

O-110-08

TRADE MARK ACT 1994

**IN THE MATTER OF APPLICATION NO 2405125
BY KOSCH TOOLS COMPANY LIMITED TO REGISTER
A TRADE MARK IN CLASSES 8 & 11**

AND

**IN THE MATTER OF OPPOSITION NO 94297 BY
ROBERT BOSCH GMBH**

TRADE MARKS ACT 1994

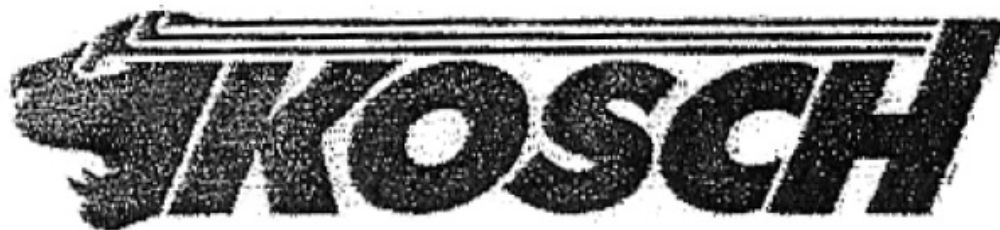
**IN THE MATTER OF Application No 2405125
By Kosch Tools Company Limited to register a
Trade Mark in Classes 8 & 11**

And

**IN THE MATTER OF Opposition No 94297 by
Robert Bosch GmbH**

BACKGROUND

1. On 29 October 2005 Kosch Tools Company Limited (previously Ormerod International Limited) applied to register the following mark:



for the following specification of goods

Class 08:

Hand tools and implements (hand operated); cutlery; side arms; razors; tool bags [filled].

Class 11:

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

2. On 19 April 2006 Robert Bosch GmbH filed notice of opposition to this application citing grounds under Section 5(2)(b) and 5(3) of the Act. In each case the opponent relies on six earlier trade marks. Three are UK domestic registrations, one is a Community Trade Mark and the remaining two are marks protected in the UK under the Madrid Protocol. Full details of these registrations and protected marks are contained in Annex A (for convenience I will simply refer to them hereafter as registrations). The registrations for the most part cover a large number of Classes of goods and (in some cases) services. The opponent has made statements of use in accordance with the requirements of The Trade Marks (Proof of Use etc.) Regulations 2004 and indicated in each case that the mark had been used during the last five years on or in relation to all of the goods for which it is registered. That statement appears in common form on each relevant page of the Form TM7 and may be said to leave

some room for doubt as to whether the opponent's use claim was intended to extend to services where the registrations cover services. It is more likely that the omission of a reference to services was simply a clerical error stemming from the fact that four of the six earlier trade marks only cover goods. In other words the use claim was intended to be all-encompassing. I should also record that No 784893 did not require a statement of use as it had not been a protected mark for the requisite period at the date of publication of the application in suit. I do not regard either of these points as having a critical bearing on the outcome of the case.

3. The opponent's position differs according to the specification of the registration relied on. I have set out the scope of the objection in each case in Annex B. The opponent's case under Section 5(3) required it to indicate the reputation claimed. Again the claim is set out for each registration in Annex B along with the goods objected to under that head. In overall terms, the opposition is directed against all goods save for 'tool bags (filled)' in Class 8.

4. The applicant filed a counterstatement denying the above-mentioned grounds of objection. It also indicated that it did not accept the opponent's statement of use claims. It further indicated that it required the opponent to provide proof of use in relation to a range of goods which corresponds to those contained in its own application.

5. Both sides filed evidence. Neither side has requested a hearing. Written submissions have been received from Dummett Copp on behalf of the applicant (under cover of their letter of 25 March 2008).

Evidence

6. Dr Bertram Huber, Senior Vice President of Robert Bosch GmbH and Dr Jörg Preiss, Director Corporate Intellectual Property - Trade Marks and Trade Names of the same company have filed a joint witness statement. In doing so they confirm that they have full access to the company's records.

7. The opponent is a leading global supplier of automotive and industrial technology and of consumer goods and building technology. The Bosch Group comprises some 280 subsidiary companies and has been trading since 1886 with worldwide sales in 2005 of 41.5 billion euros. The number of employees around the globe in the three business sectors Automotive Technology, Industrial Technology, and Consumer Goods and Building Technology in 2005 is said to be approximately 251,000.

