

O-002-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2504574

BY

PROMAX UK MARKETING ASSOCIATION

TO REGISTER THE TRADE MARK:

PUK

IN CLASSES 35 AND 41

AND

THE OPPOSITION THERETO

IN RELATION TO CLASS 35

UNDER NO 99288

BY

PEEK & CLOPPENBURG KG

Trade Marks Act 1994

**In the matter of application no 2504574
by Promax UK Marketing Association
to register the trade mark:
PUK
in classes 35 and 41
and the opposition in relation to class 35 thereto
under no 99288
by Peek & Cloppenburg KG**

1) On 11 December 2008 Promax UK Marketing Association (Promax) applied to register the trade mark PUK. The application was published for opposition purposes on 17 April 2009. This opposition is only aimed at the class 35 services of the application, namely:

marketing, sales promotion and advertising services; arranging and organising events and exhibitions for advertising, sales promotion, marketing and commercial purposes; recruitment and human resources/personnel services; information services relating to marketing, sales promotion and advertising matters; research services relating to marketing, sales promotion and advertising matters; subscription services; dissemination of advertising and publicity materials; business directory services.

2) On 7 July 2009 Peek & Cloppenburg KG (Peek) filed a notice of opposition to the registration of the application. Peek relies upon section 5(2)(b) of the Trade Marks Act 1994 (the Act). Under section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

3) Peek relies upon two earlier trade marks:

- United Kingdom trade mark registration no 2377087 of the trade mark:



The application for registration was filed on 1 November 2004 and the registration process was completed on 20 January 2006. The trade mark

is registered for goods and services in classes 18, 25 and 35. In these proceedings Peek only relies upon the class 35 services of the registration:

the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store.

- Community trade mark application no 1920156 of the trade mark:



The application for registration was filed on 24 October 2000. The specification of the application is:

retail services, including via websites and teleshopping, in relation to clothing, shoes, headgear, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, leather and imitations of leather and goods made of these materials, animals skins, hides, trunks and travelling bags, bags, handbags, pocket wallets, purses, key cases, rucksacks, pouches, umbrellas, parasols and walking sticks, whips, harness and saddlery.

This is the current specification of the application, which, of course, is the specification that must be taken into account.

4) Peek claims:

“The marks are phonetically identical and visually similar. The applicant is seeking registration for its mark without limitation as to style and so its mark could be used in identical style to that of the opponent’s mark. The services of the application are principally concerned with marketing and sales promotion and hence are services related to, and directly relevant to, the retail trade in goods.”

5) Promax filed a counterstatement. Promax denies that the respective services are similar. It claims that its trade mark in no way resembles that of Peek, except

perhaps phonetically. Promax claims that the visual and conceptual differences between the trade marks clearly overwhelm the phonetic similarities and it is most unlikely that there could be any confusion in the market place, even if the trade marks were used in relation to identical goods and/or services. Promax required proof of use of the trade marks of Peek. As the United Kingdom registration had not been registered for five years at the date of publication of the application and the Community trade mark is not registered, there is no proof of use requirementⁱ.

6) Both sides filed evidence.

7) A hearing was held on 6 December 2010. Peek was represented by Mr Victor Caddy of Wynne-Jones, Lainé & James LLP. Promax was neither represented nor did it file written submissions.

Evidence for Peek

8) In a witness statement Dr Adrian Kiehn, a member of the executive team of Peek, states that Peek is one of Germany's leading clothing retailers and it owns and manages, inter alia, the brands Peek & Cloppenburg and PuC. He states that Peek has stores in several European countries. Dr Kiehn states that Peek has always given "a high emphasis to marketing". He states that after successful advertising campaigns with Diane Kruger and Eric Dane it has launched a new campaign with Ben Affleck and Rosamunde Pike. Dr Michael Prüßner, general counsel of Peek, gives a witness statement in which he concurs with the statement of Dr Kiehn.

9) Gareth Jenkins, a registered trade mark attorney, gives a witness statement. He states that he has conducted an Internet search for retail trade associations. Mr Jenkins states that he has identified two such associations and exhibits at GPJ-1 screen prints from their websites. One is for the Association of Retail Trade (ART) and the other is for the Associated Independent Stores (AIS).

