

O/1001/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003970887  
BY LINDSEY OSBORNE  
TO REGISTER THE FOLLOWING TRADE MARK:

**equissential**

IN CLASSES 35 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 445636  
BY MACKEY EQUESTRIAN WHOLESALE LIMITED

## BACKGROUND AND PLEADINGS

1. On 23 October 2023, Lindsey Osborne (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 03 November 2023. The applicant seeks registration for the following services:

**Class 35:** *Retail services connected with the sale of all equestrian clothing and equipment; Marketing connected with the sale of all equestrian clothing and equipment.*

**Class 42:** *Provision of a website for aggregating and displaying equestrian clothing and equipment from various physical and online stores for purchase through the website.*

2. On 01 February 2024, the application was opposed in full by Mackey Equestrian Wholesale Limited (“the opponent”) under Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under Section 5(2)(b), the opponent relies upon the following trade mark and the goods covered by the same as shown below:<sup>1</sup>

UK00907260904

EQUI-SENTIAL

Filing date: 25 September 2008

Registration date: 10 June 2009

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<sup>1</sup> 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 or International Registration designating the EU. As a result, the opponent’s earlier mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in 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.

**Class 18:** *Articles of clothing for horses; blankets for horses; boots (hoof coverings) for horses; saddles made of leather for horses; covers for horse saddles; horse covers; horseshoes; knee-pads for horses; horse blankets; horse riding apparatus; horse collars; riding whips; riding saddles; riding crops; saddle cloths for horses; saddlery and tack.*

**Class 21:** *Brushes for grooming horses; grooming apparatus (non-electric) for horses; grooming mitts; combs; buckets; cleaning equipment for stables, including textile cloths, wiping cloths for cleaning, absorbent pads for cleaning, brooms for cleaning, cleaning apparatus (non-electric), devices for cleaning by wiping, gloves for cleaning, hand-held cleaning apparatus (non-electric) and pads for cleaning.*

**Class 25:** *Articles of clothing for horse riding; riding boots; riding caps; riding gloves; riding coats; riding socks; riding sweatshirts; riding trousers; riding underwear; riding waistcoats.*

4. The trade mark relied upon by the opponent qualifies as an “earlier trade mark” in accordance with Section 6 of the Act because it was applied for at an earlier date than the filing date of the applicant’s mark. Having been registered for more than five years at the date the applicant’s mark was filed for registration, the opponent’s earlier mark is subject to the use conditions contained in Section 6A(3) of the Act.

5. Under Section 5(2)(b), the opponent claims that the marks are highly similar and that the goods and services are highly similar, leading to a likelihood of confusion.

6. Under Section 5(4)(a), the opponent relies upon the sign ‘EQUI-SENTIAL’ which it claims to have used throughout the UK since 2017 in relation to *equestrian products, tools and equipment, clothing and footwear.*

7. The applicant filed a counterstatement denying the claims and putting the opponent to proof of use.

8. The opponent is represented by Tomkins & Co, and the applicant is represented by Ashley Osborne. Only the opponent filed evidence. No hearing was requested and

only the opponent filed written submissions in lieu. This decision is taken after careful consideration of the papers.

## **EU Law**

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 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.

## **The evidence**

10. The opponent's evidence came in the form of the witness statement of Sean Guinan dated 21 July 2024. Mr Guinan is the opponent's director, a position he has held since 31 August 2018. His statement is accompanied by 20 exhibits, being those labelled SG1 – SG20, and the purpose of his statement is to prove use of the opponent's 'EQUI-SENTIAL' mark and goodwill in the corresponding sign.

11. I do not intend to summarise the evidence filed in full here (or the submissions in lieu of the opponent, for that matter). However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

## **DECISION**

### **PROOF OF USE**

12. 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.”

13. 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.”

14. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

15. 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 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].”

16. 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: 24 October 2018 to 23 October 2023.

