

O-109-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2604461
BY OVER THE MOON DESIGN LTD
TO REGISTER THE FOLLOWING TRADE MARK
IN CLASSES 9, 14, 16, 18, 21, 24, 25, 26 & 28:**



AND

OPPOSITION THERETO (NO. 103221) BY PIP STUDIO HOLDING BV

The background and the pleadings

1) The trade mark the subject of this dispute was filed by Over The Moon Design Ltd (“the applicant”) on 14 December 2011 and was published in the Trade Marks Journal on 20 January 2012. The mark and the goods for which registration is sought are:



Class 9: Scientific, nautical, cinematographic, optical, weighing, measuring, signalling, supervision, life-saving and teaching apparatus and instruments; recording discs; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; downloadable electronic publications; compact discs; digital music; computer games equipment adapted for use with an external display screen or monitor; mouse mats; mobile phone accessories; spectacles and sunglasses.

Class 14: Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.

Class 16: Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; packaging materials; printed publications; paint boxes for children.

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.

Class 24: Textiles and textile goods; bed and table covers; travellers' rugs, textiles for making articles of clothing; duvets; covers for pillows, cushions or duvets.

Class 25: Clothing, footwear, headgear.

Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; badges for wear; tea cosies.

Class 28: Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; childrens' toy bicycles

2) Registration of the mark is opposed by Pip Studio Holding BV (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). It claims that there is a likelihood of confusion between the applied for mark and its marks. The opponent relies on two trade mark registrations, namely:

i) Community Trade Mark (“CTM”) registration 4452579 for the mark **PIP STUDIO** which was filed on 20 June 2005 and which completed its registration process on 6 October 2006. The mark is registered for the following goods:

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; books and magazines; diaries; bookbinding material; covers for diaries and organisers, not included in other classes; stationery and office requisites, not included in other classes, including notebooks; writing instruments, including pens, pencils and felt-tip pens; ringbinders, folders and files (office requisites); adhesive materials for household purposes; labels (not of textile); pencil cases, pencil boxes, pencil sharpeners, erasers, rulers, pads, memo boards and desk pads (office requisites); cards (not included in other classes); stickers; paintings; posters; picture postcards; photographs; artists' materials; paint brushes; instructional and teaching material (except apparatus).

Class 18: Bags and rucksacks; suitcases; purses, wallets, key cases; leather and imitations of leather, and goods made of these materials and not included in other classes; umbrellas; parasols.

Class 21: Household or kitchen containers and utensils (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Given its filing date, the mark constitutes an earlier mark as defined by section 6 of the Act. Given the date the registration process was completed, the proof of use provisions set out in section 6A¹ of the Act are applicable because the earlier mark had been registered for five years or more as of the date of publication of the applied for mark. The opponent made a statement of use that the mark has been used in respect of all the goods for which it is registered. The relevant period for proof of use is 21 January 2007 to 20 January 2012.

ii) International registration (“IR”) 1057185 for the mark **PIP** which designated the EU for protection on 6 August 2010 with protection being conferred on 23 September 2011. The mark is protected for the following goods:

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; books and magazines; diaries; bookbinding material; covers for diaries and organisers, not included in other classes; stationery and office requisites, not included in other classes, including notebooks; writing instruments, including pens, pencils and felt-tip pens; ringbinders, folders and files (office requisites); adhesive materials for household purposes; labels (not of textile); pencil cases, pencil boxes, pencil sharpeners, erasers, rulers, pads, memo boards and desk pads (office requisites); cards (not included in other classes); stickers; paintings; posters; picture postcards; photographs; artists' materials; paint brushes; instructional and teaching material (except apparatus).

Class 18: Bags and rucksacks; suitcases; purses, wallets, key cases; leather and imitations of leather, and goods made of these materials and not included in other classes; umbrellas; parasols.

Class 21: Household or kitchen containers and utensils (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class 24: Textiles and textile goods, not included in other classes; household textiles; bed linen, including duvet covers, fitted sheets, sheets and pillowcases; covers for cushions; blankets and bedspreads; quilts; travel rugs; table cloth, table covers and napkins; bath linen, including towels, bath sheets and washing mitts; furniture covers including throws; furnishing fabrics, curtains and curtain fabrics, wall covering.

¹ The provisions provide, in summary, that an earlier mark which has been registered for five years or more (measured at the date on which the new trade mark was published in the Trade Marks Journal) may only be relied upon to the extent to which it has been genuinely used.

Class 25: Clothing, including nightwear, lingerie; footwear, headgear.

