

O-374-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2505382**

**BY**

**JUSTE FASHION LIMITED**

**TO REGISTER THE TRADE MARK:**

**bee-bee** 

**IN CLASSES 18, 25 AND 28**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 99374**

**BY**

**CBM CREATIVE BRANDS MARKEN GMBH**

1) On 19 December 2008 Juste Fashion Limited (Juste) filed an application to register the trade mark:



The trade mark was published, for opposition purposes, on 24 April 2009. The application covers goods in classes, 18, 25 and 28; this opposition is only against the class 25 goods. The current class 25 specification is:

*articles of clothing made from organic cotton for babies and children; articles of maternity clothing made from organic cotton; articles of clothing made from bamboo for babies and children; articles of maternity clothing made from bamboo; articles of clothing made from natural fibres for babies and children; articles of maternity clothing made from natural fibres; maternity clothing; articles of clothing made for babies and children; articles of clothing made from wool for babies and children; articles of maternity clothing made from wool; underwear for babies, children and pregnant women; nightwear for babies, children and pregnant women; babies' bibs made from textile materials; babies' body suits; babies' bottles<sup>1</sup>; babies' bonnets; babies gloves; maternity clothing made from natural and organic materials.*

2) On 24 July 2009 Creative Brands CV filed a notice of opposition to the registration of the application. The earlier trade mark upon which Creative Brands CV based its opposition was subsequently assigned to CBM Creative Brands Marken GmbH (CBM), which has taken over the opposition.

3) CBM relies upon section 5(2)(b) of the Trade Marks Act 1994 (the Act). Under section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

4) CBM relies on Community trade mark registration no 1929223 of the trade mark **beebies**. The application for the registration of the trade mark was made on 30 October 2000 and the registration procedure was completed on 4 February 2002. Consequently, the registration is subject to proof of genuine use for the period from 25 April 2004 to 24 April 2009<sup>1</sup> (the material period). The trade mark is registered for:

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<sup>1</sup> Babies' bottles are not in class 25. In the original specification there is a reference to babies' botties, it seems that the specification should be for babies' booties.

*babywear and children's wear,*

*retail services, including via websites and teleshopping, in relation to clothing, footwear, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, sunglasses, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments, leather and imitations of leather, and goods made of these materials, animal skins, hides, trunks and travelling bags, bags, handbags, wallets, purses, key cases, rucksacks, pouches, umbrellas, parasols and walking sticks, whips, harness and saddlery; Arranging and conducting of advertising events and customer loyalty programmes.*

The above goods and services are in classes 25 and 35 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. CBM claims that it has made use of the trade mark in respect of all of the goods and services during the material period.

5) CBM claims that the respective trade marks are visually and phonetically highly similar and conceptually identical; CBM claims that both trade marks “would be perceived as fanciful and allusive corruptions of the words “baby”/“babies””. CBM claims that the some of the respective goods are identical and some of the goods and services are similar.

6) Juste filed a counterstatement. CBM accepts that:

*articles of clothing made from organic cotton for babies and children; articles of clothing made from bamboo for babies and children; articles of clothing made from natural fibres for babies and children; articles of clothing made for babies and children; articles of clothing made from wool for babies and children; underwear for babies and children; nightwear for babies and children; babies' bibs made from textile materials; babies' body suits; babies' bonnets; babies' gloves.*

are identical to the goods of the earlier registration. It denies all the other claims of CBM. Juste puts CBM to proof of genuine use of its earlier trade mark in respect of all of the goods and services for which it is protected.

7) Only CBM supplied evidence. Juste furnished written submissions following the receipt of the evidence of CBM and prior to the hearing, which was held on 21 October 2011. Only CBM was represented at the hearing, by Mr Simon Malynicz of counsel, instructed by Wynne-Jones, Lainé & James LLP.

8) The evidence consists of a witness statement by Dr Michael Prüssner. Dr Prüssner is the managing director of CBM. He is also general counsel for Peek

& Cloppenburg KG (Düsseldorf). He has internal responsibility for all of the trade mark matters of the Peek & Cloppenburg fashion group; including responsibility for the trade mark matters of both CMB and Creative Brands CV.

