

**O-545-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3292919  
FOR THE FOLLOWING TRADE MARK:**



**IN THE NAME OF  
KEVIN JOHN DAVIS AND ANTHONY EDWARD TUCKER**

**IN CLASSES 6 AND 8**

**AND OPPOSITION THERETO UNDER NO. 413508  
BY SYKES-PICKAVANT LIMITED**

## Background and pleadings

1) On 27 February 2018, Kevin John Davis and Anthony Edward Tucker ('the applicant') applied to register the trade mark reproduced on the front cover of this decision under no. 3292919. The application was accepted and published in the Trade Marks Journal on 25 May 2018 in respect of the following goods:

*Class 6: Metal tool boxes; metal safes; metal storage containers; metal industrial packaging containers; metal wall mounted tool racks.*

*Class 8: Hand operated hand tools and hand operated implements being: hex key sets, pliers, cutters, spanners, manual drills, ratchet wrenches, saws, scrapers, screwdrivers, socket sets, squares, tongs, wrenches, nut drivers, sanders, putty knives, engravers, bolt cutters, wire cutters, wire nippers, wire strippers, mauls, hatchets, nail sets for construction, socket wrenches, vices, paint scrapers, rammers, chisels, hand-operated riveting tools, glass cutters, hammers, hand cable splicers, hand held cutting tools, hand jacks, hand operated lifting jacks, sharpening wheels, picks, pincers, planers, punches, drill bits for hand drills, extension bars for hand tools, extensions for hand tools, flexible head spanners, adjustable spanners, crowbars, abrading tools (hand operated).*

2) Sykes-Pickavant Limited ('the opponent') oppose the application on the basis of sections 5(1), 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ('the Act').

3) In respect of the section 5(2)(b) claim the opponent relies upon the following earlier UK trade mark registrations. It states that the respective marks and goods are sufficiently similar to result in there being a likelihood of confusion:



**Mark:**

**Number:** 1255631

**Goods relied upon:** Class 8: *Hand-tools and parts thereof included in Class 8*

**Date of filing:** 3 December 1985

**Date of entry in register:** 3 December 1985



**Mark:**

**Number:** 2067512

**Goods relied upon:** Class 8: *Hand tools; spanners; socket sets; torque wrenches; screwdrivers; pliers; circlip tools; chisels; punches; files, hammers; valve spring compressors; valve seat cutters and refacing tools; piston ring compressors; fuel injection, carburettor and exhaust tool sets; brake service tools; clutch service tools; pipe benders; flaring tools, coil spring compressors; ball joint separators; pullers; hydraulic and percussion pullers; vehicle body repair tools; hexagon key sets; hacksaws; saw blades; riveters; tool boxes and chests; lubrication tools; stud setter and extraction tools, parts and fittings for use with the aforementioned goods.*

**Date of filing:** 2 April 1996

**Date of entry in register:** 29 November 1996



**Mark:**

**Number:** 2067514

**Goods relied upon:** Class 8: *Hand tools; spanners; socket sets; torque wrenches; screwdrivers; pliers; circlip tools; chisels; punches; files, hammers; valve spring compressors; valve seat cutters and refacing tools; piston ring compressors; fuel injection, carburettor and exhaust tool sets; brake service tools; clutch service tools; pipe benders; flaring tools, coil spring compressors; ball joint separators; pullers; hydraulic and percussion pullers; vehicle body repair tools; hexagon key sets;*

*hacksaws; saw blades; riveters; tool boxes and chests; lubrication tools; stud setter and extraction tools, parts and fittings for use with the aforementioned goods.*

**Date of filing:** 2 April 1996

**Date of entry in register:** 8 November 1996

4) The opponent relies upon its earlier 1255631 as the basis of its section 5(1) claim.

