

O-1017-24  
TRADE MARKS ACT 1994  
CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATION NO. 3634426  
BY TWINS SPECIAL LLC TO REGISTER

**KING PROFESSIONAL**

AS A TRADE MARK IN CLASSES 25 & 28  
AND OPPOSITION THERETO UNDER NO. 426560  
BY BOOSTER BUDO & FITNESS,  
BESLOTEN VENNOOTSCHAP MET BEPERKTE AANSPRAKELIJKHEID

AND IN THE MATTER OF TRADE MARK REGISTRATION NO. 801396439  
IN THE NAME OF BOOSTER BUDO & FITNESS,  
BESLOTEN VENNOOTSCHAP MET BEPERKTE AANSPRAKELIJKHEID  
FOR THE TRADE MARK



IN CLASSES 9, 18, 25 & 28  
AND THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO. 505447 BY TWINS SPECIAL LLC


## Background & Pleadings relating to Opposition No. 426560

1. Twins Special LLC (“Twins Special”) applied to register the trade mark **KING PROFESSIONAL** on 29 April 2021. It was published for opposition purposes on 2 July 2021 in class 25 and 28 for the following goods:

*25: Clothing, footwear, headwear; shirts; tank tops; pants; shorts; sweatshirts; hats; robes; footwear; jackets; belts for clothing; jerseys and warm up suits.*

*28: Games, toys and playthings; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees; boxing gloves, punching bags for boxing; punching bags; taekwondo mits; body protectors for sports use; abdomen protectors for athletic use; shin protectors [sports articles]; shin guards; shin pads; chest protectors for sports use; boxing rings; cages for mixed martial arts; martial arts training equipment; face protectors for athletic use; bags specially adapted for sports equipment; hand wraps for sports use; skipping ropes; supporters (Men’s athletic-) [sports articles]; martial arts training equipment; kick pads for martial arts; protective vest for martial arts; protective supports for shoulders and elbows [sports articles]; wrist guards for athletic use .*

2. Booster Budo & Fitness, besloten vennootschap met beperkte aansprakelijkheid (“Booster”) opposed the application<sup>1</sup> on 1 September 2021 under section 5(2)(b) of the Trade Marks Act 194 (“the Act”). It relies on the following comparable mark:<sup>2</sup>

UK TM No.801396439	Goods relied on:
	<i>9: Headguards and mouth guards.</i>  <i>18: Sports bags</i>

<sup>1</sup> Although the application was opposed in full at the Notice of Opposition stage, Booster subsequently withdrew its opposition in relation to the goods *Games, toys and playthings; video game apparatus; decorations for Christmas trees* in Twins Special’s class 28 specification.

<sup>2</sup> Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent’s mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.


Filing date: 15 January 2018	<i>25: Clothing for combat sports.</i>
Registration date: 7 September 2018	<i>28: Punching balls; gloves for boxers and fighters; shin guards for sports, ankle supports for sports: boxing rings; fighting cages [sports equipment]; gloves for boxing; elbow pads.</i>

3. Booster claims that Twins Special's application is similar to its own mark and goods and there exists a likelihood confusion including a likelihood of association under section 5(2)(b) of the Act.

4. Twins Special filed a counterstatement in which it denied that the respective marks and goods were similar and also denied there was a likelihood of confusion or association.

#### **Background & Pleadings relating to Cancellation No.505447**

5. Booster is the registered proprietor of the trade mark No.801396439 set out above. Twins Special seeks to invalidate this registration under sections 5(4)(a) and 3(6) of the Act. Under section 5(4)(a) Twins Special claim the following signs have been used throughout the UK since 11 July 2011:

<b>Sign</b>	<b>Goods</b>
KING PROFESSIONAL	gloves; training gear (protectors, headgear and pads), fightwear (fight robes and boxing shorts), shin guards, gear bags
	As above
KING	As above

6. Under section 3(6) Twins Special claim the registration was undertaken to prevent use of the above signs in the UK and was therefore made in bad faith.

7. Booster filed a counterstatement in which it denied that both grounds of invalidation and put Twins Special to strict proof of its claims.

### **Other preliminary matters**

8. Given the relationship between the opposition and the application for invalidity, these proceedings were consolidated on 9 January 2023 under Rule 62(1)(g) of the Trade Marks Rules 2008.

9. Both sides have been represented throughout these proceedings. Twins Special have been represented by Stobbs and Booster by Stevens, Hewlett & Perkins.

10. Both sides filed evidence and submissions. A hearing was requested, and the matter came to be heard by me via videoconference on 13 February 2024. Mr Julius Stobbs appeared for Twins Special and Ms Jennifer Dixon of Counsel, instructed by Stevens, Hewlett & Perkins, appeared for Booster.

