

O-371-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION 956090  
IN THE NAME OF UTOPIA SOCIAL ENTERPRISES GMBH  
FOR PROTECTION IN THE UK IN CLASSES  
3, 9, 12, 16, 25, 29, 30, 32, 35, 36, 38, 39, 41, 42 & 43  
FOR THE TRADE MARK:**

**UTOPIA**

**&**

**IN THE MATTER OF OPPOSITION 71850 BY  
UTOPIA FURNITURE LIMITED**

## TRADE MARKS ACT 1994

**In the matter of international registration 956090  
in the name of Utopia Social Enterprises GmbH  
for protection in the UK of the trade mark UTOPIA in classes:  
3, 9, 12, 16, 25, 29, 30, 32, 35, 36, 38, 39, 41, 42 & 43**

**and**

**In the matter of opposition 71850 by Utopia Furniture Limited**

1) The holder of international registration 956090 is Utopia Social Enterprises GmbH ("Social")<sup>1</sup>. The trade mark was designated for protection in the UK on 9 July 2007. The international registration has an international priority date of 10 January 2007. The trade mark consists solely of the word UTOPIA. Protection is sought for a large range of goods and services, but the only ones the subject of this opposition are:

**Class 9:** Scientific, nautical, surveying, photographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; telecommunication equipment; computer peripheral devices; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; automatic vending machines; data processing equipment and computers; computer software included in this class; digital image carriers and machine-readable data carriers included in this class; encoded telephone cards; downloadable electronic publications.

**Class 16:** Printed matter; stationery and office requisites (except furniture); instructional and teaching material (except apparatus); unencoded phone cards.

**Class 35:** Organization of trade fairs for commercial and advertising purposes; negotiation of commercial contracts with energy and water suppliers; professional organizational and business consultancy in matters of trade concerning emission rights, emission allowances and energy trade; conclusion of contracts for third parties concerning the sale or purchase of emission allowances and emission rights; advertising; business consultancy; marketing consultancy; public relations; consumer advice; services for consumer information, namely provision of information to consumers regarding prices, product quality, terms of payment and customer satisfaction, also on the Internet; marketing; business administration; business management; sales promotion for others; rental

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<sup>1</sup> Social became the holder of the international registration by way of an assignment from Claudia Langer, such assignment being recorded between the opposition being lodged and the counterstatement being filed.

and arranging of advertising space, also on the Internet; online advertising in a computer network; presentation of enterprises on the Internet and other media; arrangement of business contacts in trade and commerce, also through the Internet; compilation and systemization of data in computer databanks; presentation of goods and services through the Internet; e-commerce services, namely taking of orders and arranging contracts for others, invoicing for electronic order systems, auctioneering, also on the Internet; procurement services for others, namely acquisition of goods and services for other enterprises; retail services in connection with the sale of cosmetics, clothing, footwear, toys, electronic consumer products, electric consumer products, car accessories, food and luxury foodstuffs, jewellery, leather goods, bags, housewares, telecommunication articles, stationery, office requisites, furnishings and decorations, including such retail services provided through online shops and global computer networks and as mail order services

**Class 41:** Training; education; services of a television studio; television entertainment; production of films and television programs; organization and provision of cultural events; organization and provision of conferences, congresses, symposiums or workshops, included in this class; organization and provision of exhibitions for cultural or educational purposes; publication of printed matter (except publicity texts); publication and provision of non-downloadable electronic publications, except for advertising purposes; organization and arranging of seminars and educational events.

2) Utopia Furniture Limited (“Furniture”) opposes protection in the UK. By the time a substantive decision was required in these proceedings, the only grounds of opposition remaining were under sections 5(2)(a) & (b) of the Trade Marks Act 1994 (“the Act”)<sup>2</sup>. Furniture relies on four trade marks of which it is the proprietor, namely: Community trade mark (“CTM”) 5261300, CTM 5261292 and UK registrations 2370066A & 2370066B. However, given that: i) CTM 5261300 is for an identical mark to that of Social and ii) that 5261300 covers all of the goods and services which its other earlier marks cover, and iii) that the proof of use provisions<sup>3</sup> do not apply to it, CTM 5261300 is the only mark that I need to consider. It represents Furniture’s best case.