17. As the opponent’s earlier mark is a comparable mark based upon an earlier EUTM, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment. With regard to assessing use within the EU (for the purpose of the earlier comparable marks), I also bear in mind that in *Lenoerken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“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.<sup>2</sup>

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<sup>2</sup> 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)

## The evidence of use

18. Mr Guinan's evidence is as follows:

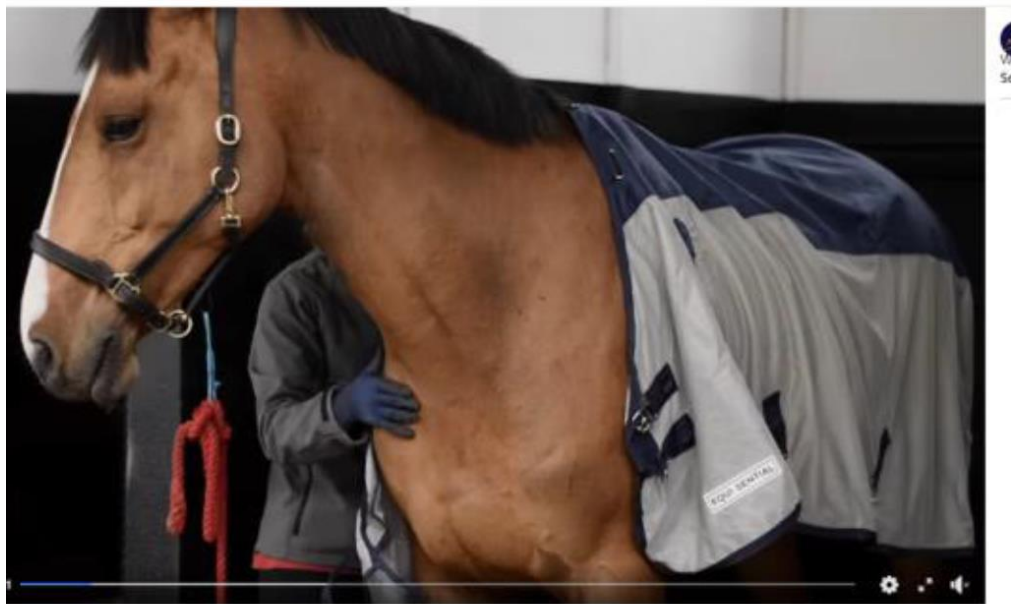
19. The opponent is an Irish company incorporated in Ireland in 1990. It has been the leader in the equestrian distribution business in Ireland for over 30 years providing a full range of equestrian products that include riding wear, riding hats, footwear, rugs, leatherwork, grooming equipment, healthcare, gifts and stable equipment. The opponent operates a number of brands in the field which include: 'Mackey', 'Carr and Day and Martin', 'Charles Owen', 'SSG Gloves', 'Racesafe', 'Stubbs', and most relevant to the present proceedings, the brand 'Equi-Sential'. The opponent has used the brand 'Equi-Sential' for a number of years and continues to promote, advertise and sell its products under the mark 'Equi-Sential' to the date of the witness statement.

20. In support of its evidence that the opponent has used the earlier mark, Mr Guinan introduces the following exhibits:

- (a) **Exhibit SG1:** this exhibit includes screenshots of the opponent's website [www.mackey.ie](http://www.mackey.ie) dated 18 July 2024 (i.e. after the relevant period) showing a range of products. The only mark which is visible is 'MACKEY EQUESTRIAN'.
  
- (b) **Exhibit SG2:** this exhibit includes a collection of archived screenshots from the opponent's website [www.mackey.ie](http://www.mackey.ie) obtained using the WayBackMachine dated 1 July 2022, 30 March 2023, and 21 September 2023 (all within the relevant period). They show use of the mark 'EQUI-SENTIAL' in relation to equestrian and equine products, which are described as "fleece cooler", "fly rug", "net cooler", "standard medium", "turnout light". Admittedly, neither the name nor the description of the products sheds much light on what these products are (and I have no knowledge of the equestrian business); however, the only picture which features (as shown below) suggests that these are goods for horses:



(c) **Exhibit SG3:** this exhibit includes a selection of screenshots of the opponent's Facebook page dated on various dated between 2016 and 2023 which promote various 'EQUI-SENTIAL' products. The exhibit confirms that some of the products shown in Exhibit SG2 (e.g. fly rugs) are for horses as shown below:



Equisential waterproof fly rug

However, other products appear to be for humans such as “cotton jods”, which I understand are trousers worn by horse riders:



Mackey Ireland

19 Jan 2022 · 🌐

...

