

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 100472

IN THE NAME OF TONY VAN GULCK

TO TRADE MARK APPLICATION No. 2526406

IN THE NAME OF WASABI FROG LTD

DECISION

1. On 7 September 2009 Wasabi Frog Ltd ('WFL') applied under number 2526406 to register **MissBoo** as a trade mark for use in relation to a wide range of goods and services in Classes 3, 9, 14, 16, 18 and 35. Tony Van Gulck ('TVG') opposed the application for registration in Classes 18 and 35 in opposition proceedings commenced under number 100472 on 5 May 2010. It was contended that use of the trade mark **MissBoo** for goods and services of the kind which WFL had specified in those classes would conflict with the rights to which TVG was entitled under Section 5(2)(b) of the Trade Marks Act 1994 as proprietor of the earlier Community trade mark **BOO!** registered under number 1592377 for use in relation to various goods of which only the following remain relevant: '*handbags*' in Class 18 and '*shoes for women*' in Class 25.

2. The opposition was in large part successful for the reasons given by Mrs. Ann Corbett on behalf of the Registrar of Trade Marks in a decision issued under reference BL

O/474/12 on 29 November 2012. WFL now maintains on appeal under Section 76 of the 1994 Act that its application for registration should not have been refused to the extent that it was under Section 5(2)(b). Annex A to this Decision is a copy of the Table compiled by the Hearing Officer for the purpose of identifying the goods and services with respect to which she decided that the opposed application for registration should be refused. Those of the itemisations in the Table in relation to which there is no appeal are underlined (I note that some, but not all, of the itemisations referring to ‘belts’ have been contested). The question raised by the appeal as to the remainder of the goods and services identified in the Table (which I shall refer to as ‘*the listed Goods*’ and ‘*the Listed Services*’) is whether it was open to the Hearing Officer to find that there were similarities (between the marks in issue and the goods and services in issue) that would have combined to give rise to the existence of a likelihood of confusion if there had been use of the trade mark **BOO!** by TVG for handbags in Class 18 and shoes for women in Class 25 concurrently with use of the trade mark **MissBoo** by WFL for the Listed Goods and the Listed Services in the United Kingdom in September 2009.

3. Both as between marks and as between goods and services, the evaluation of ‘*similarity*’ is a means to an end. It serves as a way of enabling the decision taker to gauge whether there is ‘*similarity*’ of a kind and to a degree which is liable to give rise to perceptions of relatedness in the mind of the average consumer of the goods or services concerned. This calls for a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue, giving the similarities and differences as much or as little significance as the relevant average consumer (who is

taken to be reasonably well-informed and reasonably observant and circumspect) would have attached to them at the relevant point in time.

4. The factors conventionally taken to have a particular bearing on the question of ‘*similarity*’ between goods and services are: uses, users and the nature of the relevant goods or services; channels of distribution, position in retail outlets, competitive leanings and market segmentation: see Canon KK v. Metro Goldwyn Mayer Inc C-39/97, EU : C : 1998 : 442 at paragraph [23] together with paragraphs [44] to [47] of the Opinion of Advocate General Jacobs in that case (EU : C : 1998 : 159). More than just the physical attributes of the goods and services in issue must be taken into account when forming a view on whether there is a degree of relatedness between the consumer needs and requirements fulfilled by the goods or services on one side of the issue and those fulfilled by the goods or services on the other. The relatedness or otherwise of the trading activities involved in the comparison is ultimately a matter of consumer perception.

5. That is recognised in the case law of the General Court relating to ‘*complementarity*’ as an element to be considered in the context of the overall assessment of ‘*similarity*’: see, for example, Kampol sp. z.o.o. v. OHIM T-382/12, EU : T : 2014 : 563 where the General Court stated (with emphasis added);

[40] It must be borne in mind that complementary goods and services are those which are closely connected 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 same undertaking is responsible for manufacturing those goods or for providing those services. By definition goods intended for different publics cannot be complementary (See Case T-316/07 *Commercy v. OHIM - easyGroup IP Licensing*

(*easyHotel*) [2009] ECR II-43, paragraphs 57 and 58 and the case-law cited).

...

