

O/611/20

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003322139 AND UK00003322153

BY FRUITCAKE CONSULTING LIMITED  
TO REGISTER THE FOLLOWING MARKS:

**Lotta From Stockholm**

IN CLASSES 25 AND 35

AND

**Lotta's**

IN CLASS 25

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS. 414120 AND 414121

BY LOTTO SPORT ITALIA S.P.A

## BACKGROUND AND PLEADINGS

1. On 3 July 2018, Fruitcake Consulting Limited (“the applicant”) applied to register the trade marks **Lotta from Stockholm** (“the First Application”) and **Lotta’s** (“the Second Application”) in the UK. The applications were published for opposition purposes on 20 July 2018. In respect of the First Application, registration is sought for the following goods and services:

Class 25 Articles of clothing; Boots; Casual clothing; Casual footwear; Casual wear; Childrens' clothing; Children's footwear; Children's headwear; Children's wear; Clogs; Clothes; Clothing; Coats; Footwear; Footwear for men and women; Footwear made of wood; Girls' clothing; Gloves; Hats; Head scarves; Headwear; Ladies' clothing; Woollen socks; Scarves; Shoes; Socks; Jumpers; excluding sports clothing and sports footwear.

Class 35 Advertising; Advertising and marketing; Advertising and publicity; Advertising, marketing and promotion services; Advertising through all public communication means.

2. In respect of the Second Application, registration is sought for the following goods:

Class 25 Clogs, clog boots and other footwear made on a base of wood.

3. On 19 October 2018, Lotto Sport Italia S.p.A (“the opponent”) opposed the applications based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The oppositions based upon section 5(2)(b) are directed against the applicant’s class 25 goods only and the opposition based upon sections 5(3) and 5(4)(a) are directed against the application in its entirety.

4. For the purposes of its oppositions based upon sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade marks:

LOTTO

UKTM no. 1257200

Filing date 30 December 1985; registration date 30 December 1985  
("the First Earlier Mark")

LOTTO LEGGENDA

EUTM no. 8243669

Filing date 24 April 2009; registration date 22 November 2009  
("the Second Earlier Mark")



EUTM no. 8699753

Filing date 19 November 2009; registration date 21 April 2011  
("the Third Earlier Mark")



EUTM no. 8479644

Filing date 7 August 2009; registration date 1 February 2010  
("the Fourth Earlier Mark")

**LOTTO**  
VECTOR

EUTM no. 13624762

Filing date 8 January 2015; registration date 12 August 2016  
("the Fifth Earlier Mark")

The goods and services upon which the opponent relies are set out in the Annex to this decision.

5. For the purposes of its oppositions based upon section 5(4)(a) of the Act, the opponent relies upon the sign **LOTTO** which it claims to have used throughout the UK

since 2 February 1985 in relation to “a variety of goods and services but for the purposes of this opposition, [...] sports and casual clothing and footwear, and the retailing of those items, in particular”.

6. The applicant filed counterstatements denying the claims made and putting the opponent to proof of use of the First, Second, Third and Fourth Earlier Marks.

7. The opponent is represented by Cleveland Scott York LLP and the applicant is represented by Urquhart-Dykes & Lord LLP. Both parties filed evidence. The opponent filed evidence in reply. Neither party requested a hearing and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

8. The opponent filed evidence in chief in the form of the witness statement of Andrea Tomat dated 1 November 2019, which is accompanied by 13 exhibits. Ms Tomat is the President of the opponent, a position she has held since 1999. Within the body of Ms Tomat’s witness statement, a reference was made to the fact that the opponent requested confidentiality in respect of Exhibits AT6 and AT7. A Case Management Conference took place before me on 30 November 2020 and it was directed that Exhibit AT6 would remain confidential from the public. The customer details contained within Exhibit AT7 were redacted and refiled by the opponent.

9. The applicant filed evidence in chief in the form of the witness statements of Kent Reinholdson and Alison Jane Cole, as well as the joint witness statement of Jonathan Uren and Lotta Söderholm. Mr Reinholdson is a supplier of the applicant and his evidence is dated 4 February 2020. Ms Cole is the attorney acting for the applicant and her evidence is dated 5 February 2020 and is accompanied by 4 exhibits. Mr Uren and Ms Söderholm are the Directors of the applicant and their joint statement is dated 5 February 2020 and is accompanied by 12 exhibits.

10. The opponent filed evidence in reply in the form of the second witness statement of Andrea Tomat dated 29 July 2020 and the witness statements of Tracy Kaye Crowley and Catherine Ayers. Ms Crowley is a paralegal who works at the opponent’s

representatives and her statement is dated 29 July 2020. Ms Ayers is a trade mark attorney acting on behalf of the opponent and her statement is dated 11 May 2020.

11. As noted above, both parties also filed written submissions in lieu of a hearing. I have read the evidence and submissions in their entirety. I do not propose to summarise them here, but will refer to them below where necessary.

## **DECISION**

### **Section 5(2)(b)**

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

“5(2) A trade mark shall not be registered if because –

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

13. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the Fifth Earlier Mark had not completed its registration process more than 5 years before the publication date of the marks in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all goods identified for that mark. However, the First, Second, Third and Fourth Earlier Marks are subject to the proof of use provisions and the applicant has requested that the opponent provide evidence of use.

## **Preliminary Issue**

14. I note that the applicant has filed evidence of use of the applied-for marks prior to the application date. The applicant claims to have been using the marks in the UK since 2010. However, for the avoidance of doubt, this does not assist the applicant. Firstly, the opponent's earlier marks would still pre-date the applicant's use. Secondly, prior use of the applications is not a defence in law to an opposition under section 5(2)(b) of the Act. Tribunal Practice Notice 4/2009 explains this as follows:

*“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark.*

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark.”

15. Consequently, the opponent's mark has priority.

## **Proof of Use**

16. I will begin by assessing whether there has been genuine use of those marks. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (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), (b) 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

17. Section 100 of the Act is also relevant, which reads:

“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.”

18. As set out above, the relevant period is the five year period ending with the date of publication of the applied-for marks i.e. 21 July 2013 to 20 July 2018.

19. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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 Bunderversammlung 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 Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm*



*Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

20. As the Second, Third and Fourth Earlier Marks are EUTMs, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”. ”

At paragraphs 57 and 58, the court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark 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.”

21. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames

Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guilford, and thus a finding which still left open the possibility of conversion of the community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State." On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

22. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark).

23. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTMs, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them; and
- e. The geographical extent of the use shown.

24. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

#### Form of the marks

25. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

26. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

27. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

28. There are examples of the First, Second and Third Earlier Mark in use as registered. This will, clearly, be use upon which the opponent can rely. I also consider that any use of the Second, Third and Fourth Earlier Marks will also be use of the First Earlier Mark as registered, as they all include the word LOTTO. There are also various examples of other marks used throughout the evidence. I will deal with these in turn:

1) **LOTTO LEGGENDA**

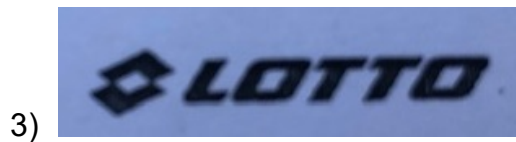
29. The Second Earlier Mark is the word only mark LOTTO LEGGENDA. Registration of a word only mark covers use in any standard typeface. Consequently, I consider the slightly stylised fonts in this mark to be covered by notional and fair use of the Second Earlier Mark. This is, therefore, use of the Second Earlier Mark as registered. The First Earlier Mark consists of the word LOTTO. That word is clearly visible in this



mark, with a slight stylisation and alongside a device. I consider this to be use of the First Earlier Mark as registered.



30. As noted above, the Second Earlier Mark consists of the words LOTTO LEGGENDA. These elements are present in the mark as used in the opponent's evidence. However, they are used in stylised fonts and with the addition of a device, which are not present in the mark as registered. For the same reasons as set out above, I consider the use of stylisation to be covered by notional and fair use of the Second Earlier Mark. Further, the word elements retain an independent distinctive role within the mark as used. Consequently, I consider this to be use of the Second Earlier Mark as registered in accordance with *Colloseum*. For the same reasons set out above, I also consider this to be use of the First Earlier Mark as registered.



31. The distinctive character of the Third Earlier Mark lies in the word LOTTO and the device. This mark is the same as the Second Earlier Mark, but presented black on white (instead of white on black) and without the divided background. I do not consider that these changes alter the distinctive character of the Third Earlier Mark. This is an acceptable variant use as per *Nirvana*. For the same reasons set out above, I also consider this to be use of the First Earlier Mark as registered.



32. As noted above, the distinctive character of the Third Earlier Mark lies in the word LOTTO and the device. These elements are rearranged in this mark and do not appear with the same divided background. However, I do not consider that these changes alter the distinctive character of the Third Earlier Mark. This is an acceptable variant use as per *Nirvana*. For the same reasons set out above, I also consider this to be use of the First Earlier Mark as registered.