8. The opponent has used the trade mark BOSCH in the UK since at least 1960. Reference is made to its ownership of an international trade mark. The number is not given but the full specification is set out from which it would seem to be No 675705.

9. In terms of the specifics of the company's trade in the UK Drs Huber and Preiss say:

“4. The Opponent has an established reputation in the Mark through extensive use of the Mark in the United Kingdom dating back to 1898 when

the first foreign distributor came to Great Britain. The Mark to me clearly identifies goods and services provided by the Opponent.

5. The number of Bosch associates in the UK reached 4920 (from 4670). Bosch is represented on the UK market with manufacturing and sales of automotive technology, industry technology, heating technology, household appliances and power tools.

6. The Bosch Group sell an extensive range of goods and services under the Mark in the UK, including: built-in kitchen appliances, evidence of which is proved by EXHIBIT JP1 which includes the Bosch Built-in Appliances catalogues from 2005/2006 and 2006/2007; home laundry, dishwashers and refrigeration appliances, evidence of which is provided by EXHIBIT JP2 which includes the Bosch Home Laundry, Dishwashers and Refrigeration catalogues from 2005/2006 and 2006/2007; and garden tools, evidence of which is provided by EXHIBIT JP3 which includes the copies of the Bosch Garden Tools catalogue from 2005 and 2006, and a printout of the Bosch Promoline Program for 2006/2007 with regard to hand tools.

7. EXHIBIT JP4 is the Bosch Annual Report for 2005, of which page 59 shows that in 2005 the sales of the Bosch Group in the UK rose by 4.7 percent to £1.380 billion (2 billion euros). Figures for 2006 are not yet available.

8. With regard to hand tools specifically, EXHIBIT JP5 is a table showing the sales figure of all products containing hand tools in the UK. In 2005 the total sales were 216,295 euros, and in 2006 this increased to 472,569 euros.

9. The Opponent's products make extensive use of the Mark which is evidenced by a selection of flattened packaging for hand tools in EXHIBIT JP6."

10. Most of the remainder of the witness statement is in essence submission. I bear Drs Huber's and Preiss' comments in mind and will return below to a number of the points they make. There is one further piece of documentary evidence, this being a Google search print-out based on the keywords "Kosch hand tools" (Exhibit JP7). The search engine has a feature which attempts to aid users by offering suggestions of corrections for typographical mistakes. In this case the search engine returned the question "Did you mean: *bosch* hand tools".

11. The applicant has also filed evidence in the form of a very brief witness statement by Barry Toms, a Director of Ormerod International Limited. He records the fact that in excess of £1 million of Kosch products (hand tools, tool bags and tool pouches) have been sold through the DIY store Homebase in the UK over the past two years without any reported instance of confusion. A sample of current packaging is exhibited.

DECISION

Proof of use

12. The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The relevant provisions read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

13. Five of the six registrations relied on by the opponent had been on the register for more than five years at the date of publication of the applied for mark (20 January 2006), the exception being No 784893. The opponent was, therefore, required to make a statement of use. As noted above the opponent made all encompassing claims. The generality of those claims was met with a request for proof of use in relation to a list of goods expressed in terms that replicate the goods of the applied for mark.

14. It is neither appropriate nor helpful for a proof of use request to be framed in this way rather than by reference to the goods and/or services in respect of which the opponent itself is claiming use though I accept that the all-encompassing nature of the opponent’s own claim may have contributed to the applicant’s response. I have considered even at this late stage whether to invite clarification. However, the terms in which the applicant framed its request was not challenged by the opponent with the result that the parties have proceeded through the evidence rounds on the basis of the above stated position. In the circumstances, and to avoid further delay, I have decided to resolve matters to the best of my ability on the basis of the material before me.

15. I will start from the point of view of the opponent’s evidence of use. It will be apparent from the passage from the joint witness statement quoted above that no sales or promotional expenditure figures are given for individual products or product areas save for the hand tools dealt with in paragraph 8. Rather, the opponent relies on catalogues dealing with product areas. The matter is further complicated by the fact that the catalogues span time frames. The use position falls to be assessed as at the publication date of the application, 20 January 2006.

