

O-376-09

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2380589

BY PRAMIC LIMITED

TO REGISTER IN CLASS 16 THE TRADE MARKS:

**TWIN-MATE
&
Twin-Mate**

AND

IN THE MATTER OF OPPOSITION NO 96120 BY

F.BENDER LTD

TRADE MARKS ACT 1994

**In the matter of Application No 2380589
by Pramic Limited
to register in class 16 the trade marks TWIN-MATE and Twin-Mate**

and

**In the matter of opposition No 96120 by
F. Bender Ltd**

Background

1. On 17 December 2004 Pramic Limited (“Pramic”) applied to register the series of two trade marks TWIN-MATE & Twin-Mate in class 16 of the Nice classification system¹. The opposition is directed only at certain of Pramic’s applied for goods, namely:

Paper, cardboard and goods made from these materials; stationery, paper holders, paper fasteners, office requisites, paper mats for drinks, plastic mats for drinks, printed matter.

2. On 6 February 2008 opposition to the registration of Pramic’s application was made by F. Bender Ltd (“Bender”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Bender relies on its UK trade mark registration 2193250 for the trade mark MATE which is also in class 16. Shortly after the filing of its opposition Bender’s trade mark was partially revoked on the grounds of non-use². No appeal was lodged against the decision. Bender’s trade mark was revoked (with effect from 18 September 2004) in respect of all of its goods except for:

Table napkins, serviettes, all made wholly or principally of paper; all included in Class 16 and being for sale to the vending machine, food, catering and hotel trades.

3. In view of the above, Bender amended its statement of grounds so as to rely only on the goods set out above and to also only claim use in respect of the same. The claim to use was required because the proof of use provisions contained in section 6A³ of the Act apply. For its part, Pramic amended its counterstatement so as to not require Bender to provide proof of use in relation to

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

² Revocation no. 82467 and the decision of Mr Reynolds dated 18 February 2008 (BL O-044-08).

³ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

Bender's amended claim. This was a helpful and constructive approach by both parties.

4. Only Bender filed evidence, this is summarised below. Neither side requested a hearing, both opting instead to file written submissions.

Bender's evidence

Witness statement of Adrian Francis Pratt

5. Mr Pratt is Bender's marketing manager, a position he has held since 1992. He states that Bender supply a range of products including catering rolls, towels, tissues, wipes, table napkins, table cloths, handkerchiefs, placemats, doilies, serviettes, coasters and bibs. In relation to the mark MATE (which has also been used in combination with other words e.g. DEMI MATE, MULTI MATE, SUPER MATE, MIDI MATE, CHECKMATE and BENDER MATE), he states that this has been used since 1980, particularly in relation to paper napkins and serviettes.

6. MATE products are sold throughout the hotel and catering industries via wholesalers who then sell to the end-user market. There are 117 such customers in the UK. Mr Pratt states that Exhibit AFP1 comprises a list of customers (together with their geographical location). However, even if I were to assume that the customers located in "Ireland" were in Northern Ireland, only 22 UK customers are detailed.

7. Mr Pratt states that Bender provide a print service (and has done since 1980) enabling the personalisation (with a brand or promotional message) of the product. Occasionally, Bender is involved in the design of this, but more often it is arranged through the end customer's wholesaler.

8. Exhibit AFP2 consists of 14 invoices that Bender has sent to its customers. They range in date from 28 October 1999 to 12 April 2006. 7 of the 14 include MATE NAPKINS. The other 7 are for other mate products (SUPER MATE, MIDI MATE and/or MULTI MATE). The most recent MATE invoice is dated 7 April 2006. Mr Pratt states that products sold under the MATE trade mark are available throughout the UK but he concedes that the number of end-users and their location is not readily available as its customers are generally wholesalers. Details of annual turnover (worldwide) between 1999 to 2007 is then provided. In the last five years (2003-2007) it has ranged between £8.7 million and £6.9 million per year. Mr Pratt says that approximately 70% of this relates to the UK and that this relates solely to goods sold under the mark MATE. Despite Mr Pratt's statement that this relates solely to goods sold under the MATE trade mark, I take this to include the other MATE variants because earlier in his evidence Mr Pratt regards use of such designations as use of the MATE mark albeit combined with other words.

