

O/094-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2584638
BY LAKELAND LIMITED FOR THE TRADE MARK:**



AND

OPPOSITION THERETO (NO 102609) BY CLAIRE-SPRAYWAY INC

The background and the pleadings

1) Application 2584638 was filed by Lakeland Limited (“the Applicant”) on 15 June 2011, and published in the Trade Marks Journal on 5 August 2011. The mark and the goods for which registration is sought are as follows:



Class 03: Cleaning, polishing, scouring, bleaching and abrasive preparation; cleaning preparations having anti-bacterial properties.

2) Claire-Sprayway Inc (“the Opponent”) opposes the registration of the mark. Its opposition was filed on 3 November 2011 on a ground under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is based on the Opponent’s Community Trade Mark (“CTM”) 839415 for the word mark **SPRAYWAY** which is registered for a number of goods in classes 1, 3 and 4; however, only the following goods are relied on in these proceedings:

Class 3: Cleaning preparations; bleaching preparations and other substances for laundry use; polishing, scouring, and abrasive preparations.

3) The Opponent’s mark was filed on 28 May 1998, and completed its registration procedure on 25 October 1999. The consequences of these dates are that: i) the Opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act, and ii) it is subject to the proof of use conditions contained in Section 6A of the Act, the registration procedure having been completed more than five years before the publication of the Applicant’s mark. The relevant period during which genuine use must be proved is 6 August 2006 to 5 August 2011 (“the relevant period”).

4) The Applicant filed a counterstatement, denying the ground of opposition and putting the Opponent to proof of use of its mark for the goods relied on. The Opponent filed evidence and both parties filed written submissions; as the primary purpose of the Opponent’s evidence is to prove that it has genuinely used its mark, I will detail what the evidence contains in the relevant part of my decision. The matter came to be heard before me on 28 January 2013. The Opponent was represented by Ms Gillian Deas of D Young & Co LLP and the Applicant by Ms Rigel Moss McGrath of WP Thompson.

Proof of use

5) As stated previously, the proof of use provisions apply to the Opponent's mark. The use conditions are set out in Section 6A of the Act as follows:

“(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 [.....]”

(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 [.....]

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

6) Section 100 is also relevant; it reads:

“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.”

7) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV [2003] R.P.C. 40* (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). The position¹ was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

¹ Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Examples that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

8) The earlier mark is a CTM which means that genuine use must be in the EC. In its recent judgment in *Leno Marken BV v Hagelkruis Beheer BV* C-149/11 (“ONEL”) the CJEU said:

“28 The Court has already - in the judgments in *Ansul* and *Sunrider v OHIM* and the order in *La Mer Technology* - interpreted the concept of 'genuine use' in the context of the assessment of whether national trade marks had been put to genuine use, considering it to be an autonomous concept of European Union law which must be given a uniform interpretation.

29 It follows from that line of authority that 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 mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether there is real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share 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 (see *Ansul*, paragraph 43, *Sunrider v OHIM*, paragraph 70, and the order in *La Mer Technology*, paragraph 27).

30 The Court has also stated that the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not (see *Sunrider v OHIM*, paragraph 76).

31 That interpretation may be applied by analogy to Community trade marks since, in requiring that the trade mark be put to genuine use, Directive 2008/95 and Regulation No [207/2009](#) pursue the same objective.”

9) Regarding the territorial scope of the use, the CJEU in *ONEL* went on to say:

“52 Some of the interested persons to have submitted observations to the Court also maintain that, even if the borders of the Member States within the internal market are disregarded, the condition of genuine use of a Community trade mark requires that the trade mark should be used in a substantial part of the Community, which may correspond to the territory of a Member State. They argue that such a condition follows, by analogy, from Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 28, Case C-328/06 *Nieto Nuño* [2007] ECR I-10093, paragraph 17, and Case C-301/07 *PAGO International* [2009] ECR I-9429, paragraph 27).

