

O-044-14

TRADE MARKS ACT 1994

In the matter of application no 2616826

by Duf Ltd

to register the trade mark:

PANTERA

in class 14

and

the opposition thereto under no 104072

by Cartier International AG

1) On 5 April 2012 Duf Ltd, hereinafter Duf, filed an application to register the trade mark PANTERA. The application was published for opposition purposes on 10 August 2012 for goods in classes 3, 14 and 25. Subsequent to publication the specification was limited to:

watches; wrist watches; watch straps; watch cases; parts and fittings for the aforesaid goods.

The above goods are in class 14 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 amended¹.

2) On 9 November 2012 Cartier International AG, hereinafter Cartier, filed a notice of opposition to the registration. Cartier bases its opposition on section 5(2)(b) of the Trade Marks Act 1994 (the Act), which states:

(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.

3) Proceedings are governed by the Trade Marks Act 1994 (the Act). The Act implements, inter alia, Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive) (as it is now). Consequently, interpretation of the Act is made on the basis of judgments of the Court of Justice of the European Union (CJEU) and the General Court (GC), both with their seats

¹ As per the Classification Guide of the Intellectual Property Office (IPO):

“In order to allow efficient searching of trade marks the UK uses “The International Classification of Goods and Services”, also known as the “Nice Classification”. The International Classification is administered by the World Intellectual Property Organisation (WIPO) and is used by over 140 countries throughout the world and by organisations such as The Office for Harmonization in the Internal Market (OHIM). Of these countries 78 are party to the Nice Agreement and 68, although not party to it, use the Nice Classification for their classification purposes. The system comprises 45 classes and groups together broadly similar goods or services into categories which assists the registry carrying out efficient searches of the register. Classes 1 – 34 contain goods and classes 35 – 45 contain services. It also allows businesses to check whether there are registered marks that conflict with marks they are using, or propose to use, in respect of particular goods or services. Whilst classification may be seen as an administrative tool its importance to applicants in relation to determining the boundaries of infringement rights cannot be stressed too highly. If the classification of the goods or services on an application is made incorrectly, the validity of any rights stemming from a subsequent registration might be called into question at a later date. This could result in a mark being the subject of proceedings to remove it from the register.”

in Luxembourg, as well as those of the courts in the United Kingdom. All of the judgments of the GC (previously the Court of First Instance) and the CJEU can be found at the url:

<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

Judgments preceded by the letter C are from the CJEU and judgments preceded by the letter T are from the GC. The former is the higher court.

Decisions of the appointed persons, who are one of the two fora for appeal from decisions of the registrar, can be found on the website of the Intellectual Property Office at the url:

<http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results.htm>

Decisions of the appointed persons can be identified by the prefix BL (decisions of the registrar also have this prefix). (The other fora of appeal are the High Court of England and Wales, the High Court of Northern Ireland and the Court of Session (in Scotland).)

Where available the urls for judgments of the courts of England and Wales have been given.

The acronyms RPC, FSR and ETMR refer to Reports of Patent, Design and Trade Mark Cases, Fleet Street Reports and European Trade Mark Reports respectively. These are publications in which various decisions and judgments are reported.

4) Cartier relies upon United Kingdom trade mark registration no 1307144 of the trade mark PANTHERE. The application was filed on 13 April 1987 and the registration procedure was completed on 31 August 1990. The trade mark is registered for:

precious metals and their alloys; articles made of precious metals or coated therewith; jewellery; precious stones; horological and chronometric instruments; all included in Class 14; but not including any such goods in the shape of or bearing representation of felidae, or table lighters for smokers or parts and fittings therefor.

5) On 21 January 2013 Duf filed a counterstatement. Duf's case has been prosecuted by Mark Duffy, a designer. From a witness statement filed on behalf of Duf and correspondence on the opposition file, Mr Duffy appears to be the controlling mind of Duf. In the counterstatement, Mr Duffy denies that his trade mark is similar to "PANTHERE DE CARTIER"². He submits that Cartier is a

² Cartier does not rely upon such a trade mark but upon the trade mark PANTHERE.

luxury brand. Mr Duffy submits that PANTHERE is the French for panther but that PANTERA is the Spanish for panther. Mr Duffy submits:

“I DONT SEE HOW CARTIER CAN CLAIM TO OWN RIGHTS TO A WORD TRANSLATED INTO A DIFFERENT LANGUAGE: THERE ARE MANY REGISTERED TRADE MARKS MORE SIMILAR TO THEM THAN MY APPLICATION. MY PRODUCTS ARE “FASHION” AND SOLD IN A DIFFERENT MARKETPLACE TO CARTIER, SO THERE IS ABSOLUTELY NO CHANCE OF ANY CONFUSION.”

