

O-320-19

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO 3319945
BY GEMMA BRAY TO REGISTER:

THE ORGANISED MUM

AND

THE OPPOSITION THERETO UNDER NO 600001000 BY
BOXCLEVER PRESS LTD.

Background and pleadings


1. On 22 June 2018, Gemma Bray (the applicant) applied to register the above trade mark in classes 16, 24, 25 and 41. Since only one of these classes has been opposed, the relevant class for the purpose of this opposition reads as follows:¹

Class 16

Printed matter; printed publications; stationery; instructional and teaching materials; newspapers; periodicals; journals; newsletters; bulletins; magazines; books; directories; handbooks; manuals; brochures; pamphlets; leaflets; guides; exercise books; lever arch files; document folders and wallets; publicity materials; posters; postcards; certificates; gazettes; advertising materials and display materials; photographs; packaging materials; printers' type; printing blocks; parts and fittings for all the aforesaid.

2. The application was published on 7 September 2018, following which it was opposed under the fast track opposition procedure by Boxclever Press Ltd (the opponent).

3. The opponent bases its case on section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies upon the following UK Trade Mark (UKTM):

Mark details and relevant dates	Goods relied upon
<p>UKTM: 2406660</p>  <p>Filed: 9 November 2005 Registered: 12 May 2006</p>	<p>Class 16</p> <p>Stationery items including calendars, diaries, leather/imitation leather stationery covers, stickers, notebooks, files, folders.</p>

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

4. The applicant filed a counterstatement in which it denied the ground raised by the opponent.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. Neither side made such a request, although, the opponent filed evidence with its notice of opposition for the purpose of showing genuine use which is permitted by the Rules.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8. Neither party requested to be heard. Both filed submissions in lieu of a hearing. I make this decision based on careful consideration of the papers before me.

Proof of use requirement

9. In its counterstatement, at section 7 of the form, the applicant selected the box which indicates it does not require the opponent to prove use. However, the same part of that form makes clear that this section is not applicable in a fast track opposition. This is because, when an opponent elects to file a fast track opposition, relying on a trade mark which has been registered for more than five years at the date of publication of the application,² its evidence must be provided at the outset, with its TM7.

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

Consequently, I must go on to make an assessment of the opponent's use of its earlier mark, based on the evidence provided by the opponent, at the outset.

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

11. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions.

12. Section 6A of the Act reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

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

(b) there is an earlier trade mark 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.”

13. The application was published on 7 September 2018. The opponent’s earlier mark completed its registration procedure on 12 May 2006. Consequently, this mark is subject to proof of use, as per Section 6A of the Act. The relevant period is the five year period ending on the date of publication of the application, namely 8 September 2013 to 7 September 2018.³ The onus is on the opponent, under section 100 of the Act, to show genuine use of its mark during this period in respect of those goods relied on.

Evidence of use

14. The opponent’s evidence is included with its notice of opposition. It provides turnover figures from 2006 to 2016, however, only figures from September 2013 are relevant for these proceedings:

Year:	Turnover (£):
2013	593,083
2014	739,667
2015	903,360
2016	2,120,266

15. It submits that:

“All products sold by the business under the brand name Organised Mum were printed stationery items falling under class 16 – Printed matter.”

16. Advertising expenditure figures are provided, which in each case are exactly 10% of the turnover for that year.

³ I note that throughout the evidence and submissions of both parties, they state that the period for which use must be shown by the opponent is 30 January 2010 – 29 January 2015. Given that the period must end on the date of publication of the application, namely, 30 January 2015, the dates I have provided above represent the correct period and I will proceed on that basis.

17. Exhibit 1 is described by the opponent as photographs of, inter alia, home planners, life books, wall planners, catalogues and brochures.

18. Page 9 is a Boxhouse Publishing trade catalogue for 2013.⁴ The front cover has the word 'Boxhouse' towards the bottom, above the words, 'High quality calendars, diaries and stationery for busy homes and families.' To the right of the text is the earlier 'Organised Mum' trade mark.

