O/0605/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003788442
BY OYSTER AND POP LIMITED TO REGISTER:

Oyster and Pop

Oyster & Pop

(SERIES OF TWO)

AS TRADE MARKS IN CLASSES 9, 16 & 28

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 437406 BY
ROLEX SA

BACKGROUND AND PLEADINGS

1. On 16 May 2022, Oyster and Pop Limited ("the applicant") applied to register the trade mark shown on the cover of this decision ("the application") in the UK for the goods and services listed in **Annex 1** of this decision.

2. The application was published for opposition purposes on 12 August 2022 and, on 10 November 2022, it was opposed by Rolex SA ("the opponent"). The opposition is aimed at only the following goods:

   Class 28: Toy clocks and watches.

3. The opposition is reliant upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). In respect of both grounds, the opponent relies on the following marks:

   OYSTER
   UK registration no. 473427
   Filing date 28 September 1926; registration date 28 September 1926
   Relying on all goods namely:

   Class 14: Watches.
   ("the opponent's first mark"); and

   OYSTER
   UK registration no. 901455005
   Filing date 10 January 2000; registration date 19 August 2002
   Relying on some goods only, namely:

   Class 14: Clocks; dials (clock and watch-making); movements for clocks and watches; watches.
   ("the opponent's second mark")

4. Under the section 5(2)(b) ground, the opponent argues that there exists a likelihood of confusion on the basis that the marks and goods at issue are similar. In addition, the opponent claims that the likelihood of confusion is increased as a result of the inherent and enhanced distinctiveness enjoyed by its earlier marks.

5. Under the section 5(3) ground, the opponent claims that the marks are similar and that the opponent enjoys a significant reputation in the UK for its marks. As such, the opponent argues that consumers are highly likely to make a mental link between the marks. As a result, the opponent argues that use of the application would take unfair advantage of the earlier marks and, further, would be detrimental to the reputation of the opponent and/or distinctive character of the earlier marks.

6. The opponent's marks qualify as "earlier trade marks" for the purposes of this decision since they were applied for at an earlier date than the filing date of the application.[1]

7. The applicants filed a counterstatement denying the claims made and requesting that the opponent provide proof of use in relation to its second mark only.

8. Both parties filed evidence in chief with the opponent also electing to file evidence in reply. A hearing took place before me on 18 April 2024, by video conference. The applicant was represented by Mr Garry Mackay of GS Verde Law Ltd, who have represented the applicant throughout these proceedings. The opponent was represented by Mr Tom Alkin of 11 South Square, instructed by D Young & Co LLP, who have represented the opponent throughout these proceedings. Both parties filed skeleton arguments in advance of the hearing.

9. 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

[1] See Section 6(1)(a) of the Act.

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.

EVIDENCE

10. The opponent's evidence came in the form of the witness statement of Mr Richard De Leyser dated 2 May 2023. Mr De Leyser is the Managing Director of The Rolex Watch Company Limited, which he confirms is an affiliate company of the opponent. Mr De Leyser has been employed by his company for over 11 years. His statement is accompanied by 14 exhibits, being those labelled RDL1 to RDL14, and is aimed at proving use and reputation in the marks relied upon.

11. The applicants' evidence came in the form of the witness statement of Ms Emma Jane Ross-McNairn dated 30 June 2023. Ms Ross-McNairn is the Director and shareholder of the applicant, a position she has held since 22 July 2020. Ms Ross-McNairn's statement is accompanied by seven exhibits, being those labelled OP1 to OP7, and seeks to demonstrate the products that the applicant sells, the nature of the applicant's brand and to raise some issues with the evidence of the opponent.

12. In reply, the opponent filed the witness statement of Ms Tamsin Holman dated 1 September 2023. Ms Holman is a Partner and solicitor at the opponent's legal representative firm and is, therefore, duly authorised to file evidence on the opponent's behalf. This evidence consists of five exhibits, being those labelled TPH1 to TPH5 and was introduced to counter the applicant's position that there is no overlap in trade channels between toy clocks, toy watches and timepieces not specifically intended for children.

13. I do not intend to summarise the parties' evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY ISSUES

<u>The applicant's position as to the distinctiveness of OYSTER</u>

14. In its skeleton argument, the applicant made reference to there being nearly 200 live registrations on the UK trade mark registry that use the word 'OYSTER' and that Google searches put the 'Oyster Travel Card' and 'Oyster' as food on the first page. Dealing with the first point, I will say that while it is not actually before me in evidence, I appreciate that there may be a number of trade marks registered that include the word 'OYSTER' on the Register. That being said, the mere existence of trade mark registrations on the Register is not sufficient to establish that the distinctive character of 'OYSTER' has been weakened. On this point, I refer to the case of *Zero Industry Srl v OHIM*, Case T-400/06, wherein the General Court stated that:

> "73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '… there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

15. Due to the fact there is no actual evidence of any of these other marks on the marketplace before me, this argument is of no assistance and I will say no more about it. As for the reference to Google searches, this is not relevant to whether the average consumer will confuse the marks because search engines use

algorithms. For example, many businesses pay for services which enable their website to be listed higher in these search returns than they would be otherwise. In other words, the results of search engines will vary over time. In any event, the assessment as to a likelihood of confusion must take into account the reactions of average consumers, who are humans, not internet search engines.

Claims as to no evidence of confusion/honest concurrent use

16. The applicant's skeleton argument set out that the opponent has submitted no evidence of confusion despite the fact that the applicant has been selling its product for over three years. In support of this argument at the hearing, Mr Mackay reiterated the fact that there is no evidence of actual confusion and that while this "might not actually go to the application itself, it does go to the Tribunal's approach to considering how likely [confusion] is going to be". On this point I appreciate that there are instances where a lack of evidence of confusion can be a factor in Tribunal proceedings.[2] However, the case law is very clear that the length of time that the parties have been using their marks alongside each other is a relevant factor and, in the present case, three years of use by the applicant is not particularly longstanding. Further, and perhaps more importantly, the applicant's evidence in respect of its use is limited in scale (more on this below) so it is not clear how many consumers are likely to have come into contact with both parties' marks. As a result, I do not consider that the applicant's argument on this point is of any real assistance.

17. It appears to me that the applicant's position may also be construed as being an argument that there is honest concurrent use. While the reliance upon such a defence is one that needs to be expressly pleaded, I will briefly say that the applicant's evidence as to its own use is not compelling enough to support such a claim. I say this because the evidence consists of a number of printouts showing the products it sells,[3] social media accounts,[4] a listing on Amazon[5] and a list of

[2] See paragraphs 34 and 35 of *INCOGNITO*, Case BL O/078/22
[3] OP2 and OP3
[4] Also OP3
[5] OP4

Amazon Best Sellers for ‘Teaching Clocks’ which lists the applicant’s learning clock at number three.[6] While all of this is noted, it is not reflective of a sufficient level of use and neither is it longstanding. On this point, I remind myself that the burden of proving honest concurrent use is a heavy one that requires evidence of substantial parallel trade over a long period of time which results in the trade marks coming to be understood by the relevant class of consumers as denoting the goods of more than one trader. Further, there is a requirement on the applicant to establish, by virtue of its honest concurrent use, that there is no longer an adverse effect on any of the functions of the earlier trade mark.[7] As such, insofar as it was the applicant’s intention to rely on such a defence, it is of no assistance here.