53 That argument cannot be accepted. First, the cases in question concern the interpretation of provisions relating to the extended protection conferred on trade marks that have a reputation or are well known in the Community or in the Member State in which they have been registered. However, the requirement for genuine use, which could result in an opposition being rejected or even in the trade mark being revoked, as provided for in particular in Article 51 of Regulation No [207/2009](#), pursues a different objective from those provisions.

54 Second, whilst it is reasonable to expect that a Community trade mark should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market (see, by analogy, with regard to the scale of the use, *Ansul*, paragraph 39).

55 Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should

be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The use made of the Opponent’s mark

10) The evidence in relation to this is given by Ms Deas, who, as I have already indicated, is a trade mark attorney in the firm of D Young & Co LLP, which represents the Opponent in these proceedings. She states that her evidence comes from her personal knowledge and/or the Opponent via her instructing attorney in the United States and/or from the Opponent’s website. Most of the information provided by Ms Deas in her witness statement appears not to be from her own personal knowledge. Whilst issues of hearsay may arise from this, most of the information provided by Ms Deas is documentary in nature, evidence with which the other side has not taken issue (at least not in terms of establishing facts, although, as will become apparent, there is a dispute as to what can be taken from those facts), so I am prepared to give the evidence reasonable weight.

11) A brief summary of the evidence, particularly focusing on what Ms Deas exhibits, is as follows:

- **Exhibit GMD1** – This contains general information “About Sprayway” from the Opponent’s website (a “.com” website). It states that the Opponent has been providing industry with aerosol products for more than 50 years. It emphasises that all ingredients used in their manufacture meet US consumer and occupational safety standards, that all products are manufactured under US standards for the workplace, and that their labelling complies with US standards. It also states that the Opponent’s central location in Illinois, USA allows reduced shipping time throughout the world. The information is aimed at business customers: “...*This means we will go the distance to make sure your business benefits from our relationship. It’s all about building stronger companies for both you and us*”. The print carries a copyright date of 2012 (after the relevant period).
- **Exhibit GMD2** – A further print from the .com website under the heading “Material Safety Data Sheets” which lists the Opponent’s products, with “product ID” numbers to entries which total just under 100 products. None of the products are listed with reference to the name SPRAYWAY. Some are cleaning products, others are not (for example, various adhesives are listed). There is no copyright date on this print; however, it was printed on 14 June 2012.
- **Exhibit GMD3** – Another print from the .com website which consists of a catalogue of pictures of the Opponent’s products, giving product numbers, and showing the application of the Opponent’s mark on the vast majority of them. The Item codes and descriptions appearing under the products depicted are consistent with the product codes and descriptions appearing in Exhibit GMD2. To the left of the screen print the following list of terms is

shown under the heading “*Categories*”: *Art supply, Auto Body, Auto Detailing, Auto Parts, Auto Trim, Digital equipment and Office Supply, Furniture & Upholstery, Glass & Mirror, Graphic Arts, Hardware Supply, Housekeeping and Sanitary Supply, Industrial Maintenance, Instant Detail, Mass Market, Picture Framing*. This, presumably, allows browsing via category. These may in many cases overlap, and this can be seen in the duplication of products in various screen print-outs (for example, glass cleaner is listed in housekeeping and also in glass & mirror). There is no copyright date on this print; however, it was printed on 14 June 2012.

- **Exhibit GMD4** – This consists of information on sales of the Opponent’s products in the EC. It consists of a list of products, variously supplied to four customers (who are said to be distributors), in Greece, the Czech Republic (two of the distributors), and the Netherlands; I note that one of the distributors listed as being in the Czech Republic was actually invoiced by the Opponent by way of a Spanish address. There are numerous entries, each relating to a single product and containing a sales figure for 2011, and a date when last sold.
- **Exhibit GMD5** – This contains copies of ten invoices recording sales in the EC in the period March 2010 to June 2011. All but one are issued by the Opponent itself to distributors (as detailed in GMD4); the one exception is an invoice from Atécé Graphic Products to a company in the UK; the address of Atécé Graphic Products is, though, almost the same as Van Leeuwen Interweb (one of the EC distributors) so a connection seems very likely.

