

O/301/20

In the matter of UK Trade Mark Applications Nos.3256346 & 3256349 to register a device mark and the word mark BOSCO in classes 18, 25, 28 and 35 6 and 8 in the name of Bosco Brands UK Limited (the Applicant)

and

Oppositions thereto Nos. 411537 & 411538 by Robert Bosch GmbH (the Opponent)

and

In the matter of an Appeal to the Appointed Person by the Opponent against the Decision of the Hearing Officer O-657-19 for the Registrar, The Comptroller General dated 29 October 2019

DECISION OF THE APPOINTED PERSON

Introduction

1. The Applications in issue were applied for on 13 September 2017. The second application, 349, was for the word mark BOSCO and the first, 346, was for this device mark:



2. Both applications were filed for the same range of goods and services in classes 18, 25, 28 and 35.
3. The Applications were opposed by the Opponent under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (as amended) (“the Act”) on the basis of its earlier European Union trade mark no. 10359966 for the word mark BOSCH which is registered for a large range of goods and services in classes 1, 2, 4, 6-12, 16, 17, 25, 28, 35, 37, 38, 41, 42, 44 and 45.
4. For the purposes of the section 5(2)(b) grounds, the Opposition was directed against all of the goods and services of the applications in classes 25, 28 and 35 only. The

section 5(3) grounds were directed at all the goods and services in the applications, with the Opponent claiming reputation for the goods registered in classes 7, 8 and 11.

The Hearing Officer's Decision

5. The hearing of the Oppositions took place by videolink before the Hearing Officer, Ms Heather Harrison, on 16 August 2019. During the evidence rounds, only the Opponent filed evidence, but both sides filed written submissions. At the hearing, both sides were professionally represented.
6. So far as the comparison of goods and service was concerned, the Hearing Officer recorded the applicant's acceptance that certain goods and services were identical between the respective specifications: namely the contested goods in classes 25 and 28 and, in class 35, the services of '*advertising; business management; business administration; office functions*'. The only disputes arose on other services in class 35, in respect of which the Hearing Officer decided as follows, where the respective services or goods are listed applicant's first : *opponent's second in italics*):
 - a. Import and Export Services: *procurement services for others [purchasing goods and services for other businesses]*. The Hearing Officer decided there was no overall similarity, but if she was wrong about that, any similarity was only at a low level.
 - b. Retail sales connected with the sale of [all of the specified goods]: *presentation of goods on communication media, for retail purposes*. The Hearing Officer decided these services were not similar.
 - c. Retail sales connected with the sale of clothing, footwear and headgear: *clothing, footwear, headgear*. The Hearing Officer decided there was a medium degree of similarity.
 - d. Retail sales connected with the sale of various goods [and there followed a list covering almost a page of A4]: *gymnastic and sporting articles not included in other classes*. The Hearing Officer decided there was a medium degree of similarity between these services and goods.

7. On the comparison of the device mark vs BOSCH, the Hearing Officer concluded there was a degree of visual similarity somewhat lower than medium; a low degree of aural similarity; on the conceptual comparison, the parties were agreed that neither word had any meaning, but the device resembled two cherries and was likely to be perceived as such, so to that rather limited extent, it introduced a point of conceptual difference.
8. On the comparison of the two word marks, the Hearing Officer concluded they were visually similar to a medium degree; aurally similar to a low degree; but conceptually, neither mark had a meaning so the position was neutral.
9. The parties were agreed that the average consumer for the goods at issue and for all of the contested retail services is a member of the general public. The Hearing Officer decided that a medium level of attention would be paid to the selection of the goods and the contested retail services. Regarding the services in class 35 of '*advertising; business management; business administration; office functions*', the Hearing Officer decided these were services used by businesses and that businesses or professionals choosing these services would pay a reasonably high level of attention.
10. In respect of all the goods and services, the Hearing Officer decided that all would be purchased primarily by visual means, although her overall analysis in [43] was more nuanced than that brief summary.
11. She found that the earlier mark had a high level of inherent distinctiveness.
12. With all those factors in mind, the Hearing Officer concluded there was no likelihood of confusion for either of the marks applied for.
13. I need not detail the Hearing Officer's findings on the section 5(3) grounds of opposition, because there is no appeal against her rejection of those grounds.
14. Overall, therefore, the Hearing Officer rejected both Oppositions.

