

O/863/22

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 03659086 BY
HOUSE MANAGE LIMITED
AND
HOLNESS GLOBAL CORPORATION LIMITED
TO REGISTER THE TRADE MARK:**



IN CLASS 7

AND

**OPPOSITION THERETO
UNDER NO. 428209
BY
INDASA-INDUSTRIA
DE ABRASIVOS, S.A.**

BACKGROUND & PLEADINGS

1. House Manage Limited and Holness Global Corporation Limited (**“the applicants”**), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 22 June 2021. It was accepted and published in the Trade Marks Journal on 20 August 2021 for the following goods:

Class 7: Vacuum cleaners; Wet vacuum cleaners; Household vacuum cleaners; Car vacuum cleaners; Electric vacuum cleaners; Vacuum cleaner hoses; Domestic vacuum cleaners; Cordless vacuum cleaners; Electric domestic vacuum cleaners; Electric carpet vacuum cleaners; Vacuum cleaners for cars; Hand-held vacuum cleaners; Wet and dry vacuum cleaners; Hand held vacuum cleaners (Electric -);Electric vacuum cleaners for domestic use; Vacuum cleaners for household purposes; Vacuum cleaners powered by rechargeable batteries; Vacuum cleaners for the cleaning of surfaces.

2. INDASA-INDUSTRIA DE ABRASIVOS, S.A. (**“the opponent”**) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (**“the Act”**). The opponent is the proprietor of the following mark:

Trade Mark no.	UK00914503577 ¹
Trade Mark	
Goods	Classes 3, 7 & 8
Relevant Dates	Filing date: 26 August 2015
	Date of entry in register: 30 March 2016

3. For the purpose of this opposition, the opponent relies on some goods in Class 7, as follows:

Class 7: Sanding and polishing machines with suction systems, Machine tools, motors and engines (except for land vehicles); Coupling and transmission components (except for land vehicles); Agricultural implements other than hand-operated; Incubators for eggs; Automatic vending machines.

4. In its notice of opposition, the opponent argues that the competing marks are similar visually, phonetically, and conceptually, stating that “[t]he same element of a rhinoceros is included in the Application.” Further, it claims that the contested goods are similar to the opponent’s.
5. In response, the applicants filed a counterstatement, asserting that “the opponent is taking undue advantage, creating confusion and misleading the tribunal, hence filed the opposition in a bad faith.” The applicants denied any similarity between the marks. In particular they claimed that:

¹ The trade mark relied upon by the opponent is a ‘comparable’ trade mark. It is based on the opponent’s earlier EUTM, being registration number 09247065. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

“3. That the opponent mark is a complete shape of RHINO animal. However, opponent cannot claim the rights of animal for their trademark.

4. That the applicant mark is comprising of a unique shape of Rhino face which is enclosed in a two arc shape stylish design with words RHINO TECHNOLOGY.

5. The opponent mark includes a words “INDASA” which has no such meaning available in the dictionary. Applicant further request to provide the description of trademark including the translation of the words INDASA if it's a foreign word.” (sic)

The applicants request that the opponent provides proof of use of its earlier mark relied upon.

6. Both parties filed evidence in these proceedings, which will be summarised to the extent that I consider necessary.
7. Only the opponent filed written submissions in lieu of a hearing which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
8. In these proceedings, the opponent is represented by Withers & Rogers LLP and the applicants by United Legal Experts.
9. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Relevant Date/Period

10. An “earlier trade mark” is defined in Section 6(1) of the Act:

“(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or European Union 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. [...]

11. As the earlier mark relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

“(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), (aa) 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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)-(5A) [Repealed]

(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.”

12. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

13. In accordance with Section 6(1) of the Act, the opponent’s trade mark clearly qualifies as an earlier mark. The relevant period for proof of use of the opponent’s mark is **23 June 2016 to 22 June 2021**. I note that the opponent in its witness statement and submissions erroneously stated a slightly different period. In the present proceedings, the opponent relies on a UK comparable mark, and, thus, it is possible for the opponent to rely on

evidence of use in the EU as set out in Tribunal Practice Notice 2/2020.² In accordance with paragraph 7(3) of Part 1 of Schedule 2A of the Act, the assessment of use shall take into account any use of the corresponding EUTM prior to IP Completion Day, being 31 December 2020. Therefore, for the portion of the relevant five year period between **23 June 2016 and 31 December 2020**, evidence of use of the mark in the EU may be taken into account.

