

O-159-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3162078 BY
SUBLI BLANKS LIMITED**

TO REGISTER THE TRADE MARK:

Galaxy

FOR GOODS IN CLASS 7

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600000471 BY
GARETH RICHARD EVANS**

Background

1) On 29 April 2016 Subli Blanks Limited (“the Applicant”) applied to register the following trade mark:

Galaxy

The application was published for opposition purposes on 20 May 2016. During the course of these proceedings the Applicant filed an amendment of its specification, so that it now covers the following services:

Class 7: *Heat sealing machines; heat transfer presses, heat transfer swing press, heat transfer mug press, pneumatic mug press, heat transfer clam press, heat transfer roll press, heat transfer vacuum press, heating mug elements, transmatic heat transfer presses, pneumatic heat transfer presses; Presses for industrial purposes [machines]; Presses for industrial use [machines]; Pressing machines; Pressing machines for industrial purposes.*

2) The application is opposed by Gareth Richard Evans (“the Opponent”) under the fast track opposition procedure. The opposition, which is directed against all the goods in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon the earlier UK trade mark registration no 3067334 for the following mark in respect of the following goods:



Class 7: *Paper folding machines & sundries; Folder Inserter (machines); Creasing & Perforating machines; Letter Openers (machines); Punches, Cutters and Rounders (machines); Print Finishing machines; Business card cutters (machines); Paper Shredders.*

The mark was applied for on 05 September 2014 and its registration process was completed on 19 December 2014. The significance of these dates is that (1) the Opponent's mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the Applicant's mark.

3) In a letter of 22 August the Registry required the Opponent to amend the form TM7F submitted by the opponent on 18 August 2016 in two respects: firstly, the date given for when the earlier mark became registered was inconsistent with the Registry's records; secondly, at Question 1 in respect of "which goods or services covered by the earlier mark are relied upon for the opposition" he had indicated "some", so that his accompanying description "Class 7 but particularly Print Finishing machines" was considered ambiguous. The Opponent was invited to amend the form accordingly, and informed that respective replacement pages would suffice. The goods relied on are as shown in paragraph 2 above.

4) The Applicant filed a counterstatement, denying the grounds of opposition. It also observed that

"...when submitting a new form TM7F, the opponent took the opportunity to also amend the answer to Q13, without making a request to do this. This effectively extended the opposition period for the opponent, allowing him to flesh out his arguments after a further three weeks consideration. Therefore the applicant requests that the opponent's original answer to Q13 should stand.....

..... In the original form filed, the opponent fails to provide any arguments as to similarities between the marks or between the goods, or why there would be a likelihood of confusion. The opponent merely states that the goods in the application 'Include print finishing machines', which is clearly not the case as print finishing machines do not appear in the applicant's specification."

5) In the TM7F form originally submitted the Opponent states:

“Subli Blanks Limited is in the same industry as the opponent, namely the print industry. Not only this, but they supply some of the same services i.e. print finishing. As such, it is believed that some of their goods and services are identical or sufficiently similar and there is a likelihood of confusion with using the name ‘galaxy’ in their trade mark for their services in the print industry”.

6) The Opponent goes on to say that the Applicant’s specification “includes print finishing machines”, and that the specification of the earlier mark “includes, among other areas, ‘Print Finishing machines’”. In the second version he adds: “These are, it would be stated, all machines that finish a product”.

7) Both versions of the Opponent’s answer to Question 13 contain some irrelevant matter; later in the course of my decision I shall deal with the points raised, including whether the Applicant’s goods can be described as “print finishing machines”. At this point it suffices to say that I cannot see that the second TM7F changes the nature of the original statement of grounds. It clarifies that all goods of the earlier mark are relied on to oppose all the goods of the Applicant’s mark. Although it could have been better drafted, I think it emerges tolerably clearly even from the initial version that the Opponent is, amongst other things, asserting that the products of both competing specifications can be viewed broadly as facilitating the finishing of products which may be seen as printed products – whether these comprise printed paper or card, or textiles or ceramics bearing a printed graphic element. Both competing specifications are relatively brief. I do not consider that the Applicant has been disadvantaged in any way by the Opponent’s “fleshing out” of his answer to question 13.

8) Rule 62(5) (as amended) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) (“the Rules”) states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) 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

neither requested nor considered necessary. The Opponent filed written submissions. The Opponent was represented by Isis Legal and the Applicant by Atkinson & Company Intellectual Property Limited.