19. The next page of that exhibit is a ring bound 'Home Planner' for 2013. The earlier mark is shown in the top right corner. The description of the product is printed on the front and reads, 'Large 16-month calendar to keep busy lives organised'. It includes 288 stickers and a pen.

20. The following page of this exhibit is photograph of a further ring bound 'Home Planner' for 2014. The earlier 'Organised Mum' mark is shown in the bottom right corner.

21. Page 13 shows a 'Life Book'. I cannot clearly see the date, which is pale text on a mid-tone background. The first three numbers of the date are '201_'. The earlier mark appears in the top right corner of the book cover.

22. Page 14 shows a 'Pocket Life Book' for 2016. It is described as a week-to-view, 16-month diary. The earlier mark is shown in the top right corner of the cover.

23. The next page shows a 2016/2017 Academic Wall Planner. The earlier 'Organised Mum' mark is shown at the top of the item.

24. Page 17 is the Boxclever Press Trade Catalogue for 2017. The earlier mark is shown on a white circular background in the top right corner.

25. Evidence is provided of a Family Weekly Planner for 2018. Boxclever Press is shown above the product title on the front cover. The earlier mark is shown in the top

⁴ Boxhouse Publishing was the previous company name used by Boxclever Ltd. Documentation showing the change of name has been provided in the evidence attached to the TM7.

right corner on the front cover. The next page of the exhibit is the inside of a family planner. Again, both Boxclever Press and the earlier mark are shown separately on the page. The product is described at the top of the page as, “The clever family calendar that will save you time.” It includes, columns for up to six family members. It starts in mid-August 2017 and lasts until December 2018. It also includes, ‘a time saving plastic overlay’, ‘288 colourful stickers’ and ‘a useful pocket for paperwork’.

26. Also included in the exhibit is what is described as a ‘fridge list’. The first page is the list itself, the second appears to be the back of the list. The earlier mark is shown at the top, with a description of the product below:

“Make weekly meal plans and shopping lists with this brilliant kitchen companion.

Can be placed on a fridge or hung on the wall

Each list is perforated so can be easily removed

Includes clip on pencil

Plus, handy pocket for storing recipes and vouchers.”

27. This concludes the summary of evidence which relates to the relevant period in these proceedings which is explained in the following paragraphs.

Use of the earlier mark

28. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. In *Walton International Ltd & Anot v Verweij Fashion BV*,⁵ Arnold J. summarised the case law on genuine use of trade marks:

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market* (Trade Marks and

⁵ [2019] EWCH 1608 (Ch)(28 June 2018).

Designs) [2006] ECR I4237, Case C-442/07 Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I-9223, Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C149/11 Leno Marken BV v Hagelkruis Behher BV [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P Centrotherm Systemtechnik GmbH V Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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 Section 5(2)(b) case law 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

29. I bear in mind *Awareness Limited v Plymouth City Council*, Case BL O/236/13, in which Mr Daniel Alexander Q.C. sitting as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

30. And further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence

should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

31. And *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*,⁶ Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be

⁶ Case BL 0/404/13

provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not '*show*' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

32. The opponent's evidence shows that its turnover in 2013 was in excess of £500,000 rising to in excess of £2 million in 2016. I bear in mind that I cannot take account of the whole of the figure for 2013 as the relevant period for the opponent to prove use begins in September of that year. The opponent has a UK website, www.organised-mum.co.uk, which it states has been used since its mark was registered in 2006, 'to market organised mum goods'. The photographs provided in evidence include the front covers of stationery catalogues produced by the opponent for 2013 and 2017, through which its goods are sold. The front pages of these catalogues provide a description of the goods which are described as, 'High quality calendars, diaries and stationery for busy homes and families.' Photographs of goods have been provided, and whilst this is usually in itself not particularly helpful without additional evidence relating to, at least, when the goods were sold, in this case the goods are somewhat time specific. The goods are, inter alia, planners, diaries and catalogues which clearly relate to a particular date or range of dates which are shown in each of the images. Furthermore, none of these items would be of any use outside the period to which they relate. For example, a 2016 diary ceases to be useful, in terms of planning, once 2016 has ended.