10) ART lists services that it will undertake for its members. These services include liaison with local authorities and government bodies, keeping members informed of technical advances, devising new marketing campaigns, negotiating discounted prices, making available best practices for point of sales, maintaining historic data, helping in purchasing capital equipment, assisting in human resources matters, negotiating with banks, making loans and leasing schemes available, cutting costs in accounting and legal fees, reducing stock taking costs, helping in the buying and selling of businesses and members can use ART's home delivery system. AIS has a system of central payment of accounts for its members; it assists its members with information technology; it assists its members in marketing, including supplying promotional material; it provides statistical information; it assists in training.

Evidence of Promax

11) This consists of a witness statement by Mr Clarke Trevor Graham, a partner of Marks & Clerk. Most of Mr Graham's statement consists of submission and comment upon the evidence of Peek, rather than evidence of fact. He states that Promax is a non-profit organisation which was set up in 1989 to help sales promotion companies, organisations and individuals develop their skills and reward their achievements. Mr Graham states that PUK is an abbreviation of Promax UK and that it is not involved in any retail sales activity. Pages from Promax's website are exhibited. As the case turns solely upon a trade mark to trade mark, services to services comparison, this exhibit has no bearing upon the issues involved.

Average consumer, nature of purchasing decision and standard for likelihood of confusion

12) The services of Peek are retail services. In relation to the United Kingdom registration, they are supplied in a department store. These services are used by the public at large. They can be services used at the spur of the moment. Consequently, the effects of imperfect recollection are increased. The services will be primarily identified by signage, whether that be on the front of a shop, on a catalogue or on a website, in the case of the Community trade mark application. If a customer is purchasing the services over the telephone, they are likely to have a catalogue, advertisement or website before them; which acts as the reference point for the purchase. Consequently, visual impression will have the greatest effect. Mr Caddy submitted that the average consumer of the services is not just the purchaser of goods and services but also the suppliers of goods to the stores, as the store is assisting in the sale of the goods. The supplier is supplying, it is not consuming; it is not a purchaser, it is a seller. It was Mr Caddy's contention that as retailing is a service which involves bringing together products in a particular environment, by selling the products of a supplier it is supplying a service to the supplier and, therefore, the supplier is a consumer of the services of a retailer, as well as the purchaser of the goods. It is difficult to see how the supplier is a consumer, it is not purchasing anything; consumption and supply are polar activities. The average consumer of the services of the earlier registration is the purchaser of goods and services.

13) The services of the application will be supplied to businesses. They are services which will be bought with some care and as a result of an educated purchasing decision. The potential customer is likely to consider a variety of providers before deciding on one. Consequently, the effects of imperfect recollection are decreased. They are services that are likely to be tendered for and for which the purchaser will be likely to seek a number of quotations, consequently, documentation will be before the average consumer. Consequently upon this, the visual impact of the trade mark will be more important than the aural impact.

14) It is to be borne in mind that the average consumer is deemed to be reasonably well informed and reasonably circumspect and observantⁱⁱ.

Comparison of services

15) Consideration should be given as to how the average consumer would view the servicesⁱⁱⁱ. The class of the services in which they are placed may be relevant in determining the nature of the services^{iv}. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^v. However, Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 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.”

In assessing the similarity of services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{vi}. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the General Court (GC) explained when goods are complementary:

“82 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 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).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{vii}.

16) Mr Caddy submitted that the services of the application are all advertising services with the exception of *recruitment and human resources/personnel services*. This ignores *subscription services*; these are services that arrange or administer subscriptions to such things as publications or telecommunication services. In *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* C- 239/05 the Court of Justice of the European Union (CJEU) stated:

“38 In the light of the foregoing, the answer to the first question must be that the Directive must be interpreted as meaning that, when refusing registration of a trade mark, the competent authority is required to state in its decision its conclusion for each of the individual goods and services specified in the application for registration, regardless of the manner in which that application was formulated. However, where the same ground of refusal is given for a category or group of goods or services, the competent authority may use only general reasoning for all of the goods or services concerned.”

