

O-535-17

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3169651
BY AIDO INTERNATIONAL LIMITED
TO REGISTER THE TRADE MARK
AIDO
IN CLASSES 3, 9, 14, 16, 25, 26, 35, 38 & 41**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 407780 BY
AIDA CRUISES**

BACKGROUND

1) On 15 June 2016, Aido International Ltd (hereinafter the applicant) applied to register the trade mark "Aido" in respect of the following goods and services:

In Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.

In Class 9: Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.

In Class 14: Precious metals; jewellery; precious stones; chronometric instruments.

In Class 16: Paper; cardboard; printed publications; printed matter; computer printers (Inking ribbons for -); bookbinding materials; books; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; periodical magazines; photographs; stationery and educational supplies; typewriters; Instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing blocks.

In Class 25: Clothing; footwear; headgear; swimwear; sportswear; leisurewear; clothing for children; infant wear; articles of clothing for women; sleepwear, lingerie; hosiery; nightwear; sports clothing; gymwear; beach clothing; belts [clothing]; underwear; socks; gloves; men's and women's jackets, coats, trousers, vests.

In Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

In Class 35: Advertising, business management and business administration, employment agency services relating to temporary and permanent placement of personnel; conducting skills evaluation for individuals; consultancy relating to personnel management; arranging subscriptions to telecommunications services for others; Presentation of goods on communication media, for retail purposes; Business management and organization consultancy;

Computerised file management; Publication of publicity texts; Rental of advertising space; Dissemination of advertisements.

In Class 38: Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.

In Class 41: Teaching, education, training and entertainment services; Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Publication of electronic books and journals on-line.

2) The application was examined and accepted, and subsequently published for opposition purposes on 2 September 2016 in Trade Marks Journal No.2016/036.

3) On 31 October 2016 AIDA Cruises the German branch of Costa Crociere S.p.A. (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
AIDA	EU 12773371	08.04.14 (opposed)	3	Cosmetics; Perfumery; Essential oils; Cotton wool for cosmetic purposes.
			9	Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers for cruises; Headphones; Balancing apparatus.
			14	Jewellery; Ornaments [jewellery, jewelry (Am.)]; Jewellery stones; Timepieces; Time instruments.
			16	Bookbinding material; Photographs; Paper; Cardboard, stationery; Artists' materials; Brochures relating to cruises; Catalogues relating to cruises; Plastic materials for packaging, included in class 16; Calendars; Tissues of paper; Paper towels; Tissues of paper for removing make-up.
			25	Clothing; Footwear; Headgear.
			26	Key straps; Artificial flowers.
			35	Advertising; Retailing, namely of travel requisites, cosmetics, perfumery, essential oils, jewellery, precious stones, horological and chronometric instruments, glassware, porcelain, earthenware, clothes, footwear, headgear, lanyards,

				games, playthings, gymnastic and sporting articles, trunks and travelling bags, umbrellas, parasols, shopping bags, handbags and travel bags; Arranging of contracts, for others, for the providing of services.
			41	Translation and interpretation; Education, other than in the field of music; Providing of training, Other than in the field of music; Entertainment, Other than in the field of music; Sporting and cultural activities, other than musical performances; Discotheque services; Theatre services; Operation of bathing facilities; Swimming pool and water chute complex services; Photography services, included in class 41; Videotape film production; Organisation of seminars; Courses and lectures; Conducting of sports programmes, in particular involving cycling, diving, golf.
AIDA	EU 4681987	12.10.05 24.01.08	various	Various
AIDA Cruises	EU 3947694	23.07.04 09.09.08	various	Various

a) The opponent contends that its marks and the mark applied for are very similar and that the goods/services applied for are identical and/or similar to the goods/services for which the earlier marks are registered. As such the mark in suit offends against Section 5(2)(b) of the Act.

4) On 3 January 2017 the applicant filed a counterstatement basically denying that the marks and goods and services are similar, and it denies that there is a likelihood of confusion. It puts the opponent to strict proof of use of its EU marks 3947694 & 4681987.

