

O-285-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2612491  
BY H.A.G. IMPORT CORPORATION (AUSTRALIA) PTY LIMITED  
TO REGISTER THE TRADE MARK  
COSMOPOLITAN  
IN CLASSES 8 & 21  
AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER No. 103938 BY  
HEARST COMMUNICATIONS INC.**

## BACKGROUND

1) On 5 March 2012 H.A.G. Import Corporation (Australia) Pty Ltd (hereinafter the applicant) applied to convert its CTM registration 9094079 (dated 10 May 2010) for the trade mark COSMOPOLITAN in respect of the following goods:

In Class 8: Hand tools and implements (hand-operated); cutlery; razors; food spreaders; mortar and pestle.

In Class 21: Household or kitchen utensils and containers; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; Household or kitchen utensils and containers (not of precious metal or coated therewith); glassware; dinnerware; cookware; servingware; chinaware; porcelain; earthenware and vases including but not limited to coffee plungers; tea pots; creamers; sugar bowls; kitchen canisters; salt and pepper mills; cups; saucers; mugs; jugs; coffee filters (non-electric); coffee grinders (hand-operated); coffee percolators (non-electric); coffee pots (non-electric); coffee services; non-electric apparatus for making coffee, hot chocolate pots, tea services; hand-operated food grinders.

2) The application was examined and accepted, and subsequently published for opposition purposes on 13 July 2012 in Trade Marks Journal No.6948.

3) On 12 October 2012 Hearst Communications Inc. (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Date of application / registration	Class	Specification
COSMOPOLITAN	CTM 7469505	16.12.08 26.08.09	3	Cosmetics; soaps; essential oils; personal care and grooming products, namely, personal hygiene preparations, skin, hand, facial and body cleansers, facial packs for cosmetic purposes, creams and lotions, beauty creams, hand creams, body milk, cleansing milk, skin moisturizers, body, face, dusting and bath powders, talcum powder, face and body masks, night cream, body sprays, makeup, eye make-up, eye liners; eye shadow, eye make-up removers, eye pencils, cotton swabs for cosmetic purposes, hair shampoo and conditioners, hair curling preparations, hair removing preparations, depilatory preparations, hair styling gel, hair-waving preparations, body shampoo, hair spray, hair colorants, hair colour removers, lip balms, lipstick, lip pencils, lip liners, skin balms, bubble bath, bath oils, bath preparations, bath and beauty soaps, liquid soaps, sun tan lotions, after-sun lotions, sun screen preparations; sun blocking preparations waxing kits, nail polish, nail polish removers, enamel for nails, nail varnish, nail manicure products, nail buffing cream, pedicure preparations, manicure and pedicure wraps, home fragrances, cologne, perfume and toilet water; anti-aging preparations, wrinkle removing skin care preparations; aromatherapy

				preparations; false eyelashes, artificial fingernails, artificial nail tips, false toenails; dentifrices; fragrant air freshening sprays; perfumed potpourris; massage oils and lotions; pre-moistened cosmetic tissues; cosmetic kits; cosmetic fingernail glue and cosmetic sponges, all sold as a unit; anti-cellulite preparations; anti-perspirant deodorants, deodorants for personal use, personal deodorant sticks; breath fresheners.
			18	Cosmetic bags; cosmetic bags, toilet bags and make-up cases sold empty; containers for cosmetics, cosmetic holdalls, make-up bags, cosmetic purses, cosmetic containers (not fitted and not of precious metal), cosmetic cases, unfilled personal care organizers and trays; jewellery organizers for travel; handbags; purses, coin purses, wallets; leather key fobs, keys cases, key holders; shoulder belts; credit card holders; boot bags, shoe bags; wash bags; belt bags; boot liners; card cases, card holders, card wallets; credit card cases, credit card holders; luggage tags; pouches; luggage, soft luggage, briefcases, carry bags, valises, tote bags, trunks and travelling bags, sports bags, beach bags, flight bags, garment bags, suitcases, satchels, school bags, shoulder bags, sling bags, rucksacks, shopping bags; umbrellas and parasols; leather shoulder belts, shoulder belts; unfitted vanity cases; boot liners.
			21	Household or kitchen utensils and containers; combs, hair combs, eyelash combs; cosmetics brushes, brushes for personal hygiene, eyebrow brushes, eyelash make-up applicators, cosmetics applicators, hair brushes, nail brushes, toilet brushes, holders for shaving brushes, holders for toilet articles, sponges, sponges for toilet use, skin cleansing brushes; clothes brushes, brush holders, shoe cleaning brushes; shoe cloths, non-electric shoe polishers; toothbrushes, toothbrush holders, toothbrush containers, toothbrush jugs, toothpaste holders, toothpicks, toothpick holders, tooth polishing appliances for personal use; electric toothbrushes incorporating oral irrigators, electrical devices for home use in the care of the teeth and mouth; soap dispensers, dispensers for liquid soap, soap dishes, soap holders; boot brushes; cosmetic utensils, containers for cosmetics, cosmetic powder compacts, powder compacts sold empty; potpourri jars; perfume burners; soap holders, soap dispensers, soap dishes; vanity cases, toiletry cases; deodorizing apparatus for personal use; name card holders; art objects of china, earthenware and glass; cafetieres; candle sticks, candle rings of common metal; candy boxes not of precious metal; ceramic ornaments; ceramics for kitchen use; china figurines; coasters in the form of crockery; non-electric coffee makers; non-electric tea makers; hand-operated coffee mills; coffee services of china, common metal or non-metallic materials; kitchen containers of precious metal; containers for household and kitchen use; cooking dishes, cookware, domestic cooking utensils, crockery for kitchen use; culinary pottery; cups (not of precious metal); cutlery holders and rests; decorative chinaware, earthenware, porcelain and glassware, decorative household containers of china, earthenware, glass and porcelain, decorative objects made of china, earthenware, glass and porcelain, decorative pots and trays of china, earthenware, glass and porcelain; drink coasters [other than of paper or table linen]; drinking containers, drinking mugs made of earthenware and porcelain; drinking glasses; shot glasses; carafes and decanters; figurines of porcelain, terra-cotta or glass, china, ceramic, crystal and decorative glass; statues of porcelain, terra-cotta or glass; flower vases, vase covers not of metal, vases not of precious metal, decorative vases not of precious metal; plant pots, plant pot covers not of metal; hand-operated fruit presses and fruit juice extractors; juice extractors and squeezers; glassware for household and kitchen purposes; holders for glasses, tumblers, drinking vessels, paper napkins and

