

O-383-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2304779
BY KENRO LIMITED
TO REGISTER THE TRADE MARK:**

FUSION

IN

CLASS 20

AND

**THE OPPOSITION THERETO
UNDER NO 91335
BY ROYAL DOULTON (UK) LIMITED
BASED UPON THE EARLIER TRADE MARK:**

FUSION

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In the matter of application no 2304779

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by Royal Doulton (UK) Limited

BACKGROUND

1) On 9 July 2002 Kenro Limited, which I will refer to as Kenro, applied to register the trade mark **FUSION**. The application was published for opposition purposes in the “Trade Marks Journal” on 18 September 2002. Subsequent to the publication the specification was amended to read:

frames of metal for photographs, prints or pictures.

The above goods are in class 20 of the International Classification of Goods and Services.

2) On 18 December 2002 Royal Doulton (UK) Limited, which I will refer to as Doulton, filed a notice of opposition against the application.

3) Doulton is the owner of the following three registrations for the trade mark **FUSION**:

- United Kingdom registration no 2195684. The specification of the registration is:

tableware, ovenware, ornamental articles, models, figurines, glassware, chinaware, pottery, porcelain and earthenware.

The above goods are in class 21 of the International Classification of Goods and Services.

- United Kingdom registration no 2198596. The specification of the registration is:

electrical kitchen appliances; electric coffee makers, coffee pots, tea makers and kettles; domestic water filtering apparatus; but not including electric lamps sold separately;

kitchenware; kitchen utensils; beverage and food containers, non-electric kitchen appliances; non-electric coffee grinders, coffee makers, coffee pots, tea makers, teapots and kettles; pot holders (being articles for use in handling hot pots);

curtain, cushion, upholstery and furnishing fabrics; cushion covers; covers for furniture; bedding, bed and table covers, tablecloths, table runners, napkins, serviettes, tablemats, coasters, towels, face cloths, curtains, shower curtains, toilet

seat and lid covers, covers for tissue boxes, blinds of textile materials, textile wall hangings, handkerchiefs and travelling rugs.

The above goods are in classes 11, 21 and 24 respectively of the International Classification of Goods and Services.

- Community trade mark registration on 1368745. The specification of the registration is:

domestic and kitchen electrical appliances; coffee makers, coffee pots, tea makers and kettles; domestic water filtering apparatus; but not including electric lamps sold separately;

tableware, ovenware, ornamental articles, models, figurines, glassware, chinaware, pottery, porcelain and earthenware; kitchenware, kitchen utensils, beverage and food containers; non-electric coffee grinders, coffee makers, coffee pots, tea makers, teapots and kettles; pot holders;

textile fabrics; curtain, cushion, upholstery and furnishing fabrics; cushion covers; covers for furniture; bedding, bed and table covers, tablecloths, table runners, napkins, serviettes, tablemats, coasters, towels, face cloths, curtains, shower curtains, toilet seat and lid covers, covers for tissue boxes, blinds of textile materials, textile wall hangings, handkerchiefs and travelling rugs.

The above goods are in classes 11, 21 and 24 respectively of the International Classification of Goods and Services.

4) Doulton states that the respective trade marks are identical. It states that the term ornamental articles in two of its registrations encompasses the goods of the application. Consequently, the goods are identical and the application should be refused under the provisions of section 5(1) of the Trade Marks Act 1994 (the Act).

5) Doulton states that its registrations are for a range of household items which if not considered identical are similar to the goods of the application. It states that the respective goods are likely to be sold through the same or similar trade channels, for example in the “household” section of department stores. Therefore, there exists a likelihood of confusion and the application should be refused under the provisions of section 5(2)(a) of the Act.

6) Doulton states that it has used the trade mark FUSION in the United Kingdom for goods such as tableware, chinaware, pottery, porcelain and earthenware since 1 September 1999. It also uses the trade mark for candlesticks, desk clocks and vases. Doulton states that it has established a reputation in the United Kingdom and the use of the trade mark by Kenro would take unfair advantage of or be detrimental to the distinctive character or the repute of its earlier trade marks. Consequently, registration of the trade mark would be contrary to section 5(3) of the Act.

