

O-313-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos. 2462601A and B
BY KLEENEZE LTD TO REGISTER TWO SERIES OF TWO TRADE MARKS**



IN CLASSES 3, 5, 8, 9, 11, 16, 18, 21, 26, 28, 35, 38, and 41

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER Nos 96879 and 96881
BY ROY THOMAS**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application Nos. 2462601A and 2462601B
By Kleeneze Ltd to register two series of two marks**

A handwritten word 'eeze' in blue ink, with a thick, slightly irregular stroke for the 'z'.A handwritten word 'eeze' in black ink, with a thick, slightly irregular stroke for the 'z'.A handwritten word 'eze' in blue ink, with a thick, slightly irregular stroke for the 'z'.A handwritten word 'eze' in black ink, with a thick, slightly irregular stroke for the 'z'.

In classes 3, 5, 8, 9, 11, 16, 18, 21, 26, 28, 35, 38, and 41

And

**IN THE MATTER OF Consolidated Oppositions thereto under Nos. 96879
and 96881 by Roy Thomas**

BACKGROUND

1) On 27th July 2007 Kleeneze Ltd of Burley House, Bradford Road, Burley-in-Wharfdale, West Yorkshire, LS29 7BZ (hereafter "Kleeneze") applied to register the following trade mark:

A handwritten word 'eeze' in blue ink, with a thick, slightly irregular stroke for the 'z'.A handwritten word 'eeze' in black ink, with a thick, slightly irregular stroke for the 'z'.A handwritten word 'eze' in blue ink, with a thick, slightly irregular stroke for the 'z'.A handwritten word 'eze' in black ink, with a thick, slightly irregular stroke for the 'z'.

2) The application was subsequently divided into two: application 2462601A comprising the first two marks and 2462601B comprising the second two. The full specification for these marks, as amended by Kleeneze, is annexed to this decision.

3) On 18th January 2008 both applications were published for opposition purposes and on 17th April 2008, Roy Thomas of 46 Eider Close, Forest Gate, London WC1V 7LE filed notices of opposition to the applications. The oppositions are solely based on grounds under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and are partial oppositions directed against Kleeneze’s goods of classes 9, 18, 28 and certain of the goods in the retail services specifications of class 35. The original specifications for these classes was subsequently amended by Kleeneze. I shall detail the (current) goods and services under attack in para 5 below.

4) Mr Thomas relies on two earlier marks, UK mark 2322793 (‘793) and 2320222 (‘222). The relevant details of these marks are:

Trade Mark No and mark	Filing and registration dates	Goods relied upon as identical or similar
2322793 EEZEE EEZEE SPORTSWEAR EEZEE CLOTHES EEZEE MERCHANDISE	4 th February 2003 and 6 th August 2004	Class 25 Headgear; warm up suits; jogging suits; tracksuits; sweatsuits; sweat pants and sweatshirts; bodysuits; leotards; leg warmers; leggings; rompers; singlets; wet suits; ski suits; ski pants; ski bibs; ski jackets; swimwear; bathing suits; sportswear, golf wear; suits; tuxedos; slacks; trousers; jeans; shorts; sweat shorts; gym shorts; tops; coats; shirts; sport shirts; t-shirts; knit shirts; polo shirts; pullovers; sweaters; vests; tank tops, blazers, jumpsuits; playsuits; jackets; over-coats; parkas; wind resistant jackets; waist coats; leatherwear; skirts; dresses; headwear; hats, caps, baseball caps, visors, hoods, berets, headbands; sweatbands; wristbands; ear muffs; neckwear; neckties; neckerchieves; scarves;

		bandannas; sleepwear, but not including bed socks; robes; pyjamas; nightshirts; rainwear; gloves; mittens; loungewear; underwear; briefs; underpants; boxer shorts; lingerie; belts.
2320222 EEZEE	8 th January 2003 and 4 th June 2004	<p>Class 9</p> <p>Computers; computer software; computer hardware; pre-recorded CD Roms and other disk carriers; sunglasses; computer programmes, data recorded and storage media, microprocessors, computer boards, visual display units and screens; slot machines; electric circuits; electric apparatus and instruments, signalling, checking (supervision), life saving and protective apparatus and instruments, shielding, safety and protecting installations, video cameras monitors.</p> <p>Class 28</p> <p>Gaming machines and games machines.</p>

5) Taking account of the statement of case and amendments to the specifications by Kleeneze, the list of surviving goods and services under challenge in respect of both applications reads as follows:

Class 9

Binoculars, telescopes, alarms, security alarms and anti-theft warning devices; smoke detectors; extinguishers; thermostats; protective clothing; earplugs; teeth protectors; photographic apparatus and instruments; electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus; vacuum cleaners, electric dust removing apparatus; wax polishing machines; welding apparatus, televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; records, tapes, discs; batteries and battery chargers; apparatus and instruments for fermentation; life saving apparatus and instruments; cleaning apparatus for CDs, records, tapes and discs; parts and fittings for all the aforesaid goods.

Class 28

Toys and soft toys; dolls; gymnastic and sporting articles; exercisers and chest expanders; Christmas trees of synthetic materials; decorations for Christmas trees, Christmas crackers; novelties; playing cards.