Given the date of EU designation, the mark constitutes an earlier mark as defined by section 6 of the Act. Given the date that protection was conferred, the proof of use provisions are not applicable because protection had been conferred only four months before the applicant's mark was published, not the required five years or more. The consequence of this is that this earlier mark may be relied upon in these proceedings for the goods set out above.

3) The applicant filed a counterstatement denying that there is a likelihood of confusion. A number of reasons are given for the defence, including that the applied for mark consists of a longer phrase and has a device element which creates a different concept overall. The applicant also put the opponent to proof of use; this, obviously, can only relate to the earlier mark (**PIP STUDIO**) which is subject to the requirement to prove genuine use.

4) Both sides filed evidence, the applicant also filed written submissions in response to the opponent's evidence. Neither side requested a hearing. The opponent filed written submissions in lieu of attending a hearing, the applicant did not. I will, of course, take into account all of the arguments that have been made in the papers before me. Two earlier marks are relied upon. I will deal initially with the earlier mark which is not subject to the requirement to show genuine use, namely IR 1057185 for the mark **PIP**.

The evidence

5) Evidence has been given by:

- i) For the opponent, Ms Anke van der Endt, the opponent's founder.
- ii) For the applicant, Ms Karen Bendy, the applicant's creative director.

6) The evidence details, essentially, the use made by the respective parties of its marks (although the applicant's use primarily concerns an earlier version of its mark **PIP & CO**). I can see two primary areas in which the parties' evidence may have potential relevance. Firstly, the opponent's use could enhance the distinctive character of its earlier mark which, as will become apparent, has an impact on the likelihood of confusion. Secondly, given that both parties have made some use of their marks (or an earlier version of it), it could potentially demonstrate that there has been confusion free parallel trading which, in turn, could be indicative that there is no likelihood of confusion; Ms Bendy makes a claim, of sorts, to this in her evidence. I will come back to these two points later and discuss the evidence that has been filed at that point.

7) Both witnesses have also commented upon a previous dispute concerning the applicant's previous trade mark **PIP & CO**. The opponent opposed this and, in

summary, the applicant gave up on the mark. However, Ms Bendy claims that the opponent agreed “that we could use the word mark MY CAT PIP and objected to the fact that we had not adopted the word mark MY CAT PIP, when we have applied to register a logo which incorporates additional material”; Ms Bendy cannot understand why the opponent is now claiming that there is a likelihood of confusion. Ms van der Endt comments on this. She states that whilst the parties had been discussing matters to resolve the dispute, the opponent has at all times told the applicant that its concern lies with the prominence of the word PIP. It states that it never saw the trade mark the subject of this dispute before it was filed and it has not stated that this mark should be used.

8) I highlight the above evidence because it is possible, in certain circumstances, for agreements between parties to give rise to an estoppel, preventing certain action (including lodging an opposition) from being taken. The applicant has not put it as clearly as this, but given that it is now without legal representation and given that its comments are of a similar nature, I am prepared to give my views on the matter. In my view, no form of estoppel arises. The exact nature of any agreement has not been put in evidence. From the basic facts that have been presented, it is clear that whatever was agreed was not based on the trade mark before me. Furthermore, if the agreement related to “use”, as opposed to registration, this will have no impact on the ability of the opponent to lodge an opposition – use of a trade mark and the registration of a trade mark are quite different matters. **There is no form of estoppel in these proceedings.** I do not see what else can be taken from this aspect of the evidence in terms of the matters that need to be determined – I will say no more about it.

Section 5(2)(b) – the legislation and the leading case-law

9) 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.”

10) The Court of Justice of the European Union (“CJEU”) has issued a number of judgmentsⁱ which provide guiding principles relevant to this ground. 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 notional assessment

11) For the benefit of the applicant, who no longer has legal representation, it is worth making a point of clarification. There is no requirement for the opponent to have made use of its mark. The earlier mark I am dealing with is not subject to the proof of use provisions. The opponent is able to rely on it for the breadth of goods for which it is registered. The test, essentially, is to consider the notional use of the earlier mark for its goods and to consider the notional use of the applied for mark for its goods, and to then decide whether the average consumer would be confused as to the economic origin of the goods sold under the respective marks.

The average consumer

12) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods can vary, depending on what is involved. A broad range of goods are involved in the dispute before me. Rather than go through them here, I will discuss the goods and the impact this will have on the identification and level of attention of the average consumer when considering whether there exists a likelihood of confusion in relation to the respective goods applied for.

Comparison of the goods

13) When making the comparison, all relevant factors relating to the goods in the 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."

14) 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.”

15) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

“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).”

16) In relation to complementarity, I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying to rigid a test:

“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*.”

17) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “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 the trade”² and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning³. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... 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.”