				paper towels; implements for opening bottles; isothermic bags for keeping foodstuffs cool; jugs not of precious metal; jars for household use; kitchen cutting boards; non-electric kitchen machines and devices for food preparation; hand-operated mixing apparatus for kitchen use; plates; crockery of ceramic, including plates, bowls, cups and saucers; ceramic dinnerware, namely plates, bowls, cups, saucers and serving pieces; kitchen and household receptacles; storage containers for domestic use; teapot stands; thermally insulated containers [household] for food and drink; woks; sugar bowls, pepper pots and salt shakers; bowls, bowls for plants, bowls for vegetables, eating bowls, fruit bowls, serving bowls, soup bowls, salad bowls; mugs, not of precious metal; teapots, not of precious metal; egg cups; tea canisters; coffee canisters; sugar canisters; tumblers (drinking vessels); soap and liquid soap dispensers; dispensers for paper wipes, paper hand towels and serviettes (other than fixed); decorative boxes of china, chinaware, earthenware and glass; drip mats for tea; drink stirrers, sticks for stirring drinks or cocktails; ice buckets; fitted vanity cases; glassware, porcelain and earthenware not included in other classes; storage tins for household use.
COSMOPOLITAN	2385480A	25.02.05	11	Electric coffee makers, panini toasters, toasters, electric kettles.
		15.02.08	21	Non-electric juicers, non-electric coffee makers, non-electric kettles, non-electric blenders for food.
COSMOPOLITAN	2478492	30.01.08 13.06.08	8	Epilators; electric shavers.

b) The grounds of opposition originally also made reference to the opponent's trade marks 1482648 & 2229341A. However, these were subject to proof of use as the opponent's evidence did not show use of these marks they were removed from the case in October 2013.

c) The opponent points out that the marks are identical, and that the goods sought to be registered are identical or similar to the goods for which the opponent's marks are registered. The mark in suit therefore offends against Section 5(1) and Section 5(2)(a) of the Act.

4) On 29 July 2013 the applicant filed a counterstatement accepting that the trade marks were identical but denying that the goods of the two parties are identical, similar or complementary.

5) Both sides filed evidence and both parties seek an award of costs in their favour. The matter came to be heard on 9 June 2014 when the applicant was represented by Ms Michaels of Counsel instructed by Messrs Kilburn & Strode; the opponent was represented by Mr Quintin of Counsel instructed by Messrs Potter Clarkson LLP.

### **OPPONENT'S EVIDENCE**

6) The opponent did not file evidence only submissions which I shall refer to as and when necessary during my decision.

## APPLICANT'S EVIDENCE

7) The applicant filed written submissions which I shall refer to as and when required in my decision and also two witness statements. The first, dated 2 January 2014, is by Ryan Pixton the applicant's Trade Mark Attorney. He provides the following exhibits.

- REP1: This consists of a number of pages from various websites. The Boots website (undated) shows various categories of goods. The heading "Shaving" has been circled, and beneath this heading are "Razors, razor blades, shaving foam and gel and electric shavers". Next are 10 pages from the John Lewis website (dated 2 January 2014) where a search for Men's shavers simply has details of electric razors. Lastly, a search of the Superdrug website (undated) for "men's shaving" revealed the following subsets "Shaving prep, shaving blades, shaving electrical, disposable razors, men's razors and shaving blades".
- REP2: This is a page from the website [www.dictionary.com](http://www.dictionary.com) and a definition for "mortar and pestle" as a device for grinding.