Class 35

The bringing together, for the benefit of others, of a variety of goods, namely binoculars, telescopes, alarms, security alarms and anti-theft warning devices, smoke detectors, extinguishers, thermostats, protective clothing, earplugs, teeth protectors, photographic apparatus and instruments, electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus, vacuum cleaners, electric dust removing apparatus, wax polishing machines, welding apparatus, televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; records, tapes; cleaning apparatus for records, tapes, and plugs, sockets and other contacts, batteries and battery chargers, apparatus and instruments for fermentation, life saving apparatus and instruments, parts and fittings for all the aforesaid goods; bed socks, robes; pyjamas; night shirts; rain ware; gloves; mittens; loungewear; underwear; briefs; underpants; boxer shorts and belts enabling customers to conveniently view and purchase those goods (including through the medium of distributors) from a catalogue by mail order or by means of telecommunications via the Internet, both of the aforesaid media specialising in general merchandise.

6) Mr Thomas filed no evidence in the proceedings. Kleeneze filed submissions dated 9th March 2009. These submissions relate, in part, to the issue of similarity as between goods in class 18 and goods in class 25. This issue was in effect made redundant by the removal from its specification by Kleeneze of all goods in class 18. The submissions also make claims regarding the control and licensing of gaming machines and games machines. I note the submission but the supporting material, filed as extracts from The Gambling Commission's website, is discounted as it is material that should properly have been put in evidence in accordance with rule 55 of the Trade Marks Rules 2000.

7) Neither side has therefore filed evidence and nor have they requested to be heard. Both sides have however filed concluding submissions in lieu of a hearing which I shall take into account. Both parties ask for an award of costs. The matter has now come to me for a decision based on the papers filed. After careful consideration of the papers I give the following decision.

DECISION

Section 5(2) (b)

8) The opposition is founded upon Section 5(2) (b) of the Act. This 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.”

8) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

Mr Thomas’s marks were filed on 8th January 2003 and registered on 4th June 2004 in the case of ‘222, and 4th February 2003 and registered on 6th August 2004 in the case of ‘793. Both of Mr Thomas’s marks are therefore earlier trade marks within the meaning of section 6(1) of the Act. Moreover, given that their respective dates of registration are both within the period of five years prior to the date of publication of Kleeneze’s mark (being 18th January 2008), neither mark is subject to proof of use requirements.

9) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (“ECJ”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR. 723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) 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; *Shaker di L. Laudato & C. Sas v OHIM*

Comparison of goods

10) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at para 23 of the Judgment:

‘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.’

11) Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

12) Two further cases on the way that specifications ought to be interpreted should be borne in mind. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd (“Thomson”)* [2003] RPC 32, at para 31, Aldous LJ, says

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use.”

Although this was in the context of arriving at a fair specification consequent to an attack of revocation on the grounds of non-use, the principle that it is the public and circumstances of the relevant trade that should underpin consideration as to the terms used in a specification nonetheless holds good. Secondly, there is the case of *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd (“Beautimatic”)* [2000] FSR 267, in which the principle of giving words their ordinary (rather than an unnaturally narrow) meaning was

enshrined. In summary, the *Beautimatic* case urges an approach that is not unnaturally narrow, whilst the *Thomson* case stresses that the exercise is not one of lexical analysis in a vacuum, but by reference to how the average consumer may perceive matters in the relevant trade.

13) The submissions of 24th July 2009 by Mr Thomas's attorneys are targeted at a list of goods and services that at times goes wider than that set out in the original grounds of opposition, and at others, attacks a narrower range. As such, I will refer to these submissions as appropriate, but *only* where they refer to Kleeneze's goods and services as identified in Mr Thomas's original statement of opposition. The following table reflects the goods and services to be compared:

Mr Thomas's goods and services	Kleeneze's goods and services
<p>Class 9</p> <p>Computers; computer software; computer hardware; pre-recorded CD Roms and other disk carriers; sunglasses; computer programmes, data recorded and storage media, microprocessors, computer boards, visual display units and screens; slot machines; electric circuits; electric apparatus and instruments, signalling, checking (supervision), life saving and protective apparatus and instruments, shielding, safety and protecting installations, video cameras monitors.</p>	<p>Class 9</p> <p>Binoculars, telescopes, alarms, security alarms and anti-theft warning devices; smoke detectors; extinguishers; thermostats; protective clothing; earplugs; teeth protectors; photographic apparatus and instruments; electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus; vacuum cleaners, electric dust removing apparatus; wax polishing machines; welding apparatus, televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; records, tapes; batteries and battery chargers; apparatus and instruments for fermentation; life saving apparatus and instruments; cleaning apparatus for CDs, records, tapes and discs; parts and fittings for all the aforesaid goods.</p>
<p>Class 28</p> <p>Gaming machines and games machines.</p>	<p>Class 28</p> <p>Toys and soft toys; dolls; gymnastic and sporting articles; exercisers and chest expanders; Christmas trees of</p>

