

**BL O-066-21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERNATIONAL REGISTRATION DESIGNATING THE  
UNITED KINGDOM NO. 1459845  
BY GUANGDONG SAMADOYO INDUSTRIAL CO., LTD  
TO REGISTER:**

**sama  
GLAS**

**AS A TRADE MARK IN CLASS 21**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 416922  
BY SAHM GMBH & CO KG**

## BACKGROUND & PLEADINGS

1. On 15 November 2018 (claiming an International Convention priority date of 12 July 2018 from an earlier filing in China), Guangdong Samadoyo Industrial Co., Ltd (“the applicant”) designated the United Kingdom seeking protection of the trade mark shown on the cover page of this decision for the following goods in class 21:

Daily glassware [including cups, plates, pots, cylinders]; kitchen utensils; drinking vessels; daily porcelain [including pots, bowls, plates, pots, jars, cans]; daily pottery [including pots, bowls, plates, jars, jars, pots, casseroles, pots, pottery utensils]; works of art of porcelain, ceramic, earthenware, terra-cotta or glass; enamelled glass, not for building; bottles; cleaning instruments, hand-operated; coffee percolators, non-electric.

The designation was published for opposition purposes on 12 April 2019.

2. On 10 July 2019, the designation was opposed in full by SAHM GmbH & Co KG (“the opponent”), relying upon a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In its Notice of opposition, the opponent indicates that it relies upon the goods and services (shown below) in International Registration no. 545507 for the trade mark (shown below) which designated the United Kingdom on 10 March 2006 and which was granted protection in the UK on 9 March 2007:

# sahm

**Class 21** - Utility and decorative objects made of earthenware, ceramic, porcelain, glass and tin for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses.

**Class 40** - Services for perfecting glassware, porcelain and earthenware, especially engraving, cutting, etching, printing, inscribing, painting.

3. The opponent indicates that in the five year period ending on the priority date of the designation being opposed, its trade mark had been used in relation to the following goods and services:

**Class 21** - Utility and decorative objects made of glass for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses.

**Class 40** - Services for perfecting glassware.

4. The applicant filed a counterstatement in which the basis of the opposition is denied. Inter alia, in its counterstatement, the applicant states:

“1. The applicant GUANGDONG SHANGMING INDUSTRIAL CO., LTD. Founded in 2009, a company located in Guangzhou, China. As an integrated company, its business involves wholesale and retail of ceramics and glassware, it is a high-end glassware manufacturer. The applicant combines traditional Chinese craftsmanship with contemporary design. Its business cover throughout Asia, including China, Korea and Malaysia.

2. The applicant's mark was created by the applicant on his own, name after the applicant's Chinese name. The applicant's name contains "SHANGMING", while it would be too long as a trademark for customers to remember, so the applicant transliterated it into "SAMA", which would be easier to remember both for home and abroad customers.

3. The applicant has built up a reputation in respect of goods in class 21 for years of honest use in China and other countries, local customers are impressed by the applicant as well as applicant' s mark. The mark "SAMA" is therefore unique and meaningful for the applicant.”

5. In these proceedings, the opponent is represented by Marks & Clerk LLP and the applicant by Bayer & Norton Business Consultants Ltd. Only the opponent filed

evidence (which was accompanied by written submissions). Neither party requested a hearing nor did they elect to file written submissions in lieu of attendance.

### **The opponent's evidence**

6. I begin by noting that on 22 January 2020, a Case Management Conference (“CMC”) was held (before a different Hearing Officer) to consider the volume of evidence filed by the opponent. Following that CMC, the opponent was directed to remove exhibit 3 and to reduce the number of pages in exhibits 6 and 9 to twenty and ten pages respectively. The opponent complied with those directions on 30 January 2020.

7. The opponent's evidence consists of two witness statements, dated 11 and 25 November 2019, from Michael Sahm, the opponent's Managing Director, a position he has held since January 2004. Mr Sahm explains that the opponent was established in Germany in 1900, adding that the “SAHM sign” has been used for over a century on the opponent's goods and services. He adds that the opponent entered the UK market in 2010, when the European Malt Company Limited (“EMCL”) became the opponent's licensee/distributor in the UK and Ireland. Mr Sahm states:

“4. Since its inception in 1900 my company has become one of the world leading manufacturers and suppliers of glasses to the beverage industry...My company develops glasses individually tailored to the flavour profile of a brand. In addition to glass manufacturing my company also offers a specialist glass personalisation service through its modern decoration technology. This service is offered mainly to businesses including breweries but also to anyone who wants to buy quality, personalized drinking glasses...”

8. Mr Sahm explains that through EMCL:

“5...as well as other UK customers including large, well known breweries such as Kingfisher Beer Europe Limited, Meantime Brewery Company Limited, Freedom Brewery Ltd (Staffordshire), Camden Town Brewery (London), Shepherd Neame Ltd, Northern Whisper Brewing Co Ltd and Marston's Beer Company my company has extensively used the SAHM sign throughout the UK [during the relevant period] for the production manufacture and sale of

beer glasses, spirit glasses, wine & champagne glasses, soft drink glasses, coffee and tea glasses and tempered glasses. My company also decorates these glasses with designs and logos requested by different customers. This is an additional service offered over and above manufacture of plain, unembellished glasses. The design methods include engraving, cutting, etching, printing, inscribing painting and decoration by decal..."

