

O/209/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003368811

BY KENNETH MCGAHEY

TO REGISTER THE TRADE MARK:



IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 416166 BY

TECHNISUB SPA

BACKGROUND AND PLEADINGS

1. On 21 January 2019, Kenneth Mcgahey (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 1 February 2019 and registration is sought for the following goods:

Class 9 Scuba diving weight belts consisting of breathable piece goods made of textile materials bonded with rubber.

2. On 30 April 2019, Technisub SpA (“the opponent”) opposed the application based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UK registration no. 2185101 for the trade mark **SEAL**. The opponent’s trade mark was filed on 23 December 1998 and registered on 12 November 1999. The opponent relies upon all of the goods for which the earlier mark is registered, namely:

Class 9 Masks and goggles for diving and for underwater activity.

3. The opponent claims that there is a likelihood of confusion because the trade marks are similar, and the goods are similar.

4. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of its earlier mark.

5. The opponent is represented by Gunnercooke LLP and the applicant is unrepresented. The opponent filed evidence in the form of the witness statement of Rosemary Burbidge, which was accompanied by written submissions. The applicant filed written submissions during the evidence rounds. The opponent did not file evidence in reply. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

6. As noted above, the opponent filed evidence in the form of the witness statement of Rosemary Burbidge, which is dated 16 October 2019. I understand that Ms Burbidge is the opponent's representative in these proceedings.

7. Ms Burbidge has provided a print out from Amazon (which is undated) displaying a pair of swimming goggles which are described as 'Aqua Sphere Unisex Adult Seal 2.0 Swimming Mask', available for sale for £17.95.¹ The product description states: "Created with vision and comfort in mind, the Seal 20 swim goggles feature a leak-free fit and are made with lightweight smoke Plexisol lenses and an easily adjustable side buckle". A further description is also provided which states:

"The seal 2.0 is a direct descendent of the original swimming mask, the seal, and is the perfect swim mask for fitness swimmers. Provided its large format wrap-around lens design, the seal offers the widest field of vision of any goggle in the market [...]"²

8. The product listing information describes the 'style' as 'Seal 2.0' and the 'brand name' as 'Aqua Sphere'.³ It also confirms that the date the product was first available was 13 February 2013 and that it is ranked as #58 in the 'Amazon Bestsellers Rank' for Swimming Goggles.

9. The print out provided by Ms Burbidge states that there are 332 reviews of the product, however, only 8 of these are visible.⁴ The earliest of these dates back to March 2016.

10. Ms Burbidge has provided a variety of print outs from online retailers who also sell the opponent's goods, but these are all undated. Ms Burbidge has also provided a

¹ Exhibit RJB1, page 3

² Exhibit RJB1, page 6

³ Exhibit RJB1, pages 5 and 6

⁴ Exhibit RJB1, pages 8 to 10

print out from the opponent's website - aquasphereswim.com/uk - which shows the Seal 2.0 mask.⁵ This page bears a copyright date of 2013.

11. As noted above, both parties filed written submissions during the evidence rounds. Whilst I do not propose to summarise those here, I have taken them into consideration and will refer to them below where necessary.

DECISION

12. Section 5(2)(b) of the Act states as follows:

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

(a)...

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

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

13. Section 5A of the Act states:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. By virtue of its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade marks pursuant to section 6 of the Act.

⁵ Exhibit RJB1, page 31

Proof of use

15. As noted above, the applicant has put the opponent to proof of use of its mark. The relevant statutory provisions are as follows:

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

6A-(1) This section applies where –

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form of which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the 5-year period ending with the date of the application in issue i.e. 22 January 2014 to 21 January 2019.

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV*

[2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*
[2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure

customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the Mark

20. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use

made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

21. The opponent uses the sign 'Seal 2.0' throughout its evidence. The addition of the numbers 2.0 to the word SEAL does not, in my view, prevent this from being an acceptable variant of the mark as registered. The addition of the numbers will be viewed by the average consumer as the model number. As used, the mark appears in title case, whereas as registered it is presented in capitals. However, registration of a word only mark covers use of that word in any standard typeface or font. Consequently, as per *Colloseum*, I consider this to be an acceptable variant upon which the opponent can rely.

22. In his written submissions, the applicant has stated that the opponent's evidence of use refers to the trade mark Aqua Sphere and use of the trade mark SEAL as part of, what he calls a reference to either 'the strength of the seal or thickness of the glass'. For the avoidance of doubt, I do not consider the fact that the mark has been used alongside another trade mark (i.e. Aqua Sphere) to impact upon my finding. It is not uncommon for a house brand to be used alongside sub-brands for particular products. It appears to me, that that is the case here. Further, I do not consider the use of the word 'seal' in this context to be a reference to the seal or strength of the glass used in the goggles/masks. In my view, the way in which the word 'seal' has been used in the

opponent's evidence is clearly trade mark use and not descriptive. I do not, therefore, consider these arguments to assist the applicant.