8) The second witness statement, dated 13 December 2013, is by Michael Stein the Managing Director of Valerie Graham, a position he has held for 22 years. He is the UK distributor of the applicant's chinaware and cutlery. These are designed for use in the home as well as in catering. He states that he is authorised to make the statement and that he has had access to company records. Mr Stein states that the applicant produces a range of chinaware and cutlery under the Maxwell & Williams house brand and that COSMOPOLITAN is used as a sub-brand. He states that these products have been sold in the UK since 2003 under the mark in suit. He provides examples of packaging at MS1, although this is undated and appears to be pre-production mock ups. He provides a detailed list of the goods available but the terms chinaware and cutlery broadly cover all the items. He also provides at exhibit MS-2 a detailed sales breakdown for goods under the mark in the UK for the years 2003-2013. These show individual figures for teapots, different sized canisters, individual items of cutlery etc. Clearly some products have ceased production, whilst others only began after the relevant date. However, there are continuous sales of cutlery and chinaware throughout the period. I shall simply rely upon the total figure for sales of chinaware and cutlery under the mark in the UK as follows:

YEAR	£ "in excess of"
2005	98,000
2006	90,000
2007	90,000
2008	99,000
2009	78,000
2010	58,000
2011	67,000

9) At exhibit MS-3 he provides copies of Maxwell & Williams catalogues for 2005, 2006 and point-of-sale leaflets which shows the full range of sub-brands including the mark in suit and how it is used. I could only find a few instances of use of the mark in suit on cutlery, glass bottles and metal canisters. He also states that social media sites such as Facebook have been used to promote the goods. At MS-4 he provides an example of an advertisement for Maxwell & Williams on Facebook (undated) which provides details of all the products including those under the mark in suit. At MS-5 he provides copies of pages from the Maxwell & Williams website (undated) which show use of the mark in suit on cutlery, metal and glass canisters, glass bottles, a cake stand, china plates and bowls and a salt and pepper set. At exhibit MS-6 he provides examples of third party advertising of the mark in suit by Selfridges, Roullier White and Divertimenti (undated). At exhibit MS-7 he provides a list of retailers throughout the UK which stock products under the mark in suit, presumably current at the time of his statement.

### **OPPONENT'S EVIDENCE IN REPLY**

10) The opponent filed a witness statement, dated 27 March 2013 by John Brendan Peacock, its Trade Mark Attorney. Broadly speaking this consists of submissions which I shall not summarise but will refer to as and when required in my decision. Mr Peacock does however take issue with the applicant's evidence. First he requests that the Registry dismiss the evidence of Mr Stein as no evidence has been provided in respect of the relationship between Mr Stein and the applicant. He also points out that whilst use since 2003 is claimed he claims that this is not corroborated by the exhibits. In particular he states:

- MS1: these are mock ups of packaging, and there is no evidence that they have been used.
- MS2: There are gaps in the table with several items not being sold for five years prior to the relevant date or only beginning after the relevant date. He points out that the figures are not corroborated by invoices.
- MS3: He states that it is not clear to whom these materials were sent. Many are not dated, large parts relate to marks other than the instant mark and some show prices in \$. The only use of the mark in suit is, he says, on cutlery, storage bottles and storage canisters.
- MS5: These are not dated and so cannot be relied upon regarding use prior to the relevant date.
- MS6: There is no evidence corroborating sales to these retailers, nor is there evidence of what these stores stock or in what quantity.

11) Mr Peacock also provides the following definitions from Dictionary.com:

- Hand tool: Any tool or implement designed for manual operation.

- Cutlery: i) cutting instruments collectively, especially knives for cutting food; ii) utensils, as knives, forks and spoons, used at the table for serving and eating food; iii) the trade or business of a cutler.
- Kitchen utensil: a utensil used in preparing food.
- Razor: i) a sharp-edged instrument used especially for shaving the face or trimming the hair; ii) an electrically powered instrument used for the same purpose;
- Electric shaver: a razor powered by an electric motor.

12) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## DECISION

13) Prior to the hearing the applicant accepted that where the goods were identical then the opposition would succeed. The applicant identified a number of goods in Class 21 which it acknowledged fell into this category. These were: Household or kitchen utensils and containers; Household or kitchen utensils and containers (not of precious metal or coated therewith); kitchen canisters; glassware not included in other classes; glassware; dinnerware; cookware; servingware; chinaware; tea pots; creamers; sugar bowls; cups; saucers; mugs; jugs; coffee services; porcelain and earthenware not included in other classes; porcelain; earthenware and vases including but not limited to coffee plungers; and coffee pots (non-electric).

14) The opposition is based upon Section 5(1) and 5(2)(a) which read:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the earlier trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

5.-(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) .....

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

15) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

16) The opponent is relying upon its three trade marks UK 2478492, UK 2385480A and CTM 7469505 which are all clearly earlier trade marks. Given the interplay between the dates that the opponent’s marks were registered (respectively, 15 February 2008, 13 June 2008 and 26 August 2009) and the date that the applicant’s mark was published (13 July 2012) the Trade Marks (Proof of Use, etc) Regulations 2004 do not apply.