18) I will go through the applied for goods class by class (although not necessarily in the order filed), and, if necessary, term by term:

19) The applicant seeks registration for the following class 25 goods:

Class 25: Clothing, footwear, headgear.

The earlier mark covers:

Class 25: Clothing, including nightwear, lingerie; footwear, headgear.

20) The fact that the specification of the earlier mark lists specific items which are included within the term “clothing” does not limit the specification to only those items. The use of the word “including” means that the listed items are just examples and are not to be regarded as exhaustive. Consequently, the earlier

² See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

³ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

mark covers all clothing and is, therefore, identical to the applicant's term "clothing". Both specifications also cover footwear and headgear and are, therefore, also identical. **My finding is that all of the applied for goods in class 25 are identical to goods covered by the earlier mark.**

21) The applicant seeks registration for the following class 16 goods:

Class 16: Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; packaging materials; printed publications; paint boxes for children.

The earlier mark covers:

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; books and magazines; diaries; bookbinding material; covers for diaries and organisers, not included in other classes; stationery and office requisites, not included in other classes, including notebooks; writing instruments, including pens, pencils and felt-tip pens; ringbinders, folders and files (office requisites); adhesive materials for household purposes; labels (not of textile); pencil cases, pencil boxes, pencil sharpeners, erasers, rulers, pads, memo boards and desk pads (office requisites); cards (not included in other classes); stickers; paintings; posters; picture postcards; photographs; artists' materials; paint brushes; instructional and teaching material (except apparatus).

22) The majority of the applied for terms have identically worded counterparts in the specification of the earlier mark. The only terms that have no identically worded counterpart are: adhesives for stationery purposes, packaging materials, printed publications and paint boxes for children. However, adhesives for stationery purposes would be covered by the earlier mark's term stationery so the goods can be considered identical on this basis; the goods would also be similar to the highest possible degree to the earlier mark's adhesives for household purposes. Packaging materials would be covered by paper/cardboard goods covered by the earlier mark, and would also likely be covered by stationery, so, again, the goods may be considered identical. Printed publications would fall within the ambit of printed matter and paint boxes within artists' materials so both of these terms are also identical. **My finding is that all of the applied for goods in class 16 are identical to goods covered by the earlier mark.**

23) The applicant seeks registration for the following class 24 goods:

Class 24: Textiles and textile goods; bed and table covers; travellers' rugs, textiles for making articles of clothing; duvets; covers for pillows, cushions or duvets.

The earlier mark covers:

Class 24: Textiles and textile goods, not included in other classes; household textiles; bed linen, including duvet covers, fitted sheets, sheets and pillowcases; covers for cushions; blankets and bedspreads; quilts; travel rugs; table cloth, table covers and napkins; bath linen, including towels, bath sheets and washing mitts; furniture covers including throws; furnishing fabrics, curtains and curtain fabrics, wall covering

24) The applied for “textiles and textile goods” has an identical counterpart in the specification of the earlier mark as does the applied for “table covers”. “Bed covers” fall within the ambit of multiple terms in the earlier mark (bed linen, household textiles, blankets, bedspreads) so are to be considered identical. The applied for “travellers' rugs” are covered by the earlier “travel rugs”. The applied for “textiles for making articles of clothing” are covered by the broad term “textiles” of the earlier mark so are considered to be identical. The applied for “duvets” represents the same product as a “quilt” so are considered identical. Covers for pillows, cushions or duvets have similarly worded, but essentially identical, counterparts in the specification of the earlier mark. **My finding is that all of the applied for goods in class 24 are identical to goods covered by the earlier mark.**

25) The applicant seeks registration for the following class 21 goods:

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.

The earlier mark covers:

Class 21: Household or kitchen containers and utensils (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

26) Again, most of the applied for terms have identical counterparts in the specification of the earlier mark. In relation to the applied for “articles made of ceramics, glass, porcelain or earthenware” this would fall within or be highly similar to “unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes” and also the earlier “household containers” would cover such goods. In relation to the applied for “electric and non-electric toothbrushes” such goods would fall within the term “brushes” of the earlier mark (which cover all brushes including those for the

teeth) and would also be covered by “articles for cleaning purposes” (which cover all types of cleaning items, including items for cleaning the teeth). **My finding is that all of the applied for goods in class 21 are identical to goods covered by the earlier mark.**

27) The applicant seeks registration for the following class 18 goods:

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.

The earlier mark covers:

Class 18: Bags and rucksacks; suitcases; purses, wallets, key cases; leather and imitations of leather, and goods made of these materials and not included in other classes; umbrellas; parasols.

