

O/003/21

IN THE MATTER OF THE TRADE MARKS ACT 1994

-and-

IN THE MATTER OF TRADE MARK APPLICATION No. 3338003

in the name of OTO INTERNATIONAL LIMITED

to register the trade marks

oTO

oto

OTO

OtO

Oto

otO

as a series in classes 12, 4, 5, 30, 32, 33, 34 and 35

-and-

OPPOSITION No. 414930

by OTTO (GMBH & CO. KG)

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF
CLARE BOUCHER, HEARING OFFICER, ACTING ON BEHALF OF THE
REGISTRAR OF TRADE MARKS DATED 26 FEBRUARY 2020**

DECISION OF THE APPOINTED PERSON

1. This is an Appeal by the Applicant against the Decision of the Hearing Officer rejecting registration under s5(2) of the Trade Marks Act 1994 in relation to the goods and services of the application, with the exception of certain goods in classes 4 and 5 and certain services in class 35.
2. The mark applied for is a series of versions of the word mark OTO, comprising every variant of capitals and lower case letters which can be

made from the three letters of the word. I shall refer to it in this Decision as 'OTO'.

3. The OTO application was opposed under s5(2)(b) of the Act by the proprietor of the following EU trade mark registered in classes 16, 25 and 35:



The image shows the word "OTTO" in a bold, red, sans-serif font. The letters are thick and closely spaced, with a slight shadow or 3D effect. The 'O's are particularly large and rounded.

4. The Hearing Officer was obliged to engage in a lengthy exercise in comparison of the goods and services of the two marks. She ultimately concluded that there was some degree of similarity in relation to some of the goods and services for which the Opponent's mark was registered and most of the goods and services of the Application. The exceptions to this were 'tallow' in class 4 of the Application, 'materials for stopping teeth, dental wax, preparations for destroying vermin, fungicides, herbicides' in class 5 and various business and marketing services relating to 'hemp based products' in class 35.
5. The goods and services which were held to be 'similar' were for the most part held to have a 'medium level' of similarity, though a few were of 'low' similarity and others were identical.
6. On the question of likelihood of confusion, the Hearing Officer held that there was such a likelihood when the Mark applied for (in any of its variants) was used in relation to the goods and services held to be similar. The Opposition therefore succeeded save in relation to the goods and services mentioned in paragraph 4 above.

7. On this Appeal, Mr Hollingworth QC who appeared for the Applicant took issue with a number of the findings of 'medium level' of similarity between the goods and services, alleging that only a 'low level' of similarity ought to have been found. However, since the Hearing Officer considered that there was a likelihood of confusion even where the level of similarity was low, this point could not in itself provide an error of principle sufficient to undermine the decision to uphold the Opposition.
8. As Mr Hollingworth accepted at the hearing, success on the Appeal thus could only be achieved if the Applicant won on its primary point which was an alleged error in relation to the level of distinctiveness of the Opponent's mark.
9. In her Decision at [75] the Hearing Officer considered the conceptual content of the two marks. It was common ground that OTO had no particular conceptual significance. However, the parties disagreed about the conceptual significance of OTTO. The Applicant submitted that OTTO would be understood by the average consumer as a given name of Germanic origin, citing in this respect the German 19C statesman Otto von Bismarck, the film director Otto Preminger and a character called Otto Mann, the school bus driver in the Simpsons cartoon series. The Opponent disagreed that the average consumer would necessarily be familiar with OTTO as a name. The Hearing Officer said this:

'In the absence of any evidence as to the average consumer's knowledge of German names, I must proceed cautiously. I can accept that some consumers will identify a name, but it seems to me that there will also be a group of consumers who assume it is an invented word. For these consumers, neither mark will have any conceptual content and so a comparison cannot be made. For the former group, the earlier mark will have a meaning while the applied-for mark will not.'
10. This finding was central to her ultimate decision. In [76] she concluded that for the group of consumers who understood the word OTTO as a

name, it would have a *'medium level of inherent distinctiveness'* but to the group who saw it as an invented word, *'the level of inherent distinctiveness would be high'*. She then, at [87], citing and underlining the words of Kitchin LJ in Comic Enterprises v Twentieth Century Fox [2016] EWCA Civ 41 that *'it follows that the court must necessarily have regard to the impact of the accused sign on the proportion of consumers to whom the trade mark is particularly distinctive.'*

11. Finally she concluded at [88] and [89] that the average consumer who would understand the earlier mark to be an invented word would be likely to be directly confused. She made no such finding about the average consumer who would understand the earlier mark as a name of Germanic origin. Indeed, the strong implication was to the contrary:

'The average consumer who thinks the applied-for mark is an invented word has no concept to keep in their mind, and so could quite easily confuse double and single Ts, even in a short word.'