It is permissible, therefore, to bring services together into a category and make a comparison based upon this categorisation, if any of the services fall within a category that will allow objections against them to be considered against them as a whole. Other than the caveat re *subscription services*, it is accepted that the services of Promax can be described as advertising services. The services of Peek, for both its registration and application, are retail services. In his submissions Mr Caddy referred to the evidence of Peek showing what it does and how it goes about its business. The GC has held on a number of occasions that the specific nature of the activities of a particular undertaking do not have a bearing in the issues surrounding likelihood of confusion. In *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-116/06 the GC stated:

“76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors (*QUANTUM*, paragraph 75 above, paragraph 104, and *T.I.M.E. ART/Devinlec v OHIM*, paragraph 75 above, paragraph 59).”

In *Phildar SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-99/06 the GC stated:

“73 Therefore, in the present case, even if it had been proved that the goods covered by the earlier mark had, for a long period of time, been sold only through an exclusive sales network, that cannot result in the network acquiring the characteristics of a normal method for marketing the

goods at issue. The ‘objective’ marketing circumstances to which *QUANTUM*, paragraph 68 above, refers, are the ‘usual’ circumstances in which the goods covered by the marks at issue are marketed, that is, those which it is usual to expect for the category of goods covered by those marks. Accordingly, it is irrelevant whether the goods of the applicant that are in question are sold by an exclusive network, in so far as it has not been proved that it is usual to expect that the categories of goods in question manufactured by the applicant’s competitors will, as a general rule, also be sold under such exclusive conditions.”

The same reasoning can be seen in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05*, *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-147/03*, *Sadas SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-346/04* and *Daimlerchrysler AG v Office for Harmonization In the Internal Market (Trade Marks and Designs) Case T-358/00*. Mr Caddy also referred to the services that retail trade associations supply. These are trade associations, not retailers; by their nature they will supply a variety of services that are not retail services and do not reflect what retailers do.

17) In *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-116/06* the GC stated:

“43 With regard, in particular, to the registration of a trade mark covering retail services, the Court held, in paragraph 34 of the judgment in *Praktiker Bau- und Heimwerkermärkte*, that the objective of retail trade is the sale of goods to consumers, which includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction, and that that activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor. The Court stated, in paragraph 35 of that judgment, that no overriding reason based on First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) or on general principles of Community law precludes those services from being covered by the concept of ‘services’ within the meaning of the directive or, therefore, the trader from having the right to obtain, through the registration of his trade mark, protection of that mark as an indication of the origin of the services provided by him.”

The primary issue of *Praktiker Bau- und Heimwerkermärkte AG v Deutsches Patent- und Markenamt Case C-418/02* was:

“9 By its first two questions, which must be considered together, the Bundespatentgericht seeks in essence to ascertain whether the concept of ‘services’ referred to by the directive, in particular in Article 2, is to be interpreted as including services provided in connection with retail trade in goods and, if so, whether the registration of a service trade mark in respect of such services is subject to the specification of certain details.”

The CJEU was being asked whether retailing was a service for the purposes of trade mark registration. It answered:

“34 In that regard, it should be noted that the objective of retail trade is the sale of goods to consumers. That trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor.

35 No overriding reason based on the directive or on general principles of Community law precludes those services from being covered by the concept of ‘services’ within the meaning of the directive or, therefore, the trader from having the right to obtain, through the registration of his trade mark, protection of that mark as an indication of the origin of the services provided by him.”

It answered that it could be and stated why it was a service, because some form of service was being supplied. Mr Caddy considers that this activity carried out by the trader for encouraging the conclusion of a transaction will cover a variety of services including promoting and advertising them. So he would have it that a registration, or application in the case of the Community trade mark, will cover, in effect, promotion and advertising. It is not possible to see how this can be extrapolated from the judgment of the CJEU, in terms of what it said and the question that was put to it. The argument would be contrary to the requirement of legal certainty required by the CJEU in *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99:

“115 Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties--particularly competitors--would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

Competitors would not know the extent of the protection granted by *retail services* if Mr Caddy is correct in his interpretation. *Advertising services* occupy a clearly defined area of industry. If Peek wants protection for advertising services, *subscription services* and or *recruitment and human resources/personnel services* it should make an application to cover these services.

