

O/0512/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NOS. UK00003216027 AND  
UK00003453332

IN THE NAME OF CIPHER INTERNATIONAL LIMITED

AND APPLICATIONS FOR A DECLARATION OF INVALIDITY THERETO UNDER  
NOS. 504304 AND 504305

BY DYNAMITE BAITS LIMITED

AND IN THE MATTER OF REGISTRATION NOS. UK00002216935 AND  
UK00908177164

IN THE NAME OF DYNAMITE BAITS LIMITED

AND APPLICATIONS FOR REVOCATION ON THE GROUNDS OF NON-USE  
UNDER NOS. 505094 AND 505095

BY CIPHER INTERNATIONAL LIMITED

## BACKGROUND AND PLEADINGS

1. On 1 March 2017, Cipher International Limited (“Cipher”) applied to register the following trade mark in the UK (no. 3216027) (“the 027 Mark”):



2. The 027 Mark was registered on 19 May 2017 and stands registered for the following goods:

Class 28 Sporting articles and equipment.

3. On 20 December 2019, Cipher applied to register the trade mark **FRENZEE** (no. 3453332) (“the 332 Mark”) in the UK. The 332 Mark was registered on 14 August 2020 and stands registered for the following goods:

Class 28 Fishing equipment; fishing tackle; hunting equipment.

4. On 2 November 2021, Dynamite Baits Limited (“Dynamite”) applied to invalidate the 027 Mark and the 332 Mark on the basis of sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). For both grounds, Dynamite relies upon the following trade marks:

FRENZIED HEMP SEED

UKTM no. 2216935

Filing date 10 December 1999; registration date 16 June 2000

Class 28 Fishing bait; fishing bait made of natural and/or artificial materials.  
 (“the 935 Mark”)

FRENZIED

UKTM no. 908177164<sup>1</sup>

Filing date 25 March 2009; registration date 21 October 2009

Class 28 Fishing bait; fishing bait made of natural and/or artificial materials; apparatus for use in fishing.

Class 31 Fishing bait; live fishing bait; foodstuffs and nutrients for fish.  
("the 164 Mark")

5. Under section 5(2)(b), Dynamite claims that the marks are similar and that the goods are identical or similar, resulting in a likelihood of confusion.

6. Under section 5(3), Dynamite claims that it has a reputation for all of the goods listed above and that use of the 027 and 332 Marks would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the 935 and 164 Marks.

7. Cipher filed counterstatements denying the claims made and putting Dynamite to proof of use.

8. On 8 July 2022, Cipher sought revocation of the 935 and 164 Marks on the grounds of non-use. Under section 46(1)(a) of the Act, Cipher claims non-use in the five year period following the date on which the marks were registered i.e.:

a) For the 935 Mark: 17 June 2000 to 16 June 2005, with an effective date of revocation of 17 June 2005.

b) For the 164 Mark: 22 October 2009 to 21 October 2014, with an effective date of revocation of 22 October 2014.

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<sup>1</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of Dynamite's EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK trade mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

9. Under section 46(1)(b), Cipher also claims non-use in the following five year periods:

a) For the 935 Mark: 17 June 2005 to 16 June 2010 (with an effective date of revocation of 17 June 2010), 17 June 2010 to 16 June 2015 (with an effective date of revocation of 17 June 2015), 17 June 2015 to 16 June 2020 (with an effective date of revocation of 17 June 2020) and 8 July 2017 to 7 July 2022 (with an effective date of revocation of 8 July 2022).

b) For the 164 Mark: 22 October 2014 to 21 October 2019 (with an effective date of revocation of 22 October 2019) and 8 July 2017 to 7 July 2022 (with an effective date of revocation of 8 July 2022).

