

O-119-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2413022
BY GIDEON LEVINGSTON
TO REGISTER THE TRADE MARK**

Carbontime

IN CLASS 14

AND

**IN THE MATTER OF OPPOSITION NO 94571
BY FRANCK MULLER WATCHLAND SA**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2413022

By Gideon Levingston

To register the trade mark “Carbontime” in Class 14

and

IN THE MATTER OF Opposition No 94571

By Franck Muller Watchland SA

BACKGROUND

1. On 6 February 2006 Gideon Levingston applied to register the trade mark “Carbontime” in relation to the following goods:

Class 14: Mechanical watch oscillators and other precision timing instruments and parts and fittings thereof.

2. On 21 August 2006 Franck Muller Watchland SA filed a notice of opposition to the above application. The opposition is based on grounds under sections 5(2)(b), 5(3), 5(4)(a) and 56 of the Trade Marks Act 1994 (“the Act”).

3. In relation to the grounds under sections 5(2)(b), 5(3) and 56, the opponent relies on their own trade mark, namely, International Registration 753384; the details of this trade mark are given below:

Trade Mark	Date of UK Designation	Specification
	29 January 2001	Precious metals and their alloys and products made of these substances or plated therewith included in this class; jewellery, jewellers' goods and precious stones; timepieces and chronometric instruments.

4. In relation to the ground under section 5(4)(a), the opponent claims that the sign as represented in International Registration 753384 (and also the sign comprising of the word KARBON alone) has been used in the UK since 1 May 1998 and that the use of the applicant’s mark would amount to an actionable claim for passing-off.

5. The applicant filed a counterstatement denying the grounds of opposition.

6. Both sides filed evidence, this is summarised below. Neither party requested a hearing. The applicant filed written submissions in lieu of attending a hearing, the submissions were made by their trade mark attorneys Mewburn Ellis. The opponent did not file any formal written submissions, they chose instead, as indicated in a letter from

their trade mark attorneys Field Fisher Waterhouse, to rely on the submissions and evidence that had already been filed; I should however add that there is little by way of submission from the opponent on the merits of the dispute. All submissions will be drawn upon and taken into account in this decision, but I do not intend to summarise them separately. Acting on behalf of the Registrar, and after a careful study of the papers, I give this decision.

Opponent's evidence

7. This comes from Mr Leighton John Cassidy of Field Fisher Waterhouse, the opponent's representatives in this matter. Whilst Mr Leighton states that his evidence is given on behalf of the opponent company, he does not explain the source of the information he gives. Mr Leighton states that the approximate date of first use in the UK of the mark KARBON was 1998. He also refers to exhibit LJC1 which consists of extracts from various publications. The witnesses' summary of the extracts followed by my own brief observations are detailed below:

“a) Extract from *Watch Market Review* dated May 1998 confirming the release of the Karbon watch in 1998.”

The extract relates to the “premier” of a new watch brand *KARBON* at a luxury watch exhibition in Geneva. Although the extract is in English, no information is provided to demonstrate that the publication is circulated in the UK.

“b) Extract from *National Jeweller* dated 16 June 1998 confirming the release of the Karbon sports watch line showing use of the KARBON trade mark.”

This extract is similar in nature to extract a). Again, although written in English, it is not clear whether the publication is circulated in the UK.

“c) Extract from *Gold' or 300* showing use of the Karbon watch namely model No 3900 Master Day Date P.”

The extract is in German, presumably from a German publication. I do not know what the article says, but it does feature a picture of a Karbon Watch.

“d) Extract from *Marche di Orologi in Italia* Edition 2000 showing use of the Karbon watch.”

The extract is in Italian, presumably from an Italian publication. I do not know what the article says, but it does feature a picture of a Karbon Watch

“e) Extract from *Modellolido News* from the year 2000 showing use of the mark KARBON.

Again, the extract is in Italian, presumably from an Italian publication. I do not know what the article says, but it does feature a representation of the opponent's mark and it refers to the word KARBON.

“f) Extract from an advertisement showing use of the KARBON mark in Italy for the watch model No 4100 Sprint (undated).”