- [47] The close connection between the goods covered by the mark applied for and mattresses and the fact that those goods and mattresses are often sold in the same specialist sales outlets are capable of leading consumers to think that the same undertaking is responsible for the production of those goods (see, to that effect, *PiraÑAM diseño original Juan Bolaños*, paragraph 35 above, paragraphs 50 and 51, and judgment of 14 May 2013 in Case T-19/12 *Fabryka Łożysk Tocznych-Kraśnik v. OHIM - Impexmetal (IKFLT KRAŚNIK)*, not published in the ECR, paragraph 35).
- [48] The Board of Appeal was therefore right to find that the goods covered by the trade mark application and ‘mattresses’ were complementary to each other and that they were similar to an average degree.
- [49] That outcome is not called into question by the applicant’s arguments.
- [50] In the first place, it is necessary to reject the so-called ‘economic’ definition of complementarity suggested by the applicant according to which complementary goods are those which have, in particular, the distinctive feature of being subject to parallel demand with the result that an increase or decrease in the demand for one product results in an increase or decrease respectively in the demand for the complementary product. No such condition is apparent from the case-law cited in paragraph 40 above.
- [51] It follows that the applicant’s argument that consumers purchase cushions and items of bedding more frequently than mattresses is irrelevant. The same is true of the claim that the Board of Appeal did not prove that consumers who bought, for example, cushions or blankets bought a mattress at the same time because the complementarity of goods is not dependent on those goods being subject to parallel demand. The fact that goods covered by the mark

applied for may be purchased more frequently than the ‘mattresses’ covered by the Portuguese mark does not alter the fact that the public may think that the same undertaking is responsible for manufacturing those goods, on account inter alia of the close connection between them.

- [52] In the second place, the applicant maintains that the definition of complementary goods must be interpreted restrictively in order to prevent the extension of the protection of a trade mark to goods for which the mark is neither registered nor used. According to the applicant, it is, inter alia, not justified to extend the protection of the Portuguese mark, which is registered for goods in Class 20, to goods in Classes 10 and 24.
- [53] That argument cannot be accepted. Article 8(1)(b) of Regulation No. 207/2009 provides that a trade mark must not be registered if a likelihood of confusion exists ‘because of its identity with, or similarity to, an earlier trade mark and the identity or similarity of the goods or services covered by the trade marks’. A likelihood of confusion does not therefore necessarily presuppose that the goods covered by the earlier mark and those covered by the mark applied for are identical, but may also exist where those goods are similar.
- [54] Furthermore, it must be pointed out that, as stated in Rule 2(4) of the Commission Regulation (EC) No. 2868/95 of 13 December 1994 implementing Regulation No. 40/94 (OJ 1995 L 303, p.1), the classification of goods and services under the Nice Agreement is intended to serve exclusively administrative purposes. Therefore, goods may not be regarded as being dissimilar on the sole ground that, as in the present case, they appear in different classes under that classification (Case T-8/03 *El Corte Inglés v. OHIM - Pucci (EMILIO PUCCI)* [2004] ECR II-4297, paragraph 40, and judgment of 7 February 2006 in Case T-202/03 *Alecansan v. OHIM - CompUSA (COMP USA)*, not published in the ECR, paragraph 38).

6. The Listed Goods are: cases; trunks and travelling bags; pouches; rucksacks; shopping bags; beach bags; briefcases; wallets; backpacks. The Hearing Officer considered that these were all either ‘*reasonably similar*’ or ‘*highly similar*’ to ‘*handbags*’ (which she regarded as ‘*similar*’ to ‘*shoes for women*’) within the scope of TVG’s earlier Community trade mark registration. Her assessment in that connection was as follows:

[42] Handbags come in all shapes and sizes and are used to carry a wide variety of things considered essential by its user. The term handbags includes not only bags for carrying in the hand (e.g. a clutch bag) but also bags which will be carried over one’s shoulder or held by a strap or handle of some sort (e.g. a tote or shoulder bag). All handbags are used to carry things within them and the larger the bag, the more diverse and numerous are the items that are likely to be carried in it. I consider *handbags* to be highly similar to *travelling bags, shopping bags and beach bags*. The nature, uses, users and trade channels all overlap. Whilst not strictly in competition with each other, the respective goods may also form part of a co-ordinated set and to that extent may be complementary goods.

[43] To the extent that *cases, trunks, satchels, pouches, rucksacks, briefcases, wallets, key cases, credit card cases, purses and back packs* are each goods for holding something safely whilst the user moves from one place to another, they have similar uses to those of *handbags*. They may also have the same users as handbags. Handbags come in a wide variety of styles. As the evidence shows, some are designed to resemble e.g. satchels, a briefcase or small cases (see page 26 of exhibit TGV5) or a purse (page 31) or backpack (page 15). Each of the respective goods may also form part of a co-ordinated set and handbags will sometimes have e.g. a key case or purse attached to it (page 29). There is a reasonable degree of similarity between these goods and *handbags*.