17) When considering the issues under Section 5(1) I take into account the decision of the European Court of Justice (ECJ) in the *LTJ Diffusion S.A. v Sadas Vertbaudet S.A.* (case C-291/00) [2003] FSR 34 where at paragraphs 49-50 they stated:

“49. On the other hand, Article 5(1)(a) of the directive does not require evidence of such a likelihood in order to afford absolute protection in the case of identity of the sign and the trade mark and of the goods or services.

50. The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Article 5(1)(a) of the directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the directive.

18) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the summary shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch):

- (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/ 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; 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;

(e) 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

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

(i) 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;

(j) 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.

### **Distinctive character of the opponent's earlier trade marks**

19) The opponent has not provided any evidence of use of its marks. The opponent's marks cannot therefore benefit from an enhanced distinctiveness in relation to any of the goods for which they are registered. The word COSMOPOLITAN is a relatively well

known standard English word which means: sophisticated, international / multinational / multi ethnic or broad based. The mark clearly suggests that the goods might be of better quality or design than standard fare. The opponent's marks must therefore be regarded as having a only moderate degree of inherent distinctiveness when used on the goods listed at paragraph 3 above.

### **The average consumer and the nature of the purchasing process**

20) I must now determine the average consumer for the goods of the parties. The goods are quite wide ranging but can all be broadly referred to as consumer goods. As such the average consumer would be the general public. This was accepted by both parties at the hearing. Clearly, the items in the applicant's specification which remain are broadly speaking household goods, hand tools or razors. Any implement that is going to be used on an individual's body, such as a razor, will not be purchased without some consideration as to whether it is suitable for one's body. Dinnerware, glassware, porcelain, kitchen utensils items and hand tools can vary enormously in price and complication, from a wooden spoon to a bone china dinner service costing many thousands of pounds. Clearly, the care taken will vary enormously and whilst the vast majority of items will be self selected from a shelf or catalogue or the internet, the more expensive and sophisticated items may be selected after contact with a sales assistant, although even here most people would have carried out some research such as on the internet. To my mind, selection will be predominantly by eye, although word of mouth recommendations may also have a part to play. Therefore, the initial selection will usually be visual but aural considerations cannot be overlooked.

### **Comparison of trade marks**

21) Clearly the marks of the two parties are identical. This was accepted by both parties from the outset.

### **Comparison of goods**

22) The accepted test for comparing goods and services is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the CJEU in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods and services;
- b) The respective users of the respective goods and services;
- c) The physical nature of the goods and services;
- d) The respective trade channels through which the goods and 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 and 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 in the same or different sectors.

23) I take into account the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

24) I take on board the Class in which the goods are placed is relevant in determining the nature of the goods (see *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34. Goods in one Class cannot be identical to those in another, although they may be similar to a high degree. Also I look to the comments of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

25) The question of complementary goods/services has been considered by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 the GC 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* (PiraNAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).”

26) However, in the cases *Sandra Amalia Mary Elliott v LRC Products Limited* (and cross opposition) [BL O-255-13] in respect of the marks LUV and LOVE respectively Mr Alexander Q.C. acting as the Appointed Person said:

“15 A formulation of the law by the same Hearing Officer in very similar terms was accepted without criticism by either party or by Floyd J (as he then was) *Youview TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) and the Hearing Officer's statement of the law cannot be faulted.

16. However, because of the particular grounds of appeal in this case, which did not arise in the *Youview* case, it is necessary to make three observations about that summary as it applies to the present case.

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 fibre 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 fibre 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.”

27) Following the applicant’s acceptance that the opposition would succeed in respect of those goods identified at paragraph 13 above, the following goods are those which need to be considered. I have listed the goods which the opponent claims, in its submissions prior to the hearing, are similar to the remaining goods of the applicant and also indicated whether the applicant accepts whether the goods are similar, although the applicant’s admissions range from “high similarity” to “barely similar”.

Applicant’s specification		Opponent’s specification	Applicant accepts goods have a degree of similarity.
<b>Class 8</b>	Hand tools and implements (hand-operated)	Class 21: non-electric juicers; non-electric blenders for food; epilators and electric shavers; hand operated coffee mills, hand operated fruit juice presses and fruit juice extractors; non-electric kitchen machines and devices for food preparation; hand operated mixing apparatus for kitchen use; juice extractors and squeezers; household or kitchen utensils; implements for opening bottles;	No
	Cutlery	Class 21: Household or kitchen utensils; cutlery holders and rests; plates; crockery of ceramic including plates, bowls, cups and saucers	No
	Razors	Class 8: Epilators; electric shavers	Yes
	food spreaders	Class 21: Household or kitchen utensils	No
	mortar and pestle	Class 21: Household or kitchen	Yes

		utensils	
<b>Class 21</b>	unworked or semi-worked glass (except glass used in building).	Class 21: Glassware; Art objects of glass; decorative objects of glass; glassware for household and kitchen purposes	Yes
	Salt and pepper mills.	Class 21: Pepper pots and salt shakers;	Yes
	Coffee filters (non-electric); non-electric apparatus for making coffee, coffee percolators (non-electric);,	Class 21: Non-electric coffee makers,	Yes
	coffee grinders (hand-operated);	Class 21: Hand-operated coffee mills;	Yes
	hot chocolate pots,	Class 21: Jugs; cookware; drinking containers; thermally insulated containers [household] for food and drink.	Yes
	hand-operated food grinders.	Class 21: Non-electric kitchen machines and devices for food preparation; hand operated mixing apparatus for kitchen use;	No
	tea services.	Class 21: Crockery of ceramic including plates, bowls, cups and saucers; teapots, not of precious metal; cups (not of precious metal); decorative chinaware, earthenware and porcelain.	Yes

