

O-464-13

TRADE MARKS ACT 1994

In the matter of application no 2604205 by

Kulbinder Singh

to register the trade mark:



and the opposition thereto under no 103509 by

The Last Hero SL

1) On 12 December 2011 Kulbinder Singh applied to register the trade mark:



The application was published on 23 March 2012 with the following specification:

scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission and/or reproduction of sound or images or other data; recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment; fire-extinguishing apparatus; apparatus, instruments and materials for transmitting and/or receiving and/or recording sound and/or images; computers, tablet computers, computer terminals, computer peripheral devices; computer hardware; computer networks; facsimile machines, answering machines, telephone-based information retrieval hardware; adapters, adapter cards, connectors and drivers; blank computer storage media; fonts, typefaces, type designs and symbols in the form of recorded data; random access memory, read only memory; solid state memory apparatus; electronic communication equipment and instruments; telecommunications apparatus and instruments; telecommunications equipment, apparatus and instruments; computer hardware apparatus with multimedia and interactive functions; microprocessors, memory boards, monitors, displays, keyboards, cables, modems, printers, videophones, disk drives; central processing units; circuit boards; integrated circuits; computer memory devices; blank computer storage media; solid-state data storage devices; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; apparatus for data storage; hard drives; miniature hard disk drive storage units; pre-recorded vinyl records; batteries; rechargeable batteries; chargers; chargers for electric batteries; headphones; stereo headphones; in-ear headphones; stereo speakers; audio speakers; audio speakers for home; monitor speakers; speakers for computers; personal stereo speaker apparatus; radio receivers, amplifiers, sound recording and reproducing apparatus, electric phonographs, record players, high fidelity stereo apparatus, tape recorders and reproducing apparatus, loudspeakers, multiple speaker units, microphones; digital audio and video players with multimedia and interactive functions; accessories, parts,

fittings, and testing apparatus for all the aforementioned goods; digital audio and video devices; audio cassette recorders and players, video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players; radios; audio, video, and digital mixers; radio transmitters; car audio apparatus; global positioning systems; navigation apparatus for vehicles (on board computers); cameras; video cameras; telephones; cordless telephones; mobile telephones; digital music and/or video players; MP3 and other digital format audio players; hand held computers, personal digital assistants, electronic organizers, electronic notepads; global positioning system (GPS) devices, telephones; handheld and mobile digital electronic devices for the sending and receiving telephone calls, faxes, electronic mail, and other digital media; manipulating, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multi-media content, software featuring musical sound recordings, entertainment-related audio, video, text and multi-media content, computer software and firmware for operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; magazines, general interest; computer hardware and software for providing integrated telephone communication with computerised global information networks; electronic handheld devices for the wireless receipt, storage and/or transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information; software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; computer software for the synchronization of data between a remote station or device and a fixed or remote station or device; sound effect apparatus and instruments (computer software); electronic tone generators (computer software); computer desktop utility software; screen saver software; software for detecting, eradicating and preventing computer viruses; software for data encryption; software for analysing and recovering data; software for computer system backup, data processing, data storage, file management and database management; software for telecommunication and communication via local or global communications networks, including the Internet, intranets, extranets, television, mobile communication, cellular and satellite networks; software for creating and delivering electronic greeting cards, messages and electronic mail; software for web design, creation, publishing and hosting; software for access to communications networks including the Internet; instructional material relating to the foregoing; computer disk holders; computer

equipment for use with all of the aforesaid goods; testing apparatus for all the aforesaid goods;

book binding material; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters plastic materials for packaging (not included in other classes); printers' type; printing blocks; paint boxes for children;

whips, harness and saddlery; walking stick seats; mountaineering sticks;

furniture; office furniture; dressing tables; easy chairs; beds and water beds, bedsteads; furniture screens; armchairs; baskets, not of metal; benches [furniture]; cabinet work; cabinets; carts for computers [furniture]; corks; hairdresser's chairs, deck chairs; desks; tables, dinner wagons [furniture]; head-rests [furniture]; divans; library shelves; lockers; locks [other than electric], not of metal; racks [furniture]; saw horses; school furniture; seats; sofas; tea carts; umbrella stands; cots; cupboards; display boards; dressing tables; footstools and stools; shelves; air mattresses; bed fittings, not of metal; curtain holders; curtain hooks; curtain rails; curtain rings; curtain rods; curtain rollers; towel dispensers; mattresses; clothes hooks and coat hangers; coat stands; hat stands; ladders of wood or plastics; door fittings; embroidery frames; statues of wood, wax, plaster or plastic; fire screens; containers, not of metal (storage, transport); storage tanks [not of metal or masonry], containers for transport [not of metal], index cabinets; containers of plastic for packaging purposes; shopping baskets; metal-substitute plastic fasteners, nails, wedges, nuts, screws, tacks, bolts, rivets and casters [not of metal], door stops; infant walkers; playpens for babies; mobiles; cots; cradles; cribs; chimes; high chairs for babies; chests; wind chimes; nesting boxes for pets; beds for household pets; nesting boxes for small birds, scratching posts for cats; flower-pot pedestals; flower-stands; trays; wickerwork; decorative edging strips of plastics and/or wood for use with window fittings; step ladders and ladders [not of metal], tool boxes [not of metal], stakes for plants or trees, artificial model food samples, flagpoles, bottle closures; bottle racks; corks for bottles; house numbers, not of metal, non luminous; identity plates, not of metal; letter boxes; letter racks; magazine racks; plate racks; cup racks; tool handles; sealing clips for bags; hand-held flat fans, hand-held folding fans, fans [non-electric]; bamboo curtains; bamboo and bamboo blinds, bead curtains for decoration; bead curtains; blinds; oriental single panel standing partition, hanging boards [Japanese style pegboards using positional hooks], oriental folding partition screens; drinking straws; keyboards for hanging keys; mannequins; drain traps [valves] of plastic; medicine cabinets; pegs (not of metal); pill cases [wood, plastics]; plastic doorknobs; porcelain or earthenware doorknobs; wood doorknobs; doorknob covers; bean bag chairs; garment bags; bathroom stools; bed pads; crib bumpers;

household or kitchen utensils and containers; brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); baby baths [portable]; birdcages; non-electric blenders; ironing