7) Doulton states that owing to its use of the trade mark FUSION, the trade mark enjoys a reputation and goodwill in the United Kingdom, particularly for the goods for which it is registered. Consequently, use of the trade mark by Kenro is liable to be prevented by virtue of the law of passing-off. Therefore, registration of the application should be refused under the

terms of section 5(4)(a) of the Act.

8) Kenro filed a counterstatement. It accepts that Doulton owns the trade mark registrations upon which it relies and that the trade marks are identical. It states that it has limited the goods to all being of metal. All of the grounds of opposition are denied.

9) Both sides seek an award of costs. Doulton filed evidence. In a letter dated 12 September 2003 Kenro stated that it would not be filing evidence and intended to contest the opposition through legal arguments at a hearing.

10) A hearing was held on 3 December 2003. Doulton was represented by Ms Clark of counsel, instructed by Swindell & Pearson. Kenro was represented by Mr Charlton of Elkington and Fife.

EVIDENCE OF DOULTON

11) This consists of a witness statement by Deborah Jane Bates. Ms Bates is head of legal services of Doulton. Parts of Ms Bates's statement can best be characterised as submission rather than evidence of fact. I will, therefore, not refer to these parts in this summary of the evidence. However, in coming to a decision I bear in mind the submission parts of Ms Bates's witness statement.

12) Ms Bates states that Doulton is one of the world's pre-eminent manufacturers and suppliers of luxury ceramic tableware, giftware and collectibles. One of Doulton's range of products is the Fusion range. This range was launched on 1 September 1999. Ms Bates states that Doulton also supplies "luxury home lifestyle ranges such as furnishings and interior accessories". Ms Bates exhibits, at DJB2, rather poor photocopies of pages from current Doulton brochures for Royal Doulton Classics, Minton – Haddon Hall, and Royal Albert – Old Country Roses. The Royal Doulton Classics page shows coasters, bottle stoppers, photograph frames and candle holders. The other pages all show photograph frames amongst a wide variety of other goods such as: beakers, cake stands, trays, boxes, bowls, plates, clocks, vases and tea pots. The various goods in each collection are connected/coordinated by what appears to be the same pattern appearing on all of the products. The goods, with the exception of Royal Doulton Classics, appear to be predominantly ceramic. Although owing to the quality of the photocopies this is not as clear as it might be. (As these are current brochures, I am a little bemused as to why Doulton has not supplied original copies.) The Royal Doulton Classics range of goods appear to be crystal.

13) Ms Bates states that Doulton currently sells a variety of "sourced wooden and metal photograph frames" under the Royal Doulton brand through its factory outlet in Stoke-on-Trent. (I am afraid that I do not understand what is meant by "sourced" in this context.) Ms Bates states that Doulton also sells gift sets including photograph frames in Australia, the United States of America and Japan.

14) Ms Bates states that other undertakings sell photograph and picture frames along with goods covered by its earlier registrations. She states that Laura Ashley sells its own branded range of picture frames alongside other home furnishings, accessories and ornaments. Ms Bates exhibits at DJB3 pages from the Laura Ashley website, downloaded on 5 June 2003. On a page entitled "unique gifts" appear a photograph frame, coasters, a metal tray, a bowl and candlesticks. Also exhibited, inter alia, are pages from the "Decorative" section of the

website. The goods included on these pages are vases, bowls, boxes, dishes, trays, photograph frames, clocks and pictures. Also exhibited, at DJB4, are pages from the Ikea website, downloaded on 3 June 2003. One page headed “decorations” has subdivisions into:

bowels & vases;
candles and candle holders;
clocks;
frames, framed art & posters;
mirrors;
ornaments.

Each of the above categories appears to be an entry point to a discrete area of the website.