23) I shall take each aspect individually and consider the submissions made by both parties:

24) **Hand tools and implements (hand-operated):** The opponent contended that as indicated by the dictionary extracts annexed to Mr Peacock’s witness statement, “hand tools” are synonymous with “implements”. This element of the specification therefore means, in essence, “hand operated tools”. For the applicant Ms Michaels contended:

“To me, a hand tool is something like a hammer or a screwdriver or possibly a garden tool like a hoe. It is not an electric razor or a blender. It explains why there is a distinction between Classes 7 and 8. One contains machinery and the other contains tools. That is a real distinction and that distinction is not then followed through by my learned friend in his submissions in relation to that element of our Class 8 specification. I would submit the first part of my learned friend's argument does not hold water. Without being overly bounded by class distinctions, one has



to look at the reality of what goods are. The suggestion that a non-electric juicer is somehow a hand tool just simply does not stack up. One can look at a dictionary definition and say that a hand tool is synonymous with an implement. Our specification is for hand tools and implements. That takes Mr. Peacock nowhere in his evidence, but it does not make any difference as to what the nature of the item is. "Hand-operated tool", to take the wording in my learned friend's skeleton, takes the matter no further because there is a distinction between a tool, which is an item you use in your hand to turn the screw or break something open or saw something in half, and using a piece of machinery. That is the real distinction. Whilst conceivably there might be some similarities, they are certainly not identical to the item my learned friend has listed in his skeleton: non-electric juicers and non-electric blenders for food. That is stretching the English language much too far.

The same would apply to electric shavers. The suggestion that an electric shaver is a hand tool, with respect to my learned friend, is plainly wrong. It is a piece of machinery. The fact you can hold it in your hand does not mean that it is a hand tool. The same would apply to anything one could hold in one's hand. On that basis, that is a hand tool (indicating glass of water) and that cannot be right.

The same point applies to the hand-operated coffee mills and non-electric kitchen machines. Those are items of machinery; those are not tools that you hold in your hand. I would submit that there is no question that there is anything in their specification which is identical to a hand tool or implement. Are they similar to any of them? My learned friend has said that they are plainly highly similar and there would be a likelihood of confusion but, with respect, what he has not done is to look at the British Sugar criteria to work out how one would equate a hand tool on the one hand to a hand-operated coffee mill on the other.

If one takes as an example of a hand tool a screwdriver, or any other piece of household tool you might happen to have in your toolbox, one cannot say it is similar. One would not expect it normally to come from the same source. One would not expect it to be sold through the same channels. The uses to which it is put are not the same and so on and so forth. In my submission, one cannot simply say, "They are similar." Following British Sugar, it is absolutely clear they are not similar at all. Therefore, there is nothing similar to hand tools and implements in any of my learned friend's specifications. It simply does not stack up.

When you get to domestic cooking utensils including a cheese grater, they are suggesting that if you take a saw on the one hand and a cheese grater on the other, both of them are sharp. However, that is not going to get you home on British Sugar any more than a saw, on the one hand, might be similar to an implement for opening a bottle, let alone when you get down to eyelash curlers. If you apply British Sugar to anything that you might see as a hand tool, you will find that there is no similarity as defined in that part of our Class 8 specification. I think that is all I need to say on that."

25) To my mind, whilst I understand and accept a great deal of the submissions made by Ms Michaels, I do not agree with the overall conclusion. For example, a non-electric juicer, often referred to as a reamer, is simply a shaped item on which one presses fruits etc in order to extract the juice. It is a hand tool in every sense as it can refer to something which is hand held and hand powered. I am also conscious that items such as spatulas, reamers, tongs ladles etc can be classed in Classes 8 and 21. **As such there is clearly a high degree of similarity between the description “hand tools and implements” and kitchen utensils; hand operated fruit juice presses and fruit juice extractors.**

26) **Cutlery:** The opponent’s view was that as indicated in the dictionary extract annexed to Mr Peacock’s witness statement, cutlery includes utensils used at the table for serving and eating food. Cutlery is therefore a subset of (and so identical to) the “household or kitchen utensils” for which the 505 Mark is registered. Alternatively, cutlery is highly similar to “household or kitchen utensils”, “cutlery holders and rests” and/or “plates; crockery of ceramic including plates, bowls, cups and saucers” for which the 505 Mark is registered. At the hearing Ms Michaels contended:

“Moving on to cutlery, I think my learned friend's first submission is that cutlery is a subset of household or kitchen utensils. All he is hanging his hat on there is a dictionary definition which suggests that it may be an element of cutlery that one would have utensil [sic]. It is quite interesting as if one looks at page 18, there are two definitions there and each is a little different to the other.