18) Most goods and services are advertised; to argue that because of this they are similar to advertising services is to argue that because a service uses a computer it is similar to a computer^{viii}. All undertakings or persons advertising their wares or services are in some way or another trying to present an image. The purpose of advertising is to promote products and services, the purpose of retail services is to sell; the intended purposes are different. Advertising services and *retail services* are not fungible, they are not in competition. *Retail services* and advertising services are not mutually dependant, nor do they have a symbiotic relationship. They are not indispensable or important to one another "in such a way that customers may think that the responsibility for those goods lies with the same undertaking". The respective services are not complementary. Advertising services are supplied by agencies or by media undertakings, this is not the same channel of trade as retailing. Indeed, they represent clearly discrete areas. The end user of advertising services is someone who wishes to promote a product or service, the end user of a retail service is someone who wishes to purchase a product or service, the end users are not the same. (This end user would still be different if it was accepted that the suppliers were also end users, as per the average consumer argument of Mr Caddy.)

19) *Marketing, sales promotion and advertising services; arranging and organising events and exhibitions for advertising, sales promotion, marketing and commercial purposes; information services relating to marketing, sales promotion and advertising matters; research services relating to marketing, sales promotion and advertising matters; dissemination of advertising and publicity materials; business directory services are not similar to retail services.*

20) The argument that Mr Caddy raises in relation to *recruitment and human resources/personnel services* shares similarities with that in relation to the advertising services. All undertakings recruit staff, they all have to manage staff; this does not give rise to similarity. The intended purpose of *recruitment and human resources/personnel services* is clearly different from *retail services*. The respective services are not fungible, they are not in competition. They are not indispensable or important to one another "in such a way that customers may think that the responsibility for those goods lies with the same undertaking". They are not complementary. *Recruitment and human resources/personnel services* have a clear position in the market, a position that has no point of conjunction with *retail services*. The respective services do not have the same channels of trade. The end user of *recruitment and human resources/personnel*

services is a person or undertaking who wishes to recruit or manage staff. The end user of *retail services* is a person or undertaking who wishes to purchase goods or services. They are not the same.

21) *Recruitment and human resources/personnel services* are not similar to *retail services*.

22) *Subscription services*, as noted above, are services that arrange or administer subscriptions to such things as publications or telecommunication services. They are services supplied to a third party. The purpose of *subscription services* is as described, the purpose of retail services is to sell goods and products. They do not have the same intended purpose. The respective services are not fungible, they are not in competition with one another. They are not indispensable or important to one another “in such a way that customers may think that the responsibility for those goods lies with the same undertaking”. They are not complementary. The respective services occupy discrete trade channels. The end user of *subscription services* is not the subscriber but the undertaking which is offering the subscription, the subscriber is unlikely to know that a third party is responsible for the organisation or management of the subscription.

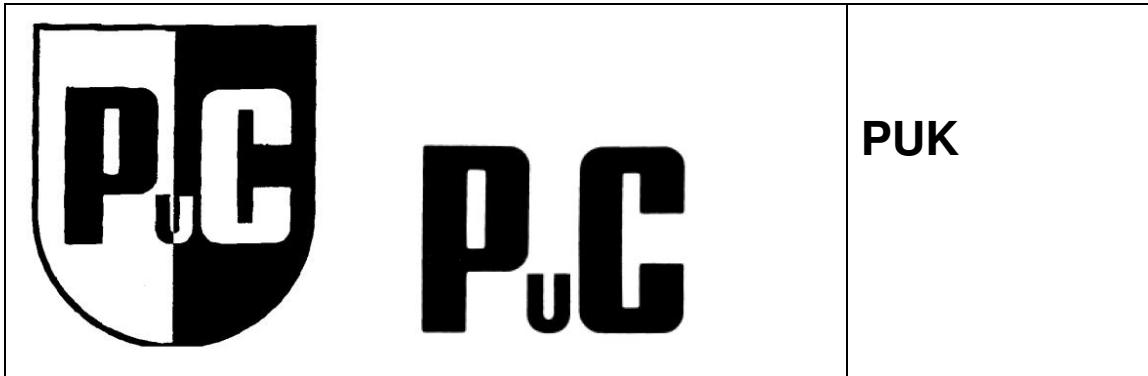
23) *Subscription services* are not similar to retail services.

24) None of the services in class 35 of the specification of the application are similar or identical to the services of the earlier registration and application upon which Peek relies. Indeed, the differences are such that the services are dissimilar.

25) Effectively, Mr Caddy’s arguments as to the similarity of goods and services was predicated on the basis that retail services would encompass the services of the application; so that the respective services are, in fact, identical. This interpretation is against the precepts of *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 and *British Sugar Plc v James Robertson & Sons Limited*, it is also based on an interpretation of the meaning of *retail services* that is contrary to both the sense and the meaning of the term.