Lusting for Summer Pony days 🥰

The girls are all wearing Equisential Cotton jods -  
Perfect for long days on the yard with your pony 🐾



Millie is wearing her Equisential headcollar (whilst  
busy looking for more snacks) 🦋🦋

#mackeyireland #equisential



- (d) **Exhibit SG4:** Mr Guinan states that while the 'EQUI-SENTIAL' mark has been used throughout the UK since at least 2017, the mark itself has been used in connection with equestrian products, riding wear and footwear since before this date – I must deduce that this refers to use outside the UK. Exhibit SG4 contains copies of pages from the Mackey Product Catalogue 2015- 2016 (i.e. prior to the relevant period) which lists the following categories of goods: riding wear, hats and skulls, footwear, rugs, saddlery and track, bits & accessories, horse wear, grooming equipment, healthcare (i.e. nutritional and veterinary supplements), Carr & Day & Martina range – the latter appears to be a range of goods offered under a different brand. The mark 'EQUISENTIAL' (presented as one word) and that shown below feature in relation to the following equestrian goods: body protectors, whips, grip gloves, helmets, half chaps, reins, bridles, headcollars, lead ropes, foot ropes, saddlecloths.



- (e) **Exhibit SGS5:** this exhibit includes copies of pages from the opponent's Mackey Product Catalogue 2019-2020 (within the relevant period). Mr Guinan points out that within the exhibit are the opponent's UK and Irish sales representatives, as well as a list of products sold under the brand 'EQUI-SENTIAL' including the following: equine rugs, fleeces and blankets, bridles, reins, headcollars and associated products such as rein stops, guards, and rings, leads, stirrup leathers, girth sleeves, footwear, riding wear, whips, and animal grooming kits.
- (f) **Exhibit SG6:** this exhibit includes copies of pages from the opponent's Mackey Product Guide 2021-2022 (within the relevant period). Mr Guinan points out that within the exhibit are the opponent's Irish and UK head office information and contact details, as well as a list of products sold under the brand 'EQUI-SENTIAL' including the following: equine rugs, fleeces and blankets, saddle cloths, bridles, reins, headcollars and associated products such as rein stops, guards, and rings leads, stirrup leathers, girth sleeves, footwear, riding wear, whips and haynets.
- (g) **Exhibit SG7:** this exhibit includes copies of pages from the opponent's Mackey Trade Catalogue 2023-2024 which was publicly available since at least 30 May 2023 (within the relevant period). Mr Guinan points out that within the exhibit are the opponent's Irish and UK head office information and contact details as well as a list of products sold under the brand 'EQUI-SENTIAL' including the following: equine rugs, fleeces, and blankets, bridles, reins, headcollars and associated products such as rein stops, guards, and rings, leads, stirrup

leathers, girth sleeves, footwear, riding wear, whips, haynets, bandages, studs, animal grooming products such as brushes, hoof picks, sweat scrapers, and sponges.

- (h) In terms of sales, Mr Guinan provides the following sales figures which, he says, relate to the sales of 'EQUI-SENTIAL' products within the UK from January 2020 to December 2023:

Year	Sales (£)
1 January 2020 to 31 December 2020	In excess of 23,000
1 January 2021 to 31 December 2021	In excess of 60,000
1 January 2022 to 31 December 2022	In excess of 60,000
1 January 2023 to 31 December 2023	In excess of 49,000

The total amount is £192,000.

EU sales figures are provided for 2020 and 2021 and are as follows:

Year	Sales (£)
1 January 2020 to 31 December 2020	In excess of 80,000
1 January 2021 to 31 December 2021	In excess of 375

The total amount is £455,000.

At **exhibit SG8 and SG9**, Mr Guinan provides a breakdown of sales by products per year (without specifying for 2023 whether sales are before or after the relevant period). Suffices to say that it reflects the types of goods shown in the opponent's product guides and catalogues, namely items of horse ware, riding equipment and horse-riding clothing and footwear.

- (i) **Exhibit SG10**: this exhibit consists of a screenshot of a map published on 15 April 2024 (after the relevant period) showing the number of retailers of the opponent's products within the UK and Ireland. Whilst the map shows a

substantial number of retailers spread across the UK, it is dated after the relevant period.

- (j) **Exhibits SG11-SG14:** these exhibits consist of screenshots of the websites of third-party stockists based in Royston, Bedfordshire, Coleraine and Wales, showing the opponent's EQUI-SENTIAL or EQUISENTIAL equestrian products available for sale; some of the screenshots are dated within the relevant period, whilst others are not.
  
