

O/0512/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004021505
BY DEQING FOX ARMOUR CO.,LTD
TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASSES 9 AND 28

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 450009
BY FOX HEAD INC.

BACKGROUND AND PLEADINGS

1. On 04 March 2024, Deqing Fox Armour Co.,Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK (“the contested mark”). The application was accepted and published for opposition purposes on 16 August 2024 in respect of the following goods:

Class 9: *Protection devices for personal use against accidents; Reflective safety vests; Gloves for protection against accidents; Bullet-proof vests; Bullet-proof clothing; Face-protection shields; Shoes for protection against accidents, irradiation and fire; Protective helmets; Riot shields; Goggles.*

Class 28: *Elbow guards [sports articles]; Knee guards [sports articles]; Arm guards for sports use; Wrist guards for athletic use; Shin guards [sports articles]; Chest protectors for sports use; Leg guards for athletic use; Hand pads for sports use; Sports equipment; Exercise bands.*

2. On 04 October 2024, the application was opposed in full by Fox Head Inc. (“the opponent”) on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under Section 5(2)(b), the opponent relies on the trade mark registration shown below:¹

Trade mark number: UK00912872065 (“the word-only earlier mark”) FOX Filing date: 13 May 2014 Registration date: 22 October 2015
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¹ On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM and IR designating the EU for protection. As a result, the opponent’s earlier EUTM were automatically converted into a comparable UK trade marks. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

The mark is registered for a range of goods and services in classes 9, 16, 18, 25 and 35 as set out below, but the opponent relies upon the goods and services in classes 9, 25 and 35 only (highlighted in grey):

Class 9: *Sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities; protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories, namely replacement lenses, frames, earstems, and nose pieces; cases specially adapted for spectacles and sunglasses and their parts and accessories; protective articles for sporting purposes (other than sporting articles or parts of sports suits); headwear for sporting activities for protection against injury; protection apparatus for personal use against accidents (other than sports articles or part of sports suits); electronic publications (downloadable) featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services; publications in machine readable form featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services; all the aforesaid goods for use in relation to extreme sports activities.*

Class 16: *Paper, cardboard; printed matter; printed advertising materials; decals; stickers (decalcomanias); brochures; catalogues; pamphlets; leaflets; periodical magazines; newsletters; stationery; photographs; instructional and teaching material (except apparatus); all relating to clothing, apparel, protective gear, footwear, casualwear accessories, and moto-cross, motorcycle, bicycle and action sports activities, goods and services; all the aforesaid goods for use in relation to extreme sport activities.*

Class 18: *Luggage, backpacks, and travel bags; all the aforesaid goods for use in relation to extreme sports activities.*

Class 25: *Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts, shoes, boots, socks and swimwear; all the aforesaid goods for use in relation to extreme sports activities.*

Class 35: *Business management and administration; advertising; organization of exhibitions for commercial or advertising purposes; event management services (organization of exhibitions or trade fairs for commercial or advertising purposes); franchising services [group purchasing, group advertising]; management advisory services related to franchising; retail services in the field of sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities, protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories, namely replacement lenses, frames, earstems, and nose pieces, cases specially adapted for spectacles and sunglasses and their parts and accessories, protective articles for sporting purposes (other than sporting articles or parts of sports suits), headwear for sporting activities for protection against injury, protection apparatus for personal use against accidents (other than sports articles or part of sports suits), electronic publications (downloadable) featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services, publications in machine readable form featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services, paper, cardboard, printed matter, printed advertising materials, decals, stickers (decalcomanias), brochures, catalogues, pamphlets, leaflets, periodical magazines, newsletters, stationery, photographs, instructional and teaching material (except apparatus); all relating to clothing, apparel, protective gear, footwear, casualwear accessories, and moto-cross, motorcycle, bicycle and action sports activities, goods and services, luggage, backpacks, and travel bags, clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts, shoes, boots, socks and swimwear; electronic publication of publicity texts; all the aforesaid services for use in relation to extreme sport activities.*

4. The opponent claims that the marks are similar, that the goods and services are identical or highly similar, and that the opponent's mark has acquired an enhanced level of distinctiveness through use. These factors, the opponent claims, will lead to a likelihood of confusion and the application should be refused under Section 5(2)(b).

5. Under Section 5(3), the opponent relies on the same earlier mark set out above, which, it claims, has a reputation in relation to all of the registered goods and services. Under this ground, the opponent claims that its business was set up in the USA in the 1970s and it has been actively selling 'FOX' branded goods in the UK for at least 16 years. The opponent claims to be a market leader in the outdoor and extreme sports fields, and to have a particularly strong reputation for mountain-biking and motocross, as well as many other activities where protective gear might be needed, ranging from wakeboarding and surfing to winter and other sports. Further, the opponent claims that use of the applicant's mark is likely to mislead the public into thinking that the applicant's goods are those of the opponent, resulting in damage to the opponent. The opponent claims that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

6. The trade mark relied upon by the opponent is an earlier mark in accordance with Section 6(1)(a) of the Act given that it was filed for registration earlier than the date of application for the contested mark. As the opponent's earlier mark had been registered for five years at the date the application was filed, in accordance with Section 6A of the Act, it is subject to proof of use. Accordingly, the opponent made a statement that it has used the earlier mark in relation to the goods and services upon which it relies.