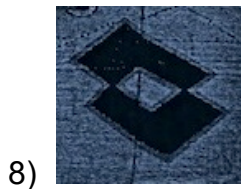
33. The distinctive character of the Fourth Earlier Mark lies in the words LOTTO WORKS and the device. I do not consider that the line and background contribute significantly to the mark's distinctive character. The differences between the Fourth Earlier Mark as registered and the way in which this mark has been presented, is the order in which the elements appear and the size of the device vs. the word elements. Further, the background and line are absent. Taking all of this into account, I do not consider that the differences alter the distinctive character of the Fourth Earlier Mark. This is an acceptable variant use as per *Nirvana*. For the same reasons set out above, I also consider this to be use of the First Earlier Mark as registered.



34. To my mind, the same also applies to this variant use. The addition of two lines, which are essentially used as a border do not, in my view, alter the distinctive character of the Fourth Earlier Mark. I consider this to be an acceptable variant use as per *Nirvana*. For the same reasons set out above, I also consider this to be use of the First Earlier Mark as registered.



35. In this mark, the Fourth Earlier Mark appears as registered with the additional words “EVERYDAY FIRST” presented beneath it. These words are likely to be seen as a slogan. I consider that the Fourth Earlier Mark continues to indicate origin in the way it has been used and retains an independent distinctive role. I consider this to be use of the Fourth Earlier Mark as registered as per *Colloseum*. For the same reasons set out above, I also consider this to be use of the First Earlier Mark as registered.



36. Throughout the opponent’s evidence the above device, described as the “double field” device, is used independently of any words that it accompanies in the earlier marks. For the avoidance of doubt, I do not consider this to be an acceptable variant of any of the earlier marks. The distinctive character of the earlier marks that include this device lies in both the device and the word elements. Where the device is used on its own, the distinctive character of those marks has been altered and this will not be acceptable variant use as per *Nirvana*.

### Sufficient Use

37. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>1</sup>

### *The First Earlier Mark*

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<sup>1</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

38. Ms Tomat gives evidence that the “Lotto” brand was founded in 1973. The First Earlier Mark is a UK trade mark and so I must make my assessment as to whether there has been genuine use in the UK. Ms Tomat notes that there are only 5 physical stores located in the UK and that internet sales are particularly important for the UK market.

39. Ms Tomat has provided a list of UK sales made under the First Earlier Mark.<sup>2</sup> This includes sales in relation to a range of clothing items, sandals and sports footwear for the years 2014 to 2018. The total sales amount to over 2.3million, although its not clear whether this figure is GBP or EUR.

40. There is also evidence of catalogues having been distributed in the UK market which display use of the First Earlier Mark as registered.<sup>3</sup> These are provided for the years 2014 to 2016 and display a range of trainers, as well as a jumper and t-shirt.

41. Examples of invoices addresses to businesses in the UK have also been provided.<sup>4</sup> The businesses are located in Warwick, London, Devon, Buckinghamshire and Flintshire. They are dated between January 2015 and March 2018 and relate to sports shoes, shorts, t-shirts, trousers, jackets, skirts, dresses, leggings, bras, socks, sports bags and backpacks.

42. Although the use shown relates to a broader range of goods than those covered by the specification (such as footwear and bags), it is only use in relation to those goods relied upon that are relevant for the purposes of my assessment. Taking all of this evidence into account, I am satisfied that the opponent has demonstrated genuine use of the First Earlier Mark during the relevant period in relation to trousers, jackets, skirts, leggings and bras.

### *The Second Earlier Mark*

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<sup>2</sup> Exhibit AT7, pages 2 to 11

<sup>3</sup> Exhibit AT7, pages 12 to 22

<sup>4</sup> Exhibit AT7, pages 122 to 146

43. As the Second Earlier Mark is an EU trade mark, the relevant market for assessing proof of use is the EU. An acceptable variant of the Second Earlier Mark appears on the cover page of catalogues for 2014, 2016, 2017 and 2018.<sup>5</sup> It is not clear what products these catalogues relate to, but at least some of them display use in relation to trainers.

44. [REDACTED]  
[REDACTED]  
[REDACTED]<sup>6</sup> [REDACTED]  
[REDACTED]  
[REDACTED]

45. Clearly, there have been sales made under the Second Earlier Mark during the relevant period. It is reasonable to infer that at least a proportion of these sales must relate to products sold under the catalogues distributed during those years i.e. trainers. Taking the evidence as a whole, I am satisfied that there has been genuine use of the Second Earlier Mark during the relevant period in relation to trainers. However, in the absence of any further evidence relating to the goods sold under the mark, I am unable to find genuine use in relation to any of the other goods relied upon.

*The Third Earlier Mark*

46. As noted above, there are examples of catalogues having been distributed in the UK during the years 2014 to 2017.<sup>7</sup> These all display the Third Earlier Mark and refer to a range of trainers, as well as a jumper and t-shirt. However, no information is provided about who these catalogues were distributed to. If these were distributed to retailers (as opposed to end consumers) based in the EU then I see no reason for these documents to support use in relation to retail services.

47. There are examples of invoices which display the Third Earlier Mark addressed to businesses located in Italy, Greece, Germany, Spain, Czech Republic, Denmark,

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<sup>5</sup> Exhibit AT5

<sup>6</sup> Exhibit AT6

<sup>7</sup> Exhibit AT7, pages 12 to 22

Portugal, Romania and the UK.<sup>8</sup> These are dated between August 2013 and March 2018 and relate to trainers, gloves, sports shoes, skirts, shorts, visors, t-shirts, trousers, leggings, bras, dresses, jackets, socks, backpacks and sports bags. In total, these invoices relate to over 20,000 units. However, these invoices appear to be addressed to businesses in the EU who would, presumably, sell the products on to end customers through their own retail outlets. These invoices do not support use in relation to retail services.

48. I note that Ms Tomat states:

“For the UK market, online sales are very important. There are only 5 stores listed on the ‘store locator’ part of our website, but our products are sold via Zalando, Amazon, Custom Planet, Tennis point and many other on-line retailers, and via our website. In the EU27 countries, there are hundreds of stockists. There are 3 stores stocking our products in central Paris, and 4 such stores in central Florence alone, for example. Across EU27 countries, we have 10 mono-brand Lotto retail stores, 8 in Italy and two in Spain.”

49. Ms Tomat’s statement is dated November 2019 (after the relevant period). As she does not confirm when any of these stores were opened, I have no way of knowing whether the opponent was offering retail services during the relevant period. Photographs of store fronts have also been provided.<sup>9</sup> However, these are also dated after the relevant period and do not, therefore, assist the opponent. Further, I have seen no dated print outs from the opponent’s website which clearly show goods being offered for sale through that website.

50. Taking the evidence as a whole into account, I do not consider that the opponent has shown genuine use of the Third Earlier Mark in relation to the services relied upon. As the opponent has failed to show genuine use of the Third Earlier Mark, it is unable to rely upon it for the purposes of this opposition.

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<sup>8</sup> Exhibit AT7

<sup>9</sup> Exhibit AT7

### *The Fourth Earlier Mark*

51. The Fourth Earlier Mark is displayed on a catalogue dated 2014 (which displays trainers).<sup>10</sup>

52. [REDACTED]  
[REDACTED]  
[REDACTED]<sup>11</sup>

53. Clearly, sales have been made under the Fourth Earlier Mark. However, no breakdown is provided in relation to what goods these sales relate to. Nonetheless, I consider that it is reasonable to infer that at least a proportion of the sales for 2014 would have related to the products displayed in the 2014 catalogue provided i.e. trainers. Taking the evidence as a whole into account, I am satisfied that the opponent has proved genuine use in relation to trainers during the relevant period.

### Fair specification

54. I must now consider whether, or the extent to which, the evidence shows use of the First, Second and Fourth Earlier Marks in relation to the goods and services relied upon. 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.”

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<sup>10</sup> Exhibit AT5

<sup>11</sup> Exhibit AT6

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

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

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

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

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of



protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

56. The use shown in relation the First Earlier Mark clearly relates to specific items which are covered by the mark’s specification. I see no reason to find use in relation to the other terms included and for which use has not been shown. I note that the specification of the First Earlier Mark includes the term “articles of underclothing”. The opponent has shown use in relation to bras and leggings, which fall within that category. Given that different goods have been used in that particular category, I do not consider that it would be appropriate to narrow the term down any further. I consider a fair specification for the First Earlier Mark to be:

Class 25      Trousers, jackets, skirts, articles of underclothing.

57. To my mind, the only use that has been shown in relation to the Second and Fourth Earlier Marks relates to trainers. This falls within the term “footwear” of the opponent’s class 25 specification. However, this is a far broader term which could cover a range of goods from casual footwear, to formal footwear to sports footwear. Given the limited use shown by the opponent, I consider a fair specification for the Second and Fourth Earlier Marks to be:

Class 25      Sports footwear.