The applicant’s petition evidence

18. The applicant’s evidence makes reference to a petition on change.org regarding the present proceedings. A copy of the petition has been provided and I note that it shows that it has 108,394 signatures.[8] The body of the petition discusses the opponent’s claim and sets out that the persons who started the petition do not believe that there is a risk of anyone confusing ‘us with ROLEX’. The evidence makes reference to the dispute being brought on the basis that ‘Oyster & Pop’ is too similar to ‘ROLEX’s OYSTER PERPETUAL WATCHES’. There is no express stated reason as to why this evidence was provided and I note that it was not discussed any further in the applicant’s skeleton argument nor at the hearing. Despite this, for the sake of completeness, I consider it necessary to discuss it briefly here.

19. It appears to me that this evidence was provided as a means to demonstrate that the 108,000 people who signed it do not consider that there is a likelihood of confusion. Having considered this position, I note that it does not accurately demonstrate what is at issue in these proceedings. The petition makes no

[6] OP6
[7] On this point, I refer to *Match Group, LLC & Ors v Muzmatch Ltd & Anor* [2023] EWCA Civ 454 at [115] to [117] and, also, *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09 in which the parties were engaging in parallel trade for almost 30 years.
[8] OP7

reference to the opponent's mark relied upon, being 'OYSTER' solus. Instead, the petition appears to artificially introduce the opponent's case as relying on the trade mark, 'ROLEX OYSTER PERPTUAL'. This is not the comparison at issue here and, further, the petition does not factor in imperfect recollection (being a factor for considering confusion). As a result, I am of the view that the reliance upon this petition is misguided. In addition, for the avoidance of doubt, I will say that evidence of signatories on a petition is not evidence that those consumers would not be confused but, instead, appears to be a show of support to the applicant's brand.[9]

DECISION

Proof of use

20. As set out above, the applicant has requested the opponent provide proof of use for its second mark. This was a point raised in the opponent's skeleton argument and was also a brief topic of discussion at the hearing. At the hearing, Mr Alkin set out that it was his view that the second mark could, effectively, be parked for the purposes of the hearing. In making his submissions on this point, Mr Alkin set out that the reliance upon the second mark added nothing to the opponent's reliance upon the first mark, which is protected for watches. Further, nothing in the opposition turns on the distinction between a complete watch and the watch component goods covered by the opponent's second mark. Further, to the extent that the second mark covers clocks and dials and movements for clocks, Mr Alkin stated that the opponent did not pretend in these proceedings that it had established evidence of use for the same.

21. The submissions of Mr Alkin on this point are appreciated as, essentially, they mean that I can dispense with the need to consider proof of use in these proceedings and, instead, focus solely on the opponent's first mark.[10] The evidence of use will, of course, still be relevant to the issue of enhanced

[9] In my view, the same points raised here can be said to apply with the examples referred to in Annex B of the applicant's counterstatement which, while noted, are not formally before me in evidence.
[10] I appreciate that the submissions do not indicate that the opponent revokes its reliance upon its second mark. On this point, if necessary to do so, I will return to discuss this issue at the conclusion of my decision.

distinctiveness under the section 5(2)(b) ground and the existence of a reputation under the section 5(3) ground and I will consider the same where appropriate below. In light of this approach, I consider it necessary, for ease of reference, to refer to the opponent's first mark from this point onwards as simply "the opponent's mark".

Section 5(2)(b): legislation and case law

22. Section 5(2)(b) of the Act reads as follows:

> "(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 or association with the earlier trade mark."

23. Section 5A of the Act states as follows:

> "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."

24. As set out above, the applicant did not elect to put the opponent to proof of use for its mark, despite it being registered for more than five years prior to the filing date of the application. It is not, therefore, subject to the proof of use provisions set out at section 6A of the Act. As a result, the opponent is permitted to rely on all goods for which that mark is registered, namely "watches" in class 14.

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

26. When making the comparison, all relevant factors relating to the goods 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:

> "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".

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

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

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

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

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

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

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

28. The competing goods are "watches" in class 14 of the opponent's specification and "toy clocks and watches" in class 28 of the applicant's specification. The issue of similarity between such goods was a topic of detailed discussion at the hearing. I do not intend to reproduce those submissions in full here but will do so to the extent that I deem necessary below. Before moving forward, I note that it is the position of the opponent that "watches" and "toy watches" are identical under the principle outlined in *Gérard Meric v Office for Harmonisation in the Internal Market*[11] and that "watches" and "toy clocks" are similar to a high degree. Alternatively, the applicant submits that there is a low degree of similarity between them.[12]

[11] Case T- 133/05
[12] See paragraph 7(g) of the applicant's submissions where it submitted this level of similarity between the respective goods.

29. In addition to the above position of the applicant, I note that at the hearing Mr Mackay submitted that:

> "The primary purpose of a watch or a clock is simply to tell the time. That, to me, is one of the areas where it is actually slightly misleading here in that, in Class 28, this is a toy clock, where its primary purpose is actually to help children learn the time. There is a big difference between telling the time and having to learn the time. This goes down to the basis upon which it serves that educational purpose and needs to be considered in that light."

30. I appreciate that the evidence filed by the applicant points to goods that are for teaching children how to tell the time. While noted, I have doubts as to whether the goods shown to me are 'toys' in class 28 goods and, further, whether the applicant's goods are for the purpose of learning to tell the time as opposed to being goods that are played with. That being said, I will proceed in making my assessment of the goods in the context of the applicant's submitted position, namely that the goods of the applicant are for the purpose of children learning to tell the time.

31. I note that I also have evidence from the opponent that it claims to point towards the similarity of the goods at issue. I note that this evidence consists of printouts from popular UK-wide retailers such as Argos, Dunelm, Sainsbury's, H. Samuel, House of Fraser, Debenhams, Next and H&M, all of which showing the offer for sale of children's watches, children's clocks and what would ordinarily be described as regular timepieces and watches.[13] While this evidence is noted, it is from after the relevant date for these proceedings.

32. Before moving to consider the comparison of the goods at issue, I wish to clarify two points. Firstly, I will assess the level of similarity between the goods by dissecting the applicant's term to consider "toy watches" and "toy clocks" as

[13] TPH2 to TPH5

separate goods. Secondly, I appreciate that the opponent may operate in the high-end sector of watches, however, the term for which its mark is registered is "watches" at large. This can cover any type of watch, be that a high-end watch made of precious metals or a cheaper watch that may be used to help children learn the time. In light of this and bearing in mind that the assessment I must make is a notional one based on all goods that the terms may cover, I will proceed in focusing on the latter good described, i.e. a children's watch.

