

O-832-22

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3589286
BY NICOLA BLAKELEY
TO REGISTER**



AS A TRADE MARK IN CLASSES 9, 16, 18, 21, 25, 28, 35 & 41

AND

OPPOSITION THERETO (UNDER NO. 425794)

BY

LIFESTYLE EQUITIES C.V.

BACKGROUND

1) On 03 February 2021, Nicola Blakeley ('the applicant') applied to register the trade mark shown on the cover page of this decision. The goods and services covered by that application currently reads as follows:

Class 9: Apparatus for recording, transmission and reproduction of sound, transmission and reproduction of images; polo helmets; all used within a polo business.

Class 16: Paper goods, namely, letterheaded paper, postcards, flyers, posters, printed advertisements, books, instruction manuals, chukka lists, tournament lists, paper bags; Cardboard goods, namely, cardboard gift boxes for prizes; all used within a polo business.

Class 18: Leather goods and imitations of Leather goods namely: polo whips; polo harness equipment; polo saddlery equipment; polo saddles; polo mallet bags; all used within a polo business.

Class 21: Equestrian combs; equestrian sponges; equestrian brushes; all used in the context of a polo business.

Class 25: Technical sports clothing worn by polo professionals within the sport of polo including technical polo shirts, technical polo white jeans, polo belts, polo base layers, polo gloves; polo boots; all used within a polo business.

Class 28: Polo balls, polo mallets; protective knee pads for use when playing polo; all used within a polo business.

Class 35: Advertising; business management; business administration; all used within a polo business.

Class 41: Education; providing of polo training; sporting activities; cultural activities; for use in a polo business.

2) The application was published in the Trade Marks Journal on 30 April 2021 and notice of opposition was later filed by Lifestyle Equities C.V. ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). It relies upon the following UK trade mark registration under the first two of those grounds:

UKTM No: 915737653



Class 3: Perfumes; colognes; body sprays; toilet water; soap; skin moisturizers and creams; shower gels, shaving creams, shaving lotions, shaving gels; shampoos; hair gels, hair creams; nail polish, nail polish remover; lipsticks, lip gloss, lip balms; skin lotions, facial lotions, body lotions, hand creams; deodorants and anti-perspirants; after shave lotions; home fragrances.

Class 9: Eyewear; eyeglasses and sunglasses; eyeglass- and sunglass frames; eyeglass- and sunglass cases; binoculars.

Class 14: Watches; watch straps, watch bands; jewellery; earrings, necklaces, rings, bracelets and pendants; cuff links.

Class 18: Luggage; hand bags; sport bags; beach bags; carry-on bags; clutch bags; trunks and travelling bags; school bags; shoulder bags; shopping bags; tote bags; rucksacks; backpacks; duffel bags; cosmetic bags, briefcases; suitcases; holdalls; purses; wallets; leather key chains; business card cases; umbrellas; parasols; walking sticks.

Class 21: Glassware for household purposes; household or kitchen utensils and containers (not of precious metal or coated therewith); crystal [glassware]; coffee sets; ceramics for household purposes; kitchenware, cooking pot sets; dishware; porcelain and earthenware, all the aforesaid goods included in class 21; tableware, other than knives, forks and spoons; services [dishes]; tea services [tableware]; pots; crockery; pottery; cups; teapots; table plates; drinking vessels; beverage glassware; saucers; plates; dishes; bowls; mugs; coolers; corkscrews; decanters.

Class 24: Towels; bath towels; hand towels; kitchen towels; Beach towels; bath linen; bed blankets; bed clothes; bed covers; bedspreads; duvet covers; bed linen; pillowcases; pillow covers; face towels of textile; handkerchiefs of textile; household linen; linen cloth; place mats, not of paper; sheets [textile]; tablecloths, not of paper; table linen, not of paper; tablemats, not of paper; table napkins of textile; textile material; towels of textile; curtains.

Class 25: Clothing; suits; tuxedos; blazers; vests; blouses; overalls; pullovers; sweaters; sweater vests; sweatpants; sweatshirts; T-shirts; shirts; polo-shirts; shirts and casual tops with long and short sleeves; halter tops; sleeveless shirts; sport shirts; tops for exercise; jeans; pants; trousers; shorts; skirts; coats; jackets (clothing); outerclothing; ponchos; raincoats; sport coats; bathing suits; swimsuits; bikinis; bikini tops; Bermuda shorts; beach clothes; bath robes; body linen (garments); underwear; undergarments; undershirts; bodysuits; boxer shorts; bras; bustiers; hosiery; stockings; lingerie; leggings; night clothes; nightgowns; nightshirts; pajamas; panties; dresses; dressing gowns; belts (clothing); socks; footwear; athletic shoes; beach shoes; booties; espadrilles; flip-flops; gym boots; heels; pumps; sandals; shoes; slippers;

sporting and gymnastic shoes; headwear; bandannas; baseball caps; caps; hats; headbands.

