BL O/0513/23

TRADE MARKS ACT 1994
IN THE MATTER OF OPPOSITION No. 426713
IN THE NAME OF VOLKSWAGEN AKTIENGESELLSCHAFT
TO TRADE MARK APPLICATION No. 3607439 DECRAFTER
IN THE NAME OF WEBIZSOL LTD

DECISION

INTRODUCTION

1. This is an appeal from the decision of Hearing Officer Sam Congreve dated 7 November 2022 in relation to the mark DECRAFTER in class 28 sought to be registered by the Applicant/Respondent WEBIZSOL LTD.

2. The Hearing Officer dismissed an opposition brought under s.5(2) Trade Marks Act 1994 by the Opponent/Appellant Volkswagen Aktiengesellschaft based on its pre-existing CRAFTER/Crafter marks registered in, amongst other things, classes 12 and 28.

3. The determination by the Hearing Officer was based on the papers, including evidence of use submitted by the Opponent. Before me, the Opponent was represented by Francesco Simone of WP Thompson. The Applicant, represented by Stobbs, took no active part in this appeal.

4. Although the TM55 contained a number of different grounds of appeal, at the hearing before me the Opponent sensibly focussed on just one of them, namely the alleged error made by the Hearing Officer in assessing conceptual similarity. This, it was said, resulted in the Hearing Officer coming to the wrong conclusion on likelihood of direct and/or indirect confusion.

5. There was no dispute as to the standard to be applied in appeals of this nature. The Opponent cited the well-known summary of Joanna Smith J. in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch). See in particular [24]-[25].

THE DECISION

6. The Opponent helpfully summarised the key parts of the Decision not challenged on appeal as follows:

> At [34] of the Decision, the Hearing Officer found that the evidence filed by the Opponent has demonstrated genuine use of the Earlier Mark in the UK during the relevant period.
> At [38] of the Decision, in determining a "fair specification", the Hearing Officer narrowed down the goods relied upon by the Opponent to "Motor vehicles, all being vans" (class 12) and "Scale model vehicles and toy vehicles for children, all being vans" (class 28).
> At [56] of the Decision, the Hearing Officer found the average consumer to be "a member of the general public who will likely pay a medium degree of attention".
> At [49] of the Decision, the Hearing Officer found the goods "Games, toys and playthings" claimed in the Application to be identical to the goods claimed in the earlier registrations.
> …
> At [50] of the Decision, the Hearing Officer found the goods "video game apparatus" to be similar to a low degree to the goods claimed in the earlier registrations.
> At [51]-[53] of the Decision, the Hearing Officer found the goods "gymnastic and sporting articles; decorations for Christmas trees; hoops for exercise; hoops for rhythmic sportive gymnastics and hula hoops" to be dissimilar from the goods claimed in the earlier registrations.
> At [63]-[66] of the Decision, the Hearing Officer found the trade marks to be visually and aurally similar to a medium degree.
> At [72] of the Decision, the Hearing Officer found the Earlier Mark to have a medium distinctive character.

7. The Hearing Officer then went on to assess the likelihood of direct and indirect confusion, and based upon the findings summarised above, dismissed the opposition.

THE APPEAL

8. As noted above, the challenge on this appeal was to the Hearing Officer's findings on conceptual similarity. These findings were as follows:

> 67. The opponent submits the following:
>
> > "Conceptually, the marks are highly similar, as they both refer to the concept of crafting. It is likely that the average consumer would perceive the applied-for mark as derived from the earlier mark."

68. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

69. The opponent's marks consist solely of the word CRAFTER / Crafter, which will be given its ordinary dictionary meaning, namely 'a person who does craftwork'. This has no obvious connection to the goods in the opponent's specification. I acknowledge that the opponent's mark is wholly contained in the contested mark however this does not result in a conceptual overlap. On seeing the contested mark DECRAFTER, consumers will perceive it as one word and will not seek to break the word into DE and CRAFTER, therefore they will not see CRAFTER as an individual element with a shared concept to the earlier mark. Consumers will see DECRAFTER as an invented word, with no clear meaning or obvious connection to the applied for goods. Accordingly, I find that the marks are conceptually dissimilar.

