

O-219-20

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No.3380121
BY WASP PRODUCTS LIMITED
TO REGISTER IN CLASSES 13 & 28
THE TRADE MARK**



**AND
IN THE MATTER OF OPPOSITION THERETO
UNDER No. 416706
BY
WASPS HOLDINGS LIMITED**

BACKGROUND

1) On 4 March 2019, WASP Products Limited (hereinafter the applicant) applied to register the trade mark shown on the page above in respect of the following goods:

In Class 13: Slingshots [weapons].

In Class 28: Slingshots; Slingshots [sporting articles]; Slingshots [sports articles].

2) The application was examined and accepted, and subsequently published for opposition purposes on 22 March 2019 in Trade Marks Journal No. 2019/012.

3) On 21 June 2019 Wasps Holdings Limited (hereinafter the opponent) filed a notice of opposition. The opponent in these proceedings is the proprietor of the following trade mark:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
 A series of two marks	3057596	29.05.14 24.10.14	18	Leather and imitations of leather; pouches;
			28	Games and playthings; gymnastic and sporting articles; toys; sports equipment; toy pistols;
			41	Education; sporting activities; sports coaching services; sports tuition and instruction.

- a) The opponent contends that the marks of the two parties are very similar and that the goods applied for are identical and/or similar to the goods and services for which the earlier mark is registered. As such the mark in suit offends against Section 5(2)(b) of the Act.

4) On 12 September 2019 the applicant filed a counterstatement basically denying all the grounds of opposition.

5) Neither side filed evidence; both sides seek an award of costs in their favour. Neither side wished to be heard and only the opponent provided submissions which I shall refer to as and when necessary.

DECISION

6) The only ground of opposition is under section 5(2)(b) which reads:

“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.”

7) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

8) The opponent is relying upon its trade mark shown in paragraph 3 above which is clearly an earlier trade mark. The mark in suit was filed on 4 March 2019 at which point the opponent’s mark had not been registered for over five years. Therefore, the proof of use requirements do not bite.

9) When considering the issue under section 5(2)(b) I take into account the following principles which 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 great degree of similarity between the marks, and vice versa;

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

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

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

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

The average consumer and the nature of the purchasing decision

10) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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.”

11) The goods at issue in these proceedings are slingshots. The average consumer for such goods will be the public at large including children. Such items may be sold through a range of channels, including retail premises such as fishing and hunting shops as well as toy shops (where the goods are normally displayed on shelves and are obtained by self-selection) and on the internet or via catalogues and print media. The selection process will be primarily a visual one, although as discussions may take place with staff and one might receive a recommendation, aural considerations

must also be taken into account. These goods are not particularly expensive and to my mind the consumer will pay no more than an **average level of attention to the selection of such goods.**

Comparison of goods

12) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

(a) The respective 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.

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

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

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

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

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

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

17) As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

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

18) For ease of reference the goods of the two parties are:

Applicant's goods	Opponent's goods
Class 13: Slingshots [weapons]. Class 28: Slingshots; Slingshots [sporting articles]; Slingshots [sports articles].	Class 18: Leather and imitations of leather; pouches; Class 28: Games and playthings; gymnastic and sporting articles; toys; sports equipment; toy pistols; Class 41: Education; sporting activities; sports coaching services; sports tuition and instruction.

19) In making this comparison I note that if the similarity between the goods/services is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the GC pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

20) Thus, where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar.

21) Slingshots are used, broadly speaking, by hunters of small game, fishermen trying to get bait into a specific area, and adults and children for fun. Such items used to be called catapults and were almost de-rigueur for any self-respecting young boy, unfortunately in the current nanny state such things are increasingly restricted. Clearly, the applicant's class 28 specification is entirely encompassed by the terms "play things; sporting articles; toys; sports equipment;" in the opponent's specification. **The class 28 specifications of both parties must therefore be regarded as identical. It also means that the applicant's class 13 specification must be regarded as highly similar to the opponent's class 28 specification.**

22) For the sake of completeness, I will continue to compare the opponent's other goods and services to the goods applied for by the applicant. The opponent has not provided any submissions as to why its class 18 goods would be regarded as similar to a slingshot. One can only assumed that slingshots might have a piece of leather as the shot-holder or be stored in a pouch. I find this unconvincing and regard the opponent's goods in class 18 as not similar to the goods applied for by the applicant. The provision of sporting activities in class 41 might involve the use of equipment, but even if one saw the name of the provider on such equipment the average consumer would assume it was merely a security marking indicating ownership not origin. In the absence of submissions to the contrary I regard the opponent's services in class 41 to be not similar to the goods applied for by the applicant.

Comparison of trade marks

23) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, 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."

24) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The opponent's mark consists of a series of two marks which are identical save for the fact that one is in black and white and the other in colour. The marks are therefore effectively identical and I shall make the comparison with only one of the marks. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
	

25) I note that in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU found that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and

industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51”).

26) Given that all of the goods applied to be registered by the applicant are slingshots, the word “slingshots” in the applicant’s mark will be seen as entirely descriptive. This does not mean that its presence should be ignored but merely that it is not significant. The distinctive and dominant aspect of the applicant’s mark is the word WASP which appears at the top of the mark and in a significantly larger font. The device element of the circle with a yellow background and black border will be noticed but given little significance by the average consumer as it is not particularly distinctive, but merely serves to emphasise the word WASP by the use of colours associated with the insect. The opponent’s mark consists of a large image of a wasp in a yellow elliptical device. The device will in my opinion be seen as merely decorative, perhaps evocative of a non-descript flower. Those who are aware of the connection to rugby may see the device as an allusion to a rugby ball. However, the device is not obviously a rugby ball as it lacks the seams and laces typically associated with a rugby ball. The device is the largest element of the opponent’s mark but merely serves to emphasise the word underneath WASPS. There are visual differences and similarities between the marks but, overall they are visually similar to at least a medium degree. Aurally the only element that will be verbalised are the words WASP and WASPS, these are clearly similar to a high degree. Conceptually the marks are virtually identical only differing in that the applicant’s mark suggests a singular wasp whereas the opponent’s mark conjures an image of more than one of the annoying pests. **Overall the marks have a medium to high degree of similarity.**

Distinctive character of the earlier trade mark

27) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

28) The opponent’s mark consists of a device element and the words WASPS which has no meaning in respect of the goods at issue in the instant case. To my mind, **it has an average degree of inherent distinctiveness**. The opponent has not provided any evidence of use of its mark, as such **the opponent cannot benefit from an enhanced degree of distinctiveness through use in relation to the goods and services for which it is registered.**

Likelihood of confusion

29) In determining whether there is a likelihood of confusion, 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 also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods is a member of the general public who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay no more than an average degree of attention to the selection of the goods in question.
- the marks of the two parties have a medium to high degree of similarity.

- the opponent's mark has an average degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the goods of the two parties in class 28 are identical. The applicant's goods in class 13 are highly similar to the opponent's class 28 goods.

30) In view of all of the above, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being directly confused into believing that the goods in classes 13 and 28 applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in respect of all the goods in classes 13 and 28.**

CONCLUSION

31) The opposition under section 5(2)(b) is completely successful and so the application is completely rejected.

COSTS

32) The opponent has succeeded in full and is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£200
Expenses	£200
TOTAL	£400

33) I order Wasp Products Limited to pay Wasps Holdings Limited the sum of £400. This sum to be paid within twenty- one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of April 2020

George W Salthouse
For the Registrar,
the Comptroller-General