O/1180/25

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3996978

BY PERDIP SINGH DOSANJH

TO REGISTER

BISONFORCE

AS A TRADE MARK

IN CLASS 28

AND OPPOSITION THERETO (UNDER NO. 446482)

BY

WOLVERSON FITNESS LIMITED

Background & pleadings

1. Perdip Singh Dosanjh ("the applicant") applied to register the trade mark **BISONFORCE** on 30 December 2023. It was published for opposition purposes on 19 January 2024 in class 28. The applicant sought to amend the applied for goods by means of a form TM21B dated 17 March 2024. The amended class 28 specification is set out below:

28: Mechanically Adjustable Dumbbells for use in weight training and exercise; Mechanically Adjustable Kettlebells for use in weight training and exercise.

2. Wolverson Fitness Limited ("the opponent") opposed the application under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following comparable registration[1] under section 5(2)(b).

UK TM No.914012637	**Goods relied on**
BISON Filing date: 29 April 2015 Registration date: 20 October 2015	*28: Sporting articles, apparatus and equipment; apparatus, articles and equipment for use in exercise and in physical training, fitness training, training for weight loss, functional training, strength training, conditioning training, body building; weight lifting apparatus; weight lifting bars; weight lifting weights; exercise weights; kettlebells; collars for weight lifting bars; dumb bells; wrist straps for weight lifters; chalk bowls for weight lifters; stands, supports, storage racks for use*

[1] Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all rights holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's 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.

	in weight lifting and for dumb bells, weight lifting bars and weights; weight lifting platforms and surfaces; exercise balls, power bands, resistance bands, mobility bands, training ropes, training harnesses, sleds for resistance training; training surfaces, protective flooring for weight lifting; sandbags; exercise bars, climbing bars, exercise frames, exercise machines, balancing and stability apparatus; targets for throwing balls; parts and fittings for any of the aforesaid goods.

3. Under section 5(4), the opponent relies on the sign **BISON** which it claims to have used throughout the UK since 2016 for the same goods as set out above.

4. The applicant filed a counterstatement in which he admitted there was a similarity between the goods but denied there was any confusion between the marks. He also put the opponent to proof of use for *dumb bells* and *kettlebells.*

5. The opponent's registration has a filing date that is earlier than the filing date of the contested application and is therefore considered an earlier mark, by virtue of section 6 of the Act. As the registration procedure for the earlier registration was completed more than 5 years prior to the filing date of the contested application, it is subject to the use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

6. During the proceedings only the opponent filed evidence, and both sides filed submissions in lieu of an oral hearing.

7. The applicant has represented himself during the proceedings whilst the opponent has been represented throughout by Swindell & Pearson Ltd.

8. I make this decision based on a reading of all the material before me.

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 that predate the UK's withdrawal from the EU.

EVIDENCE

Relevant period

10. My first task will be to establish whether, or to what extent, the opponent has shown genuine use of its earlier mark within the "relevant period". The relevant period is defined as being the period of five years ending with the filing date of the contested application. The relevant period in these proceedings is 31 December 2018 to 30 December 2023.

Opponent's evidence in chief

11. The opponent provided evidence in chief in the form of a witness statement dated 15 July 2024 in the name of Jason McCarthy who is a director of the opponent company. Mr McCarthy attached 9 exhibits. I do not intend to summarise the evidence in full, but the most pertinent points are set out below.

12. Mr McCarthy states that the opponent first used the **BISON** mark in 2008 on a range of weightlifting apparatus in class 28 including on *dumb bells* and *kettlebells.* Mr McCarthy provides sales figures and advertising expenditure figures for a number of the opponent's goods including *dumb bells* and *kettlebells.* For convenience I have set out the figures for these goods below.