11. I make this decision based on consideration of all the material before me and the submissions presented at the hearing.

12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts that predate the UK's withdrawal from the EU.

### **Approach**

13. Given that Twins Special seeks to invalidate the single earlier right relied on in the opposition, it is logical that I begin with the invalidation proceedings. Should Twins

Special be successful in invalidating Booster's earlier mark, it follows that the opposition will fall away.

## **Evidence**

14. The following evidence was filed in these proceedings.

- A witness statement dated 15 September 2022 by Leona Walker, a Chartered Trade Mark Attorney at Stevens, Hewlett & Perkins who are Booster's legal representatives. Ms Walker attached 2 exhibits. This evidence was filed in relation to the opposition action and comprises a dictionary definition of the word "king" and a screenshot setting out the differences between the professional and amateur codes of boxing.
- A witness statement dated 22 March 2023 by Christopher Mechling, a managing member of Twins Special. Mr Mechling attached 14 exhibits. This evidence was filed in relation to the invalidation action.
- A witness statement dated 10 July 2023 in the name of Yves Vyvey, a managing partner of Booster. Mr Vyvey attached 8 exhibits. This evidence was filed in relation to the invalidation action.

## **Mr Mechling's evidence**

15. Mr Mechling states a Thai company namely Twins Special Co., Ltd ("Twins Thailand") originated the "King" brand for boxing and martial arts related goods. On 22 June 2010, Twins Special was formed as a holding company between Twins Thailand and the Mechling brothers, Christopher and Nicholas. The company was set up at that date such that Twins Thailand held 50% of shares, Twins Thailand's managing partner held 10% and the Mechling brothers 40%. Twins Special was formed to "own, hold, license and enforce all trademark and other intellectual property".<sup>3</sup> On 5 February 2013, Twins Thailand transferred all shares, title, interest and intellectual property (save for those pertaining to Thai national trade mark rights) to Twins Special for the sum of \$500k.

16. Mr Mechling states that Twins Special had a prior business relationship with Booster and that on 6 July 2011, Booster assigned the following Benelux trade marks

---

<sup>3</sup> Exhibit CM13

to Twins Special, namely “Top King Boxing Equipment” and the following figurative mark:



Mr Mechling provided a copy of the assignment document<sup>4</sup>. Although the assignment document makes reference to assigning “the rights attached thereto and the goodwill associated therewith, including all rights related to the use, registration or application for this trademark”, Mr Mechling claims that unbeknownst to Twins Special, Booster did not record the assignment at the Benelux Office for Intellectual Property at that time and the above word and device mark remained on the Benelux register of trade marks in the name of Yves Vyvey (the managing partner of Booster) until 19 April 2022 when it was assigned at Twins Special’s request. Moreover Mr Mechling states that the Benelux registration (no.836322) was used as the basis for an International Registration (“IR”) No. 963953 which designated the EU and USA. The IR was registered in the name of Yves Vyvey.<sup>5</sup> Mr Mechling submits that Mr Vyvey deliberately withheld the existence of the IR from Twins Special. As a result Mr Mechling states that the consequence of this has been to deny Twins Special the benefits of the trade mark rights it believed it owned based on the 6 July 2011 assignment agreement. He also states that had the trade marks been assigned at the relevant IP offices at the time of the assignment agreement then Twins Special would have had a trade mark which predated the contested registration.

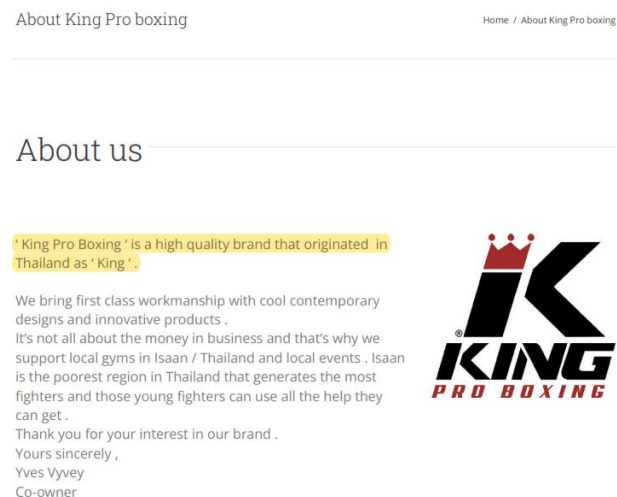
17. Mr Mechling states that Booster were formally a Twins Thailand distributor. Mr Mechling further states that Booster, being familiar with the Thai connection, has filed for various “K King” marks since 2011 including the registration at issue in these proceedings. Moreover Mr Mechling states that Booster has sought to deliberate conflate its own K KING marks with Twins Special’s KING PROFESSIONAL mark with a view to causing customer confusion and diverting custom away from Twins Special.

