

O-176-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2532782  
BY  
ACTION ON ADDITION  
TO REGISTER THE TRADE MARK**

**SHARP**

**IN CLASSES 35, 36, 43 AND 44**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 100563  
BY  
SHARP KABUSHIKI KAISHA (SHARP CORPORATION)**

## Background and pleadings

1. Action on Addiction (“the applicant”) applied for the trade mark SHARP (number 2532782) on 25 November 2009. The application was published in the *Trade Marks Journal* on 26 February 2010, following which it was opposed by Sharp Kabushiki Kaisha (Sharp Corporation) (“the opponent”).

2. After the opposition was filed, the applicant deleted its specifications in classes 16 and 41. The services listed below remain opposed:

Class 35: *Charitable services, namely, business management and administration; charitable services, namely organising and conducting volunteer programs and community service projects.*

Class 36: *Charitable fundraising services, charitable collections and charitable services, namely, financial services.*

Class 43: *Temporary accommodation.*

Class 44: *Medical services; medical clinics; health care; medical assistance; services of a psychologist; counselling relating to the treatment of medical ailments; medical counselling; psychological counselling; provision of nursing care; medical nursing services; residential medical treatment services; residential medical advice services; advisory services relating to addictions and rehabilitation treatments.*

3. The opposition is brought under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup>. Section 5(1) states:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier mark is protected.”

The opponent’s 5(1) ground, as pleaded, is predicated upon the parties’ goods in class 16 being identical; however, following deletion of the applicant’s class 16 goods, this ground can no longer stand.

4. Sections 5(2)(a) and (b) of the Act state:

“(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, or

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<sup>1</sup> Grounds under sections 5(3) and 5(4)(a) were also originally pleaded, but were later withdrawn.

(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.”

5. The opponent relies upon all of the goods and services of two<sup>2</sup> earlier registered marks, and opposes all of the services in the application. The marks relied upon are:

(i) Community Trade Mark (“CTM”) 124511

SHARP

Class 2: Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists; toners for copying apparatus and machines.

Class 7: Machines; electric washing machines, electric mixers for cooking, printing machines, drying machines, dish washers; parts and fittings therefor; but not including blades, teeth, cutting edges and machines for cutting purposes.

Class 8: Hand tools and hand operated implements; electric razors, electric shavers; but not including hand tools and hand operated implements for cutting purposes.

Class 9: Scientific, nautical, surveying, electric, electronic, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; calculating machines, fire-extinguishing apparatus; and parts, fittings and apparatus adapted for use with all the aforesaid goods; electronic cash registers; data processing equipment, computers; word processors; electronic calculators; copying machines; drums for copying apparatus and machines; printers for use with computers, word processors, electric organisers; video camcorders; scanners, electronic organisers; computers operating system software; hand-held terminal units for data processing; integrated circuit cards for electronic organisers, modems; facsimile machines; video camcorders, video cassette recorders, video tapes, videophones, video disc players; computer game apparatus; accumulators, batteries; television receivers; TV monitors; liquid crystal display monitors; antennas; liquid crystal display (LCD) projectors; radio cassette tape recorders; radio cassette tape recorders with a compact disc player; stereophonic sound systems comprising tape/disc/record players, tuners, amplifiers and speakers; compact disc players; mini disc players; headphone stereo cassette players; telephones; transceivers; intercommunication apparatus; remote controllers; car navigating apparatus; liquid crystal display apparatus; computer projection panels; vacuum cleaners; electric irons; integrated circuits; solar cells; electronic components; electro-luminescence displays; light-emitting diodes (LED's); electronic whiteboards.

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<sup>2</sup> Four marks were originally pleaded, but the opponent reduced this to two in its written submissions dated 11 October 2012.

Class 10: Medical and surgical apparatus and instruments; electronic clinical thermometers, electronic blood pressure monitors; but not including surgical cutting instruments or needles.

Class 11: Installations using electricity or solar energy for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; coffee filters and coffee percolators, all being electric; cooking apparatus; microwave ovens, air conditioners, refrigerators, lighting equipment, electric toaster ovens, electromagnetic cooking apparatus, electric coffee machines, drying machines, dehumidifiers, electric carpets, electric hot plates, electric rice-cookers, electric hot thermo- pots, electric fans for air conditioning, electric fans for ventilating, electric stoves, kerosene stoves, hair dryers, electric fan heaters, kerosene fan heaters, oil heaters, air purifiers, water purifiers, electric lamps.