boards; boot jacks; stoppers for bottles made of/from ceramics, china, glass, crystal, earthenware, terra-cotta and porcelain; iron kettles; whisks [non-electric]; rice chests; colanders; stainers; cooking funnels; food preserving jars of glass; cooking graters; chopstick cases; rolling pins [for cooking purposes]; cooking grills, lemon squeezers [citrus juicers]; cosmetic and toilet utensils; shoe brushes; shoe horns; shoe shine cloths; feeding vessels for pets; brushes for pets; boxes of metal for dispensing paper towels; bird baths; mouse traps; fly swatters; candle extinguishers [not of precious metal]; upright signboards of glass or ceramics; cooking sets for outdoor use consisting of tin cans, tin pans, tin pots and tin plates; buckets; cages for household pets; candle rings; candlesticks; candy boxes; comb cases; chopsticks (cooking utensils); clothes racks; clothing stretchers; cloths for cleaning; cocktail stirrers; coffee filters; coffee grinders; pastry bags; cooking pots; ice pails; portable coolers; champagne buckets; shower caddies, not of precious metal; corn cob holders; covers for flower pots; non-electric deep fryers; drying racks for washing; dustbins; feeding troughs; flower pots; gloves for household purposes; graters; non-electric griddles; heat-insulated containers; heaters for feeding bottles, non-electric; holders for flowers and plants; hot pots; lazy susans; menu card holders; mess-tins; mops; nozzles for watering cans; pads for cleaning; pans; perfume sprayers; perfume vaporizers; picnic baskets; pot lids; pots; pressure cookers; saucepans; scoops; scouring pads; shirt stretchers; shoe trees; stands for shaving brushes; syringes for watering flowers and plants; tea infusers; toilet brushes; toothpick holders, not of precious metal; toothpicks; nail brushes; litter trays; trivets; trouser presses; trouser stretchers; waffle and pancake irons, non-electric; cookery and baking irons, non electric; washing boards; wash tubs; watering cans; watering devices; polishing apparatus and machines for household purposes, non-electric; mouse traps; brooms; cleaning instruments [hand-operated]; clothes-pegs; portable coldboxes, non-electric; eyebrow brushes; frying pans; gardening gloves; powder puffs; multi-purpose linings and sheets for household or kitchen purposes; dusters; cocktail shakers; tissue paper box covers of wood, or plastic; stands for tooth brushes; floss for dental purposes; handles for dental floss; hygienic basins; household containers of precious metal; household utensils of precious metal;

blinds of textile; toilet gloves; napkins for removing make-up; washing mitts; mosquito nets; silk; silk fabrics; upholstery fabrics; wall hangings of textile; textile covers for napkin or tissue holders; door knob covers; toilet seat covers; coverings for lids for toilet vessels; cotton fabrics; fabrics for textile use; felt; frieze [cloth]; hemp fabric; velvet; woollen cloth; tissue paper box covers of textile; covers of fabric for door knobs; name labels; woven labels; pouches of textile, or of silk, for charms; canopies; cotton, polyester and/or nylon fabric, fabric of imitation animal skins; damask; elastic woven material; silk fabrics for printing patterns; printers' blankets of textile; lingerie fabric; jersey [fabric]; fabric impervious to gases for aeronautical balloon;

games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; hand-held computer games equipment not adapted for an external display screen or monitor,

mineral water, spring water, carbonated water, areated water, water, bottled water; non-alcoholic beverages; preparations for making beverages;

telecommunications; cable television broadcasting; television broadcasting; cellular telephone communication; communications by fibre optic networks; communications by telegrams; communications by telephone; providing information on communication by telephones and cellular telephones; computer aided transmission of messages and images; electronic mail; facsimile transmission; radio broadcasting; sending of telegrams; telephone services; television broadcasting; wire service; paging services; providing telecommunications connections to a global computer network; providing user access to a global computer network (service providers); telecommunications routing and junction services; electronic bulletin board services and providing information thereon; teleconferencing services; communication by consumer video game apparatus; providing information on communication by consumer video game apparatus; communication by arcade video game machines; providing information on communication by arcade video game machines; communication by handheld game apparatus; providing information on communication by handheld game apparatus; communication by messages and pictures by using computers; telecommunication (other than broadcasting); broadcasting; news agencies; rental of telecommunication equipment including telephones and facsimile apparatus; rental of modems; message sending; news agencies; satellite transmission;

scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services; computer services, development of computer software and the Internet; computer network services; installation and maintenance of computer software; writing, development, updating and design of computer software; consultancy, planning and design services all relating to telecommunications networks, apparatus and instruments, computers, computer networks, computer programmes, computer databases, computer networking, and to the Internet; computer systems integration services; hosting the web sites of others; hosting software applications for others; security services relating to computerised data; design information systems relating to finance and to management; consultation services rendered in connection with communication services and the delivery of data, voice, image and information by electronic transmission and related services rendered to customers in order to enable the customers to utilize the transmission services all included in Class 42;

services for providing food and drink; temporary accommodation; Accommodation and catering for guests; restaurants; cafés; caterias; bars; canteens; catering services; self-service restaurants; snack bars; cocktail lounges; providing of information in relation to food and drinks; provision and reservation of temporary accommodation and lodging facilities, hotels, motels, boarding houses and the provision of information thereto; holiday camp services; restaurants, cafés, caterias, bars, food halls, canteens and lounges installed with audio and visual apparatus with sing along devices; child-care services; day-nurseries; tourist homes; bar services, arranging of wedding receptions; providing facilities for exhibitions.

The above goods and services are in classes 9, 16, 18, 20, 21, 24, 28, 32, 38, 42 and 43 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) The Last Hero SL (Last Hero) filed a notice of opposition to the registration of the trade mark. It bases its opposition on sections 3(6), 5(1) and 5(2)(b) of the Trade Marks Act 1994 (the Act). Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Last Hero claims that Mr Singh has adopted and applied to register the trade mark in the United Kingdom knowing that it did not belong to him at the time of the filing of the application. It claims that the specification applied for is “unjustly” wide and that Mr Singh has no bona fide intention to use the trade mark on all of the goods and services of the application nor does he have the capacity to do so. Last Hero claims that “it is the applicant’s intention to seek a broad monopoly of the trade mark”. Last Hero claims that the applicant is using and/or allowing others to use the trade mark, knowing that the mark belongs to another proprietor. It claims that these actions fall short of the standards of acceptable commercial behaviour. Last Hero claims that a simple check of the Community trade mark register would have alerted Mr Singh to the earlier registered trade mark rights.

3) Sections 5(1) and 5(2)(b) of the Act state:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a)

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

In relation to sections 5(1) and 5(2)(b) of the Act, Last Hero relies upon two Community trade mark registrations of the same trade mark:



Registration no 9203407 was filed on 25 June 2010¹ and the registration procedure was completed on 10 December 2010. It is registered for the following goods:

paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; picture postcards; transfers (decalcomanias); stickers; engravings; posters; posters; document files, advertisement boards of paper or cardboard; drawings; cards; tokens; graphic reproductions, plastics for modelling; printed and embossed matter,

leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; handbags; portfolio bags; change purses; rucksacks; beach bags; bags; haversacks; Attaches; travelling bags;

clothing, footwear, headgear.

The above goods are in classes 16, 18 and 25 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

¹ With an international priority date of 8 February 2010.

