

O-276-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2132914
BY WHEELS IN MOTION (INNOVATIONS) LIMITED
TO REGISTER THE TRADE MARK:**



IN CLASSES 9 AND 16

AND

**THE OPPOSITION THERETO
UNDER NO 48564
BY
FASHION BOX SPA**

Trade Marks Act 1994

**In the matter of application no 2132914
by Wheels in Motion (Innovations) Limited
to register the trade mark:**



**in classes 9 and 16
and the opposition thereto
under no 48564
by Fashion Box SpA**

BACKGROUND

1) On 19 May 1997 Wheels in Motion (Innovations) Limited, which I will refer to as Wheels, applied to register the above trade mark (the trade mark). The trade mark was filed in colour but it is not limited to colour. The application was published for opposition purposes in the "Trade Marks Journal" on 18 February 1998 with the following specification of goods:

encoded cards displaying moving images; encoded telephone payment cards and encoded identity cards, all bearing moving images; but not including any of the aforesaid encoded cards for use in recording information;

greeting cards; collectible cards; photographs; plastics cards bearing images; identity cards.

The above goods are in classes 9 and 16 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 18 May 1998 Fashion Box SpA, which I will refer to as Fashion, filed a notice of opposition to the application. Fashion is the owner of the following Community trade mark registration:

Number:	Trade mark:	Date of application:	Specification:
520080	REPLAY	18/04/1997	Bleaching preparations and other substances for laundry use;

priority claim from Italy of 29/10/1996 cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Spectacles; life-saving apparatus and instruments; automatic vending machines and mechanisms for coin-operated apparatus; fire-extinguishing apparatus.

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Magazines, newspapers, periodicals, printed publications; paper, cardboard, articles of paper; office requisites except magazines and periodicals relating to crosswords and puzzles, writing and drawing implements and all related articles.

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Textiles and textile goods, not included in other classes; bed and table covers.

Clothing, footwear, headgear.

Gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Advertising; business management;

business administration; office functions; shop window dressing.

Transfer of know-how and licensing, consultancy relating to the installation and setting up of shops, exterior and interior design and furnishing of shops and related signs (except shop window dressing), cafeterias, cafés, catering, cocktail lounges, snack-bars, refreshments, restaurants, self-service restaurants, providing of food and drink.

The above goods and services are in classes 3, 9, 14, 16, 18, 24, 25, 28, 35 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. Fashion claims that the above trade marks are similar to the trade mark of Wheels and that “at least” some of the respective goods are identical or similar. Consequently, there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Fashion seeks the refusal of the application and an award of costs.

4) Wheels filed a counterstatement. It seeks the dismissal of the opposition and an award of costs. Wheels states that it “makes claim to prior use of the trade mark INSTANT REPLAY”.

5) Only Fashion filed evidence.

6) Correspondence sent to Wheels has been returned on the basis that the addressee has gone away. In the absence of a current address the Trade Marks Registry has continued to send copies of all correspondence to the last known address of Wheels.

7) The ownership of the earlier trade mark has changed during the proceedings and, consequently, so has the opponent. However, the name of the opponent is the same. The current Fashion is a different legal entity to the original Fashion, although having the same name.

8) Fashion originally requested a hearing, however, subsequently it decided that it wanted a decision made from the papers. Wheels has made no indication as to its wishes. Consequently, this decision has been made from the papers. No written submissions have been received.

EVIDENCE OF FASHION

Statutory declaration of Attilio Biancardi

9) Mr Biancardi is the managing director of Fashion. He exhibits at AB1 a company profile. He states that goods bearing the REPLAY trade mark have been sold continuously in the United Kingdom since 1984. He states that they have been sold in all parts of the United Kingdom. He states that goods bearing the REPLAY trade mark are currently imported into the United Kingdom by a company called Elanmain Limited (trading as Options) and distributed by them to retail outlets throughout the United Kingdom. He states that goods bearing the trade mark REPLAY have also been sold in the United Kingdom by Fashion's controlled distributors: New Mills SpA, Fashion Toys SpA and Knit Box Srl through their respective United Kingdom distributors.