	synthetic materials; decorations for Christmas trees, Christmas crackers; novelties; playing cards.
<p>Goods classes as above and</p> <p>Class 25</p> <p>Headgear; warm up suits; jogging suits; tracksuits; sweatsuits; sweat pants and sweatshirts; bodysuits; leotards; leg warmers; leggings; rompers; singlets; wet suits; ski suits; ski pants; ski bibs; ski jackets; swimwear; bathing suits; sportswear, golf wear; suits; tuxedos; slacks; trousers; jeans; shorts; sweat shorts; gym shorts; tops; coats; shirts; sport shirts; t-shirts; knit shirts; polo shirts; pullovers; sweaters; vests; tank tops, blazers, jumpsuits; playsuits; jackets; over-coats; parkas; wind resistant jackets; waist coats; leatherwear; skirts; dresses; headwear; hats, caps, baseball caps, visors, hoods, berets, headbands; sweatbands; wristbands; ear muffs; neckwear; neckties; neckerchieves; scarves; bandannas; sleepwear, but not including bed socks; robes; pyjamas; nightshirts; rainwear; gloves; mittens; loungewear; underwear; briefs; underpants; boxer shorts; lingerie; belts.</p>	<p>Class 35</p> <p>The bringing together, for the benefit of others, of a variety of goods, namely binoculars, telescopes, alarms, security alarms and anti-theft warning devices, smoke detectors, extinguishers, thermostats, protective clothing, earplugs, teeth protectors, photographic apparatus and instruments, electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus, vacuum cleaners, electric dust removing apparatus, wax polishing machines, welding apparatus, televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines, records, tapes, plugs, sockets and other contacts, batteries and battery chargers, apparatus and instruments for fermentation, life saving apparatus and instruments, cleaning apparatus for CDs, records, tapes and discs, parts and fittings for all the aforesaid goods; bed socks, robes; pyjamas; night shirts; rain ware; gloves, mittens; loungewear; underwear; briefs; underpants; boxer shorts and belts; toys and soft toys, dolls, gymnastic and sporting articles, exercisers and chest expanders, Christmas trees of synthetic materials, decorations for Christmas trees, Christmas crackers, novelties, enabling customers to conveniently view and purchase those goods (including through the medium of distributors) from a catalogue by mail</p>

	order or by means of telecommunications via the Internet, both of the aforesaid media specialising in general merchandise.
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14) I shall deal with each of Kleeneze’s classes in turn. It is important to recognise that even though there is no evidence on similarity, I nevertheless have submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said in *Raleigh International trade mark* [2001] R.P.C. 11 at paragraph 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. The tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public.

15) I should also mention one final case in terms of the application of legal principles, and that is the European Court of First Instance (“CFI”) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

Class 9

16) In applying the *Meric* case above, it is noted that Mr Thomas’s specification includes the broad term “electrical apparatus and instruments”. This has the effect of rendering identical most of Kleeneze’s specification in class 9, in that most of its goods can be electrical in nature and would be considered by the average consumer to be a sub category of the broader term “electrical apparatus”. Specifically, these are: alarms, security alarms and anti-theft warning devices; thermostats; electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios,

cassette players, electric shoe polishers, clocks and time recording apparatus; vacuum cleaners, electric dust removing apparatus; wax polishing machines; televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; batteries and battery chargers. Parts and fittings for the same would also come within the scope of electrical apparatus and instruments, as it is unlikely that they would have an economic existence apart from the main item of which they are a part.

17) The following however may not be understood by the average consumer or trade as being electrical: “binoculars, telescopes, extinguishers, smoke detectors, protective clothing, earplugs, teeth protectors, photographic apparatus and instruments, records, tapes and discs, apparatus and instruments for fermentation, life saving apparatus and instruments, welding apparatus, cleaning apparatus for CD’s, records, tapes and discs; parts and fittings for all the aforesaid goods.” That said, there are other goods in Mr Thomas’s specification in class 9 which are closer in proximity. Specifically, “video cameras monitors” must be classed as a sub category of “photographic apparatus and instruments” and therefore, applying the guidance in *Meric* the latter are identical. I also find there to be a low level of similarity as between “video cameras monitors” and “binoculars” and “telescopes”, all being generally viewed as optical instruments. That is to say that their purpose is primarily one of optical, visual representation and enhancement and the channels of trade are likely to be the same resulting in the respective goods being sold in the same specialist outlets or the same area of larger outlets. The same finding would apply for parts and fittings for the same items.

18) In respect of: “life saving apparatus and instruments”, “smoke detectors”, “extinguishers”, “teeth protectors”, “protective clothing”, “earplugs” and “parts and fittings for all the aforesaid goods”, all these items come within the term “life saving and protective apparatus and instruments, shielding, safety and protecting installations”, and will thus be regarded as identical. Extinguishers are plainly life saving apparatus as are smoke detectors, whilst “teeth protectors” and “earplugs” have a protecting and shielding nature and purpose. The same finding would apply for parts and fittings for the same items.

19) As regards “records, tapes and discs”, I find these identical to “data recorded and storage media”; that is to say that although “records and tapes” may describe somewhat old-fashioned (but not totally defunct) vinyl or cassette formatted material, it is nonetheless ‘media’ (pre-recorded or otherwise). However, I do not believe that the same finding can be made of the “cleaning apparatus for CD’s, records tapes and discs”, which plainly serves a different purpose to the media itself and will not necessarily be supplied through the same channels of trade. I have no evidence on the point but such cleaning apparatus may comprise, eg some form of impregnated cloth or mechanical apparatus to remove dust. Whilst such items are ‘complementary’ in the sense that such cleaning apparatus would not exist without the media, it would not necessarily

follow that, taking all factors into account, that they are similar goods to the media itself. Nonetheless, taking account of the ‘one way’ complementarity and the fact that such cleaning items could be sold in close proximity to the media itself, I find that they share a low level of similarity to Mr Thomas’s “storage media”.