- (k) **Exhibit SG15:** this exhibit consists of a printout (dated 18 July 2024) and a Facebook post (dated 8 December 2021) relating to the sale of the opponent's 'EQUI-SENTIAL' socks by a UK based stockist Mcfarlane Animal Health.
  
- (l) **Exhibit SG16:** this exhibit consists of screenshots of websites of a number of other UK based stockists and a selection of the opponent's 'EQUI-SENTIAL' products. The pages are undated which means that they cannot be taken into account.
  
- (m) **Exhibit SG17:** this exhibit consists of images of the AgriHealth Group stand at BETA International held in Birmingham in 2020. The event is a trade show which is said to be the UK's premier trade event for the equestrian and country living sectors. The opponent's stand at the event is visible in the pictures including the 'EQUI-SENTIAL' mark which is displayed along with other marks.

21. The rest of the evidence includes copies of marketing emails (exhibit SG18) dated after the relevant period, as well as excerpts of magazine articles advertising the opponent's 'EQUI- SENTIAL' products, including Pony Magazine, Horse & Rider Magazine, and Equestrian Trade News (exhibit SG19), some of which are dated within the relevant period. Whilst Mr Guinan says that these magazines are well-known in the equestrian sector, no readership figures are provided.

22. Finally, Mr Guinan relies on what the applicant stated in its counterstatement as shown below:

Please show historical proof of use of the Cancellation Applicant's registered mark "EQUI-SENTIAL" under class and 42 on the register of the UKIPO.

We note that EQUI-SENTIAL is not registered under classes 35 and 42 of the UKIPO in any event. There is no evidence of its use online or in historical internet records under either of these classes, it is clearly a good not a service.

23. Mr Guinan says that by stating that there is no evidence of the opponent's use of 'EQUI-SENTIAL' online or in historical records under classes 35 and 42, and that the opponent's use *"is clearly a good not a service"*, the applicant admits that the opponent has used the earlier mark in relation to the goods. He also refers to the applicant's statement made in the counterstatement that *"EQUI-SENTIAL is a brand (a good) which fits squarely within the classes it has registered itself for being 18, 21 and 25, it has only ever been a brand/good....EQUI-SENTIAL is sold through 3rd party trade channels and this is clearly visible online and through historical website records"*. However, whilst the applicant might have admitted that the opponent sells goods within the registered classes under the earlier mark, it did not admit that the use made is sufficient to establish genuine use for the purpose of this opposition. Hence, the applicant's statements lacking a clear uncontroverted admission, I will go on to assess the evidence filed to see if it establishes genuine use.

### **Genuine use**

24. In terms of the mark used, there are examples of the mark being presented as one word, i.e. EQUISENTIAL, or as part of the figurative mark shown below (e.g. exhibits SG5-SG7):



25. Another variant mark used by the opponent is that shown below:



26. Whilst these forms are not the same as the registered mark, I consider them to be acceptable variants because (1) the presentation of the word EQUISENTIAL rather than EQUI-SENTIAL does not prevent the mark from being perceived as a play on the words “equine essential” and (2) the additional figurative elements and words “*by Mackey*” and “*From Mackey*”, do not alter the distinctive character of the mark as it is registered,<sup>3</sup> being perceived either as ornamental or as referring to the name of the provider who uses the mark (i.e. MACKKEY). Further, there are examples of the mark being used as it is registered.<sup>4</sup>

27. Although quantitatively the turnover for the relevant period is relatively modest, being only £143K (for the UK) and £80K (for the EU),<sup>5</sup> and no information has been provided about marketing figures and market share, the use appears to be geographically widespread with the opponent’s goods being available from a large number of UK retailers – in this connection whilst the map exhibited at SG10 is dated April 2024, it is only 6 months after the relevant period and it is reasonable to assume that many of the retailers shown in the map offered the opponent’s goods during the relevant period. Lastly, the evidence about catalogues is pretty strong, with goods marketed under the earlier mark being promoted in the opponent’s catalogues during the relevant period and prior to it, and with a substantial number of instances of the marks being used in relation to horse ware, horse equipment and horse-riding clothing and footwear. Whilst it is true that there is no evidence about how many catalogues were distributed in the UK and whether customers relied upon those catalogues to place orders, the catalogues look very professional, display a UK head office, a UK email address and the name of UK sales representatives. Furthermore, “*catalogues*

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<sup>3</sup> *Colloiseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

<sup>4</sup> SG7

<sup>5</sup> It is not clear what proportion of the UK turnover for 2023 falls within the relevant period, and the EU turnover is only relevant until IP completion day, i.e. 31 December 2020.