33. In respect of "toy watches", I appreciate that there may be a limited degree of overlap in nature and method of use with "watches". I say this because the goods will be in the same form, i.e. a watch or watch shaped device that is worn on the wrist. Saying that, the materials that the goods are made of will differ as too will the nature of their internal components. Turning to purpose, I repeat what I have above in that the applicant's goods are for the purpose of assisting a child in learning to tell the time. As for the opponent's goods, these can cover children's watches which have features that assist the child in learning to tell the time. As such, I am of the view that regardless of whether the applicant's goods are functional watches or not, there is a degree of overlap. In respect of trade channels, I have set out above that the opponent's evidence on this point is of no assistance. Having said that, bearing in mind what I have said above in that the opponent's term is broad enough to cover watches for children, I am of the view that it is likely for producers of children's watches to also produce and sell "toy watches" and vice versa. As such, I find that there is a degree of overlap here. Turning to user, I consider that there is an overlap on the basis that both goods will be used by children and, further, are likely to be selected by parents who are looking to give them to their children so as to help them learn to tell the time. Lastly, the goods are not complementary in nature but are likely to be competitive on the basis that a purchaser looking to buy the goods for their children may choose a children's watch over a toy watch, or vice versa. Taking all of this into account, I find that these goods are similar to between a medium and high degree.

34. Turning to consider "toy clocks", I am of the view that similar outcomes will apply to that I have found above in respect of purpose, trade channels and user as well

as the competitive nature of the goods. However, the natures and methods of use will be outright different on the basis that the applicant's goods will not be watch shaped devices worn on the wrist. As a result, I consider that these goods are similar to a medium degree.

The average consumer and the nature of the purchasing act

35. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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. (as he then was) 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."

36. The applicant's position in respect of the average consumer is that those that purchase the opponent's goods will be from a professional and wealthy background who will select them as one-off purchases with a high degree of attention. As for the applicant's goods, the applicant argues that they are targeted at lower income individuals, are specifically focused on families with small children and are aimed for use by children. This approach is one that the opponent disputed at the hearing on the basis that it is in incorrect, a dispute I am minded to agree with. I say this because, in short, the assessment I must make is a notional one based on the terms as they appear before me. The opponent's term is not limited to "watches made of precious metals", for example, and is, instead, "watches" at

large. I appreciate that the goods offered by the opponent may be of a very high value, but the term as it stands covers watches of all costs. The same can be said to apply to the applicant's goods in that just because they are toys, it does not mean that they are aimed at lower income individuals.

37. The opponent's position in respect of the average consumer is that the assessment is to be focused on those that buy the applicant's goods, being those that purchase toy clocks and watches such as adults who will buy them to give to their children. This is noted but is also an incorrect approach to the identity of the average consumer. The relevant average consumer base for these proceedings is not those who will select just one party's goods but it is made up of consumers that will select the breadth of the goods at issue, being both parties' goods. In my view, this consists of members of the general public at large.

38. The goods will be available via a range of retailers, be that general retailers, toy stores or watch retailers/jewellers. The goods may also be available online. In physical stores, the goods will be displayed on shelves or behind glass cabinets where they will be self-selected by consumers after visually inspecting the product. A similar process will apply to goods selected online as they will be selected after the consumer views an image of them on a website. Regardless of where the goods are bought, they will be selected with primarily visual considerations, though I do not discount an aural component playing a role by way of word of mouth recommendations or advice from sales assistants.

39. The cost of the goods at issue will, plainly, vary quite considerably. I say this because the goods will cover cheaper toys and watches as well as significantly more expensive watches. Given the range in cost for the goods at issue, I also consider that the frequency of selection for the goods at issue will also vary dramatically. This will range from being relatively frequent selections (for the toy goods and for some cheaper watches, for example) to one off selections (for very expensive watch items, for example).

40. For the most part, I am of the view that the selection process for the goods will attract a medium degree of attention. I say this because the toy goods are likely to be selected after the consumer considers factors such as materials used, age suitability and features. As for the watch goods, consumers will consider ordinary factors such as fit, materials used and style of the watch. In my view, I consider that these factors will be considered even for relatively cheap items on the basis that, for example, consumers selecting the toy goods will still give due consideration to the above factors as they will be giving those goods to their children. In addition, given that “watches” can cover significantly more expensive purchases, I am of the view that consumers will consider additional factors to those discussed above. This will include consideration as to internal mechanisms used (the nature of the watch movement, for example), warranty offered, the presence of precious materials and the purported accuracy of the timepiece. The selection for such goods will, in my view, attract a high degree of attention.

41. To conclude, I find that goods at issue will be selected by members of the general public who will select them with, generally, a medium degree of attention that extends to high where expensive items are considered. The visual component will dominate the selection process but I do not discount an aural component playing a role.

Comparison of the marks

42. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

43. 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 trade marks are shown below:

The opponent's mark	The application
OYSTER	Oyster and Pop Oyster & Pop ("series of two")

46. I have submissions from the parties in respect of the comparison of the marks. While these are noted, I do not intend to reproduce them here but will, if necessary, discuss them further below.

Overall Impression

47. The opponent's mark is a word only mark consisting solely of the word 'OYSTER'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself. As for the marks in the application, these are both word only marks that are 'Oyster and Pop' and 'Oyster & Pop'. While the differing use of 'and' and '&' will be noticed, they will be understood as meaning the same thing. While I do not consider that the phrase 'Oyster and Pop' will be understood as

having a unitary meaning, I consider that the words do hang together and, therefore, find that the words in the phrase contribute equally to the overall impressions of the marks.

Visual Comparison

48. Visually, the marks share the word ‘OYSTER’. This is the sole element of the opponent’s mark and the first element of the marks in the application. The points of difference between the marks are the words ‘and Pop’ or ‘& Pop’ (depending on which mark in the application is being viewed). I appreciate that the beginning of the marks in the application are identical to the opponent’s mark (being where consumers tend to focus),[14] however, the additional elements are still points of visual difference. Taking all of this into account, I am of the view that the marks at issue are visually similar to a medium degree.

Aural Comparison

49. Aurally, the marks in the application are identical and I will, therefore, consider them together. Both parties’ marks consist of ordinary dictionary words that will be pronounced in the ordinary way. The applicant’s marks consist of four syllables whereas the opponent’s consist of just two. The two syllables that make up the opponent’s mark are identical to the first two syllables in the applicant’s marks. The last two syllables in the applicant’s marks have no counterpart in the opponent’s mark. The points of difference in the applicant’s marks mean that they are double the length of the opponent’s marks. Taking all of this into account, I am of the view that the marks at issue are aurally similar to a medium degree.

Conceptual Comparison

50. As was the case with the aural comparison above, I will assess the applicant’s marks together. In considering the applicant’s marks, I consider that the consumer

[14] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

will readily identify the meaning of the words, i.e. 'Oyster' will be understood as a reference to a shellfish[15] and 'Pop' will be understood as a reference to a short, sharp sound such as the popping of a balloon, for example. Plainly, the word 'and' or the ampersand sign will be understood as connecting the two. While the words in the phrase hang together, I do not consider that they have a unitary meaning outside of the meaning associated with the individual words. As for the opponent's mark, this is the word only 'OYSTER' and will, therefore, share an identical meaning to the use of the same word in the applicant's marks. While a point of conceptual identity, the words 'and Pop'/'& Pop' will, despite having no obvious meaning in the context of the mark as a whole, still contribute as points of conceptual difference. Overall, I consider that the marks are conceptually similar to a medium degree.

Distinctive character of the opponent's 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

[15] I note that the applicant's evidence, at OP7, sets out that it chose 'Oyster' because it refers to the road 'Oyster Bend' where the owners of the company were born and grew up. While this may have been the applicant's intention, there is nothing before me to suggest that consumers will be aware of this meaning.