9. In terms of promotion, Mr Pratt explains that this is achieved through a sales team of 8 people. They present the product to its wholesale customers and any potential new customers who indicate an interest or who the team believes are likely to be a source of new orders. Promotion is also achieved through brochures (the "Perfect Settings" brochure) and A4 inserts. The Perfect Settings brochure is sent to its direct clients, known end-users and new and existing customers. He states that the brochure is the best of its kind in the industry and that many customers (existing and potential) request copies directly. Between 2003-2006, 5000 copies were issued, the majority in the UK. In 2006 the figure was 3000.

10. Exhibit AFP3 contains a selection of promotional material. It ranges in date from 1980 to 2006. Most of it is Bender's own promotional material which shows its available products. MATE is clearly used as the name of one of its dispenser napkins. The dispenser itself is also branded MATE. Other materials provided include examples of packaging for the goods which, again, clearly displays the MATE trade mark. The BENDERS name is also used and is likely to be regarded as the house mark. Also shown is some material that appears to have been issued by the wholesalers themselves (e.g. *Makro* and *Booker Cash and Carry*). Some show the name BENDER MATE (but also using the words "pick the Mate that suits you best"). Some show MATE as a clear independent sub-brand.

11. From the date of first use (1980) to 2007 approximately £110,000 has been spent on promotional material. £6000 per year is spent on advertising and trade support. 75% of this is said to relate to the MATE trade mark.

12. Mr Pratt then refers to Pramic's application. He is concerned that certain of its terms ("paper and goods made from these materials" and "printed matter") would include paper napkins and that certain of its goods (paper/plastic mats for drinks) are commonly sold to the catering trade.

Witness statement of Anjum Sheikh Bashir

13. Ms Bashir works for Murgitroyd & Company, Bender's representatives in this matter. Her evidence is directed at whether the respective goods are identical or similar. Rather than summarise it here, I will return to it when dealing with the issue of goods similarity.

Section 5(2)(b) – legislation and the leading authorities

14. Section 5(2)(b) states:

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

(a)

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

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

15. When reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments germane to this issue, notably: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [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 + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). The above judgments set out the primary principles to be applied in matters such as these; I will refer to them, to the extent necessary, in more detail later in this decision.

The average consumer and the purchasing act

16. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) I will begin with an assessment of who this is.

17. Bender’s goods are table napkins and serviettes (made from paper) for the catering trade. The average consumer must, therefore, be assessed as a business or individual businessman who will make use of such goods in their business operation. There is an argument that such goods are low cost and represent a fairly casual purchase, however, businesses are likely to buy in larger proportions than the general public and, therefore, I believe that such a user, in accordance with the case-law, will be reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

18. Bender’s evidence provides some assistance in terms of the purchasing process. It seems that the average consumer will normally buy from a wholesaler. The average consumer may also look at brochures or other promotional material. All of this suggests that visual similarity may have more

significance than aural similarity, however, this is not to the extent that aural similarity should be completely ignored.

19. In relation to Pramic's goods, to the extent that any of its terms could cover napkins and serviettes, the average consumer as I have already described will also be relevant here. However, given that its specification is not limited to the trade, there is another average consumer to consider, namely, the general public. Although still reasonably observant and circumspect, the general public will likely spend less time considering its purchase so the degree of care and attention being applied will be less. In relation to paper/plastic mats for drinks, it strikes me that the same two average consumers will be relevant here and similar considerations and characteristics should be applied.

20. Pramic's specification also includes stationery and office requisites. These could have both the general public as an average consumer (buying such goods for their own personal use/home office use) and also a business user (buying to stock their businesses offices). Again, a business user is likely to adopt a slightly higher degree of care and attention than the general public. They are both, though, reasonably observant and circumspect. The goods could come from retail/wholesale establishments, selected from brochures or purchased over the Internet. Visual considerations apply more, but as stated earlier, not to the extent that aural similarity should be ignored.

21. In relation to printed matter, this is a broad term covering, at least, books, magazines, posters etc. Generally speaking, these are goods aimed at the general public. Similar characteristics and purchasing processes (of the general public) as discussed above will be utilised.

Comparison of the goods

22. All relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of its 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.”

23. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant in the assessment of goods/services similarity:

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

24. In terms of my approach, if a term in Pramic’s specification falls within the ambit of a broader term in Bender’s specification then there must be a finding of identical goods. The opposite is also true even if a broad term of Pramic could also include other goods that are, potentially, only similar (or even not similar at all)⁴ given that Pramic has filed no fall-back specification for consideration.