### **Section 5(2)(b) – case law**

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

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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

59. In light of my findings above, the competing goods are as follows:

Opponent's goods	Applicant's goods
<p><b>First Earlier Mark</b> <u>Class 25</u> Trousers; jackets; skirts; articles of underclothing.</p> <p><b>Second and Fourth Earlier Marks</b> <u>Class 25</u> Sports footwear.</p> <p><b>Fifth Earlier Mark</b> <u>Class 25</u> Clothing; Waterproof outerclothing; Mackintoshes; Weatherproof jackets; Workwear; Boiler suits; Clothing of imitations of leather; Clothing of leather; Motorists' clothing; Cyclists' clothing; Clothing for gymnastics; Sportswear;</p>	<p><b>First Application</b> <u>Class 25</u> Articles of clothing; Boots; Casual clothing; Casual footwear; Casual wear; Childrens' clothing; Children's footwear; Children's headwear; Children's wear; Clogs; Clothes; Clothing; Coats; Footwear; Footwear for men and women; Footwear made of wood; Girls' clothing; Gloves; Hats; Head scarves; Headwear; Ladies' clothing; Woollen socks; Scarves; Shoes; Socks; Jumpers; excluding sports clothing and sports footwear.</p> <p><b>Second Application</b> <u>Class 25</u></p>

<p>Clothing for athletics; Gowns; Bath robes; Bath robes; Underwear, knitted and of textile; Underwear; Sweat-absorbent underwear; Slips [undergarments]; Brassieres; Culottes; Boxer shorts; Bathing drawers; Pants (Am.); Beachwear; Swimsuits; Boxer shorts; Smocks; Swimming caps; Shower caps; Tights; Garters; Stockings; Stockings (Sweat-absorbent -); Heelpieces for stockings; Slippers; Socks; Jodhpurs; Tights; Leggings [trousers]; Leggings; Shirts; Long-sleeved shirts; Short-sleeve shirts; Aerodynamic shirts; Formal shirts; Jackets (Stuff -) [clothing]; Bodices [lingerie]; Headgear; Headgear; Hoods [clothing]; Berets; Caps [headwear]; Belts [clothing]; Belts (Money -) [clothing]; Headbands [clothing]; Ear muffs (clothing); Headgear; Visors [headwear]; Bandanas [neckerchiefs]; hankerchiefs; Shawls; Sashes for wear; Suits; Ties; Sweat shirts; Sashes; Gabardines [clothing]; Topcoats; Outer clothing; Trouser straps; Jackets; Jackets [clothing]; Wind resistant jackets; Jackets, with or without sleeves; running jackets; biker jackets; Quilted jackets; Fishing vests; Blazers; Skirts; Sports skirts; Skorts; Aprons [clothing]; Pinafore dresses; Girdles; Gloves; Mittens; Bicycle gloves; Gloves for</p>	<p>Clogs, clog boots and other footwear made on a base of wood.</p>
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motorcyclists; Ski gloves; wintergloves; Snowboard gloves; Gloves including those made of skin, hide or fur; Ready-to-wear clothing; Jumpers; Tee-shirts; Bermuda shorts; Singlets; Hosiery; Polo tops; Pullovers; Muffs [clothing]; Pelerines; Mantillas; Trousers shorts; Pants (Am.); Aerodynamic trousers; Sports trousers; Stretch pants; Ultra-breathable trousers for sport; Balaclavas; Pyjamas; Cuffs; Ponchos; Pullovers; Ski suits; Arm warmers; Body warmers; Knee warmers; Leg warmers; Ear muffs; Sandals; Bath sandals; Bath slippers; Slippers; Footwear; Sports shoes; Footwear; Gymnastic shoes; Working shoes; Beach shoes; Football boots; Sports shoes; Gaiters; Ankle boots; Work boots; Rain boots; Wooden shoes; Soles for footwear; Soles for footwear; Goloshes; Non-slipping devices for footwear; Studs for football boots; Fittings of metal for footwear; Tips for footwear; Heelpieces for footwear; Heelpieces for footwear; Footwear uppers; Footwear uppers; Combinations [clothing]; Wetsuits for water-skiing; Jumpsuits (clothing); Warm-up suits; Uniforms.	
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60. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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 für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

61. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (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.

### First Application

62. All of the goods in the specification of the First Earlier Mark will fall within the broader category of “articles of clothing [...] excluding sports clothing and sports

footwear” in the applicant’s specification. The term “clothing” in the specification of the Fifth Earlier Mark will also self-evidently be identical to that term.

63. “Boots”, “casual footwear”, “children’s footwear”, “clogs”, “footwear for men and women”, “footwear made of wood” and “shoes” in the applicant’s specification will fall within the broader category of “footwear” in the specification of the Fifth Earlier Mark. Whilst I note that the applicant’s specification contains a limitation to exclude “sports clothing and sports footwear” this does not prevent the goods from being identical, given the broad term in the opponent’s specification, which is not limited. I also consider that these terms in the applicant’s specification will overlap in method of use, purpose, trade channels and user with “sports footwear” in the specifications of the Second and Fourth Earlier Marks, notwithstanding the limitation. Consequently, these goods will be highly similar.

64. All of the goods in the specification of the First Earlier Mark could fall within the broader categories of “casual clothing”, “casual wear”, “children’s clothing”, “children’s wear”, “clothes”, “clothing”, “girl’s clothing” and “ladies’ clothing” in the applicant’s specification. This is because the opponent’s goods could cover children’s clothing as well as adults clothing. Further, these terms will be either self-evidently identical or identical on the principle outlined in *Meric* to “clothing” in the Fifth Earlier Mark’s specification.

65. “Children’s headwear”, “hats”, “head scarves” and “headwear” in the applicant’s specification will either be self-evidently identical or identical on the principle outlined in *Meric* to “headgear” in the specification of the Fifth Earlier Mark. There may also be overlap in trade channels with the goods covered by the specifications of the First, Second and Fourth Earlier Marks. There may be overlap in use as they are all intended to protect parts of the body, as well as overlap in user. Consequently, these goods will be similar to a medium degree.

66. “Coats” in the applicant’s specification may be considered identical to the term “jackets” in the specification of the First Earlier Mark. However, even if this is not the case, they will overlap in user, nature, method of use, purpose and trade channels. There may also be a degree of competition. Consequently, the goods will be highly

similar. This term will also fall within the broader category of “clothing” in the specification of the Fifth Earlier Mark and will be identical on the principle outlined in *Meric*.

67. “Sports footwear” in the specifications of the Second and Fourth Earlier Marks will not be identical to the terms “footwear [...] excluding sports clothing and sports footwear” and “shoes [...] excluding sports clothing and sports footwear” in the applicant’s specification. However, they will overlap in nature, method of use, purpose, user and trade channels. There may be a degree of competition between them. Consequently, these goods will be highly similar. Further, this term will fall within the broader category of “footwear” in the specification of the Fifth Earlier Mark and will be identical on the principle outlined in *Meric*.

68. The term “gloves” appears identically in the applicant’s specification and the specification of the Fifth Earlier Mark. There may also be an overlap in trade channels with the goods covered by the First Earlier Mark’s specification. These goods will also overlap in purpose as they are all intended to cover parts of the body, as well as user. There may be overlap in nature and method of use. Consequently, these goods will be similar to at least a medium degree.

69. “Woollen socks” in the applicant’s specification will fall within the broader category of “socks” in the specification of the Fifth Earlier Mark. These goods will be identical on the principle outlined in *Meric*. The term “socks” in the applicant’s specification will, self-evidently, be identical to the term “socks” in the specification of the Fifth Earlier Mark. There may also be an overlap in trade channels with the goods covered by the First Earlier Mark’s specification. These goods will also overlap in purpose as they are all intended to cover parts of the body, as well as user. There may be overlap in nature and method of use. Consequently, these goods will be similar to at least a medium degree.

70. The term “scarves” in the applicant’s specification will overlap in trade channels with the goods covered by the specifications of the First and Fifth Earlier Marks. The goods will also overlap in purpose, as they are intended to cover parts of the body, as



well as user. There will also be a degree of overlap in nature. Taking all of this into account, I consider the goods to be similar to a medium degree.

71. The term “jumpers” appears identically in both the applicant’s specification and the specification of the Fifth Earlier Mark. There will also be overlap in trade channels with the terms covered by the specification of the First Earlier Mark. There will also be overlap in purpose as they are all intended to cover parts of the body, as well as user. There may be overlap in nature and method of use. Consequently, these goods will be similar to at least a medium degree.

### Second Application

72. “Clogs, clog boots and other footwear made on a base of wood” in the applicant’s specification will fall within the broader category of “footwear” in the specification of the Fifth Earlier Mark. These goods are, therefore, identical on the principle outlined in *Meric*. There will also be a degree of overlap in trade channels with “sports footwear” in the specifications of the Second and Fourth Earlier Marks, as all of these goods could be sold through general footwear businesses. There will clearly be overlap in terms of purpose, user and method of use. There may also be a degree of competition to the extent that sports footwear may be worn, not only for sport, but also for fashion purposes. However, I recognise that this may be limited. Taking all of this into account, I consider the goods to be similar to at least a medium degree.

