

O/258/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2525016  
BY  
CROMWELL GROUP (HOLDINGS) LIMITED  
TO REGISTER THE TRADE MARK**

**SENATOR**

**IN CLASSES 03, 06, 09, 11, 12, 16, 18, 20, 24**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 100247  
BY  
REXEL SENATE LIMITED**

## BACKGROUND

1) On 01 September 2009, Cromwell Group (Holdings) Limited (“the applicant”) applied to register the trade mark ‘SENATOR’ for goods in classes 03, 06, 09, 11, 12, 16, 18, 20, 24. For the purpose of these proceedings it is sufficient to record that the application included the following goods:

**Class 09:** *Mirrors for inspecting work; liquid measures; magnets; plumb bobs; soldering irons (electric-); calipers; slide calipers; carpenters' rules; engineers' rules; measuring rulers; precision measuring rules; rulers (measuring instruments); rules (measuring instruments); steel rules for measuring; spirit levels; tape measures; parts and fittings for all the aforesaid goods.*

**Class 11:** *Fume extractors; heating, steam generating, cooking, refrigerating, drying, ventilating goods; hair and hand dryers; inspection lamps; inspection lights; portable lighting; portable lighting for building sites; bicycle lights; parts and fittings for all the aforesaid goods; none of the above being sanitary installations, toilet cisterns, lighting that is attached to buildings, architectural lighting.*

**Class 20:** *grommets made of plastic material.*

2) The application was published on 04 December 2009 in the Trade Marks Journal, and a notice of opposition was subsequently filed by Rexel Senate Limited (“the opponent”). The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the goods listed above.

3) Two earlier marks are relied upon, details of which are as follows:

Mark details	Goods relied upon
<p data-bbox="204 1323 568 1357"><b>UK trade mark: 2425001</b></p> <p data-bbox="204 1413 576 1491"><b>SENATE</b></p> <p data-bbox="204 1581 772 1653"><b>Date of application: 20 June 2006</b> <b>Date of registration: 19 January 2007</b></p>	<p data-bbox="815 1323 959 1357"><b>Class 35:</b></p> <p data-bbox="815 1413 1401 2031">Advertising; business management; business administration; office functions; the bringing together for the benefit of others of a variety of security appliances and instruments, intruder and fire alarms, bell boxes, buzzers, buzzers and detectors, security cameras, cameras and lenses, computer hardware and software, computer monitors and printers, video printers, video door entry module apparatus, audio and video door entry apparatus, sold in kit form, access control apparatus and instruments, printers and speakers, power supply units, electronic card readers and code locks, electronic door chimes, plugs, connectors, fuses and fuse wire, switch</p>

	<p>boxes and plug sockets, batteries, electricity control panels and electrical line controllers, transformers, electrical circuit breakers and electrical testing instruments, parts and fittings for all the aforesaid goods, insulated electric wire, insulated electric cables, conduit, trunking and channelling, all for electrical wiring installations, busbars, television aerials, electric door bells and electric door chimes, plate switches, dimmers, switch socket outlets, television outlets, television/frequency modulation diplexers, switch spurs, double pole switches, telephone outlets, parts and fittings for all the aforesaid goods, electrical apparatus for lighting, space heating, water heating and for ventilation, showers, parts and fittings for all the aforesaid goods, enabling customers to conveniently view and purchase these goods in a wholesale electrical store, via an electrical catalogue or by means of telecommunications or from an Internet website; wholesale services connected with the sale of domestic electrical and electronic equipment.</p> <p><b>Class 39:</b></p> <p>Transport; packaging and storage of goods; travel arrangements; delivery of electrical goods; packaging of electrical goods; storage of electrical goods for wholesale distribution.</p>
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<b>Mark details</b>	<b>Goods relied upon</b>
<p><b>UK trade mark:</b> 2003840</p> <p><b>SENATE</b></p> <p><b>Date of application:</b> 01 December 1994  <b>Date of registration:</b> 23 February 1996</p>	<p><b>Class 09:</b></p> <p>Security appliances and instruments; intruder and fire alarms; bell boxes; buzzers and detectors; security cameras; cameras and lenses; computer hardware and software; computer monitors and printers; video printers; video door entry module apparatus; audio and video door entry apparatus, sold in kit form; access control apparatus and instruments;</p>