9) Dr Prüssner comments on the Peek & Cloppenburg fashion group. He states that in addition to distributing fashion items from national and international brands the Peek & Cloppenburg fashion group has also developed its own fashion brands. He states that one of these brands is beebies. He states that the former owner of Community trade mark no 1929223, Creative Brands CV, is a member of the Peek & Cloppenburg fashion group. Dr Prüssner states that beebies was initially used exclusively by the Peek & Cloppenburg fashion group. In 2005 the brand was licensed to Intres BV of the Netherlands and since late 2008 the "licence relationships were continued with Eurobrands International BV, of the Netherlands".

10) Dr Prüssner states that in the material period the Peek & Cloppenburg fashion group has been continuously distributing articles of clothing for babies and children in its stores in Germany, Austria, Belgium, the Netherlands and Poland. He states that the items included:

"babies' and children's sweat shirts, T-shirts, long sleeve shirts, shirts, blouses, skirts, trousers, shorts, scarves, jackets, knitted wear, socks, stockings and underwear".

Dr Prüssner states that a beebies label has been sewn into these items. He states that exhibit MP-2 consist of photographs of items of such clothing taken on 2 August 2008 in a German store of the Peek & Cloppenburg fashion group. Page 14 shows what appears to be pair of shorts attached to which is a swing tag. The label shows the word BEEBIES in a lozenge upon which a stylised head appears. Page 15 shows an unidentifiable item of clothing; sewn into the clothing is a label that bears the word BEEBIES. Page 16 shows an unidentifiable item of knitwear into which is sewn a label in the same form as shown at page 14. Page 17 shows a jacket, attached to which is a swing tag in the same form as shown at page 14.

11) Dr Prüssner states that between 24 April 2004 and 24 April 2009 the sales given in the table below were made by the Peek & Cloppenburg fashion group in relation to the clothing for babies and children identified in paragraph 10.

2004 24 April – 31 December	204,771 items	€1,742,201.22
2005	239,348 items	€2,205,039.41
2006	206,906 items	€2,035,090.25
2007	184,043 items	€1,800,904.72
2008	148,622 items	€1,437,024.08
2009	33,854 items	€330,301.31

1 January – 24 April		
Total	1,017,544 items	€9,550,560.99

12) As between 2005 and 2008 the beebies brand was licensed to Intres BV, articles of beebies clothing sold by the Peek & Cloppenburg fashion group were purchased from Intres BV. Exhibited at MP-3 are examples of invoices from Intres BV. The invoices identify the goods as being of the Beebies brand. The identification of the goods on the invoices is followed by the word baby.

13) Since the end of 2008 the licence has been held by Eurobrands International BV. Since then, the Peek & Cloppenburg fashion group has purchased articles of beebies clothing sold in its stores from Eurobrands International BV. Exhibited at MP-4 are examples of two invoices, dated 29 January and 23 February 2009, from Eurobrands International BV. Also included in the exhibit are excerpts from the merchandise management system. The items on the invoices are correlated with information from the merchant management system which identify the trade mark being used as BEEBIES. Also identified is the department (Ressort) where the items have been sent; they have been sent to the babies department. The products are described as k-bluse, k-hemd, k-hose, k-jeans, k-waesche, k-t-shirt, k-sweat, k-accessoires (which appears to refer to a hat) and k-bermuda. The WOG for all of the goods is either “so-baby girl” or “so-baby boy”. The goods described are: blouses, vests, trousers, jeans, underwear, sweat shirts, hats and Bermuda shorts. It is assumed that k indicates kind (child).

14) Dr Prüssner states that the licensees have been allowed to market beebies fashion items to customers outside of the Peek & Cloppenburg fashion group. Exhibited at MP-5 are invoices showing sales of beebies clothes from Intres BV to E5-Mode NV of Belgium; not all of the items on the invoices relate to beebies. Goods sold under the brands Ministars and X-tract also appear on the invoices. All of the descriptions of beebies products are followed by baby. The goods that can be identified from the invoices exhibited at MP-3 and MP-5 are: caps, shorts, hats, dresses, shirts, skirts, blouses, singlets, bandanas, t-shirts, jackets, rugby sweatshirts and vests.