The first definition, by which there is the asterisk on page 18, is "Cutting instruments collectively, especially knives .... 2. Utensils are knives, forks and spoons, used at the table for serving and eating food." Underneath that, one has the World English Dictionary and the definition there is different. The first is, "1. Implements used for eating .... 2. Instruments used for cutting. 3. The art or business of a cutler."

The second definition there plainly would not include a household or kitchen utensil because you do not use a utensil to eat at table. A utensil is an item which you use in the kitchen for the purposes of cooking, cutting and perhaps cleaning, but not feeding yourself at table. In my submission, there is a realistic difference between a household or kitchen utensil which might be a spatula -- that was the example my learned friend gave -- which would be different to the normal definition of "cutlery". In my submission, they are not identical items and there is not an overlap between them.

If that is right, one is down to the question of whether there is a level of similarity. My learned friend, looking at his skeleton argument, says that it is highly similar to household or kitchen utensils. We are back again to the *British Sugar* test. Has he applied that? With the greatest respect, no, he has not.

Going to purposes and users, the users may be the same because this is all for

the general public. What are the purposes for which one uses utensils? They are not the same as the purposes for which one would use what one would normally think of as "cutlery" -- knives, forks and spoons. They have different purposes.

Are they sold through the same channels of trade? They may be. There is no evidence before you to show that that is the case. Even if they are, would people necessarily think that they come from the same manufacturer? Not necessarily. The level of complementarity is very low because they are no more similar, I would submit, than cutlery is to tablecloths. Once you start moving away in that direction, you can point in all directions. Does that mean that the cutlery is similar to the table on which you are eating? One can take it to silly extremes and in doing that one can see that one has to be a bit more analytical than I would submit my learned friend has been.

That was highlighted by my learned friend's suggestion that cutlery is similar to chopsticks and chopsticks are utensils. In my submission, I think the suggestion that chopsticks are utensils is somewhat surprising. Chopsticks, I would have thought, are in a category of their own. They are not normally used for the preparation of food, but for eating food. They are an alternative to cutlery perhaps when eating Chinese food. Unless they fall within my learned friend's specification as kitchen utensils, one need not consider them in terms of whether, by themselves, chopsticks are similar to cutlery.

If he cannot get home on that, my learned friend would rely on similarity to crockery. His submissions were essentially that they are used at the same time and the two are complementary, one to the other. I think the same point about complementarity can be made in relation to cutlery and crockery as I made a moment ago. It would mean that, on the same basis, cutlery is similar to tablecloths is similar to crockery. Realistically, one would not expect those all to be sold through the same channels or come from the same manufacturer. One has to treat that sort of submission with care.

My learned friend says that what you can rely on is our own evidence of our own catalogues. That is the only evidence that is before you showing that any one manufacturer provides goods in the two different categories of cutlery on the one hand and crockery on the other, not necessarily always under the same marks. My learned friend wants to criticise the fact that we have not shown approved use, but nevertheless wishes to show that they are sold through the same trade channels.

In my submission, that may be what my client does (whether or not under the same marks) but it does not prove that that is the general pattern in the trade, still less that the general public would expect that because they know a trade mark of one particular element of crockery, it would necessarily come from the same manufacturer as an item of cutlery. That is taking it a step too far in terms of what the evidence is which is before you, but that is the only evidence which is before you on that point. There is certainly nothing from the opponent to substantiate similarity between those items.

Sorry, I have not dealt with cutlery rests. Would you like me to deal with cutlery rests? I forgot cutlery rests. I have just seen my note and what my learned friend was saying about that. It is going back to cutlery. Is a cutlery rest similar to cutlery?

Sir, I think you have given the answer to that: not if it is made from chinaware. Is it in the same category as crockery? Is it in the same category as a tablecloth? Would anyone anticipate that a cutlery rest was going to be sold through the same channels and come from the same manufacturer as cutlery without evidence to show that is the case? I would say that is purely speculative and there is no such evidence before you. This is an example where my learned friend is relying on complementarity where there is no similarity of any other kind which puts it in the tablecloths category rather than the chinaware category.”