Filing date: 10 August 2016

Date of entry in the register: 09 January 2017

3) It is claimed that the respective goods and services are either identical, similar or complementary and the respective marks are similar such that there exists a likelihood of confusion upon initial interest, at the point of sale and post-sale under section 5(2)(b) of the Act. It is also claimed that the earlier mark enjoys a reputation in the UK in respect of all the goods covered by it and that use of the contested mark will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier mark.

4) The trade mark relied upon by the opponent is an earlier mark, in accordance with section 6 of the Act. As the earlier mark had not been registered for more than five years at the date the application was filed, it is not subject to the proof of use conditions as per Section 6A of the Act.

5) Under section 5(4)(a) of the Act, the opponent relies upon use of a sign which is identical to the registered mark relied upon under sections 5(2)(b) and 5(3) of the Act. That sign is said to have been used throughout the UK since 1982 in relation to the same goods which are covered by its registered mark. It is claimed that use of the applicant's mark, in respect of the goods and services applied for, will lead to misrepresentation, including that caused by initial interest confusion, leading to damage to the opponent's goodwill associated with its earlier sign.

6) The applicant filed a counterstatement denying the grounds of opposition. It provides the following statement which is later supported with further reasoning:

"2. In summary, the marks, goods and services are insufficiently similar to give rise to a conflict sustaining this Opposition. The nature of the Applicant's equestrian polo business and customers are distinctly different, limiting any

likelihood of confusion with the Opponent's products and services. The Applicant denies there exists any alleged reputation or goodwill deriving from the Opponent's registration in the territory for the Applicant to derive benefit from."

7) The opponent is represented by Brandsmiths. The applicant, Ms Blakeley, states, in emails filed at the tail-end of these proceedings, that she is a freelance solicitor. She has represented herself in these proceedings but states that she has also sought legal assistance and advice in connection with them from a KC (formerly QC). I will keep this in mind when I deal with the matter of costs at the end of this decision. Both parties filed evidence. The opponent's evidence consists of a witness statement in the name of Daniel Haddad dated 14 February 2022 and exhibit DH1 thereto. The applicant's evidence consists of a witness statement in the name of Nicola Blakeley dated 15 April 2022 and Exhibits 1-13 thereto. I have read all the parties' evidence and will refer to it, as appropriate, if, and when, it becomes germane to the issues before me to be determined in this case. Neither party requested to be heard but both filed submissions in lieu, including, I note, written submissions in reply filed by the applicant in response to the opponent's submissions in lieu. I have also read all those submissions and will refer to them if, and when, I consider it appropriate to do so. I now make this decision after careful consideration of all the papers before me.

DECISION

Comparable marks – relevance of evidence pertaining to the EU

8) The mark relied upon by the opponent is a 'comparable' mark and the evidence before me purporting to show enhanced distinctiveness and reputation includes use in the EU as well as the UK. In this regard, I note that Tribunal Practice Notice 2/2020 states:

'Comparable marks – use and reputation

4. Where, to the extent set out above, comparable marks are relied on in opposition/invalidation proceedings, there will be circumstances when the use provisions apply, or where a reputation is claimed under section 5(3) of the Act. Comparable marks may also be the subject of revocation claims based on non-use. In such circumstances, it may still be possible to rely on evidence of use in the EU, as set out below:

- ...
- where it is asserted that a comparable mark has a reputation under section 5(3), and that reputation falls to be considered at any time before IP Completion Day, use of the corresponding EUTM in the EU will be taken into account in determining whether the comparable mark had a reputation at the relevant date.’

I will bear this in mind in the instant case.

Cases relies upon by the parties involving the opponent and the same earlier mark

9) I consider it appropriate to make clear at the outset that, in my view, the various cases referred to by the parties involving the same earlier mark of the opponent, which has been relied upon in a number of other cases against different marks belonging to third parties, have no bearing on the decision before me. This is because I must make the assessment of the grounds before me based on the particular evidence before me together with the similarities between the actual marks before me and on the basis of the actual goods applied for by the applicant as compared to those covered by the opponent’s earlier registered mark. It appears to me that none of the court cases referred to by the parties are completely on “all fours” with the instant case. This is all the more so in relation to the various opposition cases listed in the opponent’s evidence¹ which give no indication of the particular grounds that were pleaded or the precise goods that were the subject of consideration or the evidence that may have been filed.

Section 5(2)(b)

10) Section 5(2)(b) of the Act states:

¹ See the table at pages 49-55 of exhibit DH1 of the opponent’s evidence

“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.

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

Case law

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

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

12) 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 Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Comparison of goods and services

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

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

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

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

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

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

15) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking..”

In *Sanco SA v OHIM* Case T-249/11, the General Court ('GC') found that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

16) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05) ('Meric')*, where the GC held that:

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

17) I will begin by assessing the similarity between the respective goods in class 25, before considering the similarity between the applicant's other goods and services with those of the opponent.

Class 25

Technical sports clothing worn by polo professionals within the sport of polo including technical polo shirts, technical polo white jeans, polo belts, polo base layers, polo gloves; polo boots; all used within a polo business.