5) With regard to its section 5(4)(a) claim the opponent argues to have earlier rights in the three earlier signs as shown below. The opponent claims that by virtue of the use made of the earlier signs it has acquired goodwill and that there would be a misrepresentation to the public and result in damage to the goodwill:

**Sign:** SP Sykes-Pickavant

**Date of first use:** 1921

**Goods and services:** *The supply, manufacture and distribution of tools, automotive tools and hand-held diagnostic equipment*

*Hand tools including hand tools; spanners; socket sets; torque wrenches; screwdrivers; pliers; circlip tools; chisels; punches; files, hammers; valve spring compressors; valve seat cutters and refacing tools; piston ring compressors; fuel injection, carburettor and exhaust tool sets; brake service tools; clutch service tools; pipe benders; flaring tools, coil spring compressors; ball joint separators; pullers; hydraulic and percussion pullers; vehicle body repair tools; hexagon key sets; hacksaws; saw blades; riveters; tool boxes and chest; lubrication tools; stud setter and extraction tools, parts and fittings for use with the aforementioned goods; diagnostic apparatus for determination of faults in motor vehicles and internal combustion engines; smokemeters; inflammable gas detectors; sensor, compression, injection, catalytic carbon monoxide and cooling system testers; emission analysers; brake bleeders; timing lights; tachometers; ammeters; electrical system test kits; multifunction analysers; tyre pressure gauges; inspection lamps; code readers; cylinder head leak detection kits; setting/locking and fuel pump timing kits for diesel engines; parts and fittings for all the aforesaid goods.*

**Sign:** SP

**Date of first use:** 1921

**Goods and services:** *As above.*



**Sign:**

**Date of first use:** 1996

**Goods and services:** *As above.*

6) The applicant filed a counterstatement denying the claims made. It also requested that the opponent provides proof of use of the earlier trade marks relied upon.

7) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides also filed written submissions in chief and in lieu of attendance of a hearing. Therefore, my decision is based on the evidence and submissions filed by both parties which I can confirm that I have read and shall bear in mind. Both parties are professionally represented.

### **The earlier mark and proof of use requirements**

8) The earlier marks qualify as the acceptable basis to oppose the application as defined in section 6 of the Act. Since the earlier mark is over 5 years old from the date of publication of the application, and the holder has requested proof of use as set out in section 6A of the Act which states:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

### *Relevant period*

9) The relevant period for proof of use is the five-year period ending on the date of publication of the application in the UK, namely 26 May 2013 to 25 May 2018. Under section 100 of the Act the onus is on the opponent to show genuine use of its mark during this period in respect of the goods relied upon.

## **EVIDENCE**

### ***Opponent's evidence***

10) The opponent's evidence consists of a witness statement and exhibits filed by Mr Paul Archer who is the managing director of the opponent, a position he has held since 19 December 2014.

11) Mr Archer states that his company “is the manufacturer and distributor of an array of products in the automotive tool and handheld diagnostic equipment sector”<sup>1</sup> and that the products are split into four groups: brake and suspension, diagnostics, engine service tools plus bodyshop and workshop tools.

12) Exhibits PA1 to PA6 consist of a selection of product brochures dated between July 2013 and August 2018. I duplicate the top of the earliest brochure below:

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<sup>1</sup> Paragraph 3



# Sykes-Pickavant®

Workshop Solutions

13) There are numerous references to SP within the text of the brochure. I duplicate two examples below:

**96015000**  
**SP Induction Heater - Coil Kit**  
 • Contains 8 x popular sizes of interchangeable coils  
 (15mm, 19mm x 2, 22mm, 26mm, 32mm, 38mm, 45mm)

**HIGHER QUALITY  
 COILS AT NEW  
 LOWER PRICE!**




**£99.95**

and

**96035000**  
**SP Induction Heater -  
 Extended Coil Kit**  
 • Contains 6 x extra long interchangeable coils  
 (312mm long) - 15mm, 19mm, 22mm, 26mm,  
 32mm, 38mm

**£119.95**



14) Each of the products has a code which is preceded by the mark . The goods include a wide range of tools with their prices varying from below £100 for goods such as rope coils, wrenches, etc to over £100s for various drills and other hand held tools, to thousands of pounds for goods such as booster packs. The remaining brochures follow the same theme.