20) Finally, as regards “apparatus and instruments for fermentation” and “welding apparatus”, none of Mr Thomas’s class 9 goods can be regarded as similar to such specialist items. Although I say ‘specialist’, I nonetheless take account of the fact that such goods may be purchased for domestic use, eg home brewing or for undertaking minor car repairs. Such goods are not primarily ‘electrical’ in nature and may only be available through specialist outlets and occasionally through larger retailers. Therefore I find they are not similar to any of Mr Thomas’s goods in this class.

21) My findings in class 9 are best summed up in the following table:

Kleeneze’s goods	Mr Thomas’s goods
alarms, security alarms and anti-theft warning devices; thermostats; electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus; vacuum cleaners, electric dust removing apparatus; wax polishing machines; televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; batteries and battery chargers; parts and fittings for all the aforesaid goods.	<i>Identical to</i> electric apparatus and instruments,
life saving apparatus and instruments; smoke detectors; extinguishers; protective clothing; earplugs; teeth protectors;	<i>Identical to</i> signalling, checking (supervision), life saving and protective apparatus and instruments, shielding, safety and protecting installations,
photographic apparatus and instruments	<i>Identical to</i> video cameras monitors
binoculars, telescopes, parts and fittings for the aforesaid goods	<i>Low level of similarity to</i> video cameras monitors
records, tapes and discs	<i>Identical to</i> data recorded and storage

	media
cleaning apparatus for CD's, records, tapes and discs	<i>Low level of similarity to storage media</i>
apparatus and instruments for fermentation; welding apparatus	<i>Not similar to any goods</i>

Class 28

22) Mr Thomas's attorney's submissions introduce arguments regarding the similarity between Kleeneze's class 28 goods and his class 25 goods. Similarity between these goods was not pleaded in his statement of case and no leave to amend the grounds has been requested. Therefore, as Kleeneze has had no opportunity to consider and respond to these un-pleaded arguments I do not take them into account. In his statement of grounds, Mr Thomas relied upon his own class 28 goods, namely "gaming machines and games machines", and it is the comparison between these goods and those listed in Kleeneze's class 28 specification that I will consider here.

23) On Kleeneze's claim that none of their class 28 goods are similar to "gaming machines and games machines", they say that such machines are likely to have a gambling element requiring to be licensed by the appropriate authorities¹. I have already ruled out the extracts filed in relation to The Gambling Commission's website but I think, on a normal understanding of the words, as supported by my dictionary footnote reference below, the general public and average consumer will understand "gaming machines" to have a gambling element and to be mainly found in purpose built arcades or perhaps other public places such as pubs. The general public do not as a rule acquire such items for private use. They will not understand these to be, eg "toys". Henceforth in my comparisons in relation to this class I will assume that gaming machines have that gambling element (thus making them not similar to Kleeneze's class 28 goods), and so Mr Thomas's best case in this class lies with his term "games machines". The term "games machines" could include such items as games consoles which are available for sale in general and specialised retail outlets. Applying the *Canon* factors, both "toys" and "games machines" have the same intended purpose, that of entertainment, as well as possibly having an educational function. Toys and soft toys however are traditionally 'physical' or 'mechanical' in nature; they could involve batteries or be electrically powered but

¹ The definition of the verb 'gaming' associated with the word 'game', as it appears in the Compact Oxford English Dictionary at http://www.askoxford.com/concise_oed/game_1?view=uk, is:

- **verb** play at games of chance for money.

without the sophistication of a games machine. In terms of their respective channels of trade, both toys and games machines could be sold through the same large retail outlets, sometimes of a specialist nature. It is unlikely however that they would be sold within close proximity to each other in either context. The consumer and trade recognise that games machines are discreet objects. Taking all factors into account I find only a low level of similarity as between games machines and toys.

24) As regards “playing cards”, these are simple, unsophisticated card based objects. Whilst it is true they can be used for entertainment, gambling or games purposes, this is far too tenuous a connection for a finding of similarity when they are not ‘machines’ as such. They are not complementary to games machines. It is possible they would be sold by the same specialised or larger retail outlets, but I do not believe they would be in close proximity to games machines. As regards “soft toys and dolls”, these are simple, unsophisticated physical objects, used and collected mostly by children. They are not complementary to games machines and, like playing cards, they would be unlikely to be sold in proximity to games machines, even in larger specialised or general retail outlets. Taking all factors into account, I find that “playing cards”, “soft toys” and “dolls” are not similar to “games machines”.

25) I need now to consider “Christmas trees, decorations, crackers and novelties”. These are even less similar to games machines. With the exception of novelties, such items are decorative and seasonal in nature and available to the public through a wide range of outlets, including specialist Christmas outlets. None of the goods are complex ‘machines’ by any stretch, and are likely to be low value, temporal items. They would not be sold alongside or even in close proximity to games machines, even in larger retail outlets. Taking all factors into account I find that these items are not similar games machines.