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 varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up 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. In the present case, the opponent has pleaded that its mark enjoys an enhanced degree of distinctive character. While I will consider the opponent's evidence below, I will first consider the inherent position.

53. At the hearing, Mr Mackay stated that 'OYSTER' is not in itself distinctive. On this point, I refer to the case of *Formula One Licensing BV v OHIM*[16] which sets out that by virtue of being a registered trade mark, the opponent's mark is to be afforded at least some degree of distinctive character. In any event, 'OYSTER' is an ordinary dictionary word with a commonly known meaning, i.e. a reference to a shellfish. Inherently, such a word is not descriptive of, or allusive to, watches. On this point, I wish to discuss the fact that there is evidence before me that explains that 'OYSTER' was chosen because it is a word that evokes water resistance.[17] While noted, I do not consider that consumers would make this connection and, therefore, I do not consider that it carries any descriptive, allusive or laudatory meaning. As a result, I see no reason why its distinctiveness would even be low. On the contrary, I am of the view that use of a known word that is not allusive or descriptive is sufficient to lead to a finding that the opponent's mark enjoys a medium degree of inherent distinctive character.

[16] Case C-196/11P
[17] See page 7 of RDL7

Evidence of use

54. I turn now to consider the evidence of the opponent. I note that the evidence begins with reference to the ROLEX branding and how large the opponent as a company is. I have two brief points I wish to make in respect of this. Firstly, I do not consider it controversial to accept that the Rolex brand is a very large watch brand that is known across the world. Secondly, however, the assessment I must make here is not the enhanced distinctiveness relating to the Rolex brand but to the word 'OYSTER'. Therefore, I see no merit in discussing evidence relating to the Rolex brand.

55. The opponent claims that the OYSTER branding has been used extensively since 1926 in relation to watches.[18] I note that the evidence sets out the names of the models featuring the OYSTER branding over the years. These brandings show OYSTER in use with additional words, in combinations such as OYSTER PERPETUAL and OYSTER PERPETUAL DAY-DATE, for example. Images of the opponent's watches are shown in evidence via a range of printouts taken from the opponent's website.[19] Only a limited number of images show the word 'OYSTER' solus displayed underneath the word 'ROLEX' on various watch faces.[20] It is my view that two of these images are promotional images as opposed to use of the mark on an actual watch face. I say this because those images are as follows:

[18] There is reference to additional goods such as clocks, dials and movements for clocks and watches but these are not at issue here so I see no reason to discuss such claims further.
[19] RDL3 to RDL5 and RDL7
[20] See pages 8, 10 and 21 of RDL3 and page 2 of RDL4

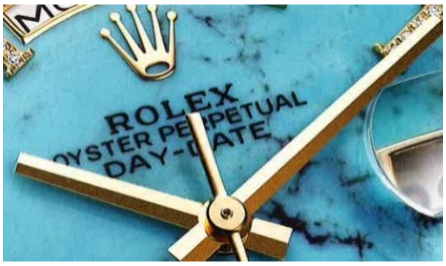
56. These are promotional images that are just images of watch faces as opposed to an image of the finished product of a watch sitting within a case and attached to a strap. From the evidence, I can only see two examples of use of such branding on a watch. This is in the form of two printouts from the opponent's website, the first of which sets out that this is the 'quintessential original' and also includes an advertising printout that featured in the Daily Mail in 1927. The second printout is taken from the timeline of the Rolex brand's history. Both printouts explain that the first use of Rolex Oyster came in 1926. Images of this evidence are shown below:

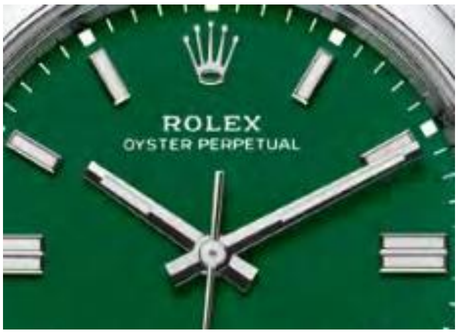
57. There are subsequent, but limited, references to just the Rolex Oyster branding in the timeline provided.[21] This appears to end when the timeline gets to 1953 when the references change to 'Rolex Oyster Perpetual'.

58. In addition to the above, I note that the majority of examples of use, show the word 'ROLEX' displayed above the words 'OYSTER PERPETUAL' that appears on the same line.[22] This same style of branding also appears in a range of catalogues that

[21] Pages 2 to 5, 7 and 8 of RDL4
[22] See the majority of watches shown at RDL7

the opponent has provided showing its range of ‘OYSTER’ branded watches.[23] As illustrative examples, I consider it necessary to reproduce some images of the branding as shown on these watch faces below:





59. Throughout this evidence, there is mention of the fact that ‘OYSTER’ is a reference to the ‘oyster case’, being the waterproof case used to encompass the watch.[24] In addition, there is reference to a watch bracelet that is referred to as being an ‘OYSTERFLEX’ bracelet,[25] a locking mechanism called ‘OYSTERLOCK’[26] and a metal called ‘OYSTERSTEEL’.[27] As the opponent’s mark is not registered for parts of watches, this evidence is of no assistance.

60. Additional printouts taken from prior to the relevant date (via the Wayback Machine) are provided that show the opponent’s OYSTER branded watches listed on third party retailers websites.[28] I do not intend to discuss this in any great detail

[23] RDL8 which consists of catalogues that the narrative evidence confirms as being distributed to official Rolex retailers in the UK.
[24] See for example, page 12 of RDL3, being a printout of the opponent’s website taken from the internet archive facility, the Wayback Machine, dated 6 November 2020
[25] See page 12 of RDL6
[26] See page 16 of RDL6
[27] See pages 22 of RDL6
[28] RDL9

as it shows watches consistent with those reproduced at paragraph 58 above, namely a range of watches branded as 'OYSTER PERPETUAL'.

61. The evidence then goes on to discuss a range of large sponsorships that the opponent undertakes. Printouts of the sponsorships are shown and I note that these include the Masters golf tournament, the US Open tennis tournament, Wimbledon and a range of motorsport events such as Formula One, Le Mans and Goodwood Revival.[29] While I note that the images show a number of OYSTER PERPETUAL watches, the sponsorship appears to be under the Rolex brand and it is not clear the actual exposure the OYSTER brand had during these sponsorships.

62. On a similar point to the above, I note that evidence is provided in relation to adverts for the opponent's watches that feature a range of celebrities and sports stars wearing the opponent's OYSTER PERPETUAL watches.[30] I do not intend to discuss them all but note that they include globally recognised sports figures such as Roger Federer and Tiger Woods and, further, it is confirmed in the narrative evidence that such adverts were published in UK publications such as Harrod's Man Edit, the Sunday Times and the Daily Telegraph, all prior to the relevant date. This same evidence shows two collaborations with TIME Magazine that show various images of people who are referred to as 'Today's Visionaries, Tomorrow's Future'.[31] I note that some of the people are likely to be well-known celebrities (such as Roger Federer, for example) but others may be less known to consumers in the UK (such as social entrepreneur Reese Fernandez-Ruiz and ophthalmologist Andrew Bastawrous, for example). The narrative evidence appears to set out that this is an advert for the watch OYSTER PERPETUAL 39.