3) CTM 5261300 was filed on 21 July 2006, so making it an earlier trade mark as defined in section 6 of the Act. As I have already said, the proof of use provisions do not apply because the mark was not registered until after the date of

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<sup>2</sup> Grounds were initially pleaded under section 5(3) and 5(4)(a) but these were deemed withdrawn due to Furniture filing no evidence to support them.

<sup>3</sup> See section 6A, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

publication of the International registration let alone five years before it<sup>4</sup>. The goods and services covered by CTM 5261300 are:

**Class 06:** Metal handles for furniture and bathroom furniture; metal handles and rails for bathrooms; metal handles and rails for sanitaryware, baths and showers; metal bathroom fittings; parts and fittings for all of the aforesaid goods.

**Class 11:** Apparatus for lighting, water supply and sanitary purposes; sanitaryware; toilets; lavatory basins; toilet bowls; toilet seats; slabtops; w.c. suites; baths, bathtubs and bathing products, apparatus and installations; showers and showering equipment, apparatus and installations; shower fittings; sinks; sink units; basins; taps; lights; lighting and lighting equipment, apparatus and installations; bathroom fixtures; parts and fittings for all of the aforesaid goods.

**Class 20:** Furniture; bathroom furniture; bedroom furniture; kitchen furniture; bathroom furniture, bedroom furniture and kitchen furniture manufactured in (MFC) melamine faced chipboard, (MDF) medium density fibreboard, plastic materials and solid surface plastic materials; worktops; pvc foil finishes; cabinets, units, doors; parts and fittings for all of the aforesaid goods.

**Class 42:** Design services; computer design services relating to fitted furniture, sanitaryware products and bathroom design; information, consultancy and advisory services relating to all of the aforesaid services.

4) Social filed a counterstatement denying the grounds of opposition. Whilst all the grounds were denied, I note that in relation to the goods/services conflict between the International registration and CTM 5261300, Social state that:

“[t]he Opponent’s goods are registered in different classes and are clearly not similar to any of the goods or services included classes 9, 16 and 35 and 41 of the Applicant’s mark”.

5) Neither side filed evidence. Neither side requested a hearing or filed any written submissions in lieu of attending a hearing.

6) CTM 5261300 is pleaded under section 5(2)(a) of the Act which reads:

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

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<sup>4</sup> The international registration was published on 8 August 2008 and the earlier mark completed its registration procedure on 18 September 2008.

(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.”

7) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

8) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks are, in this case, identical, and whether the respective goods/services are similar (and to what degree), other factors are relevant including:

The nature of the average consumer of the goods/services in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor to consider because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods/services, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

9) Some of the relevant factors can be disposed of briefly. Despite Social’s denial, both marks consist solely of the word UTOPIA. Neither mark is presented in any particular form of presentation. The marks are, therefore, visually and phonetically identical. The word UTOPIA also has a meaning (a perfect world) which is likely to be known by the general public at large and, therefore, regardless of who the average consumer is deemed to be then the marks are also conceptually identical. Furthermore, considering the goods and services covered by the earlier mark, the word UTOPIA, whilst it may have some

laudatory connotations (goods to be used in a perfect world), still strikes me as a word that possesses a reasonably high degree of distinctive character.

10) Greater analysis is required when considering any goods/service similarity. When comparing the respective goods and services I note the judgment In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* where the ECJ stated:

“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.”

11) Guidance on this issue can also be seen in the comments of Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 (“*British Sugar*”) where the following factors were highlighted as being relevant in the assessment of 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.”

12) In terms of understanding what a “complementary” relationship consists of, I note the judgment of the General Court<sup>5</sup> (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 where it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the*

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<sup>5</sup> Previously known as the Court of First Instance of the European Communities.