16. Taking exhibit JP1 as a starting point I note that the back cover of the 2005/6 brochure refers to it being “printed on environmentally friendly chlorine-free bleached paper : 4/2005” which I take to be a reference to April 2005. The 2006/7 brochure contains a similar statement with the date 4/2006. This latter document, therefore, appears to be after the relevant date for the proof of use assessment. The 2005/6 brochure is relevant to my consideration and shows use on and in relation to:

Ovens, compact ovens, microwaves, warming drawers, coffee machines, hobs and hoods.

Refrigerators and freezers

Dishwashers

Washing machines, washer dryers and tumble dryers.

After sales repair and maintenance services.

17. Leaving aside the services and dishwashers and washing machines (these goods are proper to Class 7) these items are within Class 11 of the international classification system and fall within the following goods contained in the specification of e.g. No. 67744 – “.....cooking, grilling, warming and cooling apparatus; cooling devices/refrigerators, coffee machines; roasters; baking ovens tumble driers [sic dryers]”. In terms of the proof of use claim as framed by the applicant the goods would be within the categories apparatus for cooking, refrigerating and drying.

18. Exhibit JP2 also covers a similar range of goods principally washing machines, dryers, and refrigeration apparatus.

19. Exhibit JP3 contains three brochures. The first is a Bosch garden tools brochure headed ‘Range 2005’. It shows lawn mowers, lawn rakers, grass trimmers, grass shears, hedge cutters, shredders, a garden trolley, chainsaws and high pressure washers. With the exception of the garden trolley (Class 12) all are shown to be in the nature of machines and would be appropriate to Class 7. As a result they would be within the scope of e.g. the opponent’s registration No 2111926 but are not relevant to (or subject to) the proof of use claim that is directed at Class 8 and 11 goods.

20. The second item in this Exhibit is the 2006 range. It is thus almost certainly after the relevant date and does not in any case reveal a different range of goods.

21. The final item in JP3 is a Bosch Promoline brochure said to relate to hand tools. It appears to be an advanced stage proof copy (see inside back page). Under the heading ‘Validity’ on page 2 the text reads “At the time of printing (Oct 2006)” and goes on to refer to the document being valid until August 2007. It does not, therefore, contribute to establishing use of relevant goods as at 20 January 2006.

22. Exhibit JP4 is only relied on to give an overall indication of Bosch sales in the UK and is not product specific for current purposes.

23. Exhibit JP5 is a table showing “sales of figures of all products containing hand tools in the UK”. It highlights sales amounting to 216,295 euros in 2005. Unfortunately, the document is in German and no translation has been provided. I am not in a position to even speculate on the nature of the goods and am not entirely clear on what is meant by ‘products containing hand tools’.

24. Exhibit JP6 consists of photographs of packaging and actual packaging for what are said to be hand tools. In fact the exhibits shows kits containing drill bits, socket sets, electric screwdrivers, measures and a spirit level. The individual items would or could fall into a number of Classes. Thus, the electric screwdriver would be Class 7,

the drill bits etc would also fall into that Class if intended for use with the electric screwdriver (the most likely scenario). The measure and a spirit level would fall in Class 9. I should record that drill bits could fall in Class 8 if for use with hand-operated tools or capable of being so used. I am unable to say whether the depicted goods could be so used. The opponent would in any case face the further problem that such items are parts for drills. They do not, in my view, fall within the only Class 8 specification available to the opponent, this being “hand-held garden tools and implements; parts and fittings”(No 2111926).

25. To summarise the position reached to this point, the opponent has shown use in relation to the goods identified in paragraph 16 above that in turn fall within the goods areas challenged by the applicant. In relation to these goods I need to arrive at a fair specification.

26. The correct approach to reducing a specification has been considered in a number of cases that have been before the High Court and Court of Appeal. Richard Arnold QC, sitting as the Appointed Person, considered the accumulated authorities in *Nirvana Trade Marks*, BL O/262/06. I adopt the following propositions that he derived from his consideration of the case law:

- (1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].
- (2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].
- (3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].
- (4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].
- (5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].
- (6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

- (7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; ANIMAL at [20].
- (8) The exercise of framing a fair specification is a value judgment: ANIMAL at [20].