10) Mr Biancardi states that REPLAY has been used on a wide range of clothing for men, women and children. He also states that the trade mark has been used on various accessories ie bags, belts, purses, wallets, key cases and costume jewellery. Exhibited at AM2 are copies of tags and labels that Mr Biancardi states have been used upon goods sold in the United Kingdom. Exhibited at AB3 are copies of the front pages of various catalogues of goods for sale in the United Kingdom under the REPLAY trade mark. The earliest catalogue is from spring/summer 1995. The exhibit also includes copies of pages from various catalogues showing a variety of clothing items and at least one bag. Exhibited at AB4 are copies of invoices from Fashion to Options. Mr Biancardi states that the goods described in the invoices are sold under the trade mark REPLAY. The invoices start from March 1990 and end in July 1997. Certain of the invoices refer to REPLAY BASE, REPLAY and REPLAY DONNA. The invoices show the sale of various items of clothing and belts, and a few key rings.

11) Mr Biancardi states that the REPLAY trade mark has been used in the United Kingdom in respect of goods made from paper and cardboard, such as diaries and printed matter, as well as stationery, for promotional purposes. Exhibited at AB5 are invoices which refer to small catalogues and advertising sets, catalogues and displays. There are also pictures of "color cards", calendars, packaging, a desk set and a phone book.

12) Mr Biancardi states that the REPLAY trade mark has been used in the United Kingdom in connection with eyewear products. He states that in 1997 Marcolin SpA of Italy was appointed as Fashion's licensee for the manufacture and distribution, including in the United Kingdom, of sunglasses "associated" with the REPLAY trade mark. Exhibited at AB6 is a catalogue from 1998 showing spectacle frames and sunglasses using the trade mark REPLAY.

13) Mr Biancardi states that REPLAY has been used in connection with soaps, perfumery, essential oils and cosmetics. Exhibited at AB7 are copies of photographs showing perfumes, shampoo and aftershave bearing the trade mark REPLAY. Also included in the exhibit is an invoice dated 24 November 1997 (no 40422) from Morris, which is described as a division of Henkel SpA. Mr Biancardi states that Henkel SpA

Morris is Fashion's licensee. The invoice is made out to Agreemaster Limited of London. It shows the following REPLAY goods: eau de toilette, aftershave and body and hair shampoo. The final item on the invoice is 12,460 litres of denaturated alcohol type B, there is no reference to a trade mark in relation to these last goods.

14) Mr Biancardi states that REPLAY has been used in connection with imitation jewellery items. He exhibits at AD8 copies of photographs depicting imitation jewellery sold in the United Kingdom under the trade mark REPLAY. The quality of the reproduction is poor; key rings, bracelets, desk sets and badges can be made out. There is no indication as to from when the photographs emanate.

15) Mr Biancardi states that REPLAY has been used in the United Kingdom in connection with products made from leather and imitations of leather, travelling bags, umbrellas and parasols. Exhibited at AB9 are three invoices made out to Options of London. These invoices include references to key chains, "sacks" and wallets. The invoices are dated 6 September 2005, 16 July 1996 and 2 August 1996. Also included in the exhibit are copies of pictures of bags and an umbrella. There is no indication as to the date from which the pictures emanate.

16) Mr Biancardi states that the approximate turnover of sales of goods bearing the REPLAY trade mark is as follows:

1984	£300,520
1985	£442,066
1986	£627,763
1987	£682,253
1988	£629,993
1989	£342,624
1990	£536,480
1991	£683,274
1992	£1,099,911
1993	£1,775,163
1994	£2,188,997
1995	£2,215,637
1996	£2,383,166
1997	£2,482,187

Mr Biancardi states that approximate sales of goods bearing the REPLAY trade mark sold by Fashion's subsidiaries in the United Kingdom are as follows:

New Mills SpA: 1996 - £452,064; 1997 - £111,046.

Fashion Toys SpA: 1995 - £177,240; 1996 - £308,282; 1997 - £254,499.

Knit Box Srl: 1996 - £115,594; 1997 - £280,358.

17) Mr Biancardi states that advertisements for goods sold under the REPLAY trade mark have appeared in the following magazines circulating in the United Kingdom:

'Arena' – April 1989; 'Glamour' – July 1990; 'Sportswear International' – Winter 1992/3; 'The Face' – March 1993; 'Sky Magazine' – November 1994; 'Esquire' – December 1994; 'More!' – November – December 1994; 'GQ' – December 1994, February 1995 and July 1996; 'The Observer' ('Life Section') – 14 April 1996; 'Clothes Show Magazine' – May 1996; 'Marie Claire' – May 1996; 'Loaded' – May and July 1996; 'FHM' – July 1996.