25. There is some debate between the parties in relation to the scope of certain goods in the specification, particularly in Pramic’s specification. In relation to this, the case-law informs me that “in construing a word used in a trade mark specifications, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”⁵ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁶.

26. I will go through Pramic’s specification term by term and will take into account both parties submissions on similarity and also Bender’s evidence.

⁴ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05

⁵ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁶ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

Paper

27. Bender's submissions (and evidence) refer to conflict with the combined term "paper and goods made from [this] material". It considers paper napkins and serviettes to fall within this term. However, this ignores the fact that the first term is for paper alone. Pramic highlights that paper alone is, essentially, a form of stationery used for writing or drawing and, as such, would not include paper napkins. I note, though, that in Ms Bashir's evidence she includes definitions (from Collins Concise Dictionary 5th Edition 2001) for both "napkin" and "serviette", both of which include the words:

"..a small piece of cloth or paper used while eating..."

28. In view of the above, it could therefore be argued that a napkin/serviette is simply a piece of paper. This, however, divorces from the analysis the natural and understandable meanings of the respective words. Whilst a napkin/serviette may be made from paper and is, essentially, a piece of paper, it has been processed from its core paper form into a particular product. It would never be described as paper per se. Paper would, I agree with Pramic, most likely be taken as a term indicating a piece of paper used, for example, for drawing or writing. It could also indicate the core unfinished product. I do not believe that it would ever be taken to include napkins/serviettes, even those made of paper.

29. In view of the above, the goods are not identical. In terms of similarity, whilst there may be some similarity in nature (both being made from paper) the intended purpose, method of use, channels of trade etc. are all quite different. I see no competitive or complementary relationship. My finding is that these goods are not similar.

Cardboard

30. Bender's submissions (and evidence) give no real detail in relation to the conflict with cardboard. Pramic make similar submissions to those it made in relation to paper. For the reasons I have given above, I do not see how Bender can be in any better position here. In fact, they are in a worse position because napkins are unlikely to be made from cardboard. These goods are neither identical nor similar.

Goods made from [paper and cardboard] these materials

31. Bender's submissions and evidence focus more on goods made from paper rather than those made from cardboard. Pramic submits that whilst table napkins/serviettes (made from paper) may be a subset of "goods made from paper" this does not apply to goods made from cardboard; it argues that to find similarity solely on the basis of a shared similarity in material (presumably paper

goods including napkins/serviettes compared to goods made from cardboard) would give too wide a degree of protection.

32. In relation to goods made from paper, this is a broad term that would cover any product made from paper (falling in class 16). It is not as though this is a specific trade term used to indicate a specific and potentially less narrow definition. As Bender's napkins and serviettes are made from paper then they must be considered as a subset of goods made from paper. Although there may be other goods that also fall within Pramic's broad term, no fall-back specification has been provided. It is, therefore, sufficient to find that the goods are identical.

33. In relation to goods made from cardboard, the position is different. Although this term is also a broad term covering cardboard goods, there is nothing in the evidence to suggest that napkins or serviettes can be made from cardboard. The nature of the material means that this would be an unlikely eventuality. Furthermore, no specific form of cardboard product been brought to my attention that could be said to be similar to paper napkins/serviettes. Accordingly, my finding is that the goods are neither identical nor similar.

Stationery

34. Bender submits that stationery is a broad term that could include napkins and serviettes. Pramic submits that stationery simply relates to writing materials.

35. The Collins English Dictionary defines stationery as:

“any writing materials, such as paper, envelopes, pens, ink, rulers etc”

36. Stationery is often sold through a stationery store which will sell traditional stationery as its main business activity, it will also sell other goods. However, this does not mean that every possible product sold in a stationery store should be regarded as an item of stationery. Stationery should be regarded as a term, as defined above, covering items such as paper, envelopes, pens, pencils etc. This would, it seems to me, reflect the normal understanding and natural meaning of the term. There is nothing in the evidence to suggest that this is not how the trade would regard it. The term may also cover items such as staplers, rulers, hole punches. Even though these could be said to extend from the above definition, it would be a step too far to say that a napkin or serviette was an item of stationery. Indeed, I see no reason why anyone would ever come to such a view.

37. In view of the above, napkins and serviettes do not fall within the ambit of stationery and, thus, the goods are not identical. Furthermore, I see no reason why a particular item of stationery (as defined above) would, having regarded to the nature, intended purpose, method of use, etc., be similar to napkins or serviettes. These goods are not similar.