14. The relevant date for the assessment of likelihood of confusion as per Section 5(2)(b) is the date on which the contested application was filed, namely **22 June 2021**.

EVIDENCE

Opponent's Evidence

15. The opponent's evidence consists of a witness statement by Maria Manuel Soares Monge Pinho dos Santos, who is a member of the Board of the opponent, a position they have held since June 2021. The main purpose of the evidence is to demonstrate that the earlier mark has been genuinely used in the UK for the relevant period.

Applicants' Evidence

16. The applicants' evidence consists of a witness statement by Duwayne Holness, Director of House Manage Limited and Holness Global Corporation Limited.
17. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

² See 'Tribunal Practice Notice (2/2020) End of Transition Period – impact on tribunal proceedings'.

DECISION

Proof of Use

18. 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].”

19. As the earlier mark is a comparable mark, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court noted that:

“36.It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use. [...]

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark. [...]

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

20. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance

with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

21. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since *Leno* and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute

genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted Leno as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]- [40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of Leno persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multifactorial one which includes the geographical extent of the use."

22. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even

where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

23. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i. The scale and frequency of the use shown
- ii. The nature of the use shown
- iii. The goods and services for which use has been shown
- iv. The nature of those goods/services and the market(s) for them
- v. The geographical extent of the use shown

24. The onus is on the proprietor of the earlier mark to show use. This is in accordance with Section 100 of the Act, which states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

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

Form of the Mark

26. In Case C-12/12 *Colloiseum Holdings AG v Levi Strauss & Co.*, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.”

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the

purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (Emphasis added)

27. Where the issue is whether the use of a mark in a different form, rather than with, or as part of, another mark, constitutes genuine use of the mark as registered, the decision of Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, in *Nirvana Trade Mark*, BL O/262/06, is relevant. He said:

"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."

28. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of

the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

29. For convenience, I reproduce the registered as mark below:



30. The mark consists of a figurative and a word element. The figurative element comprises an entire rhinoceros presented within a square frame. The word element, sitting underneath the figurative element, is the word “INDASA”, which has no obvious meaning, in block capitals and black font. Despite the size of the rhinoceros device, and in accordance with settled case-law,³ it is my view that the word element will be more distinctive as the relevant public is more likely to keep verbal elements in mind to identify and quote the mark instead of describing its figurative element.

31. In some circumstances, the earlier mark is used in the same format as registered, such as brochures, invoices and promotional materials provided with the opponent’s evidence. Clearly, this will be use upon which the opponent may rely. Throughout its evidence, though, the opponent has used its mark in more than one way. I have reproduced below examples of how the mark is used in the evidence:

³ *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.



32. As explained above, albeit the size and positioning of the figurative element, the word element “INDASA” is more distinctive as detailed above. The evidence shows that the word element “INDASA” is used on its own (as in ‘a’ above) or separated from the rhinoceros device (as in ‘b’ above). As cited above in *Lactalis*, changes to the figurative elements in composite marks are less likely to change the distinctive character of the mark. In this respect, I find that the use in the form as exemplified in ‘a’ is not an acceptable variant use, as the device is omitted altogether, whereas the use in ‘b’ will be an acceptable variant use.

33. As shown in 'c' above, I also note that the mark as registered appears in other colour adaptations. The difference in colour of the mark as registered has very little impact on its distinctiveness. This is because it will be recognised for what it is, namely a different colour. Similarly, the strapline "*indasa-abrasives.com*" will be recognised as the opponent's website address without affecting the distinctiveness of the mark. Consequently, I do not consider that the use in these forms alters the distinctiveness of the registered mark, and these are variants upon which the opponent can rely as per *Lactalis*.

Genuine Use

34. As indicated in the case law cited earlier in this decision, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".
35. The witness statement of Maria Manuel Soares Monge Pinho dos Santos provides a copy of the opponent's brochure, dated September 2021 (post-dating the relevant period), stating that it was "specifically created for the UK Market".⁴ I note that the brochure demonstrates various products, including abrasives, discs, strips, sheets, rolls, and polishing products under the registered mark, including its acceptable forms as identified in the previous section. In addition, publications, dated September 2016 and October-November 2018, are adduced with the evidence where sanding and polishing products bearing the registered mark are detailed.⁵

⁴ Exhibit MPS01.

⁵ Exhibit MPS02.