28) The applied for “leather and imitations of leather”, “rucksacks”, “purses”, “umbrellas”, “parasols” have direct counterparts in the specification of the earlier mark and so are identical. In relation to “animal skins, hides” one primary form of such goods would be leather skins/hides so they fall within the ambit of the earlier mark’s “leather and leather goods”. **The goods are therefore considered identical.** Even for animal skins/hides which are not of leather, there will still be a high degree of similarity as all forms of animal skins or hides will be of a similar nature, will share similar purposes and may be sold through the same trade channels.

29) In relation to the applied for “trunks”, such items are for carrying personal belongings. As such, they are similar in purpose, nature, trade channels, methods of use etc. to suitcases. **The goods are, thus, similar to a very high degree.** In relation to “travelling bags” and “handbags”, both these terms fall within the ambit of “bags” in the specification of the earlier mark and are to be considered identical.

30) In relation to walking sticks, the closest goods appear to be umbrellas and parasols as they are all long stick-like devices with handles. However, the purpose of the goods is quite different and umbrellas/parasols are much more complex in nature. I consider that the goods are similar to only a low degree. In relation to “whips, harness and saddlery” such goods are traditionally made of leather and consequently fall within the ambit of goods made of leather in the earlier mark. That leaves “clothing for animals”, as far as I am aware, such goods could be made of leather and are identical to that extent. Even if the term were amended to exclude animal clothing of leather, then the goods would still be highly similar as clothing of one material for an animal serves similar/identical purposes to those made of another material. The trade channels will also overlap.

31) The applicant seeks registration for the following class 9 goods:

Class 9: Scientific, nautical, cinematographic, optical, weighing, measuring, signalling, supervision, life-saving and teaching apparatus and instruments; recording discs; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; downloadable electronic publications; compact discs; digital music; computer games equipment adapted for use with an external display screen or monitor; mouse mats; mobile phone accessories; spectacles and sunglasses.

32) The earlier mark does not cover goods in class 9. However, that does not mean that there is no similarity with goods in the other classes of the earlier mark. Despite the opponent claiming in its statement of case that all of the applied for goods were identical or similar to goods of the earlier mark, it went on to state in relation to the applied for goods in class 9 :

“The class 16 goods of the Opponent’s CTM and IR are similar to “downloadable electronic publications” as listed above”

33) The applicant highlighted the apparent limited nature of the attack in its evidence and counterstatement. The opponent responded in its written submissions by stating that it had opposed all of the goods and goes on to give further examples of claimed similarity, but adds that even those it does not specifically mention are still similar, albeit, it accepts to a lower degree. The other aspects of similarity it specifically mentions are:

- i) Spectacles and sunglasses against clothing products.
- ii) Mouse mats and mobile phone accessories against the earlier class 16 goods because they are all, in effect, “merchandise”.

34) I can understand why the applicant made the assumption it did (i.e. of a limited class 9 attack). The opponent’s statement of case was not helpfully worded. Nevertheless, as the opponent notes, it did indicate that all of the goods were considered similar or identical. I will therefore consider its claims. In relation to the “downloadable electronic publications”, I agree with the opponent that there is a high degree of similarity between an electronic publication and a non-electronic version. The purpose is the same. Although the nature and trade channels may not overlap, the average consumer will simply make a choice as to whether he/she wishes to purchase a particular publication in electronic form or traditional paper form. **I consider the goods to be highly similar.**

35) In relation to the claim based on merchandise, this is simply untenable. Many goods can be sold as merchandise, but the purpose, trade channels,

nature etc, may be vastly different. On the basis put forward, the goods are not similar. In relation to sunglasses/spectacles, whilst certain designers may produce both sunglasses and clothing, this does not make the goods similar. The purpose is different, the nature is different. The channels of trade may sometimes overlap, but there is nothing to suggest that the class 9 goods are designed in such a way so as to complement clothing items. I bear in mind that the General Court has held that a complementary relationship can exist between clothing in class 25 and certain goods in class 18; in *El Corte Inglés SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-443/05) it was stated:

“42. First, the goods in class 25 and those in class 18 are often made of the same raw material, namely leather or imitation leather. That fact may be taken into account when assessing the similarity between the goods. However, given the wide variety of goods which can be made of leather or imitation leather, that factor alone is not sufficient to establish that the goods are similar (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 55).

43. Second, it is apparent that the distribution channels of some of the goods at issue are identical. However, a distinction must be made according to whether the goods in class 25 are compared to one or other of the groups of goods in class 18 identified by OHIM.