Paper fasteners & paper holders

38. Bender submits that “paper fasteners” is a term broad enough to cover napkin rings and that napkin rings are similar to its napkins. Pramic submits that paper fasteners and paper holders are items used in an office environment and it sees no similarity.

39. Again, matters hinge on what the terms “paper fasteners” and “paper holders” actually cover. The normal understanding of these terms would be goods which fasten or hold paper. As I have found already, it is unlikely that a napkin will be regarded as paper. It follows, therefore, that a paper fastener or holder should not be interpreted as a broad term which would cover items which fasten or hold napkins. Instead, these terms should be regarded as items such as paper clips. It would not cover napkin rings. In view of this, I see no similarity between paper fasteners/holders and napkins.

Office requisites

40. Bender submits that as “requisite” merely means “essentials” (it provides in its evidence a dictionary definition to this extent), and, given that retailers of office requisites also sell goods such as napkins, paper towels and serviettes then there is identity or similarity. Pramic says that office requisites are merely practical items used in an office environment.

41. The evidence provided by Bender stems from a *Google* search for “office supplies”. A subsequent examination of some of the sites that underpin the search results show that traders in this field sell a variety of items for an office environment including goods, Bender says, covered by or similar to its goods. To illustrate its submission the following is taken from its written submissions:

“As is clear from the Google hits contained in the said Witness Statement, “retailers of office requisites” also sell goods such as napkins, paper towels and serviettes which are goods that are the same as or similar to the goods covered by the registration, The term “office requisites” can be taken to mean office essentials, and paper towels are office essentials and are identical to or closely similar to “napkins and serviettes””

42. I have examined the evidence in detail and I firstly note that whilst the website printouts do show the sale of paper hand towels, I can see no napkins or serviettes. These websites do, as Bender submits, focus on the sale of a variety of goods for offices. However, the retailers sell a vast range of goods other than basic office requisites. For example, one depicts a toaster. This highlights the problem because even if a toaster fell in class 16, I doubt whether a normal appreciation of the term “office requisites” would go so far as to include such an item. Furthermore, the websites appear to sell anything and everything that a business may need in its day to day operation and they use different

categorisations to differentiate between different items. For example, the paper hand towels sold by *Viking Direct* are under the category “warehouse and janitorial”, *eurooffices* have a designation “kitchen and cleaning” (although, admittedly, it is under a higher level category “office supplies”), *Staples* hand towels are under “washroom supplies” (and is also under a separate heading from “office supplies”), and *office direct’s* hand towels are under “warehouse and janitorial” (and again separate from “office supplies”).

43. It seems to me that the normal meaning of office requisites should be limited to the things which are necessary for the office itself to function. This would include stationery etc. and perhaps other key items for the office itself, but would not, in my view, cover items which an office (in the wider sense of the term) may need to provide in its toilet or kitchen. Whilst one of the examples in evidence shows “warehouse and janitorial” under the broader heading office supplies, the others do not do so and, in fact, they appear to categorise them differently. In any event, the question relates to the term “office requisites” and not “office supplies”. Ms Bashir provided in evidence the meaning of requisite (meaning essential or indispensable) and I seriously doubt whether a paper towel, napkin or serviette can be said to be essential or indispensable for the running of an office. My finding, therefore, is that paper towels do not fall within the term office requisites nor do paper napkins or serviettes.

44. Furthermore, the fact that office requisites may be sold through the same trade channels as paper towels (which Pramic says are similar to napkins/serviettes) is not particularly relevant given the breadth of goods that are sold by such retailers. In any event, this would not create any similarity with napkins/serviettes as there is no evidence that such goods are sold through the same trade channels as office requisites - the fact that they may be similar to something which is sold through the same channels as office requisites is not relevant. I see no reason to find office requisites (as per my appreciation of what that term means) to be similar to paper napkins or serviettes. The goods are not identical or similar.

Paper mats for drinks & plastic mats for drinks

45. Pramic submits that there is a difference in purpose in that mats are used for catching drips, that they are items of tableware and that they are unlikely to be used in a similar way to napkins or serviettes. It also highlights that there is a difference in nature as far as plastic mats is concerned given that Bender’s napkins and serviettes are made of paper. Bender submits that both sets of goods are directed at the same trade, that they are similar in nature and that they are similar in purpose because they would all appear on a dressed table.

