

O-033-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3191789
BY MICRON PARTNERS LIMITED TO REGISTER THE FOLLOWING TRADE
MARK**

MICRON

IN CLASSES 3, 14, 25, 26, 35, 38 AND 41

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 408681
BY MICRONCLEAN LIMITED**

Background and pleadings

1) Micron Partners Limited (hereafter “the applicant”) applied to register the mark 3191789 MICRON. The application has a filing date of 18 October 2016 and a publication date of 6 January 2016. It was applied for in respect of goods and services in classes 3, 14, 25, 26, 35, 38 and 41, but for the purposes of these proceedings only the following goods are relevant:

Class 25: *Clothing; footwear; headgear; ...*

2) Micronclean Limited (hereafter “the opponent”) partially opposes the trade mark on the basis of section 5(2)(b) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed only against the goods listed above. For the purposes of its grounds based upon section 5(2)(b), the opponent relies upon the following earlier mark that is registered in respect of goods and services in classes 7, 9, 21, 24, 25, 37 and 42, but for the purposes of these proceedings it relies only upon Class 25. The relevant details are:

1287780

MICRONCLEAN

Micronclean

(Series of 2 marks)

Class 25: *Articles of protective clothing (not for protection against accident or injury) for use in cleanrooms or the like controlled environments except for rights in relation to Northern Ireland.*

Filing date: 18 October 1986

Publication date: 7 December 1988

Registration date: 26 May 1989

3) It completed its registration period more than five years before the publication of the contested application. The consequence of this is that it is potentially subject to the proof of use provisions contained in section 6A of the Act.

4) The opponent's mark is an earlier mark within the meaning of section 6(1) of the Act. It claims that the applicant's mark is confusingly similar to the opponent's mark and that it is in respect of identical or similar goods and, as a result, the application is contrary to section 5(2)(b) of the Act.

5) It also claims that as a consequence of the use of its mark in relation to protective clothing, protective footwear and protective headgear since as early as 1987, the opponent enjoys an extensive goodwill and reputation in the MICROCLEAN mark. Consequently, the registration of the contested mark would be contrary to the provisions of section 5(4)(a) of the Act.

6) The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of its earlier mark. The applicant's counterstatement also contains written submissions that I will not detail here, but I will keep in mind when making my decision.

7) The opponent filed evidence and I will summarise this as far as I consider necessary. The opponent requested to be heard and was represented at hearing held on 4 January 2018 by Mr Alan Fiddes for Urquhart-Dykes & Lord. The applicant is not represented in these proceedings and did not attend the hearing.

Opponent's Evidence

8) This takes the form of a witness statement by Simon James Fry, director and shareholder of the opponent. He provides a history of the opponent and its predecessors that I do not need to detail here. These companies supplied laundry services to operators of cleanrooms throughout England, Scotland and Wales under the MICRONCLEAN mark. They also supplied cleanroom garments.

9) Mr Fry states that the MICRONCLEAN mark has been used since at least as early 1986 and since that time turnover has totalled in excess of £250 million “in relation to all of the goods and services”.

10) Mr Fry states that the goods and services provided under the mark can be categorised as:

“Cleanroom garment rental and laundry services; consumables for cleanroom operators including disposable garments; and cleanroom cleaning and decontamination services.”

11) Annual turnover figures are provided from the year 2000 to 2015, but they relate to total turnover (including turnover in respect of goods and services provided under other marks) rather than in respect of the goods for which the opponent must show genuine use. At Exhibit SJF5, Mr Fry also provided a summary of turnover in respect of “cleanroom garment rental and laundry services and the sale of disposable garments”. Once again, it is not possible to ascertain what proportion of these turnover figures relates to the garments themselves.

12) At Exhibit SJF6 is a copy of a decision of the Competition & Markets Authority regarding the opponent’s acquisition of another company. It is noted at paragraph 28 of the decision that the parties (including the opponent) supply various cleanroom laundry services and also other cleanroom products such as disposable cleanroom apparel.