27. It is clear from the brochure at JP1 that the ovens and related goods, which occupy almost 80 pages of the brochure perform a sophisticated range of functions described as grilling, cooking, warming etc. The other goods identified above are self-explanatory. Based on the principles set out in *Nirvana I* I consider that a fair specification having regard to the opponent’s Class 11 specification is:

“Cooking, grilling, warming and cooling apparatus; cooling devices/refrigerators, deep freezers, coffee machines; roasters; baking ovens; tumble dryers; parts and accessories for the above mentioned goods included in this Class.”

28. It follows that I am unable to take into account other goods in Classes 11 or Class 8 (as a whole) where the opponent has failed to meet the applicant’s challenge. On the other hand the applicant has not asked the opponent to prove use outside the scope of its own goods in Classes 8 and 11. It follows that the opponent is entitled to rely on the broad specifications in other Classes.

Section 5(2)(b)

The law and leading authorities

29. The relevant part of the statute reads

“(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.”

30. The leading authorities and principles to be applied can be derived from the following cases - *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C.117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C Sas.*(OHIM) C-334/05.

The average consumer

31. The perception which the relevant public has of the signs and the goods and services in question is a key consideration (*Sabel v Puma*, paragraph 23). Where, as here, an opponent is relying on a wide range of goods and services the relevant public is unlikely to be a single homogenous grouping. In terms of the goods which are the subject of the opponent's evidence (household electrical items and garden equipment) the average consumer is likely to be the public at large. In general terms, the goods in question will be single occasional purchases (a refrigerator or a cooker say). They are also in the main moderately expensive items that will command a reasonable degree of attention in the purchasing process because the act of purchasing will involve balancing a range of considerations including aesthetic and functional matters as well as price, ease of servicing, availability of spares etc. That points to a reasonably high degree of care on the part of the consumer and carries over into parts and fittings which are bought with technical compatibility issues in mind.

32. There are other goods and services listed in the opponent's specifications that are more likely to be purchased and used in a manufacturing environment or otherwise purchased by commercial users (the goods in Classes 7 and 9 of No 675705 for instance). It follows that the consumers of such goods will be more knowledgeable and discriminating in making their choices.

Comparison of goods and services

33. The leading authorities on how to go about determining similarity between goods and services are accepted to be the *Canon* case (supra) and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case 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.

34. The applied for goods in Class 8 are “Hand tools and implements (hand operated); cutlery, side arms; razors; tool bags (filled).” The last of these terms does not appear to have been made the subject of opposition. The opponent’s registration No 2111926 covers a wide range of essentially powered tools for use in agriculture, horticulture and gardening (these goods are in Class 7 and the opponent has not been asked to prove use). In some cases these items would be the powered equivalent of the hand tools and implements that are the subject of the first part of the applicant’s specification (this is unrestricted as to the intended area of utilisation). Thus, to take a couple of examples, shears will in be Class 7 if electric and Class 8 if hand operated and likewise insecticide sprayers will be in Class 7 if in the nature of machines or hand held electric items and Class 8 if purely hand-operated. In each case there are close similarities in purpose, users, channels of trade and the fact that they represent alternative purchases for the consumer. I, therefore, regard these goods as being closely similar.

35. The remaining items in the applicant’s Class 8 specification that are objected to are “cutlery; side arms; razors”. I am unable to identify any goods in the opponent’s specification which would be similar to these specific items.

36. Turning to the applicant’s Class 11 goods, apparatus for cooking, refrigerating and drying correspond directly to the goods on which I have accepted that the opponent has used its mark. To that extent identical goods are involved.

37. The opponent has not proved use in relation to apparatus for lighting, heating, steam generating, ventilating, water supply and sanitary purposes. The fact that the opponent has not proved use on identical goods does not resolve the question of whether it has other goods and services that are similar. I have not had the benefit of written submissions on the nature and extent of any clash that the opponent perceives to exist between these goods in the applied for specification and other goods and services in its own specifications. Taking the goods in order, the position seems to me to be as set out in the following paragraphs.

38. Apparatus for lighting has no obvious counterpart goods or services in any of the opponent’s specification once the failure to show use in relation to lighting products is taken into account.