44. On the one hand, as regards the second group of goods in class 18 (leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery), the Board of Appeal rightly held that the distribution channels were different from those used for the distribution of goods in class 25. The fact that those two categories of goods may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (see, to that effect, Case T-8/03 El Corte Inglés v OHIM – Pucci (EMILIO PUCCI) [2004] ECR II-4297, paragraph 43).

45. On the other hand, as regards the first group of goods in class 18, namely leather and imitation leather goods not included in other classes such as, for example, handbags, purses or wallets, it should be noted that those goods are often sold with goods in class 25 at points of sale in both major retail establishments and more specialised shops. That is a factor which must be taken into account in assessing the similarity of those goods.

46. It must be recalled that the Court has also confirmed the existence of a slight similarity between ‘ladies’ bags’ and ‘ladies’ shoes’ (SISSI ROSSI, paragraph 42 above, paragraph 68). That finding must be extended to the

relationships between all the goods in class 25 designated by the mark applied for and the leather and imitation leather goods not included in other classes, in class 18, designated by the earlier mark.

47. In light of the foregoing, it must be held that there is a slight similarity between the goods in class 25 and the first group of goods in class 18. Consequently, the Board of Appeal could not conclude that there was no likelihood of confusion on the part of the relevant public solely on the basis of a comparison of the goods concerned.

48. As to whether clothing, footwear and headgear in class 25 are complementary to 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18, it must be recalled that, according to the case-law, 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 the production of those goods lies with the same undertaking (SISSI ROSSI, paragraph 42 above, paragraph 60).

49. Goods such as shoes, clothing, hats or handbags may, in addition to their basic function, have a common aesthetic function by jointly contributing to the external image ('look') of the consumer concerned.

50. The perception of the connections between them must therefore be assessed by taking account of any attempt at coordinating presentation of that look, that is to say coordination of its various components at the design stage or when they are purchased. That coordination may exist in particular between clothing, footwear and headgear in class 25 and the various clothing accessories which complement them such as handbags in class 18. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together (work, sport or leisure in particular), or the marketing strategies of the businesses in the sector. Furthermore, the fact that the goods are often sold in the same specialist sales outlets is likely to facilitate the perception by the relevant consumer of the close connections between them and strengthen the perception that the same undertaking is responsible for the production of those goods.

51. It is clear that some consumers may perceive a close connection between clothing, footwear and headgear in class 25 and certain 'leather and imitations of leather, and goods made of these materials and not included in other classes' in class 18 which are clothing accessories, and that they may therefore be led to believe that the same undertaking is responsible for the production of those goods. Therefore, the goods designated by the mark applied for in class 25 show a degree of similarity with the clothing accessories included in 'leather and imitations of leather,

and goods made of these materials and not included in other classes' in class 18 which cannot be classified as slight."

My view is that without evidence to establish a clear complementary link, the goods should not be considered similar. If I am wrong on that then any similarity between spectacles/sunglasses and clothing must be of a low degree.

36) The applicant seeks registration for the following class 14 goods:

Class 14: Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.

37) The opponent's statement of case refers to the above as being fashion items, as are the goods in classes 18, 21 and 25 of its earlier mark. The argument is based primarily on the goods being sold through the same channels, in the same stores, to the same average consumers. The opponent adds in its submissions that the class 14 goods may be worn so as to complement clothing products. Reference is made to the test for complementarity, inter alia 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 the production of those goods lies with the same undertaking". For similar reasons as I have given in relation to sunglasses and spectacles, **I conclude that the goods are not similar, or, if I am wrong on that, then any similarity must be of only a low degree.**

38) The applicant seeks registration for the following class 26 goods:

Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; badges for wear; tea cosies.

39) The statement of case refers to the opponent's class 24 goods which cover textiles and textile goods, and household textile items, which it considers to be of the same nature and/or that the goods in class 26 and the goods in class 24 can all be used for making clothing and accessories. In relation to "lace and embroidery, ribbons and braid" then I agree that these are clearly similar to textiles in the piece (which would be covered by the earlier mark's class 24 terms); the goods are similar in nature, purpose and trade channels, all being used, as the opponent states, to make clothing and other textile based items – **these goods are similar to a high degree.** I extend this finding to buttons, which, although the nature is somewhat different, the purpose and channels of trade are still similar. In relation to "hooks and eyes, pins and needles", again, the nature is different, but there seems to me to be a complementary relationship as the goods are for making items with textiles and are important for the use of the

other. The goods are likely to be sold through the same trade channels; **there is a reasonable degree of similarity.**