Class 14: Horological and chronometric instruments and apparatus, and parts and fittings therefor; time pieces; clocks and watches.

Class 16: Paper, cardboard and goods made from cardboard; printed matter; photographs; stationery; adhesives for stationery or household purposes; office requisites; instructional and teaching material; plastics materials for wrapping and packaging; bags for vacuum cleaners and for the disposal of dust; electronic typewriters; ink ribbons for computers, electronic typewriters and word processors; paper shredders.

Class 37: Repair services for electrical and electronic apparatus and instruments; repair, maintenance and cleaning of television and radio receiving apparatus and instruments, television transmitting and receiving apparatus for industrial use, sound recording and sound reproducing apparatus and instruments, tape recorders, tapes for recording sound and tapes containing pre-recorded sound, sound adaptors being parts of television and radio receiving apparatus and instruments, electronic calculating machines and electronic accounting machines, microwave ovens and bread toasters (electric).

Opposition ground: section 5(2)(a)

Date of application: 1 April 1996

Date of completion of registration procedure: 13 February 2007

(ii) International registration designating the European Union 929233



Class 1: Developers for copying machines; developers for facsimile machines; photographic supplies, namely, blueprint paper, photographic paper, photographic sensitizers, photographic dry plates, photographic developers, flash powder, photographic fixers, unexposed photographic films.

Class 2: Ink (toners); ink (toners) for photocopiers; ink (toners) for facsimile machines; ink (toners) for computer printers; toner cartridges; toner cartridges (filled) for photocopiers; toner cartridges (filled) for facsimile machines; toner cartridges (filled) for computer printers; pigments; ink cartridges (filled); ink cartridges (filled) for photocopiers; ink cartridges (filled) for facsimile machines; ink cartridges (filled) for computer printers; printing ink.

Class7: Ultrasonic machines for washing parts of semiconductor, namely, printed circuit boards, lead frame, relay contacts, experimental apparatus and implements and testing apparatus and implements; dishwashers; washing machines; vacuum cleaners; food processors (electric); garbage (waste) disposals; ultrasonic washing machines and their parts.

Class 9: Electronic cash registers; photographic machines and apparatus; cinematographic machines and apparatus; optical apparatus and instruments; image verification sensor, used in the inspection process; image positioning controllers; alphanumeric character verification apparatus, used in the inspection process; measuring or testing machines and instruments; power distribution or control machines and apparatus; alternating current adapters; switching power supplies; inverters used in the residential photovoltaic system; inverters (electricity); rotary converters; phase modifiers; batteries and cells; solar batteries; solar modules consisting of solar cells; combined modules for photovoltaic power generation, consisting of thin-film solar cells and light-emitting diodes; electric or magnetic meters and testers; wire, electric; cable, electric; coaxial cables; fiber optic cables; junction sleeves for electric cable; flat irons, electric; hair-curlers, electrically heated; buzzers; buzzers, electric; telecommunication machines and apparatus; portable telephones; portable telephones incorporating tuners for television broadcasting reception; portable telephones incorporating tuners for digital terrestrial television broadcasting reception; personal digital assistants incorporating portable telephones; telephones; low noise block down converters for satellite broadcasting reception; tuners for television broadcasting reception; tuners for digital terrestrial television broadcasting reception; tuners for digital cable television broadcasting reception; tuners for terrestrial television broadcasting reception; television apparatus; television receivers; liquid crystal display television apparatus; liquid crystal display television receivers; blu-ray disc recorders and/or players; digital video disk recorders and/or players; digital versatile disk recorders and/or players; mini disk recorders and/or players; compact disk recorders and/or players; videotape recorders and/or players; digital audio recorders and/or players; amplifiers; loudspeakers; component-type stereo including a mini disk recorders and/or players, a compact disk recorders and/or players, loudspeakers, a tuner, and an amplifier entirely or partially; sound recording apparatus and instruments; facsimile machines; video entry phones; intercoms; display modules; image sensors for camera modules; image sensors for camera modules for digital camera; image sensor for camera modules for camera phones; photo couplers; devices for infrared-ray communication; camcorders; sound reproduction apparatus; sound recording apparatus; electronic signboards consisting of light-emitting diodes; sound recording machines and apparatus; navigation apparatus for vehicles (on board computers); walkie-talkies; transceivers; computers; notebook computers; laptop computers; desktop computers; electronic desk calculators; pocket calculators; electronic calculators; camera modules for camcorders; camera modules for portable telephones; camera modules for digital still cameras; computer monitors; audiovisual monitors; liquid crystal display monitors; liquid crystal display modules; liquid crystal display panels; computer servers; personal computer servers; projectors; liquid crystal display projectors; rear projectors; personal digital assistants; electronic dictionaries; electronic dictionaries recorded on data media; computer software; computer software for controlling electronic copying machines in which a printer function, a scanner function, and a facsimile function are entirely or partially provided; computer software for translation; computer software for creating animation; computer software for browsing or editing video, images and sound; computer software for editing sound recorded in mini disks; computer software for saving documents in the electronic filing system; computer groupware for scheduling, managing documents, recording address and electronic mailing; laser pointers; printers for use with computers; bar-code printers; point-of-sales terminals; programmable controllers; integrated circuits; large scale integrated circuits; flash memories; laser diodes; semiconductor lasers; electronic copying machines; ink-jet copying machines; electronic copying machines in which a