The advertisement features the opponent's mark both on and above a picture of a watch. However, no information is provided as to where this advertisement was placed. From the nature of the advertisement, it seems to be aimed at the Italian market.

“g) Extract from *Europa Star* showing trends for the year 1999 particularly exhibiting the sprint (41 mm) Karbon watch.”

The extract refers to a KARBON watch as an example of a watch with a diameter larger than 40mm. Although the extract is in English (and the title alludes to a European publication), I do not know if the particular publication is circulated in the UK.

“h) Extract from *The World's Leading Watch* from June 1999 showing the Karbon Sprint model.”

Although the front page of the magazine is in English, the extract featuring the KARBON watch is in Italian. Although the title of the publication proclaims itself as the world's leading watch magazine, I do not know whether the particular publication is circulated in the UK.

“i) Extract from *La Clessidra* dating from 1999 showing the Karbon 4100 Sprint model on page 82 and at 107 the Karbon 3000 Master.”

This appears to be an Italian publication, but the extract itself is in English. They show two KARBON watches that are described as being new in 1999. Neither this extract, nor any of the others detailed above, contain any information (such as prices of the watch in pounds sterling or prices on the publications themselves) to support the proposition that the watches or the publications are targeted at the UK market.

Applicant's evidence

8. The evidence comes from the applicant himself, Mr Gideon Rory Levingston. Mr Levingston states that the evidence he gives comes from his own knowledge (he has worked in the watch making industry for the last eighteen years) or from the Internet.

9. Much of Mr Levingston's evidence deals with the word “Carbon” and the use of this word as a description of the internal mechanisms and other parts of timepieces. His first exhibit, GRL1, is a copy of a European patent application which describes the internal mechanism of a timepiece. Two parts of this internal mechanism are described as being made of carbon nanofiber.

10. The next exhibit is GRL2. This contains a number of extracts from newspapers and other publications which use the word carbon in relation to watches. The first is an advertisement from a Swiss newspaper showing a watch with a carbon fibre coating. Next are advertisements from the watch manufacturer Tissot which show watches described as having a carbon fibre dial. Another advert for the same watches makes use of the words “black carbon Arabic”

11. Further examples come from The French newspaper *Le Monde*. Articles featuring watches are exhibited. One of them (according to the applicant’s translation) has a bezel forged in carbon. Reference is then made to a French watch industry publication which (again according to the applicant’s translation) has references to “the case and bezel are forged in carbon”, “titanium case with carbon finish”, “the base plate of the calibre in carbon fiber (nanofibres)”, “the specialists appreciate the solid carbon baseplate..”, “decorative elements: carbon fibre, palladium and white gold;...”.

12. Also shown is a brochure for an Edox watch which (when translated) has a carbon dial. Finally, reference is made to a Swiss watch making magazine showing a watch with a carbon nanofiber baseplate and another with a carbon fiber dial; these final two examples are in English.

13. Mr Levinston’s final exhibit, GRL3, provides various documents to support the applicant’s claim that the examples of use of the opponent’s mark (as detailed in the opponent’s evidence) come from overseas sources. The *Watch Market Review* is Asia’s oldest trade journal connected with watches, *National Jeweler* is described as reaching the US industry’s most important retailers, *Gold ‘Or* is published in Switzerland, Mondello (which is featured in *Modellodio News*) is located in Italy, *Europa Star* has an address in Switzerland and *La Clessidara* is the official bi-monthly publication of the Italian Association of Producers and Distributors of Horology (a translation of this association’s web-site is made by a person conversant in English and Italian).

DECISION

Section 5(2)(b)

The law

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

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

(a)

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

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

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

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

16. Of potential relevance to a ground of opposition under Section 5(2) are the provisions that relate to proof of use. Section 6A(1) details the circumstances where these provisions apply:

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

(1) This section applies where -

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.”

17. The trade mark relied on by the opponent designated protection in the UK on 29 January 2001. The applicant’s mark was applied for on 6 February 2006. Neither party has claimed any form of priority. The opponent therefore has an earlier trade mark as defined in section 6(1) of the Act.