He adds:

"5...My company commenced promoting these goods to UK customers under the "Products" page of my company's website on 28 August 2012 and continue to promote them today..."

9. Exhibit 1 consists of pages obtained from [www.sahm.de/en](http://www.sahm.de/en) on 28 November 2019, accompanied by pages from the same website obtained from the waybackmachine Internet archive dated (in the order in which they appear in the exhibit), February 2013, May 2016, June 2013, October 2014, February 2015, August 2014, June 2018, June 2017, June 2018, May 2016 and February 2015. The word the subject of the trade mark being relied upon can be found in the various pages in the following formats:

**SAHM**

and "SAHM", with the goods and services shown as described by Mr Sahm.

10. Mr Sahm states that his company's "beverage glasses" are sold to restaurants, breweries, bars and public houses across the UK, adding that between 2013 and 2018, the opponent issued "over 1800 invoices to UK customers." I note that in 2014, 2015, 2016 and 2017, the opponent issued 354, 386, 279 and 245 invoices respectively. Exhibit 2 consists of a range of invoices (which include reference to "Sahm VAT No. DE...") issued by the opponent to undertakings based in the UK; all of the order dates are within the relevant period. I note the value of a number of the invoices (expressed in GBP) are, for example, £8,101.81 (24/4/2017), £12,180.85

(9/2/2018), £20,135.32 (9/10/2015), £8,203.86 (6/7/16), £11,843.34 (10/8/2016), £10,868.55 (23/9/16) and £23,303.74 (3/7/2018).

11. Exhibit 4 consists of, inter alia, a range of invoices for what Mr Sahm refers to as the opponent's "personalisation services for beverage glasses". All of the invoices are to undertakings based in the UK and all of the order dates are within the relevant period. The Declarations of conformity provided refers to "Sahm GmbH + Co KG" as the "Manufacturer." Mr Sahm states:

"9...To give you an idea of the gross income generated from the sales of glass products with the decorative service in the UK, the approximate total is £358,000 (to the nearest thousand) for the sample invoices alone."

12. Mr Sahm states that the opponent provides its personalised glass services to a range of breweries and brands which are very well known and have a reputation in the UK, including Beck's, Bud Light, Peroni, MGD, Kingfisher, Kirin Ichiban, Bitburger and Erdinger. Mr Sahm describes exhibit 5 as:

"10...promotional material which lists other popular brands used in the UK that we provide our products and services to under the SAHM sign..."

13. As far as I can tell, many of the pages provided contain no date information. Mr Sahm states:

"11. As a natural extension of my company's product offering, it also sells a range of reusable cups and drinking vessels. This product range includes plastic beer tankards, plastic campaign cups, plastic wheat beer cups and plastic wine cups..."

He adds:

"11...My company commenced promoting these goods to UK customers under the "Products" page of my company's website on 6 September 2012 and they continue to be available for sale through my company's

website...and catalogue...My company's decorative and personalisation service also extends to non-glass drinking vessels..."

14. Exhibit 6 consists of pages obtained from [www.sahm.de/en/products/plastic-glasses](http://www.sahm.de/en/products/plastic-glasses) on 2 December 2019 accompanied by pages obtained from the waybackmachine Internet archive dated February 2018. The first page of the exhibit printed on 2 December 2019, contains references to:

"No breakages no worries – our reusable cups"

and:

"In collaboration with ou...(text not visible) partners at Adoma, we (text not visible) broad range of plastic products in addition to traditional glass and decoration designs. The SAHM plastic product r...(text not visible) anything but a last-res"...(text not visible).

15. As far as I can tell, the earlier trade mark does not appear in the pages from 2018 which, instead, contains a reference to "ADOMA® forming solutions."

16. Mr Sahm states that the opponent has invested significantly in advertising and marketing its goods and services "under the SAHM brand in the UK." He explains that the opponent "has a product catalogue which is directed to UK consumers", adding that the catalogue can be downloaded from the opponent's website. Examples of the opponent's catalogue entitled "THE TASTE" from "01" and "02" 2017 which bear the opponent's trade mark and which contain text in German and English are provided as exhibit 7, as are further pages from the opponent's websites printed on 28 November 2019.

17. Mr Sahm states that the opponent is a Bronze Member of the Society of Independent Brewers ("SIBA") which, he explains, is a UK trade organisation established in 1980. SIBA represents around 830 independent craft breweries and provides information about the industry. Mr Sahm explains that the opponent regularly features on the SIBA website, adding that the opponent also regularly

attends SIBA trade shows such as SIBA BeerX UK which takes places annually. He further explains that the opponent has:

“13...most recently attended the two day beer and brewing exhibition in 2019, as well as in 2013 and in Liverpool on 14-15 March 2018 to promote goods and services sold under the SAHM brand to representatives of the brewing industry.”