5) The opponent decided against filing evidence in respect of its EU marks 3947694 & 4681987. Therefore the opposition is based upon its mark EU 12773371 which has yet to achieve registration. Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Only the opponent provided further written submissions which I shall refer to as and when necessary in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 30 March 2017, by Michael Conway, the opponent's Trade Mark Attorney. He states that he has carried out internet research and provides the following exhibits:

- MC1: Extracts from the internet showing the breadth of the term “computer hardware”. The first page includes the following definition of the term “hardware” as “any physical component of a computer system that contains a circuit board, IC’s or other electronics”. It goes on to name monitors, tablets, smartphones, webcams, keyboards, microphones, printers, projectors, scanners, speakers, processors, modems, motherboards, sound and video cards. These views are supported by additional pages from the internet.
- MC2: Extracts from the internet showing the breadth of the term “computer peripherals”. The papers show, *inter alia*, keyboards, speakers, headphones, printers, routers, cameras, chargers, plugs, cables, sockets, mouse mats, microphones, monitors, hard drives, projectors and scanners.
- MC3: Extracts from the internet relating to electronic equipment for controlling audio inputs and outputs. The papers show a number of electronic items such as mixing desks/controllers and individual volume controllers.
- MC4: Extracts from the internet which purport to show that jewellery and precious metals may be marketed by the same commercial enterprise. The extracts show three companies who sell jewellery and also sell and/or buy gold and other precious metals.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

8) The only ground of opposition is under section 5(2)(b) which reads:

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

(a)

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

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, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

10) The opponent was initially relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. However, the applicant requested proof of use which the opponent chose not to provide. It can only rely upon its unregistered mark EU 12773371 which, because it is unregistered, is not subject to The Trade Marks (Proof of Use, etc.) Regulations 2004.

11) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

12) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

13) Both parties' specifications cover a vast range of goods and services. The goods in classes 3, 9, 14, 16, 25 and 26 will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The average consumer of the goods at issue is a member of the general public (including businesses). Such consumers are likely, in my opinion, to select the goods mainly by visual means, although I accept that they may seek advice from shop assistants or carry out research via friends and family or on the internet.

14) The services in classes 35, 38 & 41 may also be offered in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The average consumer of the services at issue is a member of the general public (including businesses). Such consumers are likely, in my opinion, to select the services mainly by visual means, although I accept that they may seek advice from shop assistants or carry out research via friends and family or on the internet.

15) For both the goods and services, the average consumer's level of attention will vary considerably depending on the cost and nature of the item /service at issue. However, to my mind, even when selecting routine inexpensive goods such as socks **the average consumer will pay at least an average degree of attention to precisely what good or service they are getting.**

Comparison of goods

16) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

19) The goods and services to be compared are as follows:

Applicant's specification	Opponent's specification
In Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.	In Class 3: Cosmetics; Perfumery; Essential oils; Cotton wool for cosmetic purposes.

<p>In Class 9: Computer hardware; computer software; computer peripherals; electronic data processing equipment; computer networking and data communications equipment; computer components and parts; electronic memory devices; electronic control apparatus; programmed-data-carrying electronic circuits; wires for communication; electrodes; telephones; aerials; batteries; micro processors; keyboards; video films.</p>	<p>In Class 9: Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers for cruises; Headphones; Balancing apparatus.</p>
<p>In Class 14: Precious metals; jewellery; precious stones; chronometric instruments.</p>	<p>In Class 14: Jewellery; Ornaments [jewellery, jewelry (Am.)]; Jewellery stones; Timepieces; Time instruments.</p>
<p>In Class 16: Paper; cardboard; printed publications; printed matter; computer printers (Inking ribbons for -); bookbinding materials; books; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; periodical magazines; photographs; stationery and educational supplies; typewriters; Instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing blocks.</p>	<p>In Class 16: Bookbinding material; Photographs; Paper; Cardboard, stationery; Artists' materials; Brochures relating to cruises; Catalogues relating to cruises; Plastic materials for packaging, included in class 16; Calendars; Tissues of paper; Paper towels; Tissues of paper for removing make-up.</p>
<p>In Class 25: Clothing; footwear; headgear; swimwear; sportswear; leisurewear; clothing for children; infant wear; articles of clothing for women; sleepwear, lingerie; hosiery; nightwear; sports clothing; gymwear; beach clothing; belts [clothing]; underwear; socks; gloves; men's and women's jackets, coats, trousers, vests.</p>	<p>In Class 25: Clothing; Footwear; Headgear.</p>