46. Pramic's submissions relate more to whether the goods are the same as opposed to whether they are similar. Whilst I agree that the purpose of the goods are not exactly the same, there is a degree of overlap in that both items serve a

function of preventing mess, be it from food or from drink, and that both items can be used in a table setting. There is a greater degree of similarity in nature between paper mats and paper napkins than there is between plastic mats and paper napkins. I also agree with Bender that the channels of trade overlap as they are likely to be sold in close proximity to each other be it in a wholesale or retail environment. I consider these goods to be reasonably similar.

Printed matter

47. Bender submits that printed matter would include printed table napkins/serviettes. Pramic submits that printed matter covers goods which are printed, but where the purpose of the goods is served by the print (such as books, leaflets, posters).

48. Whilst a napkin can carry print (indeed, Bender offer a bespoke printing service to its customers) and from a literal perspective a napkin is, therefore, matter which is printed, this strikes me, again, as an overstretching and unrealistic definition. I do not see why a napkin (even if it carries print) would naturally be described as an item of printed matter. I agree with Pramic in its definition of this term for the reasons it has given. The goods are not identical or similar.

Summary of findings in relation to goods similarity

49. The following goods in Pramic's specification are identical to Bender's goods:

Goods made from paper

50. The following goods in Pramic's specification are similar to Bender's goods:

Paper mats for drinks

Plastic mats for drinks

51. All of the other goods in Pramic's specification (as opposed) are neither identical nor similar to Bender's goods. In relation to the non-identical or non-similar goods, the opposition must fail because the goods must be, at the least, similar⁷.

⁷ See, for example, the ECJ's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07*.

Comparison of the marks

52. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23).

53. I should say at this point that I see no real difference in this assessment regardless of which mark in Pramic's series is being considered. The difference between TWIN-MATE and Twin-Mate is inconsequential to the analysis of mark similarity and consequent confusion. I will not, therefore, differentiate between the two marks applied for.

54. Pramic submits that the obvious difference between the words MATE and TWIN-MATE (the difference in length, two hyphenated words/one word, that endings of marks can be slurred) is sufficient to counterbalance the point of similarity. It also highlights what it considers to be a conceptual difference in that MATE has a recognisable meaning whereas TWIN-MATE is an invented word. It highlights that marks must be compared as a whole and that the assessment cannot be carried out on the basis of a dominant element unless the other elements in the marks are negligible.

55. Bender's submissions overlap with its submissions on confusion. But applied to the assessment made here, it submits that MATE is the dominant part of its mark due to the word TWIN being a descriptive element which qualifies the word MATE, that this increases the conceptual similarity because a consumer will focus on the MATE element, and that there is similarity on a visual and aural level because of the common presence of the word MATE, highlighting, again, that the average consumer will see the word TWIN as descriptive.

56. In my assessment, it is clear that both marks contain the common element MATE which creates both a visual and aural degree of similarity. However, the presence of the word TWIN creates a point of difference. I do not agree, though, that the second element in Bender's mark is likely to be slurred, there is no reduction in aural similarity based on this point.

57. It is an important point that the word TWIN in Bender's mark has a descriptive connotation. This, therefore, is likely to give the word MATE an increased role and significance in the context of the overall impression that it gives to the average consumer. This does not mean that the comparison is to be made solely on the basis of the word MATE (*Shaker di L. Laudato & Co. Sas*), but it is still a relevant factor as it at least means that a conceptual hook (for TWIN-MATE) will be based more on the word MATE even though it has another element. This creates a degree of conceptual similarity rather than any significant dissonance. All of this results, in my view, in a reasonable degree of overall similarity.

Distinctive character of the earlier trade mark

58. The distinctiveness of the earlier mark is another factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent point of view, the word MATE will normally be understood as a friend or an animal's sexual partner. In relation to a table napkin or serviette, I struggle to see why such a mark should not be accorded anything other than a reasonable degree of distinctiveness. The mark, however, is not inherently highly distinctive such as an invented or highly unusual word.

