the aforementioned goods.*"

### **Likelihood of confusion**

67. When considering whether there is a likelihood of confusion between the respective marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective services originate from the same or related source.

68. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it

is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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, I conclude that it is another brand of the owner of the earlier mark."

69. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

70. Earlier in my decision I found that the goods and services were either identical or similar to a medium degree. I identified that the average consumer of the goods and some of the services to be a member of the general public who would primarily select the goods and services via visual means but with aural considerations not being discounted. I also identified for the advertising and sales promotion services that the average consumer would include the business user. In relation to the general member of the public, I found that an average level of attention would be undertaken in purchasing the goods and services but that for the business user and for those technical goods a slightly higher level of attention may be undertaken but not considerably so. I found the marks to be visually similar to a medium/ at least a medium degree, aurally similar to a high degree but that they were conceptually dissimilar. I found that the Opponent' marks possessed a medium to high degree of inherent distinctive character which had been enhanced to a high degree, as a result of the extensive use made of the marks for those goods and retail services as outlined in

paragraph 66. I bear in mind my assessment regarding the overall impression of the contested marks and what I considered to be the dominant elements in each.

71. I will consider direct confusion first, taking note that consumers rarely have a chance to compare marks side by side but must instead rely upon the imperfect picture of them that he has retained in his mind. In its counterstatement, the Applicant submitted that “the later mark has no meaning and does not allude to the speed unlike the earlier marks” therefore this fact coupled with the aural and visual differences would not lead to confusion.

72. Taking account of my conclusions regarding the overall impression of each mark, I identified that the dominant elements of each lay in the words Speedo/Sdeepo. In *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch) [48], Mr Justice Arnold stated that

“45. I entirely accept the basic proposition which the Court of Justice has repeated many times, namely that the assessment of likelihood of confusion must be made by considering and comparing each of the signs as a whole. As the Court of Justice recognised in *Medion v Thomson*, however, there are situations in which the average consumer, while perceiving a composite sign as a whole, will recognise that it consists of two signs one or both of which has a significance which is independent of the significance of the composite whole.....The essence of the Court of Justice's reasoning in *Medion v Thomson* is that an average consumer of leisure electronic products confronted with the composite sign THOMSON LIFE could perceive both the whole and its constituent parts to have significance and thus could be misled into believing that there was a similar kind of connection between the respective undertakings.

...

47. In my view the principle which I have attempted to articulate in paragraph 45 above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to that significance.”

73. Following Mr Justice Arnold's approach in *Aveda*, the element Sdeepo in the Applicant's mark has significance independently of the Chinese characters when considering the mark as a whole. Consumers who are already familiar with Speedo products, would be confused by the use of Sdeepo, irrespective of the presence of the Chinese characters, because "the human eye has a well-known tendency to see what it expects to see and the human ear to hear what it expects to hear."<sup>29</sup> Consequently, it makes little difference that the word in the application is Sdeepo as opposed to Speedo, because the familiarity with the earlier mark, which is already embedded in the minds of the average consumer as a result of its enhanced distinctive character, will mean that this element in the later mark is likely to be misheard or misread for Speedo. Given that the Chinese characters play a lesser role in the overall impression, it is my view that the marks will be imperfectly recalled or misremembered, leading to a likelihood of direct confusion. The absence/presence of a conceptual hook in the Applicant's mark does not neutralise the visual and aural similarities that I have already identified, despite the Applicant's submissions to the contrary.<sup>30</sup>

74. If I am wrong in this regard and the average consumer recognises that the marks are not the same, either by the exchange of the letters P and D in the first element and/or as a result of the devices, there is sufficient similarity in their construct and structure that they will, nevertheless, make the assumption that the application is connected to Speedo leading to indirect confusion. In *Starbucks Corp v EUIPO*, T-398/16, the GC upheld the opposition on the basis that the application had a similar structure to the earlier mark. Although this decision also involved an assessment of the use of colour, it nevertheless has application in the decision in suit because even if consumers notice the differences, it cannot be ignored that the word element of the application uses the identical letters and word structure to the Speedo element of the earlier marks.

75. In this scenario, the average consumer will notice the Chinese characters and the arrow device but misremember or not notice the transposition of the letters D and P in the first word element, as already outlined. I believe that, consumers will assume that the later mark is a variation on the earlier marks, for example, a Chinese sub brand or co brand or that the goods are in some way a Chinese version of the Opponent's

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<sup>29</sup> Para 48 in *Aveda*

<sup>30</sup> Mr Geoffrey Hobbs' decision on appeal in *Pinkies* BL O/566/19

goods because they share a similar letter/word structure for identical/similar goods and services. Therefore there will be indirect confusion.

76. The opposition under section 5(2)(b) succeeds in its entirety against the following goods and services of the application:

Class 9: Cameras; Divers' masks; Diving suits; Breathing apparatus for underwater swimming; Ear plugs for divers; Gloves for divers; Nose clips for divers and swimmers; Computers; Sunglasses; Spectacles.