33. The opponent's website, catalogues and individual goods bear the trade mark which is the earlier mark relied on by the opponent.

34. The applicant submits that evidence of the time, date and place of use of the opponent's earlier mark is insufficient to show genuine use in the relevant period. In addition, it submits that the turnover figures are not properly supported.

35. I agree that the opponent's evidence could have been better marshalled. No invoices or examples of advertising have been provided. The website page is not dated, and the turnover figures have not been broken down by jurisdiction. However, these are low cost items for which the turnover figures are significant and even if the UK market for these goods is a small percentage of the overall total, I would find it to be sufficient. When considered as a whole, the evidence is just sufficient to show that the opponent has made genuine use of the earlier mark during the relevant period.

36. In framing a fair specification of the opponent's goods, I bear in mind *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:⁷

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

37. And in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*, in which Mr Justice Carr summed up the law relating to partial revocation as follows:⁸

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas*

⁷ BL O/345/10

⁸ [2016] EWHC 3103 (Ch)

Pink Ltd v Victoria's Secret UK Ltd [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

38. Bearing these cases in mind, I find that the opponent has shown use for diaries, planners, calendars and organisers. That is how the average consumer would refer to the goods and is neither too broad nor too pernicky.

The opposition

39. Section 5(2)(b) of the Act states:

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

(a)...

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

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

40. The following principles are gleaned from the decisions of the EU courts 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.

Comparison of goods

41. The goods and services to be compared are as follows:

The opponent's goods:	The applicant's goods:
<p>Class 16 Diaries, planners, calendars and organisers.</p>	<p>Class 16 Printed matter; printed publications; stationery; instructional and teaching materials; newspapers; periodicals; journals; newsletters; bulletins; magazines; books; directories; handbooks; manuals; brochures; pamphlets; leaflets; guides; exercise books; lever arch files; document folders and wallets; publicity materials; posters; postcards; certificates; gazettes; advertising materials and display materials; photographs; packaging materials; printers' type; printing blocks; parts and fittings for all the aforesaid.</p>

42. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

43. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

44. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁹ the General Court 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”.

⁹ *Case T- 133/05*

45. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“[...] 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”.

46. The purpose of examining whether there is a complementary relationship between goods is to assess whether the relevant public are liable to believe that responsibility for the goods lies with the same undertaking or with economically connected undertakings. As Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“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”.

47. I also bear in mind Mr Alexander’s comments in the same case, where he warned against applying too rigid a test when considering complementarity:

“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”.

48. Turning first to the broad terms contained in the applicant’s specification, the application includes the term stationery. The opponent’s goods are stationery items which are, in accordance with the principles in *Meric*, identical. For the same reason, the opponent’s goods may also be considered identical to the term ‘printed matter’ in the application, as they are goods included within the broader term.

49. Turning to the remaining goods in the application, I rely on the decision in *Separode Trade Mark* BL O-399-10 (AP) which held:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

Exercise books;

50. These goods have many uses, essentially being a collection of blank or lined pages within a cover. The opponent’s goods, on the other hand, are purchased already printed with, inter alia, the dates for the relevant year. In my own experience, some consumers will use a notebook or exercise book to keep their own journal, diary or planner, rather than using a printed diary or organiser of the type contained in the opponent’s specification. To that extent, there is a medium level of similarity between these goods. They may be in competition, in these limited circumstances, and there may be a degree of complementarity, though there is unlikely to be any coincidence in trade channels. Taking account of the goods to be compared, I find these goods to have a medium degree of similarity.

