

O-301-15

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION UNDER NO 3025218
BY ROMAN KHAN
FOR REGISTRATION OF THE TRADE MARK

BOSCO

AND

OPPOSITION THERETO UNDER NO 401600
BY ROBERT BOSCH GmbH

Background

1. On 8 October 2013, Roman Khan (“the applicant”) applied to register the trade mark BOSCO for the following goods:

Class 7:

Kitchen tools [electric utensils]; electric blenders; electric juicers; electric food processors; electric coffee grinders; electric spice grinders; vacuum cleaners; electric can openers; electric hand mixers; electric meat grinders; electric food choppers; electric hand blenders; parts and fittings for all the aforesaid goods

Class 8:

Irons; steam irons; meat choppers [hand tools]; vegetable choppers [hand-operated-]; parts and fittings for all the aforesaid goods.

2. Following publication of the application in *Trade Marks Journal* 2013/043 on 25 October 2013, notice of opposition was filed by Robert Bosch GmbH “the opponent”). The opposition is based on grounds under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2) and 5(3), the opponent relies on the following Community (“CTM”) and International (“ITM”) trade marks:

Mark	Dates	Specification relied upon
CTM 5047221	Filing date: 10 April 2006	<p>Class 7: Household and kitchen machines and apparatus, in particular electric kitchen machines and apparatus, including mincing machines, mixing and kneading machines, pressing machines, juice extractors, juice centrifuges, grinders, slicing machines, electric motor-driven tools, electric can openers, knife sharpeners as well as machines and devices for the preparation of beverages and/or food; electric waste disposal units including waste masticators and compressors; dishwashers; electric machines and appliances for treating laundry and clothing including washing machines, spin driers, laundry presses, ironing machines; electric cleaning apparatus for household use including window cleaning devices and shoe cleaning devices, vacuum cleaners, hoses, pipes, dustfilters and dustfilter bags, all for vacuum-cleaners.</p> <p>Class 9: Electric apparatus and instruments, namely electric irons, kitchen scales, personal scales; electric welding devices for wrapping; remote control devices, signalling devices, controlling (supervision) devices and monitoring devices for household and kitchen machines and equipment; recorded and not recorded machine readable data carriers such as magnetic data carriers for household appliances; electric apparatus for dispensing beverage or food, vending machines; data processing devices and data processing programmes for controlling and operating household appliances.</p> <p>Class 11: Heating, steam producing and cooking devices, in particular ovens, cooking, baking, frying, grilling, toasting, thawing and</p>
BOSCH	Date of entry in register: 11 April 2007	

		food and plate warming apparatus, immersion heaters, cooking pots, electric, microwave appliances, electric tea and coffee making apparatus, cooling devices, in particular refrigerators, freezers, combination apparatus of cooling and freezing, deep freezing apparatus, ice-makers; ice-cream makers; driers, in particular laundry driers, tumble driers for laundry use; hand driers; hair driers; ventilation devices, in particular ventilators, grease filter devices and extractor devices including extractor hoods; air conditioning devices and devices to improve air quality, air humidifiers, water piping devices as well as sanitary equipment, in particular also fittings for steam, air and water piping equipment, warm water devices, storage water heaters and continuous flow water heaters; kitchen sinks; heat pumps.
ITM 675705 BOSCH	International registration date: 14 December 1996 Designation date: 14 December 1996 Date of protection in UK: 3 September 1999	Class 7: Electric power tools and their plug-in tools; electric kitchen appliances and accessories like electric food processors; dishwashing machines, washing machines, smoothing irons; parts and accessories for the abovementioned products included in this class Class 9 Telephones, car telephones; alarm systems; devices for location and navigation for installation in land vehicles Class 11 Heating, cooking, grilling, warming and cooling apparatus; gas igniters included in this class; cooling devices/refrigerators; hair driers, coffee machines; roasters; baking ovens; electric egg-boilers; toasters; air-conditioning systems; tumble dryers; parts and accessories for the abovementioned goods included in this class

3. The opponent's objection under section 5(4)(a) of the Act is based on use of the mark BOSCH since at least 2003 throughout the UK in respect of: "household appliances and apparatus, goods for use in the preparation of food, power tools, garden equipment and electrical goods for domestic purposes and parts and accessories for the aforesaid goods".