18. In relation to the proof of use requirements, although the opponent made a claim to use under section 6A of the Act in their notice of opposition, they later observe that the proof of use requirements do not actually apply; the applicant also states in submissions that the claim to use was not required. The applicant’s mark was published for opposition purposes on 19 May 2006. This means that the proof of use provisions only apply if the earlier mark completed its registration procedure before 19 May 2001. As the earlier mark was not even published before this date (it was published on 7 June 2001) let alone completed its registration procedure, the proof of use provisions do not apply. **Consequently, all of the goods covered by the earlier mark must be taken into account.**

19. When reaching my decision I have taken into account the helpful guidance provided by the European Court of Justice (“ECJ”) in a number of judgments relating to Article 7(2) of the Directive (Section 5(2) as incorporated into the Act), notably in: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

Relevant consumer and the purchasing act

20. As matters must be judged through the eyes of the average or relevant consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who this is. The applicant's mark covers mechanical watch oscillators and other precision timing instruments. The earlier mark covers items ranging from goods made of precious metals and jewellery to timepieces and chronometric instruments. The applicant submits that the purchasing act of the various goods are all quite considered purchases. Reference is also made to the applicant's oscillators as being specialised goods; in his counter-statement the applicant states that they are only used by those in the watch-making industry.

21. I do not disagree with any of the applicant's submissions. However, as the relevant consumer is an important factor to take into account when deciding on whether confusion is likely, it is important to highlight that there seems to me to be two quite different and distinct relevant consumers to consider. The different relevant consumers exist due to the distinct type of goods that are involved.

22. Firstly, there are goods that I would characterise as being specialist in nature. The applicant seeks protection for mechanical watch oscillators; also, the broad terms used by both the applicant and the opponent could include more specialist goods. Focusing on the oscillator, I certainly agree with the applicant's submission that these are very specialised in nature and are likely to be sold only to the watch making industry. Although the general public may purchase some parts of watches, for example, a new battery or a strap, the specialist nature of an oscillator is such that the general public is unlikely to ever encounter one. Indeed, I doubt very much whether the general public will even have heard of the term. The average consumer is therefore likely to be a person within the watch making industry who is buying-in oscillators to fit the watch that is being produced. This type of person is likely to be highly knowledgeable and regarded as somewhat of an expert in the field. The type of considerations that will be applied by this type of consumer during the purchasing act will no doubt be significant; the size, the type, the material of construction, the precision and performance are likely to represent some of the important considerations that will be applied. The purchasing act is likely to be one where the highest degree of consideration is applied.

23. Secondly, there are goods that I would characterise as general consumer items, for example, watches. They would be encompassed by the opponent's general terms such as "timepieces" and "chronological instruments". The applicant's specification reads "mechanical watch oscillators and other precision timing instruments...". The fact that the term "precision timing instruments" is not a self-standing term (it is tied in construction to the term "mechanical watch oscillators") does not mean that it should be accorded limited protection contextualised against the rest of the specification. The specification as a whole designates protection for oscillators and other types of precision timing and this later term should be construed on the face of its meaning. It is a term I consider to be a fairly broad one and the use of the word "precision" does not alter this as all timing instruments, be they watches, clocks or something more specialised, will require precision in their basic function of time-keeping. The applicant's specification therefore covers these general consumer items. The relevant consumer for these general consumer goods would be the general public at large. Whilst the price of these items can vary from just a few pounds to many thousands, the purchasing act is likely to be a reasonably considered one. The

purchasing act is likely to focus on the products look, feel and basic operational functions but not necessarily a detailed examination of the core components and the materials used therein. Although reasonably considered, this does not equate to the purchasing act being of the highest degree. Whilst there may be some parts of the relevant consumer, for example those likely to purchase watches at the upper end of the market, who may be more of an aficionado in the field (and who may therefore have a greater degree of knowledge and interest of the finer details of a watch), these types of consumer are likely to be the exception rather than the norm.