<p>In Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.</p>	<p>In Class 24: Textiles and textile goods, included in class 24; Bed and table covers; Bed clothes and blankets</p> <p>In Class 26: Key straps; Artificial flowers.</p>
<p>In Class 35: Advertising, business management and business administration, employment agency services relating to temporary and permanent placement of personnel; conducting skills evaluation for individuals; consultancy relating to personnel management; arranging subscriptions to telecommunications services for others; Presentation of goods on communication media, for retail purposes; Business management and organization consultancy; Computerised file management; Publication of publicity texts; Rental of advertising space; Dissemination of advertisements.</p>	<p>In Class 35: Advertising; Retailing, namely of travel requisites, cosmetics, perfumery, essential oils, jewellery, precious stones, horological and chronometric instruments, glassware, porcelain, earthenware, clothes, footwear, headgear, lanyards, games, playthings, gymnastic and sporting articles, trunks and travelling bags, umbrellas, parasols, shopping bags, handbags and travel bags; Arranging of contracts, for others, for the providing of services.</p>
<p>In Class 38: Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.</p>	<p>In Class 9: Apparatus for recording, transmission or reproduction of sound or images; Magnetic data carriers for cruises; Headphones; Balancing apparatus.</p>
<p>In Class 41: Teaching, education, training and entertainment services; Production and distribution of television programs, shows and movies; provision of non-downloadable films</p>	<p>In Class 41: Translation and interpretation; Education, other than in the field of music; Providing of training, Other than in the field of music; Entertainment, Other than in the</p>

<p>and television programs via video-on-demand services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Publication of electronic books and journals on-line.</p>	<p>field of music; Sporting and cultural activities, other than musical performances; Discotheque services; Theatre services; Operation of bathing facilities; Swimming pool and water chute complex services; Photography services, included in class 41; Videotape film production; Organisation of seminars; Courses and lectures; Conducting of sports programmes, in particular involving cycling, diving, golf.</p>
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20) I first turn to consider the goods in class 3. The applicant contends that the opponent's specification is not "wide enough to cover and there is no overlapping with e.g. hair lotions and soaps". Clearly, both specifications contain the words "Perfumery; essential oils; cosmetics" and these must therefore be regarded as identical. To my mind, the term "cosmetics" in the opponent's specification would include "make-up; eye make-up; eyeliners; blushers; lipsticks" and so these are also identical to the opponent's specification. The term "cosmetic" applies to products which are designed to beautify the body, although "hair lotions" and "soap" can be used simply for cleansing, they do also frequently have a beautifying effect or at least are claimed to have this result. These products must therefore be regarded as highly similar to the opponent's "cosmetics".

21) Turning to class 9, the applicant contends that the opponent's specification is not "wide enough to cover and there is no overlapping with e.g. "computer hardware; computer software; computer peripherals; computer components and parts". For its part, on the term "computer hardware", the opponent comments that its evidence shows that "the term encompasses a range of goods that make up the physical components of a computer system" it instances the computer case, monitor, keyboard etc. which can also be described as "computer peripherals" and indeed "computer components and parts", "keyboards", "electronic data processing equipment", "micro-processors" and "electronic control apparatus". Within its specification the opponent has "apparatus for reproduction of sound or images" which would include a computer monitor, speakers and microphones under *Meric* (para 17 above). To my mind, these goods are identical to the applicant's goods "computer hardware; computer peripherals; computer components and parts".

22) The opponent points out that the terms “computer networking and data communications equipment; telephones; aerials; wires for communication” are by their nature identical to “Apparatus for recording, transmission or reproduction of sound or images” particularly given the type of equipment in the applicant’s specification would be used for VOIP services such as Skype. I accept this view and so these must be considered identical.

23) The opponent contends that the applicant’s goods of “electronic memory devices; programmed-data-carrying electronic circuits” are identical to its “Magnetic data carriers for cruises” as they are all electronic devices for carrying data. I agree with this contention and so these goods are identical.