4. The applicant filed a counterstatement in which he requested the opposition be rejected in its entirety. Both parties filed evidence. The matter came before me for a hearing on 10 June 2015. The applicant was represented by Ms Katherine McCormick of Trade Mark Direct whilst the opponent was represented by Mrs Rigel Moss McGrath of W P Thompson.

The objection under section 5(2)(b) of the Act

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

"5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

6. An earlier trade mark is defined in section 6(1) of the Act which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), (ba) a registered trade mark or international trade mark (UK) which-

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

7. As can be seen from the details given above, the CTM and ITM relied upon by the opponent are earlier marks within the meaning of the Act. In its counterstatement, the applicant put the opponent to proof of use of its marks. That being the case, section 6A of the Act is also relevant. It states:

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 trade 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 in 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.”

8. Section 100 of the Act states that:

“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.”

9. What constitutes genuine use of a mark has been the subject of a number of judgments. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

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

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

10. Although minimal use may qualify as genuine use, the Court of Justice of the European Union ("CJEU") stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that "*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*". The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use. Whilst the

opponent relies on two earlier marks, they are both for the word BOSCH and differ only in respect of the font used. Given that the registration of the mark in plain block capitals would cover use of the mark in other forms and the fact that the stylisation of the ITM is minimal, I consider that they do not differ in their distinctive character and I shall refer to them in the singular where appropriate.

11. With the above in mind, I go on to consider the evidence filed by the opponent. This takes the form of two witness statements. The first is from Dieter Alvermann who is a director of Corporate Intellectual Property-Trademarks and Tradenames of the opponent company. The second is from Mrs Rigel Moss McGrath, the opponent's professional representative.

12. At the hearing, Ms Mc Cormick criticised the opponent's evidence as being minimal, ill-focussed, largely undated and not showing what the position might have been in the UK at any given time. Mrs Moss McGrath denied this and further submitted that the evidence filed was proportionate in the circumstances.

13. The weight to be given to evidence depends not on volume but the relevance of its content and the overall picture it presents (though I note in passing that the evidence of Mr Alvermann alone consists of almost 500 pages which is substantially more than the limit now applicable as a result of the coming into force of Tribunal Practice Notice 1/2015). Whilst it is true that not every page of the evidence is dated, the majority of it is presented as separate, numbered, pages which together form brochures which have the date on the front cover and which bear indications that they were intended for UK customers. Whilst it is also true that sales figures are not broken down in such a way that enables me to determine what sales accrue to particular goods, the evidence includes a number of invoices, copies of promotional material, website extracts showing the offer of goods under the mark from a number of suppliers and an annual report. Taking the opponent's evidence as a whole, the following facts emerge from it:

- The opponent's business started in Germany in 1886. Originally making and selling engineering products with a focus on the automotive industry, it has expanded to include consumer goods such as household appliances, power tools, gardening equipment and in-car entertainment as well as industrial electrical goods;
- Goods have been sold in the UK under the mark since 1898, either by the opponent itself or by a wholly owned subsidiary of its permitted user (the latter being a company in which the opponent has a 50% shareholding);
- The mark is used in ordinary capital letters and in an emboldened but plain upper case font as per the earlier marks relied upon and appears on every product sold;
- Between 2008 and 2013 the mark has been used on and in relation to sales of, amongst other things, washing machines, tumble dryers, washer dryers, dishwashers, fridges, freezers, ovens, hobs, vacuum cleaners, steam irons, kettles, toasters, food preparation apparatus, saucepans, hot drinks machines, choppers, microwave ovens and cooker hoods;