*are, in and of themselves, evidence of genuine use of the mark” because they are “a bona fide effort to “create or preserve an outlet for the goods or services that bear the mark (Ansul at [37]-[38])”.*<sup>6</sup>

28. In my view, the extensive marketing of goods offered under the earlier mark in the catalogues and through the UK retailers counterbalances the relatively modest turnover figures and genuine use has accordingly been made within the relevant period in relation to horse ware, horse equipment and horse-riding clothing and footwear.

### **Fair specification**

29. 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.”

30. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in

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<sup>6</sup> See BL-O/440/21, SKINY at paragraph 24

relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

31. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that 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.

32. As it will be recalled, the opponent has made genuine use of the earlier mark in relation to horse ware, horse equipment and horse-riding clothing and footwear. The earlier mark is registered for the following goods:

**Class 18:** *Articles of clothing for horses; blankets for horses; boots (hoof coverings) for horses; saddles made of leather for horses; covers for horse saddles; horse covers; horseshoes; knee-pads for horses; horse blankets; horse riding apparatus; horse collars; riding whips; riding saddles; riding crops; saddle cloths for horses; saddlery and tack.*

**Class 21:** *Brushes for grooming horses; grooming apparatus (non-electric) for horses; grooming mitts; combs; buckets; cleaning equipment for stables, including textile cloths, wiping cloths for cleaning, absorbent pads for cleaning, brooms for cleaning, cleaning apparatus (non-electric), devices for cleaning by wiping, gloves for cleaning, hand-held cleaning apparatus (non-electric) and pads for cleaning.*

**Class 25:** *Articles of clothing for horse riding; riding boots; riding caps; riding gloves; riding coats; riding socks; riding sweatshirts; riding trousers; riding underwear; riding waistcoats.*

33. Although there is no specific evidence of use in relation to a number of items in classes 18 and 25, there is sufficient evidence of use to allow the opponent to rely on the broader terms *Articles of clothing for horses; horse riding apparatus* (in class 18) and *Articles of clothing for horse riding; riding boots* (in class 25). This means that effectively, I do not need to go through the goods listed in the registered specification one by one, because they all fall within the broader terms for which I am content that there is genuine use. Likewise, the catalogues show that the opponent offers *Brushes, Grooming Essentials, Grooming Kits, Clippers & Trimmers* under the earlier mark, which would be sufficient for the opponent to rely on the broader term *grooming apparatus (non-electric) for horses* which encompasses the other goods listed in class 21.

## Section 5(2)(b) of the Act

34. Section 5(2)(b) states:

“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.”

35. Section 5A states:

“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.”<sup>7</sup>

36. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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<sup>7</sup> This section also applies to the ground raised under section 5(34).

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

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

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

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

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

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

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

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

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

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

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

### **Comparison of goods and services**

37. 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 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.”

38. 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.

39. 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 General Court (“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.”

40. 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.”

41. 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.”

42. In *Gérard Meric v OHIM*, Case T- 133/05, the 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 fur 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.”

43. The competing goods and services are as follows:

The applicant's services	The opponent's goods
	<b>Class 18:</b> <i>Articles of clothing for horses; horse riding apparatus</i>
	<b>Class 21:</b> <i>Grooming apparatus (non-electric) for horses</i>
	<b>Class 25:</b> <i>Articles of clothing for horse riding; riding boots.</i>
<b>Class 35:</b> <i>Retail services connected with the sale of all equestrian clothing and equipment; Marketing connected with the sale of all equestrian clothing and equipment.</i>	
<b>Class 42:</b> <i>Provision of a website for aggregating and displaying equestrian clothing and equipment from various physical and online stores for purchase through the website.</i>	

44. In its counterstatement the applicant argues that the earlier registration does not cover services in class 35 and 42 and that the competing specifications do not share the same classes. Accordingly, the applicant contends, the earlier registration “*under classes 35 and 42 is NOT “for goods and services identical with or similar to those for which the earlier trade mark is protected”*. Whilst I consider this statement to be sufficient to deny that the goods and services are identical or similar, it is not correct to say that goods and services belonging to different classes cannot be similar. This is provided for in Section 60A of the Act:

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

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

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

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

### **Class 35**

*Retail services connected with the sale of all equestrian clothing and equipment;*  
*Marketing connected with the sale of all equestrian clothing and equipment.*

As regards the similarity between the applied-for retail services in class 35 and the opponent’s goods in classes 18, 21 and 25, it is obvious that the contested *Retail services connected with the sale of all equestrian clothing and equipment* relate to the same goods as those covered by the opponent’s registration.

45. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that 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. Since in this case the applied-for services relate to exactly the same goods as those for which the opponent's trade mark is registered, I find that the goods and services are similar to a medium degree.

46. In addition, the application covers marketing connected with the sale of all equestrian clothing and equipment. The opponent states that these services are similar to the opponent's goods because *"the goods (equestrian goods) are indispensable to the retail and marketing services relating to them"* and given *"the complementary relationship between the goods and the retailing and marketing thereof, there is a clear overlap in the trade channels through which the goods and services reach the average consumer. Further it is clear that the Opponent's goods, and the Applicant's class 35 services will be directed at the same consumers (generally people who want to buy equestrian clothing and equipment)"*.

47. Clearly, the opponent's argument treats the marketing of goods as being the same as the retailing of goods. If the opponent is correct in that the applied-for term *"marketing connected with the sale of all equestrian clothing and equipment"* means, effectively, the provision/offering of equestrian clothing and equipment to meet consumers' needs, then I agree that the goods and services are similar to the same degree which I found to exist in relation to retail services.

48. The other possible interpretation is that the term *"marketing connected with the sale of all equestrian clothing and equipment"* means a business service consisting of marketing activities connected with the sale of equestrian clothing and equipment. In such a scenario, I would find that the goods and services are dissimilar. This is on the basis that the applied-for marketing service would be a service provided by a marketing agency to a manufacturer of equestrian clothing and equipment who wishes to increase its sales and would include a range of strategies and solutions designed to help the businesses grow, enhance their brand presence, and achieve more sales. Conversely, the user of the opponent's equestrian goods is simply the purchaser of the goods. Hence, the nature, purpose and use of the goods and services would be different. The goods and services would target different consumers, be provided

through different trade channels (i.e. retailers of goods versus marketing agencies) and be neither complementary nor in competition.

49. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

50. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language

unnaturally so as to produce a narrow meaning which does not cover the goods in question."

51. Accordingly, the first point to bear in mind is that the need for general fairness says that any ambiguity is the responsibility of the owner of the mark, in this case the applicant.

52. The second point is about the natural meaning of the words. In this connection, I note the following:

i. Collins online dictionary contains the following definition of marketing:

1. Marketing is the organization of the sale of a product, for example, deciding on its price, the areas it should be supplied to, and how it should be advertised.

2. The provision of goods or services to meet customer or consumer needs.

ii. Marketing is also the gerund of the verb 'market' which means (Collins) *"To market a product means to organize its sale, by deciding on its price, where it should be sold, and how it should be advertised."* These are all activities which are part and parcel of retail services.

53. The third point is that the applicant has been silent on what the applied-for services cover and has not argued that they are business-to-business services.

54. Lastly, it would be wrong to exclude an interpretation (i.e. that of marketing being essentially the same as retailing) which, in my view, is plausible and which - should the application succeed for retail services – would leave services identical to retail services in the application on the basis of a narrower meaning which is I am not confident is the correct one and has not been argued. Accordingly, I find that these services are also similar to the opponent's goods to a medium degree.

## Class 42

### Provision of a website for aggregating and displaying equestrian clothing and equipment from various physical and online stores for purchase through the website.

55. In *Tulliallan Burlington Ltd v EUIPO*, Cases C-155/18P to C-158/18P, the CJEU held that that goods could be considered similar to shopping arcade services in class 35. The court said that:

“127. Accordingly, the concept of ‘retail services’ covers services which are aimed at the consumer and which consist, on behalf of the businesses occupying a shopping arcade’s stores, in bringing together a variety of goods in a range of stores enabling the consumer to conveniently view and purchase those goods and in offering a variety of services separate from the act of sale, which seek to ensure that that consumer purchases the goods sold in those stores.

128. It follows from the foregoing considerations that, as the General Court itself correctly held in paragraph 32 of the judgments under appeal, the Court of Justice’s interpretation in paragraph 34 of the judgment in *Praktiker* does not support the assertion that the services provided by shopping arcades or shopping centres are, by definition, excluded from the scope of the concept of ‘retail services’ defined in Class 35, within the meaning of the Nice Agreement.