	<p>printers and speakers; power supply units; electronic card readers and code locks; electronic door chimes; plugs, connectors, fuses and fuse wire; switch boxes and plug sockets; batteries, electricity control panels and electrical line controllers; transformers, electrical circuit breakers and electrical testing instruments; parts and fittings for all the aforesaid goods; insulated electric wire; insulated electric cables; conduit, trunking and channelling, all for electrical wiring installations; busbars, television aerials; electric door bells and electric door chimes; plate switches, dimmers; switch socket outlets, television outlets; television/frequency modulation diplexers, switch spurs; double pole switches; telephone outlets; parts and fittings for all the aforesaid goods.</p> <p><b>Class 11:</b></p> <p>Electrical apparatus for lighting, space heating, water heating and for ventilation; showers; parts and fittings for all the aforesaid goods.</p>
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4) The opponent claims that the respective marks are confusingly similar and that all of the goods and services covered by the opponent's marks are identical, or similar to, all of the goods in Classes 09 and 11 and '*grommets made of plastic material*' in Class 20 of the application. The opponent submits that, due to the similarities between the respective marks and the identity/similarity in respect of the goods and services, there is a likelihood of confusion on the part of the public.

5) Both of the opponent's earlier marks are registered and therefore qualify as earlier marks under Section 6 of the Act. At the date of publication of the application (04 December 2009) the opponent's earlier UK trade mark 2425001 had not been registered for more than five years and is therefore not subject to the proof of use provision. The opponent's earlier UK mark 2003840 had been registered for more than five years and is subject to the said provision (Section 6A of the Act refers). The Opponent made a statement of use that UK trade mark 2003840 had been used in relation to all of the goods for which it is registered. However, for reasons given below, the opponent is not required to provide proof of use.

6) The applicant filed a counterstatement denying the grounds of opposition. The applicant did not put the opponent to proof of use of its earlier UK trade mark 2003840. Accordingly, the opponent is not required to provide such proof. The earlier mark in question can therefore be relied upon in respect of the full list of goods for which it is registered.

7) The opponent filed written submissions. Neither party filed evidence, nor did they request to be heard. I therefore make this decision after conducting a thorough review of the papers and giving full consideration to all submissions.

## DECISION

### Section 5(2)(b)

8) This section of the Act 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.”

9) The opponent relies upon two identical earlier marks. One of the marks is registered for Classes 09 and 11, the other for classes 35 and 39. In conducting my analysis of the likelihood of confusion between the opponent’s marks and the applicant’s mark, I will, from hereon in, refer to the opponent’s marks singularly as ‘the opponent’s mark’ but I will keep in mind that there are two separate earlier marks.

10) The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel 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* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

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

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

### **Comparison of goods and services**

11) In making an assessment of the similarity of the goods and services, all relevant factors relating to the goods in the respective specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro- Goldwyn-Mayer* the CJEU 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.”*

12) 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 when making the comparison:

*“(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.”*

13) The General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05 held:

*“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark”*

14) I also take into account the guidance in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* (“*Beautimatic*”) [2000] FSR 267, where it was held that words should be given their ordinary (rather than an unnaturally narrow) meaning.

15) Finally, I have also taken account of the comments of the GC in *Oakley, Inc v OHIM* T-116/06, regarding the similarity between goods and retail services connected with the sale of the same goods, where it was stated:

*“54. Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bauund Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods”*

16) Turning to the instant case, the goods and services to be compared are:

Opponent's goods and services	Applicant's relevant goods
<p><b>Class 09:</b> Security appliances and instruments; intruder and fire alarms; bell boxes; buzzers and detectors; security cameras; cameras and lenses; computer hardware and software; computer monitors and printers; video printers; video door entry module apparatus; audio and video door entry apparatus, sold in kit form; access control apparatus and instruments; printers and speakers; power supply units; electronic card readers and code locks; electronic door chimes; plugs, connectors, fuses and fuse wire; switch boxes and plug sockets; batteries, electricity control panels and electrical line controllers; transformers, electrical circuit breakers and electrical testing instruments; parts and fittings for all the aforesaid goods; insulated electric wire; insulated electric cables; conduit, trunking and channelling, all for electrical wiring installations; busbars, television aerials; electric door bells and electric door chimes; plate switches, dimmers; switch socket outlets, television outlets; television/frequency modulation diplexers, switch spurs; double pole switches; telephone outlets; parts and fittings for all the aforesaid goods.</p> <p><b>Class 11:</b> Electrical apparatus for lighting, space heating, water heating and for ventilation; showers; parts and fittings for all the aforesaid goods.</p> <p><b>Class 35:</b> Advertising; business management; business administration; office functions; the bringing together for the benefit of others of a variety of security appliances and instruments, intruder and fire alarms, bell boxes, buzzers, buzzers and detectors, security cameras, cameras and lenses, computer hardware and software,</p>	<p><b>Class 09:</b> Mirrors for inspecting work; liquid measures; magnets; plumb bobs; soldering irons (electric-); calipers; slide calipers; carpenters' rules; engineers' rules; measuring rulers; precision measuring rules; rulers (measuring instruments); rules (measuring instruments); steel rules for measuring; spirit levels; tape measures; parts and fittings for all the aforesaid goods.</p> <p><b>Class 11:</b> Fume extractors; heating, steam generating, cooking, refrigerating, drying, ventilating goods; hair and hand dryers; inspection lamps; inspection lights; portable lighting; portable lighting for building sites; bicycle lights; parts and fittings for all the aforesaid goods; none of the above being sanitary installations, toilet cisterns, lighting that is attached to buildings, architectural lighting.</p> <p><b>Class 20:</b> grommets made of plastic material.</p>



computer monitors and printers, video printers, video door entry module apparatus, audio and video door entry apparatus, sold in kit form, access control apparatus and instruments, printers and speakers, power supply units, electronic card readers and code locks, electronic door chimes, plugs, connectors, fuses and fuse wire, switch boxes and plug sockets, batteries, electricity control panels and electrical line controllers, transformers, electrical circuit breakers and electrical testing instruments, parts and fittings for all the aforesaid goods, insulated electric wire, insulated electric cables, conduit, trunking and channelling, all for electrical wiring installations, busbars, television aerials, electric door bells and electric door chimes, plate switches, dimmers, switch socket outlets, television outlets, television/frequency modulation diplexers, switch spurs, double pole switches, telephone outlets, parts and fittings for all the aforesaid goods, electrical apparatus for lighting, space heating, water heating and for ventilation, showers, parts and fittings for all the aforesaid goods, enabling customers to conveniently view and purchase these goods in a wholesale electrical store, via an electrical catalogue or by means of telecommunications or from an Internet website; wholesale services connected with the sale of domestic electrical and electronic equipment.

**Class 39:** Transport; packaging and storage of goods; travel arrangements; delivery of electrical goods; packaging of electrical goods; storage of electrical goods for wholesale distribution.

17) I consider it convenient to make the comparison by addressing each of the terms within the specification of the application in turn, and, where appropriate and for the sake of expediency, grouping certain terms together (*Separode Trade Mark* BL O-399-10). I will compare those terms to those which I consider represent the opponent's strongest case. I will also bear in mind the effect, if any, I consider the

applicant's limitation, 'none of the above being sanitary installations, toilet cisterns, lighting that is attached to buildings, architectural lighting' in class 11, has on the similarity between the respective goods and services. If I am silent on this point this is because I consider it has no effect on the comparison or the resulting conclusion I have reached in respect of the goods and services at issue.