7. Under Section 5(4)(a), the opponent relies upon the unregistered sign 'FOX'. The opponent claims to have used the sign throughout the UK since 2011 in relation to the following goods: *Goggles; protective goggles; protective helmets; protective clothing; protective clothing including chest guards, elbow pads, knee pads, reinforced shorts and tights; chest guard jackets; protective kidney belts; protective knee and shin guards; protective body vests; protective body frame armour; protective gloves; protective boots and shoes; protective helmets; clothing, footwear and headgear of all types; clothing, including base layers, pants and leggings, shirts, jackets, shorts, hoodies and pullovers, t-shirts, jerseys, outerwear, reinforced clothing and socks; protective guards in the form of inserts for clothing; sports guards; sports gloves; protective guards and inserts for sporting purposes, including motocross, mountain biking, cycling, outdoor activities and extreme sports activities, such as paintballing, surfing, skiing and winter sports; bags and backpacks.* The opponent also pleaded misrepresentation and damage.

8. The applicant filed a counterstatement on 9 December 2024. Aside from conceding that the applied-for goods are similar to the opponent's goods, the applicant denied the claims made. In addition, the applicant put the opponent to proof of use. In this connection, I should clarify that in its Form TM8 the applicant stated that *"it requests that the opponent provides proof of use for all goods under trade mark no. UK00912872065 [i.e. the earlier mark] that are relied upon in the opposition"*. In its counterstatement, the applicant also stated that *"the Applicant requests that the Opponent's provides proof of use for Goods in Class 9 of UKTM UK00003204461"* – this appears to be a mistake as UK00003204461 is not a mark which belongs to the opponent in these proceedings. Since the applicant requested proof of use in relation to the goods relied upon under the earlier mark without mentioning the services, and since the applicant did not file anything further which might clarify whether the omission of the services was a simple error (and the applicant actually intended to put the opponent to proof of use for the services too), there being no reason for me to extend the applicant's request beyond what it is, I will proceed on the basis that proof of use is requested in relation to the goods in class 9 and 25, but not in relation to the services in class 35. The consequence of this is that the opponent can rely upon the services it has identified in class 35 without having to prove genuine use.

9. The opponent has been professionally represented throughout these proceedings by Murgitroyd & Company. The applicant is represented by Pawel Wowra. Only the opponent filed evidence. No hearing was requested and only the opponent filed written submissions in lieu of attendance. This decision is taken following careful consideration of all the papers before me.

THE EVIDENCE

10. The opponent's evidence is given in the witness statement of Holly Cameron.

11. Ms Cameron is a Chartered Trade Mark Attorney in the opponent's representative firm. Her statement is dated 12 February 2025 and is accompanied by two exhibits being those labelled HC1-HC2.

12. Whilst Ms Cameron's evidence is aimed at supporting the opponent's claims that it has put the earlier mark to genuine use and that it enjoys reputation and goodwill under this mark (and the equivalent unregistered sign), as I will explain shortly, her witness statement is only a vehicle for introducing evidence filed in parallel proceedings between the parties, namely a witness statement from Robert Robinson and accompanying Exhibits RR1-RR10 that was filed in support of opposition no. 440653. At the time when Mr Robinson gave his evidence (i.e. 15 November 2023) he was the UK and Ireland Country Manager for the opponent, however, Ms Cameron explains that he is no longer employed by the opponent.

13. I do not intend to summarise the evidence and submissions at this stage, but I confirm that I have given due consideration to all of the documents filed.

RELEVANCE OF EU LAW

14. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

PRELIMINARY ISSUE

15. When filing its evidence, the opponent mentioned that the parties were previously involved in an earlier separate opposition before this Tribunal (i.e. opposition no. 440653) whereby the applicant in these proceedings applied for the word mark UK00003866533 'FOX ARMOUR' in Classes 9 and 28 which was opposed by the opponent in these proceedings based on the same earlier registered trade mark and unregistered sign relied upon in this opposition. As the opponent entirely correctly pointed out, in the previous case, the opponent was required to show genuine use of the same earlier mark relied upon in this opposition as well as goodwill in the same earlier sign. The opposition in that case was successful (BL-O/1003/24 dated 21

October 2024) under all grounds pleaded which included Sections 5(2)(b), 5(3) and 5(4)(a). I was the Hearing Officer who dealt with that case and issued that decision.

16. On 9 January 2025, the opponent's representative wrote to the Registry seeking guidance on whether it would be possible to rely upon the evidence in chief filed in the previous opposition no. 440653 in the current proceedings. The Registry responded on 13 January 2025 confirming that this was possible and that the opponent would be required to file a fresh witness statement and include any evidence used in earlier proceedings as an exhibit. Following these directions, the opponent filed a copy of the witness statement of Robert Robinson and accompanying Exhibits RR1 - RR10 (which were relied upon in the previous opposition) - these were introduced by Exhibit HC2 to Ms Cameron's witness statement. The opponent further submitted that "*given that the decision in the previous opposition was only issued approximately four months ago, it is highly unlikely that the reputation and goodwill acquired by the Opponent, as concluded by the Hearing Officer, has diminished to any extent*". Although that is not strictly correct, as reputation and goodwill must be considered at the filing date of the contested application, rather than at the time when the decision is issued (in this case the relevant date in these proceedings is 04 March 2024 which is just over one year after the relevant date in the previous opposition, i.e. 11 January 2023), I agree that, all things considered, the difference of just over one year, is unlikely to make any difference to the outcome of this case in terms of genuine use, goodwill and reputation.

17. For sake of procedural efficiency, I will reproduce here the parts of my previous decision which are transportable to this case in terms of summary of the evidence and findings of facts.

DECISION

Proof of use

18. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

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

19. Section 100 is also relevant, which reads:

“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.”

20. The relevant period in which genuine use must be established is the five-year period ending with the filing date of the application for registration: 5 March 2019 to 4 March 2024 (in the previous proceedings it was 12 January 2018 to 11 January 2023). As the earlier mark subject to proof of use is a comparable mark, use within the EU (including the UK) is relevant for the period ending with IP Completion Day, i.e. 12 January 2018 to 31 December 2020.² From 1 January 2021 onwards, however, the relevant territory is the UK only.

21. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology*

² See paragraph 7 of Part 1, Schedule 2A of the Act.

Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation

has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

22. With regards to assessing use within the EU (which is relevant due to the earlier mark being a ‘comparable mark’), I also bear in mind that in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU found that while use of a Community trade mark in one member state could suffice to establish genuine use in the Community, “*all facts and circumstances*” should be considered including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.³

23. I now reproduce below the summary of the evidence and the findings about genuine use from my previous decision which I have highlighted in grey to make it easier for the reader to follow:

The evidence

21. Mr Robinson, who gave the main evidence for the opponent, says that he has worked for the opponent for ten years and is responsible for the opponent’s sales and marketing across the UK, including of mountain bike and motocross product lines, clothing (including casual, sports and protective clothing), and protective products (including goggles, helmets, guards and armour).

22. Mr Robinson explains that the opponent’s company was purchased in 2022 by Vista Outdoor for \$540 million and asserts that this reflects that the brand ‘FOX’ is a market leader. He explains that Vista Outdoor is a US-based business which holds various brands in the outdoors and sporting fields

³ See also *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (paragraphs 228-230) and Case T-398/13, *TVR Automotive Ltd v OHIM* (paragraph 57)

including cycling, motorcycling, motocross, and mountain biking as well as golf and hunting. A webpage (undated) from Vista Outdoors's website (www.vistaoutdoor.com) states: *"Our two operating segments, Outdoor Products and Sporting Products, include a diverse portfolio of renowned brands that provides outdoor consumers with a wide range of performance-driven, high-quality and innovative products"* and lists 'FOX' as an outdoor product brand, along with other 29 different brands.

23. A copy of an online article from "Outside Business Journal" dated 30 August 2022 supports the narrative evidence provided by Mr Robinson about the purchase and the opponent's position as a market leader in protective gear and apparel for motocross and mountain biking.⁴ It states:

"Vista Outdoor to Purchase Fox Racing for \$540 Million.

The motocross and mountain biking gear company is to become the 40th brand under the Vista Outdoor banner"

"[...] Fox Racing is an ideal fit for our portfolio with a reputation for high quality helmets, protective gear and apparel for motocross and mountain biking," said Chris Metz, Vista Outdoor CEO, in a press release. "Motocross and mountain biking are growing and familiar categories for Vista Outdoor. Fox Racing is synergistic to our existing action sports business unit, which includes Bell Helmets, Giro, Blackburn, Krash, Copilot, and Raskullz. The addition of Fox Racing to our portfolio will allow us to target multiple consumer demographics across mountain and road biking, skiing/snowboarding, and powersports.

"[...] Fox Racing was started by Santa Clara University physicist Dr. Geoff Fox in 1974 and is known as an industry leader in protective gear, apparel and accessories for motocross and mountain biking. Fox Racing grew its net sales by a compound annual growth rate of approximately 20 percent from 2019 to 2021, and is expected to top that growth for 2022 [...]"

⁴ RR1

24. Although the article refers to 'FOX RACING', Mr Robinson states that the opponent is often known in the trade and to customers as 'FOX RACING', or simply 'FOX'.

25. Mr Robinson provides the opponent's net sales figures for the UK for 'FOX' branded goods sold between 2015 and 2021.⁵ The figures relate to sales of motorbike-related goods (MTX), motocross-related goods (MX) and lifestyle goods. The total value of the sales fluctuated from over £6million in 2015, to £7million in 2016, to £7.8million in 2017, to £5.9 in 2018, to £9.7million in 2019, to £11.8million in 2020, to nearly £14million in 2021, for a total of over £62million, with the sales of motorbike and motocross goods representing over 80% of the total sales.

26. Mr Robinson also says that UK sales of mountain bike and motocross products in 2022 are close to £11 million (without Lifestyle sales).

27. Global figures have also increased steadily between 2015 and 2022, going up from nearly €40million in 2015, to nearly €48million in 2016, to €51.3million in 2017, to €50million in 2018, to €53.1million in 2019, to €58.2million in 2020, to €87.6million in 2021, to €103.5million in 2022, for a total of over €491million. Mr Robinson says that the vast majority of these sales relate to the brand 'FOX', explaining that the opponent sells both 'FOX' and 'SHIFT' branded goods, but 'SHIFT' represents only around 5% of the sales.

28. Mr Robinson provides extracts of UK sales for 2017 and 2021 giving breakdowns of sales by reference to products. They show that the sale of mountain bike and motocross goods include helmets, pants, jerseys, outerwear, guards, shorts, gloves, bags, socks, base layers, spare parts, boots and goggles, whereas the sale of lifestyle goods include headwear, outerwear, shorts, pants, tops, fleeces, socks, swim, bags, stickers, wallets, dresses, eyewear and footwear. Mr Robinson states that he would estimate, very roughly, that 40% of the mountain bike and motocross sales relate to protective

⁵ RR2

wear such as pads, guards, helmets, goggles and the like, and provides a table showing that between January and November 2022 and in 2023 the sales of helmets, guards and goggles represented 39% and 38% of the UK sales respectively.⁶

29. Mr Robinson states that all the opponent's products bear the marks 'FOX' and/or 'FOX RACING' on the product itself and provides examples of use of the Fox word-only mark and FOX logo-mark on printed labels and on goods, as shown below:⁷



30. Copies of 'FOX' mountain bike and motocross catalogues from 2017, 2019 and 2021 are provided.⁸ They show examples of a variety of goods ranging from protective goods, including items of racewear, such as racer one piece suits, helmets, guards, goggles, gloves, body armours, to items of sport and casual clothing, including leggings, fleeces, hats, jackets, hoodies, t-shirts, long sleeves tops, shirts, socks and bags.