Registration no 9629461 was filed on 7 March 2011 and the registration procedure was completed on 25 September 2011. It is registered for the following goods and services:

bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices;

scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers, recording discs; Automatic vending machines and mechanisms for coin-operated apparatus; Decorative magnets; Cash registers, calculating machines, data processing equipment and computers; Fire-extinguishing apparatus;

surgical, medical, dental and veterinary apparatus and instruments, including artificial limbs, eyes and teeth; Orthopedic articles; Condoms; Suture materials;

precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; Jewellery, costume jewellery, precious stones; Key rings; Horological and chromatic instruments;

household or kitchen utensils and containers; Combs and sponges; Brushes; Brush-making materials; Articles for cleaning purposes; Steelwool; Unworked or semi-worked glass (except glass used in building); Chinaware, glassware, porcelain and earthenware not included in other classes;

textiles and textile goods, not included in other classes; Bed and table covers; Towels of textile; Pillowcases; Cushion covers; Bath linen (except clothing);

games, toys, and playthings; Gymnastic and sporting articles not included in other classes; Christmas tree decorations; Plush stuffed animals;

tobacco; Smokers' articles; Matches; Lighters;

advertising; Business management; Business administration; Office functions; Retailing and wholesaling via global computer networks of the following goods: bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or

images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin-operated apparatus, decorative magnets, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus, surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth, orthopedic articles, condoms, suture materials, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, key rings, horological and chronometric instruments, household or kitchen utensils and containers, combs and sponges, brushes (except paint brushes), brush-making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass (except glass used in building), glassware, porcelain and earthenware, textiles and textile goods, bed and table covers, towels of textile, pillowcases, cushion covers, bath linen, clothing, footwear, headgear, games and playthings, gymnastic and sporting articles, decorations for Christmas trees, plush toys, tobacco, smokers' articles, matches, lighters, goods of paper, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material, plastic materials for packaging, printers' type, printing blocks, postcards, transfers, stickers, prints, posters, document files, advertisement boards of paper or cardboard, graphic prints, cards, index cards, graphic reproductions, plastics for modelling, printed matter, leather and imitations of leather, and goods made of these materials, animal skins and hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, handbags, pocket wallets, purses, backpacks, beach bags, bags, haversacks, briefcases, travelling bags.

The above goods and services are in classes 3, 9, 10, 14, 21, 24, 28, 34 and 35 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

4) In relation to section 5(2)(b) of the Act Last Hero claims that all of the goods and services of the application are similar or identical to the goods and/or services of each of its registrations.

5) Mr Singh filed a notice of defence. In relation to the objection under section 3(6) of the Act Mr Singh asked the registrar to "challenge the basis for this claim". In particular Mr Singh referred to the claim that the application is "unjustly" wide. He states that he clearly has a bona fide intention to use the trade mark on all of the goods and services and that it is not for Last Hero to decide whether he can achieve this or not. (The registrar did not "challenge" the claim, it was a matter for Last Hero to substantiate.) Mr Singh states that the earlier Community trade mark registrations of Last Hero are the subject of a challenge for invalidity or will be challenged in the near future. Mr Singh claims that the earlier registrations are infringing copyright and unregistered trade mark rights which he has owned

for 40 years. Mr Singh denies that the respective trade marks are identical. In relation to section 5(2)(b) of the Act Mr Singh states:

“The 5(2)(b) claims all rest on the Opponent’s mark being found to be superior to the rights of the Applicant, despite the fact that the Applicant and his family have been using the mark for 40 years in the UK. In addition, the goods and services covered by the Opponent’s registered rights do not cover all of the applied for goods and services of the Applicant, yet the Opponent seeks to oppose these at the same time.”

Mr Singh claims that his use of his trade mark and his copyright protection in “the logo itself renders the Opponent’s claim invalid”.

6) Mr Singh claims that Last Hero has been inconsistent in its approach to policing of its I Love London trade marks. He claims that a business partner of his registered a Community trade mark for the same trade mark as the application in class 32 without opposition from Last Hero.

7) A witness statement was supplied by Anne Wong for Last Hero. Ms Wong is the representative for Last Hero. A witness statement was supplied by David Evans for Mr Singh. Mr Evans is the representative of Mr Singh

8) Mr Evans requested a hearing, which took place on 31 October 2013. Last Hero was not represented at the hearing, it did not file written submissions in lieu of attending the hearing.

9) On 26 September 2013 an official letter was sent to Mr Evans in the following terms:

“A hearing is scheduled for these proceedings for 31 October 2013.

It is noted that in the counterstatement no comment is made about the identity and/or similarity of the goods and services. (Nor is there any direct statement in relation to this matter in the witness statement of Mr David Evans.)

In your skeleton argument for the hearing you are directed to identify those goods and services that you consider are **not** similar or identical to the goods and services of the earlier registrations.”

10) The skeleton argument of Mr Evans is reproduced below:

“1. Background to the ownership of the rights in I LOVE LONDON logo

2. Copyright claim in the original I LOVE LONDON logo

3. Analysis of the respective marks

4. Goods and services as they relate to the application and the lengthy dialogue with the UK IPO on this during the initial application

5. With regards to the goods and services of the applicant's mark we would suggest that the following are **not** similar to the Opponent's earlier CTMs:-

Class 09 - Fonts, typefaces, type designs and symbols in the form of recorded data; random access memory, read only memory; electronic communication equipment and instruments; microprocessors, memory boards, monitors, displays, keyboards, cables, modems, printers; blank computer storage media; batteries; rechargeable batteries; chargers; chargers for electric batteries; global positing systems; navigation apparatus for vehicles (on board computers); manipulating, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multi-media content, software featuring musical sound recordings, entertainment-related audio, video, text and multi-media content, computer software and firmware for operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; magazines, general interest; software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; computer software for the synchronization of data between a remote station or device and a fixed or remote station or device; sound effect apparatus and instruments (computer software); electronic tone generators (computer software); computer desktop utility software; screen saver software; software for detecting, eradicating and preventing computer viruses; software for data encryption; software for analysing and recovering data; software for computer system backup, data processing, data storage, file management and database management; software for telecommunication and communication via local or global communications networks, including the Internet, intranets, extranets, television, mobile communication, cellular and satellite networks; software for creating and delivering electronic greeting cards, messages and electronic mail; software for web

design, creation, publishing and hosting; software for access to communications networks including the Internet; instructional material relating to the foregoing; computer disk holders; testing apparatus for all the aforesaid goods.

Class 20 - Entire class specification

Class 28 - hand-held computer games equipment not adapted for an external display screen or monitor.

Class 32 - Entire class specification

Class 38 - Entire class specification

Class 42 - Entire class specification

Class 43 - Entire class specification”

The statement of Ms Wong

11) Virtually all of the statement of Ms Wong consists of submissions rather than evidence of fact. These submissions are considered in coming to a decision and will be referred to if and when appropriate. Ms Wong supports her submissions with exhibits:

AW1 – a page downloaded from the Internet on 15 March 2013 in relation to software which allows a PC to be used as a fax machine.

AW2 – a page downloaded from ikea.com on 15 March 2013 which shows beds, mattresses, bedroom storage, bedroom textiles and rugs and bedroom lighting on the same page.

AW3 – a page downloaded from argos.co.uk on 15 March 2013 which shows blind and curtain accessories, blinds, curtain poles and tracks and curtains on the same page.