18) These goods all fall within the opponent's 'clothing', 'belts' and 'footwear'. The respective goods are therefore identical as per *Meric*. I make this finding on the basis that both parties specifications cover 'technical polo-wear'.

19) I should also state, for reasons that will become apparent, that I consider the non-technical polo-wear covered by the opponent's 'clothing', in the form of casual wear, to be highly similar to the applicant's goods given the similarity in physical nature, purpose (to clothe the body) and methods of use and that there may be some convergence in trade channels.

Class 28

Polo balls, polo mallets; protective knee pads for use when playing polo; all used within a polo business.

20) I note that the opponent, having highlighted that its 'clothing' includes 'technical polo-wear' (which I have already accepted above), goes on to state the following:

20. As to the remainder, it is clear that a brand of technical polo-wear is also likely to offer polo equipment in classes 9 (being protective equipment) and 28 (being sporting apparatus). This follows as a natural consequence and is evidenced by the Applicant's coverage for these goods in classes 9, 25 and 28. It is often the case that a sports brand will offer lounge/casual wear, sports wear (non-technical) and technical sportswear alongside a range of sporting goods such as protective wear, equipment, towels, bags and accessories such as toiletries and watches/jewellery and we invite you to accept that as a matter of judicial notice based upon your own experience of the market for consumer sporting goods and the example of the Applicant.

21. Given that as a matter of construction the Opponent's protection for clothing includes technical polo-wear then as a natural consequence each of the items in classes 9, 18, 25 and 28 must be similar.

21) I accept, as the applicant's own evidence shows, that a business selling technical sportswear may also sell certain other sporting goods/apparatus. However, this is just one relevant factor in assessing the overall similarity between the respective goods. As the case law above indicates, I must also be mindful of the respective nature, method of use, intended purpose and whether the goods are in competition or complementary. Although the opponent's 'technical polo-wear' (which is covered by its term 'clothing') may share trade channels with all the applicant's goods in class 28, the applicant's 'polo balls' and 'polo mallets' are obviously very different in nature, intended purpose and methods of use to the opponent's goods and neither are they in competition or complementary in the sense that one is important for, or indispensable to, the use of the other. I find a low degree of similarity between the opponent's 'clothing' (on the basis that it covers 'technical polo-wear') and 'polo balls' and 'polo mallets'.

22) As to the applicant's 'protective knee pads for use when playing polo', these are closer in similarity to the opponent's goods because both are intended to be worn on the person and may be made of similar materials. There is therefore some overlap in terms of nature and method of use. The applicant's goods have the sole purpose of protecting against injury. The applicant's own evidence indicates that certain items of technical polo-wear are designed to protect against/minimise injury, as well as having the obvious intended purpose of attiring the body². However, I cannot see that there is likely to be any real competitive relationship in play and nor is there any obvious complementarity between the respective goods. I find a medium-high degree of similarity between the opponent's 'clothing' (on the basis that it covers 'technical polo-wear') and the applicant's 'protective knee pads for use when playing polo'.

Class 18

Leather goods and imitations of Leather goods namely: polo whips; polo harness equipment; polo saddlery equipment; polo saddles; polo mallet bags; all used within a polo business.

² See, for example, Ms Blakeley's witness statement at paragraph 35

23) The applicant's 'polo mallet bags' fall within the opponent's 'sport bags'. They are therefore identical as per *Meric*.

24) Turning to the applicant's 'polo whips', 'polo harness equipment', 'polo saddlery equipment' and 'polo saddles' in class 18, the respective nature, intended purpose and methods of use are entirely different to all the opponent's goods (including its 'technical polo-wear' covered by its 'clothing') and they are not in competition or complementary in the sense described in the case law. Whilst I accept, as the applicant's evidence shows, that the goods may sometimes share trade channels (e.g. all sometimes being sold by polo clubs/businesses), this factor alone is not sufficient to conclude that the respective goods are similar overall. I find no similarity between the applicant's whips, harnesses and saddlery and the opponent's goods.

Class 09

Apparatus for recording, transmission and reproduction of sound, transmission and reproduction of images; polo helmets; all used within a polo business.

25) The applicant's 'polo helmets' are items of headwear to be worn during the sport of polo to protect against the head against injury. They are similar to the opponent's 'clothing' (on the basis that those goods would cover 'technical polo-wear') because both parties' goods are intended to be worn on the person during the game of polo and are likely to share trade channels. They are though, unlikely to be in competition and nor are they obviously complementary. I find a medium-high degree of similarity between the opponent's 'clothing' (on the basis that this term covers 'technical polo-wear') and the applicant's 'polo helmets'.

26) Turning to the applicant's 'Apparatus for recording, transmission and reproduction of sound, transmission and reproduction of images', it is not obvious to me, and there is no evidence before me to show, that there is any similarity between those goods and any of the opponent's goods. I find no similarity between the applicant's 'Apparatus for recording, transmission and reproduction of sound, transmission and reproduction of images' and the opponent's goods.