18. Exhibit 8 consists of promotional material which bears the opponent’s trade mark. A number of the pages can be dated i.e. page 2 from June 2016 (i.e. “BEV EXPO Manchester”) and pages 5 and 6 from 2018 (“SIBA BEER X”). A number of the pages provided which refer to “SIBA Beer X” appear to be undated.

19. Exhibit 9 consists of pages downloaded from [www.siba.co.uk](http://www.siba.co.uk) on 8 November 2019 in which the opponent is listed. Also included is a copy of the SIBA Journal from March 2014 which contains an article entitled “Sahm – The glass for top brands” and which, inter alia, also contains a reference to the opponent in the “Advertiser’s index”. The exhibit also contains an entry from “The SIBA Trade Directory 2012” which, under the heading EMCL, contains a reference to [www.sahm.de](http://www.sahm.de) and to “Agent for Sahm.” In his second statement, Mr Sahm states:

“5...To give you an idea of the cost, my company pays approximately £570 for each feature...”

20. Exhibit 13 consists of invoices dated 30 October 2017 and 19 January 2018 from Media Alive Limited to the opponent in respect of the “SIBA Journal – Autumn 2017” and “Winter 2018” respectively, each for the amount Mr Sahm identifies. Exhibit 14 consists of invoices from SIBA to the opponent dated 4 January and 1 October 2017 in respect of its “Supplier Associate Member” (£262.50) and “Standard Membership” fees (£450) respectively.

21. Exhibit 15 consists of invoices from SIBA to the opponent dated 20 January (in the amount of £1,116) and 13 November 2017 (in the amount of £1168.99) in respect of the opponent’s attendance at the 2017 and 2018 BeerX trade shows.



22. Mr Sahm states that the opponent has a LinkedIn presence and has had a Facebook account from 2014; it is stated that the latter has 623 followers and 589 likes (at, I presume, the date of his statement). Exhibit 10 consists of an extract from [www.linkedin.com](http://www.linkedin.com) printed on 28 November 2019 referring to the opponent. Also included is a page from Facebook which refers to “Oktoberfest 2018”. The word the subject of the earlier trade mark can be seen in both. Mr Sahm states that the opponent:

“16...sells glasses and designs specifically for Oktoberfest to breweries and event organisers in Germany and abroad. My company also sells plastic goods in Andin cases and the original Oktoberfest tankard.”

23. What appears to be undated examples are provided in exhibit 11. The exhibit also includes pages from the opponent’s website printed on 28 November 2019.

24. Finally, Mr Sahm states that the opponent has:

“17.. won a substantial number of awards for its innovative decorative technology and excellent glass design.”

25. Exhibit 12 contains pages from the opponent’s website obtained using the waybackmachine Internet archive dated (in the order they appear in the exhibit) June 2016, January 2017, October 2016, September 2016, May 2016, February 2016, April 2015, November 2014 and January 2014. While I have noted these awards, it is not necessary for me to record them here.

26. That concludes my summary of the evidence filed to the extent I consider it necessary.

## **DECISION**

27. The opposition is based upon section 5(2)(b) of the Act which reads 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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

28. The trade mark being relied upon by the opponent qualifies as an earlier trade mark under the provisions of section 6 of the Act. As this earlier trade mark had been protected for more than five years at the priority date of the designation, it is subject to the proof of use provisions. As I mentioned earlier, in its Notice of opposition the opponent stated it had used its trade mark in relation to the goods and services shown in paragraph 3 above.

### **Scope of the request for proof of use**

29. Question 7 on the Form TM8 (“Notice of defence and counterstatement”) reads:

“Do you want the opponent to provide proof of use?”

The applicant ticked the “Yes” box, below which the following appears:

#### **“List of goods and/or services**

List goods/services for which you require proof of use.”

In response to the above, the applicant stated:

“All goods in the UK registrations as the opponent relies on in their notice of opposition should be provided “proof of use.” (my emphasis).

30. As I mentioned earlier, the opponent is relying upon goods in class 21 and services in class 40. As the applicant has only asked the opponent to make good its claim in relation to the “goods”, the opponent is entitled to rely upon all the services in class 40 shown in paragraph 2 without having to demonstrate it has used its trade mark in relation to such services.

## **PROOF OF USE**

Section 6A:

31. This reads as follows:

“(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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

32. In reaching a conclusion, I must apply the same principles as I would if I were considering an application for revocation based upon non-use. The relevant five-year period is 13 July 2013 to 12 July 2018.

33. I begin by reminding myself that section 100 of the Act reads:

“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.”

34. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on genuine use as follows:

“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 Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer 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 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].”

35. In *Laboratoire de la Mer Trade Mark* [2006] FSR 5, the Court of Appeal held that sales under the trade mark to the trade may qualify as genuine use. Neuberger L.J. (as he then was) stated that:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as

explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

36. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated:

“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.”

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.”

37. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated:

“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 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.”