36. Further, an unchallenged annual breakdown of the UK sales figures from 2015 to 2021 relating to goods sold under the earlier mark is provided with the witness statement.

Year	Sales Value (£)
2015	365,220
2016	439,849
2017	509,233
2018	418,337
2019	416,199
2020	308,884
2021	350,488
TOTAL	2,808,211

37. The figures begin at over £365,000 in 2015, fluctuating over the years to approximately £350,000 in 2021. Whilst the 2016 and 2021 figures include turnover falling outside (pre-dating or post-dating) the relevant timeframe, it is reasonable to assume from the previous annual figures that at least a portion of the turnover, and sales of the goods in that respect, will fall within the relevant time period.
38. In addition to the above figures, a set of redacted invoices⁶ all addressed to the UK, for example, Devon, Bridgend, Leicester, Chilham, Wigan, Wolverhampton, etc., showing sales of various quantities of a range of products, including (line/filmline) discs; sealants; tube creams; dust extraction units; sanders; work station units; sanding sponge; dust extraction hose; masking cover roll; masking foams and tapes; dust bags under the earlier mark. I note that there are six invoices from 2018, nine from 2019, eight from 2020, nine from 2021, and seven from 2022. However, I identify that only four invoices from 2021 fall within the relevant period, while the rest post-date the relevant period. I note that the earlier mark is clearly demonstrated on the top left corner of each of the invoices.

⁶ Exhibit MPS03.

Further, I note that the opponent did not provide any evidence in relation to its market share.

39. The opponent exhibited evidence of adverts,⁷ namely an undated promotional material, titled “E-SERIES-PROFESSIONAL ELECTRIC TOOLS”, promoting a brushless motor and a mobile vacuum unit containing a mockup of a stand decoration for an exhibition, having a date of 2021.
40. Although the evidence could have been better and more comprehensive in parts, such as demonstration of market share and marketing expenditure, an assessment of genuine use is a global assessment, which requires looking at the evidential picture as a whole and not whether each individual piece of evidence shows use by itself.⁸ Bearing in mind the forms of the mark I have said may be considered, I am satisfied that the evidence supports genuine use in the UK of the mark during the relevant period. As such, the opponent can rely upon the registered mark for the purpose of these proceedings.

Fair specification

41. I must now consider what a fair specification would be for the use shown.
42. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs K.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to

⁷ Exhibit MPS04.

⁸ See *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

43. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("*Thomas Pink*") at [52].

iv) In cases of partial revocation, pursuant to Section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("*Asos*") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

44. The goods and services at issue are in Class 7 for which the opponent made a statement of use. The opponent has submitted that the earlier mark has been used in relation to all the goods relied upon in this opposition. One of the areas in which the opponent’s evidence could have been more helpful is to illustrate the link between what they have used the mark on, and how that relates to the specification they have registered. This is particularly so given the technical nature of the use in the case at hand. From my perspective, the evidence only really shows use of the mark on goods in relation to abrasives, such as sanding and polishing.⁹ The specification in Class 7 reads as follows:

Class 7: Sanding and polishing machines with suction systems, Machine tools, motors and engines (except for land vehicles); Coupling and transmission components (except for land vehicles); Agricultural implements other than hand-operated; Incubators for eggs; Automatic vending machines.

45. Some of the terms in Class 7 are far too broad to properly reflect the use shown and would not represent a fair description. Some of the terms do

⁹ Exhibit LS4.

not really represent the use shown, for example, “*Agricultural implements other than hand-operated; Incubators for eggs; Automatic vending machines*”. Consequently, I consider a fair specification to be:

Class 7: Sanding and polishing machines with suction systems, Machine tools, motors and engines (except for land vehicles) **for the purpose of sanding and polishing**; Coupling and transmission components (except for land vehicles) **for sanding and polishing machines**.

Section 5(2)(b)

46. The relevant statutory provisions are as follows:

Section 5(2)(b) of the Act states:

“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.”

47. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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.

Comparison of Goods

48. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

49. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

50. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

51. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

52. Taking into account the fair specification I indicated earlier, the competing goods to be compared are shown in the following table:

Opponent's Goods	Applicants' Goods
Class 7: Sanding and polishing machines with suction systems, Machine tools, motors and engines (except for land vehicles) for the purpose of sanding and polishing; Coupling and transmission components (except for land vehicles) for sanding and polishing machines.	Class 7: Vacuum cleaners; Wet vacuum cleaners; Household vacuum cleaners; Car vacuum cleaners; Electric vacuum cleaners; Vacuum cleaner hoses; Domestic vacuum cleaners; Cordless vacuum cleaners; Electric domestic vacuum cleaners; Electric carpet vacuum cleaners; Vacuum cleaners for cars; Hand-held vacuum cleaners; Wet and dry vacuum cleaners; Hand held vacuum cleaners (Electric -); Electric vacuum cleaners for domestic use; Vacuum cleaners for household purposes; Vacuum cleaners powered by rechargeable batteries; Vacuum cleaners for the cleaning of surfaces.