Class 16

Paper goods, namely, letterheaded paper, postcards, flyers, posters, printed advertisements, books, instruction manuals, chukka lists, tournament lists, paper bags; Cardboard goods, namely, cardboard gift boxes for prizes; all used within a polo business.

27) It is not obvious to me, and there is no evidence before me to show, that there is any similarity between any of the applicant's class 16 goods and any of the opponent's goods. The mere fact that the applicant intends to use the goods 'within a polo business' does not make the respective goods similar when their respective nature, methods of use, intended purpose are borne in mind together with the lack of any obvious competitive or complementary relationship. I find no similarity between the applicant's class 16 goods and the opponent's goods.

Class 21

Equestrian combs; equestrian sponges; equestrian brushes; all used in the context of a polo business.

28) The applicant's class 21 goods are all for the purpose of brushing, combing or cleaning horses. The mere fact that they applicant intends to use them as part of a polo business does not make them similar to any of the opponent's goods bearing in mind their very different nature, methods of use and intended purpose and the lack of any competitive or complementary relationship between them. I find no similarity between the applicant's class 21 goods and the opponent's goods.

Class 35

Advertising; business management; business administration; all used within a polo business.

29) I can see no similarity between any of these services and the opponent's goods. Their respective nature, methods of use and intended purpose are different, it is not obvious to me that there would be any convergence of trade channels and they are not in competition or complementary. I find no similarity between the applicant's class 35 services and the opponent's goods.

Class 41

Education; providing of polo training; sporting activities; cultural activities; for use in a polo business.

30) While I accept that a polo club may sell polo-wear in addition to providing training services/sporting activities in the game of polo, the respective nature, methods of use and intended purpose of the applicant's services in class 41 is very different to the opponent's 'technical polo-wear' covered by its 'clothing'. I find a low degree of similarity between those goods and services.

31) There cannot be a likelihood of confusion where there is no similarity between the respective goods and services³. The ground under section 5(2)(b) must therefore fail, at this point, against the following goods and services of the applicant:

Class 9: Apparatus for recording, transmission and reproduction of sound, transmission and reproduction of images; all used within a polo business.

Class 16: Paper goods, namely, letterheaded paper, postcards, flyers, posters, printed advertisements, books, instruction manuals, chukka lists, tournament lists, paper bags; Cardboard goods, namely, cardboard gift boxes for prizes; all used within a polo business.

Class 18: Leather goods and imitations of Leather goods namely: polo whips; polo harness equipment; polo saddlery equipment; polo saddles; all used within a polo business.

³ Waterford Wedgewood v OHIM Case C-398/07

Class 21: Equestrian combs; equestrian sponges; equestrian brushes; all used in the context of a polo business.

Class 35: Advertising; business management; business administration; all used within a polo business.

Average consumer and the purchasing process

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

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

33) The average consumer for the goods and services I have deemed to be either identical or similar includes the general public and individuals who play polo, including professional polo players. The purchasing act will be primarily visual for all the goods at issue in classes 9, 18, 25 and 28 as they will be sought out through signage on the high street/at polo clubs or on-line or are likely to be selected after perusal of racks/shelves or from photographs/images on Internet websites or in catalogues. That is not to say though that the aural aspect should be ignored since the goods may sometimes be the subject of discussions with sales representatives, for example. The cost of those goods is likely to vary. However, factors such as size, material, comfort/fit, aesthetics and/or suitability for purpose are likely to be taken

account of by the consumer. Generally speaking, I find that at least a medium degree of attention is likely to be paid during the purchase for the aforementioned goods.

34) In terms of the applicant's class 41 services, the average consumer for these services is likely to consist members of the public who wish to observe polo-based activities and/or learn to play the game of polo and polo professionals looking to improve their skills. The cost of the services at issue is likely to vary but they are, generally speaking, unlikely to be very inexpensive or the subject of an impulse purchase. Rather, I would expect the purchase to be a reasonably considered one. On the whole, I would expect a medium to high degree of attention to be paid during the purchase. The services are likely to be sought out primarily by eye using the internet or brochures. However, I do not discount that some may be the subject of aural recommendations.

Comparison of marks

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

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

It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due

weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

36) The marks to be compared are:

Opponent's mark	Applicant's mark
 <p>The logo for the Beverly Hills Polo Club features a silhouette of a polo player on a horse, positioned centrally. Above the player, the words "BEVERLY HILLS" are written in a curved, serif font. Below the player, the words "POLO CLUB" are written in a straight, bold, serif font.</p>	 <p>The logo for Hipwood Polo features a silhouette of a polo player on a horse, positioned centrally. The player is holding a mallet high. Below the player, the words "Hipwood Polo" are written in a serif font. The horse's lower legs are decorated with red and white stripes.</p>

Overall impression

37) The opponent's mark consists of two elements. The first element is a polo player on horseback; the second element is the words BEVERLY HILLS POLO CLUB which naturally combine to form a unit despite BEVERLY HILLS being positioned above the device and POLO CLUB below it. Both elements have substantial visual impact. I find that both elements contribute roughly equally to the overall impression of the mark.