15) Ms Bates states that Doulton has used the trade mark Fusion in relation to its products since 1 September 1999. She gives the following figures for sales in the United Kingdom:

1999	£72,552
2000	£927,206
2001	£1,558,801
2002	£1,504,804
2003 to date	£449,819.

16) Ms Bates states that the Fusion range of goods includes a Fusion Living range, under which items such as candlesticks, desk clocks, trays, vases and votives are sold. She states that total sales of Fusion Living products amounts to £94,041. Ms Bates states that purchasers of Doulton’s products are very familiar with Doulton’s practice of manufacturing and licensing products under their brands, including Fusion, in the home accessories and giftware markets as well as the practice of selling picture and photograph frames alongside other Doulton products. Exhibited at DJB5 are pages from the Doulton website, downloaded on 3 June 2003. A page headed “Fusion” shows various thumbnails of crockery under the names: Flirtation, Frivolous Blue, Fusion Gold, Fusion Platinum and Fusion White. Two thumbnails are present for Fusion Ice and Fusion Living; the former shows part of a piece of glassware, the latter a desk clock. Above the thumbnails the following is written:

“Fusion has been created to reflect and complement today’s confident, individualistic lifestyle. The essence of Fusion lies in its promotion of natural, unfettered individual expression, which is conveyed through bold, imaginative designs that are rooted in nature’s minimalist purity.

Reflecting the free-spirit and free-style qualities of modern living, Fusion allows you to choose amongst an inspiring range of colours and designs. A collection that truly matches your changing needs and moods.”

A page headed “Fusion Living” shows pictures of a candlestick, a desk clock, a square tray, two vases and a votive. All the goods would appear to be ceramic in nature. Ms Bates also refers to a page from the website headed “Lifestyle” which has thumbnails labelled bathrooms, jewellery, furniture, cutlery and mirrors.

DECISION

Evidence dependent grounds of opposition

17) The grounds of opposition under section 5(3) and 5(4)(a) of the Act are dependent upon the evidence which has been filed.

18) Section 5(3) of the Act states:

“A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

19) Section 5(4)(a) of the Act states that a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade. It is well established that the relevant date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429). The relevant date cannot be any later than the dates of the filing of the application, as section 5(4)(a) of the Act is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998, which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark”.

In this case there is no indication of the use of the trade mark by Kenro in the United Kingdom. Consequently, the relevant date is the date of the application, 9 July 2002.

20) The evidence of Doulton gives turnover figures but does not relate these to any specific goods. In the statement of grounds, in relation to section 5(3), it uses the vague phrase “such as” to describe the goods. In relation to section 5(4)(a) Doulton states it has a reputation and goodwill for the goods of the registrations. No exhibits emanating from the relevant date are furnished. The sole exhibited evidence of use consists of three pages from the Doulton website downloaded on 3 June 2003. This is well after the relevant date. It also lacks any degree of specificity. What am I supposed to make of a few thumbnails and the blurb I have quoted in paragraph 16? The latter actually says nothing about the products, in any meaningful sense. Doulton might wish to put some weight upon the Fusion Living range as it shows a variety of goods: candlestick, desk clock, tray, vase and a votive. However, the entire

turnover for the goods amounts to £94,041 and there is no indication as to whether any of this turnover occurred before the relevant date.

21) There is no indication of advertising expenditure and no advertisements exhibited. No goods are exhibited nor clear pictures of such goods. Consequently, I have no idea how the trade mark is actually presented to the public. I do not see how I can use the evidence before me to decide if Doulton has a reputation in respect of any of the particular goods. It might be that the trade mark has been used primarily on dinner services or equally on the class 11 goods. I have no way of knowing. There is an absence of hard, real fact.

22) In *General Motors Corporation v Yplon SA Case C-375/97* [2000] RPC 572 (*Chevy*) the European Court of Justice stated:

“Article 5(2) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory.”

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant factors of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.”

“The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.”

Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the

relevant date."