59. In terms of the use made, it has been longstanding and the turnover figures appear, on the face of it, to be reasonably significant. There is, though, no market information to contextualise the turnover. Whilst the turnover may be spread throughout the MATE variant marks, the variants are likely to be regarded by the trade consumer as the MATE range of products in view of the fact that they are marketed and promoted together with the consumer choosing which MATE to opt for, be it MATE or one of the variants. In terms of promotion, this is through direct marketing to existing and potential customers rather than print or TV advertising, but given the nature of the goods and the fact that the average consumer of Bender's goods are the trade, this is not too surprising. There seems to be a moderate degree of wholesale customers, but end-customers (those in the trade) are likely to be much greater in number; this is a reasonable inference to draw. The mark is clearly exposed to the average consumer in the wholesale environment. To those trade average consumers, the evidence persuades me that the mark is likely to be reasonably well-known. I believe that this enhances the distinctiveness to make it a mark reasonably high in distinctive character, although, I fall short of saying that the mark is of the highest degree of distinctiveness.

60. Enhanced distinctiveness does not, however, apply to the general public. Although the general public may be the end user (as opposed to the consumer) because it is them that will use the napkins in restaurants etc., the products by this time will have been removed from their packaging and the sign will no longer be visible.

Likelihood of confusion

61. It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer(s) and determining whether they are likely to be confused. I will begin by considering the position from the perspective of the trade average consumer.

62. I have found some goods to be identical and others reasonably similar. I have found the marks to be reasonably similar and for the earlier mark to have a reasonably high degree of distinctiveness. These factors point more towards confusion than away from it. There is, though, the fact that a higher degree of care and attention may be displayed during the purchasing act. This could mitigate, to some extent, the significance of imperfect recollection. Nevertheless, it seems to me that even if a higher degree of care and attention was being utilised, the trade average consumer would still clearly notice the shared MATE element and they are also likely to regard the word TWIN in Pramic's mark as descriptive, perhaps indicating, as Bender submits, twin or 2 ply material or that the goods are twin pack. This could relate to napkins/serviettes and drinks mats. I should stress that ambiguity in the "twin" message does not detract from the significance of this so long as a descriptive meaning of one kind or another is taken from the word TWIN⁸. Taking all this into account, it is my view that the average consumer identified will be confused as to the economic origin of the goods (for both the identical and similar goods) sold under the respective marks MATE and TWIN-MATE.

63. Bender makes reference to its family of MATE based marks which it uses for its table napkins and serviettes (DEMI-MATE, MULTI-MATE, SUPER-MATE, MIDI MATE etc). This is a relevant factor⁹ to consider because if the trade average consumer is used to seeing MATE in the context of the relevant goods on a range or family of marks then the assumption that another mark of similar construction (a descriptive element plus the word MATE) is the responsibility of Bender will be even greater. There is sufficient evidence to show that the trade consumer has been exposed to Bender's family of marks. Therefore, even though I have already found, based on the factors assessed so far, that there would be a likelihood of confusion, such a finding is strengthened by this aspect of its case.

64. Confusion on the part of one of the identified average consumers is enough for Bender to succeed. However, for sake of completeness, I will comment on the matter from the perspective of the general public average consumer. The factors differ from the above assessment in that the earlier mark cannot be said to have a reasonably high degree of distinctiveness (although it is still reasonably distinctive), the issue of a family of marks is not relevant (because the general public will not know of this), but the care and attention displayed at the point of purchase will not be higher than the norm so increasing the significance of

⁸ See, by way of analogy, *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-191/01 P

⁹ See the judgment of the ECJ in Case C-234/06 P, *Il Ponte Finanziaria SpA v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* and also the decision of Professor Annand (sitting as the Appointed Person) in *THE INFAMOUS NUT CO LTD'S TRADE MARKS* [2003] R.P.C. 7

imperfect recollection from that assessed above. Taking all this into account, my view is that the general public average consumer will also be confused. Imperfect recollection may result in the marks being directly confused, due to the most likely concept being recalled from Pramic's mark being the MATE element which is shared with Bender's mark. Furthermore, even if the difference was noticed, the TWIN element will, again, be put down to some form of descriptive reference and the common presence of the word MATE will lead to an assumption of economic connection.

Summary of conclusions

65. The opposition succeeds in relation to:

Goods made from paper, paper mats for drinks, plastic mats for drinks

66. But fails in relation to:

Paper, cardboard and goods made from cardboard; stationery, paper holders, paper fasteners, office requisites, printed matter.

67. None of this, of course, affects the goods that were not the subject of the opposition.

Costs

68. Before sides have achieved a measure of success. In view of this, I do not intend to favour either of them with an award of costs.

Dated this 04 day of December 2009

**Oliver Morris
For the Registrar
The Comptroller-General**