AW4 – a page downloaded from euro.dell.com on 15 March 2013 in relation to Dell laptops and computers for home and business.

The statement of Mr Evans

12) Mr Evans’ statement reiterates for the most part what has been stated in the notice of defence. Mr Evans claims that it is Last Hero which has been guilty of bad faith by copying an “existing design which is the subject of copyright protection”. He states that an application has been filed to invalidate Community trade mark -407. Mr Evans accepts that the respective trade marks are similar.

The validity of the earlier trade marks

13) On 29 May 2013 the Cancellation Division of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) rejected the request for a declaration of invalidity against Community trade mark -407 made by Mr Singh. No appeal was lodged against this decision.

14) Under article 99 of Council Regulation (EC) No 207/2009 there is a presumption of validity of a Community trade mark. Consequently, the claims of Mr Singh re the validity of the earlier trade marks of Last Hero are not pertinent to the proceedings. It is a matter of a comparison of the respective trade marks and the respective specifications and making the consequent global appreciation in relation to whether there is a likelihood of confusion.

Section 5(2)(b) of the Act – likelihood of confusion

Identity of trade marks

15) The respective trade marks are:



16) In *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00 the Court of Justice of the European Union (CJEU) considered when trade marks are identical. It stated:

“54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

As well as containing the I ♥ LONDON the earlier trade marks contain the words I LOVE LONDON. This is not an element so insignificant that it will go unnoticed by the average consumer. **The respective trade marks are not identical.**

Similarity of the trade marks

17) Mr Evans accepted that the respective trade marks are similar. The respective trade marks are conceptually identical and visually and aurally similar to a very high degree. The respective trade marks, overall, are similar to a very high degree.

Comparison of goods and services

18) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of tradeⁱ”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaningⁱⁱ. In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch) at paragraph 12 Floyd J stated:

“Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

Consideration should be given as to how the average consumer would view the goods and servicesⁱⁱⁱ. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods and services^{iv}. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^v. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{vi}. Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

“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.”

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 the General Court (GC) explained when goods are complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P

Rossi v OHIM [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48.”

Consideration is also taken into account of the decision of Mr Daniel Alexander QC, sitting as the appointed person, in *Sandra Amalia Mary Elliott v LRC Products Limited* BL O/214/13^{vii}. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 29 the GC stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

19) Mr Evan has only identified some goods and services of the application as not being similar. Consequently, the comparison of the goods and services is to be limited to the goods identified in class 9 and 28 and all of the goods and services in classes 20, 32, 38, 42 and 43.

20) In her witness statement Ms Wong gives no basis for a claim of similarity between the class 32 goods of the application and the goods and services of the earlier registrations. Her analysis is “given the identity or high degree of similarity between the marks, this offsets any difference between the Class 32 goods and those covered by the earlier registrations”. She does not identify any similarities between the respective goods and services. Her analysis is based on the similarity of the trade marks and not on the nature of the goods. The submission is untenable. **There are no coincidences within the context of the case law between the class 32 goods of the application and the goods and services of the earlier registrations; the goods are not similar to the goods and services of the earlier registrations.**

21) Ms Wong’s analysis of the class 43 services of the application is made on the same basis as that in relation to the class 32 goods. **There are no coincidences within the context of the case law between the class 43 services of the application and the goods and services of the earlier registrations; the services are not similar to the goods and services of the earlier registrations.**

22) Hand-held computer games equipment not adapted for an external display screen or monitor will be included in the class 28 specification of -461; which encompasses all types of games, toys and playthings. **Hand-held computer games equipment not adapted for an external display screen or monitor of the application are identical to the class 28 goods of -461.**

23) In relation to the class 38 services of the application, Ms Wong states:

“the services covered by Class 38 overlap in commercial terms with the Class 9 products of the earlier registrations. For example, telecommunications covers the provision of computerized telecommunications. These services are similar with goods such as computers, data processing equipment and apparatus for recording, transmission or reproduction of sounds and images.”

Ms Wong does not actually explain how the goods and services are similar. However, it is common for telecommunication companies to provide telecommunication equipment; which is encompassed by the term *apparatus for recording, transmission or reproduction of sound or images*. The users of the respective goods and services will be the same, people wishing to communicate be telecommunications. The channels of trade may be the same eg mobile telephone shops. The respective goods and services have a symbiotic and mutually dependent relationship, telecommunication services cannot function without the equipment. The same sort of link also relates to such services as *television broadcasting* and *providing user access to a global computer network*; where broadcasters provide equipment such as set top boxes and routers and the equipment is essential to make use of the service. Television, telephone and ISP services are also commonly bundled by one provider, creating a common channel of trade with the goods which give access to the services. Information services linked to such services will be closely linked to the services and the goods that allow access to the services. The rental of equipment will be the rental of the goods of the earlier registration and will coincide in terms of similarity with the services referred to above. All of the class 38 services of the application will all fall within the parameters of the similarities identified above. **The class 38 services of the application are similar to a reasonably high degree to *apparatus for recording, transmission or reproduction of sound or images* of the earlier registration.**

24) In relation to the class 42 services of the application Ms Wong states:

“the services covered by Class 42 overlap in commercial terms with the Class 9 products of the earlier registrations. For example, scientific services are very closely related to scientific apparatus and instruments.”

She also states:

“Computer and computer software related services which is the vast majority of the Class 42 specification are highly similar to computers, data processing equipment and apparatus for recording, transmission or reproduction of sound or images in Class 9.”

In relation to the first argument of Ms Wong, the use of scientific equipment by scientific services does not make them similar; no more than the use of glasses by bars makes them similar to bar services. The end user of scientific equipment is a scientist; the end user of the services is someone who wants the user of the equipment to supply a service, it is not the same end user. As an example, the person who wants a metal tested is not the same person who tests the metal and the commissioner of the service is unlikely to be aware of, or interested in, the equipment that the tester uses. There is nothing to suggest that the services and goods will follow the same channel of trade; the nature of the goods and services suggests that they will exist in very different channels of trade. It is unlikely that the customer of a scientific service will purchase scientific equipment as an alternative to using the service; owing to the requirement for expertise. The respective services are not fungible, they are not in competition. That the goods may be used in relation to the services does not make them complementary, just as glasses were not considered to be complementary to wines (see *Assembled Investments (Proprietary) Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-105/05* and *Waterford Wedgwood plc v Assembled Investments (Proprietary) Ltd and Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07 P*). Owing to the nature of the goods and services, the average consumer will not believe that the respective goods and services emanate from the same undertaking; indeed, the average consumer of the services is unlikely to even know about the goods used to effect the services. **The reasoning applies to the following services of the application:**

scientific and technological services and research and design relating thereto; industrial analysis and research services; design services; design information systems relating to finance and to management.

The above services are not similar to the goods and services of the earlier registrations.

25) The other class 42 services of the application relate to computer services or telecommunication services. The goods of -461 include *data processing equipment and computers*. As referred to above, it also includes *apparatus for recording, transmission or reproduction of sound or images* which encompasses telecommunications equipment. The goods of the earlier registration do not include computer software, only hardware. The maintenance of computer hardware is in class 37, the maintenance of computer software is in class 42.