---

<sup>4</sup> Exhibit CM1

<sup>5</sup> The IR was applied for on 7 April 2008 but was not renewed upon its expiry on 7 April 2018.

To this end Mr Mechling submits exhibits CM12 which comprises screenshots from the websites of Booster, and third party distributors of Booster. An illustration of the Booster screenshot is given below.



18. Turning to the evidence of use in the UK, Mr Mechling states that goods from the KING branded range could be purchased in the UK from the following Twins Special websites, namely [twinsfightgear.com](http://twinsfightgear.com), [twinsfight.com](http://twinsfight.com), [twinsmuaythai.com](http://twinsmuaythai.com) and [twinsgloves.com](http://twinsgloves.com). Mr Mechling states that that there was significant UK web traffic to all the Twins Special websites comprising 56k visitors between 2013 and 2018.<sup>6</sup>

19. In terms of sales Mr Mechling exhibits four invoices to UK customers for King branded goods dated 2013 and 2014.<sup>7</sup> The invoices were presented in dollars for the following amounts:

- \$126.08 for a customer in Preston
- \$151.64 for a customer in Exeter
- \$148.96 for a customer in Nuneaton
- \$211.68 for a customer in Kidderminster

---

<sup>6</sup> Exhibit CM10

<sup>7</sup> Exhibit CM9

20. In terms of advertising expenditure, Mr Mechling states that Twins Special “engages in online advertising”<sup>8</sup> and exhibits a table of Google derived advertising statistics for England, Scotland, Wales, Northern Ireland and the Isle of Man and which shows a total of \$842.90 spent on advertising in the five years between January 2013 and January 2018.<sup>9</sup>

### **Mr Vyvey’s evidence**

21. Mr Vyvey states that the current UK proceedings are one of a number of proceedings currently going on in various jurisdictions between Twins Special, Twins Thailand and Booster.

22. In terms of context, he states that Twins Thailand began trading in boxing gloves, boxing gear and martial arts equipment in the 1980s. He further states that Booster became the main European distributor for Twins Thailand in 1994 for these goods under the signs KING and KING PROFESSIONAL and under the sign K KING in the UK since 2016.<sup>10</sup> Three documents entitled “Contract on Appointment of Sales Representative for Goods” dated 7 November 2007, 10 April 2009 and 28 December 2015 are exhibited at YV 1.1. In the document dated 2007 at clause 4, no geographical area is mentioned save for the USA and Mexico but then only if Booster seeks permission before selling in that area. In the 2009 document at clause 4, Booster’s distribution area comprises Belgium, Netherlands, Benelux, Germany (except Khun Phon’s Muay Thai Shop), France, Czech Republic, Italy, Austria, Sweden, Hungary, Turkey, Denmark, Switzerland, Poland, Lithuania, Norway, Surinam, Andorra, Slovenia, Slovakia, Estonia, Bulgaria, Romania, Croatia, Monaco, Malta, Cyprus, Latvia, Macedonia, Serbia [sic], Liechtenstein and San Marino. In the 2015 document, the distribution area includes the above countries and is increased to include Albania, Armenia, Azerbaijan, Belarus, Bosnia and Herzegovina, Georgia, Iceland, Kazakhstan, Kosovo, Montenegro, Portugal and Spain.

---

<sup>8</sup> Christopher Mechling witness statement paragraph 17

<sup>9</sup> Exhibit CM11

<sup>10</sup> Witness statement of Yves Vyvey, paragraph 6



23. Mr Vyvey further states that in 2007 he applied for the following trade mark at the Benelux office in his own name:



He states this was done at the request of Twins Thailand in order to “safeguard the trade mark rights of Twins Thailand”.<sup>11</sup> This Benelux registration (no.836322) was registered on 6 March 2008 in class 28 and was used subsequently as the basis for an International Registration (“IR”) No. 963953 which designed the EU and USA.<sup>12</sup>

24. With regard to Booster’s relationship with Twins Special, Mr Vyvey states that in 2011 he was asked to assign the Benelux mark to Twins Special. Mr Vyvey states he did so believing that as 50% of Twins Special was owned by Twins Thailand, he was assigning the mark to who he believed were the rightful owners. Moreover Mr Vyvey states that Booster carried out all necessary obligations under the assignment agreement<sup>13</sup> but that did not include recording the assignment at the Benelux office as he believed it was for the Assignee to request this action. To confirm his statement, Mr Vyvey includes the following extract from the deed of assignment in his witness statement:

“At the request and at the expense of the Assignees, the assignor will do all reasonable acts, execute all documents and procure the making of any declarations or oaths necessary or required by law for further affecting the Assignment of the Trademarks to the assignees and assisting the assignees in recording the assignment of the Trademarks”.