⁶ RR2

⁷ RR3 and RR6

⁸ RR5-6

31. Mr Robinson states that the opponent's products are sold in the UK via third-party stores or via the opponent's UK website foxracing.co.uk with a 50/50 split between online sales and sales via physical stores. The opponent also owns foxracing.com as its global site. Mr Robinson further states that, at the date of witness statement, the opponent's motorbike and lifestyle goods were sold in the UK in around 400 third-party stores (with some third parties holding multiple stores) and that between 2018 and 2023 the number of stores had increased from closer to 300 to around 400. Similarly, the motocross goods were sold in the UK in around 60 stores between 2018 and 2023.

32. Copies of invoices for the UK are also supplied. They are addressed to business customers in various UK locations, including Cardiff, Swansea, Bristol and other locations in England, are dated within the relevant period (covering the years 2018, 2019, 2020 and 2022), and are for various amounts, ranging from over £7K to over £200K. All of the invoices exhibited are for sports and protective goods of the kind mentioned above and feature the mark shown below:



Form of the marks and genuine use

33. There are plenty of examples of use of the word-only mark on goods, catalogues and invoices. Whilst the word 'FOX' is also used in conjunction with a fox head device, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark insofar as it continues to be perceived as indicative of the origin of the product at issue.⁹ In this case, I consider that use of the word FOX in conjunction with a fox head device does

⁹ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

not alter the ability of the trade mark FOX to serve as an indication of the commercial origin of the goods and counts towards genuine use.

34. Admittedly, the FOX logo mark shown in evidence is slightly different from the registered version. Further, the majority of the goods shown in evidence do not display the FOX logo mark but feature a fox head device and the word FOX separately. I will deal with these issues in turn.

35. First, the differences between the registered mark and the mark that has been used are minimal, amounting to the presence, in the registered version, of a white outline around the letters and the fox head device which is absent in the mark shown in evidence:



36. In my view, the distinctiveness of the FOX logo mark lies in the letters F and X and their combination with the fox head device; the change in the outline amounts to an alteration or omission of a non-distinctive element which does not alter the distinctive character of the mark as a whole and the version used is an acceptable variant of the mark as registered.¹⁰

37. Second, although the majority of the goods shown do not display the FOX logo mark, the latter appears on internal pages of catalogues as shown below and Mr Robinson says that the FOX logo mark is the original brand:

¹⁰ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22



CODA

1

2

<p>1 THROWBACK 110 SNAPBACK HAT 21991-007</p> <p>2 RACE TEAM LS AIRLINE 22052-007</p> <p>3 THROWBACK PO FLEECE 22046-185</p> <p>4 RACE TEAM PREMIUM TEE 22093-001</p>	<p>5 THROWBACK SS TECH TEE 22348-493</p> <p>6 F HEAD X SS AIRLINE TEE 21599-190</p> <p>7 DUN FLEXFIT HAT 21988-008</p> <p>8 RACE TEAM SHERPA 22034-007</p>
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38. In any event, use of a mark does not have to be shown on every single label, product or catalogue page to be deemed to have been used in relation to the relevant goods. It is clear that the opponent has used its original FOX logo mark during the relevant period along with other variations of the same mark resulting from the deconstruction of the mark into its two components, namely the fox head device and word FOX separately.

39. Taking into account the nature of the goods concerned, the significant turnover generated under the marks, the number of stores in which the opponent's goods are available in the UK, and the continuity of use of the marks on the market, I have no hesitation in concluding that the opponent has made genuine use of both earlier marks during the relevant period in the relevant territory (being the EU including the UK, or the UK alone) for goods relating to protective clothing, casual clothing and protective gear for sports.

40. However, I must now decide on a fair specification.

Fair specification

41. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

42. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

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

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

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

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

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

43. In its submissions in lieu, the opponent states that its evidence of use demonstrates that the word-only earlier mark has been used in relation to the following goods:

Class 9: *Sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities; protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses; protective articles for sporting purposes (other than sporting articles or parts of sports suits); headwear for sporting activities for protection against injury; protection apparatus for personal use against accidents (other than sports articles or part of sports suits)*

Class 25: *Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts, shoes, boots, socks; all the aforesaid goods for use in relation to extreme sports activities.*

44. Further, it states that the logo mark has been used in relation to the following goods:

Class 9: *Sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities; protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories; headwear for sporting activities for protection against injury; protection apparatus for personal use against accidents (other than sports articles or part of sports suits)*

Class 28: *Protective articles for sporting purposes (other than sporting articles or parts of sports suits).*

45. The applicant did not comment on the opponent's evidence.

46. I shall start with class 9. Although I note that the extracts of UK sales for 2017 show the sales of £3,608 worth of eyewear under the lifestyle product line, these sales are outside the relevant period and are very small. Further, none of the catalogues or invoices exhibited in evidence include items of eyewear. Lastly, I do not consider that these types of goods belong to the same group or category as those for which the mark has been used, in particular sport goggles. Consequently, I find that the opponent cannot rely on the terms “*protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses*” (as covered by the earlier word-only mark) and “*protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories*” (as covered by the earlier logo mark).

47. The opponent’s specification in class 9 also covers *Sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities*. Whilst the article from “Outside Business Journal” refers to the acquisition of the opponent as an opportunity to expand the business by gaining customers across mountain and road biking, skiing/snowboarding, and powersports, the only sport goggles shown in evidence are those from catalogues relating to motocross and mountain biking and there is nothing to suggest that these are the same as those used for snowmobiling, snowboarding, skiing and other snow-related activities. Consequently, I find that the opponent can rely only on the term *Sports goggles for use in motorcycling and bicycling* under both earlier marks.