73. In reaching these conclusions, I have taken into consideration the evidence of Mr Reinholdson, who has worked for a shoe manufacturer for the last 43 years. Mr Reinholdson explains that his family has been manufacturing clogs for a number of years and explains that the process for producing these is very different to the production of trainers/sneakers. He gives evidence that his company would not be able to make trainers/sneakers. I have also taken into consideration the evidence of Ms Cole which identifies the different origins and methods of construction of clogs and trainers/sneakers.<sup>12</sup> That may very well be the case. However, as set out above, very often the specification of the respective parties requires comparison, not between

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<sup>12</sup> Exhibits AJC1 to AJC3

'clogs' and 'trainers', but between 'clogs' and 'footwear' more generally. Even where this comparison does need to be made, there may still be some degree of overlap in trade channels to the extent that both may be sold through the same retailers. I do not, therefore, consider this evidence to be of assistance to the applicant.

### **The average consumer and the nature of the purchasing act**

74. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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 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.”

75. The average consumer for the goods will be a member of the general public. Although prices can vary considerably, on balance it seems to me that the cost of the purchase is likely to be relatively low and the goods will be purchased reasonably frequently. However, various factors are still likely to be taken into account during the purchasing process such as materials, cut, aesthetic appearance and durability. Consequently, I consider that a medium degree of attention will be paid when selecting the goods.

76. The goods are likely to be obtained by self-selection from the shelves of a retail outlet or an online or catalogue equivalent. 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, as advice may be sought from a sales assistant or representative.

### **Comparison of trade marks**


77. 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 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.”

78. 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.

79. The respective trade marks are shown below:

<b>Opponent's trade marks</b>	<b>Applicant's trade marks</b>
LOTTO (the First Earlier Mark)	Lotta From Stockholm (the First Application)
LOTTO LEGGENDA	Lotta's

<p>(the Second Earlier Mark)</p>  <p>(the Fourth Earlier Mark)</p> <p><b>LOTTO</b> VECTOR</p> <p>(the Fifth Earlier Mark)</p>	<p>(the Second Application)</p>
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### Overall Impression

80. The First Application consists of the words “Lotta From Stockholm”. The overall impression lies in the combination of these words as a unit. The Second Application consists of the word “Lotta’s”. There are no other elements to contribute to the overall impression of the mark which lies in the word itself.

81. The First Earlier Mark consists of the word LOTTO. Again, there are no other elements to contribute to the overall impression of the mark which lies in the word itself. The Second Earlier Mark consists of the words LOTTO LEGGENDA. The overall impression lies in the combination of these words. The Fourth Earlier Mark consists of the words LOTTO WORKS presented in white slightly stylised fonts on a black background. The words are separated by a grey line and appear next to a white geometrical device on a grey background. The word and device elements play the greater role in the overall impression of the mark, with the wording playing a slightly greater role than the device. The other background elements play a lesser role. The Fifth Earlier Mark consists of the words LOTTO VECTOR presented in a slightly stylised font. The word LOTTO appears above the word VECTOR and in larger font. Consequently, it is the word LOTTO that plays the greater role in the overall impression, with the word VECTOR playing a slightly lesser role.

## Visual Comparison

### *The First Application*

82. The First Application and the First Earlier Mark overlap visually to the extent that the first four letters of both marks are the same i.e. LOTT/Lott. However, they differ in that the last letter of the word is “O” in the First Earlier Mark and “A” in the First Application. Further, the First Application has the additional words “from Stockholm” which have no counterpart in the First Earlier Mark. I do not consider that the difference in capitalisation/title case is relevant to my assessment. Taking all of this into account, I consider there to be between a low and medium degree of visual similarity between the marks.

83. The same applies to the First Application and the Second Earlier Mark. However, there is the additional point of difference in that the Second Earlier Mark also contains the word “LEGGENDA”. Taking all of this into account, I consider the marks to be visually similar to only a low degree.

84. The same similarity applies between the word “Lotta” in the First Application and the word “lotto” in the Fourth Earlier Mark. However, the words “from Stockholm” in the First Application have no counterpart in the Fourth Earlier Mark and the word “WORKS” in the Fourth Earlier Mark has no counterpart in the First Application. Further the device and background elements in the Fourth Earlier Mark are absent from the First Application. Taking all of this into account, I consider any visual similarity between the marks to be very low.

85. Again, the point of similarity between the First Application and the Fifth Earlier Mark are the first four letters i.e. LOTT/Lott. The last letter of the first word differs, being “O” in the Fifth Earlier Mark and “a” in the First Application. Further the words VECTOR in the Fifth Earlier Mark and “From Stockholm” in the First Application are a further point of visual difference. I consider the marks to be visually similar to a low degree.

### *The Second Application*

86. The Second Application and the First Earlier Mark overlap in that the first four letters are the same i.e. LOTT/Lott. The point of visual difference lies in the last letter of the First Earlier Mark being “O” and the ending of the Second Application being “a’s”. I recognise that as a general rule the beginning of marks tend to make more of an impact than the end.<sup>13</sup> I also recognise that the shorter the marks, the more impact differences tend to have.<sup>14</sup> Both marks are relatively short, but the similarities do come at the beginning. Taking all of this into account, I consider the marks to be visually similar to between a medium and high degree.

87. The same similarity applies between the Second Application and the Second Earlier Mark. However, there is the added difference created by the additional word “LEGGENDA” in the Second Earlier Mark. Taking all of this into account, I consider the marks to be visually similar to between a low and medium degree.

88. Again, the similarity between the Second Application and the Fourth Earlier Mark will lie in the common letters “Lott/lott”. The end of the first word in each mark will be a point of visual difference, as will the additional word “WORKS” in the Fourth Earlier Mark. Further, the device and background elements will act as a point of visual difference between the marks. Taking all of this into account, I consider the marks to be visually similar to a low degree.

89. Again, the point of similarity between the Second Application and the Fifth Earlier Mark are the first four letters i.e. LOTT/Lott. The ending of the first word differs, being “O” in the Fifth Earlier Mark and “a’s” in the Second Application. Further the word VECTOR in the Fifth Earlier Mark is a further point of visual difference. I consider the marks to be visually similar to between a low and medium degree.

### Aural Comparison

#### *First Application*

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<sup>13</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>14</sup> For example, see *Deutsche Bahn v OHIM*, Case T-274/09

90. The First Application will be pronounced LOTT-AHH-FROM-STOCK-HOME. The earlier marks will be pronounced LOTT-OHH, LOTT-OHH-LEGG-END-AHH, LOTT-OHH-WORKS and LOTT-OHH-VEC-TOR respectively. The first syllable of each earlier mark will be pronounced identically to the first syllable of the First Application. However, the pronunciation of the remaining syllables differ. I consider any aural similarity to be low.

### *Second Application*

91. The Second Application will be pronounced LOTT-AHS. The First Earlier Mark will be pronounced LOTT-OHH. The first syllable will be pronounced identically but there is a point of aural difference created by the second syllable in each mark, with the sound of the second syllable in the Second Application being softer. I consider there to be a medium degree of aural similarity.

92. The remaining earlier marks have further additional syllables that create greater difference from the pronunciation of the Second Application. I consider any aural similarity to be no more than between low and medium.

### Conceptual Comparison

93. The First Application consists of the words Lotta from Stockholm. The applicant submits that this will be recognised as a female forename. Ms Ayers has provided screenshots from webpages regarding the number of babies named “Lotta” in Scotland and Northern Ireland. These confirm that no children were named “Lotta”. I note that the results for “England and Wales” have not been provided. On balance, I consider it likely that the word “Lotta” will be recognised as a shortening of a female forename (such as Charlotte or Carlotta). I consider that a significant proportion of average consumers in the UK will recognise it as such. When taken together, this conveys the clear concept of a female from the city of Stockholm. Similarly, the Second Application consists of the word “Lotta’s” which will be seen as a reference to a shortening of a female name in the possessive form i.e. the goods belong to or originate from someone called Lotta.

94. Ms Ayers gives evidence that the word LOTTO, which is common to each of the earlier marks, will be seen as a reference to “a children’s game” or “a lottery”. I agree that it is likely to be seen as a reference to a lottery. Consequently, the meaning conveyed by the word LOTTO, will be dissimilar to the meaning of the word LOTTA. The word LEGGENDA in the Second Earlier Mark is likely to be seen as a foreign language word with no recognisable meaning. The words WORKS and VECTOR in the Fourth and Fifth Earlier Marks will be recognised as ordinary dictionary words and will be attributed their ordinary English meaning. However, they have no counterpart in the applicant’s marks.

95. Taking all of this into account, I consider the First and Second Applications to be conceptually dissimilar to each of the earlier marks.

96. Even if I am wrong in my finding that the word “Lotta” will be recognised as a shortening of a female forename, it will be viewed as an invented word with no clear meaning. Consequently, it will be conceptually dissimilar to the word LOTTO which, the opponent accepts, does have a clear meaning.