38) The applicant's mark also consists of two identifiable elements. The first element is a polo player on horseback; the second element is the words Hipwood Polo. The device takes up a large portion of the mark and has considerable visual impact. However, the words also have substantial impact. I find that both elements contribute roughly equally to the overall impression.

Comparison

39) Visually, both marks contain a device element of a polo player on horseback with the horse facing to the right and the polo players holding a polo mallet aloft above their heads. However, the stylisation of those elements is not the same with the applicant's device having a silhouette-type appearance and the opponent's device having a more lifelike and hand-drawn appearance. Although both marks contain the word POLO, the respective words BEVERLY HILLS and Hipwood are visually very different and the opponent's mark also contains the word CLUB which is absent from the applicant's mark. Overall, I find a medium degree of visual similarity between the marks.

40) Aurally, the respective device elements will not be articulated. The comparison is therefore between BEVERLY HILLS POLO CLUB on the one hand and HIPWOOD POLO on the other. The sole point of aural similarity is therefore the common articulation of the word POLO which occurs at the end/near the end of the marks. The beginnings of the marks are very different to the ear. This is an important factor because it is the beginnings of marks that will tend to have the greater impact upon the consumer's perception. The word CLUB is also entirely absent from the contested mark. Overall, I find no aural similarity between the marks or, if I am wrong on that, any similarity is very low.

41) Turning to the conceptual comparison, both marks share the concept of a polo player on horseback which, in turn, evokes the concept of the game of polo. I have no doubt that the average consumer will be well-aware that BEVERLY HILLS is a place in the United States of America. It follows that BEVERLY HILLS POLO CLUB is likely to immediately evoke the idea of a polo club in Beverly Hills in the USA. As for the words Hipwood Polo in the applicant's mark, Hipwood is not, as far as I am aware, the name of a place. Rather it has the appearance of a surname. In my view most average consumers are likely to perceive Hipwood as a surname. However, I acknowledge that there may be others who perceive it to be a place name, albeit an unfamiliar one. Hipwood Polo will, therefore, either be perceived as a polo business owned/run by a family/individual named Hipwood or as a polo business/club located in a place called Hipwood. Either way, this is a different concept to a polo club

located in Beverly Hills in the USA. At best, there is a low degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

42) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

43) I will deal first with the inherent distinctiveness of the earlier mark in relation to the technical polo-wear covered by the opponent’s broad term, ‘clothing’. In my view, for such goods the inherent distinctiveness of the device element is very low (if it has any distinctiveness at all), given that, in my view, it merely evokes the idea of the

game of polo which is not a distinctive concept for such goods. The device is also not stylised in such a way as to elevate its distinctiveness. The words BEVERLY HILLS POLO CLUB are distinctive for such goods to the extent that they designate a particular polo club i.e. one in Beverly Hills. Those words, however, have no more than an average degree of distinctiveness. It follows that, although the mark, as a whole, has an average degree of inherent distinctiveness for technical polo-wear, that degree of distinctiveness stems from the words BEVERLY HILLS POLO CLUB and not the device element (which, as I said, has very low, if any, distinctiveness). There is no evidence before me to indicate that there has been any use by the opponent of its earlier mark in relation to technical polo-wear (clothing specifically designed to be worn during participation in the sport of polo). I therefore find no enhanced distinctiveness for such goods.

44) I now turn to consider the inherent distinctiveness of the earlier mark for non-technical polo-wear (i.e. casual wear) which is also covered by the opponent's 'clothing'. For those goods, the device element is not so obviously non-distinctive given that the goods are not specifically intended to be worn during the game of polo. I find that both the device and the words BEVERLY HILLS POLO CLUB have average inherent distinctiveness for such goods which, in turn, means that the mark, as a whole, is averagely distinctive for the same.

45) I now turn to consider whether the evidence of use submitted by the opponent shows that the earlier mark's inherent distinctiveness has been enhanced in relation to any type(s) of casual wear. The relevant evidence comes from Mr Daniel Haddad in a witness statement dated 14th February 2022 with one exhibit thereto.⁴ A great deal of Mr Haddad's evidence is non-specific and general in the sense that he talks about the success and fame of the opponent's 'brand' globally. However, it is the use that has been made of the mark in the EU and the UK which is relevant. Mr Haddad's pertinent evidence can be summarised as follows:

- In a copy of 'License Global Magazine', 2017, the brand BEVERLY HILLS POLO CLUB was ranked number 34 in the top 150 Licensees worldwide by

⁴ DH1

revenue with \$1.7 billion of retail sales. It's ranking in other years has been as follows: 2013 – 39th, 2014 – 44th, 2015 – 49th, 2016 – 44th.⁵