26) As regard “gymnastic and sporting articles” and “exercisers and chest expanders”, these are not similar to games machines. Their nature and purpose being one of enabling physical exertion in a specific sporting context. Such items will be sold through mainly through specialised sports or body building shops but I do not discount the possibility that they may be sold by general outlets. They are unsophisticated items which do not have any complementary relationship with games machines. If they are sold by the same outlets it will not be in proximity to games machines. Taking all factors into account I find that they are not similar to games machines.

27) My findings in relation class 28 can be summarised as follows:

Kleeneze’s goods	Mr Thomas’s goods
Toys	Low level of similarity with games machines. Not similar to gaming machines.

Playing cards, soft toys and dolls	Not similar to gaming or games machines
Christmas trees, decorations, crackers and novelties	Not similar to gaming or games machines
Gymnastic and sporting articles and exercisers and chest expanders	Not similar to gaming or games machines

Class 35

28) The issue in this class is the question whether Kleeneze's application in respect of retail services can be said to be similar to Mr Thomas's registrations in respect of goods. The European Courts have issued two key decisions on this question. In Case C-418/02 *Praktiker Bau-und Heimwerkermärkte AG* ("*Praktiker*") the ECJ approved the registration of retail services and said that it was not necessary to specify in detail the services in question (ie whether they are provided, eg by a supermarket, department store, mail order or electronically online). However it was necessary to specify the goods or types of goods in all cases.

29) The second case is that of T-116/06 *Oakley Inc v OHIM* ("*Oakley*"). In this case before the CFI, the court held that the respective goods and services do not have the same nature, purpose and method of use. Despite this, the CFI found that the Board of Appeal was correct to find that there were similarities, given the complementary nature of the goods and the respective retail services. That is to say that the goods are indispensable to, or at the very least important for the provision of the retail services, which are specifically provided when the goods are sold (paras 54 and 55). This must be true, regardless of how those services are provided, whether by means of a catalogue or traditional brick and mortar environment. As a consequence, the CFI found that retail services are not merely auxiliary or ancillary to the goods in question (para 56). The one rider I should note to this is that the finding of overall similarity is only endorsed by the CFI in respect of retail services which are in respect of *identical, or closely connected to* the goods of the earlier mark (para 56).

30) There is nothing in the case before me which suggests I should not adopt the guidance provided in either *Praktiker* or *Oakley*. Accordingly, and reflecting my earlier findings in respect of the goods classes, I find the following retail services in class 35 similar to Mr Thomas's goods:

The bringing together, for the benefit of others, of a variety of goods, namely alarms, security alarms and anti-theft warning devices, extinguishers, smoke detectors, thermostats, protective clothing, earplugs, teeth protectors, photographic apparatus and instruments, electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric

shoe polishers, clocks and time recording apparatus, vacuum cleaners, electric dust removing apparatus, wax polishing machines, televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; records, tapes and discs; batteries and battery chargers, life saving apparatus and instruments, parts and fittings for all the aforesaid goods; bed socks; robes; pyjamas; nightshirts; rainwear; gloves; mittens; loungewear; underwear; boxer shorts and belts; enabling customers to conveniently view and purchase those goods (including through the medium of distributors) from a catalogue by mail order or by means of telecommunications via the Internet, both of the aforesaid media specialising in general merchandise.

32) I need to mention specifically, the retail services in respect of “bed socks, robes, pyjamas, nightshirts, rainwear, gloves, mittens, loungewear, underwear, boxer shorts and belts”. Kleeneze replaced the general term “clothing” with these specific items in class 35, presumably on the basis that Mr Thomas had expressly excluded them from his ‘ 783 class 25 specification . However, given the punctuation in Mr Thomas’s specification, this is not true. It is only “bed socks” that are excluded from the broader term “sleepwear”; the phrase reading “sleepwear, but not including bed socks”. All the remaining items listed, starting with “robes”, are separated from “sleepwear” by semi-colons, thus indicating that they are *included* rather than excluded. Plainly, given the punctuation in Mr Thomas’s specification, the items:- “robes, pyjamas, nightshirts, rainwear, gloves, mittens, loungewear, underwear, boxer shorts and belts” in class 35 of Kleeneze’s specifications are all identical to those items listed in Mr Thomas’s class 25 specification and therefore retail services in relation to the same must be treated as similar to the goods themselves. In relation to “bed socks”, although these have been expressly excluded (and therefore cannot be identical to Mr Thomas’s goods), they nonetheless must be regarded as highly similar to other forms of sleepwear.

The average consumer

33) I now turn to the question of who the average consumer would be for both parties’ goods and services and the nature of the purchasing act. It is convenient to group the goods and services according to the findings I have made above. In relation to the electrical goods that I have found to be identical in class 9, the consumers for these goods will include members of the general public, but I recognise that specialist traders may also purchase such goods. In respect of the general public, such purchases are not everyday consumables but are goods purchased on an occasional or even one-off basis. As such the purchasing act involves a higher level of consideration than in respect of everyday consumables. Many, but not all, of these goods will also be of higher cost than ordinary consumable items and this will contribute to a more considered purchasing act. Nevertheless, such goods do not demand the highest level of attention. Some goods such as batteries and possibly even some clocks and dust removing

apparatus may have a lower cost and the purchasing act may be correspondingly less considered.