9) The Opponent incorporates into his written submissions, and the Applicant incorporates into its notice of defence and counterstatement, various web page addresses in support of statements they make as to matters of fact. This material, and those statements of fact, constitute evidence. In order to be considered in these proceedings they would need to have been filed in proper evidential format, i.e. in the form of a witness statement, statutory declaration or affidavit accompanied by relevant print-outs. Rules 20(1)-(3) (as amended) of the Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4), which does, reads:

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

10) The net effect of the above is that parties are required to seek leave in order to file evidence (other than proof of use evidence which is not pertinent in these proceedings) in fast track oppositions. In a letter of 26 January 2017 the parties were referred to the guidance at paragraph 7 of Tribunal Practice Notice 2/2013 and advised that any request for leave to file evidence should be submitted on or before 9 February 2017. Neither sought leave to file evidence in these proceedings. Accordingly, material which should have been filed in evidential format has not been admitted as evidence in these proceedings. I have taken no account of it in reaching my decision, and will not refer to it.

Section 5(2)(b)

11) Section 5(2)(b) of the Act reads 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”.

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

(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 goods

13) In the judgment of the CJEU 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”.

14) 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.

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

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

16) In his statement of grounds the Opponent states that

“Subli Blanks Limited is in the same industry as the opponent, namely the print industry. Not only this, but they supply some of the same services i.e. print finishing.....”

Having listed the goods of the Applicant’s specification (which at that point also included *printing presses for ceramic material* and *printing presses*) the Opponent submits that these include print finishing machines. He goes on to state that his own firm supplies certain products covered by the Applicant’s specification.

17) The Opponent’s statements concerning products sold by his business are statements of fact. As I indicated at paragraph 10, I cannot accept these statements as establishing those facts, since they have not been filed in proper evidential format. Even if I accepted that these facts had been proved, however, they would not be relevant. This is because it is only goods covered by the earlier mark’s specification that may be relied upon in an opposition under section 5(2)(b) of the Act. It is settled law that in assessing whether there is a likelihood of confusion I must make my comparison on the basis of notional and fair use over the whole range of goods covered by the Applicant’s and (since the earlier mark is not subject to proof of use under section 6A of the Act) the Opponent’s respective specifications. I am required to consider the likelihood of confusion “in all the circumstances in which the mark applied for might be used if it were to be registered” (See the comments of the CJEU in Case C-533/06, *O2 Holdings v Hutchison 3G UK* at paragraph 66). However, it is the inherent nature of the goods of the specifications which I have to consider. Goods not covered by the earlier mark’s specification cannot be relied upon in the opposition. Nor are current use and business strategy relevant to this notional comparison (see the comments of the GC in *Devinlec Développement Innovation Leclerc SA v OHIM* Case T- 147/03).

18) The next question I must determine, therefore, is whether goods of the Applicant’s specification fall within the ambit of the *print finishing machines* of The Opponent’s’ specification. In its counterstatement the Applicant submits that the term “print finishing” is well understood in the printing industry as being the finishing

of printed paper only, such as cutting, folding, binding, sealing, laminating, varnishing, and so on, and that it does not encompass any of the goods of the Applicant's specification. It argues that, using normal language, "print finishing machines" means machines for use with paper, performing actions such as collating, cutting, folding, binding, etc. In his written submissions the Opponent disputes the assertion that that the this term would be seen in trade as referring to finishing on paper and not on three dimensional products.

19) When it comes to understanding what terms used in specifications mean and cover, the guidance in the case-law is to the effect that "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 the trade"¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

"..... 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) (IPTRANSLATOR)* [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."

20) The nub of the Opponent's argument, as I understand it, is that the process of printing text or images on products such as mugs or T-shirts in order to finish them,

¹*British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281

²*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

and the process of finishing (by cutting, folding, binding, etc.) products consisting of printed matter such as booklets, leaflets, cards, placards, posters, etc., both involve the finishing of a printed product, and can therefore both be described without straining the language as “print finishing”; accordingly, the devices employed to imprint text and images on, for example, textile and ceramic items, and the tools used to finish products consisting of matter printed on paper or card, can all be described as “print finishing machines”. I agree. I do not consider that the relevant public would understand the term “print finishing” as being necessarily confined to paper/card print finishing. In my view, the relevant public, being aware that a garment or item of crockery, for example, may be finished by the imprinting of a text or image on it, would find it natural to regard that process as being covered by the term “print finishing”, and the devices employed in this operation as being covered by the term “print finishing machines”.

21) It follows that the Applicant’s *heat sealing machines, heat transfer presses, heat transfer swing press, heat transfer mug press, pneumatic mug press, heat transfer clam press, heat transfer roll press, heat transfer vacuum press, heating mug elements, transmatic heat transfer presses* and *pneumatic heat transfer presses* fall within the ambit of the Opponent’s *print finishing machines*. Accordingly, they are identical with the Opponent’s *print finishing machines* under the guidance in *Meric*. The Applicant’s *presses for industrial purposes [machines]; presses for industrial use [machines]; pressing machines; pressing machines for industrial purposes* also cover the various heat press products considered above, and are thus also identical with the Opponent’s *print finishing machines*.