*use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”*

13) In 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 the trade<sup>6</sup>. I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>7</sup>. In relation to services, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

14) Finally, when comparing the respective goods and services, if a term clearly falls within the ambit of a term in the competing specification then identical goods/services must be held to be in play<sup>8</sup> even if there may be other goods/services within the broader term that are not identical.

15) No evidence has been filed by either party as to the similarity, or otherwise, of the respective goods/services. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated:

“22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

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<sup>6</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>7</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 (“*Beautimatic*”).

<sup>8</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T-133/05 (“*Gérard Meric*”).

16) The court required evidence of similarity to be adduced. This finding has been reiterated by the ECJ and the GC<sup>9</sup>. It may not always be practical to adduce evidence of similarity, for example, it may be that the nature of the goods/services is so well-known that it would be a waste of effort and resource to do so. However, beyond that type of circumstance evidence should be filed. Such an approach was advocated by Mr Hobbs QC (sitting as the Appointed Person) in *Raleigh International trade mark* [2001] R.P.C. 11 where he stated:

“If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their “similarity” (whether or not the objection is directed to the use of an identical mark): Canon paragraph 22. Paragraph 23 of the Judgment in Canon indicates that it is appropriate to consider the pattern of trade with reference to factors such as those (uses, users and physical nature of the relevant goods and services; channels of distribution, position in retail outlets, competitive leanings and market segmentation) identified by Jacob J. in *British Sugar Plc v James Robertson v Sons Ltd.* [1996] RPC 281 at 296, 297.”

On the basis of the above, my approach will be to go through Social’s goods and services to see if I can identify anything that is self-evidently similar.

17) Whilst I bear in mind Furniture’s full specification, it can be fairly summarised as covering:

- i) Furniture (including bathroom, bedroom and kitchen furniture) and some specific forms of furniture such as cabinets and doors;
- ii) Various metal handles and rails for furniture, for bathrooms, and for sanitary ware and metal bathroom fittings;
- iii) Lighting, water supply and sanitary apparatus, and various bathroom and kitchen installations and fittings;
- iv) Design services at large and computer design services for fitted furniture, sanitary ware products and for bathrooms.

18) The difficulty comes due to the breadth of Social’s goods and services. Furniture simply makes a general allegation of similarity. I will break the goods down as far as I consider it necessary to do, but grouping them where possible. My views are as follows:

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<sup>9</sup> See, for example, *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 16/07

i) **Scientific, nautical, surveying, photographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments:** Although these are broad terms which could cover a multitude of goods, I see nothing inherent in the language used which provides any real synergy with the goods or services of the earlier mark. I find no similarity here.

ii) **Telecommunication equipment; computer peripheral devices; data processing equipment and computers:** Again, I see no real synergy here. The only potential conflict is that Furniture's services include computer based design whereas the terms being considered here include computers (and peripheral devices). Whilst there could be said to be an element of complementarity (a computer is required for computer-based designing to be undertaken), there is no evidence to suggest that the relationship is one where customers may think that the responsibility for both the goods and the service lies with the same undertaking. Computers are used, indeed they may be essential, for many different types of service, but that does not mean that a computer should be held to be similar to all services which may use computers. There is nothing to suggest that computers are designed solely to operate in the computer based design field. Absent evidence to the contrary, I find no similarity here.

iii) **Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity:** The only potential for similarity here relates to the fact that goods such as lighting (a term covered by Furniture's specification) will be electrically controlled etc. Whilst this may be true, and whilst there may be a degree of complementarity (albeit only one way), there is no evidence to suggest that the relationship is one where customers may think that the responsibility for both goods lies with the same undertaking. Absent evidence to the contrary, I find no similarity here.