48. The opponent has also made genuine use of the earlier marks in relation to the registered term *headwear for sporting activities for protection against injury* and can rely on it under both earlier marks.

49. The registered goods in class 9 and class 28 also include *protective articles for sporting purposes (other than sporting articles or parts of sports suits)* (class 9 of the word-only mark), *protection apparatus for personal use against accidents (other than sports articles or part of sports suits)* (class 9 of both

earlier marks) and *Protective articles for sporting purposes (other than sporting articles or parts of sports suits)* (class 28 of the logo mark).

50. Clearly, the exclusion “*(other than sporting articles or parts of sports suits)*” within the class 28 term “***Protective articles for sporting purposes (other than sporting articles or parts of sports suits)***” does not make sense. This is because if a protective article is designed for sport purposes it is necessarily a sport article. In this connection, the explanatory note to class 28 states:

“This Class does not include, in particular: certain gymnastic and sporting articles, for example, protective helmets, goggles and mouthguards for sports (Cl. 9), sporting firearms (Cl. 13), gymnasium mats (Cl. 27), as well as certain fishing and hunting equipment, for example, hunting knives, harpoons (Cl. 8), hunting firearms (Cl. 13), commercial fishing nets (Cl. 22), that are classified according to other functions or purposes”.

51. Notably, protective helmets, goggles and mouthguards for sports (all of which are protective articles for sport purposes falling in class 9) are also described as sporting articles. This confirms my understanding that protective articles for sporting purposes in class 28 are also sport articles and the restriction does not make sense within the context of the specification. Further, the UK classification tools lists various protective articles for sports as “sports articles” or “sporting articles” in class 28, including for example, *Protectors for elbows for use when riding bicycles [sports articles]; Protective supports for shoulders and elbows [sports articles]; Shin protectors [sports articles]; Fist protectors [sporting articles]*. Those are the primary type of goods in relation to which the earlier marks have been used; if the restriction had priority over the existing term “*Protective articles for sporting purposes*” it would exclude the main goods in relation to which the earlier marks have been use. Consequently, since the restriction “*other than sporting articles*” within the term *Protective articles for sporting purposes (other than sporting articles or parts of sports suits)*” contradicts the first term “*Protective articles for sporting purposes*”, it should be ignored, and the opponent can rely on the term “*Protective articles for sporting purposes*”.

52. The opponent's specifications in class 9 contains a similar restriction within the term *“protective articles for sporting purposes (other than sporting articles or parts of sports suits)”* (as covered by the word-only mark). Hence, for similar reasons to those I set out above, I conclude that the restriction contradicts the first term *“protective articles for sporting purposes”* and should be ignored with the result that the opponent can rely on the term *“protective articles for sporting purposes; all the aforesaid goods for use in relation to extreme sport activities”*.

53. Lastly, both earlier marks cover the term *“protection apparatus for personal use against accidents (other than sports articles or part of sports suits)”* in class 9. The evidence shows that the opponent uses the earlier marks in relation to a race subframe which is meant to provide protection in a motocross accident, as shown below:



WHITE
13558-008

PROFRAME LC CE
S/M | L/XL |

- Low profile neck brace compatible roost deflector
 - Adjustable shoulder straps for a precise fit with or without neck brace
 - Easy to use buckle system integrated into chest plate
 - Removable back plate allows rider to wear chest plate only
 - 2 position adjustable back plate for a precise fit
 - Soft Biofoam chassis against body for a comfortable fit
 - CE certified 1621-2
-

54. The subframe is essentially a chest and back protector that is intended to prevent injuries in motocross accidents. My understanding is that the subframe

is designed to be worn by riders in the context of a motocross sport race, however, there is nothing in the evidence to suggest that it is also for wear by motorcyclists on the road. Hence, I consider that this use is not sufficient for the opponent to rely on the term *protection apparatus for personal use against accidents (other than sports articles or part of sports suits)* because the restriction excludes goods that are sport articles.

55. Turning to the specification in class 25, there is no evidence of the opponent selling tights or blouses under its lifestyle products line. Further although the extracts of sales from 2017 shows sales of £15k worth of footwear, that is outside the relevant period; the only evidence of sale of footwear which falls within the relevant period is that relating to boots. However, between the extract of sales for 2020, the catalogues and the invoices, there is enough evidence to support the conclusion that the earlier marks have been used in relation to the remaining goods in class 25.

56. Lastly, although the evidence about protective goods in class 9 and 28 is limited to goods relating to motocross and mountain bike riding, I do not consider that a fair specification needs to reflect that all of goods are limited to motocross and mountain bike riding. This is because it does not seem to me that helmets, guards, and other items of protective gear for use in sports are divided in subcategories of goods capable of being viewed independently according to the type of sport in which they are used and there is no evidence which indicates otherwise.

57. Accordingly, I consider that a fair specification for the word-only mark is as follows:

Class 9: *Sports goggles for use in motorcycling and bicycling; protective articles for sporting purposes; headwear for sporting activities for protection against injury; all the aforesaid goods for use in relation to extreme sport activities.*

Class 25: *Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, pants, shorts, hats, caps, sweatbands, headbands, gloves, belts, boots, socks; all the aforesaid goods for use in relation to extreme sports activities.*

58. I consider that a fair specification for the logo mark is as follows:

Class 9: *Sports goggles for use in motorcycling and bicycling; headwear for sporting activities for protection against injury.*