40) In class 26 that leaves badges for wear and tea cosies. Badges are classified in a number of classes according, essentially, to their material. It is possible for badges to be made of fabric or textile material and, thus, such goods would fall within the terms of the earlier mark. **On this basis, given that badges are involved, albeit of different materials, I consider there to be at least a reasonable degree of similarity.** In relation to tea cosies, I am aware that such goods are proper to class 21 not class 26 as applied for. Putting this to one side, I note that the earlier mark covers in class 21: household or kitchen containers and utensils. Whilst a tea cosy is not a kitchen container or utensil per se – **the use of the goods in the kitchen and the similar trade channels is likely to result in a moderate level of similarity. Further, the class 24 goods of the earlier mark cover various household textiles goods which would include tea towels. Given the nature of these, the area of the home in which they are used, the respective trade channels etc, I consider there to be a moderate level of similarity here also.**

41) The applicant seeks registration for the following class 28 goods:

Class 28: Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; childrens' toy bicycles.

42) The opponent states that its earlier mark in class 16 covers within its ambit:

Paper games materials
Playing cards
Decorations for Christmas trees

which are similar, it argues, to the applied for goods. It is also stated that the applied for goods will be supplied with instructional materials (a term covered by the earlier mark in class 16) and are, thus, complementary to the goods in class 28.

43) Playing cards and decorations for Christmas trees are proper to class 28, so the opponent's point is misconceived. In relation to "paper games material" I have no idea what the opponent means by this. No evidence has been presented as to what these goods are so I cannot even be sure that they fall in class 16. I have no basis for assessing similarity, so the argument on this basis is rejected. The argument in relation to instructional material is misconceived; trade mark use in relation to such goods would not include the scenario painted by the opponent. If the opponent was correct on this then such goods would be similar to virtually any other goods or services. **I conclude that the class 28 goods applied for have no similarity to any of the goods of the earlier mark.**

Summary of findings in relation to goods similarity

Class 9: *Scientific, nautical, cinematographic, optical, weighing, measuring, signalling, supervision, life-saving and teaching apparatus and instruments; recording discs; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; downloadable electronic publications; compact discs; digital music; computer games equipment adapted for use with an external display screen or monitor; mouse mats; mobile phone accessories; spectacles and sunglasses.*

Other than *downloadable electronic publications* (which are highly similar) the remaining goods are not similar to the goods of the earlier mark. If I am wrong on that finding in so far as sunglasses and spectacles are concerned, then any similarity is of only a low level.

Class 14: *Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.*

The goods are not similar to the goods of the earlier mark, or if I am wrong on that then any similarity is of only a low level.

Class 16: *Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; packaging materials; printed publications; paint boxes for children.*

The goods are identical to the goods of the earlier mark.

Class 18: *Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.*

These goods are identical, save for trunks (which are highly similar to goods of the earlier mark) and walking sticks (which have only a low degree of similarity to goods of the earlier mark).

Class 21: *Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.*

The goods are identical to the goods of the earlier mark.

Class 24: *Textiles and textile goods; bed and table covers; travellers' rugs, textiles for making articles of clothing; duvets; covers for pillows, cushions or duvets.*

The goods are identical to the goods of the earlier mark.

Class 25: *Clothing, footwear, headgear.*

The goods are identical to the goods of the earlier mark.

Class 26: *Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; badges for wear; tea cosies.*



“Lace and embroidery, ribbons and braid; buttons” are highly similar to goods of the earlier mark. Hooks and eyes, pins and needles and badges for wear are reasonably similar to the goods of the earlier mark; tea cosies are moderately similar to the goods of the earlier mark.

Class 28: *Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; childrens' toy bicycles*

The goods are not similar to any goods of the earlier mark

Comparison of the marks

44) 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 applicant's mark	The opponent's mark
 The applicant's mark consists of the words "my cat" in a lowercase, sans-serif font, positioned above the word "Pip" in a large, bold, uppercase, sans-serif font. A small silhouette of a cat's head is positioned at the base of the letter "i" in "Pip".	 The opponent's mark consists of the word "PIP" in a bold, uppercase, sans-serif font.

45) The opponent's mark has just one element, so it is its only component part. The applicant's mark is made up of the phrase MY CAT PIP together with the device of a cat. As the opponent states in its submissions, the word PIP is more prominent than the other words and the device (because it is physically larger and in bold), however, it does not form a single element in its own right as it will

be perceived by the average consumer as part of the whole phrase, MY CAT PIP. I will, though, bear in mind the greater prominence given to the word in the overall impression it creates.

46) Given the presence in both marks of the same word PIP (and that it stands out in the applicant's mark), there seems to me to be an inevitable aspect of similarity. However, I must bear in mind the points of difference (the addition of the words MY CAT and the device of a cat) which inevitably lessens any similarity. From a visual perspective, the greater prominence of the PIP element means that there is a reasonable (but not high) degree of similarity. From an aural perspective there is a moderate degree of similarity as, when articulated, there will be no greater prominence given to PIP above the other words.