- Sales of each of the above goods in the UK have been made consistently between those dates with annual turnover amounting to £232.9m (2008), £229.6m (2009), £235.7m (2010), £256.8m (2011), £258.3m (2012) and £238.5m (2013-to Oct 25);
- Sales have been made through the company's own dedicated online store bosch-home.co.uk/store, through national department stores with both an online and physical presence such as John Lewis, Currys, Argos and Euronics as well as through online-only stores such as [appliancesonline \(ao.com\)](http://appliancesonline.com);
- Approximate advertising and promotional spend in the UK amounts to: £3.805m (2008), £1.566m (2009), £1.276m (2010), £1.609m (2011), £2.367m (2012) and £5.186m (2013). The mark and goods have been promoted on the bosch.co.uk website since it was first set up at least 20 years ago. It has also been promoted regularly in national magazines, on the websites of its stockists, in catalogues published annually and distributed in-store to potential customers, through write-ups in consumer magazines, via the company's Twitter account and through sponsorship of a driver at the Le Mans 24 hour race which is shown on television worldwide.

14. At RB3 are exhibited a number of brochures and website extracts. They include:

- A brochure entitled 'Freestanding cooking' and dated Spring 2008. It shows use of the mark BOSCH on kitchen appliances including cookers, cooker hoods and microwave ovens as well as on saucepans;
- A brochure entitled 'Freestanding appliances' and dated 2008/09. It shows use of the mark BOSCH on dishwashers, washing machines, washer dryers, tumble dryers, fridges, freezers, wine coolers and irons;
- A brochure entitled 'Built-in appliances' and dated 2009/10. It shows use of the mark BOSCH on coffee makers and hobs;
- A brochure entitled 'Freestanding appliances' and dated 2012/13 which shows use of the mark on wine cabinets and coolers;
- Extracts from the Argos, Woolworths, Currys and House of Fraser websites which show use of the mark on food mixers and processors, vacuum cleaners, toasters and kettles;
- Extracts from the Bosch.co.uk website showing use on, inter alia, laundry and cooking equipment, kettles, food processors, blenders, choppers and juicers;
- Extracts from the amazon.co.uk website showing reviews in relation to e.g. vacuum cleaners (posted 2009), kettles (2009-2011) and food processors and blenders (2009-2011) sold under the mark;

- Extracts which show that various BOSCH appliances have received “Best Buy” or other recommendations following reviews by the WHICH consumer products testing organisation.

15. I find that the marks relied on by the opponent have been used within the relevant period. In its notice of opposition, the opponent indicated it relied on its CTM in respect of all the goods for which it is registered. In respect of its ITM, it indicated it relied on only some of the goods for which it registered. Those goods are set out above at paragraph 2. In both cases, the specification relied on includes goods for which no use has been shown e.g. personal scales (CTM) and location and navigation devices for vehicles (ITM). In determining what a fair specification might be for the use shown by the opponent, I bear in mind the comments made in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, where Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“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.”

16. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general,

everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that 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 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. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

17. I consider a fair specification based on the use shown is:

Class 7:

Electric household and kitchen machines and apparatus for the preparation of food and drink, cleaning and laundry purposes;

Class 9: Electric irons;

Class 11:

Apparatus for the preparation of food and drink, cooking, laundry and refrigeration purposes.

18. For the reasons given earlier in this decision, in my consideration of the objection under this ground, I will make the comparison in respect of the earlier mark as it appears in plain block capitals (the CTM) as doing so will not disadvantage either party. The parties referred to them in the singular at the hearing.

19. 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.

The principles

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the respective goods

20. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“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”.

