

O/0767/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003774745

FOR THE FOLLOWING TRADE MARK:



AND IN THE MATTER OF REGISTRATION NO. UK00003726507

FOR THE FOLLOWING TRADE MARK:



BOTH IN CLASS 16

AND BOTH IN THE NAME OF TAURUS WOJCIECH NIEGOLEWSKI LTD

AND IN THE MATTER OF A CONSOLIDATED OPPOSITION AND AN
APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NOS. 435266 AND 505367

BY KANEKA CORPORATION

BACKGROUND AND PLEADINGS

1. On 6 April 2022, TAURUS Wojciech Niegolewski Ltd (“Taurus”) applied to register UKTM(A) no. 3774745, in the UK (“the First Contested Mark”). The First Contested Mark appears as follows:



2. The First Contested Mark was published for opposition purposes on 29 April 2022.

3. Taurus is also the proprietor of UKTM no. 3726507 (“the Second Contested Mark”), which was filed on 28 November 2021 and registered on 4 March 2022. The Second Contested Mark appears as follows:



4. Both the First and Second Contested Marks are applied-for/registered in respect of the following goods:

Class 16 Office stationery.

5. On 27 July 2022, the application for the First Contested Mark was opposed by Kaneka Corporation (“Kaneka”). On 14 September 2022, Kaneka sought a declaration of invalidity against the Second Contested Mark pursuant to section 47 of the Trade Marks Act 1994. Both the opposition and the application for invalidity are based upon section 5(2)(b) of the Act. Kaneka relies upon UKTM no. 3604637 for the sign **Green Planet** in respect of both the opposition and the invalidation. The earlier mark was

filed on 4 March 2021 and registered on 1 October 2021. Kaneka relies upon the following goods for which the earlier mark is registered:

Class 16 Stationery and office requisites, except furniture.

6. Kaneka claims that the goods are identical and the marks are similar, with the result that there is a likelihood of confusion.

7. Taurus filed counterstatements denying the claims made.

8. Taurus is self-represented, and Kaneka is represented by HGF Limited.

9. Only Taurus filed evidence in chief. Kaneka filed evidence in reply. Neither party requested a hearing, and only Kaneka filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

10. Taurus filed evidence in chief in the form of the witness statement of Wojciech Niegolewski dated 31 January 2023, which is accompanied by 1 exhibit. Mr Niegolewski is a director of Taurus. I also note that Taurus filed a number of documents with its counterstatement. There is a large amount of cross over with the evidence filed by Taurus during the evidence rounds. However, as the counterstatement is signed with a statement of truth, I have also taken these documents into consideration in reaching my decision.

11. Kaneka filed evidence in reply in the form of the witness statement of Stephanie Loeffler-Reading dated 5 April 2023, which is accompanied by 1 exhibit. Ms Loeffler-Reading is the representative acting for Kaneka in these proceedings.

12. Kaneka filed written submissions in lieu dated 11 May 2023.

RELEVANCE OF EU LAW

13. Although the UK has left the EU, section 6(3)(a) of the European Union (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 Act relied upon 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.

DECISION

14. Section 5(2)(b) has application in the invalidation proceedings by virtue of section 47 of the Act. Section 47 reads as follows:

“47(1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered –

(i) within the period of 5 years ending with the date of application for the declaration; and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) [...]

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection 2B or 2C to the United Kingdom shall be construed as a reference to the European Union.

(2DA) [...]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

15. Section 5(2)(b) of the Act reads as follows:

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

(a)...

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

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

16. Section 5A of the Act is as follows:

“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.”

17. By virtue of its earlier filing date, the trade mark upon which Kaneka relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the application date of the First Contested Mark and the date of the application for invalidity in respect of the Second Contested Mark, it is not subject to proof of use pursuant to sections 6A and 47(2A) of the Act.

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, 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.

Preliminary issues

19. Taurus filed evidence to show that Kaneka is not using the earlier mark as registered and/or that it is not the primary mark used by Kaneka.¹ However, because the earlier mark is not yet subject to proof of use requirements, the opponent can rely upon it as registered and whether (or the way in which) the opponent has been using it in practice is not relevant.