Lever arch files; document folders and wallets

51. These goods are for storing documents, papers, receipts and any number of other items. Whilst at first glance, they do not appear similar to the opponent’s goods, I note

that the opponent's organisers and planners include pockets for the storage of papers relevant to their function of enabling an individual or family to organise, inter alia, appointments, events and meals. The nature and trade channels for these goods are different but there is a possibility of these goods being in competition, for example, a family may keep its upcoming appointment letters in a document wallet or lever arch file or may choose to use a family organiser. The goods are complementary only to a very small degree, to the extent that they may be used together. However, any similarity is at a very low level.

Postcards; certificates; photographs;

52. Postcards may be blank for the consumer to add their own image or message, or may include an image or photograph and be purchased for their decorative function. They may be posted, kept or collected. Certificates may be already printed or blank for the consumer to complete themselves. Photographs take many forms and are purchased primarily for their aesthetic or decorative function. Having considered the users, uses, natures, trade channels, competition and complementarity between these goods and those of the opponent, I can find no meaningful areas of similarity between these goods and the opponent's goods. These are dissimilar goods.

Printed publications; newspapers; periodicals; journals; newsletters; bulletins; magazines; books; directories; handbooks; manuals; pamphlets; leaflets; guides; gazettes; brochures; instructional and teaching materials; advertising materials and display materials; publicity materials; posters

53. All of these goods in the application are used to convey information to the consumer. The content may be editorial, promotional or instructional, but in each case, its primary function is to give information to the user. This is different to the use of the opponent's goods which are to record information such as important dates, for past or future use. There may be a small degree of overlap to the extent that using an organiser or planner necessarily includes the recording of information, but it is the planning and organising which is key to these goods and that is carried out by the user. In the case of the applicant's goods, the information is provided to the consumer, by a third party in the form of, inter alia, an instruction manual or magazine. Taking account

of their plain, ordinary meanings, the uses and natures are different. The trade channels are likely to be different and the goods are neither complementary or in competition. I find these goods to be dissimilar.

Packaging materials

54. The applicant's goods are used by those wishing to package something for any number of reasons including, inter alia, in order to post something or to prepare a good for sale. The opponent's goods are clearly used to plan, organise and keep track of upcoming events. The uses are plainly different, as are their natures and the trade channels by which they reach the consumer. They are unlikely to be displayed in close proximity on websites or in stores and are neither complementary nor in competition. I find these goods to be dissimilar.

Printers' type and printing blocks

55. These will be used by someone wishing to print something, primarily printers, but may include a broader category of artists and creators. The opponent's stationery items will be used by members of the general public. The nature and uses are different, as are the trade channels and there is no complementarity between them. The goods are also not in competition. Having considered the relevant factors, I can find no similarity between these goods and the opponent's goods.

The average consumer and the nature of the purchasing act

56. In accordance with the above cited case law, I must determine who the average consumer is for the services at issue and also identify the manner in which those services will be selected in the course of trade.

57. 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*¹⁰, 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


¹⁰ [2014] EWHC 439 (Ch)

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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

58. The goods for which I have found there to be any similarity are normal everyday goods provided to members of the general public. The purchase is likely to be primarily visual, the consumer encountering such goods online, through a catalogue or in a bricks and mortar store. The goods are fairly low cost and fairly frequent purchases, or at least purchased at regular intervals (diaries being bought annually). The consumer is likely to pay at least an average degree of attention to the purchase, as they will need to ensure the goods are fit for their particular purpose, for example, whether an organiser is for the calendar year or academic year or whether a document holder is large enough.

Comparison of marks

59. The marks to be compared are as follows:

Opponent	Applicant
	<p style="text-align: center;">THE ORGANISED MUM</p>

60. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions

created by them, bearing in mind their distinctive and dominant components¹¹, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

61. With regard to the comparison to be made between the respective marks, the applicant submits:¹²

“25. It cannot be denied that the respective marks have a certain level of similarity, given that they share the words ORGANISED MUM. However, it is submitted that, on the overall impression, the respective marks are not confusingly similar.”