#### Applicant's Class 09 goods

18) The opponent submits that its class 09 goods are similar to the applicant's class 09 goods. It states:

*"This is because all of the class 09 goods covered by the Opponent's mark relate to goods which would be used by electrical engineers, which is also the case of the class 9 goods covered by the Applicant's mark".*

19) The opponent further submits:

*'In addition, the Class 35 and 39 services covered by the Opponent's marks, are similar to the classes 9, 11 and 20 goods covered by the Applicant's mark, as these all relate to electrical services which are, by their very nature, complementary to electrical goods'.*

20) The applicant's goods in Class 09 all appear to be tools for inspection or measurement purposes and are likely to be used primarily by tradesmen/skilled workers in the building industry. Some of the goods such as 'tape measures' and 'spirit levels' may also be used by DIY enthusiasts around the home however I do not consider that they would be categorized as domestic goods. The opponent's goods in Class 09 appear to me to be electrical/electronic installations. Trade channels of the respective class 09 goods may sometimes converge and users may sometimes overlap, however I do not consider that this overlap will be significant and furthermore, the nature, purpose and method of use, of the respective goods are different. They are also not complementary in the *Boston Scientific* sense nor are they in competition with each other. The applicant's class 09 goods are not similar to the opponent's class 09 goods, however if I am found to be wrong, the similarity would only be very low. The opponent is in no stronger position in relation to its class 35 services (which relate to the same goods covered by its class 09, 'domestic' goods or dissimilar goods of the kind found in class 11). It is also in no stronger position in relation to its class 39 services (see paragraph 31).

#### Applicant's Class 11 goods

*Heating and ventilating goods; parts and fittings for the aforesaid goods.*

21) The opponent's mark covers 'Electrical apparatus for space heating, water heating and for ventilation'. To my mind, the natural meaning of the term 'apparatus' is the same as meaning of 'appliance' or 'device' (*Beautimatic*). The applicant's broad term 'Heating and ventilating goods; parts and fitting for the aforesaid goods' would include appliances/devices of the kind covered by the opponent's mark (*Meric*). 'Heating and ventilating goods; parts and fitting for the aforesaid' are identical to 'Electrical apparatus for space heating, water heating and for ventilation'.

*Fume extractors; parts and fittings for the aforesaid.*

22) The opponent's mark covers '*electrical apparatus for ventilation*'. To my mind apparatus for ventilation and fume extractors are highly similar in nature and purpose and they are both used to improve the air quality in a room. The channels of trade, methods of use and users for the respective goods are also likely to be the same or highly similar. '*Fume extractors; parts and fittings for the aforesaid*' are highly similar to '*electrical apparatus for ventilation*'.

*inspection lamps; inspection lights; portable lighting; portable lighting for building sites; bicycle lights; parts and fittings for the aforesaid.*

23) The opponent's mark covers '*Electrical apparatus for lighting*'. This is a broad term which encompasses the applicant's terms listed above (*Meric*). '*inspection lamps; inspection lights; portable lighting; portable lighting for building sites; bicycle lights; parts and fittings for the aforesaid*' are identical to '*Electrical apparatus for lighting*'.

*Steam generating, cooking, refrigerating, drying goods; hair and hand dryers; parts and fittings for the aforesaid.*

24) The opponent contends the following:

*'With regards to class 11, the Opponent's marks cover electrical apparatus for lighting, space heating, water heating and wall ventilation, which are all identical and similar goods to the class 11 goods covered by the Applicant's mark'*

25) I do not agree that the opponent's Class 11 goods are similar or identical to the applicant's '*steam generating, cooking, refrigerating, drying goods; hair and hand dryers; parts and fittings for the aforesaid*'. The respective goods may be similar in nature to a limited extent in that they may all be electrical however the opponent's goods are for the purpose of heating, lighting and ventilation whereas the applicant's goods are intended for quite different purposes of steam generation, cooking, refrigerating and drying. While trade channels of these goods may sometimes converge I do not consider that it will be to any great extent. It follows that they are unlikely to be sold in close proximity to one another and they are neither in competition or complementary. The goods are not similar, although, if I am found to be wrong, there would only be a very low degree of similarity.

26) The opponent has also submitted that its class 35 services are similar to the applicant's class 11 goods (see paragraph 19).