47) Conceptually, the applicant's mark has a concept of a cat whose name is Pip. The earlier mark is PIP alone. Although the word has a number of meanings, one of those meanings is as a name. Pip is short for Pippa and is also the name of a well-known Dickens' character. Therefore, there is a degree of conceptual similarity as both marks contain a word which will (the applicant's mark) or may (the opponent's mark) be seen as a name. The absence of the cat concept and the fact that the word PIP also has other meanings reduces the conceptual similarity to a modest level.

Distinctiveness of the earlier mark

48) 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).

49) From an inherent perspective, the word PIP has no real relationship with the goods. I consider it to be a reasonably distinctive trade mark from an inherent perspective. In terms of the use made, as stated earlier, evidence has been filed by Ms Anke van der Endt. The basic facts which come from her evidence are that:

- PIP STUDIO was first used (in 2003) as the name of a design studio, initially designing products for third parties. The studio was based in the Netherlands.
- In 2004 it began designing its own range of products and these were sold from 2005.
- Evidence has been presented of the use of PIP and PIP STUDIO being used on a very wide range of goods.

- Turnover figures are provided for the UK, but only from 2009 onwards. They are: 2009, 67, 119 Euro; 2010 1,657,864 Euro; 2011 2, 487,903 Euro. The figures are not broken down by product type.
- Promotional materials are provided in support of UK use.

50) The question of enhanced distinctiveness must be measured from the perspective of the UK average consumer, it is such person that is to be considered in terms of whether there exists a likelihood of confusion. Despite the criticisms the applicant has made of the evidence in its submissions, I have no doubt that the mark has been used for a wide range of goods in the UK before the relevant date. However, it seems to me that the use is not longstanding and the turnover figures, contextualised against the breadth of goods offered, does not appear to represent a significant impact in the UK market for the goods concerned. In reality, such use is modest. There is no evidence that any of its promotional efforts will have changed the modest impact its sales may have made. **I therefore agree with the applicant that the use made of the mark will not have had any material impact upon its distinctiveness.**

Parallel trade

51) The argument made by the applicant is, effectively, that there was no confusion with its previous mark (**PIP & CO**), so there is even less likelihood of confusion with its new mark because it is even further away. There is a tranche of case-law to the effect that lack of confusion in the market place is indicative of very little: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

52) In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J stated:

“22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind

that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

53) From the evidence of Ms Bendy, it is clear that the trade under PIP & CO was primarily used in respect of greetings cards and mugs. There were some sales in relation to clothing but only on a very small scale. I also note that, for example, on some of the greetings cards provided in evidence the focus is very much upon the cat character rather than the trade mark per se. The impact that the trade mark will have had on average UK consumers is not clear. There are, in my view, a number of reasons why the claimed parallel trade is not relevant. It is not clear what use the earlier mark has had in relation to greetings cards and mugs; even if the mark has been used the fact that the turnover figures are not broken down means the degree of potential overlap in trade is not clear. It is not clear whether the same types of outlets have been targeted by the parties. Both parties use quite different get-ups in trade which create further extraneous differences. Finally, the mark before me is different from that previously used, as such, the evidence sheds little light, for all these reasons, on whether the notional use of the mark now filed will, or will not, cause confusion.

Likelihood of confusion

54) The factors assessed so far have a degree of interdependency. A global assessment of them must be made when determining whether there exists a likelihood of confusion. 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. I will give my findings class by class.

Class 25

55) The goods applied for are identical to goods covered by the earlier mark. In terms of the purchasing act, clothing products are “consumed” by members of the general public. The goods may be tried on and are likely to be inspected for colour, size, style, fitness for purpose etc. All of this increases the potential

exposure to the trade mark. That being said, the purchase of clothing is unlikely to be a highly considered process as it is purchased relatively frequently and, although cost can vary, it is not, generally speaking, a highly expensive purchase. I consider the purchasing process to be a normal, reasonably considered one, no higher or lower than the norm. The goods will be selected, ordinarily, via self-selection from a rail or shelf (or the online equivalents) or perhaps chosen from catalogues/brochures. This suggests a process of visual selection, a view which has been expressed in previous cases⁴; despite the importance of the visual aspects of the marks, the aural impact of the mark should not be ignored completely.