***Claim to genuine use of the trade mark between 25 April 2004 to 24 April 2009***

15) A convenient summary of the criteria relating to genuine use was given by the General Court (GC) (if relating to a Community trade mark) in *Anheuser-Busch Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-191/07*:

“99 In interpreting the concept of genuine use, account should be taken of the fact that the ratio legis of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts

between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (Case T-174/01 *Goulbourn v OHIM – Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, the purpose of the provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 38, and judgment of 8 November 2007 in Case T-169/06 *Charlott v OHIM – Charlo (Charlott France Entre Luxe et Tradition)*, not published in the ECR, paragraph 33).

100 There is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the registration (Case C-234/06 P II *Ponte Finanziaria v OHIM* [2007] ECR I-7333, paragraph 72; see also, by analogy, Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 43). In that regard, the condition of genuine use of the mark requires that the mark, as protected on the relevant territory, be used publicly and externally (*Silk Cocoon*, paragraph 99 above, paragraph 39; *VITAFRUIT*, paragraph 99 above, paragraph 39; *Charlott France Entre Luxe et Tradition*, paragraph 99 above, paragraph 34; see also, by analogy, *Ansul*, paragraph 37).

101 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*VITAFRUIT*, paragraph 99 above, paragraph 40; *Charlott France Entre Luxe et Tradition*, paragraph 99, paragraph 35; see also, by analogy, *Ansul*, paragraph 100, paragraph 43).

102 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (*VITAFRUIT*, paragraph 99 above, paragraph 41, and *Charlott France Entre Luxe et Tradition*, paragraph 99 above, paragraph 36).

103 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on

several factors and on a case-by-case assessment. The characteristics of those goods and services, the frequency or regularity of the use of the trade mark, whether the mark is used for the purpose of marketing all the identical goods or services of the proprietor or merely some of them, or evidence of use which the proprietor is able to provide, are among the factors which may be taken into account (Case C-416/04 P Sunrider v OHIM [2006] ECR I-4237, paragraph 71).

104 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case (VITAFRUIT, paragraph 99 above, paragraph 42; Charlott France Entre Luxe et Tradition, paragraph 99 above, paragraph 37; see also, by analogy, Ansul, paragraph 100 above, paragraph 39).

105 Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT) [2002] ECR II-5233, paragraph 47).”

16) Mr Malynicz accepted, for the purpose of these proceedings only, that the material submitted by CBM did not show genuine use of the trade mark for retail services.

17) Juste criticises the evidence of genuine use on the following basis:

“only use actually on products shown in the evidence is in capital letters as BEEBIES and/or in conjunction with a distinctive stylised baby’s face”

“However, we submit that the change from small letters to capital letters does alter the distinctive character of the Mark as registered; when a trade mark is filed in small characters this must be considered an active decision by the applicant to protect the mark in that particular form and stylisation, rather than in block capitals which is generally considered to cover a broader range of presentations of the mark.

The addition of the Stylised Baby’s Face alters the distinctive character of the Mark to an even greater extent, bearing in mind the real prominence of the Face within the overall mark in terms of position (it appears at the top where it will be most noticed by consumers) and size (the Face is larger than the words BEEBIES).”

18) In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25 the Court of Appeal dealt with issues relating to use of a trade mark in a form which does not alter the distinctive character of the mark in the form in which it was registered. Lord Walker stated:

“43 I have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

"Bare ruin'd choirs, where late the sweet birds sang"

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vaultlike trees in winter, and the dissolution of the monasteries).

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who "normally perceives a mark as a whole and does not proceed to analyse its various details."