97. I note that the opponent has referred to a decision of this Tribunal involving the marks SANDRA and SANDRO.<sup>15</sup> In that case, the Hearing Officer found the marks to be visually and aurally similar, but conceptually dissimilar. This led to a finding that the marks were dissimilar overall. This decision was overturned on appeal.<sup>16</sup> In that case, Emma Himsworth QC, sitting as the Appointed Person, stated:

“34. Firstly, as noted above the Applicant had admitted with no qualification that the Opponent’s marks would be “understood as the male first name SANDRO” i.e. the marks in issue were names. There was no suggestion that there was any distinction to be drawn on the basis that the Applicant’s mark was a “British name” and the Opponent’s a “foreign sounding name”; secondly the Hearing Officer’s statement that he was “happy to accept” the Opponent’s contention

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<sup>15</sup> O-422-17

<sup>16</sup> O-276-18



“that its mark will be seen by the average UK consumer as a name” (paragraph [37] of the Decision); and thirdly the absence of any suggestion that either name is the name of a well-known person such as to have an established meaning of the type envisaged in Case C-361/04 P Picasso (above). In fact, it seems to me that members of the public could regard SANDRA and SANDRO as different versions of the same name or names derived from the same root such that it would have been open to the Hearing Officer to find that the marks were conceptually similar.”

98. That is not the case here. The opponent accepts that its own mark refers to a game or lottery. I have found that the applicant’s mark is most likely to be seen as a reference to a shortening of a female forename. The marks in this case are, therefore, entirely different in their meaning and do not share a common root. Even if I am wrong in my finding that the applicant’s mark will be seen as a female forename, it will be viewed as an invented word with no clear meaning. By contrast, the opponent’s mark will convey a clear meaning and the marks will share no conceptual similarity. Consequently, the present case can be distinguished from the case referred to by the opponent.

99. I note that the opponent states that, if the applicant’s mark is not recognised as a female forename and, consequently, has no clear meaning, that no conceptual comparison can be undertaken. If both marks had no clear conceptual meaning then no conceptual comparison would be possible and they would be conceptual neutral. However, the case law is clear that where one mark has a clear meaning and the other does not, the marks can be found to be conceptually dissimilar. For example, in *EU IPO v Equivalenza Manufactory*, Case C-328/18 P, the CJEU considered the similarity between two figurative marks, one of which contained the words “BLACK LABEL BY EQUIVALENZA” and the other contained the word “LABELL”. It stated:

“97. Third, from a conceptual point of view, it must be noted that it has not been established that the relevant public understands the meaning of the English word ‘label’, such that it must be held that the earlier mark will be perceived as consisting of a fanciful word which is devoid of meaning. However, the relevant public will understand the adjective ‘black’, which is a basic word in English as

a description of a colour, and will also be able to understand the words ‘by equivalenza’ as an indication that the goods in question come from Equivalenza Manufactory.

98. In view of the above, it follows that the signs at issue have an average degree of visual and phonetic similarity and that those signs are conceptually different.”

100. Similarly, in Case B O/420/18, Emma Himsworth QC, sitting as the Appointed Person, considered the conceptual similarity between the words MANGO and YANGO. She stated:

“34. Paragraph [20] of the Judgment of the CJEU in the Picasso case stated as follows (emphasis added):

By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs in issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences between them may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.

35. It is clear from this paragraph in the judgment, which is not disputed by the Opponent to be the source of the relevant law, that if the meaning of one of the signs is clear and specific such that the meaning may be grasped immediately, as is the position in the present case, then the marks have conceptual differences. That is to say in the present case Mark 1, which as the Hearing Officer found in paragraph [50] of his Decision would be known to the average consumer to be the name of a fruit and tree, is conceptually different to the mark applied for which is accepted to be a made up word.”

101. Consequently, even if the word “Lotta” in the applicant’s marks is attributed no particular meaning, the clear meaning conveyed by the opponent’s mark will mean that they are conceptually different not conceptually neutral.

### **Distinctive character of the earlier trade marks**

102. 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-2779, 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).”

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

104. I will begin by assessing the inherent distinctive character of the earlier marks. The First Earlier Mark consists of the word LOTTO. The opponent's case is that this is an ordinary dictionary word which means either a game or lottery. I agree that it will be recognised as a reference to a lottery. Consequently, I consider it to be inherently distinctive to a medium degree. The Second, Fourth and Fifth Earlier Marks also contain this word but include other elements such as additional words or devices. I consider all of these marks to be inherently distinctive to between a medium and high degree.

105. The relevant market for assessing enhanced distinctiveness is the UK market. Consequently, the opponent's evidence relating to other European countries will not be relevant to this assessment. I note that UK sales under the First Earlier Mark amounted to over 2.3million in total between 2014 and 2018.<sup>17</sup> This amounts to an average of 460,000 per year, although it is not clear whether this is GBP or EUR. I recognise that this is not an insignificant sum, although it does not represent a particularly significant market share given what is undoubtedly an extensive market in the UK for the goods in issue. [REDACTED]

[REDACTED]

[REDACTED]<sup>18</sup> [REDACTED]

[REDACTED] These do not seem to me to be particularly high (or consistent) figures for advertising expenditure. I note that the opponent has attended various European events, some of which at least have been attended by visitors from the UK. For example, the opponent attended the Pitti Immagine Uomo event ("the Pitti Event") in Italy which is described as having been attended by 507 UK visitors in 2017 and 539 UK visitors in 2018.<sup>19</sup> Again, these do not seem to be particularly high figures. I note that by the time of Ms Tomat's statement there were 5 stores operating in the UK. However, it is not clear when these opened. I also note that the opponent is heavily reliant on online sales through businesses such as Amazon. I do note that the opponent has been engaged in sponsorships of various sports teams/players.<sup>20</sup> For

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<sup>17</sup> Exhibit AT7

<sup>18</sup> Exhibit AT6

<sup>19</sup> Exhibit AT3

<sup>20</sup> Exhibit AT2

example, the opponent sponsored Boris Becker at some point prior to his retirement from competitive tennis in 1999.<sup>21</sup> However, given the time that has passed since that sponsorship, it is not clear to me that it would support a finding of enhanced distinctiveness at the relevant date. I also note that the opponent sponsored Kevin Anderson during his achievement of reaching the Wimbledon final in 2018. In 2019, the final had an audience of 9.6million viewers on BBC1 and, as Ms Tomat states, I see no reason to find that the viewer numbers would have been significantly lower the previous year. However, it is not clear to me from the evidence whether the Wimbledon tournament of 2018 took place before or after the relevant date. Many of the sports teams/players listed by the opponent are located outside of the UK. In the absence of any further explanation, I see no reason to conclude that these would be known in the UK. Further, those sports teams/players that are located in the UK are either relatively low in terms of ranking or it is not clear during what time period the sponsorship took place. The evidence filed by the opponent is far from complete. I do not consider that the evidence is sufficient to demonstrate that the distinctiveness of the First Earlier Mark has been enhanced through use.

106. In relation to the Second Earlier Mark, no evidence has been provided regarding UK sales. I have no information about market share or advertising expenditure. I note that it has been referenced in a number of press articles, but these are predominantly European publications (such as Vanity Fair Italy).<sup>22</sup> This mark was also used at the Pitti Event, but given the low levels of visitors from the UK I do not consider this to be particularly compelling. Taking the evidence as a whole into account, I do not consider it sufficient to find that the distinctiveness of the Second Earlier Mark has been enhanced through use.

107. Again, no sales figures have been provided for the Fourth and Fifth Earlier Mark in the UK. I have no information about advertising expenditure or market share. I note that the Fourth Earlier Mark has been used at some exhibitions in Europe, but no information is provided about how this related to the UK market. Taking all of this into

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<sup>21</sup> Exhibit AT2

<sup>22</sup> Exhibit AT7

account, I do not consider the evidence sufficient to find that the distinctiveness of the Fourth and Fifth Earlier Marks have been enhanced through use.

### **Likelihood of confusion**

108. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

109. As the First Earlier Mark is the mark that I have found to be most similar to both the First and Second Application, I will begin by considering likelihood of confusion on the basis of this mark. If there is no likelihood of confusion in respect of the First Earlier Mark, it follows that there will also be no likelihood of confusion in respect of the Second, Fourth and Fifth Earlier Marks.

110. I have found the First Earlier Mark and the First Application to be visually similar to between a low and medium degree, aurally similar to a low degree and conceptually dissimilar. I have found the First Earlier Mark and the Second Application to be visually similar to between a medium and high degree, aurally similar to a medium degree and conceptually dissimilar. I have found the goods to vary from being identical to similar to a medium degree. I have found the First Earlier Mark to be inherently distinctive to a medium degree. I have found the average consumer to be a member of the general public, who will pay a medium degree of attention during the purchasing process. I

have found the purchasing process to be predominantly visual, although I do not discount an aural component.

111. I note that Mr Reinholdson gives evidence that:

“6. If I were to see the trade marks Lotta’s and Lotta’s from Stockholm used in respect of footwear, I would associate it immediately and uniquely with the products of Fruitcake Consulting Limited.”