Class 28: *Protective articles for sporting purposes.”*

Conclusion on genuine use for the purpose of the present opposition

24. As can be seen, in the previous opposition the opponent relied upon the same earlier mark, which is relied upon here, as well as on an additional figurative mark. However, the fact that in the previous opposition the opponent relied upon an additional trade mark does not impact on my assessment about genuine use of the earlier mark relied upon here, namely UK00912872065 which, in my previous decision, I refer to as “*the word-only mark*”. Likewise, as I have explained above the difference of one year in the relevant period does not impact on the issue of use here. Accordingly, I consider that the fair specification I have devised for the relevant earlier mark in the previous opposition no. 440653 is applicable here and it is as follows:

Class 9: *Sports goggles for use in motorcycling and bicycling; protective articles for sporting purposes; headwear for sporting activities for protection against injury; all the aforesaid goods for use in relation to extreme sport activities.*

Class 25: *Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, pants, shorts, hats, caps, sweatbands, headbands, gloves, belts, boots, socks; all the aforesaid goods for use in relation to extreme sports activities.*

25. In addition, as the applicant did not put the opponent to proof of use in relation to the services, the opponent can also rely upon the services it has identified in its pleadings, namely:

Class 35: *retail services in the field of sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities, protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories, namely replacement lenses, frames, earstems, and nose pieces, cases specially adapted for spectacles and sunglasses and their parts and accessories, protective articles for sporting purposes (other than sporting articles or parts of sports suits), headwear for sporting activities for protection against injury, protection apparatus for personal use against accidents (other than sports articles or part of sports suits), electronic publications (downloadable) featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services, publications in machine readable form featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services, paper, cardboard, printed matter, printed advertising materials, decals, stickers (decalcomanias), brochures, catalogues, pamphlets, leaflets, periodical magazines, newsletters, stationery, photographs, instructional and teaching material (except apparatus); all relating to clothing, apparel, protective gear, footwear, casualwear accessories, and moto-cross, motorcycle, bicycle and action sports activities, goods and services, luggage, backpacks, and travel bags, clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts, shoes, boots, socks and swimwear; all the aforesaid services for use in relation to extreme sport activities.*

Section 5(2)(b)

26. Section 5(2)(b) of the Act reads 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.”

27. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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; and

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

Comparison of goods and services

28. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

29. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

30. In *Gérard Meric v OHIM* 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 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

31. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“[...] 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.”

32. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated 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 are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/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.”

33. 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.”

34. The competing goods and services are as follows:

The applicant's goods	The opponent's goods and services
<p>Class 9: <i>Protection devices for personal use against accidents; Reflective safety vests; Gloves for protection against accidents; Bullet-proof vests; Bullet-proof clothing; Face-protection shields; Shoes for protection against accidents, irradiation and fire; Protective helmets; Riot shields; Goggles.</i></p>	<p>Class 9: <i>Sports goggles for use in motorcycling and bicycling; protective articles for sporting purposes; headwear for sporting activities for protection against injury; all the aforesaid goods for use in relation to extreme sport activities.</i></p>
	<p>Class 25: <i>Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, pants, shorts, hats, caps, sweatbands, headbands, gloves, belts, boots, socks; all the aforesaid goods for use in relation to extreme sports activities.</i></p>
<p>Class 28: <i>Elbow guards [sports articles]; Knee guards [sports articles]; Arm guards for sports use; Wrist guards for athletic use; Shin guards [sports articles]; Chest protectors for sports use; Leg guards for athletic use; Hand pads for sports use; Sports equipment; Exercise bands.</i></p>	
	<p>Class 35: <i>retail services in the field of sports goggles for use in motorcycling, bicycling, snowmobiling, snowboarding, skiing and other snow-related activities, protective eyewear, namely spectacles, prescription eyewear, anti-glare glass, sunglasses, and their parts and accessories, namely replacement lenses, frames, earstems, and nose pieces, cases specially adapted for</i></p>

	<p><i>spectacles and sunglasses and their parts and accessories, protective articles for sporting purposes (other than sporting articles or parts of sports suits), headwear for sporting activities for protection against injury, protection apparatus for personal use against accidents (other than sports articles or part of sports suits), electronic publications (downloadable) featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services, publications in machine readable form featuring clothing and apparel, moto-cross, motorcycle, bicycle, action sports activities, goods and services, paper, cardboard, printed matter, printed advertising materials, decals, stickers (decalcomanias), brochures, catalogues, pamphlets, leaflets, periodical magazines, newsletters, stationery, photographs, instructional and teaching material (except apparatus); all relating to clothing, apparel, protective gear, footwear, casualwear accessories, and moto-cross, motorcycle, bicycle and action sports activities, goods and services, luggage, backpacks, and travel bags, clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts,</i></p>
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	<i>shoes, boots, socks and swimwear; all the aforesaid services for use in relation to extreme sport activities.</i>
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35. In its counterstatement the applicant states:

“The Applicant denies all claims made by the Opponent in their statement of grounds, with the sole exception being the admission that the Opponent's goods are similar to the Applicant's goods.”

36. Accordingly, there is a clear concession, on the applicant's part, that the goods are similar.

37. For reasons which will become apparent, I will proceed on the basis that given the applicant's concession as to the similarity of the goods, the applicant's goods and the opponent's goods are similar to at least a low degree (based on the applicant's concession).