### **Overview of the opponent’s evidence**

38. I begin by noting that the applicant has elected not to challenge/comment upon the opponent’s evidence.

39. As the opponent’s Managing Director since 2004, Mr Sahm appears well placed to give evidence on its behalf. He indicates that the opponent entered the UK market in 2010 when EMCL became its licensee/distributor in the UK and Ireland, with trade via its own website commencing in 2012. In his evidence, Mr Sahm states that the opponent’s goods and services are offered “to anyone who wants to buy quality, personalised drinking glasses”. However, in its written submissions, the opponent states:

“12. The Opponent has been operating in the UK since 2010 as a world leading manufacturer and supplier of glasses to the beverage industry...”

40. Although the opponent’s trade mark is registered in the form shown in paragraph 2 above (i.e. in bold lower case letters), in the evidence provided, the opponent has used its trade mark in upper case letters i.e. “SAHM” and in the slightly stylised format shown in paragraph 9 above, both of which qualify as use of the trade mark as registered. Although some of the evidence is undated or dated after the relevant period, when considered as a totality, it shows that within the relevant period the opponent has used these trade marks in relation to, broadly speaking, a trade in a variety of glass drinking vessels in class 21 and services in class 40 related to the personalisation of glass drinking vessels, all of which are, on the basis of the evidence filed, provided to the beverage industry.

41. Although turnover figures by year have not been provided, I have highlighted the value of some of the invoices provided in exhibit 2 at paragraph 10 above and, in his statement, Mr Sahm estimates the value of the invoices provided as exhibit 4 at some £358k. Although it appears the opponent may also conduct a trade in reusable cups and drinking vessels and services related to the personalisation of such goods, the evidence in this regard is inconclusive and no separate turnover figures (or even estimates) have been provided for such goods and services.

42. The opponent promotes its goods and services sold under its earlier trade mark by means of, inter alia, a product catalogue and its website. It is also a member of SIBA and has, during the relevant period, attended trade shows in the UK to promote its goods and services. Finally, the opponent has had a Facebook presence since 2014 and, between 2014 and 2016, has won a number of awards, although it is not clear to me how many of these awards relate to the UK.

### **Conclusion on genuine use**

43. On the basis of the evidence provided, it is clear that the opponent does not conduct a trade in relation to all utility and decorative objects made of glass for household and industrial use. Rather, its trade is, as it submits, as a “manufacturer and supplier of glasses to the beverage industry” and for personalisation services relating thereto (although the services relied upon are not the subject of the request for proof of use). With that in mind, I am satisfied that within the relevant period the opponent has made genuine use of its earlier trade mark in relation to the following goods:

Drinking vessels such as glasses, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses; all being utility and decorative objects made of glass for household and industrial use.

### **What constitutes a fair specification?**

44. Having reached that conclusion, I must now go on and determine what constitutes a fair specification. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK)*

*Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“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.”

45. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“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 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."

46. The opponent's relies upon use on the following goods in class 21:

Utility and decorative objects made of glass for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses (my emphasis)

47. I have found that the opponent has used its trade mark on:

Drinking vessels such as glasses, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses; all being utility and decorative objects made of glass for household and industrial use.

48. On the basis of the evidence provided, the specification in paragraph 47 above represents what I consider to be a fair specification and it is on the basis of those goods and the services in class 40 (which are not the subject of the applicant's request for proof of use), I shall conduct the comparison which follows.

## Section 5(2)(b) of the Act

### Case law

49. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts. The following principles are gleaned from the decisions of the courts of the European Union 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.

The principles:

- (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 greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

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

<b>The opponent's goods (following the proof of use assessment) and services (not subject to proof of use)</b>	<b>The applicant's goods</b>
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<p><b>Class 21</b> - Drinking vessels such as glasses, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses; all being utility and decorative objects made of glass for household and industrial use.</p> <p><b>Class 40</b> - Services for perfecting glassware, porcelain and earthenware, especially engraving, cutting, etching, printing, inscribing, painting.</p>	<p><b>Class 21</b> - Daily glassware [including cups, plates, pots, cylinders]; kitchen utensils; drinking vessels; daily porcelain [including pots, bowls, plates, pots, jars, cans]; daily pottery [including pots, bowls, plates, jars, jars, pots, casseroles, pots, pottery utensils]; works of art of porcelain, ceramic, earthenware, terra-cotta or glass; enamelled glass, not for building; bottles; cleaning instruments, hand-operated; coffee percolators, non-electric.</p>
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51. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

52. 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 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.

53. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

54. 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 General Court ("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”.

55. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“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.”

Whilst on the other hand:

“.....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.”

56. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“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”.

57. In *Separode Trade Mark* (BL O-399-10), the Appointed Person stated:

“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.”

58. That is the approach I shall adopt with the applicant’s goods shown below in bold.

59. To begin with, I agree with the opponent that the use of the word “including” in the applicant’s specification and the use of the word “especially” in its specification in class 40 do not amount to limitations. As the applicant’s specification is unlimited, it would include such goods being supplied to the trade.

**Daily glassware [including...]**

60. As the above term is broad enough to include glassware for use in drinking, to that extent the competing goods are to be regarded as identical on the *Meric* principle. In relation to those goods which fall within the above term which are not for use in drinking (of the type identified by the applicant), the users will be the same as will the nature of the goods, although the intended purpose and method of use are likely to differ. However, as such goods are likely to pass thorough the same trade channels and may be sold in close proximity to one another in, for example a supermarket, considered overall, there is, in my view, between a low and medium degree of similarity between the opponent’s goods and the goods of the type identified by the applicant which fall within the broad term mentioned above.