13) Mr Fry explains that “cleanroom garments” include hoods, coveralls, boots, coats and undergarments. At Exhibit SFJ7 he provides the “Microclean Brochure 2013” showing the range of products for sale or rental under the mark. This brochure includes sections divided into the following categories: cleanroom garments, food industry garments, industrial cleanroom garments, industrial garments, laboratory wear, plantwear/undergarments and hazard protection & hi vis garments. The individual garments shown include the following:

Coats, coveralls, trousers, tops, boiler suits, jackets, polo shirts, laboratory coats, tunics, jackets, body warmers, waistcoats, hoods and overshoes.

14) The title of the brochure as shown on its front cover is “Micronclean Brochure 2013”. The word mark “Micronclean” also appears on the contents page and on numerous occasions on the page where information is provided about the three sites from which the opponent operates. Elsewhere in the catalogue, the following mark appears prominently on many of its pages:



15) Mr Fry states that the opponents mark is applied to a number of garments and at Exhibit SJF8 is a photograph of a dummy clad in a coverall with the above mark appearing upon the chest of the garment.

16) Mr Fry explains that the cost of purchasing cleanroom garments can be very significant and, because of this, a large number of cleanroom garments bearing the MICROCLEAN mark are supplied to customers under rental agreements. Computer records provided at Exhibit SJF11 show that 366,000 MICRONCLEAN garments are currently on rental.

17) Mr Fry states that the opponent’s mark has been used since at least as early as 2009 in respect of disposable garments, including coats, over boots, over shoes, sleeve protectors, boiler suits, hoods, face masks and gloves. At Exhibit SJF12, Mr Fry provides extracts from the “Micronclean Consumables Catalogue” of 2014. He states that this shows disposable garments indicative of those sold by the opponent under its mark between 2009 and 2017. In addition to the mark shown in paragraph 14, above, the catalogue also contains a number of examples of the word mark “Micronclean” on the introduction page and specifically referring to “Micronclean products”.

DECISION

Proof of use

18) The proof of use provisions are contained in section 6A of the Act that reads:

“6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the period of five years ending with the date of
publication.

(2) In opposition proceedings, the registrar shall not refuse to register the
trade mark by reason of the earlier trade mark unless the use conditions are
met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of
the application the earlier trade mark has been put to genuine use in
the United Kingdom by the proprietor or with his consent in relation to
the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper
reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

19) It is also important to keep section 100 of the Act in mind. This reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

20) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759

(to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

21) The relevant period for which use must be shown, as defined in section 6A(3)(a) of the Act, is the five years ending with the day of publication of the contested mark i.e. 7 January 2011 to 6 January 2016.

22) The opponent’s evidence raises several questions. The first of these is that because of the general nature of Mr Fry’s statements it is not possible to ascertain the scale of use in respect of the goods relied upon by the opponent. Where turnover figures have been provided, they are not broken down in such a way as to ascertain what proportion relates to the sale of garments. Further, Mr Fry states that due to their high cost, “a large number of the cleanroom garments bearing the MICROCLEAN trade mark are supplied to customers under rental agreements...” This raises the question of what proportion does the opponent actually sell. This is not answered in the evidence.

23) At the hearing, Mr Fiddes submitted that when the exhibits (and in particular the 2013 catalogue at Exhibit SJF7) were viewed together with Mr Fry’s statements that direct sales of garments bearing the MICRONCLEAN mark have been provided to cleanroom operators since as early as 1986 illustrates a longstanding use of the opponent’s mark in respect of numerous specialist garments.

24) Whilst I am of the view that the evidence could have been better marshalled, I agree with Mr Fiddes that the overriding impression created by the evidence is that the opponent has been selling specialist garments identified by the mark MICRONCLEAN for some time and has continued to do so through the relevant period. Whilst it is not possible to ascertain the precise quantum of such use, there is a statement from Mr Fry that the opponent sells MICROCLEAN branded garments, there are two catalogues showing MICROCLEAN branded garments and there is a Competition & Markets Authority decision recording the fact that the opponent sells disposable cleanroom apparel.