In *Boura v Nirvana Spa & Leisure Ltd* BL O/262/06 Mr Richard Arnold QC, sitting as the appointed person, stated:

“15. It is clear from BUD and BUDWEISER BUDBRÄU and the four Court of First Instance cases that the normal approach to the assessment of distinctive character applies in this context. As the European Court of Justice has reiterated in numerous cases, the distinctive character of a trade mark must be assessed (i) in relation to the goods or services in question and (ii) according to the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.”



He went on to state:

“34 The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

In *Atlas Transport GmbH v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle)* (HABM) the GC held:

“42 Aus alledem ergibt sich, dass die zusätzlichen Elemente der Briefköpfe der von der Klägerin vorgelegten Rechnungen nicht als ein untrennbar mit dem Element „Atlas Transport“ verbundenes Ganzes angesehen werden können, dass sie eine untergeordnete Stellung im Gesamteindruck einnehmen, den die streitige Marke so, wie sie in den Briefköpfen benutzt wurde, hervorruft, und dass die meisten von ihnen eine schwache Unterscheidungskraft haben. Folglich ist entgegen den Ausführungen der Beschwerdekammer in der angefochtenen Entscheidung die Unterscheidungskraft der eingetragenen Marke bei ihrer Benutzung auf den zu den Akten gereichten Rechnungen nicht im Sinne von Art. 15 Abs. 2 Buchst. a der Verordnung Nr. 40/94 beeinflusst worden.”

19) Juste refers to use actually on the products. The issue of use is use in relation to the goods, not just upon the goods. The invoices exhibited at MP-5 from the licensee to third party shows use of Beebies. This is use that is external, as it is to a third party. Juste also considers the supposed intent of CBM in filing the trade mark. The question as to use in a form differing in elements which do not alter the distinctive character of the trade mark in which it was registered, is not a matter of the supposed intent of the proprietor of the trade mark but a question of comparison of the trade mark as used and the trade mark as registered.

20) It is common for trade marks to be used in upper case, in lower case and in title case. It is common for words to be used in such a form. It is not considered that use of beebies whether in lower case, upper case or title case will have any impact upon the average consumer for the goods of the earlier registration. Consequently, the use shown on the invoices exhibited at MP-5 is use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.

21) It is not uncommon for undertakings to use a device trade mark and a word trade mark. The consumer is used to identifying, and has been taught to perceive, the trade marks as separate entities. The additional elements on the labels shown at MP-2 do not form indissoluble entities with the BEEBIES element. The average consumer is likely to perceive two trade marks BEEBIES and the stylised device of a baby's head or the trade mark BEEBIES with a decorative element above it. Taking into account what has already been decided about use of the trade mark in upper case, it is considered that the use of BEEBIES on the labels is use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.

22) The use relates to use of a Community trade mark. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the GC stated:

“32 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a share in the market for the goods or services protected by the mark (*VITAFRUIT*, paragraph 27 above, paragraph 42, and *LA MER*, paragraph 26 above, paragraph 57; see, by analogy, *Ansul*, paragraph 24 above, paragraph 39, and the order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21).”

In considering whether genuine use is established it is necessary to consider, within the context of the European Union as a whole, the sector of the industry in which the proprietor operates and the nature of the goods, whether the use is warranted in the market place and if the use creates and/or preserves an outlet for the goods in the marketplace<sup>ii</sup>. There has been consistent use during the material period on a number of items and on a reasonable scale. There has been use in 5 member states of the European Union. It is clear that there has been use to maintain a market in goods in relation to which the trade mark has

been used. CBM has established genuine use of the trade mark in the European Union.

23) It is necessary to decide upon a fair description for the goods for which genuine use has been shown and which fall within the parameters of the specification. The description must not be over-precise<sup>iii</sup>. It is necessary to consider how the relevant public would describe the goods<sup>iv</sup>. The GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* held:

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has

been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

In *Animal Trade Mark* [2004] FSR 19 Jacob J considered a fair specification in relation to clothing, where there had been a large range of items of clothing sold:

"23 So, should "clothing" in the specification be qualified in some other way? The term covers a very wide spectrum of different sorts of garments. But putting aside such specialist things as diving suits, wetsuits, bullet-proof vests and so on, there is a core of goods which are likely to be bought by ordinary consumers for different purposes in their daily wear. The same woman or girl is likely to own T-shirts, jeans, dresses, both formal and informal. Both parties' goods could easily end up in the same wardrobe or drawer. He or she knowing of the range of goods for which use has been proved would, I think, take "clothing" to be fair as a description. He or she might limit the clothing to "casual clothing" but I have concluded in the end that "clothing" is appropriately fair."