Dumb bells	**Sales**	**Advertising expenditure**
2020	£26500	£1000
2021	£58256	£1000
2022	£6493.24	£500

2023	£254.95	£200

Kettlebells	**Sales**	**Advertising expenditure**
2020	£88615.89	£5000
2021	£91795.58	£5500
2022	£457890.35	£5500
2023	£1436.51	£500

13. Courtesy of the Wayback Machine internet archive service, Mr McCarthy exhibits three screenshots[2] of the opponent's website dated 19 September 2021, 2 June 2022 and 25 May 2022 showing kettlebells branded with the BISON mark for sale in pounds sterling.

Applicant's submissions

14. The applicant opted to file submissions in reply, dated 6 October 2024, to the opponent's evidence. The submissions are somewhat confusing as in paragraph 3 the applicant acknowledges the opponent's evidence is sufficient to prove use of **BISON** but then he goes on to challenge and disagree with a number of points in that evidence and in paragraph 14 he submits that the sales and promotional figures are insufficient and should not be relied on. The applicant mentions at length that the design of the kettlebells featured in the opponent's evidence is generic. I think it is appropriate to point out at this juncture that the design of the goods is not relevant and that the evidence was submitted to reflect use of the **BISON** trade mark

Opponent's evidence in reply

15. Clearly the opponent felt that the applicant had challenged its evidence in chief sufficiently to warrant filing evidence in reply in the form of a further witness statement dated 9 December 2024 from Jason McCarthy who attached 4 more exhibits. In addition 5 other witness statements and exhibits were filed from customers of the opponent.

[2] Exhibit JAM9

16. In his second witness statement Mr McCarthy sought to clarify some of the applicant's challenges to the evidence in chief. Of particular interest were the addition of market share figures which Mr McCarthy states were 15% in each of the years for which sales figures and advertising expenditure were given.

17. Mr McCarthy also exhibited a newspaper review from The Standard[3] dated 5 October 2023 for one of the opponent's kettlebell products.

Relevant statutory provision: Section 6A:

18. "(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

[3] Exhibit JAM12

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

19. As the opponent’s 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".

20. Section 100 of the Act states that:

"100. 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."

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

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

Sufficiency of use

22. The opponent has provided dated examples of its **BISON** mark in use on the goods and in text. It has also provided sales figures, advertising expenditure and market share during the relevant period. Taking all this into account, I find that the opponent has sufficiently demonstrated genuine use of the **BISON** mark on *dumb bells* and *kettlebells.*

Section 5(2)(b)

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

> "5 (2) A trade mark shall not be registered if because -
>
> […]
>
> (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,
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> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

24. Section 5A is also relevant and reads:

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

25. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

> (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
>
> (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to

make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods

26. The goods to be compared are set out below:

Opponent's goods	Applicant's goods
28: Sporting articles, apparatus and equipment; apparatus, articles and equipment for use in exercise and in physical training, fitness training, training for weight loss, functional training, strength training, conditioning training, body building; weight lifting apparatus; weight lifting bars; weight lifting weights; exercise weights; kettlebells; collars for weight lifting bars; dumb bells; wrist straps for weight lifters; chalk bowls for weight lifters; stands, supports, storage racks for use in weight lifting and for dumb bells, weight lifting bars and weights; weight lifting platforms and surfaces; exercise balls, power bands, resistance bands, mobility bands, training ropes, training harnesses, sleds for resistance training; training surfaces, protective flooring for weight lifting; sandbags; exercise bars, climbing bars, exercise frames, exercise machines, balancing and stability apparatus; targets for throwing balls; parts and fittings for any of the aforesaid goods.	*28: Mechanically Adjustable Dumbbells for use in weight training and exercise; Mechanically Adjustable Kettlebells for use in weight training and exercise.*

27. I find the following case law to be helpful when comparing specifications where in *Gérard Meric v Office for Harmonisation in the Internal Market,*[4] the General Court 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."

28. The opponent has the terms *dumb bells* and *kettlebells* at large in its specification. The terms are sufficiently broad to cover the goods of the applicant. They are therefore considered identical under the *Meric* principle.

