

O/650/18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK 3292856

BY

MORRIS JONES & ASSOCIATES LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 9



AND

OPPOSITION THERETO (NO. 600000887)

BY

FAISAL PATEL

## Background and Pleadings

1. MORRIS JONES AND ASSOCIATES LTD (the Applicant) applied to register the trade mark, shown on the cover page of this decision, on the 27 February 2018 for goods outlined in class 9 below<sup>1</sup>. It was accepted and published on the 16 March 2018 and now stands for the following specification:

CLASS 9: headsets for mobile telephones.

2. FAISAL PATEL (the Opponent) opposes the application by way of the fast track opposition procedure, under section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of his earlier series of UK trade marks, registration number UK3197765 which was filed on the 21 November 2016 and registered on the 17 February 2017.

i.	ii.
	DON

3. The series of marks is registered in respect of goods and services relied upon in classes 3,14, 25 and 35.

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<sup>1</sup> by way of form TM21B dated 28.6.18 the Applicant removed the specification in class 25 in its entirety from his application and is only proceeding under class 9

CLASS 3: Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices; Aftershave; After-shave lotions; Perfume; Perfumed body lotions; Musk(Perfumery).

CLASS 14: Precious metals and their alloys; Jewellery, precious stones; Horological and chronometric instruments; Jewellery articles; Jewellery boxes; Jewellery cases; Jewellery, including imitation jewellery and plastic jewellery; Jewellery watches.

CLASS 25: Clothing, footwear, headgear; Articles of sports clothing; Baseball caps; Beach clothes; Belts [clothing]; Belts for clothing.

CLASS 35: Advertising; Business management; Business administration; Office functions; Retail and online retail services connected with the sale of perfumery, cosmetics, clothing, footwear, headgear and accessories therefor, spectacles, leatherware, namely leather clothing, footwear, headgear, leather bags, cases, suitcases, travelling bags, boxes, purses, wallets, credit card cases, belts and key cases, clocks and watches, jewellery, stationery.

4. The Opponent relies on all the goods and services in class 3, 14, 25, and 35 for which the marks are registered. The Opponent claims that there is a likelihood of confusion because under section 5(2)(b) the trade marks are similar and are to be registered for goods or services identical with or similar to those for which the earlier marks are protected.

5. The Opponent submits in his statement of grounds that

*“The Applicant’s mark is similar to.... And is applied for in respect of goods that are identical or highly similar to the goods and the retail services covered by the Earlier Trade Mark.”*

*“The word element is identical to the word mark being the second mark of the series and is identical to the predominant word of the first mark of the series.”*

*“As a result, there exists a likelihood of confusion on the part of the public, including a likelihood of association with the earlier mark.”*

6. The Applicant filed a defence and counterstatement denying the claims made and submitting that

*“The word DON is globally and commonly used for many different purposes and for the purposes of a global appreciation, the average consumer of the category of products and distinctiveness is deemed to be reasonably well-informed and reasonably observant and circumspect.”*

7. The Opponent’s mark consists of a series of two marks. The earlier mark for the word “DON” (ii. above) is arguably the most visually, aurally and conceptually similar to the Applicant’s trade mark. This represents the Opponent’s strongest case overall and it is on the basis of this trade mark that I shall assess the ground of opposition.

8. The Opponent is represented by L.J. Bray & Co. The Applicant is unrepresented. Both have filed initial submissions and the Applicant has filed additional submissions in lieu of hearing. Neither party has applied for leave to file evidence and the matter has therefore proceeded in accordance with the Fast Track procedure. The decision is taken upon the careful perusal of the papers.

## **Preliminary issues**

9. The Opponent applied to consolidate proceedings following an opposition raised to the filing of two further applications by the Applicant. This was refused following a case management hearing on the 15 August 2018 as consolidation would lead to delay. This matter proceeds therefore on this opposition only.

10. The Applicant submits and provides examples of a number of other registered trade marks using the word DON which supply "*wines, pots, pans etc*", however, this is not relevant to this decision, which is based on the current opposition under section 5(2)(b) and a comparison of the two marks before me.

## **Decision**

11. The opposition is based on section 5(2)(b) of the Act which states:

"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".

12. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for

registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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

13. In these proceedings, the Opponent is relying upon his UKTM registration shown above, which qualifies as an earlier trade mark under section 6 of the Act. As the earlier mark had been registered for less than five years at the date the application was published it is not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all the goods and services of his registration without having to establish genuine use.