Comparison of trade marks

26) The trade marks to be compared are:



27) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{ix}. 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^x. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{xi}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xii}.

28) Owing to the presence of the shield device and two tone colouring of the Community trade mark application, Peek must be in a better position in relation to similarity with its United Kingdom trade mark than with its Community application. Consequently, the comparison will only be made in relation to the United Kingdom trade mark registration.

29) Mr Caddy submitted that as Promax's trade mark is in a standard font it could be used in the same get-up as Peek's trade mark. In *Calvin Klein Trademark Trust v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-158/07 the GC stated:

“48 In that regard, it is important to point out, as the Board of Appeal stated in paragraph 23 of the contested decision, that the examination of the similarity of the marks at issue takes into consideration those marks in their entirety, as they have been registered or as they have been applied for. A word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without

any specific graphic element. The protection which results from registration of a word mark concerns the word mentioned in the application for registration and not the specific graphic or stylistic elements accompanying that mark. **The graphic representation which the mark applied for may have in the future must not, therefore, be taken into account for the purposes of the examination of similarity** (see to that effect, Case T-211/03 *Faber Chimica v OHIM – Naberska (Faber)* [2005] ECR II-1297, paragraphs 36 and 37; Case T-353/04 *Ontex v OHIM – Curon Medical (CURON)* [2007], not published in the ECR, paragraph 74; and Case T-254/06 *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, not published in the ECR, paragraph 43).”

(emphasis added).

This judgment was subject to appeal to the CJEU (Case C-254/09 P) which rejected the grounds of appeal. Mr Caddy’s submission is directly contrary to the judgment of the GC and must be rejected^{xiii}.

30) If, as submitted by Mr Caddy, Promax could use its trade mark in the highly stylised formulation he suggested, the sequitur of this would be that such use would be in “a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered” and so save it from revocation for non-use. The stylisation he suggests is such that this would clearly not be the case. Mr Caddy’s argument requires not the comparison of an earlier trade mark with an application but with an infinite number of potential trade marks.

31) The letters P and C stand out in the trade mark of Peek, they represent the dominant and distinctive component. Promax’s trade mark consists of a one syllable invented word (there is no indication that it is other than an invented word). There is no single dominant or distinctive element, the trade mark’s distinctiveness lays in its entirety.

32) The last two letters of PUK are likely to be pronounced in the same manner as the last three letters of muck. Peek’s trade mark has the large letters PC, in between the letters is the shape of a u. There is nothing to show that the average consumer of Peek’s services will necessarily see this as the letter u rather than a shape. There is certainly nothing to indicate that the average consumer will see the trade mark as being the equivalent of the invented word PUC or that this consumer will pronounce the trade mark as puck rather than enunciate it as three separate letters or two letters PC. Visually Peek’s trade mark is dominated by the letters PC. It has a clearly different visual impression than the trade mark of Promax.

33) There is nothing to suggest that the average consumer of Peek’s services would see any meaning in either trade mark.

34) Peek's best case in relation to similarities lies with the aural identity of the trade marks, **if** Peek's trade mark is perceived by the average consumer as being the invented word PUC.

Conclusion

35) For there to be a likelihood of confusion the respective services must be similar or identical. It has been decided that the services are not similar, consequently the ground of opposition must be dismissed.

36) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

In this case it is visual similarity, or dissimilarity, that is of greater importance than aural similarity. In *Mülhens GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-206/04 the CJEU held:

“21 It is conceivable that the marks' phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.

22 Therefore, one cannot deduce from paragraph 28 of the judgment in Lloyd Schuhfabrik Meyer that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.

23 The Court of First Instance therefore correctly considered the overall impression created by the two signs at issue, as regards their possible conceptual, visual and aural similarities, for the purpose of the global assessment of the likelihood of confusion.”

In *Cabel Hall Citrus Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-488/07* the GC stated:

“52 In that connection, it should be noted that although, in general, it cannot be ruled out that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94, the existence of such a likelihood must be established as part of a global assessment as regards the visual, conceptual and phonetic similarities between the signs at issue. Thus, the assessment of any phonetic similarity is but one of the relevant factors for the purpose of that global assessment. Therefore, it cannot be accepted that there is a likelihood of confusion each time that a certain phonetic similarity can be established between the marks at issue (Case C-206/04 P *Mühlens v OHIM* [2006] ECR I-2717, paragraphs 21 and 22).”