112. However, Mr Reinholdson has worked with the applicant for a number of years and so he is not in the same position as the average consumer by reference to which I am required to carry out my assessment. The prior use of the applications by the applicant is not relevant for the purposes of an opposition based upon section 5(2)(b) for the reasons set out above. Consequently, I do not consider this evidence to be of assistance to the applicant.

113. I also note that Mr Uren and Ms Söderholm state:

“13. Neither of us, nor anyone working for or with our company have ever encountered any instances of confusion with goods sold by Lotto Sport Italia SpA.”

114. I note that Ms Tomat’s second witness statement was filed with the intention of rebutting that contention. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not

always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

115. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

116. There may be any number of reasons as to why no confusion has been reported to date. It is often the case that consumers who are confused never know that they have been confused and so do not report it to the party from which they purchased the goods. I do not, therefore, consider that this line of argument assists the applicant.

117. I note that Ms Ayers has provided evidence that when the term “lotta sh” or “lotta sho” is typed into the search function on Amazon, the opponent’s products were suggested as possible search options. I also note the applicant’s written submissions in lieu, which state:

“Any search engine results will be very different depending whether or not you have cleared the cache and cookies on your browser. Not being logged into your own account where you may have performed searches for both marks several times will also change the outcome.”

I have no evidence before me about how such search results are generated. However, it seems to me that a possible search option generated by software cannot be used as an analogy for likelihood of confusion from the perspective of the average consumer. This evidence may show that the average consumer will be presented with the option of searching for the opponent’s goods when it is actually searching for the applicant’s goods, but that is not the same as the average consumer mistaking one



for the other. Consequently, I do not consider that this evidence demonstrates that there is a likelihood of confusion.

118. In respect of the First Application, I do not consider that the words “from Stockholm” which have no counterpart in the earlier marks will be overlooked or forgotten by the average consumer. Consequently, I do not consider that there can be direct confusion in respect of the First Application.

119. The visual similarity between the Second Application and the First Earlier Mark will be particularly important for the opponent because I have found that the purchasing process is visual. The distinctiveness of the earlier mark is also a factor in favour of the opponent. However, the conceptual dissimilarity between the marks is a point in favour of the applicant. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

120. I recognise that conceptual differences do not always overcome visual and/or aural similarities.<sup>23</sup> For example, the opponent refers to the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Diramode S.A. v Richard Turnham and Linda Turnham* (BL O/566/19), in which he overturned a decision that the conceptual differences between PIMKIE and PINKIE were sufficient to outweigh the visual and aural similarities between them. Whether or not the conceptual differences are sufficient to outweigh the visual and aural similarities must be decided on the facts of each particular case. However, in this case, I consider it likely that the conceptual differences between the marks will offset the visual and aural similarities. The fact that the word “Lotta’s” in the Second Application will be seen as a possessive form of a

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<sup>23</sup> *Nokia Oyj v OHIM*, Case T-460/07

shortening of a female name and that the opponent's mark will be seen as a reference to a lottery or game will act as conceptual hooks for the average consumer, which will prevent them from being mistakenly recalled or misremembered. I consider this to be the case even when the marks are used on identical goods and taking into account the distinctiveness of the First Earlier Mark. Even if I am wrong in my finding that the word "Lotta" will be recognised as a shortening of a female forename, the conceptual hook created by the word "Lotto", which the opponent itself submits will be recognised as referring to a lottery or game, will still be sufficient to differentiate between them. Taking all of the above factors into account, I do not consider there to be a likelihood of direct confusion.

121. I note that in its Notice of opposition, the opponent claims to have a "family of LOTTO marks". In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU stated:

"62. Whilst it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation to use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.”

122. I consider that the First, Second and Fourth Earlier Marks were available on the market at the relevant date. However, I see no reason why, having recognised the differences between the marks, the average consumer would be mistaken as to the provenance or origin of goods or services covered by the trade marks applied for or consider erroneously that that applied-for marks are part of that family or series of marks. For that reason, I dismiss the opponent’s family of marks argument. I recognise that it is common in the clothing sector for the same mark to be configured in various different ways according to the type of product it designates.<sup>24</sup> However, having recognised the differences between the marks, I see no reason for the average consumer to conclude that they come from the same or economically linked undertakings. One is not a natural brand extension or development of the other. I do not consider there to be a likelihood of indirect confusion.

123. As I have found no likelihood of confusion in respect of the First Earlier Mark, which represents the opponent’s best case, it follows that there will also be no likelihood of confusion in respect of the Second, Fourth and Fifth Earlier Marks.

124. The opposition based upon section 5(2)(b) is dismissed.

## **Final Remarks**

125. For the avoidance of doubt, even if I am wrong in my finding regarding whether the distinctiveness of the First Earlier Mark had been enhanced through use, it would

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<sup>24</sup> *Claudia Oberhauser v OHIM*, T-104/01

not have changed my overall finding regarding likelihood of confusion. The evidence could only have justified a finding that the distinctiveness of the First Earlier Mark had been enhanced to between a medium and high degree through use and I consider that the conceptual differences between the marks would have been sufficient to outweigh this in any event.

### **Section 5(3)**

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

“5(3) A trade mark which -

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

127. As noted above, the marks relied upon all qualify as earlier marks pursuant to section 6 of the Act. I have found that the opponent has satisfied the proof of use requirements in relation to the First, Second and Fourth Earlier Marks and that the Fifth Earlier Mark is not subject to proof of use. However, as the opponent has not satisfied the proof of use requirements for the Third Earlier Mark, it cannot be relied upon for the purposes of its opposition based upon section 5(3) of the Act.

128. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the First, Second, Fourth and Fifth Earlier Marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will

cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

129. The relevant date for the assessment under section 5(3) is the date of the applications i.e. On 3 July 2018.

## **Reputation**

130. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

131. In determining whether the opponent has demonstrated a reputation for the goods and services in issue, it is necessary for me to consider whether its marks will be known by a significant part of the public concerned with the goods and services. In reaching this decision, I must take all of the evidence into account including “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it.”

132. As the First Earlier Mark is a UK trade mark, it must have a reputation amongst a significant part of the UK public. As the Second, Fourth and Fifth Earlier Marks are EU marks, they must have a reputation amongst a significant part of the EU public.

133. Ms Tomat’s evidence is that the First Earlier Mark was first used in the Italy in 1973. [REDACTED]

[REDACTED]<sup>25</sup> [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]<sup>26</sup> [REDACTED]

[REDACTED]

As noted above, the UK proportion of these sales amounts to around 2.3million.<sup>27</sup> I recognise that this is not an insignificant sum, although it does not represent a particularly significant market share given what is undoubtedly an extensive market in the UK for the goods in issue. The evidence shows that the opponent has distributors in Austria, France, Germany, Portugal, Spain, the UK, Greece, Croatia, Bulgaria, Czech Republic, Hungary, Latvia, Malta, Poland, Romania and Slovenia.<sup>28</sup> [REDACTED]

[REDACTED]<sup>29</sup> [REDACTED]

[REDACTED]

[REDACTED] The opponent clearly invests heavily in advertising and promotional activities across the EU. For example, the opponent has provided evidence of sponsorships of sports players and teams located in Italy, France, Spain, Belgium, Slovenia, Germany, Denmark, Portugal, Croatia, Poland, Greece, Czech

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<sup>25</sup> Exhibit AT6  
<sup>26</sup> Exhibit AT6  
<sup>27</sup> Exhibit AT7  
<sup>28</sup> Exhibit AT7  
<sup>29</sup> Exhibit AT6

Republic, Sweden and Romania.<sup>30</sup> Ms Tomat notes that the “Lotto” brand exhibits at various fashion events such as “IPSO Munich” and “Pitti Immagine Uomo” (“the Pitti Event”) in Italy. The IPSO Munich event is described as having “[o]ver 2,800 exhibits, 4 days of high visitor numbers, 18 clearly laid-out halls, 8 segments, including Snowsports and Health and Fitness, 1 full trade fair center boasting 200,000 square metres of exhibition space, 85,000 visitors from some 120 different countries, including around 2,000 accredited journalists and influencers”.<sup>31</sup> The Pitti Event in 2016 is described as having been attended by 25,000 buyers and 30,000 spectators.<sup>32</sup> The First Earlier Mark is advertised through the Miss Italia competition. One of the awarded categories is called “Miss Sport Lotto”. Ms Tomat explains that the competition has around 15,000 entrants each year and is watched by millions of viewers on Italian television. Ms Tomat confirms that in 2017, the final was watched by around 1,102,439 viewers. The evidence confirms that this sponsorship took place in 2014 and 2015.<sup>33</sup> The opponent has also provided evidence that the First Earlier Mark is promoted through Facebook, Youtube, Twitter and Instagram.<sup>34</sup> As of July 2016, these pages had over 60,000 ‘likes’, 330,298 views, 8,390 followers and 24,300 followers respectively. Since that date these figures have increased. It is not clear what proportion of these figures relate to the EU market. Although the evidence in respect of the UK is limited, it seems clear to me that the opponent does have a strong reputation in the First Earlier Mark in other parts of the EU in relation to sports clothing.