25. Mr Vyvey states that Twins Special did not ask him to record the assignment at the Benelux office until 2022 when he complied with the request.

---

<sup>11</sup> Witness statement of Yves Vyvey, paragraph 7

<sup>12</sup> Exhibit YV2

<sup>13</sup> Exhibit YV5

26. Mr Vyvey goes on to state that Booster and Twins Thailand signed an agreement<sup>14</sup> in January 2016 in which Twins Thailand returned the rights in the KING brands to Booster. Mr Vyvey states it was his belief at that time that Twins Thailand were still the majority shareholder in Twins Special and he had no reason to assume they did not have the authority to return the brands to Booster. Mr Vyvey also states that he developed his own K KING trade mark in 2016 with the knowledge and agreement of Twins Thailand.<sup>15</sup> This mark evolved and in 2018 became the contested mark in these proceedings namely .

27. That concludes my summary of the evidence.

## **DECISION RELATING TO CANCELLATION 505447**

### **The statutory provisions of section 5(4)(a)**

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

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

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

(aa) [...]

(b) [...]

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

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

---

<sup>14</sup> Exhibit YV6

<sup>15</sup> Exhibit YV7

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

30. Section 5A of the Act is as follows:

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

31. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,<sup>16</sup> Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

---

<sup>16</sup> [1990] RPC 341, HL, page 406.

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

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

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

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

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

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

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a

fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

### **Relevant date**

33. In terms of the relevant date for assessment of section 5(4)(a), in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,<sup>17</sup> Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:<sup>18</sup>

‘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.’”

34. The filing date for the contested registration is 15 January 2018. Therefore all factors will be assessed as at this date.

### **Goodwill**

35. The first hurdle for Twins Special is to show that it had the required goodwill at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*<sup>19</sup> viz,

“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 custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

---

<sup>17</sup> BL O-410-11

<sup>18</sup> BL O-212-06

<sup>19</sup> [1901] AC 217 (HOL)

36. In *Smart Planet Technologies, Inc. v Rajinda Sharm*<sup>20</sup> Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

*“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”*

37. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

“The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi’s witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of “reCUP” ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca’s Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the

---

<sup>20</sup> BL O/304/20

size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

38. The relevant market for assessing goodwill is the UK. In its notice of invalidation,<sup>21</sup> Twins Special claimed it had sold KING branded products in the UK since 2011. At

---

<sup>21</sup> TM26I – statement of grounds paragraph 16

the relevant date Twins Special had two retail websites namely twinsfightgear.com and twinsfight.com. Furthermore at the relevant date Twins Special evidenced four invoices, three dating from 2013 and one from 2014, to UK customers for KING branded goods purchased from the twinsfightgear.com website.<sup>22</sup> These invoices were presented in US dollars totalling \$368.36 and relate to boxing gloves and hand wraps, which I understand are fabric strips for use in supporting and protecting a boxer's hands and knuckles. No explanation was given as to why the invoices were presented in dollars. In his witness statement Mr Mechling states that goods available at the twinsgloves.com website are priced in pounds sterling<sup>23</sup> but unfortunately the screenshot is illegible when trying to view the prices even when the screenshot is increased in scale. Moreover the twinsgloves.com website was only registered in 2021 so was not active at the relevant date.<sup>24</sup> Even so no evidence of any UK sales from that website has been provided. In fact no other turnover figures of any description were presented by Twins Special in evidence. Mr Mechling has stated that potential customers can sign up and create a new account and provided an undated screenshot<sup>25</sup> to that effect but has not given any indication of the number of UK customers who have undertaken such an action.

39. Mr Mechling provided web traffic figures which show 56k UK based visitors clicked into the Twins Special websites between 2013 and 2018, and that the average visit lasted around 2.25 minutes. He states that website visitors had "good exposure" to the Twins Special branded goods and the KING branded goods, but provided no evidence to show what web pages those visitors actually looked at or indeed whether any of them looked at the KING branded goods. Moreover no information was provided as to whether any of the visits resulted in a sale of the relevant goods. The evidence also shows that during the same five year period 2013-2018, a sum of \$842.90 was spent on Google advertising but no other advertising expenditure was set out and no other examples of non-Google advertising were demonstrated.

---

<sup>22</sup> Exhibit CM9

<sup>23</sup> Christopher Mechling witness statement paragraph 13

<sup>24</sup> Christopher Mechling witness statement paragraph 11 and exhibit CM5

<sup>25</sup> Exhibit CM8



40. Taking all of this evidence into account I do not find that Twins Special has been able to provide sufficient evidence to establish a protectable goodwill. The four invoices that were provided dated from 2013 and 2014, so some four years before the relevant date. No evidence was provided to show any sales from other years. This factor coupled with the small turnover and the low volume of goods sold, and using the guidance given in *Smart Planet* regarding low levels of trade and turnover as well as the size of the boxing/MMA equipment market in comparison to the likely impact of Twins Special's own trade in that market, I find that the evidence provided is insufficient to demonstrate that Twins Special had anything more than a trivial goodwill in the UK at the relevant date.