23. For ease of reference, the goods to be compared are:

Opponent’s fair specification	Applicant’s specification
<p>Class 7: Electric household and kitchen machines and apparatus for the preparation of food and drink, cleaning and laundry purposes;</p> <p>Class 9: Electric irons</p> <p>Class 11: Apparatus for the preparation of food and drink, cooking, laundry and refrigeration purposes.</p>	<p>Class 7: Kitchen tools [electric utensils]; electric blenders; electric juicers; electric food processors; electric coffee grinders; electric spice grinders; vacuum cleaners; electric can openers; electric hand mixers; electric meat grinders; electric food choppers; electric hand blenders; parts and fittings for all the aforesaid goods</p> <p>Class 8: Irons; steam irons; meat choppers [hand tools]; vegetable choppers [hand-operated-]; parts and fittings for all the aforesaid goods</p>

24. With the exception of *vacuum cleaners*, each of the applicant’s goods as are included in class 7 is a piece of apparatus used in the kitchen and in the preparation of food and drink. They are goods which are included within, and therefore identical to the *electric kitchen machines and apparatus for the preparation of food and drink* as I have found to be a fair specification for the opponent’s use. The same finding applies to the *parts and fittings* as included within the applicant’s specification.

25. *Vacuum cleaners* as appear in the applicant’s specification in class 7, are included within and therefore identical to the opponent’s *household machines and apparatus for cleaning purposes* in the same class.

26. *Irons; steam irons* as appears in the application in class 8 are highly similar if not identical to *Electric irons* as appears in the opponent’s specification in class 9 and to *electric machines and appliances for laundry* as appears in the opponent’s specification in class 7. Each of these respective goods is a piece of equipment used by those who wish to press or iron clothing or other laundry and they may be purchased through the same trade channels.

27. The applicant’s specification in class 8 also includes *meat choppers [hand tools];* and *vegetable choppers [hand-operated -]*. These are apparatus used in the preparation of meat or vegetables. The opponent’s specification in class 7 includes *Electric kitchen machines and apparatus for the preparation of food and drink*. Whilst the opponent’s goods are electrical and the applicant’s are hand-operated, the respective goods are highly similar as they are each alternative pieces of equipment used by those who are preparing food and so are in competition and may be purchased through the same trade channels. The same finding applies to the parts and fittings for these goods.

The average consumer and the nature of the purchasing process

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

29. 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.”

30. Each of the respective goods is an item of household or kitchen apparatus. They are goods which will be used by the general public and are widely available from e.g. electrical stores, kitchen paraphernalia stores or from supermarkets both on the High Street and online. Whilst used on a regular basis, they are goods which are likely to be purchased on an occasional basis with that purchase being largely a visual one, not least because of the fact that such goods commonly have both functional and aesthetic appeal. Because of this, a reasonable, but not the highest, degree of care is likely to be taken over the purchase.

Comparison of the respective marks

31. 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.”

32. It would be wrong, therefore, artificially to 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.

33. The marks to be compared are:

Opponent's mark	Applicant's mark
BOSCH	BOSCO

34. Each of the respective marks consists of five letters, the first four of which are the same letters in the same order. The marks differ only in respect of their final letters. From the visual perspective, the respective marks are very highly similar. Aurally, the opponent's mark will be pronounced as a single syllable word (i.e. bosh) whereas the applicant's mark will be pronounced as a two syllable word (i.e. bos co). Whilst there is some aural similarity due to the letters 'bos' being the first part of each mark, there is also some aural dissimilarity due to the endings of them being different (i.e. what is likely to be the softer ending of "SCH" against the harder ending of "CO"). When considered as a whole, there is a moderate degree of aural similarity between them. In her submissions, Ms Mc Cormick referred the opponent's mark deriving from the German language and the applicant's from the Italian and meaning "woods", however, absent evidence to the contrary, I do not consider the average consumer will know this. I accept that it is possible he will consider they are each words of foreign derivation but this does not give either mark a conceptual hook that would assist the average consumer in distinguishing either mark or enabling its recall. The conceptual position is therefore neutral. Overall, the marks are similar to a reasonably high degree. Each of the marks is presented as a single word, no part of which is highlighted in any way and in each case its distinctiveness rests in the mark as a whole.