62. In addition, the applicant submits:

“26. It is noted that, in its submissions, the Opponent has referred to the potential use of the mark by the Applicant in a figurative manner.”

63. The applicant makes two points on this issue. The first is that the applicant cannot add evidence in its submissions in lieu of a hearing and secondly that the marks to be compared are those on which the opposition is based. I agree, on both counts, but pause to remind the applicant that fair and notional use of the application would include use of the mark in standard typefaces and colours.

64. The applicant’s mark is the words THE ORGANISED MUM presented in upper case and in plain black type with no additional stylisation. The overall impression of the applicant’s mark rests in the whole mark.

65. The opponent’s mark is a blue rectangle containing the words ‘Organised Mum’ in a fairly standard typeface. The rectangle sits below a stylised image of a woman who appears to be juggling six balls or circles, coloured alternately pink and blue. The woman’s dress is the same colour as the words and the same colour as the square which is turned through 45 degrees to form a diamond shape in the background. The

¹¹ Sabel v Puma AG, para.23

¹² See the applicant’s submissions dated 17 April 2019.

words and the device element make a roughly equal contribution to the overall impression of the mark.

Visual similarity

66. Visual similarity rests in the fact that both marks include the words 'ORGANISED MUM'. The only difference in the words is that the application has the additional word 'THE' at the beginning but, the opponent's mark has the additional device above the words, which has no equivalent in the application. I find these marks to be visually similar to a medium degree.

Aural similarity

67. With regard to aural similarity, the average consumer will not pronounce the device element in the opponent's earlier mark. The word elements of both marks are well known words in the English language with the only difference being the addition of 'THE' at the start of the applicant's mark. The marks are aurally very highly similar.

Conceptual similarity

68. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.¹³ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.¹⁴

69. Both marks refer to the concept of organised mums. In the case of the application the mark refers to a single mum, 'THE' organised mum. The opponent's mark does not include the definite article but is presented in the singular, meaning that the concept is still that of a single organised mum. I find these marks to be conceptually very highly similar.

¹³ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

¹⁴ See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, *BL O/048/08*, paragraphs 36 and 37.

Distinctive character of the earlier marks

70. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.¹⁵

71. It should be clear from my earlier assessment of the opponent's evidence that it falls short of showing that the opponent has enhanced the distinctiveness of its mark through the use made of it. In terms of inherent distinctiveness, the words 'Organised Mum' are of lower than average distinctiveness for goods whose purpose is to allow the consumer to organise themselves or their family. In addition, the earlier mark also includes a large figurative element. This is noticeable in the mark, playing a roughly equal contribution, and is likely to be seen as reinforcing the words, with the average consumer being most likely to see it as an illustration of a 'mum' juggling many 'balls' or tasks. Taking all relevant factors into account, I find the earlier mark, in its totality, to possess a slightly lower than average degree of inherent distinctiveness.

Likelihood of confusion

72. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹⁶ I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.

73. The parties' goods are, in some cases, identical, some are similar to a low degree and others are dissimilar.

¹⁵ *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

¹⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V paragraph 27*

74. I have found the average consumer to be a member of the general public. The level of attention paid to the purchase will be at least average and the purchase will be primarily a visual one. The respective marks possess a medium degree of visual similarity and are aurally and conceptually very highly similar. The earlier mark has a slightly lower than average degree of inherent distinctive character.

