

O-319-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2372005
BY TRADEMARQUE TOOLS LTD TO REGISTER A
TRADE MARK IN CLASSES 6, 7, 8, 9, 16, 20, 25, 35 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 93176 BY CREDO TECHNOLOGY CORPORATION**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2372005
by TradeMarque Tools Ltd to register a
Trade Mark In Classes 6, 7, 8, 9, 16, 20, 25, 35 and 41**

and

**IN THE MATTER OF Opposition no 93176
by Credo Technology Corporation**

BACKGROUND

1. On 2 September 2004 TradeMarque Tools Ltd applied to register the following mark:

THE MARQUE OF SKILL

for a specification of goods and services that reads:

Class 06 :

Metal tool boxes.

Class 07 :

Hand held power tools.

Class 08 :

Hand tools namely spanners, socketry, screwdrivers, hammers, pliers, drill bits for hand tools sold in sets.

Class 09 :

Electronic downloadable publications.

Class 16 :

Printed publications, catalogues.

Class 20 :

Non-metal tool boxes.

Class 25 :

Clothing.

Class 35 :

Advertising.

Class 41 :

Provision of non-downloadable information from the Internet.

2. The application is numbered 2372005.

3. On 7 February 2005 Credo Technology Corporation (Credo) filed notice of opposition to this application. Credo is the proprietor of Community Trade Mark registration No. 100560, SKIL, which has a filing date of 1 April 1996 but claims seniority from three UK trade marks (13 February 1963 from B845055, 16 May 1968

from B925361 and 16 May 1968 from B925362). The goods covered by the CTM registration are:

Class : 07

Machine tools, power driven tools; power driven saws, circular saws, jig saws, table saws, grinders, drills, hammer-drills, drill presses, sanders, screwdrivers, wrenches, hammers, plate joiners, planes, routers, trimmers, engravers; attachments, tools and accessories for the above including carrying cases, holsters, saw blades, hole saws, adjustable rip fences, adapters, vices, chucks, chuck keys, key holders, sanding discs, sanding belts, grinding wheels, cut-off wheels, screwdriver bits, drill bits, nut runner sets, socket sets, mandrels, router tables, router bits, drill pumps, chisels, scrapers, masonry bits, wire wheel brushes, cup brushes, buffing wheels, polishing discs, drill stands, protractors, jig saw tables, band saw stands, edge guides, guide bushings, adapter plates, dust collector and pick up attachments, sanding frames, grass shears, hedge trimmers, eye protectors (part of the tools); their parts and fittings compromised in this class.

Class : 08

Hand tools and implements (hand operated); grass shears and hedge trimmers and their accessories including extension handles; screwdrivers, sanders, nut runners, saws, wrenches, drills, hammers, planes, routers, trimmers and engravers and their accessories including blades, bits, sockets, nuts, tool adapters, gouges, sharpening fixtures, their parts and fittings compromised in this class.

4. In response to the invitation on the Form TM7 (Opposition) to state which goods or services in the application are considered to be identical or similar to those covered by the earlier mark, the applicant answered:

“All goods in Classes 6, 7, 8 and 20
All goods and services in Classes 9, 16, 25, 35 and 41 that relate to or refer to tools or to DIY, construction, renovation and restoration services, or to equipment for such services.”

5. That forms the basis of an objection under Section 5(2)(b) of the Act. The opponent was also required to make a statement of use pursuant to the requirements of the Trade Marks (Proof of Use, etc) Regulations 2004. It claimed that the mark had been used in respect of all the goods for which it is requested [registered?].

6. In addition to the objection under Section 5(2)(b) the opponent has raised a ground under Section 5(4)(a) based on use of SKIL since 1963 in respect of a range of hand and power tools. The range of goods and services objected to is the same as the above-quoted list referred to in relation to Section 5(2)(b).

7. The applicant filed a counterstatement which in terms must be taken as denying the grounds of opposition. The counterstatement makes a number of observations on the respective goods and the parties' current trading activities. The applicant is said to have been in business for the last 25 years as a wholesaler of professional mechanical hand tools and toolboxes.