printer function, a scanner function, and a facsimile function are entirely or partially provided; ink-jet copying machine in which a printer function, a scanner function, and a facsimile function are entirely or partially provided; facsimile machines in which a copying function, a printer function, and a scanner function are entirely or partially provided; consumer video games; electronic circuits and compact disk read-only-memories recorded programs for hand-held games with liquid crystal displays; electronic circuits and compact disk read-only-memories recorded automatic performance programs for electronic musical instruments; recorded video discs and video tapes; digital video disk data media (recorded); digital versatile disk data media (recorded); electronic publications (downloadable).

Class 11: Air-conditioning apparatus for commercial use; industrial air purifiers; microwave ovens for cooking; solar water heaters; lamps consisting of light-emitting diodes; lamps incorporating solar cells; street lamps; street lamps incorporating solar cells; electric refrigerators; electric freezers; cooking appliance consisting of a cook top having radiant electric heaters, a microwave oven and an electric oven; electrically heated carpets; electric blankets (for household purposes); hot plates (for household purposes); induction cooking heaters; crock pots having a function of electronic hot plates; electromagnetic induction cookers for household purposes; electric toaster ovens for household purposes; electric kettles for household purposes; electric rice-cookers for household purposes; humidifiers for household purposes; household tap-water filters; water purifiers for household purposes; air conditioners; air purifiers for household purposes; dehumidifiers for household purposes; ion conditioners for purifying air by emitting ion (for household purposes); dehumidifiers for commercial use; drinking water coolers; electric bathroom heating and drying apparatus for household purposes; cloth drying machines (electric, for household purposes); electric fan heaters; kerosene heaters; electric heaters; toilets stool units with washing water squirter; kerosene fan heaters; electrical ovens utilizing super heated steam and electric ovens with a function of a microwave oven utilizing super heated steam; electrical cooking appliance utilizing super heated steam and electric ovens with a function of a microwave oven utilizing super heated steam.

Class 16: Inking ribbons for facsimile machines; cassette type inking ribbons for facsimile machines; imaging film type inking ribbons for facsimile machines; inking ribbons for copying machines; cassette type inking ribbons for copying machines; inking ribbons for computer printers; cassette type inking ribbons for computer printers; inking ribbons; cassette type inking ribbons; paper for facsimile machines; thermal paper for facsimile machines; copier paper; paper and cardboard.

Class 19: Building glass incorporating light-emitting diodes and solar cells; building glass.

Opposition ground: section 5(2)(b)

Date of request for protection: 28 December 2006

Date of protection: 23 June 2008

6. The applicant denied the grounds in its counterstatement. Neither side filed evidence. The opponent filed written submissions. The parties were asked whether they wished for a decision to be taken following a hearing or on the basis of the papers filed. Neither side requested a hearing. I therefore make this decision from the papers on file.

## **Decision**

7. The opponent's word-only trade mark (CTM 124511) is identical to the applicant's mark. In relation to both sections 5(2)(a) and (b) of the Act, the

parties' goods and services are said by the opponent to be similar. The leading authorities which guide me in relation to section 5(2)(b) of the Act, and by extension also section 5(2)(a), are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

#### Comparison of goods and services

8. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU 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.”

As can be seen from the opponent’s submissions, detailed below, it considers that its goods and services are complementary to those of the applicant. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if 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...”

9. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

10. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“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.”

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] 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.”

12. A case management conference was held on 6 September 2012 (regarding a stay request) at which the opponent was directed to set out where it considered similarity to lie between the various goods and services of the parties. The opponent responded in a letter dated 11 October 2012, on a class by class basis.