Class 18: School bags; Shopping bags; Suitcases; Backpacks; Bags; Business card cases; Walking sticks; Trunks [luggage]; Pocket wallets; Handbags.

Class 25: Clothing; Clothing for gymnastics; Waterproof clothing; Bathing suits; Scarves; Shoes; Head wear; Hosiery; Girdles; Gloves [clothing].

Class 35: Procurement services for others [purchasing goods and services for other businesses]; Provision of an online marketplace for buyers and sellers of goods and services; Sales promotion for others.

### **Proof of Use**

77. In light of my findings I will now return to the position regarding the Opponent's first to four earlier marks and consider whether the Opponent has demonstrated genuine use of the remaining goods for which proof of use was sought. I need not consider the Opponent's third mark due to the overlap in the goods relied upon and opposed. I will therefore limit my proof of use assessment to those goods in classes 3 and 16 as set out below:

#### **i. First mark - SPEEDO**

Class 3: Soaps, perfumery, essential oils, cosmetics, hair lotions, shampoos, conditioners, products for styling of the hair, bath and shower gels, moisturizers, cosmetic hand and body lotions, creams and oils; suntanning preparations, suntanning lotions, creams and oils (not for medical use); none of the aforesaid being preparations for oral, dental and pharyngeal care.

ii. Second mark - SPEEDO

Class 16: Books, calendars, catalogues, flags of paper; graphic prints, representations and reproductions; magazines, handbooks, pamphlets, periodicals, pictures, photographs, playing cards, posters, decalcomanias, sign boards of paper or cardboard, teaching materials, towels of paper, transfers; all included in Class 16.

iii. Fourth Mark - 

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; printed publications; books; magazines; periodicals; brochures; catalogues; photographs.

78. I bear in mind section 100 of the Act which states:

“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.”

79. Under section 6A(1A) of the Act the relevant period in which genuine use must be established is the five-year period ending on the filing date of the applied-for mark. Consequently, the relevant period is from 29 April 2015 to 28 April 2020.

80. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

81. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy,

if more reliable) “use it – and file the best evidence first time round- or lose it” [original emphasis].

[..]

Any tribunal assessing this evidence would be bound to conclude, especially given the nature of the proprietor in question, the alleged importance of the mark and the fact that the proprietor was represented by legal advisors of repute that a diligent and careful search had been made for relevant documents proving use and this was the best that could be found.”

82. The Applicant did not comment on the Opponent’s evidence, nor challenge the extent of use demonstrated. Nevertheless, when assessing the evidence filed it is clear that the Opponent has focussed its attentions on those goods and retail services relating to swimming.

#### *Class 3*

83. No evidence was filed in relation to any of the goods contained within class 3 of its registration. The Opponent may not rely upon these goods for the purposes of its opposition.

#### *Class 16*

84. The only reference to goods covered by this specification is the Opponent’s Brand Book at AL2. However, there is no indication that this publication is printed or distributed commercially and appears to be for internal purposes only. There are no references to brochures, catalogues or any goods within class 16 within Mr Long’s statement that I can point to which demonstrates use of the trade marks for these goods.

85. Coming back to the opposition under section 5(2)(b) for those of the Applicant’s goods as opposed, but not already dealt with, having failed to demonstrate use and thus not being able to rely on them, I see no obvious similarity between the Applicant’s goods in class 3 and 16 and the Opponent’s remaining goods as relied upon. The opposition under section 5(2)(b) therefore fails for the following goods.

Class 3: Soap; Scented water; Shining preparations [polish]; Ethereal oils; Lipsticks; Cleaning preparations; Cosmetics; Cosmetics for animals; Dentifrices; Incense.

Class 16: Paper; Printed publications; Printed matter; Periodicals; Advertisement boards of paper or cardboard; Albums; Magazines; Newspapers; Bags [envelopes, pouches] of paper or plastics, for packaging; Posters.

### **Section 5(3)**

#### **My approach**

86. The Opponent is relying on three earlier marks, as outlined in paragraph 5 above, for which it claims a reputation. I note that the Opponent claims a reputation for *fitness and swimming apparatus* and *bags*, but these broader terms do not form part of the registrations relied upon. Rather its first mark specifically refers to *trunks and travelling bags* and its sixth mark is registered for *games and playthings; gymnastic and sporting articles; boards for swimming; paddles for swimming; buoys for swimming training; rubber buoys for swimming; flippers and duck-feet for swimming; flotation jackets for use in swimming; inflatable armbands for swimming; snorkels for use in swimming; surfboards; kickboards; swimming mitts; swimming fins; body toning apparatus; body training apparatus; aquatic exercise steps; aquatic fitness exercise belts; aqua planer paddles; aqua fitness paddles; aquatic exercise chutes; balls; floats for bathing and swimming; transportable swimming pools; parts and fittings for all the aforesaid goods*. The reputation relied on for the purposes of s.5(3) of the Act must be in the goods/services covered by the trade marks relied on and therefore I can only consider the terms covered by its registrations.<sup>31</sup> In addition the Applicant has only sought proof of use for the Opponent's first earlier mark and therefore the Opponent is able to rely on those goods and services of its sixth and seventh mark for which it claims a reputation without restriction. I shall undertake my assessment under section 5(3) initially based on the Opponent's sixth mark (given that the position of the arrow device and casing will make little difference in light of my previous findings) only returning to the Opponent's first and seventh mark if it becomes necessary to do so.