8. Attached to the counterstatement are copies of correspondence between the parties with a view it would seem to reaching a negotiated settlement. In the event negotiations never reached a mutually acceptable conclusion.

9. Both sides have filed evidence. The matter came to be heard on 17 October 2006 when the applicant was represented by Mr J D Knight and the opponent by Mr A Norris of Counsel instructed by Venner Shipley.

Opponent's evidence

10. The opponent has filed a witness statement by Nigel Philip Turtle. He is the Company Secretary of Robert Bosch Limited, a member of the Bosch Group of companies. He says that his company is responsible for the trademark SKIL.

11. The trade mark SKIL was first used in the UK in the 1960s and continued to be used until the mid 1990s in relation to circular saws. In 1996 Skil Corporation was bought by the Robert Bosch Group of companies and shortly after that the range of products was expanded to cover a wider range of power tools.

12. Currently the mark is used in the UK on:

Drills/Drivers	Plate joiners
Circular saws	Laser level devices
Jigsaws	High speed rotation tools
Orbital sanders	Angle grinders
Multi sanders	Delta sanders
Planers	Heatguns
Routers	

13. The main target market in the UK is the DIY user and light professional users. In support of this Mr Turtle exhibits

NPT 1- press releases issued by the company

NPT 2 – examples of press coverage of the goods in various national Publications

14. Goods bearing the mark have been sold throughout the UK through trade outlets and retail chains including B&Q, Focus, Homebase, Argos, Robert Dyas, Jewson, Wicks, Screwfix and Axminster Power Tools.

15. Sales figures are given as follows taking the matter up to the year in which the material date falls:

1999	£8,668,000
2000	£7,650,000

2001	£5,080,000
2002	£3,271,000
2003	£2,705,000
2004	£2,406,000

These figures are based on wholesales prices. Retail values are said to average about 30% more.

16. Advertising and marketing expenditure has been:

1999	£196,000
2000	£443,000
2001	£159,000
2002	£182,000
2003	£147,000
2004	£113,000

17. Mr Turtle says he is not aware of any other companies in the tool industry that use the word SKIL (alone or in conjunction with other words) as a trade mark for tools or similar goods. He also regards SKIL as being unique and highly distinctive.

18. As various points in his witness statement Mr Turtle refers to the possibility of providing a separate witness statement to supplement the information already given. So far as I am aware no further evidence has been filed by the opponent.

Applicant's evidence

19. John David Knight has filed a witness statement. He describes himself as the proprietor of Trademarque Tools Ltd. He has a background in the tool industry particularly serving the automotive market. He had various managerial roles with Snap-On Tools before joining Britool in 1992. Britool was a franchise operation. It introduced a new range of tools call the Hallmark range. Advertisements featured a nut device encircling the letter B coupled with the strap line "THE MARQUE OF SKILL". At this time Britool was owned by James Neil Limited. It was subsequently sold to Facom Tools, a French company.

20. Mr Knight explains that:

"In 2001, Facom reorganised and made the decision that they should no longer be involved in direct selling. They viewed the Britool Automotive Division as a direct sales operation. All of the assets, other than those deemed to be part of the Automotive Division, were hived out thereby leaving all the assets of the Automotive Division in the original company, Britool.

In early April 2001, the company name was changed to Hallmark Tools Ltd. Later that month I purchased Hallmark Tools from Facom and opened a new company, Trademarque Tools Ltd. I would confirm that I wholly own both companies and that Hallmark Tools Ltd, formerly Britool Ltd, is a subsidiary of Trademarque Tools Ltd."

21. THE MARQUE OF SKILL was used by Britool from the launch of their van franchise operation. The material exhibited to Mr Knight's witness statement shows the nature of that use. It is most commonly used with BRITOOOL in large lettering and beneath it as a strap line, the words THE MARQUE OF SKILL. The 'B in a nut device' is also usually present (see exhibits JDK1-12).