The Appeal in outline

15. On this Appeal, it is fair to say that the Appellant's central challenge was to the Hearing Officer's comparison of the marks. The Appellant also challenged the

findings on similarity of goods and services which I have listed above at paragraphs 6.b and 6.d above but realistically accepted that these points would only make a difference if I was persuaded the Hearing Officer's comparison of the marks was wrong. Her assessment of the likelihood of confusion was alleged to be wrong based primarily on her comparison of the marks, but the Appellant also alleged her conclusion on likelihood of confusion was largely based on an aural comparison which was in contradiction to her finding in [43] that the visual impact will have a higher impact.

16. The hearing of the Appeal took place by videolink on 7th April 2020. Mr David Gill (of WP Thompson) appeared for the Appellant and Ms Charlotte Blythe, instructed by Potter Clarkson LLP, appeared for the Respondent. I am grateful to both sides for their skeleton arguments and succinct oral submissions.

Standard of appeal

17. This appeal is by way of review of the Hearing Officer's decision. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The relevant principles were set out in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC sitting as the Appointed Person at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch). Mr Alexander QC said in particular that:

“... In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF*, *BUD*, *Fine & Country* and others).”

18. Subsequently, the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 dealt with the role of the appellate court at [78] to [81]. Lord Hodge said:

“78. ... Where inferences from findings of primary fact involve an evaluation of numerous factors, the appropriateness of an intervention by an appellate court will depend on variables including the nature of the evaluation, the standing and experience of the fact-finding judge or tribunal, and the extent to which the judge or tribunal had to assess oral evidence: *South Cone Inc v Bessant*, *In re Reef Trade Mark* [2002] EWCA Civ 763; [2003] RPC 5, paras 25-28 per Robert Walker LJ.

...

80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge’s conclusions of primary fact but with the correctness of the judge’s evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge’s conclusion is outside the bounds within which reasonable disagreement is possible. ...

81. Thus, in the absence of a legal error by the trial judge, which might be asking the wrong question, failing to take account of relevant matters, or taking into account irrelevant matters, the Court of Appeal would be justified in differing from a trial judge’s assessment of obviousness if the appellate court were to reach the view that the judge’s conclusion was outside the bounds within which reasonable disagreement is possible. It must be satisfied that the trial judge was wrong ...”

19. In relation to appeal from a Hearing Officer who has assessed the likelihood of confusion for an opposition based upon section 5(2)(b) of the Act, Mr Iain Purvis QC sitting as the Appointed Person in *Rochester* BL O/049/17 said at [33]:

“... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test ‘likely to cause confusion amongst the average consumer’ is inherently imprecise, not least because the average consumer is not a real person.

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals

with far more cases on a day-to-day basis than the Appellate tribunal.

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. ... Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.”

20. I have kept these principles in mind on this appeal.

Comparison of the marks.

21. It is sufficient to consider the comparison between the two word marks: BOSCH and BOSCO.

The Hearing Officer's analysis

22. In order to evaluate the Appellant's criticisms, it is necessary to set out the key parts of the Hearing Officer's reasoning concerning the comparison. Having directed herself appropriately by reference to *SABEL v Puma* and *Bimbo v OHIM*, the Hearing Officer summarised her approach as follows:

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

23. She analysed the marks and assessed the degrees of similarity in the following way. In this section of her decision, the comparison of the two word marks and the comparison of the device mark and work mark are intermingled. Although nothing turns on that, I need to pick up part of her comparison of device : word (in italics), because she clearly had that in mind when considering just the two word marks:

“48. The opponent's position is that there is a high degree of visual similarity between the respective marks and a low degree of aural similarity. The applicant's position is that visual and aural similarity between the marks is at best limited and that the device in the contested figurative mark adds a point of visual and conceptual difference.