15) Exhibit PA7 consists of 25 invoices. Some are addressed to Cork, Ireland and Spain so they do not assist the opponent with its claim to use in the UK. However, many of them are to UK based customers. All of them are headed as follows and are for goods such as “flaring tool kit”, “brake and fuel lime clamp”, “crimping tool”, “screw extractor set”, etc:



16) In terms of marketing Mr Archer states that the opponent attends various exhibitions and trade shows throughout the UK and across the relevant period. He lists the events that the opponent attends which were throughout the UK between 2014 and 2019.

17) There is no reference in the evidence to turnover.

18) The opponent also filed evidence in reply though this is made of various rebuttals and arguments made in response to the applicant. I have read the evidence and shall bear it in mind when making my decision, but not summarise it here.

### ***Applicant's evidence***

19) The applicant's evidence consists of a witness statement and exhibits from Mr Anthony Edward Tucker who is the CEO/Director of SP Tools having been appointed to the role in July 2006. The legal entity of "SP Tools" has not been provided.

20) Mr Tucker states that he has been trading under the SP TOOLS mark for over 14 years and in February 2013 commenced trading in the UK under the same mark.

21) The applicant provides evidence of its use and details of where the marks may have crossed paths which it is effectively filing to support its argument that there have not, to date, been any instances of confusion. Further, the applicant refers to its European Union Trade Mark ("EUTM") which "date back to 3 January 2012"<sup>2</sup>, but no further specific details have been provided. I shall deal with each of these arguments later in this decision.

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<sup>2</sup> Para. 4 of the witness statement

## DECISION

### *Proof of use case-law*

22) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale

and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

23) I begin by reminding myself that the relevant period is between 26 May 2013 and 25 May 2018. Further, the marks and goods relied upon are set out as follows:

Mark	Goods
	Class 8: <i>Hand-tools and parts thereof included in Class 8</i>
	Class 8: <i>Hand tools; spanners; socket sets; torque wrenches; screwdrivers; pliers; circlip tools; chisels; punches; files, hammers; valve spring compressors; valve seat cutters and refacing tools; piston ring</i>

	<p><i>compressors; fuel injection, carburettor and exhaust tool sets; brake service tools; clutch service tools; pipe benders; flaring tools, coil spring compressors; ball joint separators; pullers; hydraulic and percussion pullers; vehicle body repair tools; hexagon key sets; hacksaws; saw blades; riveters; tool boxes and chests; lubrication tools; stud setter and extraction tools, parts and fittings for use with the aforementioned goods.</i></p>
 <b>Sykes-Pickavant</b>	<p><i>Class 8: Hand tools; spanners; socket sets; torque wrenches; screwdrivers; pliers; circlip tools; chisels; punches; files, hammers; valve spring compressors; valve seat cutters and refacing tools; piston ring compressors; fuel injection, carburettor and exhaust tool sets; brake service tools; clutch service tools; pipe benders; flaring tools, coil spring compressors; ball joint separators; pullers; hydraulic and percussion pullers; vehicle body repair tools; hexagon key sets; hacksaws; saw blades; riveters; tool boxes and chests; lubrication tools; stud setter and extraction tools, parts and fittings for use with the aforementioned goods.</i></p>

**Sufficient use**

24) Proven use of a mark which fails to establish *that “the commercial exploitation of the mark is real”* because the use would not be *“viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark”* is therefore not genuine use.

25) An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>3</sup>

26) In paragraph 14 of the applicant's written submissions of 8 March 2019 it states that:

“As requested, the Opponent has provided evidence of use of the marks relied on in the opposition. The Applicant accepts that use has been demonstrated for the SP logo mark (registration no. 2067512) and the SYKES-PICKAVANT logo mark (registration no. 2067514), however there is very minimal evidence of use of the SP TOOLS logo mark (registration no. 1255631).”

27) The concession made is a sensible one. Whilst the opponent has not provided turnover figures, the evidence clearly demonstrates that the goods have been offered for sale (see the various brochures) and sales (invoices) have taken place. I have no reservation in concluding that the mark(s) have been used during the relevant period. Since there is a question over whether the '631 mark has been used, I shall still assess the proof of use.

### ***Form of use***

28) The mark  is present at the top of the invoices and  is present next to each product within the brochure. Therefore, the opponent has amply demonstrated that it has used its '512 and '514 marks.