6) Under section 6(A) of the Actⁱ, as the trade mark of Cartier had been registered for more than five years at the date of the publication of Duf’s application, Duf could have requested proof of genuine of the trade mark. In its statement, Cartier claimed that in the period from 11 August 2007 to 10 August 2012 (the material five year period), it had made genuine use of its trade mark in respect of all of the goods for which it is registered. Duf did not request proof of genuine use of Cartier’s trade mark when it filed its counterstatement. In the time allotted Cartier did not file any evidence; as it is relying upon an earlier registered trade mark there was no necessity for it to file evidence. On 4 July 2013 Mr Duffy sent an e-mail to the Trade Marks Registry (TMR) advising that he now wanted Cartier to prove genuine use of its trade mark. On 5 July 2013 the TMR replied to Mr Duffy. In the reply Mr Duffy was advised that:

“A colleague has noted your telephone call of 15 May 2013, in which you were advised that a request could be made that the opponent provide proof of use but that any such request should contain full reasons and would not automatically be granted. No request for proof of use has to date been received by the Registry.”

7) In the official letter of 16 July 2013 granting an extension of time to Duf, Duf was advised that if it wanted Cartier to prove proof of use of its trade mark it would be necessary to make the request in writing with full reasons. On 9 August 2013 the TMR received a letter dated 2 August 2013 from Duf in which it was requested that Cartier prove use of its trade mark. The body of the letter reads as follows:

“On the 14th of May 2013 my trade mark agent (Mike Freeman of Novagraff) advised me that I should have requested evidence on my TM8 form dated 21/01/2013. You said I could retrospectively apply to request evidence, if I wrote to you.

From that time up until I submitted my TM9R, I had been led to believe that Cartier by their UK agent would agree to a co-existence of the trade mark they claim they have been using, although not identical. In satisfying the other opposition ie: Slazengers, the trade mark had been stripped to the bone of classes also, which I believed would also help.

Cartier have now decided that they are not willing to settle this matter.

Therefore I request “retrospective proof of use”.

On 14 August 2013 the TMR responded to the request in these terms:

“The Registry has noted your application for leave to request proof of use from the opponent. It is the preliminary view of the Registrar to refuse the request. As the opponent has indicated that it does not wish to file evidence, it would be inappropriate to allow you to revisit the form TM8 and start the proceedings again.”

8) Duf was advised that if it disagreed with the preliminary view it could request a hearing. In an e-mail to the TMR dated 3 September 2013, Mr Duffy disagreed with the preliminary view expressed in the letter of 14 August 2013. The TMR responded on 4 September 2013 and the following was included in the response:

“Your request for proof of use was considered and it was decided that it would not be appropriate to allow your request at this late stage in the proceedings.

I appreciate your unhappiness with the decision however, as I have previously informed you, if you wish to challenge the preliminary view issued on 14 August 2013 then you must do so by requesting a hearing otherwise the proceedings will advance to the next step.”

On the same day, following a further e-mail from Mr Duffy, the TMR again advised him that he could request a hearing to challenge the preliminary view. He was advised that the hearing would be by telephone.

9) On three occasions Mr Duffy was advised that he could request a hearing to challenge the preliminary view of the TMR re the request for proof of use. He was advised that the hearing would take place by telephone; so limiting any inconvenience to him. The hearing officer may have come to a different conclusion but this cannot be known as Duf did not avail himself of this right and, consequently, the preliminary view must stand. (If Duf had availed himself of this opportunity it would also have had the right to appeal against the decision of the hearing officer if it disagreed with it.)

10) Consequent, upon the rejection of the late request for proof of use and the absence of a challenge to this through the means of a hearing, the trade mark of Cartier must be taken into account in respect of all of the goods for which it is registered.

11) Only Duf filed evidence. This consists of a witness statement by Mr Duffy. Neither party requested a hearing. Cartier filed written submissions. The written submissions included an attachment with dictionary definitions of foreign words.

If Cartier wished this to be considered it should have filed it as evidence. No cognisance is taken of this attachment.

