

O-251-14

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION NO 2572790**  
**BY**  
**SPECIALISED WIRING ACCESSORIES LIMITED**  
**TO REGISTER THE TRADE MARK**

**TAURUS**

**IN CLASSES 06 AND 09**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**  
**UNDER NO 102293**  
**BY**  
**ELECTRODOMESTICOS TAURUS S.L.**

## BACKGROUND

1) On 18 February 2011, Specialised Wiring Accessories Limited ('the applicant') applied to register the trade mark TAURUS for goods in classes 06 and 09. The application was published on 20 May 2011 in the Trade Marks Journal and notice of opposition was subsequently filed by Electrodomesticos Taurus S.L. ('the opponent'). Further to a number of amendments, the specification of the application now reads as follows:

**Class 06:** *Connection elements (non-electric); cable and wire connectors (non-electric); nuts; lock, screw, screw-in, threaded, pipe and wing nuts; electrical cable sealing glands; hinges for the fastening of electrical cables; trunking channels for electrical wiring; ducting conduits (non-electric); screws; binding screws for cables; threaded, self-drilling and self-tapping screws; threaded and screw threaded fasteners; thread for tying up and wrapping purposes; non-electric cables and wires; pipes and tubes; all included in Class 6; parts and fittings for all the aforesaid; all made wholly or principally of metal.*

**Class 09:** *Cable glands for use with electrical apparatus; electrical cable gland packs; all the aforesaid goods being intended for use by professional electricians in the field of electrical installation.*

2) The opponent claims that the application offends under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 ('the Act') **in respect of the goods in class 09 only**.

3) The opponent relies on the following community trade mark ('CTM') for both grounds of opposition:

Earlier Mark details	Goods relied upon
<p>CTM No: 3786662</p> <p><b>TAURUS</b></p> <p>Filing date: 06 May 2004<sup>1</sup></p> <p>Date of entry in the register: 08 July 2013</p>	<p><b>Class 9:</b> <i>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for</i></p>

<sup>1</sup> A seniority date of 20 December 1972 is recorded on the register for this mark but has been challenged by the applicant as being invalid on the basis that the UK did not become a signatory to the International system until 1995. In response to this the opponent states: "There is clearly a typo in the seniority claim such that the claim is not made from 20 December 1972, but from 20 December 1992. In any event, whether the seniority claim is valid or not is immaterial because the Opponent's registration is an earlier mark regardless". I agree.

	<i>coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.</i>
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4) The filing date of the opponent’s mark is earlier than that of the contested mark and the former has completed its registration procedure; it is therefore an earlier mark in accordance with section 6 of the Act. Further, given the interplay between the registration date of the opponent’s mark and the date of publication of the applicant’s mark, the earlier mark is not subject to the proof of use conditions contained in section 6A of the Act.

5) The applicant filed a counterstatement in which it denied the grounds of opposition. Neither party filed evidence. Both parties filed written submissions in lieu of a hearing. I now make this decision based on the papers before me giving full consideration to all submissions and making reference to the same as, and when, I consider it appropriate.

**DECISION**

**Sections 5(1) & 5(2)(a)**

6) The relevant sections of the Act provide:

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

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

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

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

**Comparison of the respective marks**

7) In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (‘CJEU’) held:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

The respective marks in this case are both ‘TAURUS’ (word only); clearly, they are identical.

## Comparison of the respective goods

8) The opponent states that it relies, in particular, on the terms which are highlighted in bold in the table below. I agree that those goods represent the opponent's strongest case. I will make the comparison solely on the basis of those goods as the opponent cannot be in any stronger position in relation to its other goods.

Opponent's goods	Applicant's goods
<p><b>Class 9:</b> <i>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.</i></p>	<p><b>Class 09:</b> <i>Cable glands for use with electrical apparatus; electrical cable gland packs; all the aforesaid goods being intended for use by professional electricians in the field of electrical installation.</i></p>

9) The opponent argues that the respective goods are identical or, in the alternative, are similar to a high degree.

10) The applicant describes its own goods as "mechanical cable entry devices" and that their purpose is "to secure the end of steel wire armoured and unarmoured cable and/or provide strain relief"; it denies that the respective goods are identical. I agree - it is not clear to me that cable glands are, of themselves, apparatus for conducting, switching, transforming, accumulating, regulating or controlling electricity. **The ground of opposition under Section 5(1) of the Act is therefore dismissed.**

11) I now turn to consider whether there is nevertheless similarity between the goods for the purpose of assessing whether there is a likelihood of confusion under section 5(2)(a) of the Act. In assessing similarity between goods all relevant factors relating to the same should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU 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.”

12) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

13) Finally, in terms of understanding what a "complementary" relationship means, I bear in mind the judgment of the General Court in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 where it 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 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 *Segio 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 *EI Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseño original Juan Bolanos)* [2007] ECR I-0000, paragraph 48)."