25) Taking all of the above into account, whilst noting the flaws in the opponent's evidence, I conclude that it illustrates that in respect of the goods relied upon, that it has demonstrated genuine use in the relevant period. As a consequence it may rely upon all the goods it set out in paragraph 2, above.

Section 5(2)(b)

26) Sections 5(2)(b) of the Act is as follows:

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

(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”.

Comparison of goods

27) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

28) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

29) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05 (*MERIC*), the General Court (“the GC”) stated that:

“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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

30) All of the opponent's goods are specialist items covered by the broader terms of the applicant's specification and applying the guidance in *MERIC*, I conclude that they are identical as submitted by Mr Fiddes.

Comparison of marks

31) It is clear from *Sabel BV v Puma AG*, Case C-251/95 (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

32) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

33) The respective marks are:

Opponent's earlier marks	Contested mark
MICRONCLEAN micronclean	MICRON

34) The opponent's marks consist of the two words MICRON and CLEAN conjoined, however, the two words retain individual character and the average consumer is likely to naturally divide the mark into these two words. The first word MICRON means “a unit of length equal to one millionth of a metre, used in many technological and scientific fields”¹. Therefore, it has no obvious meaning in respect of the opponent’s goods. The word CLEAN will be commonly understood as a reference to being free from dirt or stains and has an allusive quality in respect of garments for use in “clean” environments, as many of the opponent’s garments are. The word MICRON is the dominant and distinctive element. The applicant's mark consists of a single word MICRON being the dominant and distinctive element.

35) Visually, the marks share similarity because of the common occurrence of the MICRON element in both marks. They differ in that the opponent’s mark also includes the element CLEAN conjoined to the first element. Taking this into account, I conclude that the respective marks share a medium level of visual similarity. Aural considerations are similar with the first two syllables MY-CRON present in both marks and the syllable CLEEN being an additional element of the applicant’s mark. There is a medium level of aural similarity.

36) Conceptually, as I have already noted, MICRON means “a unit of length equal to one millionth of a metre, used in many technological and scientific fields”, however, it is not obvious to me that the average consumer of clothing will be aware of this meaning and applying the guidance of Anna Carboni, sitting as the Appointed Person in *Chorkee*, BL O-048-08, it would be wrong for me to assume otherwise. I concede that where the opponent’s goods are aimed at laboratory uses, there is a greater likelihood that the average consumers may know the meaning of the word, but because this is only a subset of the opponent’s target consumers, I reach the same conclusion regarding the opponent’s average consumer as for those of the applicant, namely MICRON is likely to be perceived as a made up word or possibly a recognised word but with the precise meaning not known. The word CLEAN is an ordinary dictionary word that will be readily understood by average consumers.

¹ <https://en.oxforddictionaries.com/definition/micron>

Taking all of this into account, I conclude that the respective marks share a medium to medium high level of conceptual similarity.

Average consumer and the purchasing act

37) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

38) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

39) The average consumer of the applicant's goods are both the ordinary clothes purchasing public and the specialist clothing purchasing public that may overlap with the average consumer of the opponent's goods. I see no reason why I should assume that the average consumers of the parties' goods are any different to that identified by Birss J. above. The GC has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPOORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). I conclude that the purchasing process is primarily a visual one. However, I do not ignore that aural considerations

may play a part and that this is more likely when specialist, functional clothing of the sort that the opponent sells is involved.

40) In respect of clothing per se, the purchasing act will, generally involve a reasonable degree of care and attention but not the highest degree of attention. This is likely to be elevated slightly in respect of the specialist clothing of interest to the opponent, where the consumer will pay particular attention to the technical features of the goods.