13. *Charitable services, namely, business management and administration; charitable services, namely organising and conducting volunteer programs and community service projects.* (Class 35)

The opponent claims that the applicant’s *charitable services* in class 35 are similar to the opponent’s “printed matter” (CTM 124511), in particular printed business materials, and to the opponent’s “instructional and teaching material” (CTM 124511). The opponent submits that such materials could be used to explain, to publicise or to be used in conjunction with the charitable services of class 35 of the application. The applicant’s *charitable services* in class 35 are similar to the “electronic publications (downloadable)” and to “computer software” in the opponent’s international registration (“IR”) 929233. The opponent submits that its computer software could cover accounting, business, educational,

financial and marketing software, all of which are complementary to the applicant's class 35 services.

*Charitable fundraising services, charitable collections and charitable services, namely, financial services.* (Class 36)

The opponent claims that the applicant's *fundraising and financial services* in class 36 are similar to its "printed matter" (CTM 124511), in particular printed fundraising or financial materials. The services are also similar to the opponent's "instructional and teaching material" of CTM 124511. The opponent submits that such material could be used to explain, publicise or to be used in conjunction with the applicant's charitable fundraising and financial services. The opponent claims that the applicant's *charitable fundraising and financial services* are similar to the opponent's "electronic publications (downloadable) and to its "computer software" (IR 929233) because the latter term could cover accounting, financial and fundraising software, all of which are complementary to the class 36 services applied for.

*Temporary accommodation.* (Class 43)

The opponent claims that the applicant's services are similar to its "printed matter" (CTM 124511), in particular printed advertising and marketing materials, because such materials could be used to explain, to publicise or to be used in conjunction with temporary accommodation services. The opponent claims that its "computer software" would cover "reservations software" and "software for use in the temporary accommodation industry", both of which would be complementary to the class 43 services applied for.

*Medical services; medical clinics; health care; medical assistance; services of a psychologist; counselling relating to the treatment of medical ailments; medical counselling; psychological counselling; provision of nursing care; medical nursing services; residential medical treatment services; residential medical advice services; advisory services relating to addictions and rehabilitation treatments.* (Class 44)

The opponent claims that the applicant's medical, health and nursing services are similar to its class 10 goods (CTM 124511). The services are also similar to the "printed matter" of CTM124511, in particular printed medical, health or nursing materials which could be used to explain, to publicise or to be used in conjunction with the applicant's services. The opponent claims that the applicant's services are also similar to its "electronic publications (downloadable)" and to its "computer software" because the latter would cover medical, health or nursing software, all of which would be complementary to the class 44 services applied for.

14. With the exception of the opponent's claim that its class 10 goods are similar to the applicant's class 44 services, the opponent's claim that the goods and services are complementary and, therefore, similar follows a pattern, which is that:

- the opponent's printed matter and its instructional and teaching materials are similar to all the applicant's services because the opponent's goods could be used to explain, publicise or be used in conjunction with the applicant's services;
- the opponent's electronic publications (downloadable) are similar to the applicant's services (presumably on an analogous basis to its printed matter);
- the opponent's computer software could cover accounting software, business software, educational software, financial software, marketing software, fundraising software, reservations software, software for use in the temporary accommodation industry, and medical, health or nursing software.

15. The opponent's term *computer software* is unrestricted in scope. In *Galileo International Technology, LLC v European Union (formerly European Community)* [2011] EWHC 35 (Ch) Floyd J stated:

"39. The unrestricted specification is of enormously wide scope. The Hearing Officer wisely reminded himself of what Laddie J had said about wide specifications for computer software in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850. Laddie J considered that:

"... there is a strong argument that a registration of a mark simply for "computer software " will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls the computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained

under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act."

40. That was a case decided under the Trade Marks Act 1938, but, like Laddie J, I see no reason why the views there stated should not apply under the [1994] Act."

16. In *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03*, the General Court ("GC") stated:

"69 Next, the Court must reject the applicant's argument that all the goods and services covered by the Community trade mark application are linked, in one way or another, to 'computers' and 'computer programs' (Class 9) covered by the earlier trade mark. As the defendant rightly points out, in today's high-tech society, almost no electronic or digital equipment functions without the use of computers in one form or another. To acknowledge similarity in all cases in which the earlier right covers computers and where the goods or services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark. Such a position would lead to a situation in which the registration of computer hardware or software would in practice exclude subsequent registration of any type of electronic or digital process or service exploiting that hardware or software.