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<sup>31</sup> *Tulliallan Burlington Ltd v EUIPO*, Case T-123/16

87. Section 5(3) the Act states:

“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.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

88. The relevant case law can be found in the following judgements of 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*).

89. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier marks are similar to the Applicant's mark. Secondly, that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed by the opponent will be suffered. It is unnecessary for the purposes of section 5(3) for the goods and services to 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 them. For the purposes of section 5(3) the relevant date for the assessment is the date of filing of the application, namely 28 April 2020.

90. The Opponent submits that the

“Applicant has deliberately set out to imitate the Opponent's SPEEDO marks by simply transposing the second and fifth letters. The goods sought for registration under the subject application are suggestive of a copycat swimwear brand... the word SDEEPO could give the initial impression that it is a parody but even without evidence put forward by the Applicant it is clear its intentions are of a commercial nature and that this is not a parody case.”

91. Furthermore:

“...the choice of the word SDEEPO to represent swimwear swimming apparatus and all goods and services covered by the application is without due cause. There is no logical reason as to why such a mark had been adopted and the only conclusion is that it is intended to piggy back and ride on the coat tails of the Opponent's undoubted reputation and to disrupt the Opponent's business.”

### **Similarity of the marks**

92. In relation to the similarity between the marks, overall, this first condition is satisfied. For the reasons set out earlier, I found that the marks were visually and

aurally similar to at least a medium/medium degree and high degree and that conceptually I found that the marks were dissimilar.

## **Reputation**

93. The Opponent claims a reputation for those goods and services as outlined in paragraph 5. In assessing whether the earlier mark has a reputation to a significant number of consumers I must assess the evidence in terms of the extent it demonstrates “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”<sup>32</sup>

94. Some of the evidence of use within Mr Long’s statement is directed at use outside the relevant date and outside the UK and EU as already outlined. This is not relevant because any reputation that the earlier mark has is one which must cause the UK public to make a link between the marks. Therefore any reputation outside of the UK or EU cannot assist the Opponent’s case.

95. The Applicant concedes that the Opponent has a reputation but only for swimming costumes, swimming trunks and swimming goggles. However, in light of the evidence filed I consider that the Opponent’s reputation extends beyond this. In relation to the Opponent’s goods in classes 9,18 and 25 the Opponent’s figurative Speedo mark is a very famous mark for swimwear, swimming caps, earplugs, nose clips, swimming bags, wetsuits, goggles, swimming training apparatus (such as floats, snorkels and paddles/flippers). The Opponent’s evidence indicates that in the five years leading up to the date of the application its minimum sales amounted to over £24 million in each of those five years, for swimming related goods (as set out in paragraph 13 of Mr Long’s statement). The Opponent has sponsored major sporting events to include the Olympic games for at least the last eighty years. Such was the excitement and publicity surrounding the London 2012 Olympic games that I cannot imagine anyone within the UK at that time not being aware of the Olympics within this country. Since the Opponent at that time sponsored a number of high profile swimmers, who competed in the 2012 games, to include Rebecca Adlington and Michael Phelps, the viewing figures for those swimming events alone would be significant and therefore the UK

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<sup>32</sup> *General Motors* para 28

public's exposure to the mark during this time would be enormous. The Opponent has claimed that it is the world's leading swimwear brand and I accept this statement. The goods referred to in relation to its reputation display Speedo's figurative arrow mark on the products themselves. The evidence filed demonstrates that with or without the arrow device the mark Speedo has become associated with swimming products.

96. For the reasons already given, I am satisfied that the mark's reputation in the UK is at the highest level for *swimwear, swimming caps, sliders, earplugs, nose clips, swimming/sports bags, wetsuits, goggles, swimming training apparatus (such as floats, snorkels and paddles/flippers) and retail services relating to the aforesaid* but not for clothing, headgear, footwear, bags, sunglasses, gymnastic and fitness articles/apparatus at large. No evidence was filed, or a reputation claimed in relation to its goods in classes 3 and 16.

### **Link**

97. The next consideration is whether the public will make the necessary link between the marks. The relevant public is the public at large for the majority of the goods and services under consideration, who are deemed to be reasonably informed and reasonably observant and circumspect. The factors to be taken into account are those as set out in *Intel*,<sup>33</sup> which I shall go through in turn.

#### *The degree of similarity between the conflicting marks.*

98. My findings at paragraphs 52 to 61 apply equally here and I adopt those findings.

#### *The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services and the relevant section of the public.*

99. I have compared the respective goods and services at paragraphs 33 to 41. I found the majority of the Applicant's goods and services in classes 9, 18, 25 and 35 to be either identical or similar to a medium degree. I found those goods in classes 3 and 16 as outlined in paragraph 83 and 84 to be dissimilar. The opposition under section 5(3), however, is directed against all of the Applicant's goods and services and

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<sup>33</sup> *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU)

therefore I shall consider those services as applied for in classes 35 and 41 which have not already been addressed.