Distinctive character of the earlier trade mark

41) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

42) The opponent's mark consists of the conjoined words MICRON and CLEAN. Whilst the word MICRON has a meaning, there is nothing before me to suggest that this meaning has any relevance in respect of the goods covered by the opponent's specification of goods. Therefore, the word has a normal level of distinctive character, neither the highest level, not low. The word CLEAN is strongly suggestive of clothing for use in clean room environments and is, therefore, of low distinctive character. When considering the mark as a whole with these observations in mind, I conclude that the mark is endowed with an average degree of inherent distinctive character.

43) I must also consider whether the mark benefits from an enhanced level of distinctive character arising from the use made of it. I have found that there has been genuine use of the mark in respect of the opponent's Class 25 goods, but observed that it is not possible to ascertain the quantum of use in respect of these goods because of the generality of the information provided in the evidence. Consequently, I am unable to conclude that the use made of the mark in respect of these goods is such that it has resulted in an enhanced level of distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

44) The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

45) I have found the following:

- The respective goods are identical;
- The dominant and distinctive element of the opponent's marks is the MICRON element;
- The respective marks share:
 - A medium level of visual and aural similarity;
 - A medium to medium high level of conceptual similarity.
- The average consumer of the applicant's goods includes both the clothes buying general public who is reasonably well informed and reasonably circumspect and also more specialist consumers of the same kind as for the opponent's goods and will have an elevated level of care and attention;
- The purchasing process is primarily visual in nature, but I do not ignore aural considerations and that the consumer pays a reasonable degree of attention during the purchasing process and this is increased for the purchasing process of the opponent's goods;
- The opponent's mark has a normal level of inherent distinctive character but the evidence fails to illustrate that it's distinctive character has not been enhanced through use.

46) When taking all the above findings into account, I find it unlikely that one mark will be confused for the other (so called "direct confusion") because of the shorter length of the applicant's mark and the addition of the word CLEAN conjoined to the first word. However, because of the allusiveness of the word CLEAN to the purpose of many of the opponent's goods, I find that the consumer is likely to perceive the opponent's mark as being a sub-brand of, or another brand coming from the same stable as the goods provided under the applicant's mark so that there will be a belief that the respective goods originate from the same or linked undertaking (so called "indirect confusion"). In reaching this conclusion, I have kept in mind that for there to

be a likelihood of confusion, it is irrelevant which way around the confusion occurs (see *Omega v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, para 43, Case T-90/05) and that the first part of a mark can play a greater importance in causing a likelihood of confusion (see *Enercon GmbH v OHIM*, T-472/07). Therefore, I find that there is a likelihood of indirect confusion.

47) As Mr Fiddes noted at the hearing, despite being offered the opportunity to put forward a fall-back position in the form of limited specification (in the Registry's letter of 31 October 2017), the applicant has not done so. As a consequence, and as I found earlier, the applicant's specification of goods consists of broad terms that describe categories of goods that include the opponent's goods. My finding of a likelihood of confusion takes this into account.

48) The opposition based upon section 5(2)(b) of the Act succeeds in its entirety.

Section 5(4)(a)

49) In light of my finding in respect of the grounds based upon section 5(2)(b), the opponent has been wholly successful and it is not necessary for me to also consider the grounds based upon section 5(4)(a).

Summary

50) The opposition is successful in its entirety and the application is refused in respect of the following goods:

Clothing, footwear, headgear

Costs

51) Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. I take account that only the opponent filed evidence, but that the applicant did not. Consequently, the amount awarded in respect of preparing evidence and considering the other side's evidence has been reduced (to a little below the

minimum on the scale). The opponent also filed written submissions and a hearing was held (but that the applicant did not attend). With all of this in mind, I award costs as follows:

Preparing statement and considering the counterstatement (including official fee)	£500
Preparing evidence	£400
Written submissions	£300
Preparation for, and attendance at hearing	£500
Total:	£1700

52) I order Micron Partners Limited to pay Micronclean Limited the sum of £1700 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 16th day of January 2018

Mark Bryant
For the Registrar
The Comptroller-General