53. In the notice of opposition, the opponent claims that the contested goods are similar to the earlier goods. In addition, the opponent in its submissions asserts that they are highly similar stating the following:

“26. Nature

Both the Applicant's Goods and Registered Goods are suction machines, and therefore have an identical nature.

27. Intended Purpose

The Applicant's Goods, namely vacuum cleaners, are intended to collect dust and debris by means of suction. The Registered Goods, namely “Sanding and polishing machines with suction systems” are

also intended to collect dust and debris by means of suction. The respective goods thus have the same intended purpose.

28. Method of Use

Both the Applicant's Goods and Registered Goods are machines operated by humans. They thus have the same or a highly similar method of use.

29. Competition

The Registered Goods could be substituted for the Applicant's Goods insofar as the suction function of the Registered Goods is concerned. Thus, the respective goods are in competition.

30. Distribution channels

The respective goods would be made available to purchase in trade and DIY stores. Further, the goods will be offered for sale in the same section of such shops due to their common nature, method of use and intended purpose.

31. Relevant Public

Both the Applicant's Goods and the Registered Goods are aimed at tradespersons and those intending to do DIY work.

32. Usual Origin

Manufacturers of the Registered Goods would also manufacture the Applicant's Goods. Indeed, the Opponent manufactures the Applicant's Goods, as shown on page 43 of Exhibit MPS01."

54. The applicants, in their notice of defence, deny any similarity between the respective goods.

55. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are

sufficiently comparable to be assessed in essentially the same way for the same reasons.¹⁰

Vacuum cleaners; Wet vacuum cleaners; Household vacuum cleaners; Car vacuum cleaners; Electric vacuum cleaners; Domestic vacuum cleaners; Cordless vacuum cleaners; Electric domestic vacuum cleaners; Electric carpet vacuum cleaners; Vacuum cleaners for cars; Hand-held vacuum cleaners; Wet and dry vacuum cleaners; Hand held vacuum cleaners (Electric -); Electric vacuum cleaners for domestic use; Vacuum cleaners for household purposes; Vacuum cleaners powered by rechargeable batteries; Vacuum cleaners for the cleaning of surfaces.

56. The contested terms are all different types of vacuum cleaners for various uses, including domestic use. The opponent's goods, "*Sanding and polishing machines with suction systems [...]*", are machines with suctioning capabilities used for sanding and polishing surfaces. The competing goods share the same nature, namely they are all machines using suction. Although there might be an overlap in the general purpose, their end-purpose is different. The contested goods are intended to clean large surfaces, whereas the earlier goods have a narrower purpose, that of suctioning the dust produced from sanding and polishing works. Although the competing goods may be sold in large stores, I do not consider that they will be sold in close proximity. In the absence of specific submissions or evidence to assist me, it is my view that the contested goods will be found in the domestic appliances section as opposed to the opponent's goods in the DIY tools section. Further, the respective goods are neither in competition nor complementary, where consumers are likely to believe that the same commercial undertaking could offer the respective goods. Taking all the above factors into account, I find that there is a low degree of similarity.

¹⁰ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Vacuum cleaner hoses

57. The contested goods are hoses for vacuum cleaners. The closest comparable term from the earlier specification is “*Coupling and transmission components (except for land vehicles) for sanding and polishing machines*”. I can see no meaningful similarity in terms of the nature, intended purpose, or method of use nor are the goods at issue in competition with or complementary to the opponent’s goods in the same Class. Thus, I find them to be dissimilar.

Average Consumer and the Purchasing Act

58. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

59. The opponent claims that “both the Applicant’s Goods and the Registered Goods are aimed at tradespersons and those intending to do DIY work.”
60. The goods at issue will be purchased by members of the general public or professionals and businesses. Such goods are usually offered for sale in stores and specialist ones, such as DIY stores, brochures, catalogues, and

online. The goods will be displayed on shelves and racks in retail premises, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant web pages. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment, as advice may be sought from a sales assistant or representative. The average consumer may examine the products to ensure suitability and whether the goods possess the desired features. In this regard, the average consumer is likely to pay a higher than average degree of attention, although not the highest, when selecting the goods at issue.