**Kitchen utensils**

61. In its submissions, the opponent states:

“35. The contested term '*Kitchen utensils*' is a broad term. The word 'utensils' is defined by the Oxford English dictionary as 'a tool that is used in the

house'...This term is considered similar to the Opponent's '*drinking vessels*' and '*glassware*'... In addition, glasses are generally sold down the same aisles in supermarkets as kitchen utensils.”

62. In its submissions, the opponent refers to two decisions of the EUIPO in support of the above. However, as the opponent accepts that these decisions are not binding upon me, I do not intend to refer to them here. I shall, of course, bear their contents in mind.

63. I agree with the opponent that “kitchen utensils” is a broad term which, I note, collinsdictionary.com defines as: “a utensil intended for use in a kitchen, such as a chopping board, saucepan, or knife.” I am satisfied that the average consumer will understand the term in the manner described. The applicant’s “kitchen utensils” would include such goods made of glass. Thus the nature of the competing goods may be the same. Although the intended purpose and method of use may differ, the users may be the same and the competing goods may move through the same trade channels. Considered overall, I regard the degree of overall similarity as being of between a low and medium degree.

### **Drinking vessels**

64. As the opponent’s specification includes the same term (albeit in relation to goods made of glass), to that extent the goods are to be regarded as identical on the *Meric* principle. In relation to “drinking vessels” not made of glass, while the nature will differ, the users, intended purpose, method of use and trade channels will overlap and there is also likely to be a competitive relationship in play. Considered overall, the applicant’s “drinking vessels” not made of glass are highly similar to the opponent’s goods.

### **Daily porcelain [including...], daily pottery [including...]**

65. In its submissions, the opponent states:

“36. '*Daily porcelain [including pots, bowls, plates, pots, jars, cans]*' and '*Daily pottery [including pots, bowls, plates, jars, jars, pots, casseroles, pots, pottery utensils]*' is similar to the Opponent's Registration for glass '*Utility and*

*decorative objects made of ... glass*'. This is because porcelain and pottery are ceramic materials that are frequently used for tableware. Tableware goods would be used together with the Opponent's glass goods at the same time of day, for example at the dinner table, where food is served into bowls, plates and pots whilst beverages are served in glasses. These goods may be sold alongside the same aisles in supermarkets and homeware stores. For the reasons above, the goods are therefore similar. In addition, the goods may be in competition given that the term '*daily porcelain*' encompasses tea and coffee cups and these beverages are also served in glasses in the UK."

66. Although the users of the opponent's goods and those of the applicant may be the same, the nature of the competing goods differs. However, as the applicant's goods would include goods made of porcelain and pottery for use in drinking, the intended purpose and method of use may overlap as may the trade channels. In addition, there is, as the opponent points out, a likely competitive relationship between the opponent's glasses and at least some of the applicant's goods. In relation to those goods which fall within the above terms which may be for drinking there is, in my view, a high degree of similarity. In relation to those goods which fall within the above terms which are not for use in drinking (of the type identified by the applicant), the users will be the same, although the nature, intended purpose and method of use are likely to differ. However, as such goods are likely to pass through the same trade channels and may be sold in close proximity to one another in, for example a supermarket, considered overall, there is, in my view, between a low and medium degree of similarity between the opponent's goods and the goods of the type identified by the applicant which fall within the broad terms mentioned above.

### **Works of art of porcelain, ceramic, earthenware, terra-cotta or glass**

67. In its submissions, the opponent states:

"31. '*Works of art of porcelain, ceramic, earthenware, terra-cotta or glass*' is encompasses the Opponent's '*Utility and decorative objects made of ... glass*', given that 'works of art' (made of glass) is a subjective term that could

encompass the Opponent's '*decorative objects made of ... glass*'. The respective goods are identical.”

And:

“38. The Contested Application makes a claim for '*works of art of ... glass*' in class 21. In order for a work of art made of glass to be made it is not unforeseeable that the following services would be necessary or important: '*Services for perfecting glassware ... especially engraving, cutting, etching, printing, inscribing, painting*'. For this reason the term is complementary and therefore similar to the Opponent's services for perfecting glassware in class 40.”

68. Collinsdictionary.com defines “works of art” as, inter alia:

- “1. a piece of fine art, such as a painting or sculpture
2. something that may be likened to a piece of fine art, esp in beauty, intricacy, etc.”

69. I am satisfied that that is how the average consumer will understand the phrase. Whilst there may be an overlap in the nature of “works of art of...glass” and the users of the competing goods and services, having applied the guidance in *YouView*, I am unable to detect any meaningful degree of overlap in the intended purpose, method of use or trade channels nor, in my view, is there any competitive or complementary relationship in play. In my view, the goods identified in the designation above are not similar to the opponent's goods and services.