9. The Opponent submitted that this assessment was wrong. It was suggested that the Hearing Officer had ignored the fact that the prefix DE is commonly applied to words to indicate a concept of reversal, privation or removal. Accordingly, the Opponent submitted that the Hearing Officer had erred in his approach to determining the likelihood of confusion.

10. The issue before me is thus whether the Hearing Officer fell into error in concluding that respective marks CRAFTER and DECRAFTER are conceptually dissimilar.

11. The appeal focussed on [69] of the Hearing Officer's decision and the Opponent's criticism of the Hearing Officer's alleged failure to take the meaning of the prefix DE into account. I will come back to that, but it is necessary to examine the whole of the Hearing Officer's reasoning on the issue of conceptual similarity, and not just [69].

12. As recorded above, first the Hearing Officer summarised the relevant law. He referred to *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R 29 which the Opponent accepted was relevant to the present case. In that case the CJEU pointed out that in the application of the global test it is the overall impression of the marks which matters (in that case PICARO and PICASSO). Further, the conceptual message of one of the marks in that case was capable of immediate grasp by the average consumer. See in particular §§18-21 (emphasis added):

18 As is apparent both from the tenth recital in the preamble to Directive 89/104 and the seventh recital in the preamble to Regulation No 40/94, the assessment of the

likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, on the association which can be made with the used or registered sign and on the degree of similarity between the trade mark and the sign and between the goods or services identified. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case (see to that effect, regarding Directive 89/104, SABEL, paragraph 22).

19 **Furthermore, that global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components** (see, in particular, SABEL, paragraph 23).

20 By stating in paragraph 56 of the judgment under appeal that, **where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public**, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.

21 As OHIM rightly maintains, **such a finding is, in this case, entirely part of the process designed to ascertain the overall impression given by those signs and to make a global assessment of the likelihood of confusion between them**.

13. The Hearing Officer then went on to apply this approach in [69]. He acknowledged that "CRAFTER" does have a conceptual meaning, namely a person who does craftwork. However, he considered that there was no obvious connection to the goods in the opponent's specification, namely Class 12 Motor vehicles, all being vans and Class 28 Scale model vehicles and toy vehicles for children, all being vans.

14. The Opponent criticised this finding before me, suggesting that the Hearing Officer should have concluded that the average consumer would think there might be a connection between the mark and the goods because scale model vehicles might be ones which are put together by the consumer, and therefore "crafted". The Opponent acknowledged that there was no evidence to this effect, but that the submission followed from the definition of the goods.

15. I accept that it is possible that some scale model vehicles within the Class 28 specification could be ones that are constructed by the consumer from kits, but I do not accept that this connection would be immediately apparent to the average consumer, not least because the vast majority of such goods would be likely to be

supplied already constructed. Moreover, I consider it a stretch to suggest that the making of such models from pre-formed parts of kits would in any event be described as “craftwork”. Therefore I reject this first criticism of the Hearing Officer’s decision.

16. The more serious objection pursued by the Opponent on this appeal is that the Hearing Officer did not consider the meaning of the prefix DE. Had he done so, it is said that he should have concluded that the average consumer would consider CRAFTER/DECRAFTER to be similar to other word pairings such as CONSTRUCT/DECONSTRUCT or FROST/DEFROST, and therefore conceptually similar. Other examples of X/DE-X word pairs relied on by the Opponent included humidifier/dehumidifier, regulation/deregulation, salt/desalt, escalate/deescalate, contaminate/decontaminate, compose/decompose, compress/decompress, caffeinated/decaffeinated and stabilise/destabilise.

17. I think that there are number of problems with this submission.

18. First, it ignores the guidance set out in the *Picasso* case that what is important is the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. On this basis it is wrong to focus on the DE prefix, and the correct test it to look at the words DECRAFTER (and CRAFTER) as a whole.

19. As to this, the Hearing Officer did consider the word as a whole. He concluded that the average consumer would not break it down into DE and CRAFTER. He was entitled to reach this conclusion. I also think he was entitled to conclude that although the opponent’s mark is wholly contained in the contested mark, this does not necessarily result in a conceptual overlap. The appearance of CRAFTER in DECRAFTER is already accounted for as part of the visual comparison. What matters for present purposes is whether the use of CRAFTER within DECRAFTER results in conceptual similarity.