23) Considering the nature of the evidence furnished by Doulton, I do not consider that it has satisfied the criteria set out for either section 5(3) of the Act or for passing-off. In relation to passing-off, how can I make any reasonable judgement when I do not know the goods upon which the trade mark has been used and how it has been used? If the trade mark had been used, at the relevant date, on a variety of goods, this would give rise to a different perspective to that if it had been used on dinner services or electric kitchen appliances only. Doulton has stated in its grounds of opposition that it "enjoys a reputation and goodwill in the United Kingdom particularly in relation to goods for which the mark is registered". It has done nothing either in its grounds of opposition under section 5(4) nor in its evidence to be more specific. It has elected not to give detailed evidence supported by exhibits, it has to stand or fall by this choice.

24) On the basis of the evidence before me the grounds of opposition under sections 5(3) and 5(4)(a) of the Act cannot get off the ground.

25) The grounds of opposition under sections 5(3) and 5(4)(a) of the Act are dismissed.

Identity of goods and trade mark – section 5(1) of the Act

26) Section 5(1) of the Act states:

"(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

The basic premise of Doulton's argument in relation to the identity of the goods is that the issue is not affected by the class in which they are placed. Therefore, class 21 could include photograph frames which are ornamental articles. This seems, to me, to miss the simple point that under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as amended and modified, no frames of any description fall into class 21. If the goods are not in there, how can they be identical? This is not one of those borderline cases referred to by Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281. It is to be noted that picture frames occur in the class heading for class 20. I have checked the registry's extensive classification data base for editions 6, 7 and 8 of the International Classification of Goods and Services, frames have not appeared in class 21 in any of the editions.

27) The class the goods are placed in does count, anyway. The issue was dealt with by Mummery LJ in *Altecnic Ltd's Trade Mark Application* [2002] RPC 34:

"41 In my judgment the legal position in this case may be briefly stated:

(a) Altecnic made an application to register "CAREMIX" as a trade mark in relation to goods. On the Form TM3 it specified the goods in question both by reference to the Class number 7 and to a list of goods, which in its original state cross-referred to Class number 7 by incorporating into the list of goods "all other goods/services in this Class".

(b) The deletion of the words "all other goods/services in this Class" as requested in

the letter of March 27, 1997 was permissible under section 39(1), as Altecnic was thereby restricting the goods covered by the application to those expressly described in the list. Such restrictions and withdrawals are not subject to the express limitations on amendments contained in section 39(2).

(c) Class number 7 rightly remained in the column for Class numbers even on deletion of the words "all other goods/services in this Class", because there was no request at that stage to substitute a different Class number or to add another Class number. Class number 7 was still part of Altecnic's application in the context of the "Specification of goods". The fact that the system of classes of goods is for the purposes of administrative convenience or that the identification of a Class number serves such purposes does not prevent the statement of the Class number from being part of the application, which can only be amended in accordance with the provisions of the 1994 Act and the Rules.

(d) Altecnic's letter of May 16, 1977 was expressed as a "request that this application is transferred to Class 11 for the specification of goods as filed". Although not in terms described as such, it was in substance an amendment of the application. The reference to Class 7 in the column for the Class number was to be deleted and a reference to Class 11 inserted in its place. In the ordinary sense of the language of section 39 the application was "amended, at the request of the applicant". That could only be properly done to correct one or more of the matters specified in (a), (b) or (c) of subsection (2) of section 39. The fact that the exercise was described by the Registry in its letter of June 19, 1997 as arranging "for this application to be immediately transferred to the correct class" does not make the alteration to the application in Form TM3 any the less an amendment of the application.

(e) That amendment of the application, at the request of the applicant, was not permissible, because it did not fall within any of the three types of correction allowed under section 39(2)(a), (b) or (c). It could not be said to be a case of an "obvious mistake", as valves do fall within Class 7. The position might well be different if none of the particular goods expressly described in the "Specification of goods" column fell within goods contained in the Class number given in the "Class number" column of Form TM3. Such a case might reasonably be described as one of an "obvious mistake" in the selection of the Class number and the Class number could accordingly be corrected. Even in those circumstances, however, the amendment of the application could only be made under section 39(2) and not simply by virtue of a determination of a question under section 34 of the 1994 Act.