41. I find that Twins Special has not been able to establish goodwill and therefore has failed at the first hurdle. The case has not been made out under section 5(4)(a).

### **The statutory provisions of section 3(6)**

42. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

43. Section 47 of the Act states:

“47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(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.

[...]

(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.”.

44. An objection to a trade mark on the grounds of bad faith is provided for at s. 3(6) of the Act, which reads:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

45. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. So far as relevant to the present case, it summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].

The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely

the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: Lindt at [45]; Koton Mağazacılık at [45].

The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: Hasbro at [41].

The date for assessment of bad faith is the time of filing the application: Lindt at [35].

It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: Pelikan at [21] and [40].

Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: Hasbro at [42].

Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: Lindt at [37].

For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: Lindt at [41] – [42].

Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: Lindt at [49].

Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: Koton Mağazacılık at [46].

It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: Lindt at [51] to [52]."

46. According to Alexander Trade Mark, BL O/036/18, the key questions for determination in a claim of bad faith are:

- (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
- (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
- (c) Was it established that the contested application was filed in pursuit of that objective?

47. It is necessary to ascertain what Booster knew at the relevant date: Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

48. It is also clear from the case law that the mere fact that an applicant or proprietor of a trade mark knew that another party used the trade mark in the UK does not establish bad faith: Lindt, Koton Mağazacılık. The applicant/proprietor may have reasonably believed that it was entitled to apply to register the mark, such as where

there had been honest concurrent use of the marks: Hotel Cipriani. However, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat Trade Mark* [2003] RPC 11, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited v DDTM Operations LLC* [2019] EWHC 769 (Ch).

49. An accusation that a party has acted in bad faith is serious. It is necessary for a party alleging bad faith to prove, on the balance of probabilities, that the proprietor acted in bad faith. The relevant date for the assessment of the Booster's conduct is the date on which the contested registration was filed, namely 15 January 2018. It is true that evidence from after that date may be relevant if it casts light on the proprietor's state of mind at the relevant date. However, it must be stressed that it is the proprietor's state of mind at the relevant date which matters. Evidence which shows poor conduct on the part of the proprietor after the relevant date will only assist if it reveals that its intentions at the time when it filed the mark were incompatible with accepted standards of ethical behaviour or honest commercial and business practices. In short, even if the proprietor's behaviour after the filing date is open to criticism, that is not of itself determinative of bad faith.

50. From the evidence provided, there is clearly a complex relationship between Booster and Twins Special. This is compounded by the interaction of both parties with Twins Thailand. Both sides provided a chronology of events in their skeleton arguments. Both sides agree that Twins Thailand originated the KING brand in the 1980s and that Booster had a distribution arrangement with Twins Thailand from the 1990s although none of the distribution agreements provided in evidence specify the UK among the named territories. With regard to the events which took place in 2007, it is not made clear from Mr Vyvey's evidence why Twins Thailand needed Booster in the person of Yves Vyvey to "to safeguard the trade marks rights of Twins Thailand" by applying for the contested registration in his own name at that time but Mr Vyvey states he did so at the request of Twins Thailand. No explanation is given as to why Twins Thailand could not have registered the mark themselves at the Benelux office.

51. Booster was aware that Twins Special was set up in June 2010 and furthermore was aware of the shareholding split between Twins Thailand and the Mechling brothers. At the time of the assignment agreement dated 7 July 2011 between Booster as the assignor and Twins Special as the assignee, Mr Vyvey states he was asked, but does not say by who, to assign the two Benelux trade marks, namely TOP KING



BOXING EQUIPMENT (No.863842) and (no.836322), back to who he believed were the “rightful owners”, namely Twins Thailand, as they were the majority shareholders. The IR, which was based on the Benelux registration no.836322, was not listed on the schedule A annexed to the 2011 assignment agreement.<sup>26</sup> Mr Vyvey makes no mention why the IR was not listed. Twins Special avers that,

“such an omission was a calculated decision by the Proprietor to prevent the invalidation applicant from shoring up its registered intellectual property portfolio [...] in the UK/EU – allowing the proprietor to develop a monopoly right in K KING in the process”.

52. A facsimile copy of the assignment agreement is in evidence at Exhibit YV5. In addition to the agreement and schedule A, there is also a form MM5(E) which is a request for the recording of a change in ownership for an IR, in this case IR no. 963953. It has been completed with the details of Twins Special as the new owner and signed by Yves Vyvey as the then holder. This indicates to me that Mr Vyvey had completed his part of this assignment form. There is no further information on what happen to the MM5(E) and why it was not filed with WIPO to record the assignment. I accept it is a confused picture that the IR was not listed on the assignment schedule but yet its details are within the same faxed document. However this confusion is not a sufficient basis for me to conclude that Booster acted in bad faith.