129. The General Court also correctly found, in paragraph 33 of the judgments under appeal, that the Court of Justice’s interpretation in paragraph 34 of the judgment in *Praktiker* precludes the argument that shopping arcade services are essentially limited to rental and real estate management services. The General Court states that the concept of ‘a variety of services’, as mentioned in that paragraph of the judgment in *Praktiker*, necessarily includes the services organised by a shopping arcade in order to retain all the attractiveness and practical advantages of such a place of commerce, the aim being to enable the customers interested by the various goods to conveniently view and purchase them in a range of stores.

130. Consequently, the General Court was fully entitled to find, in paragraph 34 of the judgments under appeal, that the concept of 'retail services' includes a shopping arcade's services aimed at the consumer with a view to enabling him or her to conveniently view and purchase those goods, for the benefit of the businesses occupying the arcade concerned."

56. The same principle applies, in my view, to these services which consists of the provision of an e-commerce website enabling users to conduct electronic purchases and transactions in an online marketplace. Whilst the e-commerce website does not offer the traditional amenities of a shopping centre, like dining, it falls within the concept of retail services. If I am wrong about this, both services have the same ending point, which is selling products, although they differ in operational strategies, target markets, and customer experiences. Consequently, comparing those services with the opponent's goods, they target the same consumers and share trade channels insofar as the opponent's goods can be sold through the applicant's website, and the goods and service are complementary. These services are similar to the opponent's goods to a medium degree.

### **Average consumer**

57. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

58. The average consumer for the goods and services will be a member of the general public who owns a horse, or practices horse riding, or a professional in the equestrian and or horse rearing field. The cost of the goods is likely to vary, and the goods and services will be purchased relatively frequently. However, various factors are still likely to be taken into consideration during the purchasing process, such as materials used, cut, aesthetic appearance and durability (for the goods) and accessibility and variety of goods on offer (for the services). Consequently, I consider that at least a medium degree of attention will be paid by the average consumer when selecting the goods and services.

59. The goods are likely to be obtained by self-selection from the shelves of retail outlets, online or catalogue equivalent. Likewise, the services are likely to be selected from signage outside shops (or their online equivalent) or from websites. This means that the mark will be seen and so the visual element of the mark will be the most significant. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase, in the form of word-of mouth recommendations or advice sought from a sales assistant.

### **Comparison of marks**

60. 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.”

61. 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. The respective marks are shown below:

<b>The application</b>	<b>The opponent’s mark</b>
equissential	EQUI-SENTIAL

62. Both marks are word-only marks.

63. The applied-for mark consists of the word ‘equissential’ presented in lower-case letters. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

64. The opponent’s mark consists of the sequences ‘EQUI’ and ‘SENTIAL’ conjoined by a hyphen with the two elements contributing equally to the overall impression of the mark.

### **Visual similarity**

65. The first thing to bear in mind is that being both marks word-only-marks, they can be presented in any typeface and font. Hence, it matters not whether one mark is presented in upper-case letters and the other in lower-case letters. As the opponent correctly states, the respective marks are made up of 12 characters of which the first four characters are identical (E-Q-U-I) as are the final seven characters (S-E-N-T-I-A-

L). The marks differ in that the applicant's mark has an additional letter 'S' as the 5<sup>th</sup> character, whereas the opponent's mark has a hyphen. However, this difference does not create a striking impression, as the double 'SS' versus the single 'S' in the middle of the marks is hardly noticeable. Overall, I consider the marks to be visually similar to a high degree.

### **Aural similarity**

66. Aurally, the hyphen in the middle of the earlier mark will not be pronounced, whereas the sound of the double 'SS' in the applicant's mark will be the same as that of the single 'S' in the opponent's mark. The most that can be said, is that the hyphen in the earlier mark will create a slightly longer pause between the elements 'EQUI' and 'SENTIAL' than in the application 'EQUISENTIAL' where the same letters (with the addition of an extra 'S') are presented as one single word. However, even when presented as a single word, there is a natural pause between 'EQUI' and 'SENTIAL' which create separate syllables (i.e. units of sound) when the word is articulated, so again, the difference is hardly noticeable. Overall, I consider the marks to be aurally identical or similar to a high degree.