In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

24) CBM has demonstrated use on a number of clothing items. In the invoices exhibited at MP3 and MP5 the identification of all the goods is followed by 'baby'. The details from the merchant management system, as per MP4, identify the department (Ressort) as 'babies'. The evidence shows that the trade mark has been used for clothing for babies. There are specific areas of shops that sell clothing for babies, clothing for babies is a recognised and clear category. The specification refers to babywear and children's wear and so CBM identify these as categories of clothing. It is considered that the appropriate description of the goods for which use has been shown is babywear.

***Average consumer, nature of purchasing decision and standard for likelihood of confusion***

25) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”<sup>v</sup>. The average consumer clothing for children and babies are parents; some clothing may be purchased by relatives and friends but these are not the average consumers. The average consumers for maternity clothing are pregnant women. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined Cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) stated:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

The same reasoning applies to the clothing in consideration here. The respective goods may vary widely in price and quality and so across the gamut of the goods there will not be a particularly careful and highly educated purchasing decision. Consequently, the possibilities of imperfect recollection are increased. In the same judgment the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

The goods in question will be on display in shops, catalogues and on websites and so primarily will be bought by the eye; consequently, visual similarity will be of more importance than aural similarity.

### ***Comparison of trade marks***

26) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>vi</sup>. 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<sup>vii</sup>. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>viii</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>ix</sup>.

27) The trade mark of Juste is in colour. In *Mary Quant Cosmetics Japan Ltd v Able C & C Co Ltd* BL O/246/08 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“10. The present oppositions under Section 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of the Opponent’s device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions.”

In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated:

“119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The

second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.”

As the trade mark of CBM is not limited to any colour or registered in any colour, the trade mark of Juste must be “drained of colour” and so colour plays no part in the consideration of similarity.

28) beebies does not split into dominant and distinctive components. The distinctiveness lies in the trade mark as whole. However, it is a rule of thumb that consumers generally pay more attention to the beginnings of trade marks than the endings. The device element of the trade mark of Juste is at the end of the trade mark and is much smaller than the rest of the trade mark. This device element consists of four heart shapes that might be seen to form the petals of a flower. It is very much subservient to the rest of the trade mark. The dominant and distinctive component of Juste’s trade mark is bee-bee.

29) In *Phillips-Van Heusen Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-292/01* the GC stated:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately.”

The conceptual meaning of a trade mark must be grasped immediately. That conceptual meaning may be affected by the goods for which the trade mark is used.

30) In its statement of grounds CBM claims that both trade marks would be perceived as fanciful and allusive corruptions of the words baby and babies. Babies is a very common word, with a common pronunciation. Even within the context of clothing for children, babies and maternity wear, beebies is most unlikely to be perceived immediately by the average consumer as meaning babies. It is considered that it will be perceived as what it is, an invented word. Juste submits that the presence of the repetition of bee and the stylised flower device “means consumers see the conceptual function of the Later Mark as having concern for environmental and ecological issues”. It is difficult to see how this concept would be grasped immediately by the average consumer. The repetition of bee with the hyphen creates an invented word that in the context of the goods will not have an immediately perceived meaning for the average

consumer. The repetition and hyphenation of bee will not give lead the average consumer to perceive the concept of bees. If the goods were honey the case might be different. The device element of hearts and the possible form of a flower might have a conceptual meaning for the average consumer. However, as it is very much a minor element of the trade mark, and may be seen as decoration, it will not have a decisive effect on the overall perception of the trade marks by the average consumer. Overall the trade marks will be seen as inventions without meaning. Consequently, the conceptual position is neutral. (If Juste was correct in its submissions, it would lead to oral use of the trade marks giving rise to conceptual identity owing to the aural similarity (see below).)

