

O-405-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2534270
BY BM POLYCO LTD TO REGISTER THE TRADE MARK**

Metallica

IN CLASS 9

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 100645
BY METALLICA, A CALIFORNIA GENERAL PARTNERSHIP**


BACKGROUND

1. On 14 December 2009, BM Polyco Ltd (“BM”) applied to register **Metallica** as a trade mark for the following goods in class 9:

Gloves for industrial purposes for protection against injury, Gloves for industrial use for protection against accidents, Gloves for protection against accidents, Gloves for protection against injury, Gloves for the protection of the wearer to prevent injury, Industrial gloves for protection against accident or injury, Protective gloves for industrial use for the prevention of accident or injury, Protective gloves for use in industry for the prevention of accident or injury, Safety gloves for protection against accident or injury.

Following examination, the application was accepted and published for opposition purposes on 9 April 2010.

2. On 24 June 2010, Metallica, a California general partnership (“Partnership”) filed a notice of opposition which, although initially consisting of grounds based upon sections 5(2)(a) and (b) of the Trade Marks Act 1994 (“the Act”), following amendment now consists of a single ground based upon section 5(2)(b) of the Act. Partnership’s opposition, which is directed against all of the goods in BM’s application, is based upon the following trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods relied upon
 The logo for the band Metallica, featuring the word "METALLICA" in a bold, black, sans-serif font. The letters are slightly slanted and have a metallic, three-dimensional appearance. The word is flanked by two stylized, black, wing-like or lightning-bolt-like shapes that point upwards and outwards.	CTM 5479159	30.12.2004	13.12.2006	Class 9: Clothing for protection against injury or accident. Class 25: Clothing; footwear; headgear; money belts; veils; fishing waders.

3. On 26 August 2010 BM filed a counterstatement (amended in June 2011) in which the ground of opposition is denied.

4. Neither party filed evidence; both filed written submissions during the evidential rounds. Neither party asked to be heard; Partnership filed written submissions in lieu of attendance at a hearing. I will refer to these written submissions as necessary below.

DECISION

5. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(a)....

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

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

6. 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) or 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings Partnership is relying upon the trade mark shown in paragraph 2 above which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which BM’s application was published i.e. 9 April 2010 and the date on which Partnership’s trade mark completed its registration procedure i.e. 13 December 2006, Partnership’s earlier trade mark is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

8. The leading authorities which guide me are from the CJEU (Court of Justice of the European Union): *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] 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 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 for 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) 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*

(f) 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*.

(g) 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*,

(h) 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*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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.*

Comparison of goods

9. For the sake of convenience the goods to be compared are as follows:

BM's goods	Partnership's goods
Gloves for industrial purposes for protection against injury, Gloves for industrial use for protection against accidents, Gloves for protection against accidents, Gloves for protection against injury, Gloves for the protection of the wearer to prevent injury, Industrial gloves for protection against accident or injury, Protective gloves for industrial use for the prevention of accident or injury, Protective gloves for use in industry for the prevention of accident or injury, Safety gloves for protection against accident or injury.	Class 9: Clothing for protection against injury or accident. Class 25: Clothing; footwear; headgear; money belts; veils; fishing waders

10. In its submissions dated 28 April 2011 Partnership said:

“3. The opponent submits that the term mentioned above [this is a reference to its goods in class 9] covers everything in the application in suit, and the trade marks are verging on being identical.”

11. In its submissions dated 28 June 2011 BM said in response to the above:

“3. The statements contained in paragraph 3 of the opponent's submissions dated 28 April 2011 are not denied.”

12. Although elsewhere in its submissions BM takes issue with the degree of similarity in the competing trade marks, its position in relation to the competing goods is, I think, a

sensible one. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC said:

“29 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).”

13. BM's goods are all gloves of one sort or another for protection against accidents and injury. These goods would all fall within the term “clothing for protection against injury or accident” contained in Partnership's earlier trade mark and the respective goods are are, as a consequence, identical.

The average consumer and the nature of the purchasing process

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

15. The goods at issue in these proceedings are gloves for protection against accident or injury, the average consumer for which will be the public at large, including those buying such goods for use in industry. In the absence of any evidence or submissions as to the cost of the goods at issue or how they are likely to be selected by the average consumer, I must reach my own conclusions. My own experience suggests that such goods will be selected to prevent accident or injury in a wide range of domestic and industrial settings. As the severity of the risk increases so, I assume, will the cost of the goods at issue and the care the average consumer will need to display when selecting the goods. The goods at issue are likely to be sold in a range of outlets (in both the physical and virtual world) and will include, for example, supermarkets, garden centres and from undertakings specialising in such goods such as industrial clothing suppliers. While this suggests that the selection of the goods may be primarily a visual one, given the nature of the goods and the need to ensure that they are fit for purpose, the purchasing act may also include enquiries (either face-to-face or by telephone) which in turn will bring aural considerations into play.