Average consumer and the purchasing process

29. I next consider who the average consumer is for the goods at issue and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.[5] For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.[6]

30. The average consumer for the contested goods will be the general public and businesses such as gyms. The contested goods will likely be an infrequent purchase and will vary in price but in my view will tend toward the less expensive end of the scale for fitness equipment. The attentiveness shown during the purchasing process will also vary but a customer would have in mind the kind and suitability of the goods and will consider factors such as weight. In my view the average consumer is likely to pay at least a medium degree of attention during the purchasing process.

[4] Case T- 133/05.
[5] *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).
[6] *Lloyd Schuhfabrik Meyer,* Case C-342/97.

31. The goods are likely to be selected from physical retailers or online equivalents. They may also be purchased from fitness providers. Consequently, there will be a predominantly visual consideration in the purchasing process. However, I do not discount an aural component, such as technical advice from fitness professionals/trainers, during the purchasing act.

Mark comparisons

32. It is clear from *Sabel BV 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. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*[7], 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."

33. 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.

34. The respective trade marks to be compared are:

Opponent's earlier registration	**Applicant's mark**
BISON	BISONFORCE

[7] Case C-591/12P.

35. The opponent's earlier registration consists of a single word **BISON** in capital letters. The registration has no other aspect to it, such as stylisation, and the overall impression is derived solely from this word.

36. The applicant's mark consists of a single element, namely **BISONFORCE**, and has no other aspect to it. The mark will be seen as a conjoining of the two words **BISON** and **FORCE**. Whilst **FORCE** is not negligible within the mark, I find that in considering the balance of distinctiveness between the two elements, **BISON** is the distinctively stronger element and contributes more towards the overall impression. The word **FORCE** may be seen as allusive of physical strength.

37. In a visual comparison, both marks share the word **BISON**. It is the entirety of the opponent's registration and the first element of the applicant's mark. The point of difference occurs with the addition of the **FORCE** element in applicant's mark. In its written submissions,[8] the opponent draws my attention to settled case law[9] that consumers may pay more attention to the beginnings of marks than the ends. I find this is a particular factor in this instance as the beginning of both marks contain the same distinctive element. Overall I find there is a medium degree of visual similarity.

38. In an aural comparison the shared word **BISON** will be pronounced identically in each case. The additional element in the applicant's mark, **FORCE**, is a regular dictionary word and will be given its usual pronunciation. Overall I find there is a medium degree of aural similarity.

39. In a conceptual comparison, the word **BISON** is likely to bring to mind the concept of the animal to the majority of consumers. This concept will be the same for both marks. Both sides made submissions regarding whether the word **BISON** would also allude to one of the known traits of the animal, namely physical strength. To my mind the majority of consumers are unlikely to see much more to the word **BISON** other than the animal. However in relation to the applicant's second element **FORCE**, the likelihood is that consumers would see an allusion to physical strength. Overall I find there is a conceptual similarity to a medium degree based on the shared word **BISON**.

[8] Paragraph 23.
[9] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Distinctiveness of the earlier mark

40. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*[10] 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 *WindsurfingChiemsee* 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)."

41. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent distinctive character, such as invented words.

[10] *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97

42. I begin by considering the inherent position. The word **BISON** is a dictionary word and has no meaning in relation to the goods for which it is registered. Therefore I find that the earlier mark is inherently distinctive to a medium degree.

43. As evidence has been provided, I next consider whether use made of the earlier mark has enhanced its distinctiveness. I remind myself of the *Windsurfing Chiemsee* factors set out above as to what I should consider.

44. The market I must consider is the UK. The opponent's evidence demonstrated that there has been use of the mark between 2020 and 2023 in relation to its *dumb bells* and *kettlebells*. I find that the opponent has maintained a continuous turnover, advertising expenditure and consistent market share during this period. The opponent has not provided invoices, so I am unable to ascertain whether the customer base is UK wide. There are some customer reviews on the website pages submitted from the Wayback Machine archive in Exhibit JAM9, however it is not clear whether the reviewers are based in the UK.