iv) **Automatic vending machines:** I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

v) **Computer software:** Unlike computers, there is a more obvious potential similarity here with regard to design services (which would include computer aided design) and the specifically listed computer based design services. This is because computer aided design (CAD) software is a commonly known and recognisable category of computer software which is not only complementary to computer based design services, but, it could also be competitive in that a person may go to a computer based designer or may acquire software to undertake the design themselves. In view of this, there is a reasonable degree of similarity with both the specifically listed computer based design services and also, on the *Gérard Meric* principle, design services at large (the term design services would include computer based design within its ambit).

vi) **Digital image carriers and machine-readable data carriers included in this class; encoded telephone cards; downloadable electronic publications:** I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

vii) **Printed matter:** I see no real synergy here with the goods or services of the earlier mark. The fact that a piece of furniture may come with instructions (likely to be in printed form) does not mean that furniture should be regarded as similar to printed matter having regard to the factors identified in the case-law that I set out earlier. I find no similarity here.

vii) **Stationery and office requisites (except furniture):** I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

viii) **Instructional and teaching material (except apparatus):** I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

ix) **Unencoded phone cards:** I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

x) **Organization of trade fairs for commercial and advertising purposes; negotiation of commercial contracts with energy and water suppliers:** Whilst the goods or services of Furniture may be offered at a trade show, the service of organising them is a business-to-business service with no similarity of purpose, nature or method of use etc. The negotiation of contracts has no real synergy. There is no similarity here.

xi) **Professional organizational and business consultancy in matters of trade concerning emission rights, emission allowances and energy trade; conclusion of contracts for third parties concerning the sale or purchase of emission allowances and emission rights:** I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

x) **Advertising; marketing consultancy; public relations; marketing; rental and arranging of advertising space, also on the Internet; online advertising in a computer network; sales promotion for others:** Although the goods and services of Furniture may be advertised or marketed etc., this does not mean that such goods/services should be considered similar to an advertising or marketing service itself. Such services are provided by particular and specialist undertakings and the nature, purpose and methods of use etc. are all quite different. There is no similarity here.

xi) **Business consultancy, business administration; business management; arrangement of business contacts in trade and commerce, also through the Internet:** These are, essentially, business-to-business services. I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

xii) **Consumer advice; services for consumer information, namely provision of information to consumers regarding prices, product quality, terms of payment and customer satisfaction, also on the Internet:** Consumer advice suggests an independence from the actual provider of the goods and services and, in any event, the nature, purpose and methods of use etc. are all quite different. I find no similarity here.

xiii) **Presentation of enterprises on the Internet and other media; presentation of goods and services through the Internet:** I am not at all sure what this service entails. It may have an element of marketing or even consumer advice. Given that I have found no similarity in relation to those terms, I do not see how Furniture can be in any better position here. I find no similarity.

xiv) **Compilation and systemization of data in computer databanks:** I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

xv) **E-commerce services, namely taking of orders and arranging contracts for others, invoicing for electronic order systems:** I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

xvi) **Auctioneering, also on the Internet:** I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

xvii) **Procurement services for others, namely acquisition of goods and services for other enterprises:** I see no real synergy here with the goods or services of the earlier mark. I find no similarity here

xiii) **retail services in connection with the sale of cosmetics, clothing, footwear, toys, electronic consumer products, electric consumer products, car accessories, food and luxury foodstuffs, jewellery, leather goods, bags, housewares, telecommunication articles, stationery, office requisites, furnishings and decorations, including such retail services provided through online shops and global computer networks and as mail order services:** Furniture's specification does not cover any form of retailing service. However it is clear from the GC's judgment in *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-116/06 ("Oakley")* that a retailing service may be considered as similar to the goods being retailed. The GC stated:

"57 Thus, notwithstanding the incorrect finding of the Board of Appeal to the effect that the services and goods in question have the same nature, purpose and method of use, it is indisputable that those services and goods display similarities, having regard to the fact that they are complementary and that those services are

generally offered in the same places as those where the goods are offered for sale.