22. Mr Knight notes that the parties operate in different market sectors and says he is not aware of any conflict.

23. That completes my review of the evidence to the extent that I consider it necessary at this stage.

Section 5(2)(b)

24. The relevant part of the statute reads as follows:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

25. The term earlier trade mark is defined in Section 6(1) of the Act. The single registration relied on by the opponent is an earlier trade mark within the meaning of the Section having a filing dated of 1 April 1996 and a registration date of 19 October 1998.

26. The application in suit was published for opposition purposes on 5 November 2004. The Trade Marks (Proof of Use, etc) Regulations 2004 came into force on 5 May 2004 and require an opponent who bases his opposition to the registration of a trade mark on certain earlier trade marks to state whether he has used his mark. The Proof of Use Regulations apply in this case. The opponent stated on the second page of the Form TM7 “To the best of our knowledge, we believe that the Trade Mark has been used in respect of all the goods of which it is requested [registered]”.

27. In response to that claim, the applicant indicated that it understood the opponent's mark was only used on electric power tools. It did not, however, further itemise such goods, expressly challenge the opponent's claim or put it to proof of the claim. That may have left the opponent in some doubt as to whether (or to what extent) it was being required to make good its claim. For reasons that will emerge the point has not proved critical and the opponent has in any case provided evidence of use in relation to its core goods.

Guidance from the leading authorities

28. Mr Norris referred me to the following well known cases from the European Court of Justice - *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

29. For the benefit of the applicant who has not been professionally represented in these proceedings I will set out in summary form the guidance that emanates from these cases and which I am bound to follow:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG and Adidas Benelux BV*, paragraph 41;

- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

30. It is a key requirement that there must be similarity between the respective marks and the respective sets of goods/services. If I am satisfied that the threshold requirement for similarity has been met I am required to consider the interaction between those elements and determine whether it results in a likelihood of confusion. This is the so-called interdependency principle. I will begin by considering the goods and services as set out at the start of this decision.

Similarity of goods/services

31. Again, as one would expect, Mr Norris identified and set out key passages from relevant authorities which give guidance on how the courts and this tribunal must consider issues of similarity.

32. The starting point is the following passage from the *Canon* case:

“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 are complementary.”

33. The above passage differs in one respect from the version referred to in Mr Norris’ skeleton argument in referring to “intended purpose” rather than “end users” (as to which see paragraph 56 of *Sergio Rossi SpA v OHIM*, Case T-169/03). Nevertheless, the users of the respective goods did feature in the considerations set out in *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) [1996] RPC 281. Mr Justice Jacob (as he was then) also considered that trade channels were relevant to the matter.

34. It is abundantly clear that the applied for goods in Classes 7 and 8 are identical to the goods of the earlier trade mark. Applying the above criteria I also find that ‘metal tool boxes’ (Class 6) and ‘non-metal tool boxes’ (Class 20) are similar to the opponent’s Class 7 and 8 goods. Their nature is different to the tools themselves but the users would be the same and they would be complementary. In fact, a carrying case for, say, an electric drill if it is adapted specifically for that purpose, would be in the same Class as the tool itself. Not all carrying boxes will be adapted in this way but I would still regard them as being similar.

35. That leaves ‘Electronic downloadable publications’ (Class 9), ‘Printed publications, catalogues’ (Class 16), ‘Clothing’ (Class 25), ‘Advertising’ (Class 35) and “Provision of non-downloadable information from the Internet’ (Class 41).

36. Mr Norris' skeleton argument and submissions did not address these goods and services in detail but suggested that they were either part of the paraphernalia of DIY or, in the case of the services, have a more distant relationship.