20. Taurus has also filed evidence that multiple companies use the words GREEN and PLANET in their trade marks.² There are a number of issues with this evidence. Most of these marks are registered in different classes. Further, there is no evidence that any of these marks have actually been used in the marketplace. In addition, there may be any number of reasons why Kaneka has not objected to these marks (for example, there may be a co-existence agreement in place). Consequently, I do not consider that this evidence assists Taurus.

21. Taurus submits that as Kaneka did not object to its application for the Second Contested Mark that this should in some way prevent them from now seeking invalidation of the mark. Kaneka's evidence is aimed at demonstrating that they were not notified of that application and, consequently, were unaware of the application for the purposes of filing an opposition. There is nothing in the legislation that makes filing an opposition a prerequisite of an application for invalidation. Indeed, that would be contrary to the purpose of the invalidation provisions of the Act. Consequently, I do not consider that this line of argument assists Taurus.

Comparison of goods

22. The competing goods are as follows:

¹ See Annex 3 to the Counterstatement

² See Annex 5 to the Counterstatement

Kaneka's goods (Cancellation applicant/opponent)	Taurus's goods (proprietor/applicant)
<u>Class 16</u> Stationery and office requisites, except furniture.	<u>Class 16</u> Office stationery.

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

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

24. Taurus submits that the parties produce different goods, as Taurus mainly produces mailing bags and padded envelopes, whereas Kaneka produces straws, shopping bags, cutlery and food packaging. Similarly, Mr Niegolewski gives evidence that the parties’ goods are made of different materials. However, I must carry out a notional assessment based upon the goods contained within the parties’ respective specifications, which includes all of the goods that might be covered by those terms, not just the goods for which the parties are using their marks in practice.

25. Taurus’s goods fall within the broader specification of Kaneka. Consequently, the goods are identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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 (as he then was) described the average consumer in these terms:

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

27. The average consumer for the goods will be a member of the general public or a business user. The goods will be relatively low in price and will be reasonably frequent purchases. The average consumer is likely to consider factors such as quality and durability. Consequently, I consider that a medium degree of attention is likely to be paid during the purchasing process.

28. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalent. Consequently, visual considerations are likely to dominate the purchasing process. However, I do not discount that there may be an aural component to the purchase given that advice may be sought from retail assistants.



Comparison of trade marks

29. 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 the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

31. The respective trade marks are shown below:

Kaneka’s trade mark	Taurus’s trade marks
<p style="text-align: center;">Green Planet</p>	<div style="text-align: center;">  <p>(the First Contested Mark)</p>  <p>(the Second Contested Mark)</p> </div>

Overall Impression

32. The earlier mark consists of the words Green Planet. There are no other elements to contribute to the overall impression, which lies in the words themselves.

33. The First Contested Mark consists of the words GREEN PLANET in large green font, with the word GREEN in a darker font than the word PLANET. Beneath those words is the word PACKING in much smaller, less bold font. Alongside the words is a device of a globe being held in a pair of hands. Given that the eye is naturally drawn to word elements in marks, I consider that the words GREEN PLANET play the greater role in the overall impression, given their size. The device plays a slightly lesser role. The word PACKING plays a much lesser role due to its smaller size and descriptive nature.

34. The Second Contested Mark is the same as the First Contested Mark, although the device is surrounded by the words "I'M 100% COMPOSTABLE" in a stylised font. In my view, these words will be attributed no trade mark significance as they simply describe a characteristic of the goods. Consequently, the same assessment regarding the overall impression applies as set out in relation to the First Contested Mark, with the additional words playing a very small role in the overall impression.

Visual Comparison

35. The First Contested Mark and the earlier mark overlap to the extent that they both contain the words GREEN PLANET. They differ in that the First Contested Mark is presented in a green, stylised font. However, I bear in mind that the earlier mark is a word-only mark and can, therefore, be used in any colour or font. The addition of the device in the First Contested Mark acts as a point of difference, as does the word PACKING (albeit to a lesser degree). Consequently, I consider the marks to be visually similar to a medium degree.

