

O-426-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3022779
FOR THE TRADE MARK

LIGHT BRONTE

IN THE NAME OF BANNOLD SUPPLIES & SERVICES LTD T/A 'BANNOLD'

AND

OPPOSITION THERETO UNDER NO 401495
BY BRETT LANDSCAPING LIMITED

Background

1. On 2 October 2013, Bannold Supplies & Services Ltd t/a 'Bannold' ("the applicant") applied to register the trade mark LIGHT BRONTE in respect of the following specification of goods:

Class 19

Paving stone;Paving blocks;Paving stones;Paving tiles;Paving;Paving blocks made of non-metallic materials;Paving made of non-metallic materials;Paving products (non-metallic-);Paving slabs, not of metal;Paving blocks, not of metal.

2. The application was published in the *Trade Marks Journal* 2013/041 on 11 October 2013, following which notice of opposition was filed by Brett Landscaping Limited ("the opponent").

3. The opposition is based on a single ground brought under the provisions of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). In support of this ground, the opponent relies on the following registration:

Registration No and Mark	Dates	Goods
2109179 BRONTE	Filing date: 4 September 1996 Date of entry in register: 7 March 1997	Class 19: Building materials; building blocks and building bricks; paving materials; paving blocks, slabs, stones and tiles; cement for building and mixes for making concrete.

4. The applicant filed a counterstatement in which it stated its case in the following terms:

"The opponents product is manufactured and bares no resemblance. Our product is a natural stone with a differing name 'LIGHT BRONTE'".

5. The opponent's mark is an earlier mark within the meaning of the Act. In its counterstatement, the applicant indicated that it did not require the opponent to prove the use of its mark. The opponent is therefore entitled to rely on its earlier mark in respect of all the goods for which it is registered.

Decision

6. The opposition is founded on an objection under section 5(2)(b) of the Act which states:

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

(a)

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

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

7. 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, in certain circumstances, 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 causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.”

8. Taking the above case law and principles into account, the test I have to apply in considering an objection under section 5(2)(b) is whether there are similarities in the respective marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

Comparison of goods

9. The General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05, said:

“...goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application...”

10. As set out above, in its counterstatement the applicant makes the comment that the opponent’s product is a manufactured one whereas its own product is natural stone. Whilst this may be true, the comparison I have to make is between the goods of the earlier mark as registered and the goods as set out in the specification of the application. Each of the goods within the application are paving materials which is a term which is included within the specification of the opponent’s earlier mark. The goods are therefore identical in line with *Merica*.

The average consumer and the nature of the purchasing process

11. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the

manner in which these goods are likely to be selected by the average consumer in the course of trade.

12. The respective goods are materials used in the construction of paving. They are goods which will be used by those in the building industry as well as by those members of the general public who have the skills or inclination to perform DIY. They are goods which are widely available from specialist building supply stores as well as DIY stores. The cost of the goods is likely to vary depending on e.g. the material from which they are made and size. The average consumer will take a reasonable but not the highest degree of care over the purchase to ensure the product is suitable for the application intended and is e.g. of suitable material, colour form etc.

Comparison of marks

13. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

14. For ease of reference, the marks to be compared are:

Earlier mark	Application
BRONTE	LIGHT BRONTE

The earlier mark consists of the single word BRONTE. As a single word, no part of which is emphasised or highlighted in any way, its distinctiveness rests in its whole. The word Bronte is a relatively uncommon surname but I have no evidence that it has any meaning in relation to the goods for which it is registered thus it creates a mark with an average degree of distinctiveness in relation to those goods. The applicant's mark consists of the two words LIGHT and BRONTE. The word LIGHT is an adjective and is commonly used to describe goods which are intended to be a less heavy or less darkly coloured version of something. The respective marks are highly similar from the visual, aural and conceptual perspectives.

Distinctiveness of the earlier mark

15. I must also assess the distinctive character of the earlier mark which can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other

undertakings – *Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

16. The opponent has not filed any evidence to show what use it may have made of the earlier mark. I am therefore unable to find that its distinctiveness has been enhanced through use. As indicated above, it is a mark with an average degree of inherent distinctive character.

Likelihood of confusion

17. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby 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. I also have to factor in the distinctive character of the earlier mark as the more distinctive it 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 on the imperfect picture of them he or she has retained in mind.

18. I have found that the respective goods are identical and the respective marks highly similar, differing only in respect of a word which is likely to be seen as descriptive and indicating a lighter version of the main product. Taking all matters into account, I have no hesitation in finding that there is a likelihood of direct confusion in respect of all goods of the application.

Summary

19. The opposition brought under section 5(2)(b) succeeds in full.

Costs

20. The opponent having succeeded is entitled to an award of costs in its favour. I take note that the opposition was brought under a single ground, that neither side filed evidence though the opponent did file written submissions and that no hearing took place. Taking all matters into account, I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Filing written submissions:	£300
Total:	£700

21. I order Bannold Supplies & Services Ltd t/a 'Bannold' to pay Brett Landscaping Limited. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of October 2014

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