### **Class 35**

*Advertising; Publicity; Bill-posting; Business management of sports people; Commercial administration of the licensing of the goods and services of others; Television advertising; Outdoor advertising.*

100. These services will not be considered to be part and parcel or ancillary to the Opponent's retail services. They are services in connection with advertising, marketing and promotion of a business or management services directed towards a business user. The Applicant's services provide others, particularly businesses with assistance in promoting their goods/services and are normally provided by specialist companies not generally provided in the same place as retail services. The fact that a retailer may advertise itself or its own goods does not mean that it offers such services to others. The Applicant's services are different in nature, purpose and user. They are neither in competition nor are complementary. They are dissimilar.

### **Class 41**

*Teaching; Physical education; Instruction services; Coaching [training]; Organisation of competitions [education and/or entertainment]; Organisation of sporting competitions; Educational services; Health club services [health and fitness training]; Rental of skin diving equipment; Entertainer services.*

101. These services, albeit that they could be in the field of sports, are dissimilar to the Opponent's goods and retail services since they cover organisation of events and training/coaching type services. Whilst the Opponent's goods and retail services in the field of swimming are sports related, there is insufficient similarity between them other than (at a superficial level) an overlap in user. They differ in nature, purpose, method of use and channels of trade. They are neither complementary nor in competition.

102. The average consumer of the relevant goods and retail services as I have found above will be a member of the public or a business user paying at least an average degree of attention in the purchasing process although slightly higher for the advertising services and some technical goods. In either case the selection process will be mainly visual.

The strength of the earlier marks' reputation.

103. The earlier mark has a strong reputation, at its highest, for those items as outlined in para 96.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use.

104. I have already found that the earlier marks have a high degree of enhanced distinctive character for those goods and retail services as outlined.

Whether there is a likelihood of confusion

105. I have found that there is a likelihood of confusion between those goods and services that were identical and similar.

106. Whilst the level of similarity required for the public to make a link between the marks for the purposes of section 5(3) may be less than the level of similarity required to create a likelihood of confusion it, nevertheless, requires the relevant section of the public to make a connection between those marks in order for the types of injury to arise.<sup>34</sup> I have already concluded that the Opponent's Speedo marks have a high level of enhanced distinctive character and that there would be a likelihood of confusion between the marks for swimming related goods and retail services relating to the same. Given that visual considerations would dominate in the purchasing process I consider that the Opponent's reputation is sufficiently strong that despite the contested mark not being identical, the Opponent's marks will be brought to mind by consumers, for those goods and services found to be identical/similar, as they are likely to recognise that the later mark is based on the earlier marks.

107. Despite my earlier findings in relation to the Applicant's class 41 services, I nevertheless consider that where those services relate to the sport of swimming, a connection will still be made to the Opponent's marks, such is its strong reputation in this field. Even though these services are dissimilar, the Opponent has filed cogent evidence that it sponsors high profile athletes, major competitions and events in the field of swimming and therefore I consider that if the Applicant's services were related to swimming the earlier marks will be brought to mind. I consider that this applies to

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<sup>34</sup> *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P

all the Applicant's class 41 services. There is sufficient similarity between the marks for the necessary link to be made.

108. However, for the goods and services I found to be dissimilar in classes 3, 16 and 35 there is no reason for this to be the case. I do not consider that this strong reputation would extend across all categories of goods and services especially where the later mark is not SPEEDO. The Applicant's goods and services as identified in classes 3, 16 and 35 are so different to the goods and services for which the Opponent claims a reputation that there is no reason for the relevant public to bring to mind the earlier marks. The relative distance between these goods and services is too great for the relevant public to make a connection. Even if I am wrong in this regard, any bringing to mind would in my view be fleeting at best and certainly insufficient to lead to any of the heads of damage arising. The size of its reputation and the strength of the link would not be such, as to extend to the goods and services that I found to be dissimilar in these classes.

### **Damage**

109. I must now assess whether any of the three pleaded types of damage arise. The Opponent argues that "the possibility of detriment to the reputation of the Opponent .. is very probable...The consumer may take the false view that the Opponent has entered into an economical venture or arrangement with a Chinese partner or that the Opponent is connected with the Applicant's business in some way... Should products bearing the Applicant's mark be of inferior quality this would be damaging to the Opponent's business and to its proud reputation. It is clear that the Applicant is seeking to benefit from the power of attraction, the reputation and the prestige of the SPEEDO marks and to exploit without paying any financial compensation the marketing effort expended by the Opponent over many years in order to create and maintain the mark's image."