10. Dynamite filed counterstatements defending its registrations in full.

11. Dynamite is represented by Barker Brettell LLP and Cipher is represented by Withers & Rogers LLP.

12. Only Dynamite filed evidence. Neither party requested a hearing, and only Dynamite filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

13. Dynamite filed evidence in chief in the form of:

a) The witness statement of Catherine Bond dated 6 May 2022. Ms Bond is the Director of Finance, IT, HR and Legal for Dynamite. Her evidence is accompanied by 8 exhibits (BB01 to BB08).

b) The witness statement of Duncan Lennox dated 21 November 2022. Mr Lennox is the Co Managing Director of Dynamite. His evidence is accompanied by 7 exhibits (DL01 to DL07).

14. Dynamite also filed written submissions in lieu dated 9 March 2023.

15. I have taken the evidence and submissions into account and will refer to them below where necessary.

## **RELEVANCE OF EU LAW**

16. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **DECISION**

17. As there are multiple relevant periods across both the revocations and the invalidations, I will summarise the key points of Dynamite’s evidence of use here and refer back to it where necessary. In particular, I note the following:

- a) Ms Bond gives evidence that Dynamite produces “boilies, ground bait, live bait, liquid attractants, pellets, bagged particle baits and various other types of fishing bait”.
- b) Mr Lennox gives evidence that the marks have been used since 2001.
- c) Dynamite has a market share of between 10-11% with “a sale value of £5million at trade and £9million at retail” in the UK. In the EU, Dynamite retails around €10million worth of goods, and therefore has a market share of around 3%.
- d) Dynamite sells goods under a number of different product brands, which include FRENZIED and FRENZIED HEMP SEED. Sales in relation to goods sold under the 935 and 164 Marks in the UK are as follows:

2016	£492,669
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2017	£575,681	
2018	£598,128	
2019	£620,357	
2020	£867,408	
2021	£818,711	
2022	£481,215	(up to July only)

e) Invoices addressed to UK customers (located in places such as London, Hull, Norfolk, Leeds, Nottingham and Lancashire) under the marks FRENZIED or FRENZIED HEMPSEED or FRENZIED FEEDER or FRENZIED PULSE or FRENZIED MONSTER show sales as follows:<sup>2</sup>

19 September 2016	£1,158.84 (£622.80)
28 September 2016	£4,278.60 (£1,195.20)
24 April 2017	£88.68 (£88.68)
31 August 2017	£440.52
15 December 2017	£1,5204.64
13 August 2018	£878.41
15 August 2018	£1,766.55
13 September 2018	£1,706.88
11 September 2018	£60.70
20 March 2019	£1,870.23
21 May 2019	£3,691.70 (£3,395.33)
21 May 2019	£53.15 (£41.66)
15 October 2019	£75.13 (£44.17)
15 October 2019	£4,751.87 (£3,984.02)
3 March 2020	£1,040.81 (£979.95)
24 November 2021	£295.93

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<sup>2</sup> Exhibits BB02(1), BB02(2), BB02(3), BB02(4), BB02(5) and BB02(6) and which appear to be duplicated at Exhibit DL01

I have included in brackets, where necessary, the amount of each invoice which relates to FRENZIED or FRENZIED HEMPSEED goods (rather than FRENZIED FEEDER, FRENZIED MONSTER or FRENZIED PULSE goods).

There is also an invoice addressed to a customer located in Romania which shows sales under the FRENZIED mark in the sum of £987.84 dated 21 April 2021.

- f) The applicant has provided advertising spend for the UK, for goods sold under the marks relied upon:

Year	Total Advertising Spend
2016	£4,000
2017	£12,800
2018	£14,150
2019	£13,600
2020	£14,670
2021	£18,000
2022 (up to July)	£11,972

- g) The following examples have been advertised in fishing magazines in 2018 and 2021:<sup>3</sup>



- h) Examples of Dynamite's advertising via social media have been provided.<sup>4</sup> A selection are set out below:

<sup>3</sup> Exhibit BB03

<sup>4</sup> Exhibits BB04(1) to BB04(3)



(20 September 2017)

Views: 13,721

Impressions: 80,000



(28 January 2020)