Distinctiveness of the earlier mark

35. 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)."

36. In her submissions, Ms McCormick attempted to draw a distinction between the opponent's use on what she referred to as "white goods" e.g. washing machines and fridges and "small kitchen electrical goods" e.g. mixers, food processors and blenders. I set out above my findings on the evidence of use filed by the opponent. That use has taken place over very many years and in relation to an increasing number and range of goods. The evidence shows the mark to have been used on both large appliances such as washing machines and well as small ones such as choppers, saucepans and blenders. Whilst turnover figures, as I have indicated above, are not given in respect of each type of equipment as a separate figure, the evidence of use from 2008 onwards, on goods which are likely to be used in almost every household in the UK on a daily basis, is in the billions (£ sterling) with advertising and promotional spend in the UK not less than £1.2 million. The wide range of goods are shown to have been sold through major suppliers such as John Lewis and Argos who have physical and online stores, the latter also distributing a catalogue to potential customers. Whilst the mark has a relatively high degree of inherent distinctiveness, I am satisfied that the use made of it in the UK will have enhanced that distinctiveness to the highest degree in respect of all of the goods sold.

Likelihood of confusion

37. 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 opponents' trade mark as the more distinctive this 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.

38. Earlier in this decision I found:

- The applicant's goods in class 7 are identical to those of the opponent in the same class whilst the applicant's goods in class 8 are highly similar if not identical to the opponent's goods in classes 7 and 9;
- The respective goods are household appliances and equipment which will be in regular use but purchased on an occasional basis with a reasonable though not the highest degree of care;
- The respective marks are very highly similar on a visual comparison moderately similar on an aural comparison, the conceptual position being neutral. Overall, the respective marks are similar to a reasonably high degree;
- The earlier trade mark has a relatively high degree of inherent distinctiveness which has been enhanced, through extensive use, to the highest degree.

39. In her submissions, Ms McCormick referred to the fact that the opponent had not put forward any evidence of actual confusion between the respective marks. She submitted that this was relevant as the applicant “has been using [his mark] since 2009 in the UK”. The applicant has filed evidence which takes the form of what is essentially a one page witness statement which acts as a vehicle to introduce a number of exhibits (RK1-12).

40. RK1 to RK11 each take the form of what appear to be photocopies of letters. All are dated September 2014. Not all are presented on headed paper but each is addressed “To Whom it May Concern”. Some are from companies said to have supplied the applicant, or what I take to be his company, with various goods whilst others indicate that they have been supplied with goods by him. None of the individuals who have signed these letters have filed witness statements. None of them indicate they have sold, under the mark, any goods which may have been supplied to them by the applicant or when they may have done so.

41. RK12 is said to be a statement from the applicant’s accountant showing annual sales under the mark by the applicant for the year 2013-14. It is also in letter form and is dated “29th September (sic) 2014”. It is addressed to the applicant himself (as Director of Bosco (UK) Ltd) and gives details of what is said to be sales for each quarter of that period. The first of those quarters is from 1 October 2013 to 31 December 2013 and thus, with the exception of one week, all of the figures provided would date from after the relevant date in these proceedings. I note in passing that the final quarter for which figures are given ends on a date which is after the date the letter itself was signed and dated. Again, the signatory to this letter has not filed evidence in his or her own right. The letter gives no details of under what mark any sales were made, where any such sales might have taken place nor what particular goods might have been sold.

42. The evidence filed by the applicant does not show that he has had a trade at any particular time under the mark applied for in relation to the goods for which he seeks registration. Even if it did, I take note of the findings in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, where Millett L.J. stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

43. In reaching my decision on the likelihood of confusion, I note that in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches

more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar."