Findings regarding genuine use

12) The evidence filed by the Opponents is not well marshaled. It requires cross-referencing to website prints to work out what goods are being sold. Although the website prints are from after the relevant period, the largely consistent use of product codes supports the proposition that some SPRAYWAY products have been sold in the EC during the relevant period. Not all of the evidence filed supports use in the relevant period. For example, some of the invoices cover goods in other classes and there is an invoice of 5 October 2011 which falls outside the relevant period. In terms of the sales figures, several entries have no sales figure given for 2011. No sales figure are provided at all where the “last sold” date falls before 2011. The probative value of such entries is therefore low – although in one instance the gap can be supplemented by cross-referencing to other evidence. This all leaves something of a mathematical/analytical challenge; however, at the hearing Ms McGrath accepted that the mark had been used (but not necessarily genuinely used), albeit on a relatively small proportion of SPRAYWAY products, namely:

- Spot Lift Cleaner
- Solvent Degreaser
- Fusing Machine Cleaner
- Glass Cleaner
- Brake Parts Cleaner
- Eurodeer Electric Cleaner
- Clean Jet

13) The reason Ms McGrath did not accept that genuine use was established was because the total sales amounted to approximately £65,000, and this figure was not sufficient to demonstrate that the Opponent had created or maintained a share in the EC market for cleaning preparations at large (although she did say it was conceivable that relatively small sales might constitute genuine use for smaller, specialist cleaning categories, but in the absence of evidence of market share it was not possible for her to comment). Ms McGrath agreed that, for the items listed above, the invoices showed sales of products bearing the Opponent's mark. The sum I find when adding up the relevant sales shown in the invoices for these products is actually somewhat less than that mentioned by Ms McGrath at the hearing; the amount I have arrived at is approximately US \$68,900, and this is the figure on which I shall base my findings.

14) The evidence shows relevant sales in Greece, the Czech Republic, the UK, Spain (although the company concerned is listed in Exhibit GMD5 as a Czech distributor) and the Netherlands. The range and quantities supplied to the Dutch customer, Van Leeuwen Interweb BV, represent the biggest proportion of such sales. The question of whether use equates to genuine use is answered by reference to whether the use is warranted so as to maintain or create a market share for the goods in question and which necessarily depends on several factors and on a case-by-case assessment. The case-law stresses that the test for genuine use is a qualitative one rather than a quantitative one. I bear in mind that the sales made do not cover the whole of the relevant period. Having said that, being more concentrated in time at least gives them a somewhat greater significance during the period in which the sales were made. However, by any scale the sales must be regarded as low. Although the EC market for the cleaning products of the kind supplied is no doubt very large, I am satisfied that, viewing the evidence in this case as a whole, including the fact that sales have been made in a number of states, establishes that the sales of certain products constitute genuine use. Such use cannot be viewed as sham or token. The purpose of the use requirement is not to assess commercial success or to restrict trade mark protection to the case where large-scale commercial use has been made of the marks – it is whether the use is warranted so as to maintain or create market share for the goods in question.

15) The goods on which I consider genuine use to have been established are: *Spot Lift Cleaner, Solvent Degreaser, Fusing Machine Cleaner, Glass Cleaner, Brake Parts Cleaner, Eurodeer Electric Cleaner, Clean Jet*. Although some of the products represent a greater proportion of sales than others, they all still form part of the Opponent's genuine use. Whilst Ms Deas may consider that wider use is shown, I have been through the evidence very carefully. For example, there are also single instances of *Granite and Marble Cleaner, Instant Shine Polish and Stainless Steel Polish and Cleaner* appearing as items in invoices, but in each case no sale is shown for the product, and in the absence of any explanation for this, I cannot hold that they have been genuinely used.