27) The opponent's mark covers '*Wholesale services connected with the sale of domestic electrical and electronic equipment*'. I do not consider that the applicant's '*hand dryers*' can be deemed to be '*domestic*' goods as these are primarily installed in commercial premises and are rarely found in domestic homes. However, the applicant's '*steam generating, cooking, refrigerating, drying goods; hair dryers; parts*

*and fittings therefore* may all be electrical or electronic domestic goods. The average consumer for such goods will be the general public. To my mind the relevant average consumer of *'wholesale services connected with the sale of domestic electrical and electronic equipment'* will primarily be retailers who will purchase goods from the wholesaler for the purpose of selling them on to the end consumer however I do not discount that the general public may also purchase goods directly from a wholesaler. The nature, purpose and methods of use are different, however, the channels of trade will be the same and, to my mind, the wholesale of goods and the goods themselves can be considered to be complementary in the *Boston Scientific and Oakley* sense, as the existence of the latter is essential for the former. *'Steam generating, cooking, refrigerating, drying goods; hair dryers; parts and fittings for the aforesaid'* are reasonably similar to *'wholesale services connected with the sale of domestic electrical and electronic equipment'*. *'Hand dryers; parts and fittings for the aforesaid'* are not similar to *'wholesale services connected with the sale of domestic electrical and electronic equipment'* however, if I am found to be wrong the similarity would only be very low.

#### Applicant's Class 20 goods

*grommets made of plastic material*

28) The opponent has made a broad statement that its class 35 and 39 services are similar to the class 20 goods of the applicant (see paragraph 19). The opponent also submits:

*"...the class 20 goods of grommets contained in the Applicant's mark, these are similar to the class 9 and 11 goods covered by the Opponent's marks, because these would all also be used by electricians or carpenters in the installation of electrical goods, and are therefore complementary."*

29) I consider that the opponent's strongest case lies with its *'insulated electric wire; insulated electric cables; conduit, trunking and channelling, all for electrical wiring installations'*.

30) *'Grommets made of plastic'* are rings designed to line a hole and include those which may be used to prevent chafing of electrical cables which are passed through the hole. Although the nature and purpose of grommets and electric wire/cables differ, it appears to me that the channels of trade may overlap significantly and the users may be the same. The nature and purpose of conduit, trunking and channelling is that it is used to protect electrical wires which are passed through it. Grommets are usually small round rings whereas conduit, trunking and channelling may be larger and may consist of tubes/pipes and therefore the exact nature of the goods differs however, the purpose and methods of use of the respective goods are similar. I consider that the trade channels of all the respective goods are likely to converge significantly such that they are likely to be stocked in the same retailers in close proximity to one another and their users may be the same. *'grommets made of plastic'* are similar to a good degree to *'conduit, trunking and channelling, all for electrical wiring installations'*.

31) For the sake of completeness, and in case I am found to be wrong in any findings above, I will also consider the opponent's contention that its Class 39 services are complementary to all of the applicant's goods (see paragraph 19). To my mind, the average consumer of the opponent's Class 39 services will primarily be manufacturers wishing to package their goods and transport them to points of sale. The applicant's goods will be purchased by different average consumers (as already identified). The average consumer of the applicant's goods may sometimes have their goods delivered to them however this act of delivery would merely be an execution of a contract of sale between the customer of the goods and the seller of the goods. In such circumstances, the consumer of the goods is not purchasing delivery services within the meaning of class 39. The nature, purpose, methods of use and channels of trade are different. Moreover, the goods and services are intended for different publics and therefore cannot be considered complementary. There is no similarity between the opponent's class 39 services and the applicant's goods. In support of this finding I refer to the comments of the General Court in *Mundipharma v OHMI - Asociación Farmaceuticos Mundi (FARMA MUNDI FARMACEUTICOS MUNDI)* T-76/09:

*"30 It should be noted that there is nothing in the file that invalidates the Board of Appeal's finding, supported by OHIM in its response, that, in essence, the relevant public for 'storage, distribution, delivery and packaging of pharmaceutical, sanitary and dietetic preparations' is made up of professionals, while the end consumer of pharmaceutical preparations will buy them, inter alia, from a pharmacy without using those services. As has already been mentioned in paragraph 26, the applicant does not dispute the Board of Appeal's finding that the relevant public for which the services and goods are intended is different. By definition, goods and services intended for different publics cannot be complementary (see, to that effect, easyHotel, paragraphs 57 and 58).*