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<sup>3</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM T-415/09*

29) There are no specific examples of the '631 mark being presented as registered,



i.e. . Further there is no use of SP solus. Therefore, the question is



whether use of is sufficient for it to be able to rely upon the '631 mark. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

30) The distinctive character in the '631 registered mark rests in the letters SP with the word "TOOLS" playing a descriptive role. The opponent has demonstrated use of



. The letters "sp" is the most distinctive element but the circle device (with the angular stripes) is also a distinctive element. Taking the guidance set out in *Nirvana*,



I find that the use of is not an acceptable variant of



### ***Fair specification***

31) Although the applicant has conceded use of two of the earlier relied upon registrations, I do not take this to be a concession for all of the earlier relied upon

goods. Therefore, I must now consider whether, or the extent to which, the evidence shows use for all or only some of the relied upon goods<sup>4</sup>. Each of the earlier relied upon marks cover “hand-tools” at large. The brochures and invoices amply demonstrate that they cover a wide range of handheld tools and it would be pernicky of me to limit these goods to any extent. In fact, the brochures and invoices are so wide ranging I consider the use to be sufficient to cover all of the goods covered by each of the trade mark registrations.

32) Following my findings in relation to the proof of use, I shall proceed on the basis

of trade mark registration number 2067512 for the mark , covering all of the goods for which it is registered. If necessary I shall then consider the remaining marks which the opponent may rely upon.

### **Section 5(2)(b)**

33) Section 5(2)(b) of the Act is as follows:

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

(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”.

### *Case law*

34) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98,

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<sup>4</sup> I must take into consideration the guidance provided in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10 and *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

*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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of goods and services

35) Following my proof of use assessment, the respective goods and services are:

Applicant's goods	Opponent's goods
<p>Class 6: <i>Metal tool boxes; metal safes; metal storage containers; metal industrial packaging containers; metal wall mounted tool racks.</i></p> <p>Class 8: <i>Hand operated hand tools and hand operated implements being: hex key sets, pliers, cutters, spanners, manual drills, ratchet wrenches, saws, scrapers, screwdrivers, socket sets, squares, tongs, wrenches, nut drivers, sanders, putty knives, engravers, bolt cutters, wire cutters, wire nippers, wire strippers, mauls, hatchets, nail sets for construction, socket wrenches, vices, paint scrapers, rammers, chisels, hand-operated riveting tools, glass</i></p>	<p>Class 8: <i>Hand tools; spanners; socket sets; torque wrenches; screwdrivers; pliers; circlip tools; chisels; punches; files, hammers; valve spring compressors; valve seat cutters and refacing tools; piston ring compressors; fuel injection, carburettor and exhaust tool sets; brake service tools; clutch service tools; pipe benders; flaring tools, coil spring compressors; ball joint separators; pullers; hydraulic</i></p>

<i>cutters, hammers, hand cable splicers, hand held cutting tools, hand jacks, hand operated lifting jacks, sharpening wheels, picks, pincers, planers, punches, drill bits for hand drills, extension bars for hand tools, extensions for hand tools, flexible head spanners, adjustable spanners, crowbars, abrading tools (hand operated).</i>	<i>and percussion pullers; vehicle body repair tools; hexagon key sets; hacksaws; saw blades; riveters; tool boxes and chests; lubrication tools; stud setter and extraction tools, parts and fittings for use with the aforementioned goods.</i>
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36) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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 für 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”.

37) Applying the principle set out in *Merica* above, I find that all of the applied for class 8 goods are various types of *hand held tools*. Therefore, they are identical.

38) The position is less clear with regard to the applied for class 6 goods. In the judgment of the Court of Justice of the European Union (“the 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”.

39) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

40) The applied for *Metal tool boxes; metal wall mounted tool racks* are all goods which are used to hold, transport or store various tools, including hand-tools. Therefore, whilst they differ in nature there is a complementary relationship between the respective goods. Further, they are likely to be sold through the same distribution channels and used by the same end user. They are similar to an above medium degree.