26) A number of the services in the application although using computers and being accessed by computers and being computer based, do not have material similarities with the class 9 goods of -461 of upon which Ms Wong relies:

design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; hosting the web sites of others; hosting software applications for others; security services relating to computerised data.

Other than that the goods use computers they do not coincide in anyway, within the parameters of the case law, with the class 9 goods of -461. **The aforementioned services are not similar to the goods and services of the earlier registrations.**

27) *Computer consultancy services* and *computer services* are wide terms. The former term will encompass advice and information in relation to computer hardware and the latter term will include such things as the rental of computers and well as the former services. The end users of the services will be the same persons as those buying computers; the suppliers of computer hardware will invariably give advice in relation to the use and purchase of the computers. Websites of such providers will normally have a help section and purchasers will often be able to seek advice through the website in relation to hardware that has been purchased. The rental of computers will be in direct competition with the sale of computers. ***Computer consultancy services and computer services are similar to the class 9 goods of -461.***

28) The remaining class 42 services:

design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; development of computer software and the Internet; computer network services; installation and maintenance of computer software; writing, development, updating and design of computer software; consultancy, planning and design services all relating to telecommunications networks, apparatus and instruments, computers, computer networks, computer programmes, computer databases, computer networking, and to the Internet; computer systems integration services; consultation services rendered in connection with communication services and the delivery of data, voice, image and information by electronic transmission and related services rendered to customers in order to enable the customers to utilize the transmission services all included in Class 42

owing to their connection and association with computer hardware and telecommunications equipment have a very limited degree of similarity with the class 9 goods of -461.

29) In relation to the class 20 specification of the application, Ms Wong states:

“Class 20 – the goods covered by the opposed application in Class 20 are very similar to those of the earlier registrations. Products such as furniture, beds, mattresses sofas, divans and tables are similar to goods such as textiles, bed covers and cushions covers in Class 21 of the earlier registrations. Such textiles are complementary to these Class 20 products. In furniture showrooms, such goods are exhibited together and can be purchased in the same place.

Exhibit AW2 is a page from www.ikea.com showing beds, mattresses, bedroom furniture and bedroom textiles on the same page.

Curtain holders, hooks, rails, rings, rods and rollers – these goods are similar to curtains as covered by the earlier registrations. Curtain products are especially designed to be used together by the same user and are sold in the same outlets.

Exhibit AW3 is a page form www.argos.co.uk showing curtains and curtain accessories on the same page.

Bamboo and bead curtains are similar to textile curtains.

Bean bag chairs are similar to textiles.

Towel dispensers are similar to towels.

Door fittings, doorknob covers are similar to textiles for doors and door fittings.

16. Umbrella stands are similar to umbrellas.

17. Chests, wind chimes, nesting boxes for pets, beds for household pets, nesting boxes or small birds, scratching posts for cats, flower-pot pedestals, flower stands, trays, bottle closures, bottle racks, corks for bottles, letter, magazine, plate and cup racks are similar to household utensils and containers in Class 21.

18. There is a high level of overlap between household items in Class 20 with household items in Classes 21 and 24.”

30) Many of Ms Wong’s submissions are assertion without analysis within the parameters of the case law. In *Canon* the CJEU stated:

“22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly

distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

The court required evidence of similarity to be adduced. This finding has been reiterated by the CJEU and the GC eg in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-316/07:

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

The above part of the *Canon* judgment has been more recognised in the breach than in the observance in this jurisdiction. It may not always be practical to adduce evidence of similarity; it may be that the nature of the goods is so well-known that it would be a waste of effort and resources to do so. However, where there is no obvious or clear link between goods or services, an opponent must expect to give some form of explanation within the parameters of the case law as to why there is similarity. Ms Wong extrapolates from the position in relation to beds and bedding to furniture in general. She gives no explanation as to why eg hat stands, library shelves, saw horses and coat stands are similar to the goods of the earlier registration. **In the absence of evidence, analysis or some obvious material coincidence within the parameters of the case law, Last Hero has not established that the following goods of the application are similar to the goods of the earlier registrations:**

office furniture; dressing tables; easy chairs; furniture screens; armchairs; benches [furniture]; cabinet work; cabinets; carts for computers [furniture]; corks; hairdresser's chairs, deck chairs; desks; tables, dinner wagons [furniture]; library shelves; lockers; locks [other than electric], not of metal; racks [furniture]; saw horses; school furniture; seats; sofas; tea carts; cupboards; display boards; dressing tables; footstools and stools; shelves; clothes hooks and coat hangers; coat stands; hat stands; ladders of wood or plastics; embroidery frames; fire screens; storage tanks [not of metal or masonry], index cabinets; metal-substitute plastic fasteners, nails, wedges, nuts, screws, tacks, bolts, rivets and casters [not of metal], door stops; infant walkers; mobiles; chimes; high chairs for babies; chests; wind chimes; nesting boxes for pets; beds for household pets; nesting boxes for small birds, scratching posts for cats; oriental single panel

standing partition, hanging boards [Japanese style pegboards using positional hooks], oriental folding partition screens; drinking straws; keyboards for hanging keys; mannequins; drain traps [valves] of plastic; medicine cabinets; pegs (not of metal); pill cases [wood, plastics]; plastic doorknobs; porcelain or earthenware doorknobs; wood doorknobs; bean bag chairs; garment bags; bathroom stools; lockers; shopping baskets; decorative edging strips of plastics and/or wood for use with window fittings; step ladders and ladders [not of metal], tool boxes [not of metal], stakes for plants or trees, artificial model food samples, flagpoles, house numbers, not of metal, non luminous; identity plates, not of metal; letter boxes; hand-held flat fans, hand-held folding fans, fans [non-electric].

31) The class 24 specification of -461 encompasses curtains and bedding. There are clear similarities between such goods as blinds and fittings for curtains by way of purpose, end user, channel of trade and complementarity. **Consequently, the following goods of the application are similar to the goods of -461:**

bamboo curtains; bamboo and bamboo blinds, bead curtains for decoration; bead curtains; blinds; curtain holders; curtain hooks; curtain rails; curtain rings; curtain rods; curtain rollers.

32) As shown in evidence, bedding is sold with bed furniture, there is a common channel of trade. There is also a common user, the person who wants bedding. The goods are also closely linked, beds are invariably used with bedding. The goods are complementary. **Consequently, the following goods are similar to the goods of -461 as being beds, goods closely related to beds or, in the case of furniture, a term that include beds:**

furniture; beds, bedsteads; water beds; head-rests [furniture]; divans; mattresses; air mattresses; bed fittings, not of metal; playpens for babies; cots; cradles; cribs; crib bumpers, bed pads.