39. Apparatus for heating is not without ambiguity but in my view, taking the natural meaning of the words, it is not terminology that would be used for cooking appliances even though heat is used in the cooking process. I note that Exhibit JP1 shows cooking appliances called ‘warming drawers’ (pages 40 and 41 of the 2005/6 brochure) but the word heating is not used as a term of art in this way. The more natural meaning of heating apparatus is in relation to, for instance, a system for supplying heat to a building. The opponent’s Class 37 specification (of No. 675705 for instance) does, however, cover installation, maintenance and repair of parts and accessories for, *inter alia*, heating systems (and proof of use has not been requested). The services are complementary to the goods and must be considered similar.

40. Apparatus for steam generating is a term of somewhat uncertain meaning and scope. Some cooking processes use steam (steamers) but would not be referred to as

steam generating apparatus. Their purpose is simply to cook using steam. On the other hand I note that the opponent's registrations Nos 675705 and 67744 contain generators in Class 7 (again not subject to a request for proof of use). The latter are generally taken to be power generation products. Steam generating apparatus may also be used to produce power. I do not rule out some points of similarity with generators. The actual extent of any similarity (beyond a low level) is a matter of conjecture in the absence of further information or evidence bearing on the application of the *Canon/Treat* criteria.

41. Apparatus for ventilating would have a measure of complementarity with 'installation, maintenance and repair ofair conditioning systems' in Class 37 of the opponent's registrations Nos 675705 and 67744 (again proof of use issues do not arise in relation to these services). They would be similar to a moderate degree.

42. Apparatus for water supply and sanitary purposes also finds a counterpart service in Class 37 of the same two registrations as well as computer devices for controlling water supplies in No 2111926. The similarity in these cases would also appear to be at a low to moderate level.

Comparison of marks

43. The principles to be applied in comparing marks are well established in the case law cited above. The perspective is that of the average consumer who is deemed to be reasonably well informed, circumspect and observant. Marks are to be compared as wholes.

44. Visual, aural and conceptual similarities must be assessed by reference to those overall impressions but bearing in mind distinctive and dominant components. The opponent's earlier trade marks are word only marks or stylised versions of the word. The typeface used in the latter cases is not particularly striking or unusual. The degree of stylisation is therefore so slight that in reality I propose to treat the variant forms as akin to word only marks. BOSCH is, therefore, the single distinctive and dominant component of the earlier trade mark.

45. The applied for mark is a composite one consisting of the device of a lions head and the word KOSCH with lines extending from the top of the lions head to the second ascender of the letter H. Device and word, therefore, form a single integrated whole. Nevertheless, the word element is visually dominant despite the positioning of the device element at the front of the mark. The device is, therefore, subordinate within the context of the mark as a whole but is not without independent distinctive character in the terms of *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*. In *Shaker di L. Laudato* it was held that it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element. The device is not so negligible here.

46. Drs Huber and Preiss submit (paragraph 10 et seq in their evidence) that the respective marks are visually almost identical; that when capitalised the K is visually very similar to a B; that the remaining letters are a distinctive and unusual combination; that the marks are, aurally, confusingly similar; that pronunciation of consonants is affected by the vowel that follows; and that regional accents would blur

any distinction. The applicant, for its part, points to the differences arising from the lion's head device and different initial letters.

47. It has long been held that the beginnings of marks are of particular importance from the consumer perspective. It is not a proposition of law merely a reflection on how the human eye and brain approaches words (see the approach of the CFI in *El Corte Inglés SA v OHIM*, Case T-183/02 (paragraph 81) and *Hoya Kabushiki Kaisha v OHIM*, Case T-9/05 (paragraph 41)).

48. The importance and effect of different first letters is likely to be heightened in short, single syllable words. In this respect I do not share the opponent's view that K is visually very similar to B. On the contrary the average consumer exercising reasonable care would readily distinguish between them. Self-evidently the marks share the same succeeding letter combination –OSCH. That clear point of similarity must be weighed in the balance. However, reverting to a whole mark comparison I find that the presence of the device element and different first letter in the applied for mark outweighs the effect of the shared letters. The marks have low visual similarity. That view is not displaced by a suggestion in the opponent's evidence that the marks would be confused if seen from a distance in a shop display. That understates the degree of care that is to be assumed from the average consumer.