12. On that basis, she found a likelihood of confusion amongst average consumers.
13. Mr Hollingworth invited me to overturn the Decision on the basis that this was an error of principle. He had two points.
14. His first point was that the Hearing Officer had nowhere attempted to quantify the relative size of the 'two groups' of consumers (I will call them the 'invented word' people and the 'Germanic name' people). Since confusion is considered to occur only amongst invented word people, one cannot say whether it is sufficient for the purpose of s5(2)(b) unless one knows how many 'invented word' people there are.
15. In theory Mr Hollingworth is plainly correct. However, I believe it to be unfair to the Hearing Officer to suggest that she did not have this in mind. She cited, as I have said, the decision in Twentieth Century Fox. In section

(v) of the passage from [34] which she quoted, and immediately after the passage which the Hearing Officer underlined about the proportion of consumers to whom the trade mark is particularly distinctive Kitchin LJ says this:

'If, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.'

16. It seems in the highest degree unlikely that the Hearing Officer, having cited that passage, did not have it in mind when coming to her conclusion a couple of paragraphs later. To my mind she plainly considered that the 'invented word' people represented 'a significant proportion' of the relevant public.
17. Mr Hollingworth's second point was to attack the Hearing Officer's conclusion that the 'invented word' people represented any significant proportion of the public.
18. The background to this point is that, as the Hearing Officer said, no evidence on the issue was advanced at all. She was essentially left by both sides to determine the point on the basis of her own general knowledge and experience, taking into account (presumably) the frequency with which she thought the general public would be likely to come across the word OTTO used as a given name.
19. Having left her to make that determination without any assistance in the form of evidence, the Applicant now disputes her decision on the basis that no reasonable tribunal could have reached it. This seems to me quite problematic. When it comes to a decision based on the interpretation of evidence, an Appellate tribunal has an objective basis on which to say whether the Hearing Officer's view was one which a reasonable person could have reached. However, when it is simply a matter of an assessment

based on general knowledge and experience, without evidence, the position is not so simple. How is the Appellate judge to know whether his own experience and understanding of the world puts him in a better position to assess other people's general knowledge and experience of given names than the Hearing Officer? And if he cannot know that, on what basis can he decide that the Hearing Officer's decision was wrong, let alone one which a reasonable tribunal could not have reached?

20. Mr Hollingworth urged me to use 'common sense', but this is a dangerous tool. One's own idea of what is 'sensible' is necessarily to some extent the product of one's particular background and experience and there is thus no reason to assume that it is 'common'.

21. I believe that I can only judge the Hearing Officer's assessment on the basis of the material with which she was provided. Here, the only instances which were provided to her of OTTO as a given name were the ones which I have cited above in paragraph 9. An objective approach would involve considering (as best one could) how many individuals in the population would satisfy all of the following propositions: (i) not being familiar with the names of the lesser characters in the Simpsons, (ii) not having studied mid-late 19C European history at school or university or otherwise been exposed to teaching or discussion of Otto von Bismarck, (iii) not being interested in 1940s and 50s movies.

22. I do not find it difficult to imagine that a reasonably large proportion of the population would satisfy those propositions. I therefore find no objective reason to disagree with the Hearing Officer's assessment.

23. I should add one further point. This was plainly a matter on which the Applicant could have called evidence if it had wanted to bolster its case. For example it could have put in evidence about the proportion of people named OTTO in the population as a whole or the viewing figures of the Simpsons. It could even have commissioned a small-scale survey on people's reaction to the word OTTO. The Applicant made the choice not to

take this step but rather to leave it to the judgment of the Hearing Officer. It may of course have made that choice in order to avoid expense. But it could equally have made that choice because it was not confident that the evidence would support its case. Either way, the choice necessarily meant that it would be difficult to appeal the Hearing Officer on the point because there would be no objective evidence to fall back on.

24. So I reject Mr Hollingworth's case that the Hearing Officer erred in her determination of the level of distinctiveness of the earlier Mark. That being the case, the Appeal fails.
25. The Respondent did not appear at the hearing, but filed short written submissions. I will award £400 towards the costs.

**IAIN PURVIS QC
THE APPOINTED PERSON**

4 January 2021