34) As regards the life saving equipment in class 9, I have also found this to be identical. The consumers in respect of these goods are therefore the same and will include the general public and specialised traders. Given the safety aspects of the items involved one would expect a more considered purchasing act even though the individual items may not be high value, eg ear plugs or teeth protectors.

35) As I have found that photographic apparatus is identical to video cameras monitors, it follows that the average consumer for these items will be the same, being the general public as well as, possibly, specialised traders. The purchases will be well considered, as high value items are potentially involved, such as sophisticated cameras and accessories.

35) In relation to the binoculars and telescopes in class 9 I found these to share a low level of similarity with video cameras monitors. The average consumer for binoculars and telescopes will include members of the general public but may also include specialised, including scientific and academic consumers. The average consumer for video cameras monitors will also include the general public. There may well also be specialised traders involved. The purchasing act for both sets of items will be a considered one; certain telescopes for example in particular are high value items, whilst the consumer of video cameras monitors will be keen to ensure compatibility with existing equipment.

36) As regards records, tapes and discs I have found these to be identical to storage media and as such, will share the same average consumer. This average consumer will be the general public but as the items are relatively low value the purchasing act will not be especially considered.

37) For cleaning apparatus for CD's records and tapes, I have found these goods to share a low level of similarity to storage media. The average consumer for both sets of goods will include the general public. Larger bulk purchases of, eg storage media may also be made on behalf of offices. Both parties' goods involve low value items, the purchasing act of which will not be especially considered.

38) Finally in class 9, there is the apparatus and instruments for fermentation and welding apparatus. The average consumer for these goods may possibly be public in the case of, eg home brewing kits or apparatus to undertake minor car repair, but clearly the goods may also encompass industrial applications where the consumer is more likely to be traders. In either case, these will be considered purchases.


39) Concerning the goods in class 28, I will tackle these collectively, the bulk of which (with the exception of toys) I have found not to be similar. The average

consumer for both parties' goods will mainly be the general public. But I do not ignore the fact that it is possible that sports clubs and other specialised traders may be involved in the purchase of gymnastic and sports articles. Games machines are generally higher value items where a more considered purchase will be involved. Toys will span a whole spectrum from very high value items to low value objects and the extent of consideration will vary accordingly. Certain items, such as novelties or Christmas decorations, will be very low value and not considered purchases, whilst sporting and gymnastic articles may well have a higher value and will thus be a more considered purchase.

40) In relation to the class 35 services, plainly the retail service provides the means by which the goods themselves are accessed. The consumer is one and the same. It is noted that Kleeneze's specification in class 35 is restricted to sale through a "catalogue by mail order or by means of telecommunication via the internet, both of the aforesaid media specialising in general merchandise." Kleeneze's sales are therefore made exclusively through these predominantly visual media, where consumers have an opportunity to consider their purchases within the confines of their own home, through the medium of a 'stand alone' catalogue or website. But this makes no difference to the identity of the average consumer and the nature of the purchasing act which will be the same for products and services. The nature of the purchasing act will vary depending on the goods involved and I have already considered the nature of that act when considering the specific goods in the above paragraphs.

Comparison of the marks

41) The respective marks to be compared are:

Mr Thomas's marks	Kleeneze's marks
EEZEE EEZEE SPORTSWEAR EEZEE CLOTHES EEZEE MERCHANDISE	
EEZEE	

42) For the purposes of comparison, I will limit my analysis to the similarities and differences as between Kleeneze's marks and Mr Thomas's first mark EEZEE *solus*. This is Mr Thomas's best case. Visually, that word is in plain type and comprises a five letter word. The versions of Kleeneze's marks differ in that the first version has two 'e's preceding the 'z' and only one after it (making it four letters in total) and the second just one before and after the 'z' (making it three

letters in total). The letter 'e' in both versions is plainly recognisable as such, but the letter 'z' is stylised to present a much larger letter in the overall word and has a sweeping appearance, as in brush strokes. The colours dark blue and black are used in both versions. Both versions differ from Mr Thomas's marks in that, as I have said, they have one less 'e' following the 'z'. Although the 'z' letter in Kleeneze's marks is larger and stylised it does not necessarily follow that this will have a distorting effect on the overall visual impact of both versions. That is to say the average consumer would still see a single word, beginning and ending with 'e', with the 'z' an integral part of that word. On that basis I conclude that when viewing the respective marks as a whole they are highly similar visually.

43) Aurally, the marks would be pronounced in the same way. Both parties' marks would be pronounced by the average consumer in the same way as the recognised word – 'EASY'. The 'e' letter in all versions ensures this. I have considered whether, possibly, Kleeneze's 'EZE' marks would be pronounced as in 'EASE' (the final 'e' being silent), rather than 'EASY'. Whilst this is possible, my view would be that the more likely pronunciation is going to be as in 'EASY'; the word is made up and accordingly the 'e' is not obviously silent. I think it more likely that the consumer will make the link to the known word, EASY, rather than EASE, especially given its prevalence in trade and laudatory nature. In conclusion I find that the respective marks are aurally identical, or if not identical, they are virtually identical.

