

**O-521-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3154319 BY  
CKL HOLDINGS N.V.**

**TO REGISTER:**

**BOND**

**AS A TRADE MARK**

**IN CLASSES 16 & 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 60000449 BY  
JEREMY BOND & PETER BOND**

## BACKGROUND & PLEADINGS

1. On 11 March 2016 (claiming an International Convention priority date of 26 October 2015 from an earlier filing in the Benelux), CKL Holdings N.V. (“the applicant”) applied to register **BOND** as a trade mark for goods in classes 16 and 25. The applicant seeks registration for, inter alia, the following goods in class 16:

**Class 16** - Printed publications; books; music sheets; music scores; periodical magazines; printed matter; photographs; stationery.

The application was published for opposition purposes on 3 June 2016.

2. On 5 July 2016, the application was opposed in class 16 by Jeremy Bond and Peter Bond (“the opponents”) under the fast track opposition procedure.

3. The opposition is based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opponents rely upon all the goods and services (in classes 16 and 41) in United Kingdom registration no. 2618469 for the trade mark **Bond** which was filed on 20 April 2012 and entered in the register on 27 July 2012. The goods in the opponents’ class 16 specification are as follows:

**Class 16** - Printed matter; printed publications; educational materials; examination papers; assessment papers, syllabi; diplomas, academic and vocational certificates; printed examination regulations; books; magazines; periodicals; journals; publications; textbooks; exercise books and notebooks; newspapers; catalogues, handbooks and manuals; study guides; instructional or teaching materials; stationery; posters; photographs and pictures.

4. The applicant filed a counterstatement in which the basis of the opposition is denied. I shall return to the applicant’s counterstatement later in this decision.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; the opponents filed written submissions which I will take into account and, if necessary, refer to below.

## **DECISION**

8. The opposition is based upon sections 5(1) and 5(2)(a) of the Act, which read as follows:

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

(b)...

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

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. The trade mark upon which the opponents rely qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponents are entitled to rely upon all of the goods and services they have identified (although it is only necessary for me to consider the goods in class 16 of the earlier trade mark).

### **Comparison of trade marks**

11. The applicant seeks registration for the word **BOND** presented in block capital letters, whereas the opponents' earlier trade mark is for the word **Bond** presented in title case. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the Court of Justice of the European Union (“CJEU”) commented on what constitutes an identical trade mark. The Court concluded:

“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.”

12. The only difference between the competing trade marks is that one is presented in block capital letters and the other in title case. I have no doubt that such a difference is “so insignificant” it may go “unnoticed by an average consumer”. The competing trade marks are to be regarded as identical.

### **Comparison of goods**

13. The competing goods are as follows:

<b>Opponents’ goods in class 16</b>	<b>Applicant’s goods in class 16</b>
Printed matter; printed publications; educational materials; examination papers; assessment papers, syllabi; diplomas, academic and vocational certificates; printed examination regulations; books; magazines; periodicals; journals; publications; textbooks; exercise books and notebooks; newspapers; catalogues, handbooks and manuals; study guides; instructional or teaching materials; stationery; posters; photographs and pictures.	Printed publications; books; music sheets; music scores; periodical magazines; printed matter; photographs; stationery.

In its counterstatement, the applicant states:

“6. In class 16, the goods offered by the respective marks differ significantly. The goods offered by the opponent’s mark such as “*apparatus for recording, transmission or reproduction of sound or images*” and “*recording discs*”, are all clearly aimed at the education market.”

14. Not only do the goods mentioned by the applicant above not appear in the opponents' specification in class 16 (they do not appear in its specification in class 41 either). In addition, the applicant's submissions proceed upon a fundamental misunderstanding of the comparison I am required to make. The applicant's understanding and its use of the word "offered" may, however, have been influenced by a compromise offered by the opponent prior to launching the opposition and by terms such as: "educational materials, examination papers, assessment papers, syllabi, diplomas, academic and vocational certificates, printed examination regulations, textbooks, study guides" and "instructional or teaching materials", which appear in the opponent's specification.

15. Regardless, as the opponents' earlier trade mark is not subject to proof of use, it matters not upon which goods the opponents may have actually used their trade mark. In those circumstances, what I am required to do is to compare the words as they appear in the competing specifications. Approached on that basis, the terms "Printed publications", "books", "printed matter", "photographs" and "stationery" appear in both parties' specifications and are identical. As for those goods in the application which are not expressed in identical terms to those contained in the earlier trade mark's specification in class 16 i.e. "music sheets", "music scores" and "periodical magazines", I remind myself that in *G rard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court ("GC") stated:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut f r 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).”

16. As (i) “music sheets” and “music scores” and (ii) “periodical magazines” are sub-categories of, at least, (i) “printed matter” and (ii) “magazines” and “periodicals” respectively which appear in the earlier trade mark’s specification in class 16, the goods mentioned are to be regarded as identical on the principle outlined in *Meric*.

### **Conclusion**

17. Having concluded that the competing trade marks and goods are identical, the provisions of section 5(1) of the Act are met. Having reached that conclusion, it is not necessary for me to consider the opponent’s alternative pleading based upon section 5(2)(a) of the Act.

### **Overall conclusion**

18. The opposition has been successful and, subject to any successful appeal, the application will be refused in class 16.

### **Costs**

19. As the opponents have been successful, they are entitled to a contribution towards their costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice (“TPN”) 2 of 2015. Using that TPN as a guide, I award costs to the opponents on the following basis:

Official fee:	£100
Preparing a statement and considering the applicant’s statement:	£200
Written submissions:	£100

**Total:**

**£400**

20. I order CKL Holdings N.V. to pay to Jeremy Bond & Peter Bond (jointly) the sum of £400. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of November 2016

**C J BOWEN**

**For the Registrar**