### **Unfair Advantage**

110. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

111. In *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods offered under the later trade mark was required to establish unfair advantage. This, however, may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark.<sup>35</sup>

112. In *Lonsdale Sports Limited v Erol*, [2013] EWHC 2956 (Ch), Norris J. rejected a claim that there was a likelihood of confusion between the appellant's mark and the respondent's mark. However, he found that:

“34. As I have said above, at a first glance the block of text in the Respondent's Mark looks like something that Lonsdale might be connected with (a first impression soon dispelled in the case of the average consumer). But that first glance is important. Those who look at the wearer of a product bearing the Respondent's Mark might not get more than a glance and might think the wearer was clad in a Lonsdale product. The creation of that illusion might be quite enough for the purchaser of a "look-alike" product: indeed who but such a person would knowingly buy a "pretend" product? Further, it undoubtedly dilutes the true

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<sup>35</sup> *Claridges Hotel Limited v Claridge Candles Limited and Anor*, [2019] EWHC 2003 (IPEC).

"Lonsdale" brand by putting into circulation products which do not proclaim distinctiveness but rather affinity with a reputable brand.

113. I find that this to be the position in the decision in suit. The way in which the Applicant's mark has been based upon the Opponent's will in my view create a familiarity with consumers when confronted with the later mark, such that there is an increased chance of consumers buying the later mark's products (both the goods and the services) because of their perceived link with Speedo. In my view this would take unfair advantage of the earlier marks' reputation and gain a foothold in the industry quickly, without having to make an equivalent investment or marketing effort themselves. The economic behaviour of customers would change leading to a commercial advantage being gained by the Applicant.

#### **Detriment to Repute**

114. Detriment to repute or tarnishing is a reduction in the attractive power of the earlier mark caused by the use of the later mark. Whilst there is some evidence produced regarding the technical and high performance nature of the Opponent's swimwear and goggles there is nothing to suggest by contrast that the quality of the Applicant's goods are substandard or inferior. Therefore it is unclear to me that there would be any detriment to the repute of the earlier marks. There does not appear to be any evidence of negative associations between the image of the later mark which would harm the image of the earlier mark. I am not satisfied that this head of damage is therefore made out.

#### **Detriment to distinctive character**

115. Detriment to distinctiveness of a mark only covers the categories of goods/services for which the mark has a reputation.<sup>36</sup> Therefore having already found in favour of the Opponent in relation to unfair advantage being taken, the Opponent is not in any better position under this head of damage for those goods and services where a reputation was not found.

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<sup>36</sup> *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

### **Section 5(3) conclusion**

116. The Opponent's reliance on section 5(3) does not improve its level of success beyond those goods and service that I found to be identical/similar under section 5(2)(b), other than in relation to the Applicant's services in class 41 where they relate to the sport of swimming. On this basis I need not consider any further marks relied upon under this ground. The opposition does not succeed in relation to those goods and services, I found to be dissimilar in classes 3, 16 and 35.

### **Section 5(4)**

117. Having reached a clear decision under sections 5(2)(b) and 5(3), in relation to those goods and services that were identical/similar and the Applicant's class 41 services where they relate to the sport of swimming, I need not consider the Opponent's opposition under section 5(4)(a) as it is unlikely to improve its position under this ground for those goods and services that I found to be dissimilar or where no proof of use was found. However, I will consider the matter briefly.

118. Section 5(4)(a) reads as follows:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met.”

119. For a claim under section 5(4)(a) to succeed the Applicant must demonstrate goodwill, misrepresentation and damage. 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)."

### **Relevant date**

120. The Opponent's claim under section 5(4)(a) must be determined as at the "relevant date". In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O410-11, Daniel Alexander QC, sitting as the Appointed Person, considered what constituted the relevant date for the purposes of this section and concluded as follows:

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

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

121. There is no indication that the applied for mark has been used prior to the application date in the UK and therefore the relevant date is 28 April 2020. The Opponent claims that its four unregistered signs have been used throughout the UK for the following goods since 1960 and 1990.

Swimwear, clothing, footwear; headwear; swimming apparatus, fitness apparatus, bags, towels, swimming goggles, eyewear, diving apparatus,

watches, mobile apps, media players, measuring and timing apparatus, sports clocks, swimming tuition services, coaching services, sporting events, retail services.

## **Goodwill**

122. I bear in mind the caselaw relating to the concept of goodwill as explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223, *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC) and *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat). Goodwill arises out of trading activities. Based on the evidence filed, I find that the Opponent has been trading on a substantial scale in the UK in relation to swimming related products and retail services. The Applicant concedes that the Opponent has goodwill but only in relation to swimming costumes, swimming trunks and swimming goggles. For the reasons set out previously, I find that the Opponent has demonstrated a substantial goodwill in the UK prior to the relevant date which extends beyond these limited goods, but only in relation to those goods and services identified at paragraph 96. I also consider that the signs relied upon were distinctive of that goodwill.

## **Misrepresentation**

123. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. set out the relevant test namely 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.”