24) As I understand it “electrodes” are conductors of electricity and are present in semi-conductors which would be present in the opponent’s goods “Apparatus for recording, transmission or reproduction of sound or images”. To my mind these are highly similar goods.

25) The remaining items in the applicant’s specification in class 9 are “computer software; batteries; video films”. These would, in my view be sold through the same outlets as the opponent’s goods “Apparatus for recording, transmission or reproduction of sound or images”; they would be purchased by the same consumers, and travel on similar trade channels. They are closely interlinked, for instance “video film” may be used to record images, batteries would most probably be used on cameras etc. and undoubtedly the opponent’s equipment would involve computer software. Taking all this into consideration the applicant’s goods of “computer software; batteries; video films” must be regarded as highly similar to the opponent’s goods in this class.

26) Moving onto the goods in class 14, the applicant’s specification of “jewellery; precious stones; chronometric instruments” are clearly identical to the terms “Jewellery; Ornaments [jewellery, jewelry (Am.)]; Jewellery stones; Timepieces; Time instruments” in the opponent’s specification. I note that the applicant in its counterstatement only draws a distinction in respect of its term “precious metals”. However, as the evidence of the opponent makes clear retailers of jewellery commonly also deal in precious metals such as buying and selling bullion, and indeed the jewellery they sell is made of precious metals. Of the goods applied for in class 14 “jewellery; precious stones; chronometric instruments” are therefore identical to the opponent’s goods in the same class, whilst “precious metals” is highly similar to the opponent’s goods.

27) The class 16 goods of the two parties have a number of identical terms “bookbinding materials; photographs; Paper; cardboard; stationery supplies; plastic materials for packaging (not included in

other classes)” which are therefore identical. I note that the applicant is silent on these goods. It is equally clear that the terms “books; printed publications; printed matter; periodical magazines;” are encompassed by the terms “Brochures relating to cruises; Catalogues relating to cruises” in the opponent’s specification. Similarly, “adhesives for stationery or household purposes” is encompassed by the term “stationery”, and “artists’ paint brushes” is encompassed in the opponent’s “Artists’ materials”.

28) To my mind the terms “music sheets; music scores; educational supplies; Instructional and teaching material (except apparatus)” would include paper versions of music sheets and scores, and printed instructional and teaching material. These would therefore be highly similar to the opponent’s Paper, stationery and brochures and catalogues. They would be sold from similar outlets to similar consumers and follow similar trade channels.

29) As to the remaining goods in the applicant’s specification “computer printers (Inking ribbons for -); typewriters; printing blocks” I do not regard these as similar to any of the opponent’s goods and I note that the opponent is silent upon these goods.

30) I next turn to the goods in class 25. As the opponent has the terms “Clothing; Footwear; Headgear” in its specification these encompass the entirety of the applicant’s specification, and so must be regarded as identical.

31) Turning to the goods in class 26 they both have the term “artificial flowers” within them and these goods are clearly identical. The applicant merely makes the point that the opponent’s specification is “not wide enough to cover and there is no overlapping with” the other terms. For its part the opponent refers me to the decision BL O-109-14 where the Hearing Officer found:

“39) The statement of case refers to the opponent’s class 24 goods which cover textiles and textile goods, and household textile items, which it considers to be of the same nature and/or that the goods in class 26 and the goods in class 24 can all be used for making clothing and accessories. In relation to “lace and embroidery, ribbons and braid” then I agree that these are clearly similar to textiles in the piece (which would be covered by the earlier mark’s class 24 terms); the goods are similar in nature, purpose and trade channels, all being used, as the opponent states, to make clothing and other textile based items – **these goods are similar to a high degree**. I extend this finding to buttons, which, although the nature is somewhat different,

the purpose and channels of trade are still similar. In relation to “hooks and eyes, pins and needles”, again, the nature is different, but there seems to me to be a complementary relationship as the goods are for making items with textiles and are important for the use of the other. The goods are likely to be sold through the same trade channels; **there is a reasonable degree of similarity.**”

32) I adopt the Hearing Officer’s reasoning and his conclusions, which corresponds with my own view of the matter.

33) Turning to the services in class 35, the applicant does not comment upon these services. The opponent points out the clear overlaps where the services of the opponent are identically worded or encompass the applicant’s specification. I find the following services to be identical.