Comparison of Trade Marks

61. 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 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.”

62. 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.

63. The marks to be compared are:

Opponent's Mark	Applicants' Mark
	

Overall Impression

64. The contested mark consists of figurative and word elements. The figurative element comprises a rhinoceros head, encaged in a curvy triangular frame, which, to my mind, resembles a shield. Next to the figurative element is the distinctive word “RHINO”, appearing in bold and large upper font case and a standard typeface, underneath which sits the word “technology.”, smaller in size and lower case. The figurative element and the verbal element “RHINO” make a roughly equal contribution and have the greatest weight in the overall impression, with the word “technology.” playing a less prominent role being allusive to the goods offered by the applicants. The word element “RHINO” will be more distinctive as the eye will also be drawn to the verbal element of the mark as the average consumer more easily refers to marks by the word than by describing a figurative element.¹¹

65. As delineated above in paragraph 30 of this decision, the earlier mark consists of the figurative element of an entire rhinoceros and the word element “INDASA”, with the latter being more distinctive for the reasons

¹¹ *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.

advanced previously. Although the device element is larger than the word element, they both have equal weight in the overall impression.

Visual comparison

66. In its submissions, the opponent claims that:

“18. The respective marks are visually highly similar by virtue of the dominant element of each mark being an image of a rhino.”

67. I disagree with this view for the reasons set out below.

68. Visually, the similarity between the marks is that both contain a figurative element of a rhinoceros. There are, though, visual differences between the marks. Although the marks share the same animal, rhinoceros, they are noticeably different. The contested mark depicts a side image of a part of a rhinoceros (head) as opposed to the earlier mark depicting the entire animal. Further, the word elements are different in the competing marks, namely “INDASA” v “RHINO” and “technology.”. Overall, taking into account the overall impressions and weighing the various points of similarity and difference, I consider that the marks are visually similar to a very low degree.

Aural comparison

69. The average consumer will pronounce the verbal element “INDASA” in the earlier mark as “IN-DA-SA”. The contested mark contains the verbal elements “RHINO” and “technology”, and they will be verbalised as “RYE-NOH” and “TEK-NOL-UH-JEE”. Further, I do not consider that the average consumer will attempt to articulate the figurative elements of the competing marks. Aurally the marks are dissimilar.

Conceptual comparison

70. The opponent in its submissions considers that:

“The word INDASA within the Registered Mark has no meaning in the English language and the relevant public will therefore not associate any meaning with that element of the mark. The relevant public will rely upon the image of the rhino to associate a concept with the Registered Mark. Thus, the concept of the Registered Mark is identical to that of the Applicant’s Mark.”

71. The average consumer will immediately understand the dictionary word “RHINO” in the contested mark, which is short for rhinoceros, bringing to mind the concept of the said animal. The presence of this word will reinforce the concept that the figurative element of the animal head is that of a rhinoceros. In addition, the dictionary word “technology.” will be considered allusive to the products offered by the applicants. In terms of the earlier mark, the figurative element will be perceived as the entire of a rhinoceros. However, the word “INDASA” will be seen as a made-up or foreign language word. Against this background, the marks are conceptually similar insofar as they both convey the concept of a rhinoceros to some degree, with the concept of the given animal in the contested mark reinforced by the word element “RHINO”, albeit being limited to that of only one body part, i.e. the head. Accordingly, I find that the marks are conceptually similar between a low and medium degree.

Distinctive Character of The Earlier Trade Mark

72. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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)."

73. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
74. As described above, the earlier mark consists of the verbal element "INDASA", which will be viewed as an invented/foreign language word, and the figurative element depicting an entire rhinoceros having no meaning in relation to the goods. In this regard, while I recognise the level of inventiveness of the mark, I bear in mind that only the common element between the respective marks should be considered to evaluate the relevant (to the question of confusion) distinctiveness,¹² a point that I shall return to later in this decision. I find that the earlier mark is inherently distinctive to a high degree.