49. The earlier mark consists of the word “BOSCH”, presented in capital letters. The overall impression of the mark is contained in that word.

51. The contested word mark is the word “BOSCO”, in which the overall impression rests.

....

52. Considering the position in relation to the contested figurative mark first, both marks begin with the letters ‘BOSC’. The final letters are ‘H’ and ‘O’ which bear no visual resemblance to one another. Although differences at the end of marks tend to have less impact, it is also important to bear in mind the relative shortness of the words, at only five letters long.(emphasis added).

....

55. The contested word mark shares with the earlier trade mark the first four of its five letters. The only point of visual difference is the final letter “O”, as contrasted with the “H” of the earlier mark. The marks are visually similar to a medium degree.

56. Aurally, the position is identical to that described above, namely that there is a low degree of aural similarity.

57. Conceptually, neither mark has a meaning and the position is neutral.”

24. Later in her decision, the Hearing Officer summarised these findings when she came to consider the likelihood of confusion. In view of one of the main arguments presented by the Appellant, I set out her summary with the key sentence underlined. (The passage which I have italicised is referred to later in my decision):

“60. I will consider first the position for the contested word mark. The opponent’s strongest case lies with the identical goods which are selected with a medium level of attention. The respective marks have a medium degree of visual similarity, a low degree of aural similarity and are conceptually neither similar nor dissimilar. *The goods and services are all subject to a purchasing process which is mainly visual and it is, therefore, the visual similarity between the marks which carries the greatest weight in the comparison.* Nevertheless, my view is that despite the high level of distinctiveness of the earlier mark and the levels of similarity between the marks and the respective goods and services, the consumer will not be directly confused. Even though the difference is at the end of the marks, a position which ordinarily has less impact than the beginning, that is offset by the shortness of the marks. I have not overlooked the impact of imperfect recollection but my view is that the differences between the marks are sufficient, notwithstanding the other factors outlined above, to avoid the consumer mistaking one mark for the other where the goods are purchased with a medium level of attention.”

The Appellant’s arguments in summary

25. The Appellant attacked the Hearing Officer’s comparison of the marks principally on the basis that she had incorrectly applied a test for short marks to these five-letter words. The Appellant contended that this test for short marks is consistently applied in UK and EU case law. It developed the point in this way in its Skeleton Argument:

‘9. The test for the comparison of short signs is to be applied in those cases in which the number of letters is so limited that one different letter could be sufficient for the signs in comparison to generate an overall different impression on the average consumer. The underlying reason for this test is that a single letter can be considered to constitute a large portion of a two or three letter word. That is not the case for five letter words, where one single letter is a relatively small portion of the whole sign and so a difference of one letter is therefore unlikely to offset the similarity between the other four; particularly when these four comprise the same consecutive letters in the signs under comparison.’

26. In essence, the Appellant submits that where two trade marks sharing, in exactly the same order and position, four out of five letters, and differing only in their respective final letters, they cannot be assessed as having only a medium degree of visual similarity (which is what the Hearing Officer found), and they cannot be assessed as visually similar to anything less than a high degree.

27. The Appellant argues that this error also infected the aural comparison. It asserts that *‘minor differences have been given a disproportionate importance due to the application of the wrong test.’*

28. Finally, the Appellant sought to bolster these submissions by arguing that her finding that there was no likelihood of confusion despite there being goods which were identical or highly similar must mean that she had applied the (wrong) test for short marks and had wrongly identified the applicable law for this case.

29. In support of its central proposition, namely, that there is a special test for ‘short’ marks, the Appellant cited one General Court decision: T-241/16 *El Corte Ingles* in which the marks were ‘WE’ and ‘EW’ (figurative), and one UK IPO decision, O-236-18 TSS FACILITIES where the marks in question were these figurative marks:



30. So far as the UK IPO decision is concerned, the Hearing Officer in that case, Mrs Teresa Perks made no reference to a specific test for short marks, although her comparison of the two marks did include these observations:

“62.Small differences can indeed make a striking difference in short marks. That process is aided in this case by the fact that the difference occurs at the start of the three letter combination.”