As far as I can see, only three examples of the advertisements are exhibited, at AB14:

'The Face' of March 1993 – a part page advertisement;

'The Observer' – an article about sportswear, there are references to several Italian fashion houses. The main references are to Diesel; there are three references to REPLAY;

'Clothes Show' – five pages of advertorials, showing women's clothing under various trade marks, including REPLAY.

18) The rest of Mr Biancardi's declaration deals with the position overseas which has no bearing upon this case.

DECISION

Likelihood of confusion – section 5(2)(b) of the Act

19) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

20) Fashion's trade mark, is an earlier trade mark within the meaning of the Act.

21) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *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 BV* [2000] FSR 77, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723 and *Vedial SA v Office for the*

Harmonization of the Internal Market (trade marks, designs and models) (OHIM) C-106/03 P.

Comparison of goods

22) In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* the ECJ held in relation to the assessment of the similarity of goods that the following factors, inter alia, should be taken into account: their nature, their intended purpose (the original incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected), their method of use and whether they are in competition with each other or are complementary. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

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

In relation to the terms used in specifications Jacob J stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of goods and services (see *Altecnic Ltd's Trade Mark Application*

[2002] RPC 34). Although it dealt with a non-use issue, I consider that the words of Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 are also useful to bear in mind:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

23) The goods of the application are:

encoded cards displaying moving images; encoded telephone payment cards and encoded identity cards, all bearing moving images; but not including any of the aforesaid encoded cards for use in recording information;

greeting cards; collectible cards; photographs; plastics cards bearing images; identity cards.

The goods of Fashion’s earlier registration are:

bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices;

spectacles; life-saving apparatus and instruments; automatic vending machines and mechanisms for coin-operated apparatus; fire-extinguishing apparatus;

precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments;

magazines, newspapers, periodicals, printed publications; paper, cardboard, articles of paper; office requisites except magazines and periodicals relating to crosswords and puzzles, writing and drawing implements and all related articles;

leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery;
textiles and textile goods, not included in other classes; bed and table covers;

clothing, footwear, headgear;

gymnastic and sporting articles not included in other classes; decorations for Christmas trees;

advertising; business management; business administration; office functions; shop window dressing;

transfer of know-how and licensing, consultancy relating to the installation and setting up of shops, exterior and interior design and furnishing of shops and related signs (except shop window dressing), cafeterias, cafés, catering, cocktail lounges, snack-bars, refreshments, restaurants, self-service restaurants, providing of food and drink.

Applying the criteria set out in the case law, I cannot see that any of the goods and services of Fashion’s registration are similar to the class 9 goods of the application. The case, indeed, is the very opposite; I consider that the class 9 goods of the application are positively dissimilar to the goods and services of the earlier registration. Fashion has not put forward any explanation or argument as to which goods are considered to be similar or identical; in its statement of grounds it does not identify which goods are considered to be identical or similar but makes the vague claim that “at least” some of the respective goods are identical or similar.

24) Any potential clash relates to the respective class 16 goods:

Class 16 goods of earlier registration:	Class 16 goods of application:
<i>magazines, newspapers, periodicals, printed publications; paper, cardboard, articles of paper; office requisites except magazines and periodicals relating to crosswords and puzzles, writing and drawing implements and all related articles</i>	<i>greeting cards; collectible cards; photographs; plastics cards bearing images; identity cards.</i>

I am of the view that a normal and fair interpretation of *articles of paper* would be goods made of paper, such as envelopes or paper covers for documents. I do not consider that this term will include the goods of the application. I do not consider that any of the goods of earlier registration will encompass those of the application; so the respective goods are not identical. I consider that the best way to deal with whether the respective goods are similar is to deal with each set of goods in the application separately. (Fashion has not advised how or why it considers the “at least” some of the goods of the application are identical or similar to the goods of its registration.)