124. I note that the test for misrepresentation requires a substantial number of members of the public to be deceived and that this test differs to the one undertaken for a likelihood of confusion where it necessitates that the average consumer is confused. However, in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether in reality the difference between the two legal tests would produce different outcomes. In light of my assessment regarding the similarities between the marks I believe this to be the case here. I am satisfied that a substantial number of the Opponent's customers or potential customers would be deceived. Applying a different legal test to that undertaken under section 5(2)(b), I nevertheless come to the same conclusion regarding the same goods and services. Having found goodwill and misrepresentation it follows that damage would arise leading to a reasonably foreseeable diversion of sales from the Opponent to the Applicant, resulting in the Opponent suffering financial loss.<sup>37</sup>

## **Overall Conclusion**

125. The opposition has succeeded in part under sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Subject to any successful appeal, the application shall be refused for the following goods and services:

Class 9: Cameras; Divers' masks; Diving suits; Breathing apparatus for underwater swimming; Ear plugs for divers; Gloves for divers;

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<sup>37</sup> *Bocacina Limited v Boca Cafés Limited, Dercio De Souza Junior, Malgorzata De Souza* [2013] EWHC 8090 (IPEC)

Nose clips for divers and swimmers; Computers; Sunglasses; Spectacles.

Class 18: School bags; Shopping bags; Suitcases; Backpacks; Bags; Business card cases; Walking sticks; Trunks [luggage]; Pocket wallets; Handbags.

Class 25: Clothing; Clothing for gymnastics; Waterproof clothing; Bathing suits; Scarves; Shoes; Head wear; Hosiery; Girdles; Gloves [clothing].

Class 35: Procurement services for others [purchasing goods and services for other businesses]; Provision of an online marketplace for buyers and sellers of goods and services; Sales promotion for others;

126. The opposition has failed in relation to the following goods and services which may proceed to registration.

Class 3: Soap; Scented water; Shining preparations [polish]; Ethereal oils; Lipsticks; Cleaning preparations; Cosmetics; Cosmetics for animals; Dentifrices; Incense.

Class 16: Paper; Printed publications; Printed matter; Periodicals; Advertisement boards of paper or cardboard; Albums; Magazines; Newspapers; Bags [envelopes, pouches] of paper or plastics, for packaging; Posters.

Class 35: Advertising; Publicity; Bill-posting; Business management of sports people; Commercial administration of the licensing of the goods and services of others; Television advertising; Outdoor advertising.

127. Section 5A of the Act, requires me to refuse an application for registration of a trade mark, only for those goods and services where grounds exist for such a refusal. In light of my findings at paragraph 107 relating to the Applicant's services in class 41, the opposition succeeds but only where those services relate to the sport of swimming.

I consider therefore that the Applicant's class 41 services may also proceed to registration, but only with the following limitation.

Class 41: Teaching; Physical education; Instruction services; Coaching [training]; Organisation of competitions [education and/or entertainment]; Organisation of sporting competitions; Educational services; Health club services [health and fitness training]; Rental of skin diving equipment; Entertainer services; but not including any of the aforesaid services relating to the sport of swimming.

### **Costs**

128. As the parties have had roughly an equal measure of success, I order both sides to bear their own costs.

Dated this 12th day of August 2021

Leisa Davies

For the Registrar

## Appendix

Opponent's goods and services as relied upon under s.5(2)(b)

EUTM no 493445 (first)

SPEEDO

Class 3: Soaps, perfumery, essential oils, cosmetics, hair lotions, shampoos, conditioners, products for styling of the hair, bath and shower gels, moisturizers, cosmetic hand and body lotions, creams and oils; suntanning preparations, suntanning lotions, creams and oils (not for medical use); none of the aforesaid being preparations for oral, dental and pharyngeal care.

Class 9: Nautical, life-saving apparatus and instruments, divers suits and gloves, swimmers and divers earplugs, wetsuits for diving, swimming jackets, bathing floats, life buoys, life belts, breathing apparatus for underwater swimming, goggles, spectacles, spectacle glasses; sunglasses.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags, umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25: Clothing, footwear and headgear.

UKTM no. 1527334 (second)

SPEEDO

Class 9: Suits and gloves, all for divers, ear plugs for swimmers and for divers, wet suits for diving, swimming jackets, bathing floats, lifebuoys, goggles; breathing apparatus for underwater swimming, marking buoys, divers' apparatus, divers' masks, floats for swimming, life-saving apparatus and equipment, lifebelts, lifejackets, life-saving rafts, swimming belts; cameras, films (exposed), compact disks, audio and video tapes; spectacles, spectacle frames, sun-glasses, cases for spectacles and sun-glasses; teaching apparatus; all included in Class 9.

Class 16: Books, calendars, catalogues, flags of paper; graphic prints, representations and reproductions; magazines, handbooks, pamphlets,

periodicals, pictures, photographs, playing cards, posters, decalcomanias, sign boards of paper or cardboard, teaching materials, towels of paper, transfers; all included in Class 16.

EUTM no. 1063208 (third)

**SPEEDO**

Class 9: Suits and gloves, all for divers, ear plugs for swimmers and for divers, wet suits for diving, swimming jackets, bathing floats, life-buoys and goggles.

Class 18: Bags included in Class 18, suitcases, satchels, knapsacks, purses (not of precious metal or coated therewith), pocket wallets and umbrellas.