### **Conceptual similarity**

67. Conceptually, the opponent states that there are two groups of consumers. For the first group, the marks at issue would evoke/allude to the idea of being essential to equine use (or horses more generally) due to both marks having the identical play on the words "EQUINE" and "ESSENTIAL". For this group, the marks are conceptually identical. For the second group, the marks are invented words conveying no concept and the conceptual position is neutral. I agree with the opponent, though I believe that being the marks registered or applied-for goods and services which relate to the equine sector, most consumers will understand the marks as a play on the words 'ESSENTIAL FOR EQUINE', in which case the marks are conceptually identical.

## **Distinctive character of earlier mark**

68. 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).”

69. 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.

70. The earlier mark consists of the word ‘EQUI-SENTIAL’. As it will be recalled, I found that a significant part of consumers will appreciate the play on words in the mark. I should add that the play on words will be seen as a clever one with a high level of

inherent distinctive character. For the other group of consumers who will see 'EQUISSENTIAL' as an invented word with no meaning, the mark will also have a high degree of distinctive character.

71. I have already commented on the evidence of use. Whilst I found that the evidence is sufficient to establish genuine use, the threshold for enhanced distinctiveness is higher. As I have already highlighted, there are many gaps in the evidence. Further, the turnover generated prior to the relevant date (i.e. the filing date of the contested mark) is relatively low, in the context of the goods concerned which relate to the equine sector. In this connection, although there is no market share, the equine market in the UK must be in the region of millions, if not billions.

72. Bearing in mind all of the above, I conclude that the evidence is not sufficient to establish that the distinctiveness of the earlier mark has been enhanced to any material extent.

### **Likelihood of confusion**

73. 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, including that 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. I must 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. 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.

74. 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).”

75. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.

76. 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.”

77. 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.

78. Earlier in this decision I found that:

- The goods and services are similar to a medium degree.
- The goods and services will be purchased with a medium degree of attention.
- The goods and services will be purchased mainly visually although aural considerations cannot be discounted.
- The marks are visually similar to a high degree and aurally identical. Conceptually, for a significant part of the relevant public the marks are conceptually identical, whereas for another group (equally significant) they are conceptually neutral.
- The earlier mark is inherently distinctive to a high degree and the use made of it has not enhanced its distinctiveness to a material extent.

79. Bearing in mind all of the above, I consider that given the high degree of visual similarity between the marks and their aural and conceptual identity, and the high degree of distinctive character of the earlier mark, consumers will directly confuse the marks when encountering them on similar goods and services. Alternatively, if consumers notice the differences between the marks, they will consider the applicant's mark as a variant mark used by the opponent whereby the distinctive play on words 'EQUI-SENTIAL' is presented as one word rather than two, and the presence of an additional letter 'S' will be overlooked. There is a likelihood of confusion. For the sake of completeness, I should say that the same finding extends to the second group of consumers for which the marks are meaningless.

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

80. Section 5(4)(a) states:

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

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

(aa) [...]

(b) [...]

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

81. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

82. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

83. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

### **The relevant date for Section 5(4)(a)**

84. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

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

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

85. The *prima facie* relevant date is the date the contested mark was filed, that is to say 23 October 2023. As there is no evidence of the applicant having used the applied-for mark that is the only relevant date.

### **Goodwill**

86. The requirement for a finding of goodwill is considerably less onerous than that of enhanced distinctiveness. Having found that there has been genuine use of the earlier mark, I also find that at the relevant date the opponent had a protectable goodwill in the sign and for the goods relied upon.

### **Misrepresentation**

87. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898)

15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case *Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

*Annabel's (Berkeley Square) Ltd. v. G. Schock* (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego* case *Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

88. Even if I am wrong about the services in class 42 being equivalent to retailing services, the parties are in the same or a very similar field of activity, and the goods and services are sufficiently close - all relating to the equine sector - to give rise to misrepresentation and damage.

89. The opposition based on Section 5(4)(a) also succeeds.

## **CONCLUSIONS**

90. The opposition has been successful.

91. The application will be refused registration.

## **COSTS**

92. 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 opponent the sum of £1,600 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement: £400

Filing evidence: £700

Submissions in lieu: £300

Official Fees: £200

Total: £1,600

93. I therefore order Lindsey Osborne to pay Mackey Equestrian Wholesale Limited the sum of £1,600. 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 28<sup>th</sup> day of October 2025**

**TERESA PINTO**

**For the Registrar**