20. The Hearing Officer went on to consider this at the end of [69]. He concluded that consumers would see DECRAFTER as an invented word with no clear meaning or obvious connection to the applied for goods.

21. The Opponent accepted before me that DECRAFTER is an invented word which the average consumer would not find in the dictionary nor know what it meant. This undermines any suggestion that the average consumer would attribute a meaning to it which was conceptually similar to CRAFTER. The average consumer does not search for meaning in words which are not known or apparent.

22. Nevertheless, it was suggested that the average consumer would break down DECRAFTER into DE and CRAFTER, and would, given the accepted meaning of CRAFTER, conclude that DECRAFTER was meant to indicate dis-assembly of a crafted good, in the same way that deconstruct means the opposite of construct.

23. I do not accept that just because some words have well known X and DE-X pairings, the average consumer would necessarily think that DECRAFTER was the opposite of CRAFTER. That submission wrongly assumes that the X and DE-X pairing is so well known that it can be automatically applied to new pairs of words and understood.

24. As to this, although the Opponent relied on a list of words showing X and DE-X pairings, there are many, many more examples of words which do not have a DE- equivalent. It is therefore misleading to focus only on those that do. I consider that it is necessary for a DE- prefix word to become used for it to be associated with a particular meaning. Thus, for example, the verb “deplane” has accrued a meaning over recent years in the UK as a result of its increased use here, but prior to that the combination of PLANE and DEPLANE would not have been thought to be conceptually linked – the latter would be thought to have no meaning or to be a nonsense word.

25. So although the average consumer would be aware of specific pairs of words with and without a DE- prefix, their non-awareness of DECRAFTER as a word would mean that they would be less inclined to recognise DECRAFTER as a DE- version of CRAFTER.

26. The Opponent also relied on examples of other invented words. Thus, it was said that the mark PROTECHT maintains a relationship with the original words PROTECT and TECH and derives its meaning from them. That may be, but the attempted analogy soon breaks down because of the aural similarities between PROTECT and PROTECHT leading to conceptual similarities. It does not assist the Opponent in the present case.

27. Finally, it was said that that “DE” is so short that it would not prevent the average consumer from recognising the word CRAFTER within DECRAFTER. Thus, when seeing the word “DECRAFTER” and asking themselves if it means anything, the average consumer would notice “CRAFTER” and link the two words conceptually.

28. I disagree. The average consumer would not necessarily attempt to give DECRAFTER any meaning at all. Just because DE is short does not mean that the

average consumer would attempt to deconstruct the word, recognise CRAFTER (which in any event is not a particularly well known way of describing 'a person who does craftwork') and come to the conclusion that conceptually the words are linked. The DE coming as it does at the beginning of the word, I think the Hearing Officer was entitled to conclude that the two marks were conceptually dissimilar.

29. For all these reasons I do not think that the Hearing Officer fell into error in concluding that DECRAFTER is conceptually dissimilar to CRAFTER. He applied the correct law, and I cannot conclude that he came to the wrong decision about conceptual similarity.

30. As I have concluded that there was no error made in relation to conceptual similarity, and as the Opponent accepted at the hearing, there is no need for me to go on and reconsider the Hearing Officer's assessment of direct or indirect confusion. The appeal should be dismissed.

COSTS

31. In respect of the proceedings below, the Hearing Officer ordered the Opponent Volkswagen Aktiengesellschaft to pay the Applicant WEBIZSOL LTD the sum of £500 within 21 days of final determination of the appeal proceedings.

32. The Applicant WEBIZSOL LTD played no apparent role in this appeal. I was told that its agents Stobbs had indicated that they had no instructions to engage in the appeal. I therefore make no additional costs award in the Applicant's favour.

33. In summary:

    (a) The appeal is dismissed;

    (b) Volkswagen Aktiengesellschaft shall pay WEBIZSOL LTD the sum of £500 within 21 days of the date of issue of this decision.

Thomas Mitcheson KC
The Appointed Person
2 June 2023