45. I find that the earlier mark's distinctive character has been enhanced though use but only to a modest extent for *dumb bells* and *kettlebells.* Taking this into account I find the level of distinctive character to be slightly higher than medium.

Likelihood of confusion

46. 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 and services down to the responsible undertaking 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 goods and services may be offset by a greater degree of similarity between the marks, or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alert 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 the marks that they have retained in their mind.

47. In *L.A. Sugar Limited*[11]*,* Mr Iain Purvis Q.C., sitting 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.).

[11] *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

(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)."

48. I bear in mind that the categories listed above in *L.A. Sugar* are not an exhaustive list of all the ways in which indirect confusion can occur. They are merely examples of the way in which it could or tends to occur.

49. In *Kurt Geiger v A-List Corporate Limited*[12], Mr Iain Purvis Q.C. again sitting as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited Sabel v Puma at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in Sabel. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

50. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

51. So far in this decision I have found that:

- The goods are identical.

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- The average consumers for the contested goods at issue are the general public and fitness businesses paying a medium degree of attention in a predominantly visual purchasing process.
- There is a medium degree of visual, aural and conceptual similarity between the respective marks.
- The earlier mark is inherently distinctive to a medium degree which has been enhanced through use to a modest extent for *dumb bells* and *kettlebells.*

52. The respective marks share the word, namely **BISON**, at their beginnings. However even taking into account the case law relating to the beginnings of words and the distinctiveness of the earlier mark, I find this similarity is outweighed by the difference, namely the additional word **FORCE**, in the applicant's mark. Although in my view **FORCE** is not as strong in distinctiveness as **BISON** which precedes it, it is sufficiently impactful for the average consumer not to directly confuse the marks, that is to mistake one mark for the other where the goods are identical.

53. Having found that there is no likelihood of direct confusion, I now consider whether there is any indirect confusion. I remind myself of the guidance given in *L.A.Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to a shared undertaking, taking the later mark to be a possible brand extension or sub brand of the earlier mark.

54. I find that the average consumer on seeing **BISONFORCE** may note that additional second element but since the word **FORCE** could allude to the goods, to my mind, the consumer is likely to see this as indicating a brand extension or sub-brand, i.e. consumers will likely assume that it is perhaps an additional range of goods from the opponent's stable of products, as illustrated by the example given in point 17(c) of *L.A.Sugar.* As such the consumer is likely to be confused into believing that the respective goods come from the same or economically linked undertakings. Therefore I find there is a likelihood of indirect confusion.

55. The opposition brought under section 5(2)(b) is successful.

Section 5(4)(a)

56. 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) […]
>
> (a) [...]
>
> (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."

57. 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)."

58. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires "a substantial number of members

of the public are deceived" rather than whether the "average consumers are confused". However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*[13], it is doubtful whether the difference between the legal tests will produce different outcomes. In my view, this is the case here. Whilst I accept that the opponent has demonstrated sufficient use for its goods, namely *dumb bells* and *kettlebells*, and I would likely find goodwill in those goods, its claim under Section 5(4)(a) does not provide any better an outcome than for section 5(2)(b). Therefore I will not consider this ground further.

Overall conclusion

59. The opposition has been successful and, subject to any appeal of this decision, the application will be refused.

Costs

60. The opponent has been successful and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. Bearing in mind the TPN, I award costs as follows:

£200	Official fee
£400	Preparing statement and considering the counterstatement
£700	Preparing evidence and considering the other side's submissions
£450	Preparing written submissions
£1750	**Total**

61. I order Perdip Singh Dosanjh to pay Wolverson Fitness Limited the sum of £1750. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

[13] [2012] EWCA (Civ) 1501

Dated this 18th day of December 2025.

June Ralph
For the Registrar
The Comptroller-General