31) It is likely that the first six letters of both trade marks will be pronounced in exactly the same fashion. The two bee sounds are the dominant phonetic elements of the earlier trade mark. The s is a soft sound at the end of the trade mark and so will have limited aural effect. It is common in English to pluralise words or use them in a possessive form, this includes trade marks. Consumers will often, for instance, refer to Asda's and Tesco's. Consequently, notional and fair oral use of Juste's trade mark would often to give rise to phonetic identity. Even without the pluralisation or use in the possessive form the respective trade marks are phonetically highly similar.

32) Juste's trade mark contains a device element that is alien to the earlier trade mark. Although this device is not a dominant component it must still be considered in relation to the overall impression of the trade mark. There is nothing striking about the font of Juste's trade mark. The average consumer is likely to perceive it as letters in a standard form and will remember the trade mark by reference to the letters per se and not by reference to the font in which they have been produced. The respective trade marks begin with the same three letters. A hyphen in the later trade mark then appears, the letters b and e are then in the same position, the letters i and s of CBM's trade mark are alien to Juste's trade marks. It is considered that there is a reasonable degree of visual similarity between the respective trade marks.

### ***Comparison of goods***

33) In "construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade<sup>xv</sup>". Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning<sup>xi</sup>. Consideration should be given as to how the average consumer would view the goods<sup>xii</sup>. The class of the goods in which they are placed may be relevant in determining the nature of the goods<sup>xiii</sup>. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary<sup>xiv</sup>. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed<sup>xv</sup>.



34) In its counterstatement, Juste accepted that the respective goods were identical with the exception of:

*articles of maternity clothing made from organic cotton; articles of maternity clothing made from bamboo; articles of maternity clothing made from natural fibres; maternity clothing; articles of maternity clothing made from wool; underwear for pregnant women; nightwear for pregnant women; babies' bottles<sup>2</sup>; maternity clothing made from natural and organic materials.*

35) This acceptance was based on babywear and children's wear being in CBM's registration. Use has been shown on babywear only. The clothing for children of Juste's application will have the same purpose as babywear, being for clothing the person; moreover being for the purpose of clothing young persons. The respective goods will have the same nature, being of clothing material. The respective goods will be used in the same manner, being worn. The respective goods could all be sold in the shops that cater for maternity wear, baby wear and clothing for young children. Babywear is highly similar to the class 25 goods of the application which are for children.

36) It is Juste's argument that the goods of the earlier registration are not similar to the goods rehearsed in paragraph 34. Babywear has the same nature and purpose as maternity clothing, being made of material and for wearing. Maternity clothing and babywear is sold in establishments that cater for expectant mothers and for the early years of children; they will follow the same distribution chain. It is considered that the goods identified in paragraph 34 are similar to a high degree to babywear.

### **Conclusion**

37) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>xvi</sup>. In this case the respective goods are identical, highly similar or similar to a high degree.

38) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion<sup>xvii</sup>. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>xviii</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has

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<sup>2</sup> Babies' bottles are not in class 25. In the original specification there is a reference to babies' botties, it seems that the specification should be for babies' booties.

been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings<sup>xix</sup>. In this case, despite the submissions of Juste, beebies is neither descriptive nor allusive of babywear. beebies has a greater capacity to identify the goods for which it is registered and so enjoys a reasonable degree of inherent distinctiveness.

39) The average consumer will seldom be comparing trade marks directly but will be relying upon imperfect recollection. The nature of the goods and the consequent purchasing process will increase the effects of imperfect recollection. That the words involved are invented will mean that there is no conceptual hook upon the consumer can rely; so further increasing the effects of imperfect recollection.

40) Owing to the nature of the goods the visual aspect is of more importance than the aural aspect. In this case the phonetic similarity is greater than the visual similarity. However, there is still visual similarity. In terms of recollection the average consumer is likely to primarily remember the words and not the fonts nor the device element of Juste's trade mark. It is also the case that the trade marks are phonetically extremely similar and in use are often likely to be identical.