49. In oral use it is unlikely that consumers will refer to the device element, the more likely position being that they will refer to the applicant's mark by reference to the word KOSCH. I am not persuaded by the opponent's claims that the marks (word elements) are aurally similar. They are single syllable words with a shared vowel and closing consonant sound but with distinctly different first letters. Nor does it seem likely that regional accents will blur or erode the distinction to the point that the marks can be considered to have more than a very low degree of oral/aural similarity.

50. I am not aware that KOSCH has a clear conceptual meaning. The applicant's written submissions suggest that it is similar to the English word cosh meaning a weapon of assault. The spelling mitigates against that approach in my view. Given the disparities in spelling, I see no reason why consumers would seek out the nearest equivalent word they recognise.

51. It is possible that BOSCH would be recognised by some as a surname (as to which see below). I am less confident that I can take that as being a prevailing view particularly for potential customers who are not already familiar with the opponent company. In those circumstances both marks may be considered to be invented words. The position on conceptual similarity is neutral.

Distinctive character of the earlier trade mark(s)

52. The distinctive character of the earlier trade mark(s) is a factor to be taken into account. It is well established that there is a greater likelihood of confusion where the earlier mark has a highly distinctive character either because of its inherent qualities or because of the use that has been made of it (*Sabel v Puma*, paragraph 24).

53. Bosch is the surname of the founder who has given his name to the company. That much may be apparent to customers familiar with the company and its goods – a

point that is somewhat reinforced by the picture of a bust of the founder and a quotation from him in, for example, the inside covers of the brochures at JP1. For those not already familiar with the company, BOSCH may or may not be taken as a surname. Either way, I have no reason to suppose that it does not enjoy a reasonable level of distinctiveness.

54. The opponent's evidence refers to the claimed reputation of the brand. Sales in the UK of £1.3 billion is testament to the scale of the opponent's activities in this country. The supporting exhibits show an extensive range of white goods and garden tools (mainly powered). Disaggregated figures for particular goods or general types of goods have not been supplied. It is doubtful whether the mere provision of brochures and catalogues combined with high-level turnover figures can support a claim to enhanced distinctiveness in relation to particular goods. I think it is possible that the opponent can lay claim to such a reputation in relation to the range of kitchen appliances illustrated in exhibits JP1 and 2 but I cannot, with confidence, say whether my own knowledge is typical of the consumer base as a whole. I am even less certain of the extent of the reputation in relation to the powered garden tools shown in Exhibit JP3. The only product area where a specific sales figure has been provided is hand tools - 216,295 euros in 2005. This does not strike me as a particularly significant sum. On the basis of the limited information available the case for enhanced distinctiveness has not been made out.

Likelihood of confusion

55. According to settled case law, the risk that the public might believe that the goods in question came from the same undertaking or from economically linked undertakings, constitutes a likelihood of confusion. The likelihood of confusion must be assessed globally, according to the perception that the relevant public has of the signs and goods at issue, taking into account all factors relevant to the circumstances of the case, in particular the interdependence between similarity of the signs and similarity of the goods or services designated.

56. The opponent's strongest case rests on those goods that I have found to be identical, namely apparatus for cooking, refrigerating and drying. In coming to a view on whether use of the applied for mark in relation to such goods would result in a likelihood of confusion I bear in mind that these goods are generally purchased at irregular intervals. The risk of defective recollection is a factor to be borne in mind. Against that, they usually involve not insignificant expenditure and consequently will be purchased with some care and attention. I accept that the position may be slightly more favourable to the opponent if lower value items are involved but it is not a crucial difference in my view. The differences in the marks outweigh the similarities to the extent that the overall level of similarity is low. In the circumstances I do not consider there is a likelihood of confusion. Furthermore, I can see no basis for a finding of indirect confusion. The BOSCH mark is used in a consistent form. There is nothing to suggest that KOSCH would be seen as a related sub-brand, the mark of an associated company or some form of brand extension. If any association is made because of the similar sound of the endings of the words it is not such as to give rise to a likelihood of confusion as opposed to inconsequential association. That would also be the position if, contrary to what I consider the position to be on the evidence,

the opponent's mark was deemed to enjoy an enhanced distinctive character in relation to certain goods (such as cookers, refrigerators, dryers).

