

O-121-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3153521
BY ELEVEN ARCHES
TO REGISTER**

ELEVEN ARCHES

**AS A TRADEMARK
IN CLASSES 4, 6, 8, 9, 13, 14, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 31, 32, 33, 41
AND OPPOSITION THERETO (UNDER NO.600000501)
BY
MUNKSJÖ ARCHES**

BACKGROUND AND PLEADINGS

1. Eleven Arches ('the applicant') applied to register the trade mark **ELEVEN ARCHES** on 7 March 2016. It was accepted and published in the Trade Marks Journal on 15 July 2016 in respect of a number of goods and services in classes 4, 6, 8, 9, 13, 14, 16, 18, 20, 21, 24, 25, 27, 28, 29, 30, 31, 32, 33 and 41. For the purpose of this decision it is only necessary to set out the goods in class 16 as only this class is subject to opposition. The goods published for class 16 are:

Class 16: Printed matter; printed teaching activity guides; children's activity books; books; periodicals; brochures; binders; notebooks; postcards; gift wrapping materials; greetings cards; photographs, stationery.

2. Munksjö Arches ('the opponent') opposed the trade mark under Section 5(2)(b) of the Trade Marks Act 1994 (the Act) and under the fast track opposition procedure. This is on the basis of its earlier International Trade Mark set out below:

IR details	Goods relied on
WE no. 469360 ARCHES International registration date: 07 June 1982 Date of Designation of the EU: 08 June 2012 Date Protection Granted in EU: 26 June 2013	Class 16: paper for all artistic techniques, particularly for drawings, aquarelles, engravings, lithographs, screen prints, pastels, pencils, charcoal pencils; papers for bookbinding; papers for luxury printing and publishing.

3. The applicant filed a counterstatement denying the grounds of opposition with supporting explanation.

4. The opponent's trademark is an earlier mark in accordance with Section 6 of the Act. As it is not subject to proof of use, the opponent is entitled to rely upon all of the goods listed in the table above.

5. Rules 20(1)-(3) of the Trade marks Rules ("TMR") (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit".

6. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rules 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was not requested nor considered necessary in this case. Only the opponent supplied written submissions.

SECTION 5(2)(B)

8. Section 5(2)(b) of the Act is as follows:

"5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

9. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

COMPARISON OF THE GOODS

10. The goods to be compared in this case are:

Opponent's goods	Applicant's goods
Class 16: paper for all artistic techniques, particularly for drawings, aquarelles, engravings, lithographs, screen prints, pastels, pencils, charcoal pencils; papers for bookbinding; papers for luxury printing and publishing.	Class 16: Printed matter; printed teaching activity guides; children's activity books; books; periodicals; brochures; binders; notebooks; postcards; gift wrapping materials;

	greetings cards; photographs, stationery.
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11. With regard to the comparison of goods, in the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

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

13. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... 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."

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

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

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

16. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Meric’*), the General Court (‘GC’) held:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

17. In paragraph 7 of the applicant's counterstatement, it is submitted that

“the applicant has no interest in specific and niche types of paper, its own area of interest under its ELEVEN ARCHES trademark being in relation to class 16 goods in the nature of branded stationery and associated merchandise goods to be sold in the on-site gift shop of its entertainment show venue”

18. The way in which the applicant uses their mark is irrelevant. The way the opponent uses its mark is also irrelevant given that its mark is not subject to proof of use. I must compare the parties' goods on the basis of notional and fair use of the goods listed in the parties' specifications. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

19. In addition in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of Justice of the European Union stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. In *Oakley v OHIM* (case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks, ...cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective –of the trade mark proprietors...”

20. I will address each of the applicant’s class 16 terms in turn and, where appropriate, will group terms together.¹

Periodicals; brochures

21. The users of these goods are the general public. The purpose of these goods is to be read or to give information. They are likely to be pre-printed and pre-formatted items. Although there may be some overlap in users and trade channels, their purpose is quite different to the opponent’s goods. These goods are unlikely to contain blank paper for drawing, printing and/or bookbinding. The goods at issue are made of paper as submitted by the opponent but this is insufficient to lead the consumer to believe that the responsibility for both parties’ goods lies with the same undertaking. On that basis I find there to be no similarity between the respective goods.

Printed matter; books; printed teaching activity guides; children's activity books

22. The users of these goods are the general public and there may be some overlap with the opponent’s goods in terms of users and trade channels. These goods are likely to be pre-printed and pre-formatted in part, but may also contain blank sections or pages for children/adults to draw, colour or write on. The goods may be in competition with each other with a consumer choosing between purchasing the opponent’s blank paper or the applicant’s children’s activity books, for example. I find there to be medium degree of similarity between the goods.

¹ *Separode Trade Mark* BL O-399-10

Binders

23. The nature of the goods is different to the opponent's goods but the users and the trade channels are likely to be the same. The purpose of the goods is to keep paper in, so could be complementary to the opponent's goods and they are likely to be found in close proximity in a stationers. I find there to be a medium degree of similarity between the goods.

Notebooks

24. This term includes notebooks of blank pages for drawing or sketching. The respective goods may be in competition with each other given the obvious overlap in purpose. The trade channels and users are likely to be the same. I find there to be a high degree of similarity between the goods.