36. Given the minimal impact of the words I'M 100% COMPOSTABLE in the Second Contested Mark, I do not consider that they impact upon the visual comparison materially. Consequently, I also consider this mark and the earlier mark to be visually similar to a medium degree.

Aural Comparison

37. The earlier mark consists of two ordinary dictionary words which will be given their usual English pronunciation. The First Contested Mark consists of the same two words, plus the additional word PACKING. The word PACKING may not be articulated by all consumers given its size and descriptive nature. If that is the case, then the marks will be aurally identically. If it is articulated then the marks are aurally similar to between a medium and high degree.

38. I do not consider that the additional words I'M 100% COMPOSTABLE in the Second Contested Mark will be articulated by the average consumer, given their descriptive nature. Consequently, I also consider this mark and the earlier mark to be aurally similar to between a medium and high degree. If I am wrong in this finding, then given the minimal impact that these additional words play on the overall impression, I still consider the marks to be aurally similar to a medium degree.

Conceptual Comparison

39. The words GREEN PLANET evoke ideas about protecting the planet, and sustainable businesses/goods. The same meaning will be identical in all three marks. The word PACKING in the First and Second Contested Marks is likely to be seen as referring to the type of goods sold i.e. they are stationery goods used for packing purposes. This will be a point of conceptual difference, although not a distinctive one. I agree with Kaneka that the device in the First and Second Contested Marks just reinforces the message conveyed by the words themselves. The additional words I'M 100% COMPOSTABLE in the Second Contested Marks will also be a non-distinctive point of conceptual difference.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

41. Kaneka has not pleaded that its mark has acquired enhanced distinctive character through use, nor has it filed any evidence to support such a finding. Consequently, I have only the inherent position to consider. The words GREEN PLANET evoke ideas of sustainability and protecting the planet. They allude to goods that will fulfil this aim. Consequently, I consider the earlier mark to be inherently distinctive to between a low and medium degree.

Likelihood of confusion

42. Confusion can be direct or indirect confusion. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether

there is a likelihood of confusion; rather, it is a global assessment where 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 goods may be offset by a greater degree of similarity between the marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing act. In doing so, I must be alive to 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 that he has retained in his mind.

43. I have found as follows:

- a) The goods are identical.
- b) The average consumer is a member of the general public or a business user, who will pay a medium (or average) degree of attention during the purchasing process.
- c) The purchasing process is predominantly visual, although I do not discount an aural component.
- d) The marks are visually similar to a medium degree and aurally identical or similar to between a medium and high degree (depending on how they are pronounced). The common element is conceptually identical, and the points of conceptual difference are non-distinctive.
- e) The earlier mark is inherently distinctive to between a low and medium degree.

44. The fact that the earlier mark is inherently distinctive to between a low and medium degree is a factor in favour of Taurus. I recognise that the purchasing process is predominantly visual. However, the identity of the goods and the fact that the part of the First and Second Contested Marks that has the greater impact on the overall impression is identical to the earlier mark, leads me to conclude that there is potential for the average consumer to mistakenly recall or misremember the marks as each

other. Even if the additional text/device elements of the First and Second Contested Marks are recalled, I consider that the average consumer would believe them to be different marks used by the same undertaking. They are likely to be viewed as simply a stylised version of Kaneka's mark. Consequently, I consider there to be a likelihood of direct and indirect confusion.

CONCLUSION

45. The opposition against UKTM(A) no. 3774745 is successful and the application is refused.

46. The application for invalidation against UKTM no. 3726507 is successful and the registration is deemed never to have been made.

COSTS

47. As Kaneka has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award Kaneka the sum of **£1,600**, calculated as follows:

Preparing a Notice of opposition, a Notice of invalidation and considering the counterstatements	£350
Filing evidence and considering Taurus' evidence	£500
Written submissions in lieu	£350
Official fees (x2)	£300
Total	£1,600

48. I therefore order TAURUS Wojciech Niegolewski Ltd to pay Kaneka Corporation the sum of £1,600. This sum should be paid within 21 days of the expiry of the appeal

period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 11th day of August 2023

S WILSON

For the Registrar