- The opponent has successfully opposed a number of marks in the EU and worldwide. A table of those cases is provided showing the opposed marks and the class number which was opposed. It does not show the precise nature of the goods or services in those classes.
- Mr Haddad states that goods bearing the brand and/or sold under reference to the brand include menswear, womenswear, childrenswear, footwear, perfume, watches, eyeglasses, bags and luggage, cosmetics and skin products (which he refers to as the 'Brand Goods'). Retail sales of those Brand Goods are said to amount to hundreds of millions (in USD) per annum worldwide.
- Mr Haddad states that on average, over the last ten years, prior to 2020, retail sales within the EU exceeded \$21 million per annum and over \$5 million per annum in the UK. These figures appear to relate to all of the 'Brand Goods' identified in the previous bullet-point.
- Between 2006 – 2018, total sales of clothing (kidswear, menswear and underwear) was more than \$22.1 million with average sales of more than \$1.7 million per annum in the UK.
- Between 2018 – 2022, sales of clothing across the EU (excluding the UK) was over \$35 million. In the same period, sales of clothing in the UK amounted to over \$15 million and sales of 'leather goods' across the EU and UK was more than \$36 million.
- Mr Haddad states that new collections of clothes bearing the earlier mark are released twice a year in Spring/Summer and Autumn/Winter which are accompanied by new marketing material. That material is provided to each of the opponent's licensees and typically includes new fashion shoot visuals, a campaign video and style look books. An example of such a look book is provided.⁶ It shows the earlier mark present on the cover page above the words 'SPRING SUMMER 2015 COLLECTION'. The mark is also present on each page of the book in relation to casual shoes.

⁵ Paragraph 56 of Mr Haddad's witness statement

⁶ See pages 56-76 of DH1

- The main website for the brand is www.bhpoloclub.com. According to Google Analytics, between 2018 and 2022, there were a total of 721,760 unique visitors to the site, of which 35,412 originated from the UK. There are also social media accounts relating to this website on Facebook with 93,280 followers and Instagram with 23,300 followers.
- The opponent has undertaken video advertising campaigns worldwide which are said to show the fashion presentations of the opponent's products in the EU and elsewhere. These are said to be provided to each of the opponent's licensees worldwide which are then used on the licensees' store television screens as part of their in-store brand marketing campaigns. Links to the videos are provided but the content of those videos is not before me.
- The opponent's current marketing budget, which has been in place for several years, for the EU and Middle East is approximately \$1,000,000 per annum with approximately \$400,000 of that being spent on the opponent's Italy-based showroom, visuals for adverts, trade shows and video productions. The remaining \$600,000 per annum is said to be spent on the sampling and design process of the annual collections which includes the creation and provision of look books.
- In addition, licensees are required to carry out their own marketing activities, with marketing budgets set at a minimum of 2% of their net sales.
- The brand is said to be consistently showcased at trade and fashion shows in the EU. Images from some of those shows are provided which are aimed at Industry, however Mr Haddad states that many also allow paying customers in at the end.⁷ The earlier mark can be seen in use in relation to casual shoes, casualwear for men, women and children, bedding, bags and luggage.
- A number of other trade shows are referred to by Mr Haddad, at which the opponent is said to have exhibited the 'brand' such as i) Pitti Uomo, Italy, in January 2020 which is said to be for exhibiting men's fashion, ii) Pitti Bimbo, a childrenswear trade show in Italy which has been attended by one of the opponent's licensees every year from 2009 – 2015. No photographs of those shows are provided.

⁷ See pages 77-102 of DH1

- The 'brand' has sponsored sports teams, including the EU Pallavolo Molfetta, a professional volleyball team in Italy. Photographs are provided from one of the games showing players wearing a t-shirt with the earlier mark present on the sleeve.⁸
- The 'brand' is said to have been featured in third party publications in RLI magazine in 2004. No further information is given about the content of those articles.
- In 2016, the 'brand' was nominated for Best Emerging Market Retailer of 2016 which was held in London and said to have been attended by many hundreds of people. The 'brand' was highly commended in this category. When nominated again, for the same award in 2017, the opponent won. That event was held in Dubai in May 2017.⁹

46) The opponent's unchallenged sales figures in relation to the sale of clothing for the EU (and UK) from 2006 up to the relevant date have clearly been consistently substantial year-on-year. However, there is very little before me to show the precise kinds of clothing that have been sold for the duration of that period aside from a few photographs showing casual shoes and other items of casual clothing. There is also nothing before me to show the nature or extent of the marketing that has taken place by the opponent's licensees and there is little evidence showing the nature of the promotion which took place at the various trade shows referred to or the kinds of goods that were promoted at them. Neither is it clear to me how many consumers are likely to have been exposed to the various 'look books' referred to. The evidence therefore is clearly not without deficiencies. Nevertheless, I remind myself that I must stand back and take a collective view of the evidence. Having done so, and reminding myself, in particular, of the consistently substantial sales figures for clothing for 15 years prior to the relevant date in both the EU and the UK, I am prepared to accept that the opponent's earlier mark, as a whole, did, on the balance of probabilities, have an above average degree of enhanced distinctiveness in relation to casual clothing (i.e. general casualwear, not including technical polo-wear/sportswear) at the relevant date.