24. In summary the relevant consumer differs between the respective goods at issue, **for specialist goods such as oscillators the relevant consumer is a highly knowledgeable specialist paying the highest degree of consideration; for consumer goods such as watches the consumer is a member of the general public paying a reasonable degree of consideration.**

Similarity of trade marks

25. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective trade marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). For ease of reference, the respective trade marks are:

Applicant's trade mark

Opponent's trade mark

Carbontime



26. From a visual point of view, there are some clear differences: the opponents mark contains a device element whereas the applicant's mark has none; in the applicant's mark the word "carbon" has the word "time" appended to it; the word element in the opponent's mark begins with the letter K as opposed to C. There is however one point of visual similarity, namely, that of the presence of the word CARBON/KARBON. In terms of visual dominance, neither the word "carbon" nor the word "time" dominates the applicant's trade mark, nor does the word KARBON or its accompanying device element dominate the opponent's trade mark. Despite the point of similarity, **I consider that the differences highlighted above result in any visual similarity being of only a slight or minimal degree.**

27. In relation to aural similarity, the applicant's mark will be pronounced as "carbon time" and the opponent's mark as "carbon". The letter K appearing in the opponent's mark rather than the letter C does not alter this given that both letters produce a hard K sound. The device element in the opponent's mark would, if pronounced, be pronounced as the letter K. However, I think it unlikely that the consumer will go to the trouble of pronouncing it as it is likely to be seen simply as the initial letter of the other word in the mark. The common phonetic presence of the word "carbon" therefore creates a point of

aural similarity. Although this is lessened by the presence in the applicant's mark of the word "time" (without this element the marks would be phonetically identical), **I still consider the respective marks to be, from an aural point of view, reasonably similar.**

28. In relation to conceptual similarity, the applicant's mark does not create a single clear conceptual meaning. The word "time" would be taken as a reference to the goods being, as they are, timing instruments. The word carbon would be taken for what it is, a reference to the element with the chemical symbol "c". The applicant argues that it would be taken as a descriptive reference but with the mark as a whole being distinctive; I will deal with the aspect of the descriptiveness of the word carbon in more detail later in this decision. The opponent's mark would also be seen as a reference to the element carbon. This is so despite it being spelt with a K rather than a C. The conceptual hook that will be taken by the consumer is carbon. Even taking into account the potential for the word carbon/karbon to have descriptive qualities, **I consider that there is some conceptual similarity.**

Similarity of goods

29. The applicant's specification includes the term "other precision timing instruments". I have already found (see paragraph 23) that this term should be treated as a general term and not limited or contextualised in any way. The opponent's specification includes the term "chronometric instruments". In my view, the issue is clear here as both these descriptions relate to instruments for the measurement of time. I do not feel I need to say anymore. **The applicant's "precision timing instruments" are identical to goods covered by the opponent's earlier mark.**

30. The applicant's specification also includes the term "mechanical watch oscillators". The opponent's specification does not include this term or anything expressed in similar language. However, the opponent's specification does cover chronometric instruments at large. Therefore, the first question I must answer is whether a mechanical watch oscillator is, in itself, a chronometric instrument. If the answer to this question is yes then identical goods are in play because the applicant's goods will fall within the ambit of the opponent's broad terminology¹. If the answer is no, I must answer the supplementary question as to whether and to what extent the goods are similar.

31. Is a mechanical watch oscillator a chronometric instrument? Neither party have provided any submissions specifically addressing this point. However, I note from the applicant's counter-statement that he says an oscillator is a component within a precision instrument or timekeeper (my emphasis). This suggests that the applicant does not regard an oscillator to be an instrument itself but merely part of one. However, I also note that in his specification the applicant uses the words "and other precision timing instruments" directly after the term "mechanical watch oscillators". Upon a normal construction of the language used, it appears to me that the latter term qualifies the former, namely, that a mechanical watch oscillator is in itself a precision timing instrument. These two

¹ See to that effect the judgment in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05

statements can be seen as antagonistic, however, I bear in mind that the statement in the applicant's counter-statement was made in the context of his argument that mechanical watch oscillators and finished time-pieces are not the same, the former merely being a part of the latter.