17. *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-316/07* concerned the comparison between the applicant for cancellation's goods and services in class 9 and 42, which were 'Computer software for the production of platform-independent internet shops and internet authoring systems chiefly for the reservation, booking and payment of accommodation'; and 'Development and design of computer software, namely for internet shops and internet authoring systems, especially for the reservation, booking and payment of accommodation', and the registered proprietor's services in classes 39 and 42, which were 'Information services relating to transportation services, including information services provided on-line from a computer database or the internet; travel reservation and travel booking services provided by means of the world wide web'; and 'Computerised hotel reservation services'. The Board of Appeal had agreed with the Cancellation Division at OHIM that the parties' goods and services were not similar and, therefore, despite the parties' signs being identical (EASYHOTEL), there was no likelihood of confusion. The applicant for cancellation appealed and the GC stated in its judgment:

"49 In addition, the Board of Appeal examined whether the goods and services concerned may be complementary. According to its findings,

complementarity had to be excluded in the present case since the public at large, for which the services covered by the mark at issue are intended, does not purchase the relevant goods and services covered by the earlier mark, which are exclusively intended for businesses which, subsequently, provide services to the public at large.

50 Finally, the Board of Appeal found, in the same context, that users of the internet who purchase travel services on-line are not likely to be aware of who provided the software that allows an internet shop to operate and are, in any event, able to distinguish between a company that provides sophisticated technology and another company that sells travel services via the internet.

51 Those findings must be upheld. They show, to the requisite legal standard, that the goods and services concerned differ in respect of their nature, intended purpose and method of use and are neither in competition with each other nor complementary. First of all, the relevant goods and services covered by the earlier trade mark are computer-related whereas the information, booking and reservation services covered by the mark at issue are different and use computer technology only to support the transmission of information or to make it possible to reserve hotel accommodation or travel.

52 Further, the relevant goods and services covered by the earlier trade mark are especially intended for businesses in the hotel and travel sector, and the information, booking and reservation services covered by the trade mark at issue are intended for the public at large.

53 In addition, the relevant goods and services covered by the earlier mark are used to enable a software system, and, more specifically, an internet shop, to function, whereas the information, booking and reservation services covered by the trade mark at issue are used to reserve hotel accommodation or travel.

54 The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

55 Computer goods and computer services are used in nearly all sectors. Often, the same goods or services – for example, a certain type of software or operating system – may be used for very different purposes, and that does not mean that they become different or distinct goods or

services. Conversely, travel agency services do not become something else – in terms of their nature, intended purpose or method of use – solely because they are provided via the internet, particularly since, nowadays, use of computer applications for the provision of such services is almost essential, even where those services are not provided by an internet shop.

56 Moreover, the goods and services concerned are not substitutable, since they are intended for different publics. Therefore, the Board of Appeal was right to find that those goods and services are not in competition with each other.

57 Finally, those same goods and services are also not complementary. It must be recalled in this respect that 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 consumers 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 (SISSI ROSSI)* [2005] ECR II-685, paragraph 60; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gómez Frías (euroMASTER)*, not published in the ECR, paragraph 35; and Case T-420/03 *El Corte Inglés v OHIM – Abril Sánchez and Ricote Saugar (Boomerang TV)* [2008] ECR I-0000, paragraph 98).

58 That case-law definition implies that complementary goods or services can be used together, which presupposes that they are intended for the same public. It follows that there can be no complementary connection between, on the one hand, the goods and services which are necessary for the running of a commercial undertaking and, on the other, the goods and services produced or supplied by that undertaking. Those two categories of goods or services are not used together since those in the first category are used by the relevant undertaking itself whilst those in the second are used by customers of that undertaking.

59 Although it accepts that the end users of the goods and services concerned are different, the applicant maintains that a likelihood of confusion cannot be ruled out in the present case since the relevant goods and services covered by the earlier mark have the sole purpose of making it possible to provide the information, booking and reservation services covered by the mark at issue. As a general rule, the public concerned by those services does not know who developed the necessary software and likewise cannot distinguish between the information on the intervener's website which comes from the intervener itself and that which derives from the software or services provided by an undertaking specialised in computing, such as the applicant. In short, on the intervener's website the

services covered by the mark at issue are indissociable from the relevant goods and services covered by the earlier mark.