Applicant’s specification	Opponent’s specification
Advertising, Presentation of goods on communication media, for retail purposes; Publication of publicity texts; Rental of advertising space; Dissemination of advertisements.	Advertising;
Arranging subscriptions to telecommunications services for others;	Arranging of contracts, for others, for the providing of services.

34) In relation to the residue of services claimed by the applicant, the opponent contends that these are similar to its Class 35 service “Advertising”. In support of this contention it refers me to the findings of the General Court (GC) in Case T-58/16 (*Apax Partners LLP v EUIPO*) where the GC held at paragraph 49:

“Nevertheless, as the Board of Appeal rightly noted, firstly, “business management” services and “office functions”, which imply, typically, in particular, the renting and running of office equipment and photocopying, secretarial and typing duties can be offered by the same specialised suppliers, secondly, those services are aimed at the same consumers, namely, professional business customers and, thirdly, they contribute to the same purpose, namely the proper running and success of an undertaking. In those circumstances, the Board of Appeal did not err in its assessment finding that “office functions” services were similar, to a low degree, to “business management” services. The “business administration” services in class 35 covered by the mark applied for. It must be noted that, as the EUIPO states, the “business administration”

services covered by the application for registration have the same purpose, are addressed to the same consumers and offered by the same kind of specialised undertakings as the “business management” services covered by the earlier mark. In those circumstances, the Board of Appeal’s assessment, according to which those services are similar, which moreover, is undisputed by any of the applicant’s arguments, must be confirmed.”

35) I do not accept the contention put forward by the opponent and do not accept that the case relied upon is on all fours with the instant case. To my mind, the class 35 services “business management and business administration, employment agency services relating to temporary and permanent placement of personnel; conducting skills evaluation for individuals; consultancy relating to personnel management; Business management and organization consultancy; Computerised file management;” are not similar to the opponent’s “advertising services”. In reaching this decision I rely upon the views set out in paragraph 18 above.

36) I next turn to the class 38 services. The opponent does not have any services registered in the class but is instead relying upon its goods in class 9. The opponent contends:

“It is well established that telecommunications services are similar to equipment used for telecommunications and broadcasting, such as is encompassed by the term “apparatus for transmission of sound or images” which includes equipment for television or radio broadcasting, as well as telephone and wireless broadband communications equipment, which transmits sound and images along with other data. These goods and services have the same intended purpose and are supplied by the same commercial undertakings, such as BT, Sky and Virgin Media, and through the same trade channels. Consumers therefore expect them to originate from the same commercial undertaking and be supplied under the same brand. The class 38 services in the application are accordingly similar to at least a medium degree with the goods covered in class 9 of the earlier mark.”

37) I note that in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

38) Also in *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“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.”

Whilst on the other hand:

“.....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.

39) Taking all the above into consideration I consider that the applicant’s services in class 38 are reasonably similar to the opponent’s class 9 goods.

40) Lastly I consider the services of the two parties in class 41. The applicant contends there is no overlap with the following services “Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services” but is otherwise silent. Certain elements are obviously identical as they use identical or alternative terms.

Applicant’s services	Opponent’s services
Teaching, education and training services;	Education, other than in the field of music; Providing of training, Other than in the field of music;

entertainment services;	Entertainment, Other than in the field of music;
Arranging and conducting of workshops (education), congresses, lessons	Education, other than in the field of music; Organisation of seminars; Courses and lectures;
Organization of exhibitions for cultural or educational purposes	Organisation of seminars; Courses and lectures; Education, other than in the field of music;

41) I also believe that the applicant’s specification of “Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services;” is encompassed by the opponent’s specification of “Entertainment, Other than in the field of music” and “Videotape film production”. These I believe to be similar.

42) However, the residue of the applicant’s services “Publication of electronic books and journals on-line” have nothing equivalent or even remotely similar in the opponent’s class 41 services. I note that the opponent is silent upon these services in its submissions. Whilst the opponent has some printed matter goods in its class 16 specification it did not seek to rely upon these goods in its opposition to the class 41 services either in its statement of grounds or its submissions. I therefore regard the aforementioned services in class 41 to be not similar to the opponent’s services.