134. As noted above, the opponent must demonstrate that its reputation extends to the UK market as the First Earlier Mark is a UK trade mark. I note that the opponent has used its mark in the UK (albeit to a lesser extent than, for example, Italy) and has engaged in advertising here. [REDACTED]

[REDACTED]<sup>35</sup> [REDACTED]

[REDACTED] It has also sponsored some sports teams/players.<sup>36</sup> For example, sponsorship of Boris Becker. However, given that the

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<sup>30</sup> Exhibit AT2

<sup>31</sup> Exhibit AT3

<sup>32</sup> Exhibit AT3

<sup>33</sup> Exhibit AT4

<sup>34</sup> Exhibits AT8 to AT11

<sup>35</sup> Exhibit AT7

<sup>36</sup> Exhibit AT2

evidence shows that Mr Becker retired in 1999, it is not clear to me that this would support a finding of a reputation in the UK at the relevant date. Further, of those sports teams/players located in the UK, many are low in terms of ranking in their respective sports and, in the absence of any further explanation, I see no reason to conclude that they would have raised the opponent's profile in the UK. Further, no dates have been provided for many of the sponsorships meaning that it is impossible to find that they had taken place prior to the relevant date. Consequently, I do not consider that the opponent has demonstrated a reputation in the First Earlier Mark at the relevant date.

135. [REDACTED]  
[REDACTED]  
[REDACTED]<sup>37</sup> [REDACTED]  
[REDACTED]  
[REDACTED]

[REDACTED]<sup>38</sup> These figures seem to me to represent a relatively low market share for the EU as a whole. No advertising expenditure for these marks has been provided. There are examples of the marks being referred to in publications and being shown at exhibitions, but this evidence is fairly limited.<sup>39</sup> Taking all of this into account, I do not consider that the evidence is sufficient to demonstrate a reputation in a significant part of the EU.

136. I have seen no evidence to suggest that there has been use of the Fifth Earlier Mark (or an acceptable variant thereof) in the EU such that it would justify a finding that the opponent had a reputation in the Fifth Earlier Mark at the relevant date.

137. The opposition based upon section 5(3) of the Act is dismissed.

138. In the event that I am wrong in my finding regarding the reputation of the First Earlier Mark in the UK, I will go on to consider whether there would be a link in the event that the opponent had demonstrated a moderate reputation in the UK in relation to sports clothing.

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<sup>37</sup> Exhibit AT6

<sup>38</sup> Exhibit AT6

<sup>39</sup> Exhibits AT3 and AT7



## Link

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

### The degree of similarity between the conflicting marks

I have found the First Earlier Mark and the First Application to be visually similar to between a low and medium degree, aurally similar to a low degree and conceptually dissimilar. I have found the First Earlier Mark and the Second Application to be visually similar to between a medium and high degree, aurally similar to a medium degree and conceptually dissimilar.

### The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

I will proceed on the basis that the First Earlier Mark has a reputation for sports clothing. I consider that these goods will be similar to at least a medium degree to the applicant's class 25 goods for the same reasons set out above. In many cases, these goods will be identical.

I consider these goods to be dissimilar to the class 35 services for which the First Application is applied for. The opponent's goods will clearly differ in nature to the applicant's services. The method of use and purpose will also clearly differ. I recognise that there may be a degree of overlap in user as both may be used by members of the general public, but this is not sufficient on its own for a finding of similarity. I see no reason to conclude that there will be any overlap in trade channels. The opponent's goods will be sold through fashion and sports retailers whereas the applicant's services will be sold through businesses

specialising in advertising services. There is no reason for the goods and services to be in competition or be complementary.

The strength of the earlier mark's reputation

I will proceed on the basis that the First Earlier Mark has a moderate reputation in the UK.

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

I have found the First Earlier Mark to be inherently distinctive to a medium degree.

Whether there is a likelihood of confusion

I consider that there would be no likelihood of confusion in respect of the applicant's class 25 goods for the same reasons set out above. As I have found the applicant's class 35 goods to be dissimilar to those goods for which the opponent has a reputation, there can be no likelihood of confusion.

140. In my view, even for identical goods, the conceptual differences between the marks are such that I do not consider consumers will make any link between the marks in use. Given the opponent accepts that the word "Lotto" will be recognised as a reference to a lottery or game, that will be the case irrespective of whether the applicant's marks are recognised as a shortening of a female forename or not. If any link is made, then it would be too fleeting for the image of the earlier mark to transfer to the later mark in such a way that would give it an unfair advantage.

141. The opposition based upon section 5(3) is dismissed.

## **Final Remarks**

142. In any event, at Q3 of the Notices of opposition, the opponent has selected “yes” in relation to the question “Is it claimed that the similarity between the reputed earlier trade marks and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the marks?”. For the reasons set out above, I do not consider that the relevant public would believe that there was an economic connection between the undertakings responsible for the marks.

143. In relation to Q4, Q5 and Q6, namely:

“Is there any other basis for your claim of unfair advantage?”

“Is there any other basis for your claim to detriment to the reputation of the earlier mark?”

“Is there any other basis for your claim of detriment to the distinctive character of the earlier mark?”

The opponent has given the answer “no”. Consequently, even if I had considered that there was a link, I do not consider that the opponent has demonstrated any basis for damage to arise.

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

144. Section 5(4)(a) of the Act states as follows:

“5(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, or

b) ...

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

145. 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).”

146. For the purposes of its opposition based upon section 5(4)(a), the opponent claims to have used the sign **LOTTO** throughout the UK since 1985. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded 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) proceeding 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.”

147. Mr Uren and Ms Söderholm confirm in their evidence that they have been selling goods under the First and Second Applications since 2010. They state that:

“4. In the early years, (2010 to 2013) our company sold clogs by reference to the trade marks at Portobello market on Fridays (which as fashion day then) and Saturdays. We also attended at least ten events around the UK such as the Oyster Festival in Falmouth and Truro market. The majority of our sales are now done online. Since we moved into our new premises in January 2015, we have also had a retail outlet on site.

5. Our company’s website [www.lottafromstockholm.co.uk](http://www.lottafromstockholm.co.uk) was launched in March 2010, its first recorded scan by the Internet Archive was on April 28<sup>th</sup> 2010. [...]”

148. The first relevant date for the purposes of my assessment based upon section 5(4)(a) will be the date on which the contested marks were applied for i.e. 3 July 2018. However, it is also necessary to consider what the position would have been at the start of the behaviour complained about. In this case, that date will be the date on which the applicant began using the applied-for marks in the UK. This appears to have been at some point in 2010, although it is not clear exactly when. I note that the applicant confirms that its website was established by as early as March 2010. I have taken into consideration the evidence of Ms Crowley which is filed to dispute the use made of the applied-for marks. However, the evidence does not appear to challenge the claim that the applicant used the mark at a market stall in 2010 nor that the applicant has been operating its own website since March 2010. Ms Crowley’s

evidence focuses upon sales through third-party stockists. Taking all of this into account, I will proceed on the basis that the second relevant date is March 2010.

## **Goodwill**

149. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

150. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not

occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

151. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

152. I note that the opponent's evidence shows UK sales under the sign LOTTO amounted to over 2.3million in total between 2014 and 2018.<sup>40</sup> This amounts to an average of 460,000 per year, although it is not clear whether this is in GBP or EUR. Figures for advertising expenditure in the UK during those years have also been provided.<sup>41</sup> I note that Ms Tomat confirms that there were 5 stores operating in the UK at the date of her statement, but it is not clear when these opened. There are examples of sponsorships of well-known sports players and teams, but it is not always clear when these took place.<sup>42</sup> I do note that the sponsorship of Boris Becker must have taken place at some point prior to his retirement from competitive tennis in 1999, although this will mean a significant time had passed between this sponsorship and either relevant date. Taking the evidence as a whole into account, it seems to me that it is sufficient to demonstrate goodwill at the first relevant date i.e. 3 July 2018. However, there does not appear to be sufficient evidence to demonstrate goodwill at the second relevant date i.e. March 2010. No evidence has been provided to demonstrate the extent of the opponent's trading in the UK prior to that date.

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<sup>40</sup> Exhibit AT7

<sup>41</sup> Exhibit AT6

<sup>42</sup> Exhibit AT2

153. Taking all of this into account, I do not consider that the opponent has demonstrated goodwill at the relevant dates and the opposition based upon section 5(4)(a) is dismissed.

### **Final Remarks**

154. Even if I am wrong in that finding, and the opponent did, in fact, have a reasonable degree of goodwill at both relevant dates and that the sign relied upon was distinctive of that goodwill in relation to sports clothing and footwear, I still do not consider that there would be any misrepresentation.

155. 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 consumer are confused”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here. Even when used in relation to goods within the same field of activity, the conceptual differences between the marks are, in my view, sufficient to avoid consumers purchasing the applicant’s goods in the mistaken belief that they are the goods of the opponent.