22) In case I am wrong in my determination as to the ambit of the term *print finishing machines*, however, I will now also make an assessment as to similarity between the competing goods. In doing so I will adopt the assumption that the term *print finishing machines* should – contrary to my finding above – be narrowly construed as applying only to print finishing machines which operate on paper or card. I will make the comparison with reference to the Applicant’s goods. I will go through them term by term (but grouping them when it is useful and reasonable to do so – see the comments of the Appointed Person in *Separode* BL O-399-10). With the possible exceptions of *letter openers* and *paper shredders*, I consider that all the goods of the

Opponent's specification can be regarded as covered by the term *print finishing machines*. It will therefore be convenient to compare the goods of the Applicant's specification with the Opponent's *print finishing machines*, mentioning other goods of the Opponent's specification only if a point can usefully be made by reference to them specifically.

Heat sealing machines; heat transfer presses, heat transfer swing press, heat transfer mug press, pneumatic mug press, heat transfer clam press, heat transfer roll press, heat transfer vacuum press, heating mug elements, transmatic heat transfer presses, pneumatic heat transfer presses

23) The Applicant submits that while the Opponent's goods are machines for use on paper in order to finish a printing process, the applicant's goods are machines for printing onto objects using a heat transfer process, and industrial presses, which are generally used for producing three-dimensional objects, and that the goods in the two specifications therefore have completely different uses.

24) The Applicant submits that the likely users of the Opponent's goods are printers of books, magazines, etc, whereas the users of the Applicant's goods are suppliers of printed objects such as cups, T-shirts, bags etc. It further submitted that the printing of paper and the printing of objects are not generally activities undertaken by a single company, though it is possible that there may be some overlap between users, for example a graphic print company offering a number of services. The Opponent submits that there are many businesses which do both.

25) On the physical nature of the goods the Applicant submits that they are completely different machines, most of the Opponent's goods being mechanical machines for the folding, cutting, sorting etc of paper, whereas, by contrast, the Applicant's goods all apply heat and/or pressure to objects in order to transfer a design or create an object. The Opponent submits that most of its products also apply pressure to create a finished result.

26) The Applicant submits that print finishing machines are in general sold by different retailers and wholesalers from those who sell heat transfer presses and pressing machines. The Opponent disputes this.

27) The Applicant submits that the Applicant's and Opponent's goods cannot be used for the same purposes, and are not in competition. Further, they cannot be used on the same kind of items, and are therefore not complementary.

28) I shall begin by comparing the Applicant's *heat sealing machines; heat transfer presses, heat transfer swing press, heat transfer mug press, pneumatic mug press, heat transfer clam press, heat transfer roll press, heat transfer vacuum press, heating mug elements, transmatic heat transfer presses* and *pneumatic heat transfer presses*, these being machines used in printing onto objects using a heat transfer process, with the Opponent's' *print finishing machines*.

29) If one construes the term *print finishing machines* as applying only to print finishing machines which operate on paper or card, I agree that printers of books, magazines, etc. would be likely users of the Opponent's goods, and that the users of the applicant's goods are suppliers of printed objects such as cups, T-shirts, bags etc. While it may be true that the printing of paper and the imprinting of designs or text on objects such as garments or crockery may not generally be activities undertaken by a single company, some overlap is also to be expected. Indeed, the Applicant concedes that it is possible that there may be some overlap between users – for example a graphic print company offering a number of services. Not only businesses of all sizes, but also charities, clubs and associations of private persons, some of which may be small or local, will require not only printed matter such as booklets, leaflets and posters, etc. promoting or furthering their business or objects, but also promotional objects such as mugs, T-shirts, mouse mats, coasters, key rings, etc. One may expect, therefore, some overlap between users of the Applicant's machines used in printing onto objects using a heat transfer process and users of the Opponent's print finishing machines, whether these users be in-house or third party providers.

30) I accept that, for example, laminators and heat binders, such as would be covered by the Opponent's *print finishing machines*, and the Applicant's various heat transfer printing machines are very different machines. Nevertheless, both apply heat and/or pressure in connection with the printing of objects or paper, so that I think that at least some degree of similarity in their respective physical natures can be recognized.