44. Whilst I accept the respective marks are less similar aurally than they are visually, I have found that the purchase of the goods at issue is primarily a visual one. The marks differ only in respect of their final letters. In her evidence for the opponent, Mrs Moss McGrath shows an image of what appears to be a food processor bearing the applicant's mark and taken from the website of one of his suppliers on an unknown date. Next to it is what is said to be one of the opponent's goods of a similar nature. Both show the parties' respective marks in similar font in a prominent place on pieces of kitchen equipment. Whilst this is not determinative, it requires some care to establish which mark is which and I have encountered similar difficulties when preparing this decision. Taking all matters into account, I find that there is a likelihood of confusion between the respective marks. The opposition under section 5(2)(b) succeeds in full.

The objection under section 5(3) of the Act

45. Section 5(3) of the Act states:

"(3) A trade mark which-
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

46. In brief, the opponent opposes registration on the basis of its earlier CTM and ITM in which it claims have a reputation. In particular the opponent argues that the applicant will benefit from the opponent's investment in advertising, leading to an unfair advantage. Further that the applicant will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier marks. The opponent also claims that the later use will be out of its control and that poor quality goods will cause detriment to its valuable reputation and business. Finally, it claims that use of the later mark will dilute the distinctive character and reputation of its marks.

47. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction,

the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

48. I set out above my findings on the evidence filed by the opponent. In my view, it very clearly shows the opponent to have a reputation in the UK in its mark BOSCH in respect of (at least) household and kitchen appliances and equipment. Despite her criticism of the opponent's evidence, Ms McCormick conceded the opponent had a reputation in its mark for kitchen appliances. The first hurdle which the opponent has to overcome is therefore met and I go on to consider whether the relevant public would make a link between them.

49. In my consideration of the same marks under the provisions of section 5(2)(b) of the Act, I found that there is a likelihood of confusion between them. The level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

50. The respective marks each consist of five letters with only the last of those letters being different. I have found them to be similar to a reasonably high degree, taking account of visual, aural and conceptual considerations. I have found the respective goods to be at least highly similar. They are household items used for the preparation of food or drink, for laundry or for cleaning purposes. They are each goods used by the general public. I also found that the earlier mark has a relatively high degree of inherent distinctiveness which has been enhanced to the highest degree through use. Taking all matters into account, I consider the relevant public would make the necessary link. The second hurdle the opponent has to overcome is therefore met.

Unfair advantage

51. In *L'Oréal v Bellure*, the CEJU stated:

“The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.”

i.e. the later mark calls to mind the earlier mark and appears instantly familiar to the relevant public thereby making it easier for the defendant to establish its mark and to seek its goods without the usual marketing expenditure.

52. There is some debate as to whether the judgment of the CJEU in *L'Oréal v Bellure* means that an advantage gained by the user of a junior mark is only unfair if there is an intention to take advantage of the senior mark, or some other factor is present which makes the advantage unfair. The English Court of Appeal has considered this matter three times. Firstly, in *L'Oréal v Bellure* [2010] RPC 23 when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood* [2010] RPC 2: see paragraph 136. Thirdly, in *Specsavers v Asda Stores Limited* [2012] EWCA Civ 24: see paragraph 127. On each occasion the court appears to have interpreted *L'Oréal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause. The absence of due cause, however, appears to be closely linked to the existence of unfair advantage. (See paragraph 36 of the opinion of Advocate General Kokott in Case C-65/12 *Leidseplein Beheer and Vries v Red Bull*).

53. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

54. I have no evidence which goes to the applicant's intention, however, in choosing a mark which is so similar to that of the opponent, I consider an unfair advantage will be taken of that earlier mark and the applicant will benefit from its power of attraction as well as the marketing effort which has been expended.

Detriment to repute

55. In respect of the opponent's claim to detriment to the repute of its earlier mark, it states:

"The BOSCH trade mark enjoys a reputation for inter alia technical reliability and good design which are factors which have contributed to the mark's longevity and success. Many of the applied-for goods are performance-critical. Poor workmanship in the Applicant's goods may lead to damage to the BOSCH trade mark and its standing in the minds of the public. The association of the BOSCH trade mark with BOSCO goods, whether through the "bringing to mind" of the earlier mark or actual confusion, is likely to lead to damage to the good standing/reputation of the BOSCH trade mark."

