

O-125-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2391843
BY SHERWOOD AGENCIES LTD TO REGISTER THE TRADE MARK**

MAXIM

IN CLASS 21

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 96293
BY MARKS AND SPENCER PLC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2391843
By Sherwood Agencies Ltd to register the trade mark
MAXIM in Class 21**

and

**IN THE MATTER OF Opposition thereto under No. 96293
by Marks and Spencer plc**

BACKGROUND

1) On 13th May 2005 Sherwood Agencies Ltd, of Sherwood House, Mutual Mills, Aspinall Street, Heywood, Lancashire, OL10 4HW (hereafter "Sherwood") applied to register the following trade mark:

MAXIM

2) The application was in respect of the following goods in class 21:

Small domestic utensils and containers; cookware; mugs and cups; glassware; bakeware; ovenware; oven gloves; dishes; plates and tableware.

3) The application was published on 16th November 2007 and on 15th February 2008, Marks and Spencer plc of Waterside House, 35 North Wharf Road, London, W2 1NW (hereafter "M & S") filed notice of opposition to the application, based on their mark 2376677. The opposition is based on grounds under section 5(1) and 5(2)(a) of the Trade Marks Act 1994 ("the Act").

4) The details of M & S's trade mark, 2376677, are:

Trade Mark	Filing and registration dates	Specification
MAXIM	27 th October 2004 and 4 th August 2006	Class 21 Tableware of porcelain or earthenware; drinking glasses

5) M & S say in their statement that the goods of Sherwood's application are largely identical to the goods covered by M & S's mark, with the exception of oven gloves, thus invoking section 5(1) of the Act. Further, or in the alternative, they say that the goods covered by Sherwood's mark are similar to those for which the M & S mark is registered, thus invoking section 5(2)(a) of the Act. They ask that application 2391843 be refused. They also ask for costs.

6) Sherwood subsequently filed a counterstatement denying the grounds for opposition. They say that their mark has been used in the UK in relation to a wide range of products, including products falling into class 21, for in excess of 10 years. They say that M & S's mark and theirs have co-existed here in the UK for some considerable time. They deny that the goods in class 21 are identical to those covered by M & S's mark. Further, they deny that their application offends against section 5(2)(a) for the same reason, namely that the marks have co-existed for some considerable time without any confusion arising. They ask that registration be granted and costs awarded.

7) The matter proceeded to determination without evidence. Neither side wanted an oral hearing but M & S did file written submissions which I shall take into account in due course. This decision is taken from the papers.

DECISION

Section 5(1)

8) The opposition is founded upon Section 5(1) and Section 5(2)(a) of the Act. First of all I shall deal with the Section 5(1) ground. Section 5(1) reads:

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

9) This is a mandatory provision. Without consent, the registrar is constrained to refuse an application if the mark applied for is identical to an earlier trade mark and if, or to the extent that, the goods or services are also identical.

10) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

Sherwood's mark was filed on 13th May 2005 and M & S's on 27th October 2004. As M & S's mark was registered on 4th August 2006 and the application in suit published on 16th November 2007, it is not subject to proof of use requirements. M & S's mark is clearly an earlier trade mark in accordance with the Act.

11) There is no dispute that the marks are identical.

12) The respective goods are as follows:

M & S's goods	Sherwood's goods
<p>Class 21</p> <p>Tableware of porcelain or earthenware; drinking glasses</p>	<p>Class 21</p> <p>Small domestic utensils and containers; cookware; mugs and cups; glassware; bakeware; ovenware; oven gloves; dishes; plates and tableware.</p>

13) M & S say that, The Collins English Dictionary defines “tableware” as “articles such as dishes, plates, knives, forks, etc used at meals”. I accept that the broad term “tableware” would include a range of items, all used at meal time. I also know that, as a consumer myself, there are various items such as casserole dishes, which are used both for cooking and then serving at the table. Accordingly, the broad terms “cookware” and “ovenware” in Sherwood’s specification may include items which could also come within the term “tableware”. Similarly, the broad term “glassware” would encompass “drinking glasses” in M&S’s specification. Oven gloves, on the other hand, I would not regard as encompassed within the term “tableware”; their place is not at the table during the meal but to assist with the food preparation beforehand.

14) I note also that M& S’s specification is plainly limited by the material of which the tableware is made – “tableware of porcelain or earthenware”. Attorneys for M & S agreed to this specification by letter dated 2nd March 2006 during the examination phase of their application. I mention this as, in their submissions, it appears that the same attorneys are labouring under the mistaken belief that the specification reads: “tableware or porcelain or earthenware.” However, based upon the approach I shall take below, this limitation has no practical effect on my conclusions as to goods considered to be identical.