(f) On the facts of this case section 34 of the 1994 Act cannot be relied on as authorising the deletion of Class 7 from the application and the insertion of Class number 11 in the application. It is clear from the correspondence and other documents, read in their contextual setting, that the registrar was acceding to a request to amend the application. He was not simply being asked by Altecnic to exercise his discretion under section 34 to determine a question arising as to the class within which the goods fall. Even if he was being asked by Altecnic to make that determination, such determination alone did not suffice for Altecnic's purposes. The determination might, for example, be a prelude to a fresh application for registration in relation to goods in a different class. In most situations that would not cause any problem. But in the circumstances of this case Altecnic does not want to make a fresh application for Class 11, which would post date the application of Reliance for the same mark, and lose its priority. It is clear that it was seeking to amend the existing application, which it was only entitled to do in a case falling within section 39(2). As already explained, this was not such a case.

42 This result is not inconsistent with the approach in the current general practice of the Registry nor, as I understand it, with the general practice of OHIM in dealing with amendments to an application by treating the Class number in the application for registration as part of the application. In my judgment, the registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods. The application is a considered statement of the applicant which, on ordinary principles of the construction of documents, has to be read as a whole to determine its meaning and effect. The fact that the internationally agreed Nice Classification System has been devised to "serve exclusively administrative purposes" (see, for example, rule 2(4) of the Commission Regulation 2868/95 E.C.) does not mean that the selection by the applicant of one or more Class numbers in his application for registration has to be totally ignored in deciding, as a matter of the construction of the application, what the application is for and whether it can properly be amended. I would reject the submission of Mr Purvis that it is only permissible to take account of the Class number when it is expressly (or implicitly) referred to in the description of the "Specification of goods" column of Form TM3, as in the examples helpfully discussed by Jacob J. in *British Sugar Plc v. James Robertson & Sons Limited* [1996] R.P.C. 281 at page 289 (e.g. consideration of the relevance of the practice of the registrar at the date of registration of adding to the list "All included in this class" and "All included in class X"). That kind of case is no doubt a stronger one for interpretation of the application by reference to the Class number, but I fail to see why it should be the only kind of case in which the Class number can be taken into account by the registrar or why the registrar should have to ignore the Class number which the applicant (or his advisers on his behalf) have inserted in the Form TM3 as part of the required expression of the applicant's case in relation to the registration of the trade mark.

43 For these reasons I would allow this appeal.

44 Both the hearing officer and the judge dealt with and rejected a further submission by Reliance that, if the application by Altecnic were forced to proceed in Class 7 as set out in the unamended Form TM3, that would offend against section 3(6) of the 1994 Act, which provides that a trade mark shall not be registered if or to the extent that the application is "made in bad faith". This Court indicated that it did not wish to hear argument on that point. The appropriate course is for Altecnic to consider its position with its advisers in the light of this judgment and, if it decides to proceed with an application to register in respect of Class 7, that particular application should in the first instance be the subject of a decision by the registrar on the basis of the material before him on that application."

The reason that goods and services are in different classes is because they are different. The differences might be great or small but a difference means a lack of identity. In this case the goods in question, frames, simply are not in class 21 whatever their construction.

28) The position is also plain in respect of the Community trade mark. Rule 2(2) of Commission Regulation (EC) No 2868/95 states:

"The list of goods and services shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one

class of the Nice Classification.”

The specification cannot include goods covered by another class. The goods in the specification for class 21 could not be goods covered by class 20.

29) In this case the issue is very clear. Frames simply do not fall into class 21. Whatever goods the class 21 specifications encompass, frames are not included.

30) As the goods are not identical, the objection under section 5(1) is dismissed.