60 That argument cannot be accepted. The commercial origin of the software and the computer services which enable the intervener's website to function is not generally of the slightest interest to the public for which the services covered by the mark at issue, which are supplied via that website, are intended. For that public, the intervener's website is a mere tool for the online reservation of travel and accommodation. What is of importance is that it functions well and not who provided the software and computer services which enable it to function.

61 If, however, some of the intervener's customers wonder about the commercial origin of the software and the software development and design services which are necessary for the functioning of the intervener's website, they are capable, as was correctly pointed out by the Board of Appeal, of making a distinction between the specialised undertaking which supplies those goods and services and the intervener which supplies services relating to the tourism and travel sector over the internet. Since the services covered by the mark at issue are, by definition, supplied exclusively over the internet, it must be assumed that the intervener's customers have at least some basic knowledge of computing. They are thus aware that an online reservation system cannot be set up by merely any computer user and that it requires software and software development and design services which are provided by a specialised undertaking.

62 The applicant's claim that the intervener's customers cannot distinguish information which comes from the intervener itself from that which derives from software and computer services of the kind covered by the earlier mark is likewise incorrect. The information likely to be of interest to the intervener's customers is that relating to travel arrangements, the availability of hotel accommodation and their prices. The provision of that information is precisely what constitutes the services covered by the mark at issue. The goods and services covered by the earlier mark serve only to convey that information and do not themselves transmit other separate information to the persons concerned."

18. Computer software is used in every part of modern life. This does not automatically make computer software similar to the services which use computer software to operate. If the average consumer for an undertaking is the general public, that average consumer is not likely to be interested in what software the undertaking uses and would not consider there to be a link between them. Whether there is complementarity depends on the facts of the case and the identity of the relevant public.

19. In relation to the applicant's services in class 43, *temporary accommodation*, there is an analogy with *Commercy*. The opponent's claim is one of complementarity in that its software could cover reservation software and software for use in the temporary accommodation industry. However, as in paragraph 52 of *Commercy*, the average consumers for the opponent's goods are the businesses providing temporary accommodation, whilst the average consumer for the service of providing temporary accommodation is the general public. By analogy with paragraph 58 of *Commercy*, there is no complementary relationship between the opponent's computer software and the applicant's service of providing temporary accommodation. **They are not similar.**

20. The applicant's services in class 35 are *charitable services, namely, business management and administration; charitable services, namely organising and conducting volunteer programs and community service projects*. The manner in which the specification has been worded means that the first half of the specification covers business management and administration of charities. These are business services aimed at supporting charities to run and organise themselves as businesses; they are not charitable services aimed at the intended recipients of the service or at potential donors to the charities. In comparing services with the opponent's notional claim to computer software for accounting, business, finance and marketing, there is a clear difference in nature (there is always a difference in nature between goods and services). There is some shared purpose in that the services are provided to a business (the charity) to enable it to function more efficiently and the software provides the practical tool. The users will be the business (charity) and the channel of trade may be shared in that the providers of the business management and administration services will provide the software, perhaps bespoke software, to achieve the aim. The users of both the service and the goods will be the same as will the trade channel. There is an element of complementarity. There is a **reasonable level of similarity** between the opponent's computer software and the applicant's *charitable services, namely, business management and administration*.

20. However, it is difficult to see any similarity with regard to the other class 35 services, *charitable services, namely organising and conducting volunteer programs and community service projects* and to the class 36 services, *charitable fundraising services, charitable collections and charitable services, namely, financial services*. These are services aimed at the community or general public. The public are the volunteers or the recipients of the community service projects and the recipients of or donors to the charity. The opponent's goods are for use by the charity which, subsequently, provides its service to the general public. Therefore, the opponent's claim that the various types of notional software functions are complementary to the applicant's services falls down on the *Commercy* principle: the two sets of average consumer are entirely different. The general public will not be interested in where the software which the charity uses comes from (paragraph 60, *Commercy*). There is not a complementary relationship. The opponent's computer software and the applicant's services

*charitable services, namely organising and conducting volunteer programs and community service projects, charitable fundraising services, charitable collections and charitable services, namely, financial services are not similar.*

21. The opponent's claim to complementarity between the applicant's class 44 services and its notional claim to coverage for medical, health or nursing software also suffers from the same lack of consumer overlap. The applicant's services are used by patients. The opponent's services will be used by healthcare professionals. The goods and services are not intended for the same public, therefore the average consumers of one will not expect that the responsibility lies with the same undertaking. The opponent's computer software and the applicant's services in class 44 are **not similar**.