Comparison of trade marks

43) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

44) It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
AIDA	Aido

45) The applicant contends that visually the marks are dissimilar as the last letter is different “a” and “o”. They are aurally dissimilar as the “rhythm and number and sequence of their syllables are completely different”. It also contends that:

“According to the Oxford Online dictionary, the pronunciation of the “AIDA” element of the earlier marks are “eɪdə”, while the pronunciation of the “Aido” element of the subject mark is similar to the word “aidos” whose pronunciation is “ˈaɪdɒs”. There is no common syllable between the “AIDA” element of the earlier marks and the “Aido” element of the subject mark. Conceptually there is no similarity between the “AIDA” element of the earlier marks and the “Aido” element of the subject mark. According to Oxford Online Dictionary, the “AIDA” element refers to a “material consisting of a mesh of small holes, used in cross-stitch embroidery”, while the “Aido” element of the subject mark is recognised by the dictionary as referring to the ancient Greek concept of shame, modesty, or reverence, especially as a motivating force.”

46) The opponent points out that the marks differ only in their last letter, that both are two syllable marks “AI-DA” and “AI-DO” and that the letters “a” and “o” at the ends are both soft sounds. It states that AIDO is an invented word, and that most consumers would not attribute any particular meaning to the mark AIDA, and therefore both marks are conceptually neutral.

47) I do not agree fully with either party. To my mind the marks are clearly visually similar sharing as they do the first three letters with only the last letter being different, but they are short marks and in such circumstances differences are often seen. Aurally, I think it depends on whether the consumer is aware of the opera AIDA. If they are they will almost undoubtedly pronounce the opponent’s mark AH-EE-DUH or AYE-EE-DUH. In which case they will probably do much the same to the applicant’s mark AH-EE-DOH or AYE-EE-DOH. Those unfamiliar with the opera will probably agree with the opponent’s agent and pronounce them as AY-DA and AY-DO. In either case they have aural

similarities. I do not accept that the average consumer for the range of goods and services sought to be registered will be aware of a very obscure English word and an even more abstruse ancient Greek term. I agree with the opponent that the marks are, for the majority of the general public, conceptually neutral. Those that are aware of the opera Aida, will have conceptual differences between the marks, but this will be a very small number of the average consumers. Overall I believe that the similarities outweigh the differences such that **the marks must be regarded as similar to a medium degree at least.**

Distinctive character of the earlier trade mark

48) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

49) The opponent’s mark has no meaning for the goods and services for which it is sought to be registered. As I stated earlier in this decision, I do not accept that the average consumer will be aware of a highly obscure word from the world of embroidery, which even those involved in embroidery may not have come across. The average consumer will consider the opponent’s mark to be an invented

word and so it is **inherently distinctive to at least a medium degree**. The opponent has not shown use of its mark, and **so cannot benefit from enhanced distinctiveness**.

Likelihood of confusion

50) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public including businesses who will select the goods and services by predominantly visual means, although I do not discount aural considerations and that they are likely to pay an average degree of attention to the selection of said goods and services.
- the marks of the two parties are similar to a medium degree.
- the opponent's mark has a medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the goods and services of the two parties are fall into a number of categories. The applicant's following goods and services are identical to those of the opponent:

Class	Goods or services
3	Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks.
9	Computer hardware; computer peripherals; computer components and parts; keyboards; electronic data processing equipment; electronic control apparatus; micro-processors;

	computer networking and data communications equipment; telephones; aerials; wires for communication; electronic memory devices; programmed-data-carrying electronic circuits.
14	Jewellery; precious stones; chronometric instruments.
16	bookbinding materials; photographs; Paper; cardboard; stationery supplies; plastic materials for packaging (not included in other classes); books; printed publications; printed matter; periodical magazines; adhesives for stationery or household purposes; artists' paint brushes.
25	Clothing; footwear; headgear; swimwear; sportswear; leisurewear; clothing for children; infant wear; articles of clothing for women; sleepwear, lingerie; hosiery; nightwear; sports clothing; gym-wear; beach clothing; belts [clothing]; underwear; socks; gloves; men's and women's jackets, coats, trousers, vests.
26	Artificial flowers.
35	Advertising, Presentation of goods on communication media, for retail purposes; Publication of publicity texts; Rental of advertising space; Dissemination of advertisements. Arranging subscriptions to telecommunications services for others.
41	Teaching, education and training services; entertainment services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes;

The following goods are highly similar to those of the opponent:

Class	Goods
3	hair lotions; soap.
9	computer software; batteries; video films; electrodes.
14	precious metals
16	music sheets; music scores; educational supplies; Instructional and teaching material (except apparatus)"
26	Lace; embroidery; ribbons; braid;

The following goods and services are reasonably or moderately similar to those of the opponent:

Class	Goods and services
26	Buttons; hooks and eyes; pins; needles.