Likelihood of confusion – section 5(2)(a) of the Act

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

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

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

(b) 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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

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

32) The registrations of Doulton are all earlier trade marks in the terms of section 6(1)(a). The respective trade marks are identical. Consequently, the issue that has to be decided is as to the similarity of the respective goods.

33) In determining the question under section 5(2)(a), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

34) In *British Sugar Plc v James Robertson & Sons Limited* Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

(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.”

In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, the European Court of Justice held in relation to the assessment of the similarity of goods that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. I do not consider that there is any dissonance between the two tests. However, taking into account the judgment of the European Court of Justice, I do need to consider whether the goods are complementary.

35) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

So I need to give the terms in the specifications their natural meanings within the context of the trade. I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods or services (see above).

36) At the hearing Ms Clark submitted that the most relevant goods, for the purposes of this opposition, are *ornamental articles, models, figurines, glassware, chinaware, pottery, porcelain and earthenware*. I believe that she is correct. If Doulton does not win on the basis of these goods, it is not going to win on the basis of any of the others.

37) The argument that Doulton is running, as far as I see it, is that the goods of the application could be very well the type of goods that would be covered by various ranges of its trade marks. Consequently, one sees that picture frames occur in the Classic Crystal, Haddon Hall and Old Country Roses ranges of goods along with various items that are encompassed by its class 21 specifications. They are the sorts of goods that would be found in the same area of a shop. They are all the sort of goods that would be given for presents. As well as evidence of its own usage, Doulton has put in exhibits from other undertakings. Photograph frames are shown on the Laura Ashley website under the heading “unique gifts” along with coasters and trays. On the same website under the heading “Decorative” photograph frames are shown along with boxes, baskets, containers, clocks and pictures. These goods are not linked by any

single design feature. The term “decorative” or “gifts” covers a multitude of possibilities. Is a clock to be considered similar to a picture because it appears on the same page of a website? Also included in the evidence are pages headed informal tableware; this shows placemats, coasters, mugs, vases and glasses. The items are linked by a common design element. The only thing that the Laura Ashley website tells me is that various items may be linked by a common design element. Doulton also seeks help from the pages reproduced from the Ikea website. Under the general heading “decorations” there are various sub-headings, which presumably link to discrete web pages. These sub-headings are “bowls & vases”, “candles & candle holders”, “clocks”, “frames, framed art & posters”, “mirrors” and “ornaments”. In the “virtual department store” of the Ikea website the various categories are separated. In terms of a traditional shop, they might all be on the same floor but they are in different areas of it. “Frames, framed art & posters” is a discrete heading. Rather than supporting the case of Doulton, the Ikea exhibit is against it. The goods of the application are separated and separately categorised from the goods upon which it relies.

38) Ms Clark argued strongly in relation to the decorative/ornamental nature of the goods of the application. However, many goods are decorative and are designed to please the eye as well as serve a purpose. This does not define the use of the product. The goods of the application are to frame photographs, prints or pictures. None of the goods of the Doulton registrations serve this purpose. Therefore, the respective goods have a different use. The use effectively defines the user, it is someone who wishes to frame something. Frames have a clear purpose, they are not stand-alone products. Unlike a figurine or a vase, they have to have something added to them, the thing that is framed. I consider, therefore, that the users are different. Ms Clark pointed out, correctly, that the Doulton registration encompass various goods of metal. The specification is not limited to ceramic goods. Such goods as candlesticks, boxes and figurines could be of metal and covered by the specification. Consequently, the goods could all be made of metal and so be of the same physical nature as far as material of construction is concerned. (However, so many goods are made of metal that this can hardly be seen as a major element of establishing similarity.) There is a lack of conclusive evidence as to the respective goods appearing in the same area of a shop. The Ikea evidence contradicts this proposal. There is certainly no evidence from actual retail premises. On the basis of the evidence before me, I cannot conclude that the respective goods will be found in the same area of a shop. It might be that they are; the evidence is deficient in this point. Ms Clark argued that the respective goods are in competition. She gave a very liberal interpretation of what being in competition should mean. The respective goods could be bought as alternatives for presents eg for weddings. Equally, toasters could be given alternatively to tableware or frames. If one would substitute one article for another for a similar purpose then they would be in competition. I do not see that one would substitute a candlestick or pot for a frame. I do not consider that the respective goods are in competition. From the evidence, it would appear that the respective goods would be likely to go through similar trade channels. However, as all the goods are household items this means that they are part of the congregation of a very wide church. Finally, there is the consideration as to whether the respective goods are complementary. Unfortunately, it is difficult to state what complementary means. I tend to consider that, for the most part, it relates to goods that are mutually dependent or have a symbiotic relationship. In *QS by S Oliver* [1999] RPC 530 the hearing officer stated:

“The descriptions falling in category B cover goods which I regard as clothing accessories, such as hand bags and purses”

So he used complementary in the context of goods that are traditionally bought to match each other, such as shoes and handbags. The Court of First instance in *Pedro Díaz, SA v OHIM (CASTILLO)* Case T-85/02 recently stated:

“36. Instead the products are complementary, since, in the eyes of the relevant public, they belong to a single product family and may easily be regarded as components of a general range of milk products capable of having a common commercial origin.”

This would fit with the argument of Doulton, that the goods could be part of a common product family. From its evidence, Doulton includes picture frames in common product ranges. There is nothing to suggest that Doulton’s practice is atypical. However, the goods it relates to are all primarily ceramic rather than metallic. Also the common element of the Doulton products is not just the brand name but also the design. In fact the common element would appear to be the design. Just like marketing (see *Daimler Chrysler AG v OHIM (TELE AID)* Case T-355/00 of the Court of First Instance) design is something extraneous to the trade mark issue. I do not see that on any of the three views as to what complementary means that the respective goods can be considered to be complementary.

39) That there may be similarities between the goods does not make them similar. If that were the case all goods of metal would become similar and so the drawing pin and the elbow prosthesis would be similar. In this case the respective goods could all be made of metal and go through the same trade channels. Bearing in mind the nature of the goods, and the emporia that sell them, the latter does not say a great deal. Equally, that the respective goods could be of metal tells me little. This is a case in which I have had a great deal of difficulty in coming to a conclusion as to whether the respective goods are similar. In fact it is only in the writing of this section of the decision that I have been able to come to a determination. However, in the written analysis it has become clear to me that the respective goods cannot be considered to be similar. Ultimately the argument of Doulton rests on a common co-ordinated design, rather than on the nature of the goods. If undertakings wish to protect goods linked by a common design theme, they need to apply for the appropriate registrations.

40) The respective goods are not similar.

41) To succeed under section 5(2)(a) of the Act the goods have to be similar; that is what the Directive states, it is what the Act states. It is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

Identity of trade marks, distinctiveness of the earlier trade mark, these cannot make dissimilar goods similar. Consequently, the case under section 5(2)(a) of the Act fails.

Costs

42) Mr Charlton submitted that if the section 5(4)(a) and 5(3) grounds had not been run then a decision could have been made without need for a hearing. Consequently, he felt that this should be reflected in the award of costs. I do not see why a decision from the papers could not have been given in respect of these grounds also, if it had been requested. It is also the right of both sides to be heard. If Doulton had requested a hearing it would have been inappropriate to penalise it for so doing; to do so would be to punish a party for exercising its rights. Mr Charlton characterised these two grounds as being without any hope of success. I consider that, on the basis of the evidence, the section 5(3) ground was somewhat optimistic. However, the section 5(4)(a) ground had some legs. Mr Charlton requested the hearing, before the case had come to me for review. I can see nothing that should lead me to move away from a standard award of costs.

43) Kenro Limited having been successful is entitled to a contribution towards its costs. I order Royal Doulton (UK) Limited to pay Kenro Limited the sum of £1,000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of December 2003

**David Landau
For the Registrar
the Comptroller-General**