63. The evidence includes printouts taken from various social media accounts owned by the opponent.[32] These show the opponent's Instagram, Facebook and Twitter accounts. In addition, there are printouts taken from the opponent's YouTube

[29] RDL10
[30] Pages 2 to 7 of RDL11
[31] Pages 8 to 15 of RDL11
[32] RDL12

account.[33] I appreciate that the level of engagement for the posts and accounts shown are significant. However, the issue with this evidence is that social media is often international in nature and there is nothing to suggest the level of engagement that actually relates to that of the UK consumer. In any event, I note that the various accounts shown are under the branding 'ROLEX' and not 'OYSTER'. As for the actual posts shown, I note that these show use of the mark on watches in the same vein as those already reproduced above and I see no reason to reproduce such use again here.

64. Turning to advertising evidence, the opponent claims to have advertised its watches for nearly 100 years. In respect of UK advertising, I note that the narrative evidence provides a breakdown of the advertising spend incurred by the opponent in relation to its OYSTER mark between 2017 and 2022. These figures are as follows:

Year	**Advertising spend (£)**
2017:	6,000,000
2018:	6,000,000
2019:	2,800,000
2020:	2,600,000
2021:	3,300,000
2022:	2,800,000
Total:	23,500,000

65. Examples of the advertising undertaken in the UK are also provided.[34] These include features in Revolution Magazine, The Financial Times, Surrey Life and the Financial Times Weekend Magazine. The printouts provided are all from prior to the relevant date. I note that all, save for one, include images of watches consistent with the branding already discussed above. The alternative branding shown does

[33] RDL13
[34] RDL14

show the OYSTER branding but this is significantly less prominent than the other examples shown in evidence. For illustrative purposes, this image is as follows:[35]

66. In order to support its claims, the opponent reiterates that it has sold watches under the OYSTER branding all over the world for nearly 100 years. The evidence then goes on to speak to the level of sales of watches featuring the OYSTER mark in the UK between 2017 and 2022.[36] These are as follows:

Year	**UK revenue (£)**
2017:	2,400,000
2018:	2,000,000
2019:	2,100,000
2020:	2,000,000
2021:	2,900,000
2022:	3,500,000
Total:	14,900,000

67. On the point of the revenue figures and advertising spend provided, I wish to clarify that the figures from 2022 are likely to cover figures from after the relevant period

[35] This image has been stitched together to show the entire watch face which, in evidence, is spread over two pages.
[36] The narrative evidence states that these figures are to be read as figures 'in excess of' the amount shown.

for these proceedings. I say this because the relevant date sits just before the halfway point of the year meaning it is likely that a significant proportion of those figures provided are of no assistance here. While I have no way to accurately determine how much of these figures are relevant, this is a point I will bear in mind in considering my assessment of the evidence.

Conclusions on the evidence

68. As I have suggested above, I do not consider it controversial to suggest that the opponent is a very large and well-known watch brand. This is something that I am willing to take judicial notice on as I do not consider it to be a point that is the cause of any serious dispute.[37] It does not appear to me that the applicant disputes such a point. However, the applicant does dispute that, when you look at the evidence, the use before me requires the word 'ROLEX' in order to give it any kind of distinct entity. Further, at the hearing, Mr Mackay stated as follows:

> "There is a mix and match between the power of the Rolex brand and OYSTER on its own, and that when you look at OYSTER on its own, the opponent's position that they have this well-established mark of nearly 100-odd years is actually not supported by the evidence on how that is portrayed and how it is publicised. It is not publicised as OYSTER, it is always publicised using the crown, Rolex, and always then usually by Perpetual or Daytona or some other sub-brand that it associates itself to."

69. Speaking to Mr Mackay's point, clearly ROLEX is the primary indicator of origin of the goods shown in evidence before me. That being said, use of a sub-brand does not mean that the sub-brand cannot enjoy a finding of enhanced distinctiveness in its own right. The issue for the opponent here, however, is that the sub-brand is itself most commonly used as part of a composite mark, being 'OYSTER PERPETUAL'.[38] I must, therefore, consider whether use of 'OYSTER

[37] *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08
[38] I appreciate that evidence shows additional words, however, these are often underneath the words 'OYSTER PERPETUAL' and are likely to be indicators of the watch models as opposed to an indication of branding.

PERPETUAL' is sufficient to give rise to a finding that any enhanced distinctiveness lies in the word 'OYSTER' solus.

70. In considering this point, I am of the view that the words 'OYSTER PERPETUAL' do not form a unitary meaning and neither does one word qualify or inform the other. As such, I find that each word retains its own meaning. On this point, 'PERPETUAL', on watch goods, will be understood as a somewhat laudatory reference to the perpetual (never ending) motion of the opponent's watches or the long-standing nature of the opponent's products. Despite the existence of evidence explaining that the 'OYSTER' was chosen because it is a word that evokes water resistance,[39] I repeat my point from my inherent distinctiveness assessment wherein I set out that I did not consider that consumers would be aware of this. Therefore, I am of the view that when viewing the mark as used in the evidence, consumers would still attribute distinctiveness to the word 'OYSTER' as a reference to a sub-brand of 'ROLEX'.

71. In light of the above, I am satisfied that the way in which the opponent has used 'OYSTER' in the evidence is capable of being attributed enhanced distinctiveness so long as the evidence warrants such. On this point, I wish to first discuss the evidence of advertising. I appreciate that the evidence confirms that the opponent spent approximately £23.5 million advertising its OYSTER brand. However, such advertising costs greatly outweighs the revenue figures provided. Further, the evidence before me of advertising for different sport events, for example, appear to show advertising of the Rolex brand and not the OYSTER brand. The evidence does show an image of an OYSTER watch alongside the sponsorship information but nothing is before me demonstrating whether consumers would have even seen such goods during the course of the sponsorship. On this point, the only evidence before me showing actual discernible evidence of the opponent's presence at these events is as follows:

[39] See page 7 of RDL7

(at the US Open in 2020)

(at Wimbledon in 2019)

72. Such evidence makes no reference to OYSTER. In addition, I appreciate there are images showing Wimbledon winners Roger Federer (2017) and Angelique Kerber (2018) wearing watches and that those watches are likely to be OYSTER watches, however, there is nothing to suggest whether anyone viewing the event knew what brand those watches were.

73. Following what I have said above, I consider it necessary to set out briefly that the focus of part of the advertising evidence on the Rolex brand leads me to conclude that the advertising spend evidence cannot be said to relate solely to the OYSTER brand. I do appreciate, however, that this does not discount the evidence as a whole as, clearly, there is evidence of advertising of the OYSTER brand by way of advertisements placed in a number of UK based publications. So while I do not discount the advertising spend provided, I am of the view that I am entitled to treat it with a degree of caution in light of the issues described above.

74. While this issue as to the advertising evidence is noted, I do not consider that the same can be said to apply to the actual sales revenue figures provided. In short, the entirety of the evidence of watches shown before me all include the OYSTER branding and, as such, I have no reason to doubt that these figures accurately reflect the level of sales associated with watches bearing the relevant branding. In total, the evidence of sales suggests that the opponent has sold in excess of £14.9 million over 6 years. I remind myself that not all of this turnover is relevant as the 2022 figures are likely to include sales from after the relevant date. That being said, this is only likely to have a limited impact on the total figures provided.