38. Alternatively, and in addition to the above finding of a low degree of similarity, I find that:

1. In my previous decision I found that all of the applied-for goods (which were more or less the same as those at issue in these proceedings) were either identical or similar to a low degree to the goods identified in the fair specification of the earlier mark which applies here.
2. In this case the opponent can rely upon the earlier services in class 35 (in respect of which I have concluded that the applicant has not requested proof of use). These include retail services in connection with *“protective articles for sporting purposes (other than sporting articles or parts of sports suits)”* and *“protection apparatus for personal use against accidents (other than sports articles or part of sports suits)”*. Whilst I note that the earlier class 35 specification include the limitation *“all the aforesaid services for use in relation to extreme sport activities”* that would not apply in my view to the term

“protection apparatus for personal use against accidents (other than sports articles or part of sports suits)” because the nature of these goods (which are NOT for use in relation to sport activities) renders the limitation (which limits the goods to those for use in relation to extreme sport activities) inapplicable and nonsensical. Proceeding on that basis, the applicant seeks registration for goods in class 9 and 28 (which are essentially protective/safety gear against accidents and protective articles for sport) in respect of which the opponent’s specification covers corresponding retail services. Accordingly, I find that these goods are similar to a medium degree because although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.¹¹

39. Therefore, the competing goods and services are similar to a medium degree, but if I am wrong, are similar to at least a low degree as a result of the applicant’s concession.

Average consumer

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

41. In *Iconix Luxembourg Holdings* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

¹¹ Oakley, Inc v OHIM, Case T-116/06,

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(g) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

42. I now reproduce below my previous findings about the average consumer and the purchasing process (which being the goods at issue the same as those in the earlier proceedings, equally apply here). I have highlighted the relevant parts in grey to make it easier for the reader to follow:

"76. The average consumer for the parties' goods in class 9 and 28 [and services in class 35] will be a member of the general public purchasing protective equipment for sport purposes or for personal use, a business user purchasing protective equipment for work purposes, or those responsible for

the procurement of supplies for the police force or the military. When selecting the goods and services, consumers will take a number of factors into account such price, quality, functionality and safety. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process by members of the general public whilst business users are likely to pay an above medium degree of attention.

77. The goods are likely to be selected from the shelves of retail outlets (or their online equivalents) or following the perusal of catalogues and marketing material. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that aural components may play a part as word-of-mouth recommendations may be made.”


Comparison of marks

43. 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.”

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

45. The respective marks are shown below:

The applicant's mark	The opponent's mark
	<p data-bbox="1062 584 1129 618">FOX</p>

Overall impression

46. The opponent's mark is a word-only mark. It consists of the three-letter word 'FOX'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

47. The application is a figurative mark. It consists of two words, being the three-letter word 'FOX' and the six-letter word 'ARMOUR' presented in red, in a slightly stylised font, with the two 'R's' in 'ARMOUR' being joint by a curved line which evokes the idea of a fox tail. This verbal element of the mark is placed below a figurative element representing the image of a fox wearing a protective gear which, in turn, reinforces the meaning of the words 'FOX ARMOUR'. The word 'FOX' will be understood as a reference to a wild animal which looks like a dog and has reddish-brown fur, a pointed face and ears, and a thick tail (Collins online dictionary). When it is viewed in relation to goods that relate to protective equipment, the word 'ARMOUR' meaning "*strong covering that protects something, especially the body*" (Cambridge online dictionary) will be seen as descriptive. Whilst both the word and figurative element reinforce each other, bearing in mind the rule of thumb that words speak louder than devices, I conclude that although the figurative element is larger in size, it being neither striking nor original, the most distinctive and dominant element of the mark is the verbal element 'FOX ARMOUR'. Further, whilst 'FOX ARMOUR' is presented as a whole, I

agree with the opponent that 'FOX' is the only distinctive element since 'ARMOUR' is descriptive of the goods at issue which are items of protective gear. The figurative element contributes to the overall impression but has less weight than the word element and will be perceived as subsidiary to it.

Visual similarity

48. Visually, the marks coincide in the distinctive verbal element 'FOX' which is the sole element of the earlier word-only mark and the first verbal element of the application. They differ in the second verbal element of the application, namely the word 'ARMOUR', which has no counterpart in the opponent's mark and is descriptive as well as in the figurative element representing a fox wearing protective body armour. Overall, I consider the marks to be visually similar to a low to medium degree.

Aural similarity

49. Aurally, the earlier mark will be pronounced as FOCS, whereas the application will be pronounced as FOCS ARMA. Overall, I consider the marks to be aurally similar to a medium degree.

Conceptual similarity

50. Conceptually both marks will convey the concept of fox being a wild animal – this is the only concept conveyed by the earlier mark and the dominant and most distinctive concept conveyed by the application. The word 'ARMOUR' in application will convey the descriptive concept of a strong covering that protects something, especially the body and will be seen as having little or no trade mark significance in the context of the goods concerned. Lastly, as I have said, the figurative element of the application conveys no additional concept as it only reinforces the verbal element 'FOX ARMOUR'. Overall, I consider the marks to be conceptually similar to a high degree.

Distinctive character of earlier mark

51. 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).”

52. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

53. I now reproduce below my previous findings about the distinctiveness of the earlier mark (which being the same as the one at issue here and being the evidence filed the

same as that in the previous proceedings equally apply here). I have highlighted the relevant parts in grey to make it easier for the reader to follow:

“96. The opponent’s earlier marks consist of the word ‘FOX’ and a logo version of the same word. I consider that neither the word fox nor the fox logo is suggestive or allusive of the goods covered by the specifications. I therefore consider the level of inherent distinctive character of the word-only mark to be medium. I consider that the device of a fox head replacing the letter ‘O’ in the logo mark is fanciful and increases the distinctiveness of the mark to an above medium degree. However, I also bear in mind that this increased distinctiveness does not assist the opponent because it is the distinctiveness of the common element that is the key.

97. I will now consider whether the distinctiveness of the earlier marks has been enhanced through use.

98. I have already discussed the evidence of use above. By the relevant date of 11 January 2023, the opponent had sold over £73million worth of goods in the UK. That is, by any means, a large amount of goods sold, indicating that the opponent has a significant presence on the UK market in relation to protective gear for sport, in particular gear for motocross and mountain bike. Further, Mr Robinson says that the opponent’s goods are sold in over 400 stores in the UK which, again is, by any means, a significant number, especially when considering the nature of the goods concerned which represent only niche markets on account of, inter alia, their nature, as they relate to extreme sports and target only a certain type of consumer demographics.