31. To my reading of her decision, these observations did not recognize any specific test for short marks. Instead, they were entirely common sense observations apposite to that case.

32. The decision of the General Court in T-241/16 *El Corte Ingles* seems initially more promising from the Appellant’s point of view. The General Court stated:

“35 It must be observed that, when faced with short signs, the relevant public is likely to perceive the differences between them more clearly (see, to that effect, judgment of 3 December 2014, *Max Mara Fashion Group v OHIM — Mackays Stores (M & Co.)*, T-272/13, not published, EU:T:2014:1020, paragraph 47 and the case-law cited). In the present case, there are differences between the sign at issue inasmuch as, first, the letters ‘w’ and ‘e’ are not arranged in the same order and, secondly, although the typeface used in the mark applied for is indeed banal, it is, however, necessary to note the interconnection in the upper part of the letters ‘e’ and ‘w’ which, though barely visible, nevertheless strengthens the impression that the mark applied for forms a single syllable and an indivisible whole.”

33. However, the notion that this evidences a special test for short marks starts to unravel when one tries to find the basis for it.

34. In the case cited, T-272/13 *Max Mara*, the marks being compared were these:

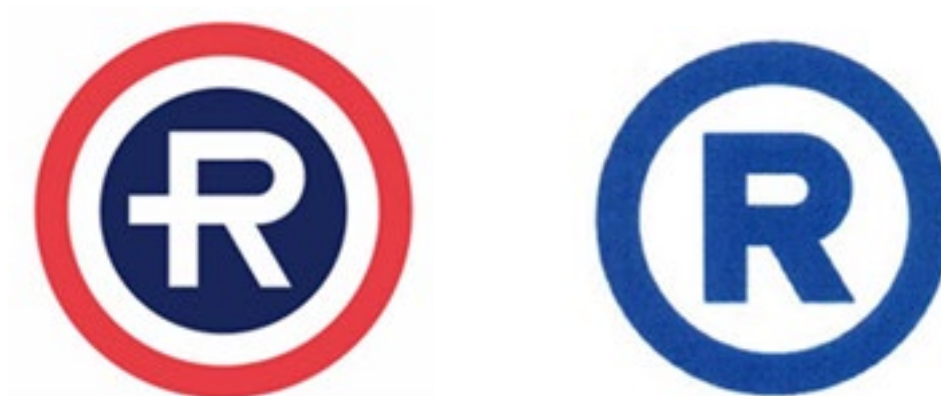
M&Co. MAX&Co.

35. The cited paragraph 47 reads as follows

“47 The Court must observe, as OHIM did, that is precisely because the signs are short that the relevant public will perceive the differences between them more clearly (judgment in R, EU:T:2013:335, paragraph 37). In the present case, it is the

letters ‘ax’ in the earlier signs which differentiate the signs visually, phonetically and conceptually.”

36. Following the thread back to T-89/12, R, the marks being compared were:



37. In that context, the cited paragraph 37 reads:

“37 It follows from the foregoing that, despite the similarities between the signs at issue, the differences between those signs will be more easily perceived by the relevant public and that the marks at issue are only similar. Therefore, the Board of Appeal was wrong to conclude that the marks at issue were very similar visually.”

38. In my view, it is clear that none of these cases establish any sort of special test for short marks. The point is a common sense one – that if marks differ e.g. by one letter, the difference may have a greater impact in marks which consists of two letters than four etc. But every comparison must be conducted according to the approach laid down in the CJEU case law and every comparison will depend on its own facts.