57. The opponent has exhibited (JP7) the results of a Google search where a search for KOSCH hand tools returned the message "Did you mean : bosch hand tools". That is far from evidence of confusion. Firstly the word used for the search was KOSCH and not the composite mark applied for. Secondly, the search did actually throw up 'hits' for KOSCH. Thirdly, the fact that a search engine may be programmed to offer correction for a range of typographical mistakes is not evidence of confusion between the searched term and the 'alternatives'. Fourthly, the search included 'hand tools' in the search parameter. The sponsored links list on the right hand side of the Google printout shows a link with sites selling Bosch tools (along with other sites selling Stanley, Draper and Teng tools). It seems, therefore, that the search process and resulting links were triggered in part at least by the presence of the reference to hand tools in the search parameters.

58. In short the opposition fails under Section 5(2)(b) based on identical goods. It follows that the opponent cannot be better placed where the competing goods or services are only similar.

Section 5(3)

59. As amended this reads:

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

60. The opponent's statement of grounds says this in relation to Section 5(3):

“The trademark BOSCH is so well-known in relation to the goods in respect of which it has a reputation that use of the opposed mark even for dissimilar goods would be likely to remind consumers of the opponent's trademark and could well prompt an association in the consumers mind with the opponent's trademark to the extent that the applicant would gain unfair commercial advantage from such association if the reputation of the opponent's mark and the association therewith on the part of the consumer causes the consumer to think more positively about the applicant's goods because such goods remind the consumer of the opponent's trademark and its reputation. In the alternative the reputation of the opponent's trademark may be damaged if the consumer subsequently forms a poor opinion of the applicant's products and this would be unjust as the opponent has no control over the quality of the applicant's goods.”

61. I have set out in Annex B those goods on which the opponent claims a reputation. The opponent's case as expressed in the above passage focuses on both unfair advantage and detriment. As the detriment is said to be in relation to the reputation of the BOSCH mark, the claim is based on tarnishing rather than blurring. Reputation is an underpinning requirement whether the claim is unfair advantage or detriment based.

62. The test for reputation is that set out in *General Motors Corporation v Yplon SA (Chevy)* [1999] E.T.M.R. 950 and in particular the following passage.

“23. In so far as Article 5(2) of the Directive, unlike Article 5(1), protects trade marks registered for non-similar products or services, its first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product of [or] service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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

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

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

63. The overriding requirement is that the tribunal take into consideration all the relevant facts of the case. Paragraph 27 indicates what some of those relevant facts and indications might be. Paragraph 25 indicates that the fact finder must not be too prescriptive and insist on knowledge amongst a given percentage of the relevant public.

64. In considering acquired distinctiveness for Section 5(2) purposes I gave an indication of the difficulties inherent in moving from the generality of the opponent's claim (which points to a very substantial business in the UK) to the specifics of trading in particular goods or areas of goods. Although the applicant has not challenged the claims made in Drs Huber's and Preiss' witness statement, that evidence does not enable me to focus on the nature, duration and extent of trade in

particular areas of goods or the effect of that trade in terms of satisfying the reputation test for Section 5(3) purposes.

65. The result is that whilst I personally consider that the opponent has a reputation in, for instance, the kitchen appliance market, I am uncertain whether the relevant public would share my own view and the evidence does not enable me to gauge the public's perception. In those circumstances it would not be appropriate to take my subjective view as an indication of, and confirmation of, the opponent's reputation as a matter of common knowledge.

66. Particular care is, in any case, needed where, as here, a party is claiming to be represented in a very wide range of goods areas (see paragraph 5 of the opponent's evidence) and also claims a reputation across a significant number of goods items (see Annex B). Reputation is unlikely to be spread uniformly across all those areas of goods. Without the benefit of a clear starting point in terms of reputation there is no firm foundation on which I can assess the opponent's claim as regards association leading to one or more of the heads of damage envisaged by the section. The Section 5(3) objection also fails.

COSTS

67. The applicant has been successful and is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of **£1000**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of April 2008

**M Reynolds
For the Registrar
The Comptroller-General**