35) Accepting that imprinting text or graphics onto objects such as garments or crockery on one hand, and the printing and print finishing of paper and card on the other, will be seen as separate processes requiring different techniques and different machines, I nevertheless consider that the average consumer would recognize a degree of similarity between the printing of text or images on certain objects and on paper or card. They may well wish to offer to customers, or, for that matter, to arrange themselves in-house, the printing of the same images, slogans, logos, etc. on various media, including leaflets, posters, mugs, T-shirts, etc. Although the method of use and physical nature of the operations performed by the Applicant's machines for printing objects using heat transfer and the Opponent's print finishing machines may be different, and the respective machines are not physically in competition or complementary, there would nevertheless be a certain degree of shared purpose.

36) The parties disagree about channels of trade. Even if heat transfer machines are in general sold by different retailers and wholesalers from heat presses, however, I consider that the factors I have outlined above result overall in a moderate degree of similarity – that is to say a degree of similarity less than medium but somewhat more than low – between the Opponent's *print finishing machines* and the Applicant's *heat sealing machines; heat transfer presses, heat transfer swing press, heat transfer mug press, pneumatic mug press, heat transfer clam press, heat transfer roll press, heat transfer vacuum press, heating mug elements, transmatic heat transfer presses* and *pneumatic heat transfer presses*.

Presses for industrial purposes [machines]; Presses for industrial use [machines]; Pressing machines; Pressing machines for industrial purposes.

37) The Applicant submits that industrial presses are generally used for producing three-dimensional objects. However, *presses for industrial purposes [machines]; presses for industrial use [machines]; pressing machines; pressing machines for industrial purposes* are terms broad enough to cover the various heat presses considered above, which I have already found to have a moderate degree of similarity with the Opponent's *print finishing machines*. The terms would also cover printing presses, which manifestly have a high degree of complementarity with the Opponent's *print finishing machines*. Users of printing presses and print finishing machines will largely coincide. Moreover, as the Opponent points out, many of his goods also apply pressure to create a finished result, examples being those deployed in paper punching, cutting, folding, indenting and perforating. There is therefore also at least some degree of physical similarity. Overall, there is at least a medium degree of similarity between the Opponent's *print finishing machines* and the Applicant's *presses for industrial purposes [machines]; presses for industrial use [machines]; pressing machines; pressing machines for industrial purposes*.

The average consumer and the purchasing process

38) 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

39) The Applicant submits:

“The average consumer of both the applicants and the opponent’s goods is not an individual making quick decisions in the supermarket, but a person working for a business, purchasing expensive machines for use in a factory or shop. They are therefore likely to be knowledgeable and have a high degree of attentiveness.”

The Opponent submits:

The Applicant seems to argue that only large business using these machines for a factory or shop will be considering the website. This is not accepted. The costs of the machines provided by the Opponent (and proposed by the Applicant) are not thousands of pounds and many can quite easily be within the budget of a member of the public with not [*sic*] specific industry knowledge.

40) The relevant goods of the competing specifications cover a wide potential spectrum of technical items. Machines for printing onto objects using a heat transfer process, pressing machines and print finishing machines may all range from industrial plant for large-scale mass production to much smaller scale items suitable for more limited use in small and medium-sized businesses. There may even be some scope for use by members of the public producing hobby items. Where pressing machines are described as being for industrial use, this does not preclude smaller scale items for use by SMEs.

41) The purchase of large-scale industrial plant may involve exploratory meetings or conversations with, or invited tenders from, potential suppliers. However, the degree of attention of a small or medium-sized business (or a private purchaser) buying a relatively less expensive item will obviously be less than that of a large concern awarding a substantial purchasing order for heavy-duty plant. The goods will still be selected with due care and attention, though, having regard to the purchaser’s requirements. The purchasing process is likely to be primarily visual, the average consumer encountering the goods and trade marks on the internet, in a catalogue or in product literature; but oral dealings may also play a part, and aural considerations will also be considered in my assessment.

Comparison of the marks

42) 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo*, 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.”

43) It would be wrong, therefore, to dissect the trade marks artificially, 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.

44) The marks to be compared are shown below:

The Applicant's mark	The earlier mark
Galaxy	

45) The Applicant's mark appears on the register as the word *Galaxy* in plain font with an initial capital. The orthographical treatment does not play a role. The word itself, being the mark's sole element, forms its dominant and distinctive component.