39. Ms Blythe for the Respondent drew my attention to the Decision of the Appointed Person, Iain Purvis QC, in *ELLA TM* (O-277-12). In that case, where the earlier mark was ELLE, the Appointed Person was faced with the proposition that ‘*short marks differing in only one letter cannot have a high degree of visual similarity*’. This proposition was derived from this paragraph in the decision of the General Court in T-112/06 *Inter-Ikea Systems BV v OHIM*, where the marks in question were IKEA and IDEA:

‘54. As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter ‘d’ in the contested mark and the letter

‘k’ in the earlier word marks. However, the Court has already held in Case T-185/02 *Ruiz-Picasso and Others v OHIM – DaimlerChrysler (PICARO)* [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.’

40. The marks being compared in case T-185/02 were, of course, PICASSO and PICARO. Paragraph 54 that case actually reads as follows:

‘54. As regards visual and phonetic similarity, the applicants rightly point out that the signs at issue each consist of three syllables, contain the same vowels in corresponding positions and in the same order, and, apart from the letters ‘ss’ and ‘r’ respectively, also contain the same consonants, which moreover occur in corresponding positions. Finally, the fact that the first two syllables and the final letters are identical are of particular importance. On the other hand, the pronunciation of the double consonant ‘ss’ is quite different from that of the consonant ‘r’. It follows that the two signs are visually and phonetically similar, but the degree of similarity in the latter respect is low.’

41. As Mr Purvis QC noted, the General Court in *Ruiz-Picasso*:

“(a) did not give any direction, or even guidance, on the subject of ‘*word marks which are relatively short*’;

(b) did not find that in the case of marks (short or not) which differed by no more than a single consonant ‘*it cannot be found that there is a high degree of visual similarity between them*’

(c) did not find even in the case of the marks before it (PICASSO and PICARO) that there was not a high degree of visual similarity (as opposed to aural similarity).

18. How the General Court in *Inter-Ikea* came to make an entirely erroneous characterization of this passage in *Ruiz-Picasso* is a mystery to me, but it should be noted for future reference that it is erroneous and should not therefore be followed.’

42. Although there was a further appeal to the CJEU, case C-361/04, in which paragraph 54 was considered, none of the four pleas in law were directed to the issue of the visual comparison. In so far as the Court made reference to the comparison of marks, the CJEU simply referred to *SABEL*, para 23.

43. All the cases to which I have made reference on this topic establish that there are no special tests which apply to ‘short’ marks – whatever falls within the supposed category of ‘short’ marks. In reality, the tribunal simply has to apply the well-

established propositions for assessing the visual, aural and conceptual similarities. In my view, that is precisely what the Hearing Officer did in this case.

44. To summarise therefore:

- a. There is no special test which applies to the comparison of ‘short’ marks. Their visual, aural and conceptual similarities must be assessed in the normal way – see *SABEL*, paragraph 23. The Hearing Officer directed herself entirely appropriately by reference to *SABEL* and *Bimbo v OHIM*.
- b. In any event, the criticism of the Hearing Officer in this case, that she had incorrectly applied a test for short marks to these five-letter words, is entirely baseless. The references in her decision to the ‘shortness’ and ‘relative shortness’ of the marks were part of her explanation when she was applying the standard approach to the comparison of marks.

45. The Appellant’s criticisms of the Hearing Officer’s comparison of the marks amounts to nothing more than disagreement with her findings. However, I should point out that the Appellant’s focus on the identity of the first four letters of each mark ignores reality. Underlying the Hearing Officer’s analysis is the notion that the earlier mark BOSCH is a single syllable word pronounced ‘BOSH’ and the mark applied for is perceived and pronounced as ‘BOS-CO’. I am unable to detect any error, let alone a material error, in the Hearing Officer’s reasoning on either visual or aural similarity. Accordingly I reject this ground of appeal.

Comparison of the goods and services

46. Notwithstanding the fact that the issues on Appeal regarding the comparison of goods and services are not determinative, I consider there is one aspect on which it is worth commenting. This aspect involves an issue of somewhat wider import which sometimes arise with long specifications of services in which certain terms, if read literally, do not make a lot of sense and require a degree of interpretation.