Views: 4,496

Impressions: 48,000



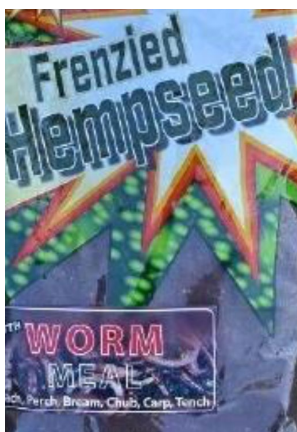
(19 December 2016)

Reach: 34,000



(10 March 2018)

Reach: 17,000



(11 September 2019)

Reach: 8,000



(29 January 2020)

Views: 4,401

Impressions: 51,000



- i) Examples of Dynamite’s catalogues (1,000 produced every year for distribution by retailers) have been provided for 2015 to 2020.<sup>5</sup> These included references to the FRENZIED and FRENZIED HEMPSEED marks and goods such as maize and mixed particle fish bait, hempseed fish bait, ground bait, snails, sweetcorn, meat and worms.
- j) Dynamite’s FRENZIED products have won awards from Total Carp Magazine (2017) and Angling Times (2020) for their fish bait.<sup>6</sup>
- k) The Angling Trades Association describes Dynamite as “possibly the UK and Europe’s best-known bait producer, with market leading brands including The Source Swim Stim, Frenzied particles, Complex-T and more”.<sup>7</sup> As far as I can tell, this document is undated.

18. I will return to the relevance of this evidence below.

19. As the revocations will have an impact upon the scope of the specifications that Dynamite is entitled to rely upon for the purposes of the invalidations, I will begin by assessing the revocation for non-use claims.

## **THE REVOCATIONS**

20. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the

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<sup>5</sup> Exhibit BB05

<sup>6</sup> Exhibit BB06

<sup>7</sup> Exhibit BB08

goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

21. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

22. As the 164 Mark is a comparable mark, Dynamite can rely upon use of the mark in the EU (which included the UK) for any and all parts of the relevant periods prior to IP Completion Day i.e. 31 December 2020. After that date, only use in the UK will be relevant.<sup>8</sup>

23. 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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm*

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<sup>8</sup> See paragraphs 7 and 8 of Part 1 and Schedule 2A of the Act.

*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].”

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 not, therefore, genuine use.

25. As noted above, the relevant periods for the 935 Mark are 17 June 2000 to 16 June 2005, 17 June 2005 to 16 June 2010, 17 June 2010 to 16 June 2015, 17 June 2015 to 16 June 2020 and 8 July 2017 to 7 July 2022. For the 164 Mark, the relevant periods are 22 October 2009 to 21 October 2014, 22 October 2014 to 21 October 2019 and 8 July 2017 to 7 July 2022. As section 46(3) provides that resumption or commencement of use at a later date can prevent marks from being revoked, I will begin by assessing the later relevant period for both marks first i.e. 8 July 2017 to 7 July 2022, returning to the earlier periods only if it is necessary to do so.

26. There are various examples in Dynamite’s evidence of the 935 and 164 Marks being used as registered. Where there are decorative or non-distinctive additions, I consider that this is acceptable use of the marks as registered and is use upon which Dynamite can rely (see, for example, the third image shown in paragraph **17(g)** above). Similarly, where the marks are used as part of a composite mark, this will also be use upon which Dynamite can rely (see, for example, the second image shown in paragraph **17(g)** above). However, where additional words are added which form a unit with a different meaning, this will not be use upon which Dynamite can rely. For example, use of the phrases FRENZIED FEEDER, FRENZIED MONSTER and FRENZIED PULSE are all examples of additions which change the meaning of FRENZIED (solus). For the avoidance of doubt, as the word HEMPSEED in the 164 Mark is non-distinctive, I consider that Dynamite can rely upon use of the word FRENZIED (solus) to demonstrate use of that mark (and vice versa for the 935 Mark).