### **Enamelled glass, not for building**

70. In its submissions, the opponent states:

“32. '*Enamelled glass, not for building*' falls within the meaning of the Opponent's '*Utility and decorative objects made of ... glass*' and is therefore identical.”

And:

“39. The Contested Application's *'Enamelled glass, not for building'* is a broad term which could encompass enamelled beverage glasses. The term 'enamelled' or 'enamel' is defined as '*a decorative glass-like substance that is melted onto ... glass objects, and then left to cool and become hard*'... The Opponent's Registration covers '*services for perfecting glassware*'...The broad term '*services for perfecting glassware*' encompasses the process of enamelling glass. The process of enameling glass is necessary for the production of enameled glass goods and therefore complementary and similar to the service of enameling glass. In addition, the manufacture and sale of enameled glass to consumers, such as Breweries, goes hand in hand with the provision of services by glass manufacturers, where Breweries specifically request enameled beverage glasses bearing specific designs, brands or logos...”

71. The opponent's trade is in glasses, not glass per se; in my view, the competing goods are not identical. However, the opponent's services in class 40 would include, inter alia, the enamelling of glass. Although the nature of the competing goods and services differs, the users of the competing goods and services may be the same and, as the opponent suggests, there is also likely to be a complementary relationship between the goods and services in the sense outlined in the case law. Considered overall, there is, in my view, between a low and medium degree of similarity between the goods and services at issue.

## **Bottles**

72. In its submissions, the opponent states:

“33. '*Bottles*' may be made of glass and therefore could fall within the meaning of the Opponent's '*Utility and decorative objects made of ... glass*'. The goods are therefore identical.

34. In the alternative, 'bottles' encompasses bottles made out of glass. Glass bottles are similar in nature to the Opponent's beverage glasses, being objects made out of glass capable of being held in the hand. Their intended purposes are also similar, both being for the purpose of holding liquids and enabling consumers to drink. The goods are therefore highly similar, if not identical."

73. Insofar as the applicant's "bottles" would include, for example, bottles made of glass for drinking, the nature of the competing goods may be the same as may the users, intended purpose and method of use. As there is also, at least, a likely competitive relationship between the competing goods, for example, one may choose to drink from either a drinking bottle or a glass, it results in a fairly high degree of similarity between them. Insofar as "bottles" at large are concerned (including those not made of glass), the users will be the same, although the nature may differ as will the intended purpose and method of use. However, as such goods are likely to pass through the same trade channels and may be sold in close proximity to one another in, for example a supermarket, considered overall, there is, in my view, between a low and medium degree of similarity between the opponent's goods and the remaining goods which fall within the term mentioned above.

**Cleaning instruments, hand-operated; Coffee percolators, non-electric**

74. Despite its detailed submissions in relation to all of the other goods in the designation, the opponent has made no submissions in relation to the goods mentioned above. The irresistible inference is that the opponent was unable to identify any similarity between its own goods and services and those listed above. In those circumstances, I am not prepared to find there is any meaningful degree of similarity between the opponent's goods and services and the applicant's goods shown above.

75. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is



served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

76. Consequently, in relation to those goods shown below, there can be no likelihood and the opposition to these goods fails accordingly:

Works of art of porcelain, ceramic, earthenware, terra-cotta or glass; Cleaning instruments, hand-operated; Coffee percolators, non-electric

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

77. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods and services I have found to be identical or similar. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

78. The average consumer of the goods and services at issue is either a member of the general public or, as the opponent’s evidence shows, a business user. As the goods and services at issue are most likely to be obtained by self-selection from bricks and mortar outlets, from catalogues or on-line, visual considerations are likely to dominate the selection process, although not to the extent that aural

considerations in the form of, for example, requests to sales assistants and word-of-mouth recommendations can be ignored.

79. As to the degree of care that will be deployed when selecting the goods and services at issue, the cost of the goods and services at issue are likely to vary. However, even when considered in relation to those goods and services at the lower end of the price spectrum, as the average consumer will wish to ensure they select items which are, for example, of the correct style, size, colour, material etc and which bear the correct type of decoration, I would expect a member of the general public to pay a normal (medium) degree of attention to the selection of the goods and services at issue. As the opponent's evidence shows, when considered from the perspective of a business user in which very specific requirements may be in play and not insignificant costs involved, I would expect a business user to pay a fairly high degree of attention to the selection of all the goods and services at issue.



### **Comparison of the trade marks**

80. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, 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.”

81. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore

contribute to the overall impressions they create. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
	

### Overall impression

82. The opponent's trade mark consists of the single word shown above presented in a heavy bold, yet unremarkable font. The overall impression it conveys and its distinctive character lies in the single word of which it is composed.

83. The applicant's trade mark consists of two components, both of which are presented in a finer bold, yet still unremarkable font. In its written submissions, the opponent states:

“21...The position of the prefix 'SAMA' is visually dominant, appearing above the suffix 'GLAS', the suffix being descriptive for the goods applied for.”

84. The applicant's specification includes, inter alia, “Daily glassware” and, in its counterstatement, the applicant states that it is:

“1.. a high-end glassware manufacturer...”

