

O/156/15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2605074
BY
BM POLYCO LTD**

TO REGISTER THE TRADE MARK

METALLICA

IN CLASS 9

AND

**THE OPPOSITION THERETO
UNDER NO 103562
BY
METALLICA, A CALIFORNIA GENERAL PARTNERSHIP**

BACKGROUND

1. On 20 December 2011, BM Polyco Ltd (the applicant) applied to register the trade mark: **METALLICA** in class 9 of the Nice Classification system.¹ The specification stands as follows:

Class 9

Cut and puncture resistant safety gloves; safety gloves containing metal; safety gloves for industrial and commercial use.

2. The application was published on 6 April 2012, following which Metallica, a California General Partnership (the opponent) filed notice of opposition against the application.

3. The opposition was brought under section 5(2)(a) of the Trade Marks Act 1994 (the Act). The opponent relies upon community trade mark (CTM) 4545018 for the services shown below:

Mark details and relevant dates	Services relied on
<p>Mark:</p> <p>METALLICA</p> <p>Filing date:</p> <p>Date of entry in the Register: 24 September 2010</p>	<p>Class 35 Retail services in the fields of clothing (and) footwear.</p>

4. On 21 January 2014,² the applicant filed a counterstatement, denying the grounds of opposition.

5. The applicant did not file evidence. The opponent filed written submissions in the period allowed for the filing of evidence. Neither side filed written submissions in lieu of attendance at a hearing nor did they request a hearing.

6. I give this decision following a review of all of the material before me.

DECISION

7. The opposition is brought under section 5(2)(a) of the Act which reads as follows:

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

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

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

² *Following two periods of cooling off.*

8. 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) or 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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. The opponent’s mark is an earlier mark which had not been registered for five years at the date of publication of the application. Consequently, the proof of use requirements set out in section 6A of the Act, do not apply.³ Accordingly in these proceedings, the opponent is entitled to rely on its earlier mark for the full specification as registered.

Comparison of marks

10. Both parties’ marks consist of the nine letter word METALLICA. Both are presented in block capitals with no additional stylisation.

11. Clearly, the mark applied for and the opponent’s earlier mark, are identical.

The average consumer

12. 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*. 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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

13. The applicant’s goods are safety gloves for use commercially or within industry. Clearly the average consumer for these goods is likely to be a professional working within such an industry. The purchase of such goods may be made for their own use or use by their employees. These goods are likely to require a slightly higher than average level of

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

attention to be paid in making a selection due to their purpose, namely the protection of a person's hands.

14. The opponent's services are broad, including the retail of a wide range of clothing and footwear items which may include clothing for weddings on one hand and socks/t-shirts on the other. Accordingly, the level of attention paid by an average consumer choosing a service provider for clothing and footwear goods is likely to vary according to the nature of goods required and the purpose for which they are intended.

15. The nature of the purchase is likely to be primarily visual, in both cases, the average consumer encountering the goods, services and trade marks on the internet, via a catalogue or product literature, through advertising or at the point of purchase such as in store or on the high street, though I do not rule out there may be an aural element, particularly where advice is sought prior to purchase.

Comparison of goods and services

16. The goods and services to be compared are as follows:

The opponent's services	The applicant's services
Class 35 Retail services in the fields of clothing (and) footwear.	Class 9 Cut and puncture resistant safety gloves; safety gloves containing metal; safety gloves for industrial and commercial use.

17. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

"29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

18. I also bear in mind the comments of the CJEU in *Canon* in which it stated, at paragraph 23 of its judgment:

"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."

19. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (a) the respective *uses* of the respective goods or services;
- (b) the respective *users* of the respective goods or services;

(c) the physical nature of the goods or acts of service;

(d) the respective trade channels through which the goods or services reach the market;

(e) in the case of self-serve consumer items, where in practice they are 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;

(f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

20. Guidance from the same case with regard to interpreting terms in specifications is given as:

In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

21. I also bear in mind comments in *YouView TV Ltd v Total Ltd* when⁴ Floyd J said:

“... 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.”

22. Further, in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267, Neuberger J 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.”

23. With regard to specifications for services Jacob J stated in *Avnet Incorporated v Isoact Limited*:⁵

⁴ [2012] EWHC 3158 (Ch) at [12]

⁵ [1998] F.S.R. 16

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

24. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (*Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

25. In this case the comparison to be made is between the applicant’s goods which are broadly safety gloves and the opponent’s retail services ‘in the fields of footwear and clothing’. In making a finding I am mindful of the following guidance:

26. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

27. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

28. On the basis of the European courts’ judgments in *Sanco SA v OHIM*⁶, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁷, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*⁸, Mr Hobbs concluded that:

⁶ Case C-411/13P

⁷ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁸ Case C-398/07P

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

29. The opponent submits that:

"Safety gloves are clothing and therefore specifically included in the stock for sale by the Opponent's retailing services, so the services are similar to the goods for the purposes of Section 5(2)(a)."

30. As can be seen from the case law I have identified above, it is not sufficient to simply point to goods which are provided by a particular retail service and conclude that the goods and the services must be the same. I must consider all of the circumstances and the relationship between the particular goods and services at issue.

31. In this case it is worth noting that whilst clothing and footwear goods may be classified in a different classes according to their particular characteristics, the retail of such goods may only be classified in class 35. Therefore, the obvious conclusion must be that retail of clothing and footwear at large includes the retail of the broad range of clothing and footwear which are classified in a number of goods classes. Whilst I appreciate that classification is to some extent the result of administrative necessity, in this case the retail services in the opponent's specification may include retail of the types of goods included in the specification applied for.

32. Having made such a finding I must determine whether the relationship between them is sufficient to give rise to similarity and if so, to what extent. With regard to these particular services, in my experience, it is not uncommon to see a clothing/footwear retailer trading in goods provided by third party traders, goods sold under their own 'house' brand(s) or a combination of the two. This clearly gives rise to an obvious similarity between the goods branded 'x', in this case, safety gloves, and the same goods sold under an own name brand by retailer 'x', who retails clothing which may include safety gloves. Taking all of these factors into account, there may be coincidence of users, uses and trade channels and a complementary relationship between these goods and services. I find the goods and services at issue to be similar to a medium degree.

Distinctive character of the earlier mark

33. The degree of distinctiveness of the earlier mark must be assessed. This is 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). 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).”

34. The opponent’s mark is the word METALLICA. It is not stylised in any way. It will be seen as an invented word by the average consumer and therefore, cannot be said to be descriptive or elusive of the goods and services at issue. It enjoys a high level of inherent distinctive character.

Likelihood of confusion

35. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁹ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

36. The parties’ marks are identical and the goods and services are similar to a medium degree. The earlier mark has a high level of inherent distinctive character. Taking these factors into account, I find there is a likelihood of confusion as the goods sold under the mark applied for would be assumed to be offered by the same or economically linked undertaking as the earlier marks’ services or vice versa. **The opposition succeeds under section 5(2)(a) of the Act.**

⁹*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

COSTS

37. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I take into account in making an award that the submissions filed by the opponent on 20 May 2014 amount to one paragraph and I decline to make an award in respect of them. The award stands as follows:

Preparing a statement and considering the other side's statement:	£300
Official fee:	£100
Total:	£400

38. I order BM Polyco Ltd to pay Metallica, a California general partnership the sum of £400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9TH day of April 2015

**Ms Al Skilton
For the Registrar,
The Comptroller-General**