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

The principles:

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may 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 greater 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 to mind the earlier mark, 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.

### **Comparison of goods and services**

15. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European

Union("CJEU") in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer inc* Case C-39/97, where 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".

16. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

17. In addition, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks)* (IP

*TRANSLATOR*) [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ("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".

19. The Opponent submits that the goods covered are "*similar or complementary to the earlier mark.*" The Applicant submits that "*The services are not similar or identical.... the likelihood of confusion or association is none existing.*"

20. To establish a likelihood of confusion between the marks it is essential for there to be identity or similarity between the goods or services. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that (my emphasis):

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

21. When assessing this all relevant factors need to be considered, the nature, intended purpose, method of use and whether they are in competition or are complementary. The case of *2nine Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-363/08* considered whether class 25 goods were similar to certain goods in classes 9,14 and 26.

30. According to settled case-law, in assessing the similarity of the goods, all the relevant factors relating to those goods should be taken into account, including, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account such as the distribution channels of the goods concerned (see Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR II-2579, paragraph 37 and the case-law cited).

40. It must, moreover, be pointed out that the fact that the goods in question may be sold in the same commercial establishments, such as department stores or supermarkets, is not particularly significant, since very different kinds of goods may be found in such shops, without consumers automatically believing that they have the same origin (*PiraÑAM diseño original Juan Bolaños*, paragraph 30 above, paragraph 44; see also, to that effect, Case T-8/03 *El Corte Inglés v OHIM – Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 43).

22. For the purposes of considering the issue of similarity of goods and services I have grouped together the terms collectively rather than go through each item in the Applicant's specifications. The comparison is therefore between headphones for mobile phones and class 3 (toiletries), class 14 (jewellery), class 25 (clothing) and class 35 (retail/advertising services).

23. Headphones cannot be considered similar to clothing, headgear, footwear, jewellery, toiletries or accessories to these items; they are electronic equipment for listening to audio material. They are completely dissimilar. The goods are manufactured from different raw materials by different industries and sold through different distribution channels and outlets. Even if there was a cross over in the trade channels, in so far as internet sales and conventional shopping channels are concerned, they are likely to be sold in different areas of a shop or online departments. No consumer would determine that there would be any identity or similarity in the goods. The items belong to different markets and could not compete with one another. There is no complementarity between them where one could be used or was indispensable to the other so that consumers would think that the same or linked undertakings were responsible.

24. I must consider whether there is any similarity between "*headphones for mobile phones*" and "*retail services connected with the sale of ...headgear and accessories*". In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

25. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

26. However, on the basis of the European courts’ judgements in *Sanco SA v OHIM* (Case C-411/13P), and *Assembled Investments (Proprietary) Ltd v. OHIM* (Case T-105/05 at paragraphs [30] to [35] of the judgement), upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*(Case C-398/07P), Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods 'X' as though the mark was registered for goods X;

iv) The General Court's findings in Oakley did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

27. It is not necessary for the goods covered by the application to be identical to the goods specified in the Opponent's retail services specification in order for there to be a complementary relationship between them, it is however necessary for there to be sufficiently close relationship between the respective goods and services that the public might reasonably believe that they are complementary goods/services likely to be offered by the one and the same undertaking.

28. I see no such relationship between "*retail services connected with the sale of ...headgear and accessories*" and "*headphones*". There is no similarity between headphones in class 9 and the Opponent's services in class 35.

29. I conclude therefore that the respective parties' goods or services are not identical or similar. Under s5(2)(b) for there to be a likelihood of confusion between the marks there has to be a finding of similarity between the goods or services. Since I have determined that they are not, then I need not compare the marks further.

## **Conclusion**

30. The opposition fails under section 5(2)(b) of the Act. Subject to appeal, the application may proceed to registration.

## Costs

31. The opposition having failed, the Applicant is entitled to a contribution towards its costs. For fast track opposition proceedings, costs are capped at £500 according to TPN 2/2015. The parties attended a case management hearing where the issue of consolidation was discussed and refused. Neither party sought costs in relation to that hearing. I take into account the fact that the Applicant is unrepresented and has not incurred any legal fees and therefore the award for costs is as follows:

Preparing a counterstatement, submissions	£200
and considering the notice of opposition	

32. I therefore order Faisal Patel to pay Morris Jones & Associates LTD the sum of £200. The sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of October 2018

Leisa Davies

For the Registrar