58 It therefore follows from all of the foregoing that the goods and services in question resemble each other to a certain degree, with the result that the finding in paragraph 24 of the contested decision that such a similarity exists must be upheld.”

Irrespective of the above, most of the goods the subject of the retail service have no relationship to the goods covered by Furniture’s earlier mark. The service does, though, cover the retailing of *electronic consumer products, electric consumer products, housewares, furnishings and decorations*. Whilst I have borne in mind the terms *electronic consumer products* and *electric consumer products* and whilst goods such as lighting (as covered by Furniture’s specification) are likely to be electrically powered, lighting does not strike me as something that would ordinarily be described as an electric consumer product. Absent evidence to the contrary, I find no similarity between the retail of these goods with the goods or services covered by the earlier mark. The position is different in relation to the retail of housewares, furnishings and decorations. I see no reason why such terms would not include lighting such as lamps for example, or bathroom and kitchen fittings etc. In view of this, and applying the guidance from *Oakley*, I consider there to be a reasonable degree of similarity.

xix) ***Training; education; organization and arranging of seminars and educational events***: I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

xx) ***Services of a television studio; television entertainment; production of films and television programs***: I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

xxi) ***Organization and provision of cultural events; organization and provision of conferences, congresses, symposiums or workshops, included in this class; organization and provision of exhibitions for cultural or educational purposes***: I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

xxii) ***Publication of printed matter (except publicity texts); publication and provision of non-downloadable electronic publications, except for advertising purposes***: I see no real synergy here with the goods or services of the earlier mark. I find no similarity.

19) I should add that when considering the question of goods/services similarity, I have not ignored the fact that Furniture’s specification in class 42 covers design services at large. Whilst it could be argued (although Furniture themselves have provided no arguments at all) that a design service should be regarded as similar

to every and any product because it must have been designed in the first place, such an assessment would be too superficial and overreaching. Applying the *Avnet* principle, I consider that design services should be limited to those services where, traditionally, a designer would be required such as fashion design, graphic design, and perhaps the design of kitchens/bathrooms etc. Absent evidence to suggest any form of closer link to Social's goods/services, I do not consider that design services at large places Furniture in any better position.

20) In view of the above, the only terms I have found to be similar are:

- a) Computer software, and
- b) Retail services in connection with the sale of housewares, furnishings and decorations, including such retail services provided through online shops and global computer networks and as mail order services:

21) I do not need to consider the matter any further in relation to the goods/services that are not similar as there can be no likelihood of confusion if the goods/services have no similarity<sup>10</sup>.

22) The final question (in relation to the terms in paragraph 20) is whether all the relevant factors combine to create a likelihood of confusion. All such relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

23) The marks are identical. The earlier mark is reasonably high in inherent distinctive character. The goods/services are similar to a reasonable degree. In my view these factors combine so that the average consumer<sup>11</sup>, even though the goods are not the same, will believe that they are the responsibility of the same undertaking. The identity between the marks, combined with the similarity between the goods/services, will be put down to an economic link and not coincidence. The opposition succeeds in relation to the goods/services in paragraph 20. The opposition fails in relation to everything else.

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<sup>10</sup> See, for example, the ECJ's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07*.

<sup>11</sup> The average consumer in relation to the retailing of house-wares and goods such as lamps will be the public at large. The competing goods/services will be selected with at least a reasonable degree of care and attention; they are not grab and go selections. The same applies to design services and computer software (for designing), but the average consumer could also be a business; however, I would go so far as to say that the degree of care and attention used during the purchasing process is likely to be higher than the norm.

### **Costs**

24) Although both sides have achieved a measure of success, the bulk of the opposed goods and services remain. Furniture's success has been a small one. Furniture's claims were broad and it did nothing to support them. In the circumstances, I consider that Social is entitled to an award of costs. I hereby order Utopia Furniture Limited to pay Utopia Social Enterprises GmbH the sum of £400. This is calculated as follows:

Preparing a statement and considering the other side's statement.  
£400

25) The above 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 22 day of October 2010**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**