Post cards; greetings cards

25. Whilst these goods may bear some form of printed image (unlike the opponent's goods), their main purpose is to be written on to send a message or express a sentiment. The opponent's goods could potentially be used for the same purpose and so there may be some degree of competition between the goods and the trade channels may be the same or overlap. I find there to be a low degree of similarity between the goods.

Photographs

26. The purpose of these goods is to present an image for display. They are not intended to be written or drawn on. There is no obvious crossover in trade channels with the opponent's goods. Nor is there likely to be any competition between the goods at issue. I find there to be no similarity between the respective goods.

Gift wrapping materials

27. The purpose of these goods is to cover objects which are to be given as gifts. The term includes boxes or bags as well as sheets or rolls of pre-printed patterned or plain paper. There may be some overlap of trade channels with the opponent's goods and there may be some low level of competition between the goods at issue if a consumer chooses between, for example, the applicant's patterned gift wrapping paper or the opponent's plain paper to decorate themselves and use as gift wrap. Taking all these factors into account, I find there to be low degree of similarity between the goods.

Stationery

28. This term is very broad and is likely to cover all types of paper, artists' materials and office requisites. As such, it covers all of the opponent's goods and so on the *Meric* principle they are identical.

29. As I have found no similarity between the applicant's goods of periodicals, brochures and photographs and the opponent's goods, then it follows that the opponent has no prospect of success in relation to them. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

AVERAGE CONSUMER AND THE PURCHASING ACT

30. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood

of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

31. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

32. The average consumer for the parties' goods is the general public. All of the goods are primarily visual purchases, but I cannot not rule out an aural element if for example advice is sought from an art or paper supplier prior to purchase. Prices could vary within the range of goods, however I believe that the level of attention paid would be at least reasonable to the extent that choices may have to be made with regard to paper size, weight, texture, cost and suitability for purpose and the consumer may also take into account the aesthetics of gift wrap and greetings cards, for example.

COMPARISON OF THE MARKS

33. The marks to be compared are:

Opponent's mark	Applicant's mark
ARCHES	ELEVEN ARCHES

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

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.

35. Both marks are word only and have the word ‘arches’ as the common element.

36. The opponent’s mark is a single word in plain font. Therefore the overall impression lies solely in that word.

37. The opponent claims that the dominant and distinctive element of the later mark is ARCHES. It also claims that ELEVEN ‘should be considered negligible for the purposes of comparing the marks’. I am not persuaded by this submission that ELEVEN is negligible. The applicant argues that the consumer would pay more attention to ELEVEN than ARCHES. I also do not agree with this submission. I consider that the two words combine to form a phrase in which neither word materially dominates the other.

38. In a visual comparison of the marks, the opponent has a one word mark, the applicant has two. The common element to both is the word ARCHES. I conclude that there is a medium degree of similarity.

39. In an aural comparison of the marks, and returning to the opponent's submission that they felt the word ELEVEN to be 'negligible', I see no reason why, when speaking about the mark, the average consumer would not vocalise both words in their entirety. I conclude that there is a medium degree of similarity.

40. In a conceptual comparison of the marks, the word ARCHES is likely to indicate a structure and the word ELEVEN being a number of such structures. I conclude that there is a high degree of similarity.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

41. The distinctive character of the earlier mark must be considered. 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-0000, 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).”

42. As no evidence has been filed in this case, I can only consider the trade mark’s inherent distinctiveness.

43. The earlier trademark consists of a single dictionary word which has no meaning in relation to the goods at issue. It is not descriptive or allusive. Therefore I would say that the mark has a normal level of distinctiveness.

LIKELIHOOD OF CONFUSION

44. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

45. I have found that certain of the applicant’s goods share a low, medium and high degree of similarity with the opponent’s goods and that there is a medium degree of visual and aural similarity and a high degree of conceptual similarity. I have also found that the purchase of the goods at issue is likely to be mainly visual so the level of visual similarity is of particular importance.² Taking all these factors into account,

² In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated: “49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in

together with the normal level of distinctiveness of the earlier mark, I do not consider there to be a likelihood of direct confusion between the applicant's mark and the opponent's mark, on the part of an average consumer paying at least a reasonable degree of attention. However I do find that, when all factors are considered, and bearing in mind in particular the high degree of conceptual similarity between the marks, that the average consumer is likely to be confused in to believing that respective goods come from the same or linked undertakings. Consequently I find that there is a likelihood of indirect confusion.

CONCLUSION

46. The opposition succeeds under section 5(2)(b) of the Act for the following goods opposed in class 16:

Printed matters; books; Printed teaching activity guides; children's activity books; binders; notebooks; post cards; greetings cards; gift wrapping materials; stationery.

47. The opposition fails under section 5(2)(b) of the Act for the following goods in class 16:

Periodicals; brochures; photographs.

COSTS

48. As the opponent has had the greater degree of success, which I estimate to be around 70%, they are entitled to a contribution towards their costs incurred in the proceedings, but this will be adjusted to take account of the degree of success

particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."

enjoyed by the applicant. Using the guidance in Tribunal Practice Notice 2/2015 (which was in force when the opposition was filed) I make the following award:

£100 official fee for TM7

£140 preparing a statement and considering the other side's statement

£70 written submissions.

49. I order Eleven Arches to pay Munksjö Arches the sum of £310. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of March 2017

J Ralph

June Ralph

For the Registrar,

The Comptroller General