Class 25: Articles of sports clothing, shirts, blouses, singlets, bathing caps, vests, trousers, trouser suits, slacks, shorts, skirts, dresses, jumpers, tracksuits, pullovers, cardigans, coats, blazers, jackets, pyjamas, nightdresses, wet suits for water skiing, articles of underclothing, socks for wear, stockings; tights, swimwear and footwear, all being articles of clothing.

EUTM no. 3386241( fourth)

**SPEEDO** 

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; printed publications; books; magazines; periodicals; brochures; catalogues; photographs.

UKTM no. 3271996 (fifth)

**SPEEDO**

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images or other data; magnetic data carriers, recording discs; compact

discs, DVDs and other digital recording media; computer software; mobile application software; mobile apps; application software; application software for use with smartphones and mobile devices in the fields of sports and fitness; mobile application software for creating personalised fitness training programs; personal electronic devices used to track athletic performance, goals and statistics; wearable activity trackers; smart watches; watchbands for communication of data to mobile phones and other electronic devices; global positioning system (GPS) apparatus for tracking athletes during athletic activities; portable electronic devices for monitoring and analysing athletes' movement in sports; electronic apparatus for measuring, testing and enhancing athletic performance; electronic devices for sports coaching; electronic sports aids and electronic sports coaching aids; measuring apparatus with electric and electronic monitors used in sports activities; timing apparatus; apparatus for recording sounds and images used in sports activities; pedometers; electronic heart rate and electronic respiratory monitors (non-medical); swimming stroke counters; swimming goggles; sunglasses; spectacles; eyewear; cases for spectacles and sunglasses; ear plugs for divers and swimmers; nose clips for divers and swimmers; life buoys; life belts; diving suits and diving gloves; breathing apparatus for underwater swimming; swimming snorkels; divers' masks; cameras; digital music players; MP3 players; bags and cases adapted or shaped to contain digital music players; headphones; earphones; audio speakers; chargers for electric batteries; solid state memory apparatus; parts, fittings and accessories for the aforementioned goods.

UKTM no. 3445905 (sixth)



(series of five)

Class 9: Swimming goggles; sports goggles; sunglasses; spectacles; eyewear; optical apparatus; weighing, measuring, life-saving and teaching apparatus and instruments; swimmer and diver earplugs; diving suits and diving gloves; nose clips;

swimming snorkels; diver masks; swimming masks; life buoys; life belts; breathing apparatus for underwater swimming; computer software; mobile application software; global positioning system (GPS) apparatus for tracking athletes during athletic activities; portable electronic devices for monitoring and analysing athletes' movement in sports; electronic measuring apparatus for measuring, testing and enhancing athletic performance; electronic sports coaching aids; smartwatches; apparatus for recording sounds and images used in sports activities; pedometers; lap counters; electronic heart rate recorders and electronic respiratory monitors (non-medical); swimming stroke counters; portable audio and video media players; bags and cases adapted or shaped to contain portable audio and video media players; headphones; earphones; audio speakers; cameras; digital music players; MP3 players; parts and fittings for all the aforesaid goods.

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith; jewellery, precious stones; horological and chronometric instruments; clocks; watches; stopwatches; watch bands; watch cases; watch straps; parts and fittings for all the aforesaid goods.

Class 18: Leather and imitations of leather and bags, holders and carriers made of these materials; bags; gym bags; sports bags; shoulder bags; beach bags; backpacks; rucksacks; satchels; holdalls; wallets; purses; umbrellas; trunks; portfolios; suitcases; luggage bags; travel bags; attaché cases; briefcases; tote bags; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; parts and fittings for all the aforesaid goods.

Class 25: Clothing; footwear; headgear; swimwear; sportswear; triathlon wear; belts for wear; parts and fittings for all the aforesaid goods.

Class 28: Games and playthings; gymnastic and sporting articles; boards for swimming; paddles for swimming; buoys for swimming training; rubber buoys for swimming; flippers and duck-feet for swimming; flotation jackets for use in swimming; inflatable armbands for swimming; snorkels for use in swimming; surfboards; kickboards; swimming mitts; swimming fins; body toning apparatus;

body training apparatus; aquatic exercise steps; aquatic fitness exercise belts; aqua planer paddles; aqua fitness paddles; aquatic exercise chutes; balls; floats for bathing and swimming; transportable swimming pools; parts and fittings for all the aforesaid goods.