22. The opponent claims that the applicant's services are complementary to its printed matter, instructional and teaching material, and electronic publications (downloadable). All businesses use printed matter and the like in relation to goods and services. The argument of the opponent is akin to those which have been considered by the GC (set out above), and rejected, in relation to the similarity of computer goods and services that may use such goods. The opponent is conflating the potential content of the goods with the services of the application rather than considering the goods against the services. It is necessary to compare the nature of the product in class 16 with the services of the applicant; otherwise, on the logic of the opponent, it has infringement rights in all goods and services as all goods and services will be liable to use printed matter eg in relation to arc welding apparatus, screws or nails. In the terms of *Boston Scientific Ltd v OHIM*, considering the actual goods and services, and not the potential contents of the goods, there is not 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 respective goods and services lies with the same undertaking. In none of the services of the application would the use of printed matter in relation to them indicate a trade in those services, it would be indicative of the services and of the services alone and so the average consumer would not be led to believe that the responsibility for the respective goods and services lies with the same undertakings.

23. The last category to compare is the opponent's class 10 goods, *medical and surgical apparatus and instruments; electronic clinical thermometers, electronic blood pressure monitors; but not including surgical cutting instruments or needles* and the applicant's class 44 services, *medical services; medical clinics; health care; medical assistance; services of a psychologist; counselling relating to the treatment of medical ailments; medical counselling; psychological counselling; provision of nursing care; medical nursing services; residential medical treatment services; residential medical advice services; advisory services relating to addictions and rehabilitation treatments*. Some of these services are in the nature of counselling or advice and it is difficult to envisage that these services will require the use of medical and surgical apparatus. In relation to *services of a*

*psychologist; counselling relating to the treatment of medical ailments; medical counselling; psychological counselling; residential medical advice services; advisory services relating to addictions and rehabilitation treatments*, there is no shared nature and no shared purpose with the class 10 goods. The users will differ, as the users of the class 10 goods will be the healthcare professional and the users of the services will be the general public (and addicts and their carers). The goods are not in competition with the services (the one will not suffice as a substitute for the other).

24. The users of the other services, *medical services; medical clinics; health care; medical assistance; provision of nursing care; medical nursing services; residential medical treatment services*, is the general public. The users of the opponent's *medical and surgical apparatus and instruments; electronic clinical thermometers, electronic blood pressure monitors* will be the healthcare professional, but some goods may be for domestic use, such as blood pressure monitors and thermometers. So some goods may be for use by the general public and they may be obtained via attendance at a clinic of some description; in this way, there may be a coincidence of trade channel between the service and the goods. There may also be an element of competition in that self-treatment is an alternative to the use of the medical service. There is a **reasonable similarity** between the applicant's *medical services; medical clinics; health care; medical assistance; provision of nursing care; medical nursing services; residential medical treatment services* and the opponent's *medical and surgical apparatus and instruments; electronic clinical thermometers, electronic blood pressure monitors; but not including surgical cutting instruments or needles*.

#### Average consumer and the purchasing process

25. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. I have made some observations about the identity of the average consumer during the comparison of goods and services, above. In some instances, the average consumer will be business or healthcare professionals (such as in the Class 35 and part of the Class 44 comparisons); in others it will be the general public (as in the case of the class 36 and 43 comparisons). The purchasing process for the parties' goods and services is likely to be predominantly visual, but for some of the applicant's services, such as charitable collecting and counselling services, there is likely also to be an aural dimension, such as recommendation or referral. The average consumer will pay a greater degree of attention, for example, to the purchase of the opponent's class 10 goods than to its class 16 goods. In the case of the applicant's services, the level of attention will vary depending on the service; for example, a reasonable amount of attention will be paid to donating to a charity or choosing temporary accommodation, but a great degree of attention will be paid to rehabilitation advice for addictions.

## Comparison of trade marks

26. The marks to be compared are:

Opponent's marks	Applicant's mark
<p>(i) SHARP</p> <p>(ii)</p> 	<p>SHARP</p>

27. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. The opponent's word-only mark is identical to the applicant's mark. Although the opponent's composite mark has a clear background element to it, the eye is immediately drawn to the prominent word SHARP. This word is the dominant and distinctive element. It is a well-known English word, the meaning of which varies according to context (e.g. a sharp knife, a sharp tongue, a sharp mind, a sharp-tasting drink). In the case of the opponent's word-only mark, there is visual, aural and conceptual similarity with the application. In the case of the opponent's composite mark, there is a high degree of visual similarity with the application, and identical aural and conceptual similarity. The composite trade mark is highly similar to the trade mark of the applicant.