46) The earlier mark consists of the word *galaxy* in a plain font and lower case throughout. The centre of the upper loop of the initial letter *g* is encircled by an elliptical red figure suggestive of a representation of the planet Saturn. The words *PRINT FINISHING* appear in much smaller capitals in a plain red font between the tails of the letters *g* and *y*. Although not negligible in the overall impression of the mark, these words will receive limited attention when the mark is encountered visually, the focus lying on the word *galaxy*. As the Applicant's mark is a word mark not limited to colour, the earlier mark will be drained of colour for the purposes of comparison of the respective marks³, but I bear in mind that it consists of two tones. Nevertheless, its figurative elements are graphically quite simple and their contribution to the overall impression of the mark is also a relatively minor one. The distinctive weight of the mark lies heavily on the clearly dominant word *galaxy*. Viewing the mark as a whole, there is a high degree of visual similarity between the competing marks.

47) Aurally, the figurative elements of the earlier mark will not be articulated. It is unlikely that the words *PRINT FINISHING* in the earlier mark will normally be articulated in trade, because they will be perceived as descriptive, and the mark can be referred to much more simply by its distinctive dominant element *galaxy*, making the marks aurally identical. Even if the words *PRINT FINISHING* are included in oral use, however, I consider that there is still a high degree of aural similarity between the marks.

48) Similarly, the words *PRINT FINISHING* add a conceptual element not present in the Applicant's mark but, being descriptive, their impact on the attention of the consumer will be limited in comparison with the heavily dominant and distinctive word *galaxy*. Insofar as the simple figurative elements evoke a planetary motif, I think this concept will itself be seen as closely associated with, and alluding to, that

³ See on this the observations of Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch).

of the word *galaxy*. There is a reasonably high degree of conceptual similarity between the marks.

The distinctiveness of the earlier mark

49) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, on the basis either of 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).”

50) I have no evidence of acquired distinctiveness to consider. I therefore have only the inherent distinctive character of the earlier mark to assess. The words *PRINT FINISHING* are descriptive. I have already found that the graphic and figurative elements of the Opponent’s mark play only a subordinate role, the mark’s

distinctiveness lying overwhelmingly in its word element *galaxy*. The word *galaxy* is neither descriptive nor allusive of the relevant goods. Overall, the earlier mark has a normal degree of distinctive character.

Likelihood of Confusion

51) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

52) I have found a high degree of visual similarity, either aural identity or, at any rate, a high degree of aural similarity, and a reasonably high degree of conceptual similarity between the competing marks. I have found the earlier mark to have a normal degree of inherent distinctive character. I have noted that the figurative elements of the contested mark are graphically quite simple, that their contribution to the overall impression of the mark is a relatively minor one, and that their conceptual content, where noticed, will be seen as closely associated with, and allusive of, that of the clearly dominant and distinctive word *galaxy*. Where noticed, the figurative elements will be seen as a small, decorative embellishment of the basic *galaxy* mark. Given the effects of imperfect recollection, they may not be recalled.

53) I have found some of the Applicant's goods to have at least a medium degree of similarity with those of the earlier mark, while others are similar to a moderate degree. Even where I have found only a moderate degree of similarity between the competing goods, however, I consider that the differences between them are not sufficient to avoid confusion, in view of the high degree of similarity overall between the competing marks, and bearing in mind my findings on the average consumer, the purchasing process, and the degree of attention with which purchases will be made. The words PRINT FINISHING in the earlier mark may well go unnoticed. Even where noticed, however, they cannot serve to avoid confusion. These purely descriptive words simply add a non-distinctive element to the mark, of the kind which

one would expect to find in a sub-brand or brand extension⁴. They may be taken to indicate a particular line of goods covered by the *galaxy* brand. I consider that there is a likelihood that a consumer who encounters the earlier mark used in connection with print finishing machines (even where this term is construed narrowly as covering only print finishing machines which operate on paper or card) will be confused when meeting with the Applicant's mark used for the goods of the Applicant's specification.

54) Where the differences between the marks are noticed, they will not be perceived as indicating a different trade origin from that of the earlier mark; rather, in the light of the strongly dominant and distinctive *word* galaxy, the marks will be seen simply as variants; the average consumer will believe that the respective goods come from the same or economically linked undertakings; there is a likelihood of indirect confusion. Where the differences in the competing marks go unnoticed there is a likelihood of direct confusion. There is a likelihood of confusion in respect of all the goods of the Applicant's mark. Accordingly, **the opposition succeeds in its entirety.**

Costs

57) Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. The Opponent has been successful and is entitled to a contribution towards his costs. The pleadings and the written submissions were simple and brief. I hereby order Subli Blanks Limited to pay Mr Gareth Richard Evans the sum of £450. This sum is calculated as follows:

Opposition fee	£100
Preparing a statement and considering the other side's statement	£150
Preparing written submissions	£200

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

⁴ See the observations of Mr Iain Purvis, QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 at paragraph 17(b).

Dated this 30th day of March 2017

**Martin Boyle
For the Registrar,
The Comptroller-General**