37. I cannot help thinking that there is scope here for a rather sterile debate. It arises in my view because there is sometimes a misunderstanding on the part of applicants as to the coverage they need. To take 'advertising' as an example. I hope I am not doing this particular applicant a disservice if I say that advertising services (the sort of services that an advertising agency will provide) forms no part of its business. The misunderstanding under which applicants sometimes labour is that they think they need coverage in Class 35 so as to be able to advertise their own products. That is not the case. Advertisements, product catalogues, etc for in this case tools would constitute use in relation to the underlying Class 7 or 8 goods but would not be evidence of the provision of an advertising service. The misfortune in all this from an applicant's point of view is that it results in unnecessary expense in securing registrations in Classes that are of no real relevance and potentially nugatory effort in defending such registrations in the event of a later challenge.

38. It also follows from the above that I am not persuaded that these other goods and services are in conflict with the goods of the opponent's earlier trade mark. In reality they are largely a side issue in this case and, for that reason I do not propose or need to consider the position in more detail.

The parties' actual trade

39. I have dealt with the similarity of goods/services on the basis of the plain wording of the specifications presented to me. It has, however, been a consistent theme of the applicant's pleaded case, evidence and Mr Knight's submissions at the hearing that the parties operate in different market sectors.

40. In particular it is said that the opponent is a manufacturer of power tools for sale to the DIY and light professional market. In contrast, Mr Knight describes the applicant's business as that of a wholesaler selling to the automotive after-market. On that basis, it is said that the parties' are not in competition with one another. For the applicant's benefit (particularly in the event that the matter goes to appeal) I should briefly explain why this line of argument is of no assistance.

41. Firstly, it is well established that the tribunal must consider the full notional scope of the specifications before it. Thus, if a specification covers printed publications, all forms of such goods (books, magazines, newspapers etc) must be allowed for even if in practice the mark is only used or intended to be used on a single item or in a particular part of the market for such goods.

42. Secondly, it will rarely if ever be possible to cast specifications in terms which seek to differentiate on the basis of particular marketing methods or concepts. In *Daimler Chrysler AG v OHIM*, Case T-356/00, [2003] E.T.M.R 61 the Court of First Instance held that:

“46 However, contrary to what the Office argues, the Court finds that a sign's descriptiveness must be assessed individually by reference to each of the

categories of goods or service listed in the application for registration. For the purposes of assessing a sign's descriptiveness in respect of a particular category of goods or service, whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing concept involving goods and services in other categories in addition to the goods and services within that category is immaterial. Whether or not there is a marketing concept is of no consequence to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it may change after a sign has been registered as a Community trade mark and it cannot therefore have any bearing on the assessment of the sign's registrability.”

43. The issue there was an absolute grounds objection. A decision to similar effect in a relative grounds context can be found in *Croom's Trade Mark Application*, [2005] RPC 2 where the Appointed Person considered that it was not possible to re-write a clothing specification so as to exclude a category of clothing, namely haute couture.

44. Thirdly, it must be borne in mind that trade marks can be assigned. The new owners may wish to trade in different types or quality of goods or by different means (within the scope of an existing registration) with the result that the relative position of parties in the market place changes.

45. For these main reasons the mere fact that the parties may have traded concurrently without apparent problem is not a basis for accepting that that state of affairs will continue.

Similarity of marks

46. The competing marks are SKIL and THE MARQUE OF SKILL. The latter is presented in a bold typeface. I note that it is captured on the Registry's records as a stylised word mark. The amount of stylisation is in fact minimal. I propose to treat it as if it were plain block capitals.

47. I am required to consider the marks from a visual, aural and conceptual standpoint. Mr Norris contended that there was a striking conceptual similarity and significant aural and visual similarity. He considered that the first part of THE MARQUE OF SKILL simply indicated that it is a 'skill' mark and that the opponent's mark creates a similar mental image.

48. The conceptual significance of the marks does, indeed, represent a useful starting point in the comparison. The applied for mark has the appearance of, and has in fact been used as, a strapline supporting another mark or marks. The word SKILL needs no explanation. The word 'marque' is sometimes used to mean brand though less commonly these days. I note that Collins English Dictionary defines 'marque' as a brand of product, esp of a car. The latter reference corresponds to my own understanding of the context in which the word is most commonly met nowadays.