47. This issue arises on each of the Applicant’s services listed in paragraphs 6.b, 6.c and 6.d above. Take the services in the first two of those sub-paragraphs: ‘Retail sales connected with the sale of [all of the specified goods] and ‘Retail sales connected with the sale of clothing, footwear and headgear’. Read literally, these

specifications cover the retail sale of anything provided it has some connection with the sale of e.g. clothing. In a large department store which sold clothing along with a very wide range of other goods, this could cover the full range of goods sold in that department store. Such a specification would be absurdly broad and extremely vague. I am reminded of the guidance of Jacob J (as he then was) in *Avnet Incorporated v Isoact Ltd*, [1998] FSR 16:

"... definitions of services are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as "boots and shoes".

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

48. In my view, these example specifications have to be interpreted restrictively. There are probably two possibilities: "Retail sales in connection with the sale of clothing, footwear and headgear" could mean either (i) the retail sale of accessories to clothing, footwear and headgear (e.g. spare buttons, zips, shoe polish, shoe horns, and the like) or (ii) the *retail* sale of clothing, footwear and headgear (i.e. not wholesale). I incline to the latter interpretation, not least because if someone wants to claim protection over accessories for clothing, footwear etc., it is very easy to say so.

49. As mentioned above, the Appellant challenged the Hearing Officer's findings which I have summarized at paragraphs 6.b and 6.d above. In view of my conclusion on the main ground of appeal (which I have considered above) I will not lengthen this decision by examining the criticisms in detail. Suffice to say I was not persuaded that the Hearing Officer had committed any error.

Likelihood of Confusion

50. Aside from its criticisms directed to the assessment of similarity (dealt with above), the only separate criticism the Appellant levels at the finding of no likelihood of confusion is its contention that the Hearing Officer contradicted herself. It is said that in [43] she correctly agreed that the visual aspect will have a higher impact on the average consumer, but when it came to her assessment of the likelihood of

confusion, the Hearing Officer wrongly considered the marks dissimilar largely based on the aural comparison. Although this point was set out in the Grounds of Appeal and Skeleton Argument, it was not pursued in oral submissions but I will deal with it for completeness. The passage italicized from [60] of the Hearing Officer's decision, set out above at paragraph 24 above, demonstrates there is absolutely nothing in this point.

51. Perhaps implicit in the Appellant's arguments is a contention that, where certain goods are identical, the earlier mark has a high degree of inherent distinctiveness, both marks share the first four letters and differ only in the final letter, the end result of no likelihood of confusion must be wrong. For this reason I have stood back from the detail and considered whether the Hearing Officer's conclusion on the lack of a likelihood of confusion could be said to be plainly wrong. To do this, one has to examine the factors taken into account when making the global assessment of the likelihood of confusion. In this case it is not suggested that the Hearing Officer took into account any factors she should not have. As for the factors she did take into account, clearly the visual and aural comparison of the marks was a critical factor, but the Hearing Officer was obliged to take into account both the degree of those similarities and the differences which impact on the average consumer. As recognized in the Appellant's arguments, the assessment of the degrees of visual and aural similarity were critical in this case. Since I was unable to find any error in the Hearing Officer's analysis on those issues, in this case, it must follow that I am wholly unable to conclude her finding on the likelihood of confusion was wrong. On the contrary, I agree with it.

52. For all these reasons, I dismiss the Appeal.

Costs

53. The Hearing Officer made an award of £1,600 as a contribution towards the costs of the Applicant. So far as the costs of the Appeal are concerned, I order the Appellants to pay £800 by way of contribution to the costs incurred by the Respondent/Applicant in dealing with this Appeal.

54. Therefore, the Appellant/Opponent must pay to the Applicant or its representatives the total sum of £2,400 (being the combination of the award made by the Hearing

Officer and my award in respect of the Appeal) on or before Wednesday 17th June 2020.

JAMES MELLOR QC

The Appointed Person

1st June 2020