41) I also consider the applied for *metal safes; metal storage containers; metal industrial packaging containers* to be similar, but only to a low degree. The applied for goods are used to safely store various items. They are likely to be sold through similar distribution channels and potentially purchased by the same end user. They are not in competition. They are similar to a low degree.

### **Comparison of marks**

42) 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 the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

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

44) The respective trade marks are shown below:

The applicant's mark	The opponent's mark
	

45) The earlier mark consists of a circle with two angular stripes running from the top right to the middle left. They are not particularly distinctive. In the bottom right are the letters sp. It is these letters which I consider the overall impression of the mark resides, with the circle and stripes playing subordinate roles.

46) The applicant's mark consists of letters, words and devices. It begins with the letters s and p with a star device within the letter p, followed by a spanner-head with

the word tools present below it. All of the letters are in lowercase and stylised but not to a particularly distinctive degree. In terms of overall impression, I consider the letters “sp” to be the most prominent. The device also contributes to the overall impression but to a lesser degree, with the star and device being progressively less prominent with the word tools being descriptive of the goods in question.

47) Visually, the respective marks coincide by virtue of them both containing the letters SP. They differ insofar that the applicant’s mark also contains a star device in the letter p, a spanner-head device and the word tools, all of which are not present in the opponent’s earlier mark. The circular device with angular stripes are not present in the applicant’s mark. Taking all of these into account I find that there is a low to medium degree of visual similarity.

48) The applicant has not provided any submissions with regard to aural similarity (or not, as the case may be). In my view, the applicant’s mark would be pronounced as S-P-TOOLS. Whilst the spanner-head device at a fleeting glance may be viewed as a C I think this would be limited to only a few and the clear majority would not enunciate it. The opponent’s mark would be pronounced as S-P. Therefore, they are aurally similar to a high degree,

49) Conceptually, the letters SP do not have a clear and graspable meaning. The word tools in the applicant’s mark will be viewed as descriptive of the goods. Therefore, I find that since the letters have no meaning, nor are they suggestive of the goods, a conceptual comparison is not possible, and the position is neutral.

### **Average consumer and the purchasing act**

50) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

51) 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.”

52) The goods at issue are various tools and various storage items made of metal. Whilst some goods concerned may be relatively expensive (as indicated by the opponent’s evidence) and purchased infrequently, this cannot be said to be the case for all of the goods, some of which will be moderately priced (again, as indicated by the opponent’s evidence) and purchased on a more frequent basis, e.g. wrenches. The relevant public will be both the general public and professionals.

53) I consider that members of the public will pay no more than a medium degree of attention during the selection process for the goods at issue, whereas the professional consumers may pay a higher than medium degree of attention whilst selecting the goods to ensure the product chosen is fit for purpose.

54) The average consumer is likely to purchase the goods from specialist suppliers either in a retail premises or from a website or catalogue. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural element to the purchase of these goods, given that advice may be sought from sales representatives or by telephone.

### **Distinctive character of the earlier trade mark**

55) 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).”

56) The level of distinctive character of a trade mark can vary, depending on the particular goods at issue: a mark may be more distinctive for some goods than it is for others. Distinctiveness can also be enhanced through use of the mark. There has not been an explicit claim of enhanced distinctiveness. Even if there had been a claim to enhanced distinctiveness, the evidence would not have supported such a claim. The opponent has not provided any turnover figures, an indication of the size of the market and its share thereof.

57) From an inherent perspective, the earlier mark is not descriptive or allusive of the goods in question. However, the mark only consists of two letters and a circular device which is not stylised to a remarkable extent. Accordingly, I find that the earlier mark has a medium degree of inherent distinctive character.

## GLOBAL ASSESSMENT AND OTHER ARGUMENTS

### *Arguments*

58) As previously stated the applicant's evidence is that the respective parties have been using their marks and, to date, there are no instances of confusion. There is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little<sup>5</sup>. For example, in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held at paragraph 22 that:

"It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

59) I am prepared to accept that the applicant is using its mark in respect of tools in the UK and Europe. The applicant's evidence demonstrates that it has advertised and participated in various events throughout the UK. However, I am not aware of

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<sup>5</sup> See also *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch)

the extent of sales and what use has been made of the in what must be a significant UK market. The implication of not knowing the extent of use means that I am unable to conclude the proposition that the marks have been trading on a concurrent basis. Therefore, I reject this line of argument.