27) I was also referred to the case of *Rousselon Frères v Horwood Homewares Ltd O/215/07* where the Hearing Officer, assessing the similarity of knives in Class 8 to a range of domestic utensils in Class 21, decided that although the goods might be sold through the same trade channels and had the same notional end users, their nature and intended uses differed and were not in competition. The conclusion was that they were not the same or similar, and this decision was upheld on appeal. I am aware that in the case quoted the Hearing Officer was presented with evidence from the trade which assisted him in reaching his decision, and such evidence is lacking in the instant case. I find myself agreeing with most of the points made by Ms Michaels save that regarding cutlery rests. At the hearing Mr Quintin pointed out that “Cutlery rests” irrespective of what they are made of, and they are made in a variety of materials, are complimentary to cutlery as the rests have no other purpose other than to be used with cutlery. Clearly, cutlery rests and cutlery are not in competition, nor do they have the same uses and their physical nature is different. However, the users would be the same, and although no evidence was provided I am willing to accept that they would have the same trade channel and be sold in close proximity given their closely related functions. It is my opinion that customers may think that the responsibility for those goods lies with the same undertaking. **I therefore find that there is a moderate degree of similarity between cutlery and cutlery rests. Using the same tests in relation to the opponent’s other goods I do not find any of them similar to the applicant’s specification of “Cutlery”.**

28) **Razors:** The applicant accepted that these goods were similar to the opponent’s specification of “electric shavers”. **To my mind these must be regarded as identical.**

29) **Mortar and pestle:** The applicant accepted that these were similar to the opponent’s “Household or kitchen utensils” in Class 21. Goods in different classes cannot be regarded as identical (*Altecnic Ltd’s Trade Mark Application* [2002] RPC 34). **However, to my mind, they must be regarded as highly similar.**

30) **Food spreaders:** The opponent contends that its Class 21 specification of “household or kitchen utensils” is similar. The applicant takes a different stance. Ms Michaels contended:

"We do not accept that food spreaders are similar. If you are looking at a spatula then you are looking at a household utensil. What is a food spreader? A food spreader is not necessarily a spatula. I would have taken food spreaders in Class 8 to be some sort of rather more technical food preparation item not used in a domestic context, but perhaps in an industrial context. I do not know if it has some technical meaning but, to me, it certainly does not leap to mind as being obviously something where one would say, "That must be a pallet knife so therefore it is a utensil." I do not want to take more time on that not very exciting item, however."

31) A food spreader could be akin to a large knife, sometimes referred to as a pallet knife or a squeegee used to spread out mixtures e.g. pancake mix, on a hob. Other than this I am as unsure as the parties are as to what this term refers to. **If this item is as I describe then "kitchen utensils" would be highly similar.**

32) **Unworked or semi-worked glass (except glass used in building):** The opponent contends that this is either identical or highly similar to "art objects of glass" or "decorative objects of glass". For its part the applicant contended that there was nothing identical to *unworked or semi-worked glass*, but did accept that it may have some level of similarity to the Opponent's Glassware not included in other classes. Ms Michaels stated:

"My learned friend has relied upon the fact that glassware, art objects of glass, decorative objects of glass and glassware for household and kitchen purposes obviously have one element of similarity, which is the material of which they are made. That is why I accept there is some level of similarity. However, I would submit there is a very big gap between an art object of glass and un-worked or semi-worked glass. Almost by definition, an art object of glass is going to be worked and therefore I would submit there is more difference than there is similarity between those items. That is just looking at the items of themselves without seeking to apply any *British Sugar* criteria to them. The suggestion that you would get un-worked or semi-worked glass in the same place (similar on *British Sugar* principles, for example, in terms of where it is sold) as an art object of glass, I would submit suggests there is not a similarity. If there is similarity there, you have put a "Yes" in the box and I have written beside it "Barely". I think that is my submission. I accept obviously there is an element of similarity because of the product and because of the material, but it goes no further than that."

33) To my mind the opponent specification of "glassware" must encompass all forms of glass within class 21 whether or not it is worked. **In my opinion the goods are identical.**

34) **Salt and pepper mills:** The Applicant accepted that these are similar to pepper pots and salt shakers. **To my mind, the goods are moderately similar.**

35) **Coffee filters (non-electric); non-electric apparatus for making coffee, coffee percolators (non-electric):** The applicant accepted that these are similar to "non-

electric coffee makers” in the opponent’s specification. **To my mind, they are highly similar if not identical.**

36) **Coffee grinders (hand-operated):** The applicant accepted that these are similar to the opponent’s “hand-operated coffee mills”. **To my mind, they are highly similar if not identical.**

37) **Hot chocolate pots:** The opponent contends that these goods are either identical or highly similar to “cookware” and/or “drinking containers” and/or “thermally insulated containers [household] for food and drink”. Ms Michaels stated:

“I think the only other one which is dubious is hot chocolate pots because I am not absolutely clear in my mind what a hot chocolate pot is and what material it is made from. I accept that it may, if it is made from earthenware or china, be similar to a jug perhaps. It may fall within serving ware or cookware. As it is not limited as to what material it is made from perhaps it is difficult to exclude it from similarity with one of those categories. I do not think I can take that very much further.”

38) Again, in the absence of specifics from the parties as to what exactly is being applied for, I can only use my own knowledge just as Counsel have done. **To my mind, a hot chocolate pot is highly similar to the goods relied upon by the opponent at paragraph 37 above.**

39) **Hand-operated food grinders:** The applicant accepted that these are similar to “non-electric kitchen machines”. **In my opinion they are identical.**

40) **Tea services:** The applicant accepted that there was “overlap with teapots”. Equally the terms “cups (not of precious metal); decorative chinaware, earthenware and porcelain” would encompass these goods. **They are identical.**

41) For ease of reference I draw my conclusions regarding the similarity of the goods together.