99. Admittedly, there is limited evidence of marketing and advertising and no indication of market share. However, the article from “Outside Business Journal” says that the opponent is known as an industry leader in protective gear, apparel and accessories for motocross and mountain biking; whilst that article is not clearly targeted at the UK, the level of turnover generated under the earlier marks in the UK and the number of stores where the goods are sold in the UK, suggest in my view, that the opponent has achieved a significant

level of market penetration in the UK especially having regard to the nature of the market for protective gear for motocross and motorbike riding. Hence, I conclude that the distinctiveness of the earlier marks has been enhanced through use to a degree between medium and high (for the word-only mark) and high (for the logo-earlier mark) for protective gear for motocross and motorbike riding.”

54. Accordingly, insofar as the earlier mark which is relevant in these proceedings is concerned, and insofar as the difference of just over one year in the relevant date is not going to make any material difference, I conclude that the finding of enhanced distinctiveness of the earlier mark applies in this case and that the earlier mark is distinctive to a medium to high degree.

Likelihood of confusion

55. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

56. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. (as he then was) 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.).
- 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).”

57. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a

finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

58. 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.

59. Earlier in this decision I found that:

- The goods are similar to a medium degree. Alternatively, the applicant's concession means that they are similar to a low degree.
- The average consumer for the goods is a member of the general public purchasing protective equipment for sport purposes or for personal use, or a business user who will pay a medium or above medium degree of attention during the purchasing process.
- Visual considerations are likely dominate the selection of the goods, although I do not discount aural considerations completely.
- The marks are visually similar to a low to medium degree, aurally similar to a medium degree, and conceptually similar to a high degree.
- Inherently, the earlier mark is distinctive to a medium degree. However, its distinctiveness has been enhanced though use to a medium to high degree.

60. The opponent's primary position is that there is a likelihood of direct confusion between the marks. In the alternative, in relation to the possibility of indirect confusion, the opponent states that where the consumer does readily perceive the differences between the marks, he may conclude that the differing elements denote a sub-brand or a brand extension.

61. The fact that in my previous decision I found there to be a likelihood of confusion between the opponent's mark 'FOX' and the applied-for mark 'FOX ARMOUR' (both

being word-only marks) does not mean that the outcome should be the same in this case as the present application is for a different mark.

62. In my previous decision, I found that there was a likelihood of indirect confusion reasoning my conclusion as follows:

“106. In relation to the applied-for goods which I found to be identical or similar to the specification of the word-only mark, I conclude that given the high level of visual and aural similarity and the very high level of conceptual similarity between the marks, and taking into account the descriptiveness of the differentiating element ‘ARMOUR’ in the application, it is likely that the relevant public will overlook the word ‘ARMOUR’ in the later mark, and give it little or no trade mark significance, focusing on the identical and dominant element ‘FOX’ and directly confusing the trade marks themselves. In those circumstances, I find that the conclusion that there is a likelihood of direct confusion cannot be overcome by the fact that some the goods are similar to a lesser degree or are selected with an above medium degree of attention as the only differentiating element between the marks is descriptive and the earlier mark is more the averagely distinctive.”

63. Accordingly, in that case I found that there was a likelihood of direct confusion because the only differentiating element between the mark, i.e. the word ‘ARMOUR’, would be seen as descriptive.

64. Admittedly, in this case, there application contains a figurative element and the words ‘fox armour’ are stylised. However, as I have already said, the figurative element only reinforces the word ‘FOX ARMOUR’ being the depiction of a fox wearing a body armour or protective gear which is likely to be perceived as a logo version of the word ‘FOX ARMOUR’. Further, the figurative element does not resolve the descriptiveness of the word ‘ARMOUR’ and does not add a unitary connotation to the words ‘FOX ARMOUR’ to the point that it takes away the independent distinctiveness of the coinciding element ‘FOX’ within the application. In those circumstances, I find that whilst the addition of the figurative element might prevent a likelihood of direct confusion, it is not sufficient to prevent the marks being indirectly confused, as the

average consumer is likely to see the application as a logo version or a variant mark originating from the opponent's brand 'FOX'. The opposition under Section 5(2)(b) is successful.

Other grounds

65. In my previous decision, based on the evidence filed, which is the same as that filed in these proceedings, I have found that the earlier mark relied upon here enjoys sufficient reputation and goodwill to sustain the opponent's claims under Section 5(3) and 5(4)(a). The same conclusion applies here. Accordingly, proceeding on the basis that the opponent has established the required reputation and goodwill, and that the goods and the marks are sufficiently similar to engage a likelihood of confusion, I also find that they are sufficiently similar to bring the opponent's earlier mark to mind (i.e. there is a link) under Section 5(3) and cause misrepresentation (i.e. to deceive a substantial number of the opponent's consumer into believing that the applicant's goods or business are from the same source or are connected) under Section 5(4)(a). In both cases, I conclude that damage (being unfair advantage under section 5(3) and diversion of sales under 5(4)(a)) would follow and that those other two grounds are also successful.

OUTCOME

66. The opposition succeeds in its entirety, and the application will be refused registration.

COSTS

67. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the sum of £1,100, calculated as follows:

Preparing a notice of opposition:	£400
Filing evidence:	£500
Written submissions:	£400

Official fees:	£200
Total	£1,100

68. I therefore order Deqing Fox Armour Co., Ltd to pay Fox Head Inc. the sum of £1,100. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of June 2026

TERESA PINTO
For the Registrar