*31 Consequently, the Board of Appeal was correct to hold that the services in Class 39 and the goods in Class 5 were not similar.*

*32 That conclusion cannot be undermined by the applicant's argument that a manufacturer of pharmaceutical, sanitary and dietetic preparations also provides packaging, storage, distribution and delivery of those goods. Those activities must be considered to be subsidiary to that manufacturer's main business and not services which are separate from that main business, in Class 39 (see, to that effect, judgment of 7 February 2006 in Case T-202/03 *Alecansan v OHIM – CompUSA (COMP USA)*, not published in the ECR, paragraphs 46 and 47).*

*33 Nor, moreover, is it apparent from the file, including in the 'selling to order' situation invoked by the applicant, that pharmaceutical companies use the trade mark for storage, distribution, delivery and packaging of pharmaceutical preparations, independently of their main business of manufacturing and selling those goods. On the contrary, the applicant itself indicates in its application that the fact that a pharmaceutical company provides 'storage, distribution, delivery and packaging of pharmaceutical, sanitary and dietetic preparations' when working to order 'corresponds to the usual course of business activity.*

34 It follows that the single plea in law must be rejected and, therefore, the action as a whole dismissed.”

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

32) It is necessary to consider these matters from the perspective of the average consumer of the goods and services at issue (*Sabel BV v.Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods.

33) The average consumer for the applicant’s Class 09 goods will primarily be tradesmen/skilled workers in the construction industry and DIY enthusiasts. The same can be said for the applicant’s ‘*grommets made of plastic*’. In relation to the applicant’s class 11 goods, for the most part I would expect these to be purchased by the general public with the exception of ‘*fume extractors, hand dryers, inspection lamps, inspection lights, portable lighting for building sites*’ where I would expect the consumer to be businesses/professionals. The applicant’s goods are likely to vary greatly in price and the consumer may wish to test out certain goods to ascertain their functionality and suitability for purpose. The purchasing act will therefore be primarily visual but I do not discount aural considerations that may play a part. I would expect ‘*grommets made of plastic*’ to be at the lower end of the cost scale and therefore a lower degree of attention will most probably be afforded to their purchase relative to the other goods. I would also expect that the degree of attention paid to the purchase of ‘*heating, steam generating, cooking, refrigerating, drying goods*’ would be at the higher end of the scale as these may be reasonably costly on the most part and an infrequent purchase.

34) The opponent’s goods and services in classes 09, 11 and 35 are likely to be purchased by both the general public and skilled workers such as electrical engineers. I would expect the average consumer of the opponent’s wholesale services to mainly constitute intermediaries, such as retailers, however I do not discount that the general public may also purchase goods directly from the wholesaler. The opponent’s goods and services vary greatly in price. I consider that the degree of attention afforded during the purchasing act will, for the most part, be of a reasonable degree. Where wholesale services are concerned, the degree of attention may be at the higher end of the scale as goods may be purchased in bulk and the relevant consumer may be more alert to differences between brands; that said, the level of attention will not be of the very highest level. The visual aspect is of primary importance in the purchasing process for the same reasons given above but aural considerations are not disregarded.

### **Comparison of marks**

35) For ease of reference, the respective marks are:

Opponent's mark	Applicant's mark
<b>SENATE</b>	<b>SENATOR</b>

36) In making a comparison between the marks, I must take account of the respective marks' visual, aural and conceptual similarities with reference to their overall impressions, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*). However, I must not engage in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

### Visual Comparison

37) The respective marks are identical in terms of their first five letters, 'SENAT'. In the opponent's mark, these letters are followed by the single letter 'E' to form the word 'SENATE', where as, in the applicant's mark they are followed by the letters 'OR' to form the word 'SENATOR'. Bearing in mind that the marks consist of six and seven letters respectively, the first five of which are identical, and that both are presented in the same font, I find the marks to be visually similar to a reasonable degree.

### Aural Comparison

38) From an aural perspective the opponent's mark consists of two syllables and is likely to be pronounced as either, SEN-IT, SEN-ET or SEN-ATE.