33) *Baskets, not of metal; containers, not of metal (storage, transport); containers for transport [not of metal], containers of plastic for packaging purposes; wickerwork; bottle racks; letter racks; magazine racks; plate racks; cup racks* are all forms of container or serve the functions of a container, consequently, they serve the same overall purpose as *household or kitchen containers* of -461. The channels of trade could be the same as could the end users. ***Baskets, not of metal; containers, not of metal (storage, transport); containers for transport [not of metal], containers of plastic for packaging purposes; wickerwork; bottle racks; letter racks; magazine racks; plate racks; cup racks*** are similar to the goods of -461.

34) *Trays; bottle closures; corks for bottles; tool handles; sealing clips for bags* all have close affinities to *household or kitchen utensils and containers* and are similar to these goods of -461.

35) *Chinaware, glassware, porcelain and earthenware* of -461 will encompass statues, flower pot pedestals and flower-stands made of these materials. Consequently, other than the material of which the goods are made, the respective goods are identical. ***Statues of wood, wax, plaster or plastic; flower pot pedestals; flower-stands* are highly similar to the goods of -461.**

36) Umbrellas are placed in umbrella stands. This does not make them similar. The nature of the goods is different, the purpose of the goods is different, the channels of trade are different. The goods are not sold in the same areas of shops. The relationship between them is not such that the average consumer would believe that the respective goods are the products of the same undertaking; they are not complementary. The respective goods are clearly not fungible, they are not in competition. **Umbrella stands are not similar to the goods of the earlier registrations.** A similar logic applies to *towel dispensers* and *towels*. **Towel dispensers are not similar to the goods of the earlier registrations.**

37) Ms Wong submits that *door fittings* and *doorknob covers* are similar to textiles for doors and door fittings. She does not explain what a textile door fitting is; it is difficult to envisage such a product. She does not explain what a *doorknob cover* is; further she does not explain what form such an object would be if it were textile. In the absence of any clear explanation or evidence, it is found that ***door fittings* and *doorknob covers* are not similar to the goods of the earlier registrations.**

38) ***Random access memory, read only memory; electronic communication equipment and instruments; microprocessors, memory boards, monitors, displays, keyboards, cables, modems, printers; blank computer storage media; navigation apparatus for vehicles (on board computers)* are goods that are included in *apparatus for recording, transmission or reproduction of sound or images* and *data processing equipment and computers* or are closely linked by being an essential periphery or part and fitting of these goods. Where the respective goods are not identical, they will have the same channels of trade, the same end users, the same purpose, the same nature and will be highly complementary eg a memory board is essential to a computer and vice versa. The goods rehearsed above are either identical or highly similar to the goods of -461.**

39) A large part of the rest of the class 9 specification which Mr Evans submits is not similar to the goods and services of the earlier registrations covers software of various types. In *Galileo International Technology, LLC v European Union (formerly European Community)* [2011] EWHC 35 (Ch) Floyd J stated:

“39. The unrestricted specification is of enormously wide scope. The Hearing Officer wisely reminded himself of what Laddie J had said about wide specifications for computer software in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850. Laddie J considered that:

“... there is a strong argument that a registration of a mark simply for “computer software ” will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls the computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

40. That was a case decided under the Trade Marks Act 1938, but, like Laddie J, I see no reason why the views there stated should not apply under the Act. “

Ms Wong submits:

“software is an integral part of any computer or computerized product. Such goods are sold through the same channels, to the same users and are complementary to computers and apparatus for recording, transmission or reproduction of sound or images.”

Ms Wong is treating all software as being essentially the same, whether it be operating software, firmware or application software. She makes the statement that it is all sold through the same channels of trade. However, various types of software are sold through different suppliers eg navigation software may be sold by outdoor shops or car accessory shops. It is accepted that computers need software and vice versa but the degree of similarity will depend on the nature of the software. *Software for computer system backup, data processing, data storage, file management and database management* is, for instance, at the heart of a computer and so brings greater similarity. Certain of the software of the application will be used in relation to apparatus for recording, transmission or

reproduction of sound or images eg *software that enables users to play and program music and entertainment-related audio, video, text and multi-media content*. Taking into account all the factors in relation to the similarity of goods, the degree of similarity between the class 9 goods of -461 and the goods which Mr Evans submits are not similar can be divided into two. The first group, owing to their connection to the functioning or general relationship to various goods in -461, have a higher degree of similarity than the second group.

Group 1:

manipulating, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multi-media content, computer software and firmware for operating system programs, data synchronization programs, computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; computer software for the synchronization of data between a remote station or device and a fixed or remote station or device; sound effect apparatus and instruments (computer software); computer desktop utility software; screen saver software; software for detecting, eradicating and preventing computer viruses; software for data encryption; software for analysing and recovering data; software for computer system backup, data processing, data storage, file management and database management; software for telecommunication and communication via local or global communications networks, including the Internet, intranets, extranets, television, mobile communication, cellular and satellite networks; software for access to communications networks including the Internet.

Group 2

software featuring musical sound recordings, entertainment-related audio, video, text and multi-media content, application development tool programs for personal and handheld computers; electronic tone generators (computer software); software for creating and delivering electronic greeting cards, messages and electronic mail; software for web design, creation, publishing and hosting.

Group 1 has a reasonable degree of similarity with the class 9 goods of -461. Group 2 has a limited degree of similarity with the class 9 goods of -461, taking into account the factors set out in the case law.

40) Ms Wong submits that “batteries are an integral part of many goods covered by the earlier registrations. They are typically sold through the same channels, to the same users and are complementary to computers and apparatus for recording, transmission or reproduction of sound or images.” It is noted that the specifications of the earlier registrations do not include parts and fittings. The GC considered the relationship between finished article, their component parts and similarity in *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03*:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

The position was reiterated by the GC in *Promat GmbH v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle) (HABM) Case T-71/08*:

“33 Auch wenn, wie die Klägerin in der mündlichen Verhandlung ausgeführt hat, Mineralfasern und Werg denselben Ursprung haben können, genügt dies nicht, um die Ähnlichkeit der betreffenden Waren festzustellen. Die bloße Tatsache, dass ein Produkt als Einzelteil, Zubehör oder Komponente einer anderen Ware verwendet wird, reicht nicht als Beweis dafür aus, dass die diese Komponenten enthaltenden Endprodukte einander ähnlich sind (Urteil des Gerichts vom 27. Oktober 2005, *Éditions Albert René/HABM – Orange [MOBILIX]*, T-336/03, Slg. 2005, II-4667, Randnr. 61).”

These judgments do not state that a component cannot be similar to a finished product in which it appears; the matter is one that must be considered on the basis of the particular facts of the case. On the logic of Ms Wong anything that contains a battery is similar to a battery. Batteries are sold in a multitude of establishments. They are invariably sold in a discrete area of a shop with their own display. The complementarity claimed by Ms Wong is based on the basis that they give power to many products, this is on a par with the argument that glasses and wines are complementary. The complementarity claimed is at such a general level than it does not give rise to similarity. *Rechargeable batteries; chargers; chargers for electric batteries* are in a similar position to batteries. ***Batteries; rechargeable batteries; chargers; chargers for electric batteries*** are not similar to the goods of the earlier registration.