A fair specification

16) In terms of deciding upon a fair description, the description must not be over-*pernickety*². It is necessary to consider how the relevant public would likely describe the goods³. The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 (“Aladdin”)* held:

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

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 subcategories 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

² See *Animal Trade Mark* [2004] FSR 19.

³ See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

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.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

17) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he 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 Page 23 of 68 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.”

18) The products for which I have found genuine use comprise: products for stain removal; for cleaning glass; for removing grease, oil, etc. from parts and surfaces, for cleaning brake parts; for cleaning electronic components; for removing dust and dirt with air blasts from items like computer and electronic equipment; and for cleaning fusing machines. Fusing machines, as used in producing garments, may be used in factories. The other products are all capable of being used in a variety of contexts from industrial, commercial and office use, professional or home vehicle maintenance, DIY and household cleaning. In addition to business and household use, stain removers are certainly used by laundries and would fall both under *substances for laundry use* and *cleaning preparations* in the specification of the Opponent’s mark. Glass cleaners fall under *cleaning preparations*; whilst it is possible for a glass cleaner to have a polishing function, the evidence does not demonstrate that this is the case. Like glass cleaner the rest of the goods are, effectively, cleaning preparations of one type or another. Although the information on the Opponent’s website suggests that they target businesses rather than the general public, it is the inherent properties of the goods which a fair specification should reflect. Whilst Ms McGrath argued against such a specification, I have reached the conclusion that the fair specification should read:

“cleaning preparations; substances for laundry use”

19) The breadth of the goods so used means that it would be pernicky to limit the goods only to the exact products and would unfairly strip the Opponent of appropriate protection. I do not see how it would be possible to sub-categorise the goods beyond that set out above. I consider this to be a fair specification, and for the purposes of the opposition I shall confine my comparison of the goods to this.

Section 5(2)(b)

20) Section 5(2)(b) of the Act reads:

“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.”

21) In reaching my decision I have taken into account the guidance provided by the CJEU in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(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;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

22) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

23) Cleaning preparations will be purchased both by businesses and by private consumers. For private consumers the selection of the goods is most likely to consist of a predominantly visual act made on the basis of self selection in a retail outlet such as a supermarket. Nowadays goods may also be selected from catalogues or online. Business customers are likely to buy from a trade supplier such as a wholesaler or distributor, and the catalogues and websites are likely to be those directed at the trade. Given the cost and nature of the cleaning preparations normally bought by private consumers, their attention level is likely to be fairly casual. Business consumers are more likely to purchase in bulk, so their attention level may be higher (but still no higher or lower than the norm).

Comparison of the goods

24) When “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 (*British Sugar PLC v James Robertson & Sons Ltd.* [1996] RPC 281). Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning (*Beaumatic International Ltd. V Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267). 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 (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc Case C-39/97*). Goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (*Boston Scientific Ltd v OHIM Case T-325/06*). The specification of the earlier registration must be compared with the specification of the application objectively – current marketing strategy is irrelevant (*Devinlec Développement Innovation Leclerc SA v OHIM⁴ Case T- 147/03*).

25) I will make the comparison with reference to the goods for which registration is sought by the Applicant, comparing them with the specification I have found to be justified by the evidence of use of the Opponent’s Mark, namely:

Class 3: *Cleaning preparations; substances for laundry use.*

Cleaning preparation

This falls within the *cleaning preparations* of the Opponent’s mark. The goods are identical.

Polishing preparation

Polishing preparations and *cleaning preparations* are closely related, both in nature and use, and will be so regarded by both business and private consumers. There will be a considerable overlap between users of cleaning and polishing preparations,

⁴ “104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.