Sufficient Use

23. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁶

24. There are clearly issues with the opponent's evidence. The opponent has not provided any information about the revenue generated under the mark or the number of units sold during the relevant period. However, it is clear from the opponent's evidence that its product has been on sale since at least 13 February 2013. Clearly, there have been at least 332 sales through Amazon, because the site confirms that there have been 332 reviews. At a sale price of £17.95 this amounts to total sales of over £5,000. The product went on sale before the relevant period and the page is undated so that figure is likely to be accurate to a date after the relevant period. The sales made by the opponent through Amazon are further evidenced by the fact that the product is ranked in the Best Sellers list. However, at least a proportion of these sales would have taken place within the relevant period. Further, the copyright date on the opponent's website is 2013, showing that the product has been available throughout the relevant period. Taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated genuine use of the earlier mark during the relevant period.

Fair Specification

25. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon.

26. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

⁶ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

27. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular

goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

28. The products sold by the opponent are described as both masks and goggles interchangeably in the evidence. It also seems to me, that they could be used for both diving and other underwater activities (such as snorkeling). Consequently, I consider that the opponent has shown genuine use of all of the goods upon which it relies.

Section 5(2)(b) – case law

29. The following principles are gleaned from the decisions of the EU courts 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:

(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 greater 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 to mind the earlier mark, 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

30. In light of my finding above, the competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 9</u> Masks and goggles for diving and for underwater activity.	<u>Class 9</u> Scuba diving weight belts consisting of breathable piece goods made of textile materials bonded with rubber.

31. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are 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;

(f) 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.

32. In its Notice of opposition, the opponent states:

“The goods are also highly similar. “Masks and goggles for diving and underwater activity” are the same type of product, namely specialist diving equipment, to “Scuba diving weight belts consisting of breathable piece goods made of textile materials bonded with rubber”. In addition to being the same type of specialist product, the goods are sold: 1) in the same locations, namely specialist stores (whether it be physical or virtual); in the same location within larger sports outlets; using similar search terms such as ‘diving equipment’ or ‘diving kit’; to the same customers, namely persons interested in diving equipment; and at similar price points.”

33. In his counterstatement, the applicant states as follows:

“I deny that the goods are identical or similar to their mark on the following grounds

- a) The oppression [sic] allegedly markets diving masks using their mark, could be for swimming or diving
- b) We do not market ‘diving masks’ we market weight belts for Scuba Diving and our mark represents that by the company who Markets them.”

34. The specific uses of the goods clearly differ. The opponent’s goods are used to keep water out of the user’s eyes whilst in the water, whereas the applicant’s goods are used to enable the user to sink beneath the surface of the water easily whilst diving. However, they can both be used for the same general purpose of enabling a user to dive underwater. They overlap in user because they can both be purchased by people interested in scuba diving (albeit the opponent’s goods could also be purchased and used for other water-based activities). The goods overlap in trade channels, as both could be sold by specialist diving retailers or in more general

sporting outlets. Where they are sold in more generalised outlets, they are likely to be sold in the same section i.e. the area selling diving or swimming-related goods. The physical nature and method of use of the goods will clearly differ. Taking this all into account, I consider the goods to be similar to a medium degree.

The average consumer and the nature of the purchasing act

35. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

36. The average consumer for the goods will be a member of the general public with an interest in swimming or diving activities or a professional (such as a diving instructor or tour operator). The cost of the purchase is likely to be relatively low, although the purchase is unlikely to be a particularly frequent one. Notwithstanding the relatively low cost of the goods, the average consumer will take various factors into account such as ease of use, quality of the materials used in the products and suitability for the user's particular purpose. Consequently, I consider that a medium degree of attention will be paid during the purchasing process. In the case of goods purchased for scuba diving, a slightly higher degree of attention may be paid given the need to ensure the user's safety whilst under water.

37. The goods are likely to be purchased either from specialist diving/swimming equipment retailers or from more general sports stores, or their online or catalogue equivalents. The purchasing process is, therefore, likely to be predominantly visual. However, as advice may be sought from sales assistants, I do not discount that there will also be an aural component to the purchase of the goods.

Comparison of trade marks

38. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

39. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

40. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
SEAL	

41. The applicant's mark consists of the word SEAL, with the horizontal line on the 'E' and 'A' presented as one curving blue line, followed by the words 'Supplies Ltd'. In the background, is a device, the subject of which is not entirely clear, but which may be viewed as an image of the marine mammal. Given its size, I consider the word SEAL to play the greater role in the overall impression of the mark, with the stylisation, device and words 'Supplies Ltd' playing a lesser role. The opponent's mark consists of the word SEAL. There are no other elements to contribute to the overall impression which lies in the word itself.

42. I have no substantive submissions from the applicant on the similarity of the marks. However, I note that in its written submissions, the opponent stated as follows:

"Visually, the signs are highly similar due to the dominant feature, namely the word 'SEAL'. This is identical to the Earlier Mark. The figurative aspect is unclear but appears to be a drawing of the marine animal. This reinforces the dominance of the English word SEAL. The words "supplies ltd" are in a tiny font size and add little visually. [...]"