### Distinctiveness of the earlier mark

28. It is necessary to consider the distinctive character of the opponent's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion<sup>3</sup>. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant

<sup>3</sup> *Sabel BV v Puma AG* [1998] RPC 199.

public<sup>4</sup>. The opponent has not filed any evidence that it has used its marks, so I have only the inherent position to consider. For the goods to which the opponent refined its case, in its letter of 11 October 2011, it is not obvious how SHARP could be descriptive of printed matter, computer software or medical apparatus and instruments, all such 'sharp' medical instruments having been excluded from the scope of protection (i.e. surgical cutting instruments and needles). SHARP has a good level of distinctiveness.

#### Likelihood of confusion

29. One of the factors to consider in the global appreciation is the weight which I should attach to the type of purchasing process because sometimes the characteristics of the purchasing process for some goods and services are more aural than visual. In the current case, however, it does not impact greatly because for one of the earlier marks, there is identity both visually and aurally, and for the other there is identical aural similarity and also a high degree of visual similarity. As the trade marks are identical or highly similar, the nature of the purchasing process and the purchaser will not have an effect upon the outcome as there is nothing, or effectively nothing, with which to distinguish the marks.

30. The aforementioned high degree of similarity/identity between the marks feeds into the principle of interdependency, whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). However, where there is no similarity between the goods and services, neither identity between the marks nor a good degree of distinctive character in its earlier marks will help the opponent's case. The CJEU said in *Waterford Wedgwood plc v OHIM* Case C-398/07:

“35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

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<sup>4</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

31. Consequently, the opposition **fails** in respect of the following services in the application:

Class 35: *charitable services, namely organising and conducting volunteer programs and community service projects.*

Class 36: *Charitable fundraising services, charitable collections and charitable services, namely, financial services.*

Class 43: *Temporary accommodation.*

Class 44: *Services of a psychologist; counselling relating to the treatment of medical ailments; medical counselling; psychological counselling; residential medical advice services; advisory services relating to addictions and rehabilitation treatments.*

32. In the case of the applicant's remaining class 44 services, they are reasonably similar to the opponent's goods registered under its identical mark, a mark which has a good level of inherent distinctive character. There is a likelihood of confusion in respect of the applicant's *medical services; medical clinics; health care; medical assistance; provision of nursing care; medical nursing services; residential medical treatment services.*

33. In respect of the applicant's remaining class 35 services, they are reasonably similar to the opponent's goods protected by its mark which is highly similar visually, and conceptually and aurally identical. The only visual difference between the marks is a relatively simple dark background. The difference will not be enough to avoid a likelihood of confusion. Even if the average consumer notices the presence of the background, they are likely to conclude that it is a variation on the word-only mark and belongs to the same undertaking. There is a likelihood of confusion in respect of the applicant's *charitable services, namely, business management and administration.*

## **Outcome**

**34. The opposition succeeds in respect of:**

Class 35: *Charitable services, namely, business management and administration.*

Class 44: *Medical services; medical clinics; health care; medical assistance; provision of nursing care; medical nursing services; residential medical treatment services.*

**The application is therefore refused for the above services.**

**35. The opposition fails in respect of the following services, for which the application will be registered:**

Class 35: *Charitable services, namely organising and conducting volunteer programs and community service projects.*

Class 36: *Charitable fundraising services, charitable collections and charitable services, namely, financial services.*

Class 43: *Temporary accommodation.*

Class 44: *Services of a psychologist; counselling relating to the treatment of medical ailments; medical counselling; psychological counselling; residential medical advice services; advisory services relating to addictions and rehabilitation treatments.*

**Costs**

36. Both sides have achieved a measure of success, but the applicant has had the greater share of success. The ratio is about 2:1. I will make an award to the applicant to reflect its greater level of success. The applicant did not file any evidence or written submissions. If wholly successful, it would have received £500 costs, as follows:

Considering the opposition and preparing the counterstatement	£300
Considering the opponent's submissions filed as a result of the case management conference	£200

Offsetting this amount by a third, the applicant is entitled to **£333**.

37. I order Sharp Kabushiki Kaisha (Sharp Corporation) to pay Action on Addiction the sum of £333. 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 30th day of April 2013**

**Judi Pike  
For the Registrar,  
the Comptroller-General**