107 It follows that by taking into consideration in the assessment of the likelihood of confusion between the marks the particular circumstances in which the goods covered by the earlier mark are marketed, the temporal effect of which is bound to be limited and necessarily dependent solely on the business strategy of the proprietor of the mark, the Board of Appeal erred in law.”

whether in the commercial or private sphere, and *cleaning preparations* and *polishing preparation* are likely to share the same channels of trade, whether those channels serve business or private consumers, or both. There is a fairly high degree of similarity between *polishing preparation* and *cleaning preparations*.

Cleaning preparations having anti-bacterial properties

This falls within *cleaning preparations* of the Opponent’s mark. The goods are identical under the guidance set out in *Meric*.

Scouring, bleaching and abrasive preparation


Scouring, bleaching and abrasion are all methods of cleaning in both industrial and household contexts. They therefore fall within *cleaning preparation* of the Opponent’s mark. *Bleaching preparation* also falls within *substances for laundry use*. The goods are identical.

The distinctiveness of the earlier mark

26) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). As I have already said, the scale of use of the Opponent’s Mark shown is low. I am therefore of the view that the evidence falls well short of establishing that the mark is entitled to an enhanced degree of distinctiveness by virtue of the amount of use made of it in the EU. In terms of the mark’s inherent characteristics, the word SPRAY has a descriptive quality in relation to aerosol products, but the addition of WAY creates a word which, though it may have some allusiveness, is not immediately descriptive of cleaning products. The mark has an average degree of distinctiveness.

Comparison of the marks

27) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

The Opponent’s mark	The Applicant’s Mark
<p>SPRAYWAY</p>	

28) The opponent’s Mark consists exclusively of the word SPRAYWAY which, as the sole component of the mark, constitutes its dominant and distinctive element. In the Applicant’s mark, and despite the figurative aspects it contains, the words

SPRAY AWAY constitute the dominant and distinctive component of the mark, though the other elements are not completely negligible and must be considered in the whole mark comparison.

29) Visually, the Opponent's mark consists of one word, the Applicant's mark of two, presented one on top of the other. The Opponent's mark is a simple word mark; in the Applicant's mark the words appear against a device background. However, the device is a fairly basic and simple one, and it is the words SPRAY AWAY which dominate the Applicant's mark. There is only one letter's difference between the two marks. There is a reasonably high degree of visual similarity between the marks.

30) Aurally, the A which begins AWAY in the Applicant's mark can easily be lost in pronunciation. Even where it is pronounced distinctly, the aural similarity between the two marks is high.

31) Conceptually, both marks begin with the word SPRAY, which has a descriptive character for aerosol products, though not for all cleaning products. The words SPRAY AWAY have a meaning. SPRAYWAY is less obvious, but consists of two English words which might suggest "manner of spraying". There is something of a conceptual difference, but not the strongest of ones.

Likelihood of confusion

32) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer, and determining whether they are likely to be confused.

33) The goods are identical or highly similar. I have found the marks to have a reasonably high degree of visual similarity, a high degree of aural similarity, but a conceptual difference. Lack of conceptual similarity may sometimes offset a high degree of visual and/or aural similarity,⁵ but this is not always so⁶, and I do not consider it to be the case here. I have found the Opponent's mark to possess an average degree of inherent distinctive character. Bearing all this in mind, together with my assessment of the nature of the average consumer and their purchasing process, and having regard to the interdependency principle, I consider there is a likelihood of confusion. **Accordingly, the opposition succeeds in its entirety**

⁵ *Ruiz-Picasso v OHIM*, case 36/104 P [2006] ETMR 29

⁶ See the judgment of the General Court in *Nokia Oyj v Ohim*, Case T-460/07: "Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98)."

Costs

34) The Opponent has been successful and is entitled to a contribution towards its costs. I hereby order Lakeland Limited to pay Claire Sprayway Inc the sum of £1600. This sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	£300
<i>Preparing evidence</i>	£500
<i>Preparing for and attending a hearing</i>	£600
<i>Opposition fee</i>	£200

35) The above sum should 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 27th day of February 2013

**Martin Boyle
For the Registrar,
The Comptroller-General**