⁸ See page 126 of DH1

⁹ See page 138 of DH1

Likelihood of confusion

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

48) I will first consider the likelihood of direct confusion. In relation to casual clothing, the earlier mark, as a whole, has an above average degree of distinctiveness and those goods are highly similar to the applicant's goods in class 25. The marks are visually similar to a medium degree. However, aurally they share no similarity, or at best, a very low degree of aural similarity and the conceptual similarity between the marks, as wholes, is, at best, low. Weighing these factors, I find that an average consumer paying at least a medium degree of attention is unlikely to mistake one mark for the other, even allowing for imperfect recollection. There is no likelihood of direct confusion on the basis of the earlier mark's casual clothing.

49) The likelihood of direct confusion is, in my view, even lower when based upon the opponent's clothing insofar as it covers 'technical polo wear' for all of the contested goods and services and even those goods in class 25 that are identical, owing, in particular, to the lower degree of distinctiveness of the earlier mark in relation to such goods (no more than average as a whole) and the very low degree of distinctiveness of the common element (if that element has any distinctiveness at all for such goods). Accordingly, having weighed all relevant factors, having due regard for the degree of similarity between the marks, as a whole, and allowing for imperfect recollection, there is no likelihood of direct confusion on the basis of the earlier mark's clothing insofar as it covers 'technical polo-wear'.

50) I now turn to consider whether there is a likelihood of indirect confusion. The opponent draws my attention to the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10¹⁰, where 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 recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

¹⁰ The opponent’s submissions in lieu, at paragraph 36.

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

51) I also note that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

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

53) I do not consider that an average consumer, having noticed that the marks are different, would put the similarities between them down to the respective goods or services coming from the same undertaking because i) the common element is not "so strikingly distinctive" for any of the relevant goods or services, and especially those which directly relate to the game of polo, ii) the later mark does not simply add a non-distinctive element to the earlier mark and iii) a change from using the place name Beverly Hills to the entirely different place/surname Hipwood appears to me to be far from entirely logical and consistent with a brand extension of the earlier mark. I, of course, bear in mind that the categories highlighted by Mr Purvis do not constitute an exhaustive list of all the ways in indirect confusion can occur. However, I cannot see that there is likely to be any other kind of mental process on the part of the consumer, falling outside of those categories, that is likely to lead them to believe that the respective goods and services come from the same or linked undertaking(s). I make this finding in respect of all the relevant contested goods and services, regardless of the degree of similarity/identity between them and the opponent's goods, and even where the earlier mark, as a whole, has an above average degree of distinctiveness. There is no likelihood of indirect confusion.

54) I have not overlooked the opponent's assertion that there is a likelihood of initial interest confusion¹¹. However, the opponent does not explain how such confusion is likely to occur and it is not clear to me that any such form of confusion is likely. I have also, of course, taken account of relevant notional and fair use of the respective marks but this does not include, as the opponent appears to contend, use of the respective marks with the device element separated from the words within the marks. Such use does not fall within the ambit of notional and fair use which must take account of use of the marks as wholes.

55) The ground under section 5(2)(b) of the Act fails.

Section 5(3)

56) Section 5(3) of the Act provides:

“(3) A trade mark which-

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

Reputation

57) Bearing in mind my earlier comments regarding the use that has been made of the earlier mark for casual clothing (not including technical polo-wear/sportswear) in the EU, I accept that that the earlier mark did, on the balance of probabilities, have a reasonable reputation at the relevant date, as per Case C-375/97, *General Motors* [1999] ETMR 950 for those type of goods.

¹¹ See Form TM7

Link

58) Whether the public will make the required mental 'link' between the opponent's mark and the contested must take account of all relevant factors. The relevant factors identified in Case C-252/07, *Intel* [2009] ETMR 13 are:

i) *The degree of similarity between the conflicting marks*

There is a medium degree of visual similarity, no aural similarity or, if I am wrong, only a very low degree of aural similarity, and a low degree of conceptual similarity, at best, between the marks as wholes.

ii) *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*

The opponent's casual clothing is highly similar to the applicant's polo-related goods in class 25. I cannot see any similarity between the opponent's casual clothing and any of the other contested goods and services bearing in mind their respective nature, purpose, methods of use, trade channels and that they are unlikely to be in competition or complementary. The relevant public for all the goods and services at issue includes the general public and professional polo players who will pay at least a medium degree of attention during the purchase.

iii) *The strength of the earlier mark's reputation*

I have found that it is likely the earlier mark had a reasonable reputation in relation to casual clothing at the relevant date.

iv) *The degree of the earlier mark's distinctive character, whether inherent or acquired through use*

The earlier mark, as a whole, has an average degree of inherent distinctiveness in relation to casual clothing which had been elevated to above average at the relevant date for those goods.

v) *Whether there is a likelihood of confusion*

There is no likelihood of confusion.