53. Booster stated that it was not aware of the 2013 agreement between Twins Thailand and Twins Special and went on to sign a further distribution agreement with Twins Thailand in 2016 on the understanding that Twins Thailand still had the legal

---

<sup>26</sup> Exhibit YV5

standing to be a party to that agreement. That agreement stated that “Twins Special gives rights back of the King brands to Booster BVBA”.<sup>27</sup> On the face of the evidence before me, there is nothing to suggest that Booster acted inappropriately based on the information it had at that time. Twins Special’s submission is that,

“whilst it may have been Booster’s belief that a presumed connection between the parties [Twins Special and Twins Thailand] would override the fact that they were separate legal entities, the position must be judged not by what Booster thought it know but what it should have understood based on objective standards of reasonableness”.<sup>28</sup>

This appears to be speculation about what Booster should have known, not what it did know. Twins Special appears to be saying that Booster showed a lack of curiosity or did not undertake due diligence with a company it had already been dealing with for some years but I do not find that this amounts to a dishonest intention on Booster’s part. Moreover in November 2016 Twins Thailand signed an agreement that Booster could have ownership of a new trade mark namely  which Mr Vyvey claims to have developed independently. This mark eventually evolved to become the contested registration . It strikes me that the behaviour of Twins Thailand in these matters did not raise concerns, which may have strengthened Booster’s belief that there was nothing untoward about their actions. On the basis that Mr Vyvey believed that Twins Thailand had the correct standing to enter into agreements with him and they had knowledge of the first K KING mark and had not objected then it appears that Booster believed it had received a ‘green light’ to proceed. I do not find that Booster had acted in bad faith.

54. The claim under section 3(6) fails.

### **Conclusion on the cancellation action**

55. As the cancellation action under no. 505447 has failed, I shall move on to consider the opposition action under no. 426560.

---

<sup>27</sup> Exhibit YV6

<sup>28</sup> Twins Special skeleton argument, paragraph 30

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

56. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

57. The following principles are gleaned from the judgments 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 C3/03, *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.

The principles:

(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 the 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 the goods and services**

58. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*<sup>29</sup>, the court stated at paragraph 23 of its judgment 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”.

59. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>30</sup>, for assessing similarity were:

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

---

<sup>29</sup> Case C-39/97

<sup>30</sup> [1996] R.P.C. 281

60. I also find the following case law to be useful in these proceedings where in *Gérard Meric v Office for Harmonisation in the Internal Market*<sup>31</sup>, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

61. The goods to be compared are:

<b>Booster's goods</b>	<b>Twins Special's contested goods</b>
<i>9: Headguards and mouth guards.</i>	
<i>18: Sports bags</i>	
<i>25: Clothing for combat sports.</i>	<i>25: Clothing, footwear, headwear; shirts; tank tops; pants; shorts; sweatshirts; hats; robes; footwear; jackets; belts for clothing; jerseys and warm up suits.</i>
<i>28: Punching balls; gloves for boxers and fighters; shin guards for sports, ankle supports for sports: boxing rings; fighting cages [sports equipment]; gloves for boxing; elbow pads.</i>	<i>28: gymnastic and sporting articles; boxing gloves, punching bags for boxing; punching bags; taekwondo mitts; body protectors for sports use; abdomen protectors for athletic use; shin protectors [sports articles]; shin guards; shin pads; chest protectors for sports use; boxing rings; cages for mixed martial arts; martial arts training equipment; face protectors for athletic</i>

<sup>31</sup> Case T- 133/05

	<p><i>use; bags specially adapted for sports equipment; hand wraps for sports use; skipping ropes; supporters (Men's athletic-) [sports articles]; martial arts training equipment; kick pads for martial arts; protective vest for martial arts; protective supports for shoulders and elbows [sports articles]; wrist guards for athletic use .</i></p>
--	---

### Class 25

62. In my view Twins Special's goods in this class namely *Clothing, footwear, headwear; shirts; tank tops; pants; shorts; sweatshirts; hats; robes; footwear; jackets; belts for clothing; jerseys and warm up suits* are not limited so could be used in combat sports. Therefore these goods can all be considered as highly similar to Booster's goods namely *Clothing for combat sports*. They are similar in nature and purpose and will overlap in users and in trade channels. I also feel there is a degree of complementarity and competition between the respective goods.

### Class 28

63. I find the following goods in Booster's specification, namely *gloves for boxers and fighters; shin guards for sports, boxing rings; fighting cages [sports equipment]; gloves for boxing; elbow pads* are identical or virtually identical to the terms *boxing gloves; shin protectors [sports articles]; shin guards; shin pads; boxing rings; cages for mixed martial arts; protective supports for elbows [sports articles]* in Twins Special's specification.