75. I note that I have no evidence before me as to the size of the market at issue. Even without such evidence, I am of the view that it is likely to be a fairly sizeable market. I do, however, appreciate that the nature of the market is not such that it attracts an overly high volume of frequent sales. I say this because while some cheaper brands of watches may be sold on a more frequent basis than the opponent's watches, I do not consider that this will be on an overly frequent basis so as to suggest that the market is a fast natured one. So while I do not consider that the level of sales shown to me in the evidence are overly large in comparison to the market at issue, I am satisfied that they reflect a sizeable level of use that is likely to reflect a fairly respectable market share.

76. Taking all of the evidence into account, I am of the view that it does reflect a finding that consumers would, upon seeing the mark 'OYSTER', associate it with the opponent. While I appreciate that this will be as a sub-brand, I am satisfied that the use before me points to the existence of an enhanced degree of distinctive character. In further support of such a finding, I remind myself that while the turnover figures only cover six years of sales, the evidence is clear in that the opponent has used its 'OYSTER' brand for a very longstanding period of time. All of the above being said, I do not consider that the evidence is so compelling to warrant a significant increase in the distinctiveness to an outright high degree. I say this because while the sales figures are reflective of a sizeable level of use, they are not overly significant in the context of the market at issue. Therefore, I find that the distinctiveness of the opponent's mark has been enhanced to between a medium and high degree in relation to watches.

Likelihood of confusion

77. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. 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 trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s mark, the average consumer for the goods 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 trade marks and must instead rely upon the imperfect picture of them that he has retained in his or her mind.

78. I have found the parties’ goods to be similar either to between a medium and high degree or a medium degree. I have found the average consumer for the goods to be members of the general public at large who will select the goods via primarily visual considerations (though I do not discount the aural component) and after having paid, generally, a medium degree of attention. I have, however, found that some goods on the more expensive end of the scale would attract a high degree of attention. In respect of the similarity of the marks at issue, I have found them to be visually, aurally and conceptually similar to a medium degree. I have found that the opponent’s mark is inherently distinctive to a medium degree but that this has been enhanced to between a medium and high degree due to the use made of it.

79. In the present case, I note that the opponent’s submissions at the hearing set out that it is focusing on indirect confusion. While this focus is noted, for the avoidance of doubt, I will give a brief finding on direct confusion.

80. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I am of the view that consumers will not misremember or inaccurately recall the parties’ marks for one another. I appreciate that the marks at issue share the word ‘OYSTER’ (which sits at the beginning of the marks in the application) and that the opponent’s mark enjoys a degree of enhanced distinctive character. However, I do not consider that these are factors sufficient enough to lead consumers to forget that the application includes the additional words ‘and

Pop'/'& Pop'. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks at issue.

81. I turn now to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein 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.).

(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)”.

82. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 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.

83. The opponent’s position as to indirect confusion is that (1) the common element of the marks is so strikingly distinctive (both inherently and enhanced through use) for watches that this is a case that falls within category (a) of *L.A. Sugar* (cited above) and (2) there is a compelling logic to ‘Oyster and Pop’/‘Oyster & Pop’ as a sub-brand of the main ‘OYSTER’ brand, aimed at children. The opponent argues that the adding of the words ‘AND POP’ maintains the well-known ‘OYSTER’ brand and that this will appeal to adult purchasers, whilst adding a whimsical second element that is clearly designed to engage the interests of children who may not be so familiar or interested in the ‘OYSTER’ brand.

84. While I see no reason why consumers would believe it was logical for an undertaking operating under the ‘OYSTER’ brand to add the words ‘and Pop’/‘& Pop’ to indicate a sub-brand or brand extension, I do see merit in the argument that ‘Oyster’ is distinctive enough to result in a finding that only one undertaking would use it. On this point, I remind myself that I have found the evidence to give rise to a finding that the opponent’s mark has been enhanced to between a medium and high degree. While not outright high, it is on the higher end of the scale.

Further, from an inherent position, the word 'OYSTER' is not descriptive or allusive of the goods at issue so its shared use would not be considered coincidental. Taking this into account and bearing in mind the level of similarity between the goods at issue, I am of the view that consumers would believe that the marks at issue originate from the same or economically connected undertakings. Taking this into account and even bearing in mind the comments of Arnold LJ and Mr Mellor Q.C. referenced at paragraph 82 above, I find that there exists a likelihood of indirect confusion between the marks at issue.

85. As a result of the above, the opposition reliant upon the section 5(2)(b) ground has succeeded in full. I will now proceed to consider the section 5(3) ground of this opposition.

Section 5(3)

86. Section 5(3) of the Act states:

> "5(3) A trade mark which –
>
> > 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 repute of the earlier trade mark."

87. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure,* Case C-323/09, *Marks and Spencer v Interflora,* Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

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

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

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63.*

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

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

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

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

88. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar. Secondly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the

factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

89. The opponent relies upon the same earlier mark and goods under the present ground as it did under its section 5(2)(b) ground. I have already summarised the evidence insofar as it relates to the 'OYSTER' mark for "watches" at paragraphs 54 to 67 above. While that assessment related to the issue of enhanced distinctiveness, it is equally relevant here. This is because the relevant dates and relevant territories for the assessments are the same. Further, whilst the tests for enhanced distinctiveness and reputation are different, the factors relevant to both assessments are the same. As a result, I see no merit in reproducing that summary here. Instead, I will simply say that for similar reasons to those given at paragraphs 68 to 76 above, I find that the opponent's mark enjoys a reputation in the UK in relation to watches that is at an above moderate degree of strength.

Link

90. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

<u>The degree of similarity between the conflicting marks.</u>

91. The marks are issue are visually, aurally and conceptually similar to a medium degree.

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.

92. I have found above that the goods at issue are similar to either between a medium and high degree or a medium degree. In addition, even if it were not the case that the goods were similar, I find that they would still be selected by overlapping sections of the relevant public.

The strength of the earlier mark's reputation.

93. I have found that the strength of the reputation enjoyed by opponent's mark is at an above moderate level.

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

94. Inherently, I have found the opponent's mark to be distinctive to a medium degree. I consider that as a result of the evidence before me, this has been enhanced to between a medium and high degree in relation to watches due to the use made of it.

Whether there is a likelihood of confusion

95. I have found that there exists a likelihood of indirect confusion between the marks.

Conclusions on link

96. At the hearing, Mr Mackay raised two points in respect of the issue of link. First, he claimed that the opponent had not filed any evidence to support the existence of any mental link between the marks. Secondly, he argued that the reputation does not lie in 'OYSTER' but in the Rolex brand meaning that there can be no link between 'OYSTER' and the application. In response to the former point, Mr Alkin

argued that the issue as to a lack of evidence on this point was neither here nor there and that, instead, the present assessment involves a question of analysing the similarities and differences between the two marks and deciding whether they are sufficient as to create a link. In short, I agree with Mr Alkin's submissions on this point that evidence of a link is not necessary. Much like a consideration of confusion under section 5(2)(b) grounds, this is a notional assessment based on the factors before me. In respect of the second point raised by Mr Mackay, I will simply repeat my position from above in that I have found that there is a degree of distinctiveness and reputation in OYSTER meaning that his submission on this point is of no assistance.