Aurally, the signs are identical. Both consist of the English word 'SEAL' this would be pronounced the same way by consumers. The word 'Supplied ltd' are in a different font and hard to read so are unlikely to be pronounced by a consumer.

Conceptually, the signs are identical. The word SEAL has at least two meanings, the first is to make something watertight and the other is the marine animal. The Earlier Mark can have either meaning. the Application includes what appears to be a picture of the marine animal. There is therefore conceptual identity with the Earlier Mark. The words "Supplies Ltd" are descriptive and do not add anything conceptually to the sign."

43. Visually, the marks coincide, as stated by the opponent, in the presence of the word SEAL. I recognise that the horizontal elements of the letter 'E' and 'A' in the application are formed by a blue curving line, but I do not consider that this will prevent the average consumer from recognising it as the word 'seal'. The marks differ in the addition of the device in the applicant's mark, as well as the words 'Supplies Ltd' which have no counterpart in the opponent's mark. Consequently, I consider the marks to be visually similar to a medium degree.

44. Aurally, the word SEAL will be pronounced identically in both marks. I recognise that the words 'Supplies Ltd' in the applicant's mark are presented in a smaller font, but I see no reason to conclude that they would not be pronounced at all. Consequently, I consider the marks to be aurally similar to between a medium and high degree.

45. Conceptually, I agree with the opponent that the word 'seal' may be recognised as a reference to the marine mammal. The opponent also makes reference to the meaning of the word 'seal' as 'to make something watertight'. To my mind, seals are not just used in making something watertight, but are used more broadly in ensuring that something is securely closed. For example, a seal may be used to ensure that something is airtight. It may also be viewed as a verb i.e. the process of sealing something (such as 'to seal an envelope'). If the device in the applicant's mark is recognised as the marine mammal then it is likely to be this meaning that is attributed to the applicant's mark. If the device is not recognised as the marine mammal then any of the other meanings of the word 'seal' may be identified by the average consumer. The word 'supplies' in the applicant's mark will be viewed as a reference to the fact that the undertaking provides supplies for something and the letters 'Ltd' will be viewed as being a reference to the fact that the undertaking is a limited company.

Taking all of this into account, I consider the marks to be conceptually similar to between a medium and high degree.

Distinctive character of the earlier trade mark

46. 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-2779, 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).”

47. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

48. The opponent has not pleaded that its mark has acquired enhanced distinctive character. In any event, I do not consider that use on the scale shown by the opponent to be sufficient to establish that its mark has acquired enhanced distinctive character through use. I have, therefore, only the inherent position to consider. The word SEAL is likely to be recognised either as a reference to a marine mammal or to the act of closing something securely (or a product that facilitates the secure closing of something else). In the context of goggles or masks for use in the water, the latter meaning will be allusive and may be seen as indicating a product with a secure fit. In the case of the marine mammal, it may be seen as alluding to something that enables you to move effectively underwater. I consider that the opponent's mark to be inherently distinctive to between a low and medium degree.

Likelihood of confusion

49. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

50. I have found the marks to be visually similar to a medium degree and aurally and conceptually similar to between a medium and high degree. I have found the earlier mark to be inherently distinctive to between a low and medium degree. I have identified the average consumer to be a member of the general public with an interest in diving/swimming activities or a professional user (such as a diving instructor or tour

operator). I have concluded that a medium degree of attention will generally be paid during the purchasing process, but that a higher degree of attention may be paid for the goods used in diving where the safety of the user underwater will be a key consideration. I have found the purchasing process to be predominantly visual, although I do not discount an aural component. I have found the parties goods to be similar to a medium degree.

51. Taking all of these factors into account, I consider that the differences between the marks, particularly the visual differences between them, will be sufficient to avoid the marks being mistakenly recalled or misremembered as each other. This will particularly be the case given that at least a medium degree of attention will be paid during the purchasing process. I do not consider that the presence of the device will be overlooked or forgotten by the average consumer. I do not, therefore, consider there to be a likelihood of direct confusion.

52. However, I do consider that the common word SEAL in both marks will lead the average consumer to conclude that the goods at issue originate from the same or economically linked undertakings. The presence of the device in the applicant's mark, the slight stylisation on the 'A' and 'E' as well as the additional words 'Supplies Ltd' are likely to be viewed as an alternative mark being used by the same business. I consider this to be the case notwithstanding the fact that the earlier mark has only a low to medium degree of inherent distinctive character. Consequently, I consider there to be a likelihood of indirect confusion.

CONCLUSION

53. The opposition is successful, and the application is refused.

COSTS

54. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£900** as a contribution towards its costs. This sum is calculated as follows:

Preparing a Notice of opposition and considering the applicant's counterstatement	£200
Filing evidence and written submissions	£600
Official fee	£100
Total	£900

55. I therefore order Kenneth MCGahey to pay Technisub SpA the sum of £900. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 2nd day of April 2020

S WILSON
For the Registrar