85. Although the word “GLAS” in the applicant's trade mark will contribute to the overall impression it conveys, given its obvious visual and aural similarity to the English language word “GLASS”, I am satisfied that the average consumer will construe the word “GLAS” as the word “GLASS” and for goods in the designation which are made of glass, or may be made of glass, the word “GLAS” will be regarded as descriptive. However, even in relation to those goods which are not made of glass, given my comments above, any distinctive character the word

“GLAS” may possess will, in my view, be at best, low. Considered overall, it is in the first component in the applicant’s trade mark that the bulk of the distinctiveness lies and it is that component which will make by far the most significant contribution to the overall impression it conveys.

86. I shall bear the above conclusions in mind when conducting the visual, aural and conceptual comparison which follows.

### **Visual similarity**

87. In its written submissions, the opponent states:

“21. Visually the Contested Application would be broken down into two words by the UK consumer: "SAMA" and "GLAS". The prefix of the Contested Application, "SAMA" is highly visually similar to the Opponent's Registration, "SAHM", sharing three out of four of the same letters in the same sequence, differing by only one letter. In addition, the signs have the same beginning which increases the visual similarity, given that the English consumer reads from left to right. The Opponent's Registration consists of letters that are in a bold, black font. The letters are all the same height which is unusual as generally the first letter is capitalised. This stylisation is reproduced almost identically in the word 'SAMA' of the Contested Application. The position of the prefix 'SAMA' is visually dominant, appearing above the suffix 'GLAS', the suffix being descriptive for the goods applied for.”

88. Both parties’ trade marks are presented in varying bold fonts. The opponent’s trade mark consists of a four letter word presented in lower case letters as is the first component in the applicant’s trade mark. The first two letters of the opponent’s trade mark and the first component in the applicant’s trade mark are identical i.e. “sa” and both trade marks contain a letter “m”, albeit in differing positions. Although the word “GLAS” in the applicant’s trade mark is alien to the opponent’s trade mark, as I mentioned earlier, this word is likely to be equated with the descriptive word “GLASS”. Keeping that in mind, there is what I regard as between a low and medium degree of visual similarity between the competing trade marks.

## **Aural similarity**

89. In its counterstatement, the applicant states:

“6. By comparing the length and pronunciation, it can be seen the marks are different. The applicant's mark "sama glas" consists of eight letters, while the opposing mark "sahm" consists of four letters. Whilst it is agreed that an English speaker in the UK, and quite likely the average UK consumer generally, is likely to pronounce the opposing mark "sahm" in a phonetically similar way to the English word "some", such persons would not have any idea how to correctly pronounce the non-English language word "sama", and are just as likely to pronounce it as "summer".

90. In its written submissions, the opponent states:

“22. With regard to the phonetic comparison, the Opponent sees no reason why the general rule, namely that consumers pay more attention to the beginning of a sign, should not be applied in the present case. Having regard, also, to the fact that the suffix in the Contested Application would be pronounced identically to the word 'glass' and is clearly descriptive and non-distinctive for the goods applied for by the Contested Application. As can be seen from the evidence provided by the Opponent, the word 'glass' consistently features in marketing and promotional material alongside the 'SAHM' brand. Taking into account the silent 'h' in the Opponent's Registration, the sign "SAHM" would be pronounced almost identically to the prefix "SAMA" - "sarm" as against "sarm-a". It is submitted the ending of "sarm-a" and the "a" would ultimately be lost and blurred at the end of the mark. The ending in SAMA makes no material difference to the way it is pronounced, and the overall comparison with SAHM.”

91. If articulated at all (which is doubtful given many of the goods for which the applicant seeks protection), the word “GLAS” in the applicant’s trade mark will be pronounced as the word “GLASS”. Although I have no evidence as to how the average consumer will pronounce the opponent’s trade mark and the first component of the applicant’s trade mark, I do not agree with the applicant that the opponent’s

trade mark will be pronounced as the word “some” or that the first component in its trade mark will be pronounced as the word “summer”. In my view, the opponent’s trade mark is likely to be pronounced as “sarm” (as in “psalm”). As for the applicant’s trade mark, in my view, this is most likely to be pronounced as “sammer” or if the word “GLAS” is verbalised, as “sammer glass”. As the component that will be pronounced as “sammer” will be articulated first in both cases, it results, once again, in what I consider to be between a low and medium degree of aural similarity.

### **Conceptual similarity**

92. In its counterstatement, the applicant states:

“4. According to <https://en.wiktionary.org/wiki/Sahrn>, "sahm" is a known and recognised dictionary word in the English language meaning a surname. While "sama", on the other hand, may refer to different language with different meaning but does not have any meaning in English, see <https://en.wiktionary.org/wiki/sama>. These facts distinguish it immediately from the opposing "sahm" marks.

5. For native customers, they may recognise "sahm" as an English wording but "sama" as a non-English wording. It is submitted that "sama" immediately strikes and conveys the impression to the average English speaking reader, and likely also the average UK consumer, as being a foreign or invented word, none of these impressions being conveyed by the word "sahm".