Greeting cards

Greeting cards are of paper or card and so would be made of the same material as the goods of the earlier registration. They are to send congratulations, condolences, greetings etc. The goods of the earlier registration will include notepaper and letter paper, so to some extent the respective goods could have the same intended purpose. The aforementioned goods would all be written upon and sent, most likely by post; so there is a coincidence in the method of use. One could send a letter instead of a card as an expression of some feeling. The aforementioned goods could go through the same channels of trade. In my experience greeting cards are in discrete areas of shops or even have shops largely devoted to them. I am aware that certain types of note/letter paper have designs/pictures upon them and the accompanying envelopes; it seems to me that such goods bear an affinity to greeting cards and that, subject to the similarity of the trade marks, could be seen as emanating from the same undertaking. **I find that *greeting cards* are similar to the goods of the earlier registration.**

Collectible cards

As the name states these are cards which are designed to be collected. In my experience, nowadays, these tend to be sold in opaque packets; so the purchaser does not know what which particular card he or she is buying. *Collectible cards* were traditionally given away with cigarettes and packets of tea and then stuck into an album. The collectibles will have a subject that links them; it could be famous footballers or characters from animated films. The cards will normally be made of thick paper or thin card. The intended purpose of the cards is to create a collection, to have every card of the collection. From my own knowledge and experience, I am aware that these cards might be sold in conjunction with a companion publication into which the cards can be placed; slightly more sophisticated than the albums of yesteryear. In these circumstances there is a relationship between printed publications and these cards. The cards do not depend on the publications but the publications depend on the cards, so there is a dependent relationship; if only in one direction. In the circumstances described above, the nature of the relationship is symbiotic. Consequently *collectible cards* would be complementary to the *printed publications* of the earlier trade mark. They could appear, like magazines and newspapers, in newsagents. I cannot see that one would substitute these goods for any of the goods of the earlier registration, so I do not see them as being in competition. Both sets of goods would be used to create a collection and so their use is the same. **Taking all the above factors into account, I consider that *collectible cards* are similar to the goods of the earlier registration.**

Photographs

Photographs are printed upon photographic paper. Only non-sensitised paper for carrying photographic imaging materials is in class 16; sensitised paper is in class 1. In that *photographs* are produced on a form of paper there is some similarity of nature in relation to *paper* at large in the specification of the earlier registration. *Photographs* are purchased to be displayed as an item of decoration or an indication of affection; I cannot

see that they have the same intended purpose as the goods of the earlier registration. They will be placed in an album, in a frame or put upon a wall; I cannot see that that their method of use has anything in common with the goods of the earlier registration. *Photographs* do not represent an alternative for the goods of the earlier registration; neither do they have a symbiotic or dependent, mutually or otherwise, relation with the goods of the earlier registration. Consequently, I do not consider that the respective goods are complementary or in competition. It is likely that they would be in a discrete area of a shop. **Taking these factors into account, I do not consider that *photographs* are similar to the goods of the earlier registration.**

Plastics cards bearing images

I cannot see any other point of intersection, based on the case law, with the goods of the earlier registration. **Consequently, I do not consider that *plastic cards bearing images* are similar to the goods of the earlier registration.**

Identity cards

The sole purpose of *identity cards* is explained by their name; they are to identify. They are for security purposes and/or to prove identity eg to prove to a publican that one is over eighteen years of age. Such goods may be made of cardboard, although nowadays they are more likely to be of plastic. Other than with this possible intersection of material of manufacture, I cannot see any other point of intersection, based on the case law, with the goods of the earlier registration. **Consequently, I do not consider that *identity cards* are similar to the goods of the earlier registration.**

Comparison of trade marks

25) The trade marks to be compared are:

Earlier trade mark:

Application:

REPLAY



26) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

27) The stylisation of the application is limited, one is presented very much with an Instant replay trade mark; consequently, I do not consider that anything will turn upon the stylisation of the application. The trade marks, obviously, coincide in the word “replay”. As this is the only element of the earlier trade mark, it must be the distinctive and dominant component. As a result of my findings in relation to the similarity of goods, the only goods that can fall foul of section 5(2)(b) of the Act are *greeting cards* and *collectible cards*. In considering the trade mark of Wheels I need to bear in mind the perception of the relevant public in relation to such goods. In relation to such goods will anyone element be the dominant and distinctive component? ‘Instant replay’ is often used in relation to sporting events, where, for instance, adjudication can be given by video replay, eg to decide whether a ball has been grounded for a try or whether a batsman has been run out. I believe that it is a phrase that has been in use for some time. I consider that the average consumer of *greeting cards* and *collectible cards* will take the trade mark in its entirety and will not give any greater emphasis to any element of the phrase. I am of the view that “instant replay” hangs together as an entity, being a commonly known phrase; the dominant and distinctive element of the trade mark are the two words together.

28) The issue of the similarity of trade marks which have an identical or similar component was dealt with by the Court of First Instance (CFI) in *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T – 6/01:

“33. Consequently, it must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.

34. It should be made clear that that approach does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. However, that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.