39) The applicant's mark consists of three syllables. The first syllable is only likely to be pronounced as SEN. However, the second syllable may be pronounced slightly differently such that the mark as a whole may be pronounced as SEN-IT-OR, SEN-ET-OR or SEN-AT-OR.

40) I bear in mind that the third syllable, OR, in the opponent's mark is absent from the applicant's mark however the first syllable, SEN, of the respective marks is identical. Furthermore, the second syllable of the respective marks is likely to be pronounced in a highly similar, if not identical manner. I therefore find that the marks are phonetically similar to a moderately high degree.

### Conceptual Comparison

41) The opponent's mark consists exclusively of the word 'SENATOR' which *Collins English Dictionary (Collins)* defines as:

*"noun:*

*1. (often cap) a member of a Senate or senate.*

2. any legislator or statesman.”<sup>1</sup>

42) The applicant’s mark consists solely of the word ‘SENATE’. *Collins* indicates that the exact definition of the word is dependent on whether the initial letter is presented in upper or lower case, and accordingly two possible definitions are given, as follows:

“**Senate**: noun (sometimes not cap)

1. the upper chamber of the legislatures of the U.S., Canada, Australia, and many other countries.
2. the legislative council of ancient Rome. Originally the council of the kings, the Senate became the highest legislative, judicial, and religious authority in republican Rome.
3. the ruling body of certain free cities in medieval and modern Europe.”<sup>2</sup>

“**senate**: noun

1. any legislative or governing body considered to resemble a Senate.
2. the main governing body at some colleges and universities.”<sup>3</sup>

43) The UK consumer is unlikely to realise that the presence or absence of a capital letter ‘S’ may alter the meaning of the word ‘SENATE’ and may also not be aware of all of the possible definitions of the word as given in *Collins*. I would expect that the word ‘SENATE’ would conjure the general concept of some sort of legislative, governing or state body and the word ‘SENATOR’ would be perceived as a legislator or statesman of some sort. Whilst the respective marks consist of two different English language words with differing definitions, there is nonetheless a clear conceptual consistency between them since ‘SENATOR’ refers to a particular individual (of the kind already identified) and ‘SENATE’ refers to a collective of those same individuals. I therefore find that there is a moderately high degree of conceptual similarity between the marks.

44) In summary, I have found that the respective marks share a reasonable degree of visual similarity and a moderately high degree of aural and conceptual similarity. This combines to create a moderately high degree of similarity overall between the respective marks.

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

45) I must consider the distinctive character of the opponent’s mark. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by

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<sup>1</sup> ‘[senator](http://www.credoreference.com/entry/hcengdict/senator)’ 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 30 May 2012, <from <http://www.credoreference.com/entry/hcengdict/senator>>

<sup>2</sup> ‘[Senate](http://www.credoreference.com/entry/hcengdict/senate/1)’ 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 30 May 2012, <from <http://www.credoreference.com/entry/hcengdict/senate/1>>

<sup>3</sup> ‘[senate](http://www.credoreference.com/entry/hcengdict/senate)’ 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 30 May 2012, <from <http://www.credoreference.com/entry/hcengdict/senate>>



reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91). No evidence of use has been filed by the opponent, so I have only to consider the inherent level of distinctiveness.

46) As I have already stated, ‘SENATE’ is a word in the English language and, as a consequence, does not enjoy the highest level of distinctiveness of an invented word. Nonetheless, it does not describe or allude to any characteristic of the goods or services covered by the opponent’s earlier marks and I therefore conclude that it is possessed of a high level of inherent distinctiveness.