63. I find that the Twins Special's terms *taekwondo mitts* are identical on the Meric principle to Booster's *gloves for fighters*. In my view a mitt is a type of glove, and the term fighter is broad enough to encompass taekwando practitioners.

64. The Twins Special's term *hand wraps for sports use* relates to a length of material which is wrapped around a person's knuckles, hands and wrist to prevent injury, in

particular for contact sports such as boxing and MMA. As such I find this term to be complementary to Booster's goods namely *gloves for boxers and fighters* to a medium degree as both goods are likely to overlap in terms of users and can be used in conjunction with one another and likely to be sold in close proximity.

65. I find that the Twins Special's terms *body protectors for sports use; abdomen protectors for athletic use; chest protectors for sports use; face protectors for athletic use; supporters (Men's athletic-) [sports articles]; protective vest for martial arts; protective supports for shoulders and elbows [sports articles]; wrist guards for athletic use* to be similar to a medium degree to Booster's *Headguards and mouth guards* in class 9 and *ankle supports for sports* in class 28. All the respective goods can be described as protective equipment for the prevention of injury to the body during sports. Whilst the individual nature of each item may be different in terms of shape or material, the overall purpose is the same. The goods will have an overlap of users and trade channels. All goods are likely to be found in the same area of a physical or online store.

66. I find that the Twins Special terms *punching bags for boxing; punching bags; kick pads for martial arts* to be similar to a medium degree to Booster's goods namely *Punching balls*. All goods are for the purpose of absorbing blows from the fighter even if the nature of balls and bags in terms of shapes and hanging arrangements are different. There will be crossover of users and trading channels. All goods are likely to be found in the same area of a physical or online store. There may also be an element of competition between the goods.

67. I find that Twins Special's term *bags specially adapted for sports equipment* can be considered as similar to a high degree to Booster's *Sports bags* in class 18. The respective goods are both specified as being for use with sports and are similar in nature and purpose. The users will also overlap as will the trade channels. There is also likely to be a degree of competition between the goods.

68. With regard to the remaining goods in Twins Special's class 28 specification namely *gymnastic and sporting articles; skipping ropes; martial arts training equipment*, I find these goods can all be used in sports including in combat sports. The

goods will have an overlap of users and trade channels. They can also be considered as complementary to Booster's goods. As such I find the goods to be similar to a medium degree

### **Average consumer and the purchasing process**

69. I next consider who the average consumer is for the goods at issue and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.<sup>32</sup> For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.<sup>33</sup>

70. The average consumer for the contested goods are members of the general public and businesses such as gyms especially those concerned with the practice of combat sports. The costs of the contested goods will vary as some goods may be more expensive than others. In terms of the frequency of purchase, then in my view protective equipment may be purchased less frequently than goods such as clothing. I find the average consumer is likely to pay a high degree of attention during the purchasing process for the protective equipment goods, especially given that they are purchased to avoid personal injury so there will be greater consideration of their suitability for purpose. The average consumer is likely to pay a lesser degree of attention, i.e. to a medium degree for clothing goods.

71. The goods are likely to be selected from retail outlets, websites and catalogues. Consequently, there will be a visual consideration in the purchasing process. However, I cannot discount an aural component to the purchase as information and advice on suitable gear may be sought prior to purchase.

---

<sup>32</sup> *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)

<sup>33</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97.


## Mark comparisons

72. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>34</sup>, 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.”

73. 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.

74. The respective trade marks to be compared are:

Booster's registration	Twins Special's application
	KING PROFESSIONAL

75. Booster's mark is a composite arrangement which consists of a letter K rendered in black which has a red crown device at the top of its upstroke. The letter K is positioned above the stylised word KING, which is also rendered in black. Given the

---

<sup>34</sup> Case C-591/12P

scale of the letter K and device being approximately twice the size of the word KING, I find it makes an equal contribution with the word element to the overall impression.

76. Twins Special's mark consists of the words KING PROFESSIONAL rendered in plain block capitals. There is no other aspect to the mark. In relation to combat sports the word PROFESSIONAL is descriptive of a particular specification of goods, such as gloves or boxing rings, which are used in professional fights as opposed to amateur fights. Taking this into account, I find the word KING to be the dominant and distinctive element of the mark.

77. In a visual comparison of the respective marks, both share the word KING. The points of difference are the additional word PROFESSIONAL in the Twins Special's mark and the letter K with crown device in Booster's mark. Taking all this in account I find there is a medium degree of visual similarity.