- The following goods from the applicant’s specification are identical to goods in the opponent’s CTM specification: Razors; Unworked or semi-worked glass (except glass used in building); Hand-operated food grinders; Tea services.
- The following goods from the applicant’s specification are highly similar to goods in the opponent’s CTM specification: Hand tools and implements (hand-operated); Mortar and pestle; Food spreaders; Coffee filters (non-electric); non-electric apparatus for making coffee, coffee percolators (non-electric); Coffee grinders (hand-operated); Hot chocolate pots.
- The following goods from the applicant’s specification are moderately similar to goods in the opponent’s CTM specification: Cutlery; Salt and pepper mills.

## Likelihood of confusion

42) I must now take all the above into account and consider the matter globally taking into account 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. The opponent did not file any evidence of use of its marks and so it cannot benefit from an enhanced distinctiveness. Inherently, the marks are only moderately distinctive. The absence of any evidence of the opponent's use of its marks in the market also rules out any defence under concurrent trading. In her skeleton Ms Michaels stated:

"17. As for the goods in the Applicant's specification which are similar to some extent to the Opponent's specifications, it is important to recall that, as Ms Carboni put it recently in *Thornton & Ross's application*, BL O-175-14 (16 April 2014):

"33 ... it simply is not the case that, under section 5(2)(b) of the Act, similarity of marks plus similarity of goods (or services), with an average consumer who is reasonably observant and circumspect, equals success of opposition. The law is that, where there exists a likelihood of confusion *because of* the similarities between the particular marks in issue and the particular goods (or services), then the mark shall not be registered. This requires an assessment which takes into account "all factors relevant to the circumstances of the case" (as explained in *Sabel v Puma C-251/95* [1998] R.P.C. 199 at [22] and subsequent cases). To follow a path of automatism would be contrary to established law."

18. The Applicant submits that in the absence of any evidence that the relevant consumers would consider it usual for those products to be sold under the same trade mark, on the basis that a large number of the producers or distributors of the goods are the same, there is no likelihood of confusion for the rest of the goods in its specification, and the opposition should therefore fail."

43) At the hearing she clarified the meaning of these paragraphs thus:

"I think I was making the trade channels point. In the absence of evidence as to whether goods of this nature, for example, hand tools on the one hand and chinaware on the other, would be sold through the same trade channels and therefore might be taken by members of the public to emanate from the same manufacturer, the likelihood of confusion is not established. What you do not have here is any evidence from the opponent as to relevant trade channels or as to the nature of this trade. The only evidence you have is in the form of some of my client's catalogues. That may or may not be symptomatic of the way in which this trade works and may or may not in any event cover all of the goods in the specification.

For example, I do not believe that there are any hand tools, as I would define them, in my client's catalogue. Therefore, there is no evidence before you of how the trade channels work in relation to those sorts of goods. It may be a matter of

which you can take reasonable notice with your hat on as an average member of the public, but there is no evidence before you to suggest that at least with some of the goods concerned, there are particular ways in which these goods are sold or come to the public's attention which would help you to come to the conclusion that there is a likelihood of confusion. I am sorry if I did not make that clear, but I think that is the point I was trying to make.”

44) I fully accept that no evidence of trade channels was provided by either party, and if I were comparing crockery to hand tools I would accept that the applicant’s point. However, the opponent’s weakest case is in relation to “Cutlery” which I found to be moderately similar to “cutlery rests” and “Salt and pepper mills” which I found to be moderately similar to “pepper pots and salt shakers”. In carrying out the comparison I considered that “cutlery rests” would be sold alongside “cutlery” although accepting that it could also be sold in with china dinner services if the rests were to be made of china. As the opponent had no restriction on the material that the rests were made of, then it is entirely possible for it to manufacture items in chinaware to sell with its dinner services and also metal, glass, horn etc to sell alongside cutlery items. Similarly, it is my belief that salt and pepper mills will be found on the same shelf as pepper pots and salt shakers. It is possible that some pepper pots and salt shakers may also be sold as part of a china dinner service and thus be in a different part of a shop or indeed a different retail outlet all together. However, again there is no restriction on either party’s specification and so I must allow for all possibilities. Given that the marks are identical I find that when used on goods that are only moderately similar there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(1) succeeds where the goods are identical and succeeds under 5(2) (a) where the goods are similar. Overall the opponent therefore succeeds in respect of all the goods applied for by the applicant.**

## CONCLUSION

45) **The opponent has succeeded in its opposition.**

## COSTS

46) As the opponent has been successful it is entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side’s statement	£300
Preparing evidence and considering the evidence of the other side	£500
Preparing for and attending a hearing	£600
<b>TOTAL</b>	<b>£1,600</b>

47) I order H.A.G. Import Corporation (Australia) Pty Limited to pay Hearst Communications Inc. the sum of £1,600. This sum 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 26th day of June 2014**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**