15) It will be appreciated that the scope of M&S’s specification is not co-extensive with that of Sherwood. M&S’s specification contains goods which, as I have said, may be subsumed within broader, ‘portmanteau’, terms in Sherwood’s specification. Conversely, the term “mugs and cups” in Sherwood’s specification comes within the broad term “tableware” in M&S’s specification. The approach I shall take to determine whether the goods are identical accords with that taken in OHIM (see Decisions 1033/2003 and 1978/2004, by way of example) and the European Court of First Instance (CFI) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, where, at paragraph 29, it is stated:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

16) I might add that such an approach to ‘identical’ accords also with *Kerly’s Law of Trade Marks and Trade Names* (“*Kerly’s*”), 13th Edition, which states at para. 8-10:

“... the goods or services must be the same as those the subject of the earlier trade mark. Although not explicit, it would seem that this provision can only sensibly be interpreted as prohibiting registration where there is an overlap of goods or services.”

17) In this particular case, if both the CFI and *Kerly’s* are wrong and a co-extensive test applied, it would be nigh on impossible to determine, (a) precisely how ‘broader’ Sherwood’s specification is in terms of goods which would not be considered identical to M&S’s goods, and then (b) exactly which of those goods may otherwise be subject to a successful section 5(2)(b) challenge, having avoided section 5(1). Such an approach would also necessitate a rewriting of Sherwood’s specification, consequent on conclusions reached under sections 5(1) and (2) (not just ‘blue-pencil’ deletion), since they have offered no unconditional limitations or restrictions to their broader terms.

18) Finally on this matter, I should mention that the OHIM, CFI and *Kerly’s* approach has also been expressly endorsed by Professor Ruth Annand, sitting as the appointed person, in BL O/269/04, *Galileo International Technology LLC v Galileo Brand Architecture Limited*, (see para13 and following).

19) Adopting this approach, I find the following ‘overlapping’ goods of Sherwood’s specification to be identical to those of M&S:

“Small domestic utensils and containers; cookware; mugs and cups; glassware; bakeware; ovenware; dishes; plates and tableware”.

To reiterate, for the benefit of absolute clarity, this is because I find M&S’s porcelain or earthenware tableware to be subsumed within the portmanteau terms: “small domestic utensils and containers”, “cookware”, “bakeware” and “ovenware” (see my comments in para 13 above regarding dual purpose items). “Drinking glasses” in M&S’s specification is subsumed within Sherwood’s

“glassware”. The reverse happens in connection with Sherwood’s terms: “mugs and cups”, “dishes” and “plates”, which are subsumed within M& S’s “tableware”. Tableware is plainly identical to tableware in Sherwood’s specification.

20) It is mandatory that all the above goods are refused under section 5(1). This leaves ‘oven gloves’ to be determined under section 5(2)(a).

Section 5(2)(a)

21) Section 5(2)(a) reads:

“(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).....

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

22) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (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.*,
- (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*,
- (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*,

(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.*,

(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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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*,

(j) 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

The average consumer and the buying process

23) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the respective goods at issue.

24) The average consumer for oven gloves will be the general public. The value of the products concerned will not necessarily be high and functionality may well be a key element in the buying process. That said, I am conscious from my own experience as a consumer, that manufacturers these days provide decorative oven gloves, and that the consumer will also purchase such oven gloves to match each other (as sets), and perhaps other items (such as tablecloths or other kitchen items etc) he or she has already got, or is buying at the same time. In other words, the aesthetic and decorative element cannot be ignored in the buying process.

25) The average consumer for M&S's goods, being tableware and drinking glasses, will likewise be the general public. They will have similar considerations as to functionality but aesthetic and decorative considerations may play an even more important role in their choice. Such items will, unlike oven gloves, be 'on display' in the home. Tableware varies in value of course with the best items and sets being very highly priced. The purchasers of such tableware will undoubtedly be very circumspect, but even where lower priced items are concerned, it would be my view that the average consumer will nevertheless select them carefully. **Plainly, the average consumer for both sets of goods, being the general public, will be the same.**

26) As to the buying process for the respective goods of both parties, the consumer, being the general public, will be reasonably well-informed, circumspect, and as alert to design and aesthetic qualities as they are to functional. The aesthetic nature of the selection of both parties' goods maps into my analysis of the comparison of goods below, but it is also relevant in my consideration of the qualities of the respective average consumers and the buying process. Manufacturers will strive for striking and unique designs in this field, thus cultivating brand awareness and loyalty. This must be balanced against the fact that some items may be low value; in other words, the buying process, for both party's goods, is not an ill-considered or random one, but neither will it involve the highest level of consideration.