41) Even if Juste is correct in relation to a lack of visual similarity this does not gainsay that there would not be confusion. As the GC held in *Phildar SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-99/06:

"82 In that regard, it must be pointed out, first, that the importance of certain visual dissimilarities may be diminished by the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks at issue but must rely on the imperfect picture of them that he has retained in his mind. Secondly, the consumer may be prompted, as submitted by the applicant, to choose goods from the categories in question in response to a television advertisement, for example, or because he has heard them being spoken about, in which cases he might retain the aural impression of the mark in question as well as the visual aspect. It has already been held that mere aural similarity may, in certain cases, lead to a likelihood of confusion (see paragraph 58 above). It is possible that the consumer might let himself be guided in his choice by the imperfect aural impression that he has retained of the earlier mark which may, inter alia, remind him of something in common with a 'thread'. The importance of the aural aspect was mentioned only in respect of some of the goods concerned such as the 'strings' in Class 22, the various goods in Class 23 and those in Class 26, with regard to which the Board of Appeal accepted that they are generally sold over the counter, that is to say, orally (paragraphs 26 to 28 of the contested decision)."

In *Mühlens GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-206/04 P the Court of Justice of the European Union (CJEU) stated:

“21 It is conceivable that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.

22 Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.

35 That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (see, to that effect, Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-0000, paragraph 20).

In this case the trade marks have no clear conceptual associations. It is also to be noted that the CJEU referred to the conceptual **and** visual differences counteracting the aural similarities.

42) There is a likelihood of confusion in relation to all of the class 25 goods of the application and the application is refused in respect of all these goods. (This finding takes into account that it has been inferred that *babies’ bottles* should read *babies’ booties*.)

## **Costs**

43) CBM, having been successful, is entitled to a contribution towards its costs. Costs are awarded upon the following basis:

Opposition fee:	£200
Preparing a statement and considering the statement of Juste:	£400
Preparing evidence:	£500
Preparation for and attendance at hearing:	£500
Total:	£1,600

**Juste Fashion Limited is ordered to pay CBM Creative Brands Marken GmbH the sum of £1,600. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 28th day of October 2011**

**David Landau  
For the Registrar  
the Comptroller-General**

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<sup>i</sup> Section 6A of the Act reads:

- “(1) This section applies where –
- (a) an application for registration of a trade mark has been published,
  - (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
  - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if –
- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
  - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

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- (4) For these purposes –
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
  - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects –
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
  - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)."

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

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

<sup>ii</sup> See *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01:

"36. "Genuine use" must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market

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concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

and *MFE Marienfelde GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-334/01:

“34 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*Ansul*, paragraph 43).

35 Concerning the extent of the use made of the earlier mark, account must be taken, in particular, of the commercial volume of all the acts of use on the one hand and the duration of the period in which those acts of use occurred, and the frequency of those acts, on the other.

36 In order to examine, in a given case, whether use of the earlier mark is genuine, an overall assessment must be made taking account of all the relevant factors in the particular case. That assessment implies a certain interdependence between the factors taken into account. Thus, a low volume of goods marketed under that trade mark may be compensated for by a high intensity or a certain constancy in time of the use of that trade mark or vice versa. Moreover, the turnover achieved and quantity of product sales under the earlier mark cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking exploiting the mark, and the characteristics of the products or services on the market in question. For that reason, the Court has held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39).

37 However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness.”

<sup>iii</sup> *Animal Trade Mark* [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a picky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a

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value judgment as to the appropriate specification having regard to the use which has been made.”

<sup>iv</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is-- how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. 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. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

<sup>v</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

<sup>vi</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>vii</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>viii</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

<sup>ix</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

<sup>x</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>xi</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>xii</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

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“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. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

<sup>xiii</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

<sup>xiv</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>xv</sup> He considered that the following should be taken into account when assessing the similarity of goods and/or services:

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

<sup>xvi</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>xvii</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>xviii</sup> *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

<sup>xix</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.