Evidence of Duf

12) Mr Duffy states that the trade mark of Cartier was not raised as a notification in the examination report. Whether an earlier trade mark has been raised in an examination report cannot have a bearing upon a finding in opposition proceedings; the report simply represents the view of one examiner. An opposition has to be considered on the basis of the claims of the parties and the evidence submitted within the parameters of the law, both statute and case.

13) Mr Duffy refers to the issue of proof of use of the earlier trade mark. This issue has been dealt with above.

14) Mr Duffy states that PANTHERE is a style name given to a watch made by Cartier. He states that he has not been able to find PANTHERE appearing upon the watch. If Cartier had been required to prove proof of use, the use would not have had to be on the watch but in relation to the watch. As Cartier has not been put to proof of use, the trade mark of Cartier must be considered as it is registered and for the full panoply of goods for which it is registered.

15) Mr Duffy refers to PANTERA and PANTHERE as being the Spanish and French words meaning panther. It is necessary to consider the average consumer for the goods in the United Kingdom and the average consumer is not going to know that these are foreign words or what their meaning is. If the average consumer was aware of the meaning, this would be in favour of Cartier as it would give rise to conceptual similarity (see below). In its written submissions Cartier makes reference to the Registry's practice in relation to words in Italian, Spanish and French. This practice relates to absolute grounds of objection and not relative grounds. It in no way relates to the perception of the average consumer.

16) Mr Duffy states that Cartier is a luxury watch brand, whose watches cost £2,500 and upwards whilst Duf's watches retail for between £60 and £200. The watches, he states, will be bought by very different customers and will never be displayed in shops side-by-side. The comparison that is to be made for the purposes of section 5(2)(b) of the Act is mark to mark, goods to goods; the current or proposed marketing strategies of the parties is not pertinent to the consideration. The GC stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05*:

"71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when

determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely 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 of the trade mark proprietors – whether carried out or not – which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

The same reasoning can be seen, inter alia, in *Phildar SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-99/06, *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-116/06, *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 147/03, *Sadas SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-346/04 and *Daimlerchrysler AG v Office for Harmonization In the Internal Market (Trade Marks and Designs) Case T-358/00*.

Average consumer and the purchasing process

17) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”ⁱⁱ. 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 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.”

18) Watches and watch accessories, in retail establishments, will normally be on display with signs identifying the brand. They may also be bought via the Internet and catalogues. In all these circumstances visual similarity will be of greater importance than aural similarity.

19) In *Adelphoi Limited v DC Comics (a general partnership)* BL O/440/13 Professor Annand, sitting as the appointed person stated

“21. As for the services, e.g., broadcasting, whilst I agree with Mr. Malynicz that the average consumer would include business consumers or professionals as well as the general public, the likelihood of confusion must be assessed in relation to the part of the public whose attention is lower (see e.g., Case T-448/11, *Golden Balls Ltd v. OHIM*, 16 September 2013, para. 26), although in any event, the Hearing Officer relied on an average consumer (reasonably well informed and reasonably circumspect and observant) paying an average level of attention (para. 41).”

20) The average consumer for the goods of the application is the public at large. The cost of the goods will vary widely and, consequently, the degree of care in the purchasing process. However, the purchasing process, even for the cheapest watches, is likely to be relatively considered. *Watch straps* are likely to be purchased with less care than *watches*.

Comparison of goods

21) 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 tradeⁱⁱⁱ”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^{iv}. Consideration should be given as to how the average consumer would view the goods and services^v. In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch)^{vi} Floyd J stated:

“12. There are sound policy reasons for this. Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning

are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

The class of the goods in which they are placed may be relevant in determining the nature of the goods^{vii}. 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^{viii}. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{ix}. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the General Court (GC) explained when goods are complementary:

“82 It is true that 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

Consideration is also taken into account of the decision of Mr Daniel Alexander QC, sitting as the appointed person, in *Sandra Amalia Mary Elliott v LRC Products Limited* BL O/214/13^x.

22) *Horological and chronometric instruments* encompass all types of time pieces in the class. **Consequently, watches and wrist watches are included in the goods of the earlier registration and so are identical to those goods.**

23) The other goods of the application are inextricably linked to watches. They will have the same channels of trade as *watches*. The end user will be the wearer and buyer of *watches*, they have the same end users. There is a close connection between the remaining goods and *horological and chronometric instruments* in that they are indispensable to each other, so the customers will think that the responsibility for the goods lies with the same undertakings. **Watch straps; watch cases; parts and fittings for the aforesaid goods are highly similar to horological and chronometric instruments.**

Comparison of trade marks

24) The trade marks to be compared are PANTHERE and PANTERA.

25) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{xi}. 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^{xii}; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

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^{xiii}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xiv}.

26) Neither trade mark readily divides into constituent parts. However, the consumer's attention is normally directed to the beginnings of words or trade marks^{xv}. There is nothing in the trade marks to gainsay this rule of thumb. The respective trade marks start with the same four letters. They each contain the letters er in the same sequence. One has eight letters and the other seven. There is, overall, a good deal of visual similarity. The respective trade marks will share the same pronunciation of the pan elements. The first four letters could be pronounced in the same fashion as pant. However, the t of Cartier's trade mark could form part of a th sound as in panther. The final three letters of Cartier's trade mark could be pronounced either as in here or as in there. The final three letters of Duff's trade mark could be pronounced with a strong e, as in ear; or with a soft e as in error. As for the average consumer in the United Kingdom, the respective trade marks will be invented words, there can be no prescriptive approach to the pronunciation. In these circumstances, the aural comparison must include that which brings the trade marks closer ie Cartier's trade mark would be pronounced as the words pant and here and Duff's as the words pant and era. In such circumstances there is a good deal of aural similarity between the trade marks.

27) As has been noted, for the average consumer the respective trade marks will be invented words and so the position of conceptual similarity or dissimilarity is neutral. **Overall, there is a good deal of similarity between the respective trade marks.**

Likelihood of confusion

28) 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^{xvi}. 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^{xvii}. 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 trade mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings^{xviii}. For the average consumer PANTHERE is an invented word; it neither describes nor alludes to the goods of the registration. It has a reasonable degree of inherent distinctiveness.

29) It is necessary to consider 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^{xix}. The respective goods are either identical or highly similar. The GC in *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-505/11* stated:

“91 In addition, the Opposition Division considered that the goods at issue were identical, as was recalled in the contested decision, without the Board of Appeal’s taking a final decision in that regard (see paragraph 40 et seq. above). That implies, in accordance with the case-law cited at paragraph 23 of the present judgment, that, if there is to be no likelihood of confusion, the degree of difference between the marks at issue must be high (see, to that effect, judgment of 29 January 2013 in Case T-283/11 *Fon Wireless v OHIM – nfon (nfon)*, not published in the ECR, paragraph 69).”^{xx}

Owing to the nature of the trade marks, this is not a case where the considerations in *Meda Pharma GmbH & Co KG c Office de l’harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI) les affaires jointes T-492/09 et T-147/10* comes into play; ie the trade mark of Cartier does not have a limited degree of distinctiveness^{xxi}.

30) As neither trade mark has a meaning there is no conceptual hook for the consumer to rely upon; this will increase the effects of imperfect recollection.

31) The respective trade marks enjoy a good deal of similarity.

32) Bearing in mind all of these factors, there is a likelihood of confusion and the application is to be refused under section 5(2)(b) of the Act.

Costs

33) Cartier, having been successful, is awarded costs upon the following basis:

Preparing a statement and considering the statement of Duf:	£200
Opposition fee:	£200
Written submissions and considering the evidence of Duf:	£200
Total:	£600

34) Duf Ltd is ordered to pay Cartier International AG the sum of £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 27th day of January 2014

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

ⁱ 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.

(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).”

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

ⁱⁱⁱ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^{iv} *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^v *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:

“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”

The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWCA/Civ/2002/1828.html>

^{vi} The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWHC/Ch/2012/3158.html>

^{vii} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34. The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWCA/Civ/2001/1928.html>

^{viii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{ix} 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.”

^x “17. First, the starting point for the analysis of similarity is the wording of the Act and the Directive. These require the tribunal to determine whether or not the respective goods are “identical or similar” but they do not specify the criteria by reference to which similarity is to be assessed. In the well-established guidance from the Court of Justice on this issue originating in *Canon*, to which the Hearing Officer referred, the Court has not suggested that every case requires assessment of whether the respective goods or services are complementary. To the contrary, the Court has regularly made it clear that all relevant factors relating to the goods or services themselves should be taken into account, of which complementarity is but one (see e.g. in *Boston*).

18. Second, the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in *Boston* as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.

19. Third, the Hearing Officer said at [32]:

As stated above, the legal definition of ‘complementary’, as per *Boston*, is that the goods must be “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”. It is not sufficient that the goods “can” be used together; nor is it sufficient that they are sold together.