On the meaning of complementary, I also bear in mind the comments of Mr Daniel Alexander QC, sitting as the appointed person, in *Sandra Amalia Mary Elliott v LRC Products Limited* BL O/214/13.

14) The opponent submits that the respective goods are similar to a high degree on the basis that they are:

“all for the same use i.e. for electrical installations; are of the same nature i.e. they are all electrical equipment; are all complimentary in that they are all used (often in combination) in electrical installations; are all for use by professional electricians; and; would have the same point of sale, most often trade sellers of electrical equipment”.

15) The applicant denies that the respective goods are similar. It asserts that the opponent's goods are “domestic electrical products” that are purchased by ordinary members of the public for domestic home use whereas the applicant's goods are “industrial goods which are not ready for immediate use without installation and testing by professional electricians” and “such industrial ‘*cable glands*’ goods are not likely to be purchased by ordinary members of the public”.

16) The applicant's arguments do not assist it. The assessment of the similarity between the respective goods must be undertaken from a notional and objective stand point based on the terms, as listed, in the competing specifications and not on

the current marketing strategies of either party.<sup>2</sup> The opponent's specification, which is in no way limited, would include domestic and industrial electrical goods.

17) The opponent's goods would include electrical cables and wires (within the term 'apparatus for conducting electricity'). It is self evident to me that there is a complementary relationship between the respective goods; cables and wires are indispensable to cable glands. There is also a degree of similarity in purpose since the competing goods are all essentially concerned with enabling or aiding the flow of electricity. Further, it is likely that the trade channels and users (i.e. primarily electricians) will be the same. There is, in my judgment, a high degree of similarity between the opponent's 'apparatus for conducting, switching, transforming, accumulating, regulating or controlling electricity' and the applicant's goods.

### **Likelihood of confusion**

18) The applicant contends that there are a number of 'TAURUS' marks on the register, including those owned by the opponent, which have clearly co-existed for many years. It further states that this co-existence is reflected in the marketplace since there have been no reported instances of confusion on the part of the public. In *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283 at p 291 Millet J stated:

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

As neither party has filed any evidence in these proceedings, there is nothing before me to indicate that the average consumer has been exposed to both marks in the marketplace and been able to distinguish between. Therefore, the applicant's submission does not assist it.

19) In considering whether there is a likelihood of confusion under Section 5(2)(a) of the Act, it is necessary to have regard to the principle that there is a greater likelihood of confusion where the earlier mark has a highly distinctive character; either per se, or because of the use that has been made of it.<sup>3</sup> The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public.<sup>4</sup> As there is no evidence before me, I have only the inherent level of distinctiveness to consider. I am not aware, and there is nothing before me to suggest, that the word 'TAURUS' has any descriptive, suggestive or allusive meaning in relation to the opponent's goods. It thus appears to me that the opponent's mark is possessed of a good degree of inherent distinctive character.

20) It is also necessary to bear in mind the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of

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<sup>2</sup> See, for example, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, paragraph 59.

<sup>3</sup> *Sabel BV v Puma AG* [1998] RPC 199

<sup>4</sup> *Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91

similarity between the goods, and vice versa.<sup>5</sup> The marks in the instant case are, of course, identical. This identity means that, regardless of how careful or educated the purchasing decision may be, there is nothing by which the average consumer of the goods can distinguish the marks. Bearing this in mind together with the good degree of distinctive character of the earlier mark and the high degree of similarity between the goods, I have little hesitation in finding a likelihood of confusion.

21) The applicant has put forward a fall-back specification, as follows:

“Electrical cable gland packs; strain relief cable glands; the aforesaid goods not including domestic electrical goods and being intended for industrial use by professional electricians in the field of electrical installation.”

22) In light of the scope of the opponent’s specification and bearing in mind my earlier comments at paragraph 16, this fall-back specification does not assist the applicant.

**The ground of opposition under Section 5(2)(a) of the Act succeeds. Accordingly, the application is refused in respect of the goods in class 09 and will proceed to registration solely in respect of the goods in class 06.**

### **COSTS**

23) As the opponent has been successful, it is entitled to an award of costs. I award costs to the opponent on the following basis:

Preparing notice of opposition	£200
Opposition fee	£200
Written submissions:	£300
<b>Total:</b>	<b>£700</b>

24) I have not overlooked the opponent’s request that the applicant should be “penalised” for limiting the specification at a late stage since the opponent had already “needlessly spent considerable time preparing written submissions that dealt with the wider specification”. The opponent’s submissions in lieu of a hearing were not particularly detailed or lengthy. I do not consider it appropriate to increase the award to the opponent any further; the amount given above is fair and proportionate.

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<sup>5</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117

25) I order Specialised Wiring Accessories Limited to pay Electrodomesticos Taurus S.L. the sum of **£700**. 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 9th day of June 2014**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**