### **Likelihood of confusion**

47) In determining the likelihood of confusion, I must take the global approach advocated by case law (*Sabel BV v. Puma AG*). I must also take account that the average consumer only rarely has the chance to make a direct comparison between marks, relying instead upon the imperfect picture of them that he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

48) I have found that the marks share a reasonable degree of visual similarity and a moderately high level of aural similarity. On the most part, a reasonable level of attention will be paid during the purchasing act. The average consumer will vary, depending on the specific goods and services at issue, and may include certain professionals (as already identified), intermediary consumers, such as retailers, and the general public. I have also concluded that the earlier mark enjoys a high level of inherent distinctiveness and that the purchasing act for all of the goods and services will be primarily visual. Accordingly, the visual aspect must play a greater role in the likelihood of confusion (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

49) In relation to the conceptual similarities of the marks, I have found that the respective marks are conceptually similar to a moderately high degree despite consisting of different English language words. In this regard, I note that in *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)*(2003) ECR Case T-292/01, the CFI stated:

*“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 fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning **or only a totally different meaning** - to counteract to a large extent the visual and aural similarities between the two marks.”*

50) Furthermore in *Picasso and others v DaimlerChrysler AG Picarro/Picasso* case (C- 361/04P) it was held:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law....

23. Thereafter, the Court of First Instance ruled, in paragraph 56 et seq. of the judgment under appeal, on the overall impression given by those signs and concluded, following a factual assessment which it is not for the Court to review in an appeal where there is no claim as to distortion of the facts, **that there was a counteraction of the visual and phonetic similarities on account of the particularly obvious and pronounced nature of the conceptual difference observed in the present case.** In doing so, the Court of First Instance, in its overall assessment of the likelihood of confusion and as is apparent from paragraph 59 of that judgment, took account in particular of the fact that the degree of attention of the relevant public is particularly high as regards goods like motor vehicles.”

51) In the instant case, I do not consider that the words ‘SENATE’ and ‘SENATOR’ can be significantly distinguished on conceptual terms as they both evoke similar concepts, namely a statesman/legislator or a state/legislative body. Accordingly, it appears to me that the counteraction described in the case law above does not have the capacity to operate. There is therefore no conceptual dissonance great enough to counteract the visual and aural similarities identified and having taken into account all of the above factors, I conclude that where I have found that the respective goods are identical/highly similar or similar to a good degree, I find that there is a likelihood that the average consumer will confuse the marks, particularly where the consumer has not had the benefit of a side by side comparison, but rather, has to rely upon the imperfect picture that he has kept in his mind.

52) The opposition is therefore successful in relation to the following goods covered by the applicant’s mark:

*Class 11: Fume extractors; heating, ventilating goods; inspection lamps; inspection lights; portable lighting; portable lighting for building sites; bicycle lights; parts and fittings for all the aforesaid goods; none of the above being sanitary installations, toilet cisterns, lighting that is attached to buildings, architectural lighting.*

*Class 20: grommets made of plastic material.*

53) In relation to the applicant’s goods which I have found to be reasonably similar to the opponent’s wholesale services, I conclude that, bearing in mind the higher level of attention that is likely to be paid by the relevant consumer there is unlikely to be confusion. Furthermore, where I have found no similarity of the respective goods and services the opposition fails. There cannot be confusion where there is no similarity of goods and services (*Waterford Wedgewood plc v OHIM-C-398/07*). Where the similarity of the goods and services is low I also consider that there is unlikely to be any confusion on the part of the average consumer. The differences in nature, intended purpose, methods of use, users and channels of trade of the respective

goods and services concerned are such that they outweigh the similarities between the marks.

54) The opposition is therefore unsuccessful in relation to the following goods covered by the applicant's mark:

*Class 09: Mirrors for inspecting work; liquid measures; magnets; plumb bobs; soldering irons (electric-); calipers; slide calipers; carpenters' rules; engineers' rules; measuring rulers; precision measuring rules; rulers (measuring instruments); rules (measuring instruments); steel rules for measuring; spirit levels; tape measures; parts and fittings for all the aforesaid goods.*

*Class 11: Steam generating, cooking, refrigerating, drying goods; hair and hand dryers: parts and fittings for all the aforesaid goods; none of the above being sanitary installations, toilet cisterns, lighting that is attached to buildings, architectural lighting.*

## **COSTS**

55) In light of each party having achieved a reasonable measure of success, I consider that both parties should bear their own costs and I therefore decline to make an order.

**Dated this 3<sup>rd</sup> day of July 2012**

**Beverley Jones  
For the Registrar,  
the Comptroller-General**