Comparison of trade marks

16. The trade marks to be compared are:

BM's trade mark	Partnership's trade mark
Metallica	

17. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

18. BM's trade mark consists of the word Metallica presented in title case. As no part of the trade mark is highlighted or emphasised in any way, its distinctiveness must lie in the totality. Insofar as Partnership's trade mark is concerned, in its submissions dated 29 September 2011 it said, inter alia:

“2. The prior mark is clearly the word METALLICA with a certain stylisation to the initial letter M and terminal A...”

And:

“4...and the prior mark and the trade mark in suit are verging on being identical.”

19. In its submissions BM said (in relation to why in its view the competing trade marks were different):

“2. ...because not only the initial M and terminal A are stylised; The whole mark is stylised including the intervening letters ETALLIC...”

And:

“Also, we submit that the opponent is interpreting the mark with the benefit of hindsight. We submit that the word METALLICA is not immediately derivable from the registered mark and that the mark would be perceived as the word ETALLIC proceeded and succeeded by devices resembling tribal markings or weapons.”

20. In my view, Partnership's trade mark is clearly not “verging on being identical” to the trade mark of BM. While the letters ETALLIC are, I agree, presented in a stylised script, this stylised script is, in my view, unremarkable. Insofar as the elements which appear

at the beginning and end of the trade mark are concerned, I agree that if considered in isolation the message these elements convey to the average consumer may be ambiguous. However, in the manner in which they appear in Partnership's trade mark (i.e. as part of a larger word), and despite the heavy degree of stylisation present in both letters, they are, in my view, clearly intended to represent the letters M and A, and that, in my view, is how the average consumer will construe them. In short, while the stylised letters M and A are (by virtue of their size) dominant and distinctive elements of Partnership's trade mark, the natural tendency of the average consumer to try to "make sense" of trade marks of this type, results in the distinctiveness of the trade mark as a whole lying in the overall impression it creates i.e. the word METALLICA.

Visual similarity

21. While the heavily stylised letters M and A present in Partnership's trade mark create obvious points of difference, the fact that both trade marks consist of nine characters and are made up of the same letters in the same order, results, in my view, in a reasonable degree of visual similarity between them.

Aural similarity

22. As the stylisation present in the letters M and A will have no impact when the competing trade marks are verbalised, they are, in my view, aurally identical.

Conceptual similarity

23. In its submissions BM said:

"The word METALLICA is an Italian word meaning METALLIC, being an adjective – see www.wordreference.com/iten/metallica."

24. While I am unconvinced that the average consumer in the United Kingdom would know that the word METALLICA was an Italian word meaning metallic, if they were aware of this meaning, the concepts both trade marks will evoke in their mind will, given my conclusions above as to how Partnership's trade mark will be construed by them, be identical. More likely, in my view, is that the average consumer will construe both trade marks as alluding in some way to metal, thus also creating similar conceptual imagery in their mind. The competing trade marks are, as a result, and insofar as they are likely to create any imagery in the average consumer's mind, conceptually identical.

Distinctive character of Partnership's earlier trade mark

25. I must now assess the distinctive character of Partnership's earlier trade mark. The distinctive character of a trade mark must be appraised first by reference to the goods in respect of which it has been registered and, second, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing

whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. There is nothing to suggest that the word METALLICA (presented in normal typeface) would be either descriptive of or non-distinctive for the goods at issue in these proceedings; it would, as a consequence, be a trade mark possessed of a reasonable level of inherent distinctive character. While the form in which Partnership's trade mark is presented is likely to enhance the inherent distinctiveness of the word compared to its being presented in normal typeface, this is not a factor that is likely to have great significance in these proceedings.

Likelihood of confusion

26. In determining whether there is a likelihood of confusion, I need to bear a number of factors in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to keep in mind the distinctive character of Partnership's earlier trade mark (as the more distinctive this trade mark is, the greater the likelihood of confusion), the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

27. In its submissions, BM said:

“5. The opponent is a well known rock music band see www.metallica.com and any likelihood of association with the opponent's earlier trade mark is reduced because the public would not expect such an undertaking to apply the mark to the goods for which registration is sought i.e. protective gloves per se.”

28. As Partnership's earlier trade mark is not subject to proof of use, this submission does not assist BM. The fact remains that earlier in this decision I concluded, inter alia, that the goods were identical and that the competing trade marks shared a reasonable degree of visual similarity and were aurally and (insofar as they conveyed any imagery) conceptually identical.

29. Having reached those conclusions and despite the visual differences in the competing trade marks which is likely to militate against direct confusion (i.e. where one trade mark is mistaken for another), I have no hesitation finding that the similarities in the trade marks and the identity in the goods will lead to a likelihood of indirect confusion i.e. where the average consumer assumes there is an economic link between the parties. Partnership's opposition based upon section 5(2)(b) of the Act succeeds accordingly.

Costs

30. Partnership has been successful and as such is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, I award costs to Partnership on the following basis:

Preparing a statement and considering BM's statement:	£200
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Opposition fee:	£200
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Written submissions:	£100
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31. However, I intend to reduce the total shown above by £100 to reflect the fact that BM filed an amended counterstatement in response to Partnership's request to amend its notice of opposition.

32. I order BM Polyco Ltd to pay to Metallica, a California general partnership the sum of **£400**. 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 21 day of November 2011

C J BOWEN
For the Registrar
The Comptroller-General