56. The issue to be determined is not whether there is the potential for there to be damage caused should the applicant's goods be of poor quality (see, *Unite the Union* BL O/219/13) but whether there is something about the later mark or the type of goods to which it is applied which spoils the image of the earlier mark or creates a negative association in the mind of the relevant consumer. In my view, there is nothing about the applicant's mark or type of goods that would cause such detriment.

Detriment to distinctive character

57. In *L'Oréal*, the CJEU stated:

"39. As regards detriment to the distinctive character of the mark, also referred to as 'dilution', 'whittling away' or 'blurring', such detriment is caused when that mark's ability to identify the goods or services for which it is registered is weakened since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29)."

58. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) pointed out that the alleged detriment to the distinctive character of the earlier mark must be connected to the mark's reputation. The judge stated that:

"122. The requirement that the registered trade mark has a reputation therefore underpins and is intimately tied to the possibility that the mark may be injured. Put another way, if and in so far as the registered mark is not known to the public then, in a case in which there is no likelihood of confusion,

it is very hard to see how it can be injured in a relevant way. This presents no conceptual difficulty in a case in which it is alleged that the use of the later mark will take unfair advantage of or tarnish the reputation attaching to the registered mark. Self evidently both of these kinds of injury can only be inflicted upon the registered mark to the extent that it has a reputation. But in my judgment just the same must apply to the third kind of injury, that is to say, damage to distinctive character by, for example, dilution or blurring. Just as in the case of the other kinds of injury, there must be some connection between the reputation and the damage.”

And

“140. Finally, and most importantly for present purposes, in assessing whether there is detriment to the distinctive character of the earlier mark, it must be considered whether the mark’s ability to identify the goods or services for which it is registered and used as coming from the proprietor of the mark is weakened (see *Intel* at paragraph [29], set out above).”

59. I also bear in mind the comments of Birss J [2014] EWHC 2631 (Ch) *PINK* where he said:

“Furthermore the link to the CTM will inevitably cause a detriment to the distinctive character of the claimant’s mark. The defendant is not using PINK in a descriptive sense, it is using PINK as an indication of trade origin for its articles of clothing and other articles, Over time, if it is not stopped, it is bound to cause the claimant’s clothing trade mark to begin to lose its ability to act as a designation of the claimant as the origin of its goods. The defendant is backed by a huge business and is in a position to saturate the market with its conflicting origin message in a very short space of time. A key element in the claimant’s mark, the word PINK, will not serve as an exclusive designation of the claimant. The public will think that the claimant’s trade mark refers to Victoria’s Secret. There is a real risk that this will lead to a change in economic behaviour. For example consumers are likely to enter one of the claimant’s shops looking for lingerie and be surprised and disappointed when they find they have made a mistake.”

60. I have no relevant evidence of the applicant’s business, however, I consider that any use by or authorised by him of his mark will weaken the distinctive character of the earlier mark.

61. The objection under section 5(3) of the Act succeeds.

The objection under section 5(4) of the Act

62. Whilst the opponent indicated it continued to rely on this ground, I decline to deal with it as I do not consider it puts it in any stronger position than those I have already determined.

Summary

63. The opposition to the application succeeds.

Costs

64. The opponent having succeeded is entitled to an award of costs in its favour. I take note that both sides filed evidence, the applicant's not extensive or of any probative value, and that a hearing took place. Taking all matters into account, I make the award on the following basis:

Statement of case (inc fee):	£400
Evidence:	£1000
Preparation for and attendance at hearing:	£500
Total:	£1900

65. I order Roman Khan to pay Robert Bosch GmbH the sum of £1900 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of June 2015

**Ann Corbett
For the Registrar
The Comptroller-General**