Class 35: Retail services, retail store services (including electronic shopping retail services) and wholesale services connected with the sale of swimwear, sportswear, triathlon wear, swimming apparatus, swimming goggles, sports goggles, sunglasses, spectacles, eyewear, optical apparatus, weighing, measuring, life-saving and teaching apparatus and instruments, swimmers and divers earplugs, diving suits and diving gloves, nose clips, swimming snorkels, divers' masks, swimming masks, life buoys, life belts, breathing apparatus for underwater swimming, computer software, mobile application software, portable electronic devices for monitoring and analysing athletes' movement in sports, global positioning system (GPS) apparatus for tracking athletes during athletic activities, electronic measuring apparatus for measuring, testing and enhancing athletic performance, electronic sports coaching aids, smartwatches, apparatus for recording sounds and images used in sports activities, pedometers, lap counters, electronic heart rate recorders and electronic respiratory monitors (non-medical), swimming stroke counters, portable audio and video media players, portable media player cases, digital music players, MP3 players, headphones, earphones, audio speakers, bags, gym bags, sports bags, shoulder bags, beach bags, backpacks, rucksacks, satchels, holdalls, wallets, purses, umbrellas, trunks, portfolios, suitcases, luggage bags, travel bags, attaché cases, briefcases, tote bags, travelling bags, umbrellas, parasols, walking sticks, clothing, footwear, headgear, belts for wear, towels, games and playthings, gymnastic and sporting articles, boards for swimming, paddles for swimming, buoys for swimming training, rubber buoys for swimming, flippers and duck-feet for swimming, flotation jackets for use in swimming, inflatable armbands for swimming, snorkels for use in swimming, surfboards, kickboards, swimming mitts, swimming fins, swimming masks, body toning apparatus, body training apparatus, aquatic exercise steps, aquatic fitness exercise belts, aqua planer paddles, aqua fitness paddles, aquatic exercise chutes, balls, floats for bathing and swimming and transportable swimming pools; retailing,

wholesaling, advertising, marketing and business promotion services provided online or via a communications network; provision of information, advisory and consultancy services in relation to the aforementioned services.

UKTM no. 1422588 (seventh mark)

The logo for SPEEDO, featuring the word "SPEEDO" in a bold, serif font, followed by a stylized black arrow pointing to the right.

Class 9: Suits and gloves, all for divers, earplugs for swimmers and for divers, wetsuits for diving and for underwater swimming, swimming jackets, bathing floats, life buoys and goggles;

Class 18: bags, knapsacks;

Class 25: articles of sports clothing; bathing caps, vests, shorts, tracksuits, jackets, wet suits for water skiing; articles of underclothing; socks for wear, swimwear and footwear;

Class 28: gymnastic and sporting articles (other than clothing); hand paddles and flippers, all for use as swimming aids

Opponent's goods subject to proof of use as pleaded by the Applicant

First mark EUTM no 493445 SPEEDO

Class 3: Soaps, perfumery, essential oils, cosmetics, hair lotions, shampoos, conditioners, products for styling of the hair, bath and shower gels, moisturizers, cosmetic hand and body lotions, creams and oils; suntanning preparations, suntanning lotions, creams and oils (not for medical use); none of the aforesaid being preparations for oral, dental and pharyngeal care.

Class 9: Nautical, life-saving apparatus and instruments, divers suits and gloves, swimmers and divers earplugs, wetsuits for diving, swimming jackets, life buoys, goggles (except swimming and diving goggles), spectacles, spectacle glasses; sunglasses.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags, umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25: Clothing, footwear and headgear apart from swimming costumes, swimming trunks, swimming shorts, swimming suits, swimming caps, flip flops, sliders (footwear) and footwear adapted for use in the water.

Second mark SPEEDO UKTM no. 1527334

Class 9: Suits and gloves, all for divers, ear plugs for swimmers and for divers, wet suits for diving, swimming jackets, ~~bathing floats~~, lifebuoys, goggles (except swimming and diving goggles); breathing apparatus for underwater swimming, marking buoys, divers' apparatus, ~~divers' masks~~, ~~floats for swimming~~, life-saving apparatus and equipment, lifebelts, lifejackets, life-saving rafts, ~~swimming belts~~; cameras, films (exposed), compact disks, audio and video tapes; spectacles, spectacle frames, sun-glasses, cases for spectacles and sun-glasses; teaching apparatus; all included in Class 9.

Class 16: Books, calendars, catalogues, flags of paper; graphic prints, representations and reproductions; magazines, handbooks, pamphlets, periodicals, pictures, photographs, playing cards, posters, decalcomanias, sign boards of paper or cardboard, teaching materials, towels of paper, transfers; all included in Class 16.

Third mark EUTM no. 1063208 SPEEDO

Class 9: Suits and gloves, all for divers, ear plugs for swimmers and for divers, wet suits for diving, swimming jackets, ~~bathing floats~~, life-buoys and goggles (except swimming and diving goggles).

Class 18: ~~Bags included in Class 18~~, suitcases, satchels, ~~knapsacks~~, purses (not of precious metal or coated therewith), pocket wallets and umbrellas.

Class 25: Articles of sports clothing, shirts, blouses, singlets, bathing caps, vests, trousers, trouser suits, slacks, shorts, skirts, dresses, jumpers, tracksuits, pullovers, cardigans, coats, blazers, jackets, pyjamas, nightdresses, wet suits for water skiing, articles of underclothing, socks for wear, stockings; tights, swimwear and footwear, (except swimming costumes, swimming trunks, swimming shorts, swimming suits, swimming caps, flip flops, sliders (footwear) and footwear adapted for use in the water) -all being articles of clothing.

Fourth mark EUTM no. 3386241

**SPEEDO** 

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; printed publications; books; magazines; periodicals; brochures; catalogues; photographs.