59) Having considered all the above factors, I find that the earlier mark would not be brought to mind when the relevant public is faced with the applicant's mark despite the high similarity between certain of the goods and notwithstanding the reasonable reputation and above average degree of enhanced distinctiveness of the earlier mark for casual clothing. The marks are aurally not similar or at best aurally similar to a very low degree and conceptually low (at best) in similarity. Furthermore, although the marks share a medium degree of visual similarity, that degree of similarity stems from the common presence of the device of a polo player on horseback. When faced with the applicant's mark on polo-related goods that device element will simply indicate/reinforce to the consumer that the applicant's goods relate to/are intended to be used during the sport of polo and nothing more. I see no reason why, in such circumstances, the opponent's mark would be brought to mind. The requisite link is not established. Without a link there can be no damage.

60) The opposition under section 5(3) of the Act fails.

Section 5(4)(a)

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

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

62) 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).”

63) The opponent relies upon the use of a sign under this ground which is identical to that which I have already considered under section 5(2)(b) of the Act and which is said to have been used in the UK for the same goods as covered by its earlier registered mark. I recognise that the test for misrepresentation is different to that for likelihood of confusion because misrepresentation requires “*a substantial number of members of the public are deceived*” rather than considering whether the “*average consumer is confused*”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the

difference between the legal tests will produce different outcomes. I believe that to be the case here. Even if I were to accept that the opponent had the requisite goodwill in the UK at the relevant date in relation to a business selling casual clothing (which is, at best, where any such goodwill would lie given the nature of the use shown before me) and that the sign corresponding to its registered mark was distinctive of that goodwill, I find it unlikely that a substantial number of the opponent's customers will be misled into purchasing any of the applicant's goods or services in the belief that they are those of the opponent, for essentially the same reasons that I set out when considering the likelihood of confusion under section 5(2)(b).

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

OUTCOME

65) The opposition fails.

COSTS

66) As the applicant has been successful she is entitled to a contribution towards her costs. As Ms Blakeley appeared to be unrepresented, at the conclusion of the evidence rounds the tribunal invited her to indicate if she intended to make a request for an award of costs, and, if so, to complete a proforma containing a breakdown of her actual costs, including providing accurate estimates of the number of hours spent on a range of activities relating to the prosecution of the proceedings. Ms Blakeley responded to this invitation. In her response, Ms Blakeley claimed costs in relation to solicitor and KC (formerly QC) fees. It subsequently became apparent that Ms Blakeley is a qualified solicitor acting on her own behalf but has also availed herself of legal services provided by a KC. A copy the relevant KC bill is provided relating to work undertaken which is directly relevant to these proceedings up to and including the filing of Ms Blakeley's evidence. The proforma indicates that KC services were also used in relation to the applicant's written submissions in lieu but no bill has yet been provided in relation to these.

67) Insofar as Ms Blakeley has claimed solicitor's costs (due to being a solicitor herself), I agree with the opponent that it would not be appropriate to compensate her for those professional costs given that she is, in that regard, effectively a litigant in person acting on her own behalf. However, given that she has also clearly used the services of a KC to assist her with these proceedings, as supported by the relevant bill, I consider it appropriate to award costs to Ms Blakeley, taking into account of those KC costs, using the scale of costs applicable to parties with legal representation which can be found in Annex A of Tribunal Practice Notice ('TPN') 2/2016. As is made clear in that TPN, the scale is based on costs being determined on a contributory rather than a compensatory basis. Only in exceptional circumstances will the tribunal depart from that scale if it can be shown, for example, that one or both parties have acted persistently unreasonably or obstructively. In this connection, I note that both parties have requested costs off the scale. However, there is nothing in the reasons provided from either party which satisfies me that costs above the scale are appropriate. I therefore proceed to determine an appropriate costs award to the applicant based upon the published scale and the bills provided but must ensure that I only award Ms Blakeley a contribution towards the KC fees rather than compensating her in full for the same. My assessment is as follows:

Official Fees

Ms Blakeley has not incurred any official fees (there is no fee for the filing of a counterstatement as opposed to a notice of opposition).

Preparing a counterstatement and considering the other side's statement of case.

The scale is between £200 and £650 depending on the complexity of the statement of case. Counsel's bill in this connection is £1, 500 (excluding VAT). I consider a fair contribution to be **£300**.

Filing and considering evidence

The scale for this is between £500 and £2200. The bill from counsel is for £2750 (excluding VAT) for this aspect of the work. I consider a fair contribution to be **£800**.

Written submissions

The scale for this is between £300 and £550. Ms Blakeley indicates that, although Counsel's services were used in relation to this aspect of the proceedings, she has not yet received the bill relating to them. She does, however, provide an estimate of 5 hours for Counsel's time at a cost of £3000 for these services. I see no reason to doubt this estimate or that Counsel's services were indeed used for this aspect of the proceedings. I note, for example, that reference to Counsel's advice is made in Ms Blakeley's email of 07 July 2022 in connection with the filing of her written submissions in lieu. I consider a fair contribution to be **£400**.

Total: £1500

68) I order Lifestyle Equities C.V. to pay Nicola Blakeley the sum of **£1500**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of September 2022

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