44) Given my discussion above in relation to visual and aural comparison, I would regard both parties' marks as sharing the same concept – namely as invented words, but nonetheless sharing the same derivation from the known word 'EASY'. The CFI in Case T-189/05 *Usinor SA v OHIM (Galvalloy)* notes at para 62 that the average consumer will break down a verbal sign into elements which "suggest a concrete meaning or which resemble words known to him". I have already noted the prevalence of this word in trade and its laudatory nature. That prevalence in trade is reflected by a variety of misspellings and this would be seen as simply another version. On that basis I conclude that the respective marks are conceptually identical.

45) Bringing the visual, aural and conceptual analyses together, my overall finding on these combined elements is that the respective marks share a very high level of similarity.

Likelihood of confusion

Distinctiveness of the earlier mark

46) Prior to moving to an overall assessment of likelihood of confusion, I need to assess the distinctiveness of the earlier marks – just how distinctive are they? At the higher end of the scale are invented words, having no derivation from any known words, still less any derivation from words which may be used in a trading

context. At the lower end would be words which are barely distinctive. I have found the derivation of Mr Thomas's marks would be the well known word, EASY, and therefore even though EEZEE is technically an invented word, I find the mark to have only moderate to average distinctiveness rather than being highly distinctive based upon its plain derivation. That is a finding based on inherent characteristics. There is no evidence of use on the part of Mr Thomas which may give rise to a claim to enhanced distinctiveness.

47) I need now to bring my respective findings together in a global assessment of likelihood of confusion. Taking account of imperfect recollection, my finding in relation to moderate to average distinctiveness, my findings in relation to the similarities of goods and services and the average consumer and the comparison of marks themselves, my overall conclusion is that the opposition succeeds only in relation to the goods I have found to be identical and the services I have found to be similar. These goods and services are:

Class 9

Alarms, security alarms and anti-theft warning devices; smoke detectors; extinguishers; thermostats; protective clothing; earplugs; teeth protectors; photographic apparatus and instruments; electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus; vacuum cleaners, electric dust removing apparatus; wax polishing machines; televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; records, tapes, discs; batteries and battery chargers; life saving apparatus and instruments; parts and fittings for all the aforesaid goods.

Class 35

The bringing together, for the benefit of others, of a variety of goods, namely: alarms, security alarms and anti-theft warning devices, extinguishers, smoke detectors, thermostats, protective clothing, earplugs, teeth protectors, photographic apparatus and instruments, electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus, vacuum cleaners, electric dust removing apparatus, wax polishing machines, televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; records, tapes and discs; batteries and battery chargers, life saving apparatus and instruments, parts and fittings for all the aforesaid goods; bed socks; robes; pyjamas; nightshirts; rainwear; gloves; mittens; loungewear; underwear; boxer shorts and belts; enabling customers to conveniently view and purchase those goods (including through the medium of distributors) from a catalogue by mail order or by

means of telecommunications via the Internet, both of the aforesaid media specialising in general merchandise.

42) For all *remaining* goods and services under attack, the opposition fails. These goods and services are:

Class 9

Binoculars, telescopes, apparatus and instruments for fermentation; welding apparatus; cleaning apparatus for CDs, records, tapes and discs; parts and fittings for all the aforesaid goods.

Class 28

Toys and soft toys; dolls; gymnastic and sporting articles; exercisers and chest expanders; Christmas trees of synthetic materials; decorations for Christmas trees, Christmas crackers; novelties; playing cards.

Class 35

The bringing together, for the benefit of others, of a variety of goods, namely binoculars, telescopes, apparatus and instruments for fermentation, welding apparatus; cleaning apparatus for CDs, records, tapes and discs; parts and fittings for all the aforesaid goods; toys and soft toys, dolls, gymnastic and sporting articles, exercisers and chest expanders, Christmas trees of synthetic materials, decorations for Christmas trees, Christmas crackers, novelties; enabling customers to conveniently view and purchase those goods (including through the medium of distributors) from a catalogue by mail order or by means of telecommunications via the Internet, both of the aforesaid media specialising in general merchandise.

43) I should just comment that even if I had taken account of Mr Thomas's broader claims in his attorney's submissions of 24th July 2009, it would not in any event have resulted in a wider penumbra of success.

Costs

44) Each party has achieved a measure of success: Mr Thomas in some of class 9 and the related retail services, and Kleeneze in the remainder of class 9, class 28 and those related retail services. In the circumstances I do not propose to make any award of costs.

Dated this 9th day of October 2009

**Edward Smith
For the Registrar,
the Comptroller-General**

Annex

Class 03:

Soaps all for personal or household use; cleaning preparations all for personal or household use, but not including wipes and/or cloths impregnated with or incorporating cleaning preparations; polishing preparations and polish remover preparations; carpet shampoos.

Class 05:

Air freshening and air purifying preparations and substances, perfumed and unperfumed disinfectants; germicidal preparations having cleaning properties.

Class 08:

Hand operated tools; garden tools and implements; insecticide sprayers; cutlery; knives; nutcrackers; scissors; razors; manicure and pedicure sets; beard clippers; needle threaders.