### **CONCLUSION**

156. The oppositions are unsuccessful and the applications may proceed to registration.

### **COSTS**

157. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,600** as a contribution towards the costs of the proceedings. This sum is calculated as follows:



Filing counterstatements and considering the Notices of opposition	£400
Filing evidence and considering the opponent's evidence	£800
Written submissions in lieu	£400
<b>Total</b>	<b>£1,600</b>

158. I therefore order Lotto Sport Italia S.p.A to pay Fruitcake Consulting Limited the sum of £1,600. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 7<sup>th</sup> day of December 2020**

**S WILSON**  
**For the Registrar**

## ANNEX

LOTTO

UKTM no. 1257200

(First Earlier Mark)

Relying on all goods, namely:

Class 25: Coats, jackets, shirts, sweaters, waistcoats, skirts, trousers, bathing suits, bath gowns, shawls, neckties, boots, shoes, slippers, hats, dressing gowns, scarves; foudards, belts; gloves, all being articles of clothing; articles of underclothing.

LOTTO LEGGENDA

EUTM no. 8243669

(Second Earlier Mark)

Relying on all goods and services, namely:

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides, trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; attaché cases; backpacks; bags (net-) for shopping; bags (nose-) [feed bags]; bags for sports; beach bags; briefcases; card cases [notecases]; chain mesh purses; covers (umbrella-); game bags (hunting accessories); handbags; haversacks; muzzles; net bags for shopping; nose bags [feed bags]; pocket wallets; purses; rucksacks; satchels (school-); school bags; school satchels; shopping bags; umbrella covers; vanity cases, not fitted; wallets (pocket-); wheeled shopping bags; bags (game-) [hunting accessories].

Class 25: Clothing, footwear, headgear; boot uppers; boots (heelpieces for-); boots (iron fittings for-); boots (non-slipping devices for-); boots (welts for-); cap peaks; dress shields; footwear (tips for-); footwear uppers; heelpieces for boots and shoes; heelpieces for stockings; heels; inner soles; linings (ready-made-) [parts of clothing]; non-slipping devices for boots and shoes; peaks (cap-); pockets for clothing; ready-made linings [parts of clothing]; shields (dress-); shirt fronts; shirt yokes; shoes

(heelpieces for-); shoes (iron fittings for-); shoes (non-slipping devices for-); shoes (welts for-); soles for footwear; stockings (heel pieces for-); tips for footwear; uppers (footwear-); visors [hatmaking]; welts for boots and shoes; yokes (shirt-); Fittings of metal for shoes and boots; Football boots (Studs For-).

Class 35: Sale by retail, wholesale, on-line, by mail order of clothing, sports clothing, footwear, sports footwear, headgear, belts; perfumery, cosmetics, soaps; watches; spectacles, sunglasses and eyeglasses, sports glasses, spectacle frames, spectacle cases; protective and safety clothing and footwear, protective helmets for sports; luggage, rucksacks, bags and holdalls for sports, bags for sporting articles; goods made from paper, stationery; gymnastic and sporting articles, footballs, shin pads, knee pads, gloves for sports.



EUTM no. 8699753  
(Third Earlier Mark)

Relying on some of the services for which the earlier mark is registered, namely:

Class 35: Sale by retail, wholesale, online and by mail order of clothing, sportswear, footwear, sports footwear, headgear and belts; perfumery, cosmetics, soaps; watches; spectacles, sunglasses and eyeglasses, sports glasses, spectacle frames, spectacle cases; protective and safety clothing and footwear, protective helmets for sports; luggage, rucksacks, bags and holdalls for sports, bags for sporting articles; goods made from paper, stationery; gymnastic and sporting articles, footballs, shin pads, knee pads, gloves for sports; household and kitchen utensils and containers; woven and textile products; household linen; bedlinen; blankets; table linens.



EUTM no. 8479644 directed at class 25

(Fourth Earlier Mark)

Relying on some of the goods and services for which the earlier mark is registered, namely:

**Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; attaché cases; backpacks; bags (net-) for shopping; bags (nose-) [feed bags]; bags for sports; beach bags; briefcases; card cases [notecases]; chain mesh purses; covers (umbrella-); game bags [hunting accessories]; handbags; haversacks; muzzles; net bags for shopping; nose bags [feed bags]; pocket wallets; purses; rucksacks; satchels (school-); school bags; school satchels; shopping bags; umbrella covers; vanity cases, not fitted; wallets (pocket-); wheeled shopping bags; bags (game-) [hunting accessories].<sup>43</sup>**

Class 25: Clothing, footwear, headgear; boot uppers; boots (heelpieces for-); boots (iron fittings for-); boots (non-slipping devices for-); boots (welts for-); cap peaks; dress shields; footwear (tips for-); footwear uppers; heelpieces for boots and shoes; heelpieces for stockings; heels; inner soles; linings (ready-made-) [parts of clothing]; non-slipping devices for boots and shoes; peaks (cap-); pockets for clothing; ready-made linings [parts of clothing]; shields (dress-); shirt fronts; shirt yokes; shoes (heelpieces for-); shoes (iron fittings for-); shoes (non-slipping devices for-); shoes (welts for-); soles for footwear; stockings (heel pieces for-); tips for footwear; uppers (footwear-); visors [hatmaking]; welts for boots and shoes; yokes (shirt-).

Class 35: Retailing, wholesaling, on-line selling, mail order selling of: goggles for sports, not of precious materials, protective goggles, clothing for protection against

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<sup>43</sup> The goods identified in bold are relied upon under section 5(3) of the Act only.

accidents, irradiation and fire, shoes for protection against accidents, irradiation and fire, gloves for protection against accidents, protective masks, protective helmets, protective helmets for sports, motorcyclists' helmets, life belts, life jackets, clothing, clothing for sports, footwear, sports shoes, headgear, belts, luggage, backpacks, bags.

**LOTTO**  
VECTOR

EUTM no. 13624762 directed at class 25  
(Fifth Earlier Mark)

Relying on all goods for which the earlier mark is registered, namely:

Class 25: Clothing; Waterproof outerclothing; Mackintoshes; Weatherproof jackets; Workwear; Boiler suits; Clothing of imitations of leather; Clothing of leather; Motorists' clothing; Cyclists' clothing; Clothing for gymnastics; Sportswear; Clothing for athletics; Gowns; Bath robes; Bath robes; Underwear, knitted and of textile; Underwear; Sweat-absorbent underwear; Slips [undergarments]; Brassieres; Culottes; Boxer shorts; Bathing drawers; Pants (Am.); Beachwear; Swimsuits; Boxer shorts; Smocks; Swimming caps; Shower caps; Tights; Garters; Stockings; Stockings (Sweat-absorbent -); Heelpieces for stockings; Slippers; Socks; Jodhpurs; Tights; Leggings [trousers]; Leggings; Shirts; Long-sleeved shirts; Short-sleeve shirts; Aerodynamic shirts; Formal shirts; Jackets (Stuff -) [clothing]; Bodices [lingerie]; Headgear; Headgear; Hoods [clothing]; Berets; Caps [headwear]; Belts [clothing]; Belts (Money -) [clothing]; Headbands [clothing]; Ear muffs (clothing); Headgear; Visors [headwear]; Bandanas [neckerchiefs]; hankerchiefs; Shawls; Sashes for wear; Suits; Ties; Sweat shirts; Sashes; Gabardines [clothing]; Topcoats; Outer clothing; Trouser straps; Jackets; Jackets [clothing]; Wind resistant jackets; Jackets, with or without sleeves; running jackets; biker jackets; Quilted jackets; Fishing vests; Blazers; Skirts; Sports skirts; Skorts; Aprons [clothing]; Pinafore dresses; Girdles; Gloves; Mittens; Bicycle gloves; Gloves for motorcyclists; Ski gloves; wintergloves; Snowboard gloves; Gloves including those made of skin, hide or fur; Ready-to-wear clothing; Jumpers; Tee-shirts;

Bermuda shorts; Singlets; Hosiery; Polo tops; Pullovers; Muffs [clothing]; Pelerines; Mantillas; Trousers shorts; Pants (Am.); Aerodynamic trousers; Sports trousers; Stretch pants; Ultra-breathable trousers for sport; Balaclavas; Pyjamas; Cuffs; Ponchos; Pullovers; Ski suits; Arm warmers; Body warmers; Knee warmers; Leg warmers; Ear muffs; Sandals; Bath sandals; Bath slippers; Slippers; Footwear; Sports shoes; Footwear; Gymnastic shoes; Working shoes; Beach shoes; Football boots; Sports shoes; Gaiters; Ankle boots; Work boots; Rain boots; Wooden shoes; Soles for footwear; Soles for footwear; Goloshes; Non-slipping devices for footwear; Studs for football boots; Fittings of metal for footwear; Tips for footwear; Heelpieces for footwear; Heelpieces for footwear; Footwear uppers; Footwear uppers; Combinations [clothing]; Wetsuits for water-skiing; Jumpsuits (clothing); Warm-up suits; Uniforms.