78. In an aural comparison of the respective marks, as previously stated they share the word KING which will be given its usual pronunciation. It is unlikely that a consumer would verbalise the letter K element of Booster's mark, but in my view the word PROFESSIONAL would likely be verbalised in the Twins Special mark. Overall I find there is high degree of aural similarity.

79. In a conceptual comparison, consumers would understand the shared word KING as meaning a monarch, as per the opponent's evidence.<sup>35</sup> The crown device in Booster's mark may reinforce that concept. They would also see and understand the letter K as a letter of the alphabet. With regard to Twins Special's mark, consumers are likely to regard the word PROFESSIONAL as being goods which are of a professional standard or that can be used according to the rules and regulations underpinning a professional fight as opposed to an amateur fight as set out in the opponent's evidence.<sup>36</sup> Taking all this into account I find the respective word marks are conceptually similar to a high degree by virtue of the shared KING element.

---

<sup>35</sup> Exhibit LM2

<sup>36</sup> Exhibit LM3



### **Distinctive character of the earlier registered trade mark**

80. 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.

81. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,<sup>37</sup> 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).”

82. As no evidence of use was filed in these opposition proceedings, I am only considering the inherent position. Booster’s registration has several elements. The word KING is a known English dictionary word but has no meaning in relation to the

---

<sup>37</sup> Case C-342/97

goods for which it is registered but it is not especially distinctive. The addition of the letter K and crown device add something more to the mark. Overall I find the earlier registered mark is distinctive to a medium degree.

### **Likelihood of confusion**

83. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.<sup>38</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

84. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

85. In *L.A. Sugar Limited*<sup>39</sup>, Mr Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

---

<sup>38</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

<sup>39</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

86. In addition I find the following case law to provide helpful guidance where in *Kurt Geiger v A-List Corporate Limited*<sup>40</sup>, Mr Iain Purvis Q.C (as he then was), sitting as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

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

88. However I also bear in mind that there must be a “proper basis” for finding indirect confusion where there is no direct confusion.<sup>41</sup>

89. So far in this decision I have found that,

- The goods were identical and similar to varying degrees

---

<sup>40</sup> BL O-075-13

<sup>41</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

- The purchasing process is predominantly visual with consumers paying a high degree of attention for goods which prevent personal injury and a medium degree of attention for clothing goods.
- The marks are visually to a medium degree, but aurally and conceptually similar to a high degree.
- The earlier registration overall is inherently distinctive to a medium degree.

90. All marks clearly share KING in their respective constructions. However, I find this similarity is outweighed by the differences, namely the additional elements of the letter K and crown device and the word PROFESSIONAL. These additional elements are sufficient in my view for the average consumer not to directly confuse the marks, that is to mistake one mark for the other even where the goods are identical or similar. Therefore I find there is no likelihood of direct confusion.

91. I will move on to consider whether there is any indirect confusion. I remind myself of the guidance given in *L.A.Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to a shared undertaking, taking one mark to be a possible brand extension or sub brand of the other mark.

92. I find that the average consumer on seeing the respective marks may note the additional elements but given the descriptive nature of the word PROFESSIONAL will likely assume that this could be a brand extension, i.e. that it is a product from the KING stable of goods which are either of a professional standard or suitable for use in professional combat sports competitions. As such they are likely to be confused in to believing that it comes from the same economic undertaking. Therefore, I find there is a likelihood of indirect confusion.

### **Conclusion on the opposition action**

93. The opposition under section 5(2)(b) is successful. Subject to any appeal of this decision the application will be refused for all goods in class 25 and for the following goods in class 28 namely: *gymnastic and sporting articles; boxing gloves, punching bags for boxing; punching bags; taekwondo mitts; body protectors for sports use; abdomen protectors for athletic use; shin protectors [sports articles]; shin guards; shin pads; chest protectors for sports use; boxing rings; cages for mixed martial arts;*

*martial arts training equipment; face protectors for athletic use; bags specially adapted for sports equipment; hand wraps for sports use; skipping ropes; supporters (Men's athletic-) [sports articles]; martial arts training equipment; kick pads for martial arts; protective vest for martial arts; protective supports for shoulders and elbows [sports articles]; wrist guards for athletic use .*

94. The application can proceed to registration for the following goods namely: *Games, toys and playthings; video game apparatus; decorations for Christmas trees;*

### **Costs**

95. Booster has been successful in both the invalidity and the opposition proceedings and is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the TPN, I award costs as follows:

£100	Official fee
£500	Preparing statement and counterstatement
£900	Preparing evidence and considering the other side's evidence
£900	Preparing for hearing
<b>£2400</b>	<b>Total</b>

95. I order Twins Special LLC to pay Booster Budo & Fitness, besloten vennootschap met beperkte aansprakelijkheid the sum of £2400. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24<sup>th</sup> day of October 2024**

**June Ralph**

**For the Registrar**

**The Comptroller-General**