75. The types of confusion were explained in *L.A. Sugar Limited v By Back Beat Inc*,¹⁷ by Mr Iain Purvis Q.C., sitting as the Appointed Person:

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

76. Furthermore, in *Duebros Limited v Heirler Cenovis GmbH*,¹⁸ Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

77. With regard to the ‘common element’, I bear in mind *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed

¹⁷ BL O/375/10

¹⁸ BL O/547/17

out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

78. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

79. In this case, the purchase of the goods will be made based on primarily visual considerations and the consumer will pay at least an average level of attention to the selection of the goods at issue. The goods themselves vary in similarity from being identical to having only a low degree of similarity. In terms of direct confusion, the visual differences between the marks are sufficient to avoid the consumer thinking that one mark is the other mark. However, whilst I acknowledge that the degree of visual similarity is lower than the other factors, this is a case in which the very high conceptual similarities outweigh the differences when indirect confusion is considered. I remind myself of the question asked by Mr Purvis above, ‘what it about the earlier mark is that gives it its distinctive character?’. In this case, it is the ‘organised mum’ concept which is reinforced by the figurative element in the earlier mark and notwithstanding the fact that the distinctiveness of the common element is lower than average it is still likely to lead the average consumer to believe that the contested mark is another mark in the

'organised mum' range. There is a likelihood of indirect confusion, for all of the goods where I have found there to be a degree of similarity.

CONCLUSION

80. The opposition fails in respect of the following, as these goods are not similar to any goods contained in the opponent's specification:¹⁹

Printed publications; instructional and teaching materials; newspapers; periodicals; journals; newsletters; bulletins; magazines; books; directories; handbooks; manuals; brochures; pamphlets; leaflets; guides; publicity materials; posters; postcards; certificates; gazettes; advertising materials and display materials; photographs; packaging materials; printers' type; printing blocks.

81. The opposition succeeds prima facie, under section 5(2)(b) of the Act against the following goods, where I have found there to be some similarity between these goods and the opponent's:

Exercise books; lever arch files; document folders and wallets.

82. I turn now to consider the two broad terms in the applicant's specification, parts of which will be identical to the opponent's goods.

Stationery

83. The applicant has applied for the broad term 'stationery' in its specification which, given that it includes the goods in the earlier specification for which I have found the earlier mark to be have been used, is bound to be identical.²⁰ In addition, I have found similarity, albeit at a low level between the opponent's goods for which use has been shown and a number of named stationery items included in the application.

¹⁹ See *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA and *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU).

²⁰ In accordance with the decision in *Meric*.

84. I do not propose to limit the specification for stationery as the term does not lend itself to suitable limitation which would avoid a likelihood of confusion. In accordance with my earlier conclusion, an average consumer familiar with one of the parties' marks, used for items of stationery, would, when encountering the other, on a different item of stationery, consider it to be part of the familiar 'Organised Mum' range of goods.

85. Such a conclusion is made in accordance with the Registry's practice with regard to the partial refusal of trade marks taken from Tribunal Practice Notice (TPN) 1 of 2012, paragraph 3.2.2(d), which reads:

"d) ...Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal."

'Printed matter'

86. I have identified that the broad term, 'printed matter' includes the opponent's goods which will lead to a likelihood of confusion. However, there are other types of printed matter which will not. In the circumstances, in accordance with TPN 1/2012, paragraph 3.2.2, I invite the applicant to file a revised specification and accompanying submissions detailing any types of goods it wishes to register that:

- a) Fall within the ambit of "printed matter";
- b) Fall within the scope of this decision in that the goods so specified have no similarity to 'diaries, planners, calendars and organisers';
- c) Do not fall foul of the guidance issued by the CJEU in the *Postkantoor*²¹ decision;

²¹ CJEU case C-363/99

87. The applicant's written submissions should explain why it considers the terms to be within the scope of my decision. A period of 14 days from the date of this decision is permitted for such action. Upon receipt of the above, the opponent will be allowed 14 days to comment on any proposed terms and I will then issue a supplementary decision in which I will decide whether any proposed terms are free from objection. If the applicant puts forward no revised terms then I will issue a supplementary decision confirming that the broad term 'printed matter' may include goods which are the same or similar as those contained in the opponent's specification. Consequently, there will be a likelihood of confusion.

88. The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision which will also include a decision on costs.

Dated 6 June 2019

**Al Skilton
For the Registrar,
The Comptroller-General**