20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.

21. Moreover, it is necessary to view the quotation from *Boston* in the context of the facts of that case where the dispute over similarity turned in part on whether the goods were used together for a rather specific medical procedure. The Court of First Instance said at [77]-[87]:

Similarity between the products

77 According to consistent case-law, in order to assess the similarity of the products or services concerned, all the relevant features of the relationship that might exist between those products or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*Sunrider v OHIM*, paragraph 27 above, paragraph 85; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM - Gómez Frías (euroMASTER)*, paragraph 31).

78 As regards the assessment of the similarity of the goods at issue, the Board of Appeal found, in paragraphs 22 to 24 of the contested decision, that, owing to their functional differences, apparatus for placing a suture, on the one hand, and hollow fiber oxygenators with detachable hard-shell reservoir, on the other hand, have a different method of use, are not in competition with each other and are not interchangeable. However, the Board found, in essence, that the goods at issue were closely linked to the goods of the intervener in so far as they had a certain complementary character, since they could be used simultaneously in the field of medicine, for example during surgery. They might also be purchased through the same distribution channels and be found in the same points of sale, so that the relevant public could be led to believe that they came from the same undertaking.

79 Those findings must be upheld.

80 In this respect, it must be noted that the goods bearing the earlier trade mark and those covered by the mark applied for both concern the medical field and are therefore intended to be used in the context of a therapeutic treatment.

81 In addition, as the Board of Appeal rightly pointed out, all the goods covered by the mark applied for have a certain complementary relationship with those bearing the earlier trade mark.

82 It is true that 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM - Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM - Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).

83 It is also true that, as OHIM moreover acknowledged, apparatus for placing a suture cannot be considered to be indispensable or important for the use of hollow fiber oxygenators with detachable hard-shell reservoir.

84 However, it is clear that apparatus for placing a suture and hollow fiber oxygenators with detachable hard-shell reservoir can be considered to be complementary where, in surgery which has required an incision and during which an oxygenator has been used, the surgeon uses apparatus for placing a suture. Thus, in the course of a single, very specific procedure, namely a surgical operation, two apparatus, namely an oxygenator and apparatus for placing a suture, might be used, one bearing the trade mark CAPIOX and the other the trade mark CAPIO.

85 It follows that, even though the applicant claims that the goods at issue cannot be considered to be similar simply because they are both used in the field of medicine, which, according to the applicant, is the case of nearly all goods of significance, the goods at issue are similar because they are in fact in a certain complementary relationship and specifically target certain professionals in the medical sector. In addition, in the present case, contrary to what the applicant claims, the goods at issue are not similar solely because they are used in the field of medicine, but because they could be used in the same, very specific surgical operation, namely open-heart surgery.

86 Finally, the products at issue can in fact be found in the same distribution channels, such a criterion being relevant for the purposes of the assessment of the similarity of the goods (*PiraÑAM diseño original Juan Bolaños*, paragraph 82 above, paragraph 37; see also, to that effect, *SISSI ROSSI*, paragraph 82 above, paragraph 65; and *PAM PLUVIAL*, paragraph 82 above, paragraph 95).

87 Accordingly, given the close link between the products in question as regards their end users, the fact that they are to some extent complementary and the fact that they may be distributed via the same distribution channels, the Board of Appeal was right to find that the applicant's goods and those of the intervener were similar (see, to that effect, Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 56).

22. The Court of First Instance was not attributing decisive importance to the question of whether the goods in that case were complementary in determining the overall question of whether they were similar.

23. In the present case, because of the way in which the case was presented to the Hearing Officer, the issue of whether the goods were complementary assumed excessive importance which may have diverted the Hearing Officer's attention from other, no less important, considerations in the evaluation of similarity. That requires me on this appeal to scrutinize the approach taken by the Hearing Officer in considering the evidence by reference to the test of similarity more closely than would ordinarily be warranted by the REEF principles on an appeal of this kind.£

^{xi} *Sabel BV v Puma AG* Case C-251/95.

^{xii} *Sabel BV v Puma AG* Case C-251/95.

^{xiii} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{xiv} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xv} *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-336/03:

“75 It should be noted in this regard that the attention of the consumer is usually directed to the beginning of the word (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-0000, paragraph 83).”

^{xvi} *Sabel BV v Puma AG* Case C-251/95.

^{xvii} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xviii} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.