93. In its written submissions, the opponent states:

“23. Conceptually, the Opponent's Registration has no meaning to the relevant consumer... In the Contested Application, the prefix "SAMA" also has no meaning, whereas the suffix "GLAS" would create associations in the minds of the UK consumer with "GLASS"...The suffix "GLAS" describes the goods applied for under the Contested Application...”

94. Although I have no evidence as to how the average consumer will conceptualise the opponent’s trade mark and the first component in the applicant’s trade mark, as I mentioned earlier, I am satisfied that the average consumer will treat the word

“GLAS” as the word “GLASS.” Although the applicant has explained how its trade mark was coined, that would not be known to the average consumer. The applicant submits that the opponent’s trade mark is “a known and recognised dictionary word in the English language meaning a surname.” In my view, the average consumer will treat the opponent’s trade mark and the first component in the applicant’s trade mark as either a foreign surname or as a foreign language word with which they are unfamiliar or as an invented word. In the first scenario it will send a concrete conceptual message, whereas in the latter two it will convey no conceptual meaning to the average consumer. I shall return to this point below.

### **Distinctive character of the earlier trade mark**

95. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

96. In its written submissions, the opponent states:

“42...the Opponent's Registration possesses a high degree of inherent distinctive character for beverage glasses and the decorative services for beverage glasses. In addition, owing to the Opponent's use of the sign in the UK since 2010...the Opponent's Registration possesses an enhanced degree of distinctive character...”

97. Although the use the opponent has made of its trade mark in relation to the goods and services mentioned above will have enhanced its distinctive character in relation to its business customers, as its trade mark enjoys a high degree of inherent

distinctive character, any enhancement which has taken place is unlikely to improve its position (at least to any material extent).

### **Likelihood of confusion**

98. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is 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 goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

99. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

100. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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



101. Earlier in this decision, I concluded that:

- where not identical, the remaining goods in the designation are similar to the opponent's goods and services to at least between a low and medium degree;
- the average consumer of the goods and services at issue is either a member of the general public or a business user who, whilst not ignoring aural considerations, will select the goods and services at issue by predominantly visual means whilst paying at least a medium degree of attention during that process;
- the competing trade marks are visually and aurally similar to between a low and medium degree
- while the word "GLAS" in the applicant's trade mark will convey a concrete descriptive message to the average consumer, the average consumer will treat the opponent's trade mark and the first component in the applicant's trade mark as either a foreign surname, as a foreign language word with which they are unfamiliar or as an invented word;
- as the earlier trade mark enjoys a high degree of inherent distinctive character, the use made of it will not improve the opponent's position to any material extent.

102. I have found that the visual aspect of the comparison is the most important and that the competing trade marks are only visually similar to between a low and medium degree. Although that is a point in the applicant's favour, as is the between low and medium degree of aural similarity, I also found that with the exception of the descriptive message likely to be conveyed by the word "GLAS" in the applicant's trade mark, the average consumer will conceptualise the opponent's trade mark and the word "sama" in the applicant's trade mark in the manner described above.

103. I have also found as the specification of the designation is unlimited, the applicant's goods may, like the opponent's goods, be directed at the trade, the average consumer for which will pay a fairly high degree of attention during the

selection process (thus making him/her less prone to the effects of imperfect recollection). However, although the word “GLAS” will contribute to the overall impression the applicant’s trade mark conveys, given my comments above about the descriptive nature of this word, in distinguishing between the competing trade marks, the average consumer will, for the most part, have to rely upon their imperfect recollection of the opponent’s trade mark and a component in the applicant’s trade both of which will either be treated as a foreign surname, as a foreign language word with which they are unfamiliar or as an invented word. Even in the first scenario, the surname is unlikely to be familiar to the average consumer and in the second and third scenarios there will be no conceptual “hook” to aid their recall. In those circumstances, even in relation to those goods in the designation I have characterised as being similar to between a low and medium degree, I find there is a likelihood of direct confusion through imperfect recollection.

### **Overall conclusion**

104. The opposition has succeeded in relation to:

Daily glassware [including cups, plates, pots, cylinders]; kitchen utensils; drinking vessels; daily porcelain [including pots, bowls, plates, pots, jars, cans]; daily pottery [including pots, bowls, plates, jars, jars, pots, casseroles, pots, pottery utensils]; enamelled glass, not for building; bottles

105. And failed in relation to:

Works of art of porcelain, ceramic, earthenware, terra-cotta or glass; cleaning instruments, hand-operated; coffee percolators, non-electric

106. Subject to any successful appeal, the designation will be refused in relation to the goods shown in paragraph 104 and will become protected for the goods in paragraph 105.

## Costs

107. As the opponent has been largely successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the above guidance, but making a “rough and ready” reduction to the amount I would otherwise have awarded the opponent to reflect the measure of the applicant’s success, I award costs to the opponent on the following basis:

Filing the Notice of opposition and reviewing the counterstatement:	£200
Official fee:	£100
Filing of evidence and written submissions:	£530
<b>Total:</b>	<b>£830</b>

108. I order Guangdong Samadoyo Industrial Co., Ltd to pay to SAHM GmbH & Co KG the sum of **£830**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 29<sup>th</sup> day of January 2021**

**C J BOWEN**  
**For the Registrar**