### *Likelihood of confusion*

60) Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. It is a global assessment where 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 necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

61) Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

62) To determine whether there is a likelihood of direct or indirect confusion I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the factors I have set out above.

63) I have found that the respective goods are either identical or similar to a medium or low degree. I also concluded that the respective marks are visually similar to a low to medium degree, they are aurally similar to a high degree and a conceptual comparison is not possible. I have also found that since the earlier mark has a medium degree of inherent distinctive character. I concluded that the goods will be

purchased following a visual inspection of the goods (though I do not discount aural considerations) whereby members of the public will pay no more than a medium degree of attention will be paid whereas professional consumers will pay a higher than medium degree of attention.

64) Taking all of the above factors into account I do not consider that the average consumer will mistake one mark for another and so there is no likelihood of direct confusion. However, I do consider the indirect likelihood of confusion position to be different. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

65) I also bear in mind the guidance in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, whereby Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. However, I am of the view that whilst the average consumer will notice the differences in the marks, they will merely consider that the respective marks originate from the same, or an economically linked, undertaking.

66) Both marks share the letters SP and the application includes the descriptive word “tools” and the device of a spanner-head. I consider that the use of the letters in both marks, even for goods which are of low similarity, would attribute the differences to a rebranding exercise, and so I find there is also a likelihood of indirect confusion.

67) Although the opponent’s section 5(2)(b) has succeeded in full, I shall nevertheless go on to consider its section 5(4)(a) claim.

#### **SECTION 5(4)(a)**

68) the opponent’s claim under section 5(4)(a) is set out in paragraph 6 above. It is convenient for me to set out the position in relation to its alleged earlier right in the

sign  which I have already found the opponent to have established use.

*The law*

69) Section 5(4)(a) of the Act states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

*The case law*

70) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

71) Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

### **Relevant date**

72) Since the opponent has not filed any evidence to support that it has used its mark, the date at which I must assess the section 5(4)(a) claim is the date of the UK designation<sup>6</sup> or, as is the case here, the claimed priority date, i.e. 16 January 2015.

### **Goodwill**

73) In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 the House of Lords defined goodwill as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

74) It is clear that the opponent has the requisite goodwill, in terms of the operation of a business in the tool sector. This is clear from the concession made, the advertising materials evidenced, and the numerous invoices submitted.

### **Misrepresentation**

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<sup>6</sup> *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person

75) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

76) In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant

public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

77) Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

78) Bearing in mind my assessment of the similarities between marks already made, together with my assessment that the opponent has the requisite goodwill, I am satisfied that “a substantial number” of the opponent’s customers or potential customers will be deceived. Whilst recognising the difference in legal tests between likelihood of confusion and misrepresentation differ, the outcome is the same. Therefore, the section 5(4)(a) ground of opposition succeeds.

## **DAMAGE**

79) In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff’s goodwill by the

deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.

80) In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

81) In this case, and bearing in mind where I have held misrepresentation, there is a likelihood of damage based on the potential loss of sales and damage in the more general sense outlined in the above case.

#### **DECISION - SECTION 5(1)**

82) Since the opponent has succeeded in respect of its section 5(2)(b) and 5(4)(a) claims I am not required to assess the section 5(1) claim.

#### **OVERALL CONCLUSION**

83) The opposition has succeeded in full. Therefore, subject to appeal, trade mark application no. 3292919 shall be refused registration.

## **COSTS**

84) The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent/applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£200
Considering the other side's statement and preparing a counterstatement	£200
Preparing evidence and considering and commenting on the other side's evidence	£500
Written submissions	£100
<b>Total</b>	<b>£1000</b>

85) I therefore order Kevin John Davis and Anthony Edward Tucker, being jointly and severally liable, to pay the sum of £1000. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19<sup>th</sup> day of September 2019**

**Mark King**  
**For the Registrar,**  
**The Comptroller-General**