97. While the present assessment as to the existence of a link is not the same as the one undertaken when considering the issue of confusion, I consider that as there exists confusion between the marks, it plainly follows that consumers would, upon being confronted by the applicant's marks, be caused to wonder if it was linked to the opponent's mark. This is particularly the case in light of my finding that the opponent's mark enjoys a reputation at an above moderate level and between a medium and high degree of enhanced distinctive character.

98. Even if I was wrong to find confusion and at least a medium degree of similarity between the goods at issue, this does not mean that there cannot exist a link between the marks.[40] In this scenario, it is my view that the reputation and distinctiveness enjoyed by the opponent's mark (though not at the highest levels) and the shared use of the identical word 'OYSTER' are such that consumers will believe that's there exists a link between them. I make this finding because I consider it likely that consumers who are familiar with the opponent's reputation would, upon being confronted with the similar marks in the application, be caused to wonder if they were connected to the opponent's branding. As a result, regardless of any finding of confusion or similarity of the goods, I consider that a

[40] On this point, I remind myself that the applicant's submissions are that the goods are similar to a low degree. Therefore, even if I was wrong to find similarity to the degrees that I have, the goods would, at worst, be similar to a low degree.

link will be made and, therefore, the opponent's reliance upon the present ground may proceed.

Damage

99. The opponent has pleaded that use of the applicant's marks would, without due cause, lead to an unfair advantage in favour of the applicant and cause a detriment to both the reputation of the opponent and to the distinctive character of the opponent's mark.

Unfair Advantage

100. I bear in mind that unfair advantage has no effect on the consumers of the opponent's goods. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to select the goods of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

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

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts

to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

102. In support of a claim as to unfair advantage, Mr Alkin submitted at the hearing that:

"A lot of adults will see OYSTER as an aspirational brand for watches, whether they can afford one or not, and when they are choosing a watch or a clock for their child, the fact that the brand of that watch or clock reminds them of the OYSTER brand and all of its aspirational and extremely sophisticated connotations, in my submission, will plainly make it easier for [the applicant] for watches and clocks sold under the Oyster and Pop brand to find favour among consumers. That is a classic example of free riding, that is riding on the coattails of the OYSTER mark and its fame which has been built up over the last century. That is not to suggest that that was [the applicant's] intention, it is not to suggest that this is what they were trying to do but it is, we say, on a fair notional use, unfortunately, an objective consequence of the mark that they have chosen."

103. Given that I have found that there exists a likelihood of indirect confusion between the marks at issue, I consider that unfair advantage is automatically made out on the basis that consumers (who are aware of the opponent's mark and its reputation) will erroneously purchase the applicant's goods on the mistaken belief that they are connected to the goods of the opponent. Such a scenario clearly demonstrates a transfer of image from the opponent's mark to the applicant's marks, therefore giving the proprietor a commercial advantage without paying financial compensation. The applicant's claim as to unfair advantage, therefore, succeeds on this basis.

104. However, if I am wrong to have found confusion, I consider that an unfair advantage would exist in any event. I say this because the above submission of Mr Alkin is, in my view, a valid argument as to the existence of unfair advantage under the present ground. While I do not consider it necessary to fully echo the comments of Mr Alkin, I do agree that those consumers who are aware of the

OYSTER brand's reputation will likely transfer the image of that brand to the goods of the applicant, even if that consumer is buying the goods for their children. For example, if an adult consumer was aware of the OYSTER brand of watches and was looking to select a toy watch for their child, I am of the view that the identical use of 'Oyster' in the application would, notwithstanding the presence of 'and Pop'/'& Pop', result in the image conveyed by the opponent's mark being transferred onto the applicant's goods.[41] I consider it reasonable to suggest that it is likely that this consumer would, being aware of the reputation, select the applicant's goods due to the perceived connection with the opponent's brand. Such a connection would achieve instant familiarity in the eyes of the average consumers, thereby securing an unfair commercial advantage and benefitting from the opponent's reputation without paying financial compensation. Such commercial advantage would not exist were it not for the reputation of the opponent's mark. Therefore, I find it likely that the application takes unfair advantage of the opponent's mark.

105. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. The section 5(3) ground of the opposition, therefore, succeeds.

CONCLUSION

106. The opposition has succeeded in full meaning that the application is, subject to any successful appeal against this decision, hereby refused for the following goods:

Class 28: Toy clocks and watches.

[41] I am of the view that such an outcome would apply regardless of whether the goods were considered similar to only a low degree or outright dissimilar. I say this because even if the goods are dissimilar, the present ground does not require the goods to be similar. On this point, I remind myself that the goods at issue will be selected by an overlapping section of the relevant public meaning that the association discussed here would apply regardless.

107. As this was a partial opposition aimed only against those goods listed above, the application may proceed to registration for all of the remaining goods for which registration is sought.

COSTS

108. As the opponent has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £2,100 as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement of the applicant:	£300
Preparing evidence:	£800
Preparing for and attending a hearing:	£800
Official fees:	£200
Total:	**£2,100**

90. I hereby order Oyster and Pop Limited to pay Rolex SA the sum of £2,100. The above sum should 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 27th day of June 2024

A COOPER
For the Registrar

ANNEX 1

Class 9

Height charts; Chart recorders; Magnetic recording charts; Magnetic pens; Teaching instruments; Teaching apparatus; Teaching and instructional apparatus; Teaching apparatus and instruments; Teaching and instructional apparatus and instruments; Instructional and teaching apparatus and instruments; Electronic instructional and teaching apparatus and instruments; Science sets for children being teaching apparatus; Erasing magnets; Magnetic tape erasers; Educational software; Education software; Downloadable educational media; Children's educational software; Fridge magnets; Magnets; Tapes (Magnetic -); Decorative magnets; E-books; Downloadable electronic books; Downloadable e-books; Downloadable posters.