Class 09:

Binoculars, telescopes; alarms, security alarms and anti-theft warning devices; smoke detectors; extinguishers; thermostats; protective clothing; earplugs; teeth protectors; photographic apparatus and instruments; electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios, cassette players, electric shoe polishers, clocks and time recording apparatus; vacuum cleaners, electric dust removing apparatus; wax polishing machines; welding apparatus, televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines; records, tapes and discs; batteries and battery chargers; apparatus and instruments for fermentation; life saving apparatus and instruments; cleaning apparatus for CDs, records, tapes and discs; parts and fittings for all the aforesaid goods.

Class 11:

Apparatus for lighting, heating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; parts and fittings for all the aforesaid goods.

Class 16:

Printed publications, books and manuals; paints, paint boxes, paint brushes, and artists' materials; stencils; packaging materials, gift wrapping paper, paper ribbons and bows; cards, gift tags, greeting cards and card holders; all included in Class 16.

Class 21:

Brushes, handles; connectors and extensions for all the aforesaid goods; apparatus and instruments, all for dispensing cleaning or washing preparations; gloves for domestic, cleaning or household purposes; dustpans; cloths for cleaning purposes; household and kitchen utensils and containers; dusters and refuse bags.

Class 26:

Haberdashery; buttons, hooks and eyes, fastenings for clothing; buckles, brooches, feathers; ornaments for hats; false hems; false hair and beards, toupees; tea cosies; hair ornaments, hair bands, hair curlers, hair curling pins, hair grips, hair slides, hair nets, hair pins, hair combs, snoods; pins, needles, bodkins, knitting needles and pin cushions; artificial flowers and fruits.

Class 28:

Toys and soft toys; dolls; gymnastic and sporting articles; exercisers and chest expanders; Christmas trees of synthetic materials; decorations for Christmas trees, Christmas crackers; novelties; playing cards.

Class 35:

The bringing together, for the benefit of others, of a variety of goods, namely soaps and cleaning preparations, all for personal or household use, polishing preparations and polish remover preparations, carpet shampoos, air freshening and air purifying preparations and substances, perfumed and unperfumed disinfectants, germicidal preparations having cleaning properties, hand operated tools, garden tools and implements, insecticide sprayers, cutlery, knives, nutcrackers, scissors, razors, manicure and pedicure sets, beard clippers, needle threaders, binoculars, telescopes, alarms, security alarms and anti-theft warning devices, smoke detectors, extinguishers, thermostats, protective clothing, earplugs, teeth protectors, photographic apparatus and instruments, electrically heated hair curlers, apparatus and instruments for the purpose of sound reproduction, record players, CD players, radios,

cassette players, electric shoe polishers, clocks and time recording apparatus, vacuum cleaners, electric dust removing apparatus, wax polishing machines, welding apparatus, televisions and video recorders, telephones and answering machines, facsimile machines, weighing machines, records, tapes, plugs, sockets and other contacts, batteries and battery chargers, apparatus and instruments for fermentation, life saving apparatus and instruments, cleaning apparatus for CDs, records, tapes and discs, parts and fittings for all the aforesaid goods, apparatus for lighting, heating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, parts and fittings for all the aforesaid goods, printed publications, books and manuals, sticky tape, playing cards, stickers, paints, paint boxes, paint brushes and artists' materials, stencils, packaging materials, gift wrapping paper, paper ribbons and bows, cards, gift tags, greeting cards and card holders, pictures, prints, stationary, bags, boxes, cases, suitcases, trunks, travel bags, satchels, rucksacks, purses, wallets, key cases, net bags and wash bags, luggage straps, walking sticks, umbrellas and parasols, belts, collars and harnesses for animals, slings for carrying infants, tool bags, suit and dress covers, shoe caddies, brushes, handles, connectors and extensions for all the aforesaid goods, apparatus and instruments all for dispensing cleaning or washing preparations, gloves for domestic, cleaning or household purposes, dustpans, cloths for cleaning purposes, household and kitchen utensils and containers, dusters and refuse bags, furniture, tableware, decorative household articles, mirrors, statues, haberdashery, buttons, hooks and eyes, fastenings for clothing, buckles, brooches, feathers, ornaments for hats, false hems, false hair and beards, toupees, tea cosies, linen, tableware, bed linen, sheets, towels, bed socks, robes; pyjamas; nightshirts; rain ware; gloves, mittens; loungewear; underwear; briefs; underpants; boxer shorts and belts, hair ornaments, hair bands, hair curlers, hair curling pins, hair grips, hair slides, hair nets, hair pins, hair combs, snoods, pins, needles, bodkins, knitting needles and pin cushions, artificial flowers and fruits, toys and soft toys, dolls, gymnastic and sporting articles, exercisers and chest expanders, Christmas trees of synthetic materials, decorations for Christmas trees, Christmas crackers, novelties, enabling customers to conveniently view and purchase those goods (including through the medium of distributors) from a catalogue by mail order or by means of telecommunications via the Internet, both of the aforesaid media specialising in general merchandise.

Class 38:

Telecommunications services, telephone services, telephone connection services.

Class 41:

On-line publications; on-line publications providing information of distributors relating to mail order and electronic shopping.