^{xix} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97.*

^{xx} In *Fon Wireless Ltd c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* l'affaire T-283/11 the GC stated :

« 67 Il convient de rappeler que le risque de confusion doit être apprécié globalement, selon la perception que le public pertinent a des signes et des produits ou des services en cause, et en tenant compte de tous les facteurs pertinents en l'espèce, notamment de l'interdépendance entre la similitude des signes et celle des produits ou des services désignés (voir arrêt *GIORGIO BEVERLY HILLS*, précité, points 30 à 33, et la jurisprudence citée). Ainsi, un faible degré de similitude entre les produits ou les services désignés peut être compensé par un degré élevé de similitude entre les marques, et inversement [arrêt de la Cour du 29 septembre 1998, *Canon*, C-39/97, Rec. p. I-5507, point 17, et arrêt *VENADO* avec cadre e.a., précité, point 74].

68 En l'espèce, comme indiqué au point 39 ci-dessus, il y a lieu de confirmer le constat de la chambre de recours selon lequel les produits et les services désignés par les marques antérieures et par la marque demandée sont hautement similaires s'agissant des produits relevant de la classe 9, et identiques s'agissant des services relevant de la classe 38.

69 Ce constat implique, conformément à la jurisprudence citée au point 67 ci-dessus, que le degré de différence entre les marques en conflit doit être élevé pour éviter un risque de confusion. Or, ainsi qu'il ressort du point 62 ci-dessus, il existe un degré de similitude visuelle et phonétique élevé et un certain degré de similitude conceptuelle entre les marques en conflit. »

^{xxi} «50 La requérante soutient que, en cas d'identité de produits, il est nécessaire, pour exclure tout risque de confusion, que les signes présentent une plus grande différence que dans une situation où l'écart entre les produits est important. Or, dans les circonstances de l'espèce où l'identité des produits n'est pas contestée, la chambre de recours aurait dû conclure au risque de confusion, à l'instar de ce qui a été considéré dans la décision R 734/2008-1 de la première chambre de recours de l'OHMI, du 14 septembre 2009 (*Alleris et Allernil*). Selon la requérante, plusieurs décisions de l'OHMI démontrent que les décisions attaquées s'écartent de la pratique décisionnelle de l'OHMI, ce qui viole les principes d'égalité et de non-discrimination.

51 Il ressort de la jurisprudence que l'OHMI est tenu d'exercer ses compétences en conformité avec les principes généraux du droit de l'Union. Si, eu égard aux principes d'égalité de traitement et de bonne administration, l'OHMI doit prendre en considération les décisions déjà prises sur des demandes similaires et s'interroger avec une attention particulière sur le point de savoir s'il y a lieu ou non de décider dans le même sens, l'application de ces principes doit toutefois être conciliée avec le respect du principe de légalité. Au demeurant, pour des raisons de sécurité juridique et, précisément, de bonne administration, l'examen de toute demande d'enregistrement doit être strict et complet afin d'éviter que des marques ne soient enregistrées de manière indue. C'est ainsi qu'un tel examen doit avoir lieu dans chaque cas concret. En effet, l'enregistrement d'un signe en tant que marque dépend de critères spécifiques, applicables dans le cadre des circonstances factuelles du cas d'espèce, destinés à vérifier si le signe en cause ne relève pas d'un motif de refus [voir, en ce sens, arrêt de la Cour du 10 mars 2011, *Agencja Wydawnicza Technopol/OHMI*, C-51/10 P, non encore publié au Recueil, points 73 à 77, et la jurisprudence citée, et arrêt du Tribunal du 22 novembre 2011, *LG Electronics/OHMI (DIRECT DRIVE)*, T-561/10, non publié au Recueil, point 31).

52 Or il apparaît que, dans la présente affaire, la chambre de recours a correctement pris en compte les circonstances de l'espèce. À cet égard, elle a, à juste titre, constaté l'identité des produits concernés en l'espèce, elle a aussi retenu une similitude très faible des signes en cause sur les plans phonétique et visuel et une impossibilité de comparaison de ces mêmes signes sur le plan conceptuel, comme il ressort des points 40, 41 et 46 ci-dessus. Dès lors, comme le soutient à juste titre l'OHMI, l'identité entre les produits désignés est compensée par un très

faible degré de similitude entre les signes en cause et la chambre de recours a pu conclure à bon droit à l'absence de tout risque de confusion, d'autant que le degré d'attention du public est accru et qu'il n'est pas démontré que la marque antérieure présente un caractère distinctif élevé."