32. In the absence of evidence from the trade as to what a particular term may or may not cover, I must assess the matter based upon the natural meanings of the terms in question. I note the decision in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 where it was stated:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations” or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

33. When approaching the question in this manner, I consider² that an “instrument” would be taken by the consumer as a device or tool for conducting some form of activity. The word “chronometric” relates to the science or technique of measuring time. A finished time piece such as a watch or clock would clearly fall within the category of chronometric instruments, however, I take the view that the term chronometric instruments would cover much more than this. It could include not only the mechanisms for displaying the measured time to the user, but also the mechanisms that record or keep the time itself. From the information provided by the applicant, the oscillator is the key part of certain timepieces. As the name suggests, it is the mechanism that oscillates within a mechanical timepiece, the purpose of which is to maintain a regular oscillation which is then converted eventually to the dials of the timepiece. If the oscillation stops so does the timekeeping function of the device. I see no reason why the oscillation system itself would not be described as the time keeping instrumentation of a timepiece. This is re-inforced, in my view, by the description of goods in the applicant's specification (“and other precision timing instruments”). As such, I conclude that the term chronometric instruments is broad enough to encompass mechanical watch oscillators and therefore these goods are identical to goods within the earlier mark.

34. I should add that the breadth of the term chronometric instruments is not so wide so as to cover every part of a timepiece. For example, it would not include parts of timepieces such as rivets, pins or single gears. However, the fundamental mechanisms that act or serve to keep, measure or display the time should be included whether they are part of a larger finished timepiece or not. **Taking all this into account, I conclude that all of the goods in the applicant's specification are identical to goods within the opponents.**

² after taking into account the various definitions in Collins English Dictionary (5th Edition)

Distinctiveness of the earlier trade mark

35. The distinctiveness of the earlier mark is another important factor to consider because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Much of the applicant's evidence focuses on the fact that carbon is, he says, a material used in the manufacture of timepieces. The inference from this is that the opponent's mark is therefore distinctive only because of the stylised letter K and the misspelling of the word CARBON (the K for the C). The evidence relates to the descriptive use of the word carbon in the watch industry. Some thirteen articles or advertisements have been adduced which feature, in some way, the word carbon. I should say that many of these are from overseas publications, however, this does not alter their relevance as watch making is an international industry and the position is unlikely to be any different in the UK. Of these articles, seven refer to what is described as "carbon fiber/fibre/nanofiber". They all relate to a description normally of a component part of a watch, for example, watches with a "carbon fibre dial" or "carbon nanofiber faceplates". The other six examples also mention carbon and state:

- "Black carbon arabic"
- "bezel forged in carbon"
- "the base and bezel are forged in carbon"
- "case with carbon finish"
- "solid carbon baseplate"
- "carbon dial"

36. From this evidence, it does appear that the use of carbon in some form is common within the horological industry. I also note that the opponent has filed no evidence to counter this or to otherwise challenge it in any way. Nevertheless, I must assess distinctiveness from the point of view of the relevant consumer. When making this assessment I must of course do so on the basis of the different goods at issue given that I have found the relevant consumer to be different.

37. In relation to specialist goods such as oscillators, on the basis of the evidence filed I am prepared to accept that the highly specialist and knowledgeable consumer of the goods will be aware of the use of various forms of carbon in the watch making and horological industry. Encountering the earlier mark, they are likely to regard the presence of the word KARBON as a descriptive reference or at the very least an allusion to the material of manufacture, i.e. that some element of the goods is made from a form of carbon. This will mean that the distinctiveness in the mark lies more in the overall stylisation of the earlier mark, its device element and misspelling and not in the root of the word itself. Nevertheless, the overall construction of the mark is distinctive as a whole, although, given the inclusion of a misspelt descriptive word, the overall distinctiveness is at the lower end of the scale.

38. In relation to goods of a more general or commercial nature, watches for example, the evidence filed does not persuade me that the misspelt word carbon will have such an obvious descriptive connotation. The relevant consumer is the general public and whilst they may pay a reasonable degree of consideration in the act of purchasing, the evidence does not persuade me that the general public at large would be aware of the finer details of component watch

parts and their materials. As I have already said, other than aficionados of watches, most of the relevant public may pay attention to the look, feel and operational functions. Also, the evidence of the applicant demonstrating the use of the word “carbon” may be aimed more at the consumer at the high end of the market; even if it is not, the degree of attention paid to the finer detail of the advertising may not be significant. Furthermore, I have no information on how frequently advertisements for watches featuring descriptive references to carbon take place within the UK. This all equates, in my view, to the general public not necessarily being aware that carbon is a material used in the manufacture of component parts of watches. Although lots of goods could potentially be made from some form of carbon, it is not so obvious a reference to a material of manufacture such as terms like gold or silver etc. I am left with the view that the general public at large is likely to regard not only the mark as a whole as distinctive, but that this distinctiveness lies in the root of the word itself and not just the stylisation, misspelling and device element. Overall, for the relevant consumer here, this equates to a mark that has a reasonably high degree of distinctive character.