38	Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.
41	Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services.

The following goods and services are not similar to those of the opponent:

Class	Goods and services
16	Computer printers (Inking ribbons for -); typewriters; printing blocks.
35	Business management and business administration, employment agency services relating to temporary and permanent placement of personnel; conducting skills evaluation for individuals; consultancy relating to personnel management; Business management and organization consultancy; Computerised file management;
41	Publication of electronic books and journals on-line”

51) In view of all of the above, and allowing for the concept of imperfect recollection there is a likelihood of consumers being confused into believing that the goods and services listed above as being identical, highly similar or reasonably/moderately similar and provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2)(b) therefore succeeds in respect of those goods and services.**

52) **However, the opposition under section 5(2)(b) must fail in relation to those goods and services identified above as being not similar.**

CONCLUSION

53) The opposition succeeds in respect of the following goods and services:

Class	Goods or services

3	Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soap.
9	Computer hardware; computer peripherals; computer components and parts; keyboards; electronic data processing equipment; electronic control apparatus; micro-processors; computer networking and data communications equipment; telephones; aerials; wires for communication; electronic memory devices; programmed-data-carrying electronic circuits; electrodes; computer software; batteries; video films.
14	Jewellery; precious stones; chronometric instruments; precious metals.
16	bookbinding materials; photographs; Paper; cardboard; stationery supplies; plastic materials for packaging (not included in other classes); books; printed publications; printed matter; periodical magazines; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; educational supplies; Instructional and teaching material (except apparatus).
25	Clothing; footwear; headgear; swimwear; sportswear; leisurewear; clothing for children; infant wear; articles of clothing for women; sleepwear, lingerie; hosiery; nightwear; sports clothing; gym-wear; beach clothing; belts [clothing]; underwear; socks; gloves; men's and women's jackets, coats, trousers, vests.
26	Artificial flowers; Lace; embroidery; ribbons; braid; Buttons; hooks and eyes; pins; needles.
35	Advertising, Presentation of goods on communication media, for retail purposes; Publication of publicity texts; Rental of advertising space; Dissemination of advertisements. Arranging subscriptions to telecommunications services for others.
38	Telecommunications and broadcast communication services; transmission and streaming of data content via computer and global information networks; operating of electronic communications networks; providing access to databases; providing access to online databases via portals; electronic data interchange; telecommunications services for providing access to computer databases; providing data access to databases for downloading information via electronic media.
41	Teaching, education and training services; entertainment services; Arranging and conducting of workshops (education), congresses, lessons; Organization of exhibitions for cultural or educational purposes; Production and distribution of television programs, shows and movies; provision of non-downloadable films and television programs via video-on-demand services.

54) The opposition fails in respect of the following goods and services:

Class	Goods and services
16	Computer printers (Inking ribbons for -); typewriters; printing blocks.
35	Business management and business administration, employment agency services relating to temporary and permanent placement of personnel; conducting skills evaluation for individuals; consultancy relating to personnel management; Business management and organization consultancy; Computerised file management;
41	Publication of electronic books and journals on-line”

55) The above finding in favour of the opponent is contingent upon its EU mark 12773371 achieving registration. Any reduction in the specification which is registered by EUIPO will, potentially, have an effect upon the outcome of this opposition.

COSTS

56) As the eventual outcome depends upon the opponent’s mark achieving registration I will deal with the issue of costs in the supplementary decision once the registration process at OHIM has been concluded. The appeal period for this decision will not begin until the supplementary decision has been issued.

Dated this 24th day of October 2017

**George W Salthouse
For the Registrar,
the Comptroller-General**