27. There are clearly issues with Dynamite’s evidence. For example, market share figures have been provided, but these are not broken down for the individual brands relied upon in these proceedings. The examples of social media advertising provided is not limited to the UK market. However, the UK sales under the marks and the advertising expenditure is not insignificant. Further, invoices have been provided which show sales between 8 July 2017 to 7 July 2022 of over £16,000. There have clearly been commercial activities undertaken under the FRENZIED sign in order for awards to have been won in well-known angling publications. I recognise that some of

the sales shown may relate to those signs that I have found not to be acceptable variants of the marks relied upon. However, bearing in mind the extent to which the marks (or acceptable variants thereof) have been used in the evidence, I am satisfied that a reasonable proportion would relate to the relevant marks. Whilst the evidence filed is far from complete, when taken as a whole, I am satisfied that there has been commercial exploitation of the 935 and 164 Marks during the period 8 July 2017 to 7 July 2022 with a view to create or maintain a market for various types of fishing bait.

28. I must now consider whether, or the extent to which, the evidence shows use for the goods for which the 935 and 164 Marks are registered.

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

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

30. In *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."

31. The 935 Mark is registered for "fishing bait; fishing bait made of natural and/or artificial materials" in class 28 and the 164 Mark is registered for "fishing bait; fishing bait made of natural and/or artificial materials; apparatus for use in fishing" in class 28 and "fishing bait; live fishing bait; foodstuffs and nutrients for fish" in class 31.

32. It seems to me that the use shown relates to a broad range of fishing baits and, consequently, I consider that Dynamite should be entitled to retain the broader term



“fishing bait” in class 28 of both specifications. I have seen no obvious evidence of fishing baits made of artificial materials, and so I consider that only the term “fishing bait made of natural materials” should be retained in class 28 of both specifications. I have seen no evidence of use of “apparatus for use in fishing”, nor have I seen any evidence of use of live fishing bait. The majority of the evidence appears to relate to fishing bait, rather than fish food or nutrients for fish. Consequently, I consider a fair specification for the 935 Mark to be:

Class 28 Fishing bait; fishing bait made of natural materials.

I consider a fair specification for the 164 Mark to be:

Class 28 Fishing bait; fishing bait made of natural materials.

33. There is no evidence relating to the earlier relevant periods which would change my findings as set out above.

## **THE INVALIDATIONS**

34. Section 5(2)(b) and 5(3) have application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

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

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

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

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

35. 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.”

36. The 935 and 164 Marks qualify as earlier trade marks pursuant to section 6 of the Act. As the 935 and 164 Marks had completed their registration process more than 5 years before the application for the declarations of invalidity, they are subject to proof of use, as requested by Cipher.

### **Proof of use**

37. As explained in the legislation set out above, there are two relevant periods for proof of use. The first is the five year period ending with the date of the application for invalidity i.e. 3 November 2016 to 2 November 2021, and the second is the period of five years ending with the filing date of the applications i.e. 2 March 2012 to 1 March 2017 for the 027 Mark and 21 December 2014 to 20 December 2019 for the 332 Mark.

38. I have set out the case law relating to genuine use above and apply the same here.

39. Although there is no information relating to the beginning of the earlier relevant periods (i.e. the years 2012 to 2015), there are significant sales in relation to the years 2016 to 2022. The later relevant periods overlap significantly with the relevant period discussed above in the revocations. For the same reasons already set out, I am satisfied that there has been genuine use of the 935 and 164 Marks and that a fair specification would be as set out in paragraph **32** above.

### **Section 5(2)(b) – case law**

40. 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

41. The competing goods are as follows:

<b>Dynamite's goods (the invalidation applicant)</b>	<b>Cipher's goods (the proprietor)</b>
<b>The 935 Mark</b> <u>Class 28</u> Fishing bait; fishing bait made of natural materials.	<b>The 027 Mark</b> <u>Class 28</u> Sporting articles and equipment.
<b>The 164 Mark</b> <u>Class 28</u> Fishing bait; fishing bait made of natural materials.	<b>The 332 Mark</b> <u>Class 28</u> Fishing equipment; fishing tackle; hunting equipment.

42. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

44. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:



“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

45. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

46. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

### The 027 Mark

#### *Sporting articles and equipment.*

47. If bait can be considered fishing ‘articles’ or ‘equipment’ then these goods could be identical on the principle outlined in *Meric* to “fishing bait” in the specifications of the 935 and 164 Marks. However, if they are not identical, then this term in the applicant’s specification could clearly include other fishing goods (such as rods), which would be sold through the same retailers, to the same users. The nature and method of use may be different, but the purpose will overlap. There may be complementarity. Taking all of this into account, the goods will be similar to at least a medium degree.

### The 332 Mark

#### *Fishing equipment; fishing tackle*

48. If bait can be considered fishing ‘equipment’ or ‘tackle’ then these goods would be identical on the principle outlined in *Meric* to “fishing bait” in the specifications of the 935 and 164 Marks. However, even if they are not identical, they will clearly be sold through the same retailers, to the same users. The nature and method of use may be different, although the purpose will overlap. There may be complementarity. Taking all of this into account, the goods will be similar to at least a medium degree.

#### *Hunting equipment.*

49. Dynamite submits that these goods are identical to “fishing bait”. I disagree. In my view, the average consumer would not consider fishing bait to be a type of hunting equipment (taking the ordinary meaning of the term) and I have no evidence before me to suggest that they would. I accept that these goods may be sold through the same sporting/outdoor activity retailers as “fishing bait” in the specifications of the 935

and 164 Marks. They may also be sold to the same users. The nature, method of use and purpose of the goods will differ. There will be no competition or complementarity. Consequently, I consider any similarity to be at a low degree.

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

50. 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 (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

51. The average consumer will be a member of the general public with an interest in fishing/hunting or may include professional users. The goods are likely to vary in price, but for the most part will be relatively low in cost. However, various factors will be taken into account such as ingredients and effectiveness (for fishing bait) and functionality and ease of use (for other sporting/hunting equipment). Consequently, I agree with Dynamite's submission that a medium (or average) degree of attention is likely to be paid during the purchasing process.

52. The goods are likely to be purchased following perusal of signage on websites, at bricks-and-mortar premises, on packaging or on advertisements. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that aural components may play a part as advice may be sought from retail assistants.

## Comparison of trade marks

53. 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 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.”

54. 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.

55. The respective trade marks are shown below:

<p align="center"><b>Cipher’s marks (the proprietor)</b></p>	<p align="center"><b>Dynamite’s marks (the invalidation applicant)</b></p>
<div data-bbox="252 1675 742 1751" data-label="Image"> </div> <p align="center">(the 027 Mark)</p> <p align="center">FRENZEE (the 332 Mark)</p>	<p align="center">FRENZIED HEMP SEED (the 935 Mark)</p> <p align="center">FRENZIED (the 164 Mark)</p>

## Overall Impression

56. The 027 Mark consists of a highly stylised graphic device, mostly in white (with black outline), but with one section highlighted in orange. The overall impression lies in the mark as a whole.

57. The 332 Mark consists of the word FRENZEE. There are no other elements to contribute to the overall impression, which lies in the word itself.

58. The 935 Mark consists of the words FRENZIED HEMP SEED. The overall impression of the mark lies in the combination of these words, although the word FRENZIED is the more distinctive element due to the non-distinctive nature of HEMP SEED.

59. The 164 Mark consists of the word FRENZIED. There are no other elements to contribute to the overall impression which lies in the word itself.

## Visual Comparison

### *Cipher's marks and the 164 Mark*

60. Dynamite submits that the 027 Mark is the word FRENZEE with "minimal" stylisation. I disagree. The 027 Mark is highly stylised to the point that, in my view, it is difficult to identify any definite letters within it. I consider that the 164 Mark overlaps with 027 Mark to the extent that the middle section of the 027 Mark could be said to resemble the letters ENZ. Arguably, the beginning of the 027 Mark has some resemblance to the letter R. However, that is where the similarity ends. The 027 Mark does not, in my view, contain an identifiable word, and is highly stylised. In my view, these marks are visually similar to a low degree.