Comparison of goods

27) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to

the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at para 23 of the Judgment:

‘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.’

28) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, para 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance SA v OHIM – Johnson & Johnson GmbH (monBeBé)*).

29) As a consumer I am aware that tableware and oven gloves are going to be sold through the same trade channels, that is to say that in outlets such as supermarkets there are dedicated areas where cookery items and implements are sold. I am aware also as a consumer that dedicated cooking or kitchen shops, which sell a wide range of kitchen or cookware, either for the preparation of food or drink or for its consumption, exist. Tableware and oven gloves can be said to share the same or a similar general function, namely that they assist in either the preparation or consumption of food or drink. Whilst tableware may specifically be used, functionally, at meal times, oven gloves nevertheless complement, and are essential to tableware, inasmuch as they may be used for the preparation of the food or drink. I conclude that oven gloves can be considered similar to, in the sense of being, ‘complementary’ to tableware. By ‘complementary’ I mean goods which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (see, eg, CFI Case T-169/03 *Sergio Rossi SpA v Sissi Rossi Srl* [2005] ECR II-685, paras 60-64).

30) In the CFI’s *El Corte Ingles* case (Case T-443/05), we see further development of the complementarity theme into one of aesthetic complementarity where, for example, consumers select clothing and accessories (such as handbags) to contribute to an overall co-ordinated ‘look’. I have already referred to the aesthetic element in the selection process and see no reason why the concept of a co-ordinated ‘look’ should not extend into the realm of tableware and oven gloves.

31) My conclusion is that oven gloves are similar to tableware.

Use and distinctive character of the earlier trade mark

32) The word ‘MAXIM’ has a dictionary meaning as follows:

noun, a short pithy statement expressing a general truth or rule of conduct (see The New Oxford Dictionary of English).

33) This meaning has no connection or relationship with the goods of either party. It may be seen as faintly laudatory but only in a vague way. Whilst Sherwood refer to the fact that the respective marks have 'co-existed' for some considerable time, there is no evidence from M&S as to their own use of MAXIM. I can only then take into account the inherent qualities of the word 'MAXIM', without any enhanced distinctive character through use. **On that basis I consider the mark to be of reasonably high distinctive character.**

Comparison of marks

34) The marks are identical.

Likelihood of confusion

The effect of parallel trading on likelihood of confusion

35) Sherwood's counterstatement asserts that their mark has been used for a wide range of products, including product falling into class 21, for in excess of 10 years. They go on to say that no confusion has arisen as a result. Thus their case relies upon co-existence. Evidence of what is often referred as "parallel trading" is a factor which could potentially assist in deciding whether there exists a likelihood of confusion. This is because if the evidence establishes that the respective marks have actually been put to use in the same market (as opposed to the notional use which is normally considered) without the consumer being confused regarding economic origin, then this can inform the tribunal's decision. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace, however, this should be tempered by a number of decisions which express caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paras 42 to 45.) In the first of the above cases Millet LJ stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

Crucially, in this case there simply is no evidence from Sherwood on the nature of that co-existence. It remains therefore an assertion and, as M & S say, in the

absence of evidence, co-existence or parallel trading cannot be taken to be a factor in this case. The notional (unused) position has to prevail.

Conclusion

36) Weighing all my findings above in the global assessment under section 5(2)(a), and assuming imperfect recollection, I find that, in relation to 'oven gloves' there is a likelihood of confusion under section 5(2)(a). In particular, I have said that the average consumer will be the same, the goods are similar to tableware and I have accorded 'MAXIM' a reasonably high degree of distinctive character. Therefore, the opposition under section 5(2)(a) is successful in that there is a likelihood of confusion between M&S's goods and Sherwood's one term, oven gloves, that survived my analysis under section 5(1).

Costs

37) The opposition has succeeded in its entirety and therefore M & S is entitled to a contribution towards its costs. I award them costs on the following basis.

Filing opposition, preparing statement of case and considering counterstatement - £ 500

Preparing submissions - £400

Total - £900

38) I order Sherwood Agencies Ltd of Sherwood House, Mutual Mills, Aspinall Street, Heywood, Lancashire, OL10 4HW to pay Marks & Spencer plc of Waterside House, 35 North Wharf Road, London, W2 1NW the sum of £900. The sum should 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 11th day of May 2009

**Edward Smith
For the Registrar,
the Comptroller-General**