41) *Testing apparatus for all the aforesaid goods will be included in the general terms scientific, weighing and measuring apparatus and instruments* and so are identical to these goods.

42) An essential requirement for ships and boats is knowledge of where the vessel is; the term *nautical apparatus and instruments* will include such equipment which in turn will include global positioning apparatus. **Consequently, *global positing (sic) systems and global positioning system (GPS) devices* are identical to *nautical apparatus and instruments*.**

43) *Fonts, typefaces, type designs and symbols in the form of recorded data and magazines, general interest* are electronic versions of *printers' type, printing blocks and printed matter* (which includes magazines) of the class 16 specification of -407 and so are the same products but supplied/accessed in a virtual rather than physical form. It is also common for publications to be provided in both a print and electronic form. ***Fonts, typefaces, type designs and symbols in the form of recorded data and magazines, general interest* are similar to the class 16 goods of -407.**

44) Any connection between *computer disk holders* and the goods of the earlier registrations is in the form of complementarity which does not give rise to material similarity. No submissions have been made in attempt to substantiate the claim that these goods are similar. ***Computer disk holders* are not similar to the goods and services of the earlier registrations.**

45) *Instructional material relating to the foregoing* stands and falls with the primary goods to which it relates.

Overall conclusion on likelihood of confusion

46) The average consumer and the purchasing process are analysed as they affect the likelihood of confusion where there are differences between trade marks eg small differences may have a significant effect where the goods or services are purchased as a result of a particularly careful and educated purchasing decision. Owing to the extreme similarity of the trade marks, nothing can turn upon the nature of the average consumer and the purchasing process; he or she will effectively have nothing with which to distinguish the respective goods and services being sold under the respective trade marks.

47) It is a sine qua non that goods and services have to be similar for there to be a likelihood of confusion. Consequently, in relation to the non-similar goods and services there can be no likelihood of confusion.

48) It is necessary to consider the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{viii}. The respective trade marks are similar to the highest degree. (The colour of the earlier registrations is not pertinent to the comparison of the trade marks as there are no colour limitations^{ix}.)

49) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^x. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xi}. 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 trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods and services from those of other undertakings^{xii}. The earlier trade mark in relation to certain goods and services may be seen as a banal statement, indicating affinity or that the purchaser has visited London eg on textile articles. In relation to certain goods such as *dental apparatus* it would have no such indication. Consequently, there is a large degree of difference in relation to the distinctiveness of the earlier trade mark dependent upon the goods and services in question.

50) In the end, taking all of the above factors into account, the question in these proceedings turns upon the degree of similarity between the trade marks. A degree of similarity which does not allow for the average consumer for any goods or services to effectively distinguish the trade marks. **In relation to all of the goods and services which are similar there is a likelihood of confusion.** (Mr Evans only submitted that the goods and services which he identified in his skeleton argument are not similar.)

51) The application, in relation to section 5(2)(b) of the Act, is **acceptable** for the following goods and services:

batteries; rechargeable batteries; chargers; chargers for electric batteries; instructional material relating to the foregoing; computer disk holders;

office furniture; dressing tables; easy chairs; furniture screens; armchairs; benches [furniture]; cabinet work; cabinets; carts for computers [furniture]; corks; hairdresser's chairs, deck chairs; desks; tables, dinner wagons [furniture]; library shelves; lockers; locks [other than electric], not of metal; racks [furniture]; saw horses; school furniture; seats; sofas; tea carts; cupboards; display boards; dressing tables; footstools and stools; shelves; clothes hooks and coat hangers; coat stands; hat stands; ladders of wood or plastics; embroidery frames; fire screens; storage tanks [not of metal or masonry], index cabinets; metal-substitute plastic fasteners, nails, wedges, nuts, screws, tacks, bolts, rivets and casters [not of metal], door stops; infant walkers; mobiles; chimes; high chairs for babies; chests; wind chimes; nesting boxes for pets; beds for household pets; nesting boxes for small birds, scratching posts for cats; oriental single panel standing partition, hanging boards [Japanese style pegboards using positional hooks], oriental folding partition screens; drinking straws;

keyboards for hanging keys; mannequins; drain traps [valves] of plastic; medicine cabinets; pegs (not of metal); pill cases [wood, plastics]; plastic doorknobs; porcelain or earthenware doorknobs; wood doorknobs; bean bag chairs; garment bags; bathroom stools; umbrella stands; towel dispensers; door fittings; doorknob covers; lockers; shopping baskets; decorative edging strips of plastics and/or wood for use with window fittings; step ladders and ladders [not of metal], tool boxes [not of metal], stakes for plants or trees, artificial model food samples, flagpoles, house numbers, not of metal, non luminous; identity plates, not of metal; letter boxes; hand-held flat fans, hand-held folding fans, fans [non-electric].

mineral water, spring water, carbonated water, areated water, water, bottled water; non-alcoholic beverages; preparations for making beverages;

scientific and technological services and research and design relating thereto; industrial analysis and research services; design services; design information systems relating to finance and to management; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; hosting the web sites of others; hosting software applications for others; security services relating to computerised data.

services for providing food and drink; temporary accommodation; Accommodation and catering for guests; restaurants; cafés; cafeterias; bars; canteens; catering services; self-service restaurants; snack bars; cocktail lounges; providing of information in relation to food and drinks; provision and reservation of temporary accommodation and lodging facilities, hotels, motels, boarding houses and the provision of information thereto; holiday camp services; restaurants, cafés, cafeterias, bars, food halls, canteens and lounges installed with audio and visual apparatus with sing along devices; child-care services; day-nurseries; tourist homes; bar services, arranging of wedding receptions; providing facilities for exhibitions.

It is to be refused for the other goods and services.

Section 3(6) of the Act – bad faith

52) Last Hero has filed no evidence to substantiate its claims in relation to bad faith. In relation to Mr Singh's knowledge of its trade mark, it has filed no evidence. Even if Mr Singh did have such knowledge this is not in itself an act of bad faith. In *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) Arnold J

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which

must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks*[2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

In *Boxing Brands Limited v Sports Direct International Plc and others* [2013] EWHC 2200 (Ch) Birss J stated:

“79. Mr Purvis also referred to the recent decision of the CJEU in *Malaysia Dairy v Ankenævnet for Patenter og Varemærker* Case C-320/12 [27 June 2013]. In this case the court held that when considering the overall assessment in relation to the bad faith ground, “*the fact the applicant knows or should know that a third party is using such a sign is not sufficient in itself to permit the conclusion that that applicant is acting in bad faith. Consideration must, in addition, be given to the applicant's intention at the time when he files the application for registration of a mark, a subjective factor which must be determined by reference to the objective circumstances of the particular case.*” This must be right. If a business person decides entirely independently that they are going to register a given trade mark for a particular set of goods, the fact that they might happen to find out that someone else is also interested in the same thing cannot necessarily put them in a worse position. The issue will be highly sensitive to the circumstances.”