49. Mr Norris' skeleton argument suggested that the first part of THE MARQUE OF SKILL simply indicates that the word SKILL is a mark. I do not accept that that is an entirely fair reading of the words. It is not a statement that SKILL is the trade mark.

It represents a complete statement alluding either to the user or the skill with which the goods have been made. There is, admittedly, an element of ambiguity in the mark which does not make the message easy to unpack but that does not detract from the fact that it would be read and understood as a self-contained statement.

50. Furthermore, in relation to the first element of the applied for mark, two cases suggest that care should be taken in considering the impact of descriptive terms that are incorporated into marks. In *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40 it was held by the Court of Appeal that:

“37 It was over “Reed Business Information” that battle was joined. The composite is not the same, as for instance, use of the word “Reed” in the sentence: “Get business information from Reed.” In the latter case the only “trade-marky” bit would be “Reed”. In the former, the name as a whole is “Reed Business Information.” The use of capital letters is of some visual significance – it conveys to the average user that “Business Information” is part of the name. If the added words had been wholly and specifically descriptive – really adding nothing at all (eg “Palmolive Soap” compared with “Palmolive”) the position might have been different. But “Business Information” is not so descriptive – it is too general for that.”

and in *Intel Corporation Inc and CPM United Kingdom Limited*, [2006] EWHC 1878 (Ch), Mr Justice Patten held:

“It seems to me that the reputation enjoyed the INTEL mark would be sufficient for the average consumer to focus on INTEL in INTELMARK at least so as to bring to mind the INTEL mark. But I accept that the addition of MARK in a single word does create a degree of dissimilarity which may or may not be enhanced depending on the wider context in which the two marks are used.”

51. The earlier trade mark is SKIL. Where I differ from Mr Norris is the question of whether it creates the mental image of SKILL. The word skill is a well known dictionary word. It is not a word that is likely to be commonly misspelt. I do not accept, as was submitted, that low standards of literacy amongst users (or some sections of the user community) might lead to SKIL being taken to mean, or be a variation of, skill.

52. Nor is it suggested that SKIL would be seen as a foreign language equivalent of the English word. In short it is an invented word that has no reference to the goods. I approach the issue of similarity from this starting point.

53. Conceptually, it follows that I find the marks have little, if anything, in common. The significance of conceptual differences was noted by the court of First Instance in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and

aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

54. Aural considerations on the other hand, represent the high point of the opponent’s case. SKIL and SKILL would be indistinguishable when spoken or heard. That would leave the remaining words (THE MARQUE OF) as the only distinguishing feature. I was also asked to consider oral use in advertising along the lines of “These power tools are brought to you from the mark of”. Whilst I cannot rule out the possibility of the words “the mark of” being used in advertising it does not strike me as altogether natural usage. It is somewhat straining normal usage to make a point.

55. Visual considerations closely follow conceptual recognition. Unless I am mistaken in how consumers will react to the word SKIL I find only a very limited degree of visual similarity.

56. The net effect of these considerations points to a low degree of similarity between the competing marks.

Distinctive character of the earlier trade mark

57. There is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either on account of its inherent qualities or because use has given it a reputation or enhanced its intrinsic qualities. Strong marks command greater protection. A mark need not have ‘household name’ status to benefit from a claim to enhanced distinctive character, and hence protection, through use. The matter was put as follows by David Kitchin QC, sitting as the Appointed Person, in *Steelco Trade Mark* BL O/268/04 at paragraph 17:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of

distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

58. SKIL is an established brand in the UK market (first used in the 1960s). Turnover figures are substantial though on the decline somewhat in more recent years, a trend that is being corrected according to Mr Turtle’s evidence. Consistent with the products being directed at DIY and light professional use they are sold through the big DIY retail chains and other organisations such as Argos.

59. The extensive press cuttings contained in Exhibits NPT2 for the years 2001 onwards consistently show the SKIL products featured in competition with eg Bosch and Black & Decker for drills and De Walt, Hitachi and Makita for sanders.