35. With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.”

A trade mark that “hangs together” may not bring to mind an earlier trade mark even though there is a common element. This will especially be the case where the common element forms part of a commonly known whole. If the product in question was coffee, the “instant” element of the application would have such an overwhelming reference to the product that the earlier trade mark would be brought to mind; despite the unity of the phrase. “Instant” has no such meaning in relation to *greeting cards* and *collectible cards*, the unity of the entity of the trade mark is not split by the nature of the goods. However, replay and instant replay both clearly refer to playing back, so they both have a common conceptual link. That “instant replay” is commonly known phrase does not create a conceptual dissonance or even dissipate conceptual similarity with the earlier trade mark; the trade marks are conceptually similar. The common element in the trade marks inevitably gives rise to a degree of visual and aural similarity. **Primarily owing to the conceptual similarity, I consider that the respective trade marks are similar.**

Conclusion in relation to likelihood of confusion

29) First Council Directive 89/104 of December 21, 1988 requires goods or services to be similar for there to be a finding of likelihood of confusion. Likelihood of confusion is a cumulative process. once one part of the cumulative process is absent the claim collapses, as was stated by the CFI in *Alecansan, SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-12/04:

“35 However, a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services referred to in the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions are cumulative (*Canon*, paragraph 22, concerning the provisions of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), and Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraph 51, concerning Article 8(1)(b) of Regulation No 40/94). Thus, even where the sign applied for is identical to a mark which is highly distinctive, it must be established that the goods or services covered by the opposing marks are similar (judgment of 1 March 2005 in Case T-169/03 *Sergio Rossi v OHIM– Sissi Rossi (SISSI ROSSI)* [2005] ECR II-0000, paragraph 53; see also, by analogy, *Canon*, paragraph 22).”

In *Eurodrive Services and Distribution NV c Oficina de Armonización del Mercado Interior (marcas, dibujos y modelos) (OAMI)*, Case T- 31/04 the same approach was adopted:

“39 Por lo que respecta a la apreciación global del riesgo de confusión, procede recordar que la similitud o identidad de los productos y servicios designados por las marcas en conflicto es un requisito determinante del riesgo de confusión, expresamente exigido por el artículo 8, apartado 1, letra b), del Reglamento nº 40/94.”

(The above judgment is only available in Castellano and French.)

The above judgments are in full accord with the corollary in relation to similarity of signs as per *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM) C-106/03 P*.

30) Consequently, the only goods for which there can be a finding of a likelihood of confusion are *greeting cards* and *collectible cards*. In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case there is a reasonable, if not overwhelming proximity, in relation to *greeting cards*; there is a greater proximity in relation to *collectible cards*. The respective trade marks have a reasonable degree of similarity. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade marks (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). 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] ETMR 585). I cannot see that Fashion’s trade mark is descriptive or allusive of the sort of class 16 goods that would clash with *greeting cards* or *collectible cards*. Consequently, it has a good degree of inherent distinctiveness. The average consumer for *greeting cards* is the public at large; the design and message of the card may be the subject of a good deal of study but I do not consider that the trade mark under which they are sold will be. The average consumer of *collectible cards* is likely to be a child. However, there is an adult market for such goods also; probably mainly a male adult market. The purchaser will wish to collect the right card and the trade mark message will be reinforced by repeat purchase (which is inherent in the nature of the product). So a reasonable degree of care may be used in the purchase of the cards.

Taking into account all the above factors, and especially bearing in mind the conceptual similarity of the trade marks, I consider that the average consumer will consider that *greeting cards* and *collectible cards* and the clashing class 16 goods of Fashion come from the same undertaking or an economically linked undertaking. Therefore, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, there is a likelihood of confusion in respect of *greeting cards*. **The application is to be refused in respect of *greeting cards* and *collectible cards*.**

COSTS

31) Wheels has for the most part been successful and is entitled to a contribution towards its costs. This is one of two cases between the parties, in which the evidence is substantially the same. I have taken this into account in my award of costs. Since 30 November 2000 Wheels has not been professionally represented. This was after the filing of the counterstatement and evidence of Fashion, so it is not appropriate to reduce the amount of costs by the one third, as is normal with those without representation. I order Fashion Box SpA to pay Wheels in Motion (Innovations) Limited the sum of £850. 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. This payment is subject to Wheels advising the representatives of Fashion of its current address.

Dated this 26th day of September 2006

**David Landau
For the Registrar
the Comptroller-General**