53) In this case Mr Singh as can be seen from his counterstatement, the evidence of Mr Evans and the (failed) application to the cancellation division of OHIM believes that he has better title to his trade mark than Last Hero. In such circumstances, even if Mr Singh knew of the registrations of Last Hero at the date of the filing of his application, the action of the filing of the application would not fall below the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined (*Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379).

54) The argument of Last Hero also effectively conflates a likelihood of confusion with bad faith, making an absolute ground contingent effectively upon a relative ground.

55) Last Hero also claim that Mr Singh had no intention to use the trade mark for all of the goods and services of the application. It has filed no evidence in relation to this. All it has done is submit speculation and conjecture. Once this claim was made, it was to be expected that evidence would be filed to support it,

Mr Singh would be the subject of cross-examination and quite possibly a request for disclosure would have been made.

56) Last Hero has in no way substantiated its claims in relation to section 3(6). It has made no attempt to do so. As has been stated on a plethora of occasions, an accusation of bad faith is a serious accusation; it goes to the bona fides of an applicant. It is not a ground that is to be used as a makeweight; if it is pleaded it is to be expected that evidence will be supplied in order to substantiate the claim. The ground under section 3(6) of the Act is dismissed. The complete lack of substantiation of such a serious claim will be taken into account in the award of costs.

Costs

57) Last Hero has been far more successful than Mr Singh. Last Hero's evidence was for the most part submission. Usually the costs would include a sum for writing of the statement of the grounds, considering the counterstatement and the submissions. (Although taking into account the nature of the statement of grounds and the evidence, a not very large contribution.) However, in this case Last Hero made a serious allegation under section 3(6) of the Act and made no attempt to substantiate the claim. In these circumstances the award of costs is limited to the opposition fee. **Kulbinder Singh is ordered to pay The Last Hero SL the sum of £200. 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 20th day of November 2103

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

ⁱ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

ⁱⁱ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

ⁱⁱⁱ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the

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

^{iv} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^v *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{vi} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

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

^{vii} “17. First, the starting point for the analysis of similarity is the wording of the Act and the Directive. These require the tribunal to determine whether or not the respective goods are “identical or similar” but they do not specify the criteria by reference to which similarity is to be assessed. In the well-established guidance from the Court of Justice on this issue originating in *Canon*, to which the Hearing Officer referred, the Court has not suggested that every case requires assessment of whether the respective goods or services are complementary. To the contrary, the Court has regularly made it clear that all relevant factors relating to the goods or services themselves should be taken into account, of which complementarity is but one (see e.g. in *Boston*).

18. Second, the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in *Boston* as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.

19. Third, the Hearing Officer said at [32]:

As stated above, the legal definition of ‘complementary’, as per *Boston*, is that the goods must be “indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”. It is not sufficient that the goods “can” be used together; nor is it sufficient that they are sold together.

20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.

21. Moreover, it is necessary to view the quotation from *Boston* in the context of the facts of that case where the dispute over similarity turned in part on whether the goods were used together for a rather specific medical procedure. The Court of First Instance said at [77]-[87]:

Similarity between the products

77 According to consistent case-law, in order to assess the similarity of the products or services concerned, all the relevant features of the relationship that might exist between those products or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*Sunrider v OHIM*, paragraph 27 above, paragraph 85; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM - Gómez Frías (euroMASTER)*, paragraph 31).

78 As regards the assessment of the similarity of the goods at issue, the Board of Appeal found, in paragraphs 22 to 24 of the contested decision, that, owing to their functional differences, apparatus for placing a suture, on the one hand, and hollow fiber oxygenators with detachable hard-shell reservoir, on the other hand, have a different method of use, are not in competition with each other and are not interchangeable. However, the Board found, in essence, that the goods at issue were closely linked to the goods of the intervener in so far as they had a certain complementary character, since they could be used simultaneously in the field of medicine, for example during surgery. They might also be purchased through the same distribution channels and be found in the same points of sale, so that the relevant public could be led to believe that they came from the same undertaking.

79 Those findings must be upheld.

80 In this respect, it must be noted that the goods bearing the earlier trade mark and those covered by the mark applied for both concern the medical field and are therefore intended to be used in the context of a therapeutic treatment.

81 In addition, as the Board of Appeal rightly pointed out, all the goods covered by the mark applied for have a certain complementary relationship with those bearing the earlier trade mark.

82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM - Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM - Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).

83 It is also true that, as OHIM moreover acknowledged, apparatus for placing a suture cannot be considered to be indispensable or important for the use of hollow fiber oxygenators with detachable hard-shell reservoir.

84 However, it is clear that apparatus for placing a suture and hollow fiber oxygenators with detachable hard-shell reservoir can be considered to be complementary where, in surgery which has required an incision and during which an oxygenator has been used, the surgeon uses apparatus for placing a suture. Thus, in the course of a single, very specific procedure, namely a surgical operation, two apparatus, namely an oxygenator and apparatus for placing a suture, might be used, one bearing the trade mark CAPIOX and the other the trade mark CAPIO.

85 It follows that, even though the applicant claims that the goods at issue cannot be considered to be similar simply because they are both used in the field of medicine, which, according to the applicant, is the case of nearly all goods of significance, the goods at issue are similar because they are in fact in a certain complementary relationship and specifically target certain professionals in the medical sector. In addition, in the present case, contrary to what the applicant claims, the goods at issue are not similar solely because they are used in the field of medicine, but because they could be used in the same, very specific surgical operation, namely open-heart surgery.

86 Finally, the products at issue can in fact be found in the same distribution channels, such a criterion being relevant for the purposes of the assessment of the similarity of the goods (*PiraÑAM diseño original Juan Bolaños*, paragraph 82 above, paragraph 37; see also, to that effect, *SISSI ROSSI*, paragraph 82 above, paragraph 65; and *PAM PLUVIAL*, paragraph 82 above, paragraph 95).

87 Accordingly, given the close link between the products in question as regards their end users, the fact that they are to some extent complementary and the fact that they may be distributed via the same distribution channels, the Board of Appeal was right to find that the applicant's goods and those of the intervener were similar (see, to that effect, *Case T-388/00 Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 56).

22. The Court of First Instance was not attributing decisive importance to the question of whether the goods in that case were complementary in determining the overall question of whether they were similar.

23. In the present case, because of the way in which the case was presented to the Hearing Officer, the issue of whether the goods were complementary assumed excessive importance which may have diverted the Hearing Officer's attention from other, no less important, considerations in the evaluation of similarity. That requires me on this appeal to scrutinize the approach taken by the Hearing Officer in considering the evidence by reference to the test of similarity more closely than would ordinarily be warranted by the REEF principles on an appeal of this kind.£

^{viii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{ix} In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J stated:

“119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is limited to a colour, then the mark that is used has to be compared, as used, to the mark that is registered, as registered (and therefore in colour). If the registered mark is unlimited as to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that

its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course.”

Also see *Mary Quant Cosmetics Japan Ltd v Able C & C Co Ltd* BL O/246/08.

^x *Sabel BV v Puma AG* Case C-251/95.

^{xi} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xii} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.