61. The 164 Mark and the 332 Mark overlap in the first five letter FRENZ-. The latter part of the marks differ: -EE in the 332 Mark and -IED in the 164 Mark. However, given

that both contain a letter E, there remains some visual similarity between these elements. In my view, the marks are visually similar to a high degree.

*Cipher's marks and the 935 Mark*

62. The same applies to the comparison with this mark with the additional difference created by the words HEMP SEED. In my view, there is a very low degree of visual similarity with the 027 Mark and between a medium and high degree of visual similarity with the 332 Mark.

Aural Comparison

*Cipher's marks and the 164 Mark*

63. The 027 Mark is, in my view, unlikely to be articulated at all due to its lack of clear letters. If that is correct, then the marks will be aurally dissimilar as the word in the 164 Mark will be given its ordinary English pronunciation. Even if I am wrong in this finding, at best, the 027 Mark could be pronounced ENZ or possibly RENZ. Consequently, any aural similarity will be low.

64. The 332 will, in my view, be pronounced in the same way as the ordinary dictionary word FRENZY (FREN-ZEE). This, clearly, overlaps aurally with the ordinary dictionary word FRENZIED (FREN-ZEED). In my view, the marks are aurally highly similar.

*Cipher's marks and the 935 Mark*

65. The same applies to the comparison with this mark with the additional difference created by the words HEMP SEED. In my view, there is either no similarity or very low aural similarity with the 027 Mark and between a medium and high degree of aural similarity with the 332 Mark.

Conceptual Comparison

*Cipher's marks and the 164 Mark*

66. The 164 Mark will be given its ordinary dictionary meaning i.e. wild, excited and uncontrolled.<sup>9</sup> The 332 Mark is likely to be attributed the same meaning as the ordinary dictionary word FRENZY (of which it will be seen as a misspelling) i.e. great excitement or wild behaviour often resulting from loss of control.<sup>10</sup> Clearly, there will be a high degree of conceptual similarity between the marks.

67. In my view, whether the 027 Mark is identified as the letters ENZ or RENZ, or whether it is not identified as containing any letters at all, no conceptual meaning will be conveyed by the mark. Consequently, it is dissimilar to the 164 Mark which does have a clear conceptual meaning.

#### *Cipher's marks and the 935 Mark*

68. The same applies to this mark with the additional difference of the conceptual message conveyed by the words HEMP SEED. However, as this meaning is likely to be non-distinctive, I consider it will make little (if any) difference to my findings above.

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

69. 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).

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<sup>9</sup> <https://www.collinsdictionary.com/dictionary/english/frenzied>

<sup>10</sup> <https://www.collinsdictionary.com/dictionary/english/bidding-frenzy>

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).”

70. 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.

71. I will begin by assessing the inherent position. I do not consider the 164 Mark to be descriptive for the goods relied upon. However, in my view, it is allusive, creating images of a ‘feeding frenzy’ i.e. referring to the success of the goods. Consequently, I consider it to be inherently distinctive to between a low and medium degree. Although the 935 Mark has the additional words HEMP SEED, I have already identified these to be non-distinctive and so I do not consider that they materially change the distinctiveness of the mark and I find the 935 Mark to also be inherently distinctive to between a low and medium degree.

72. I will now consider whether the distinctiveness of the earlier marks has been enhanced through use. The relevant market for assessing enhanced distinctiveness is the UK market. I have already set out Dynamite’s evidence of use above. Clearly, sales have not been insignificant, reasonable amounts have been spent on advertising, and there is a reasonably good geographical spread of use, according to the invoices filed. As noted above, presumably only a portion of the sales figures listed can be attributed to the marks relied upon because some of the evidence shows use



of marks that are not acceptable variants. Further, I have no market share information for the UK, so it is difficult to assess the extent of the business within the relevant market. I note that the opponent has been described as a 'market leader' but this document is undated and only one of the awards won could be prior to the application dates for the contested marks. Consequently, taking the evidence as a whole into account, I am not satisfied that the distinctiveness of the earlier marks has been enhanced through use.