39. The distinctive character of a mark may be enhanced by the use made of it. The opponent’s evidence deals in the main with the launch of the *Karbon* watch. However, it is not clear from this information as to the extent that this launch translated into sales and exposure within the UK. Nor is it possible to place any of the articles relied on by the opponent as being circulated within the UK. Indeed, the applicant’s evidence counters much of the opponent’s by shedding light on some of these publications and there is strong evidence to suggest that much of it relates to overseas publications. Questions relating to enhancement of distinctiveness through use are made on the basis of knowledge of the mark by a significant part of the relevant public, the relevant public for watches (the only evidence filed by the opponent) being the general public. I therefore have little hesitation in concluding that the use provided by the opponent does nothing to enhance the distinctiveness of the mark in the mind of either group of relevant consumer.

Likelihood of confusion

40. It is clear from the case-law that there is interdependency between the various factors that need to be taken into account when deciding whether there exists a likelihood of confusion. In my assessments above I have found that the relevant consumer and their purchasing attention differs between the various goods sought, as does the impact and significance that the word KARBON/CARBON will have on them and, following this, the degree of distinctive character the earlier mark possesses. Given this, I must break down my assessment in relation to likelihood of confusion.

Likelihood of confusion in relation to mechanical watch oscillators and parts and fitting.

41. I have found the opponent’s specification to be broad enough to include oscillators within its ambit; identical goods are therefore in play. I have found the relevant consumer to be a specialist in the field and that the nature of these goods will result in the purchasing act being a highly considered one. I have found that there is some similarity in the marks, particularly from an aural and conceptual point of view. However, I have found that the element that creates this point of similarity will be known by the specialised relevant consumer as a descriptive reference to a material used in the manufacture of timepieces and

that this also results in an earlier mark that is at the lower end of the scale in terms of distinctiveness. Does all this combine to create a likelihood of confusion?

42. The applicant contends that confusion will not arise. As well as highlighting the differences between the marks themselves and the uses to which the respective marks are put (although this point has little bearing given that identical goods are in play) his other primary argument centres on the presence of the word CARBON (misspelt in the earlier mark) in the respective marks and the fact that this word describes a material used in the manufacture of watches and other timepieces. Whilst I have stated above that the relevant consumer will see the descriptive connotation of the word carbon, I am also conscious that a finding that a mark or an element of it being low in distinctiveness should not be translated into a finding that there cannot be a likelihood of confusion. In case C-171/06 P *TIME ART v Devinlec and OHIM* [2007] the CFI stated:

“Since likelihood of confusion is the specific prerequisite for protection of the earlier mark, that protection applies irrespective of whether the earlier mark has only weak distinctiveness.”

43. On the basis of the above, I cannot rule out the possibility of a likelihood of confusion, but I must continue to assess the matter on the basis of a global appreciation of all the relevant factors. Approaching the question in this manner, I am left with the view that the specialised consumer of the goods in question will pay particular and considered attention to the signs of origin on the goods he is considering purchasing, and, furthermore, when doing so the descriptive connotation of the words CARBON/KARBON will be clearly apparent to him. If he encounters the mark “carbontime” then he is likely to see it as a distinctive whole, but not, given the descriptive qualities of both the word “carbon” and “time”, the individual elements of it. Similarly, when encountering the KARBON mark, it is also distinctive as a whole (due to its overall impression and the misspelling), but the conceptual reference to carbon will not form part of its distinctive and distinguishing character. The concept of carbon may be common to both marks, but this is a descriptive concept and one that will not form part of the trade origin message that the consumer will take away.