56) The average consumer will rarely have the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them kept in mind. However, even bearing this in mind, I consider the differences between the marks to be sufficient to ensure that one mark is not directly mistaken for the other. This rules out what is often known as direct confusion. However, the opponent also argues upon the basis of what I will call indirect confusion. This was explained by Mr Purvis QC, sitting as the Appointed Person, in *L..A. Sugar Limited v By Back Beat Inc* (BL-O/375/10) as follows:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

⁴ See, e.g. *New Look Ltd v OHIM* – Joined cases T-117/03 to T-119/03 and T-171/03 (GC)

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

57) In my view, the average consumer, whilst appreciating that the applicant’s mark consists of a whole phrase (and that it includes a device element), will still notice the prominence in the mark of the word/name PIP. When PIP alone is then encountered I consider it likely that this will signal to them that the goods come from the same or a related company. In other words, they will assume that the PIP of the earlier mark is the same PIP in the applied for mark. The focus will be upon the name. The same scenario has potential to operate in reverse. **In view of this, my finding is that there is a likelihood of indirect confusion.**

58) I extend this finding to:

Class 16: Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; packaging materials; printed publications; paint boxes for children.

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols; whips, harness and saddlery; clothing for animals.

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.

Class 24: Textiles and textile goods; bed and table covers; travellers' rugs, textiles for making articles of clothing; duvets; covers for pillows, cushions or duvets.

Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; badges for wear; tea cosies,

I have found most of these goods to be identical or highly/reasonably similar to goods in the earlier mark. The average consumer for the above goods will also be a member of the general public. They all seem, as per the clothing items already discussed, to be consumer items purchased more by the eye than by the ear and the degree of care and consideration will be no higher than the norm. For

similar reasons already given, **I consider that there is a likelihood of indirect confusion.** This is so even in relation to tea cosies, for which I only found a moderate degree of similarity; nevertheless, **the factors still combine to create a likelihood of confusion.**

59) In relation to downloadable electronic publications in class 9, I found these to be highly similar to the paper based publications that would be covered by terms in class 16 of the earlier mark. **Therefore, my findings also extend here.**

60) In relation to the class 28 goods and the remaining goods in class 9, I found no similarity between the goods. If the goods are not similar then there can be no likelihood of confusion under section 5(2)(b) of the Act. The opposition fails in relation to these goods. Similarly, in relation to sunglasses and spectacles in class 9 and the goods in class 14, my primary finding was that there was no similarity between the goods. However, even if I am wrong on that the any similarity is of a low level and this, together with the differences between the marks, **means that the combined effect is that there is no likelihood of confusion. This finding also extends to walking sticks in class 18 – the goods are only similar to a low degree and my overall assessment is that there will be no likelihood of confusion.**

61) The earlier PIP mark has been focused upon in the above findings. Although the opposition was only partially successful, it is not necessary to consider the other earlier mark in detail. This is for two reasons: firstly, the mark itself is further away (consisting of the words PIP STUDIO) and, secondly, its goods are no wider/closer than that of the PIP mark and may, furthermore, have been limited if the proof of use conditions were probed in detail. In short, the opponent will be in no better position.

Outcome of opposition

62) The opposition succeeds and, therefore, the application for registration should be refused in respect of:

Class 9: Downloadable electronic publications.

Class 16: Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; packaging materials; printed publications; paint boxes for children.

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols; whips, harness and saddlery; clothing for animals.

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.

Class 24: Textiles and textile goods; bed and table covers; travellers' rugs, textiles for making articles of clothing; duvets; covers for pillows, cushions or duvets.

Class 25: Clothing, footwear, headgear.

Class 26: Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; badges for wear; tea cosies.

But the opposition fails for and, therefore, the application should be registered for:

Class 9: Scientific, nautical, cinematographic, optical, weighing, measuring, signalling, supervision, life-saving and teaching apparatus and instruments; recording discs; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; compact discs; digital music; computer games equipment adapted for use with an external display screen or monitor; mouse mats; mobile phone accessories; spectacles and sunglasses.

Class 14: Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.

Class 18: Walking sticks.

Class 28: Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; childrens' toy bicycles

Costs

63) The opponent has won slightly more than it has lost and I consider it is entitled to a contribution towards its costs. However, I will make some allowance for the fact that the opponent did not succeed in full. I should add that I reject the applicant's submission that the costs award should reflect the previous agreement referred to in paragraphs 7-8 above. This is not only given the comments I have already made, but also because my costs decision must be

made on the basis of the conduct of the parties during these proceedings, not on what has gone on before. My assessment of costs is as follows:

Filing a statement of case and considering that of the applicant	£100
Filing and considering evidence:	£250
Filing written submissions:	£150
Official fee for opposition	£200

64) I hereby order Over The Moon Design Ltd to pay Pip Studio Holding BV the sum of £700. 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 10th day of March 2014

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

ⁱ The leading judgments are: *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).