37) Owing to the visual differences between the trade marks and the nature of the services, even if there was some degree of similarity between the respective services and it was considered that they were phonetically identical, there would not be a likelihood of confusion.

Costs

38) Promax having been successful is entitled towards a contribution towards its costs. The evidence of neither party has had any influence on the decision. Consequently, Promax will receive no contribution towards the costs of its evidence, although it will receive a contribution towards considering the evidence of Peek. Costs are awarded on the following basis:

Preparing statements and considering the statement of Peek:	£300
Considering the evidence of Peek:	£200
Total:	£500

Peek & Cloppenburg KG is ordered to pay Promax UK Marketing Association the sum of £500. 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 06 day of January 2011

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

ⁱ Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

ⁱⁱ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

ⁱⁱⁱ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^{iv} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^v *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{vi} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{vii} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

(a) The respective uses of the respective goods or services;
(b) The respective users of the respective goods or services;
(c) The physical nature of the goods or acts of service;
(d) The respective trade channels through which the goods or services reach the market;
(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

^{viii} See *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-316/07:

“54 The mere fact that the information, booking and reservation services covered by the trade mark at issue are exclusively provided via the internet and therefore require software support such as that provided by the goods and services covered by the earlier trade mark does not

suffice to remove the essential differences between the goods and services concerned in terms of their nature, their intended purpose and their method of use.

55 Computer goods and computer services are used in nearly all sectors. Often, the same goods or services – for example, a certain type of software or operating system – may be used for very different purposes, and that does not mean that they become different or distinct goods or services. Conversely, travel agency services do not become something else – in terms of their nature, intended purpose or method of use – solely because they are provided via the internet, particularly since, nowadays, use of computer applications for the provision of such services is almost essential, even where those services are not provided by an internet shop.

56 Moreover, the goods and services concerned are not substitutable, since they are intended for different publics. Therefore, the Board of Appeal was right to find that those goods and services are not in competition with each other.

57 Finally, those same goods and services are also not complementary. It must be recalled in this respect that goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gómez Frías (euroMASTER)*, not published in the ECR, paragraph 35; and Case T-420/03 *El Corte Inglés v OHIM – Abril Sánchez and Ricote Saugar (Boomerang TV)* [2008] ECR I-0000, paragraph 98).

58 That case-law definition implies that complementary goods or services can be used together, which presupposes that they are intended for the same public. It follows that there can be no complementary connection between, on the one hand, the goods and services which are necessary for the running of a commercial undertaking and, on the other, the goods and services produced or supplied by that undertaking. Those two categories of goods or services are not used together since those in the first category are used by the relevant undertaking itself whilst those in the second are used by customers of that undertaking.”

^{ix} *Sabel BV v Puma AG* Case C-251/95.

^x *Sabel BV v Puma AG* Case C-251/95.

^{xi} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{xii} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xiii} Also see *Frag Comercio Internacional, SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-162/08:

“46 It must be emphasised that the examination of the similarity of the marks in dispute takes them into consideration as a whole, as they are registered or sought to be registered. Figurative marks are, by nature, exclusively protected in accordance with the fixed nature of their morphology covered by their registration. In that regard, as OHIM correctly states on its internet site, it must be borne in mind that a figurative mark is defined as a specific representation of word or graphic characteristics or a combination of word and graphic elements, whether or not in colour. A complex figurative mark consists of two or more categories of signs, combining, for example, letters and graphics (Case T-211/03 *Faber Chimica v OHIM – Nabersa (Faber)* [2005] ECR II-1297, paragraph 33).

47 It is therefore not necessary, for the purposes of assessing similarity, to take account of any other graphic representation or any representation in enlarged format which the mark applied for might take on in future (see, to that effect and by analogy, *Faber*, paragraph 46 above, paragraphs 36 and 37; judgment of 13 February 2007 in Case T-353/04 *Ontex v OHIM – Curon Medical (CURON)*, not published in the ECR, paragraph 74; and judgment of 22 May 2008 in Case T-254/06 *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, not published in the ECR, paragraph 43).”