44. In summary, the relevant consumer, applying a high level of consideration, is unlikely to place any form of reliance on the trade origin of the highly specialised goods at issue on the presence of a term he knows to be descriptive. Whilst there is some similarity between the marks, these similarities are outweighed by the descriptive connotation of this point of similarity particularly bearing in mind the high degree of consideration during the purchasing act. Even if there is a bringing to mind of the other mark when encountering the first (or vice versa) this will not, in my view, lead to a likelihood that the relevant consumer will be confused. **The ground of opposition under section 5(2) fails in relation to mechanical watch oscillators and their parts and fittings.**

Likelihood of confusion in relation to precision timing instruments

45. I have already found (see paragraph 23) that “precision timing instruments” is a broad term that would cover (even if this was not the intent of the applicant) basic timepieces such as watches and clocks. I have found there to be identical goods within the opponent’s specification. The relevant consumer here is of a more general nature and the purchasing act, although being reasonably considered, will not be of the highest degree. I have already found that for the relevant consumer, the presence of the word carbon (misspelt in the earlier mark) will have a more distinctive significance as opposed to a descriptive one.

46. Adopting a global approach, and bearing in mind my view that the general public will place some reliance (in terms of distinguishing power) on the presence of the word carbon (misspelt in the opponent’s mark) in both marks, it seems to me that the similarities between them are strong enough to lead to a likelihood of confusion. When the applicant’s mark is encountered, the word “time” will certainly be seen as a descriptive element and therefore the primary point of recall will fall on its carbon element; this is the conceptual hook that will be taken away. The opponent’s mark has the word KARBON as one of its dominant and independent elements and regardless of the misspelling, the conceptual hook is the same. Aural similarity is equally strong.

47. Visual similarity is less strong, however, there is no evidence filed or submissions made to suggest that the purchasing act is predominantly a visual one and therefore that the factor of visual similarity has a significant counteraction on the other factors that I consider to point towards confusion. Indeed, aural similarity may have a greater degree of significance in the overall analysis due to the propensity of watches to be orally requested in a jewellers’ shop for inspection and, furthermore, that word of mouth recommendations are also often made. Therefore, the similarities between the marks and their distinctive and distinguishing qualities, together with the nature of the relevant consumer, outweigh the differences between the marks.

48. I should state that there is, in my view, an likelihood of both direct and indirect confusion. Taking into account the concept that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27) then the respective marks could be directly confused bearing in mind the hook that will be taken away (carbon). Also likely is that the consumer may recall that the word “time” is present in the applicant’s mark, but the non-distinctive nature of this word, together with the common presence of the word CARBON/KARBON means that they will simply believe that the goods are from the same or an economically linked undertaking. **The ground of opposition succeeds in relation to the general term “precision timing instruments and their parts and fittings”.**

Sections 5(3), 5(4)(a) and 56

49. My findings in relation to these grounds of opposition are brief. I say brief because all these other grounds have a similar, although not identical, requirement. A claim under section 5(3) requires a reputation in the UK, a claim under section 5(4)(a) that is based on the common law tort of passing off requires an establishment of goodwill within the UK, finally, a claim under section 56 requires that the mark is well known within the Member State (the UK) or a substantial part of it³.

50. As can be seen in paragraph 35 above, dealing with whether the earlier mark's distinctiveness has been enhanced because of any use made of it, I have found that the evidence filed was inadequate for this purpose. I consider the evidence to be no better for these other grounds of opposition. There is certainly no evidence of a reputation within the UK. The position in relation to goodwill, although one could say that this is a lower hurdle than reputation, does not appear to be any better due to the lack of information on whether the various publications and articles had any UK exposure. Similar observations apply to whether the earlier mark is well known. These requirements are a pre-requisite of a finding under these grounds; their absence is fatal. **Although shortly stated, I reject these grounds of opposition.**

CONCLUSION

51. Given my findings under section 5(2) of the Act, and absent appeal, the application should proceed to registration in relation to:

“Mechanical watch oscillators and parts and fittings thereof”.

COSTS

52. Both sides have achieved a measure of success. In the circumstances, my decision is that both sides should bear their own costs.

Dated this 24th day of April 2008

**Oliver Morris
For the Registrar
The Comptroller-General**

³ See to that effect the judgment of the ECJ in *Alfredo Nieto Nuño v Leonci Monlleó Franquet* C-328/06