60. The evidence does not disclose market share figures but taking the evidence in the round and the inherent qualities of the mark I find that SKIL has a high degree of distinctive character.

Likelihood of confusion

61. Mr Norris made two submission that I am invited to take into account in the global assessment of the likelihood of confusion. The first is that SKIL lends itself to punning use which in turn suggests the word ‘skill’. The example he gave was from Builders’ Merchants News of June 2004 which carried the headline ‘A Skilful power tool range’. There are a few others. Thus ‘Skilfully done’ from Practical Householder of October 2002 and ‘Increase your Skil at Argos’ from Woodmaker of November 2005. In each case it would be well understood that it is a deliberate play on the brand name. Given that the name lends itself to word-play it is perhaps surprising that the large volume of press cuttings exhibited do not yield more examples of such usage.

62. Mr Norris’ second point was that there is an example of a Creda product being mis-described as a SKILL 9.6v cordless drill (Swindon Evening Advertiser of May 2002).

63. This appears to be no more than a typographical error. The short article in question and accompanying photograph was clearly made available to local press. A similar piece appears in The Huddersfield Daily Examiner without the typographical

mistake. I see no reason to give weight to these points. The overwhelming evidence is that the mark SKIL is properly and consistently referred to in its registered form.

64. I have commented above on the goods and in doing so touched on the nature of consumers for those goods. Mr Norris submitted that oral ordering has a part to play in the purchase process for tools and power tools. The evidence points to advertisements by press releases and press cuttings and hence promotion of the products by visual rather than oral/aural means. Perhaps some oral ordering and word of mouth recommendation does take place. It is more likely in my view that purchasers or potential purchasers meet brands through trade or other press advertising or through product displays at retail outlets. The evidence does not lead me to think that oral/aural considerations should be elevated above visual ones.

65. I also take the view that the purchase of tools, particularly power tools, will be undertaken with a reasonable degree of care. Such items are not particularly cheap and in many cases there will be technical data to absorb before a decision is taken on whether a particular product meets the user's needs.

66. Taking all relevant factors into account including identity and/or similarity in relation to the core goods, the low degree of similarity between the marks (mainly phonetic) and the high distinctive character of the earlier trade mark I have come to the conclusion that there is no likelihood of confusion. Nor, in view of the clear meaning of the words THE MARQUE OF SKILL, is this a case where imperfect recollection might point to a different conclusion.

67. I bear in mind that confusion does not have to be direct. An association that causes the public to believe that the respective goods come from the same or economically linked undertaking is relevant confusion for the purposes of the Section as would be association suggesting that the applied for mark represented, a development in the product range. In this respect, it has been submitted that products sold under THE MARQUE OF SKILL are likely to be viewed as an extension of the SKIL product range. It is pointed out that new ranges are regularly brought out under the SKIL mark. That may be so but the evidence tells a consistent story that the mark used is in each case either SKIL or that word elided with an element describing or alluding to the goods, SKILSAW, SKILDRIVER etc.

68. Accordingly, the opposition fails under Section 5(2)(b).

Section 5(4)(a)

69. Although I received brief submissions in relation to this ground, it is accepted that it does not give rise to materially different issues than those considered under Section 5(2)(b). In particular the mark used is the same and the use is within the scope of the specification of the opponent's earlier trade mark. The two grounds of opposition stand or fall together.

COSTS

70. The applicant has been successful and is entitled to a contribution to its costs. The applicant has not been professionally represented in these proceedings and is in effect

in the position of a litigant in person. It is appropriate to reflect this in the costs award on the basis of Simon Thorley QC's observations in *Adrenalin Trade Mark*, BL O/040/02 at paragraph 8:

“It is correct to point out that the Registrar's practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6”.

71. Part 48 of the Civil Procedure Rules referred to in the above passage provides as follows:

“**48.6(1)** This rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative”.

72. On that basis I order the opponent to pay to the applicant 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 November 2006

M REYNOLDS
For the Registrar
The Comptroller General