¹² See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

Enhanced Distinctiveness

75. Taking into account the evidence, which I have referred to earlier in this decision, I will now consider whether the earlier mark has acquired enhanced distinctive character through use. I should stress here that, whilst the mark is a comparable mark, it is the position in the UK that must be considered because the question is whether the average consumer in the UK will be confused. I find the evidence insufficient to demonstrate that the mark has acquired an enhanced degree of distinctive character through use in the UK for the given goods that the opponent has genuinely used the mark. Although the sales, which have been evidenced, are sufficient, they do not strike me as particularly significant in what must be a niche market. There is no indication of the market share held by the mark and no marketing expenditure figures as to the amount invested by the opponent in promoting the given mark. Overall, whilst the mark has been genuinely used, the evidence is insufficient to demonstrate enhanced distinctiveness.

Likelihood of Confusion

76. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.¹³ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.¹⁴

¹³ See *Canon Kabushiki Kaisha*, paragraph 17.

¹⁴ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

77. 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 marks are different, but concludes, due to the similarities between them, that the later mark is another brand of the owner of the earlier mark or a related undertaking (or vice versa).
78. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.C., sitting 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).”

I note that the categories identified above by Mr Purvis K.C. are not exhaustive.¹⁵

79. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, on the court’s earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may

¹⁵ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

80. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC, sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.
81. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

82. Earlier in this decision I have concluded that:

- the goods at issue range from similar to a low degree to dissimilar;
- the average consumer for the goods is a member of the general public or professionals and businesses, who will select the goods by predominantly visual means, but without dismissing the aural means. The average consumer will examine the goods to identify suitability, thereby selecting the relevant goods with a higher than average degree of attention, although not the highest;
- the competing marks are visually similar to a very low degree, aurally dissimilar, and conceptually similar between a low and medium degree;
- the earlier mark is distinctive to a high degree. The use is not sufficient to establish enhanced distinctiveness of the mark.

83. The likelihood of confusion does not arise in relation to the application's goods which are dissimilar to the earlier mark's goods. **The opposition cannot succeed against dissimilar goods and, therefore, is dismissed insofar as it concerns the following terms:**

Class 7: Vacuum cleaner hoses.

84. Taking into account the above factors, I am persuaded that there is no likelihood of direct confusion for similar goods. I make this finding on the basis that there is only a very low degree of visual similarity where the higher than average degree of attention in conjunction with the visual interaction with the goods at issue will play a significant part. In addition, the competing marks are aurally dissimilar. Notwithstanding the highly distinctive character of the earlier mark, I do not consider that the average consumer would overlook the difference in the word elements “INDASA”/ “RHINO” and “technology.”, which have an equal contribution to the overall impressions, and the different depiction of the rhinoceros in the competing marks. Therefore, I find that the similarities between the marks are such that they will not be mistakenly recalled as each other, even though the earlier mark is distinctive to a high degree .
85. Even if the average consumer recalls the points of similarity between the marks, such as that both contain the figurative element of a rhinoceros, I still consider the marks would not be indirectly confused. Sitting as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, Case BL O/547/17, James Mellor QC stated:

“81.4 [...] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining¹⁶ in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’” (Emphasis added)

¹⁶ In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10.

86. Notably, the overall impression resides not only in the figurative elements but also in the word elements of the respective marks, which I have found to be more distinctive than the rhinoceros device. In more detail, the word element “INDASA” in the earlier mark is an invented/foreign word and nothing like the words in the contested mark. Furthermore, the visual representation of the figurative elements in the competing marks is fundamentally different, and the mere fact that the marks are conceptually similar will not suffice.¹⁷ Therefore, I do not consider that the differences in the marks will be seen as consistent with a logical re-branding of one another. In this regard, I consider that there is no proper basis for an average consumer to assume that there is an economic connection between the undertakings. Consequently, I find that there is no likelihood of indirect confusion.

OUTCOME

87. The opposition has failed, and, subject to an appeal against this decision, **the application may proceed to registration in its entirety.**

COSTS

88. This opposition has failed in its entirety and the applicants are entitled to a contribution towards their costs of defending the application. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I also note that whilst the applicants filed evidence, their evidence did not assist my decision. In this regard, I award costs to the applicants as a contribution towards the cost of the proceedings on the following basis:

¹⁷ See for example Case C-251/95, *SABEL BV v Puma AG*.

Considering the other side's statement and preparing a counterstatement	£200
Considering the other side's evidence	£500
Total	£700

89. I, therefore, order INDASA-INDUSTRIA DE ABRASIVOS, S.A. to pay House Manage Limited and Holness Global Corporation Limited the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 6th day of October 2022

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General