### **Likelihood of confusion**

73. 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 them and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the 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.

74. I have found as follows:

- a) The goods vary from being identical to similar to a low degree.
- b) The average consumer will include members of the general public with an interest in fishing/hunting or professional users, who will pay a medium degree of attention during the purchasing process.

- c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.
- d) The 164 Mark and the 027 Mark are visually similar to a low degree, aurally similar to a low degree (at best) and conceptually dissimilar.
- e) The 164 Mark and the 332 Mark are visually, aurally and conceptually similar to a high degree.
- f) The 935 Mark the 027 Mark are visually similar to a very low degree, aurally similar to a very low degree (at best) and conceptually dissimilar.
- g) The 935 Mark and 332 Mark are visually and aurally similar to between a medium and high degree and conceptually similar to a high degree.
- h) The 164 and 935 Marks are inherently distinctive to between a low and medium degree.

75. Bearing in mind the differences between the 027 Mark and the earlier marks, I can see no reason why the average consumer would mistakenly recall or misremember this mark for either of the earlier marks. Consequently, I do not consider there to be a likelihood of direct confusion in respect of the 027 Mark. Further, having identified the differences between the marks, I can see no reason why the average consumer would conclude that the marks originate from the same or economically linked undertakings. Consequently, I find no likelihood of indirect confusion.

76. However, there are significant visual, aural and conceptual similarities between the 332 Mark and the earlier marks. In my view, it is likely that the average consumer will mistakenly recall or misremember these marks, notwithstanding the fact that the earlier marks have a relatively low level of distinctiveness, when used on goods that are similar to at least a low degree (bearing in mind the interdependency principle).

77. The application for invalidation against the 027 Mark based upon section 5(2)(b) is dismissed.

78. The application for invalidation against the 332 Mark based upon section 5(2)(b) succeeds in its entirety.

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

79. 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 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.”

80. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

81. As the 164 Mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

“10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(a) the United Kingdom include the European Union”.

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

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

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

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

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

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

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

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

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

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

83. I can deal with this ground relatively swiftly. I have discussed Dynamite's evidence of use above. For the same reasons already explained, I am not satisfied that it has demonstrated the requisite reputation.

84. The application for invalidation based upon section 5(3) is dismissed.

## **CONCLUSION**

85. The revocation against UKTM no. 2216935 is successful in relation to the following goods for which the registration is revoked:

Class 28 Fishing bait made of artificial materials.

86. The effective date of revocation is 17 June 2005.

87. The revocation against UKTM no. 2216935 is unsuccessful in relation to the following goods for which the registration can remain registered:

Class 28 Fishing bait; fishing bait made of natural materials.

88. The revocation against UKTM no. 908177164 is successful in relation to the following goods for which the registration is revoked:

Class 28 Fishing bait made of artificial materials; apparatus for use in fishing.

Class 31 Fishing bait; live fishing bait; foodstuffs and nutrients for fish.

89. The effective date of revocation is 22 October 2014.

90. The revocation against UKTM no. 908177164 is unsuccessful in relation to the following goods for which the registration may remain registered:

Class 28 Fishing bait; fishing bait made of natural materials.

91. The application for a declaration of invalidity against UKTM no. 3216027 is unsuccessful and the registration may remain registered in its entirety.

92. The application for a declaration of invalidity against UKTM no. 3453332 is successful in its entirety and, pursuant to section 47(6), the registration is deemed never to have been made.

### **COSTS**

93. The parties have enjoyed a roughly equal degree of success. Consequently, I make no order as to costs.

**Dated this 1<sup>st</sup> day of June 2023**

**S WILSON**

**For the Registrar**