Class 16

Stationery; Pins [stationery]; Stickers [stationery]; Party stationery; Scented stationery; Office stationery; Stationery folders; Seals [stationery]; Transparencies [stationery]; Stationery boxes; Envelopes [stationery]; Printed stationery; Thumbtacks [stationery]; Paper stationery; Wrappers [stationery]; Binders [stationery]; Folders [stationery]; Stationery cases; Stencils [stationery]; Pads [stationery]; Manifolds [stationery]; Writing stationery; Covers [stationery]; Files [stationery]; Rubber bands [stationery]; School supplies [stationery]; Pencil ornaments [stationery]; Adhesive pads [stationery]; Reinforced stationery tabs; Pocket books [stationery]; Adhesives for stationery; Paper folders [stationery]; Office paper stationery; Paper sheets [stationery]; Index cards [stationery]; Gummed tape [stationery]; Announcement cards [stationery]; Document holders [stationery]; Marking pens [stationery]; Cases for stationery; Pencil ornaments (stationery); Adhesive foils stationery; Tapes (adhesive -) [stationery]; Writing cases [stationery]; Stationery-type portfolios; Copying paper [stationery]; Document files [stationery]; Envelopes for stationery use; Glitter for stationery purposes; Stationery and educational supplies; Rubber cements for stationery; Starch paste for stationery; Adhesives for stationery purposes; Wood pulp board [stationery]; Organizers for stationery use; Plantable seed paper [stationery]; Clips for paper [stationery]; Seaweed glue for stationery; Adhesive tape cutters being stationery; Sealing compounds for stationery purposes; Spirit gum for stationery purposes; Gummed cloth for stationery purposes; Adhesive bands for stationery purposes; Cabinets for stationery [office requisites]; File pockets for stationery use; Marking inks for stationery purposes; Glue pens for stationery purposes; Sealing tape for stationery use; Adhesive tape for stationery purposes; Stationery (Cabinets for -) [office requisites]; Glitter glue for stationery purposes; Adhesive tapes for stationery purposes; Glitter pens for stationery purposes; Glue for stationery or household purposes; Pastes for stationery or household purposes; Self-adhesive tapes for stationery use; Adhesives for stationery or household use; Adhesives for stationery and household use; Glue for stationery or household use; Felt mats for Chinese calligraphy (stationery); Isinglass for stationery or household purposes; Document holders being articles of stationery; Adhesives for stationery or household purposes; Desktop cabinets for stationery [office requisites]; Protractors [for stationery and office use]; Stapling guns (Electric -) for stationery use; Paste for stationery or household purposes; Plastic adhesives for stationery or household purposes; Gums [adhesives] for stationery or household purposes; Double sided adhesive tapes for stationery use; Stapling guns (Hand-operated -) for stationery use; Latex glue for stationery or household purposes; Gluten [glue] for stationery or household purposes; Gelatine glue for stationery or household purposes; Adhesives [glues] for stationery or household purposes; Adhesive tapes for stationery or household purposes; Self-adhesive tapes for stationery and household purposes; Self-adhesive tapes for stationery or household purposes; Starch paste [adhesive] for stationery or household purposes; Adhesive tape dispensers for household or stationery use; Label printing machines for household and stationery use; Pastes and other adhesives for stationery or household purposes; Gum arabic glue for stationery or household purposes; Red algae gelatine glue, for stationery or household purposes (funori); Red algae gelatine glue, for stationery or household purposes [funori]; Charts; Wall charts; Flip charts; Colour charts; Score charts; Printed charts; Blank flip charts; Pens; Colouring pens; Artists' pens; Steel pens; Fountain pens; Pen trays; Pen sets; Pen rests; Correction pens; Drawing pens; Film pens; Pen refills; Pen cartridges; Highlighter pens; Stylographic pens; Inkless pens; Pen clips; Pen nibs; Etching pens; Pen holders; Pen stands; Pen boxes; Fibertip pens; Marker pens; Highlighting pens; Coloured pens; Colour pens; Pen wipers; Pen cases; Ball pens; Rollerball pens; Ballpoint pens; Marking pens; Felt pens; Ink pens; Brush pens; Pens [office requisites]; Pen ink refills; Marking pen refills;

Boxes for pens; Cases for pens; Fiber-tip pens; Ball-point pens; Pen ink cartridges; Ink for pens; Felt writing pens; Steel pens [styluses or stencil pens]; Ballpoint pen refills; Gel roller pens; Porous tip pens; Pocket pen shields; Ball point pens; Roller ball pens; Felt tip pens; Pen and pencil cases; Stands for pens; Fibre-tip pens; Pens for marking; Felt marking pens; Felt-tip pens; Pen or pencil holders; Pen and pencil holders; Stands for pens and pencils; Pen and pencil boxes; Paper; Paraffined paper [waxed paper]; Paper stock [printing paper]; Stencil paper [mimeograph paper]; Graph paper; Gummed paper; Paper emblems; Paper signs; Directory paper; Thermal paper; Honeycomb paper; Opaque paper; Calligraphy paper; Paper pads; Paper clasps; Parchment paper; Paper folders; Note papers; Writing paper; Paper-clips; Paper flags; Bunting [paper]; Paper garlands; Paper signboards; Paper tapes; Teaching manuals; Teaching materials; Paper teaching materials; Printed teaching materials; Printed teaching material; Teaching materials [except apparatus]; Instructional and teaching materials; Instructional and teaching material; Printed teaching activity guides; Histological sections for teaching purposes; Instructional manuals for teaching purposes; Instructional and teaching material (except apparatus); Plastic envelopes; Plastic wrap; Plastic transparencies; Drawing pencils; Drawing sets; Drawing ink; Drawing books; Drawing rulers; Drawing templates; Drawing stencils; Drawing brushes; Drawing instruments; Drawing materials; Drawing pads; Chalks for drawing; Drawing instruments for blackboards; Writing or drawing books; Drawing materials for blackboards; Desk organisers; Personal organisers; Pencils; Charcoal pencils; Correction pencils; Coloured pencils; Pencil sharpeners; Mechanical pencils; Retractable pencils; Color pencils; Colouring pencils; Colour pencils; Propelling pencils; Pencil trays; Pencil holders; Pencil erasers; Artists' pencils; Pencil cases; Pencil boxes; Pencil grips; Pencil sets; Painting pencils; Pencils for colouring; Attachments for pencils; Decorations for pencils; Leather pencil cases; Pencils with erasers; Whiteboards; Whiteboard erasers; Whiteboards having magnetic properties; Dry erase markers; Dry erase writing boards; Erasers; Chalk erasers; Blackboard erasers [chalk erasers]; Cap erasers; Writing board erasers; Erasers (Writing board -); Wet erase markers; Erasing products; Rubbers for erasing written text; Correcting and erasing implements; Wet erase paper labels; Educational equipment; Educational books; Educational publications; Printed educational materials; Educational and instructional material; Magnetic levitation floating globes; Decals; Wall decals;

Resource books; Books; Book wrappings; Score books; Sketch books; Book covers; Children's books; Book markers; Activity books; Sticker books; Book ends; Printed books; Painting books; Scrap books; Writing books; Book marks; Exercise books; Colouring books; Coloring books; Picture books; Note books; Children's activity books; Exercise-book covers; Leather book covers; Posters; Posters made of paper; Cards; Blank cards; Picture cards; Index cards; Flash cards; Reference cards; Motivational cards; Printed cards; Marking tabs; Chalk (Marking -); Sticker activity books; Stickers; Stickers [decalcomanias]; Sticker albums; Adhesive stickers; Covers for books; Covering materials for books; Protective covers for books; File binders; File dividers; Filing cards; Card files; File trays; Document files; Box files; File sorters; File folders; Expanding files; Ring files; File indexes; Filing containers; File covers; File cards; Letter files; Holders for files; Lever arch files; Document file racks; Files [office requisites]; Paper file jackets; Paper expanding files; File sorters [office requisites].

Class 28

Toy clocks and watches; Toys; Educational toys; Developmental toys; Children's toys; Educational playthings; Electronic educational teaching games; Card games; Cards [games]; Game cards; Games; Playing cards; Dice games; Party games; Manipulative games; Cards (Playing -); Target games; Quiz games; Go games; Memory games; Sports games; Board games; Boards games; Dart games; Building games; Manipulative puzzles; Manipulative logic puzzles; Manipulative logic games.