7. As between the marks in issue, the Hearing Officer considered the position with regard to ‘*similarity*’ to be as follows:

[52] For ease of reference, the marks to be compared are as follows:

Earlier mark	Application
BOO!	MissBoo

The earlier mark consists of the word BOO presented in plain block capitals followed by an exclamation mark. To the extent that the exclamation mark will be noticed, the two elements hang together as its use is indicative of the fact that the word BOO is an interjection used in syntactic isolation to express surprise. The distinctiveness of the mark lies in its whole. The mark applied for is presented as a single word, however, it naturally breaks down into two component words Miss and Boo, more especially so given that the initial letters of each component part are presented in upper case with the remaining letters being in lower case. The word Miss is commonly used to refer to a female and is not distinctive of goods and services for women. The word Boo is a distinctive element of the mark.

[53] From both the visual and aural perspectives, as both marks contain the word ‘Boo’ there is a certain degree of similarity between them. There are also differences given that the mark applied for begins with the word Miss which is absent from the earlier mark. Whilst the exclamation mark will not be articulated of itself, it may lead some to place a vocal stress on the word BOO which will not be given to the mark applied for. From both perspectives the respective marks are similar to a fairly high degree.

[54] As I set out above, the earlier mark will be seen as an interjection of surprise whereas the mark applied for might be seen as the name of a female called Boo in which case there would be no conceptual similarity between the respective marks. MissBoo could, however, also be seen as referring to Boo goods

designed or intended for women in which case there would be a high degree of conceptual similarity between them.

8. On weighing the similarities between the marks in issue and the Class 18 goods in issue (and allowing for ‘*a relatively high degree of inherent distinctiveness*’ in the earlier mark **BOO!**) she concluded that WFL’s application to register **MissBoo** for use in relation to the Listed Goods was objectionable under Section 5(2)(b). She addressed herself to that aspect of the objection under Section 5(2)(b) from the correct legal perspective. She did not, when making the required assessment, take immaterial factors into account or omit to take material factors into account. It was open to her on evaluating the factors she had indentified in the way that she did to come to the conclusion she did.

9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.

10. Point (i) maintains the distinction between registering a sign for use as a trade mark in relation to goods and registering it for use as a trade mark in relation to services.

The need to maintain that distinction was confirmed by the CJEU in Apple Inc C-421/13, EU : C : 2014 : 2070 at paragraphs [25] and [26] (with emphasis added):

[25] Finally, as regards the question, which is also critical for the resolution of the dispute in the main proceedings and which was debated at the hearing in response to a question inviting an oral response which was posed by the Court, namely whether services intended to induce the consumer to purchase the products of the applicant for registration can constitute ‘services’ within the meaning of Article 2 of Directive 2008/95 for which a sign, such as that at issue in the main proceedings, may be registered as a trade mark, Apple submits that such is the case and refers to the distinction that the Court has already made between the sale of goods, on the one hand, and services, falling within the concept of ‘service’, intended to induce that sale, on the other hand (*Praktiker Bau- und Heimwerkermärkte*, C-418/02, EU : C : 2005 : 425, paragraphs 34 and 35). By contrast, the Commission considers that the case-law cannot be transposed to a situation, such as that arising in the main proceedings, in which the sole objective of those services is to induce the consumer to purchase the products of the applicant for trade mark registration itself.

[26] In this regard, it must be held that, if none of the grounds for refusing registration set out in Directive 2008/95 preclude it, a sign depicting the layout of the flagship stores of a goods manufacturer may legitimately be registered not only for the goods themselves but also for services falling within one of the classes under the Nice Agreement concerning services, where those services do not form an integral part of the offer for sale of those goods. Certain services, such as those referred to in Apple’s application and clarified by Apple during the hearing, which consist of carrying out, in such stores, demonstrations by means of seminars of the products

that are displayed there, can themselves constitute remunerated services falling within the concept of ‘service’.

11. Point (ii) refers to the practice approved by the CJEU in Praktiker Bau-und Heimwerkermärkte AG C-418/02, EU : C : 2005 : 425 at paragraphs [49] to [52] and Netto Marken - Discount AG & Co. KG C-420/13, EU : C : 2014 : 2069 at paragraphs [41] to [53]. It was maintained in submissions to the Court in Praktiker Bau-und Heimwerkermärkte that services eligible for protection as retail services should be identified in a way which distinguishes them from services which, being closely connected with the sale of goods, could not give rise to registration of a trade mark: paragraph [41]. However, the Court decided that for the purposes of registration of a trade mark covering services provided in connection with retail trade, it should not be necessary to specify in detail the service(s) for which registration is sought and that it was sufficient to use general wording such as ‘bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods’: paragraph [49]. In order to meet the need for clarity and precision as to the sectors of trade in which the retail services are to be provided, they should be linked to the supply of specified types of goods: paragraph [50]. Netto Marken-Discount confirmed that retail services linked to the supply of specified types of services can be covered by registration in the same way as retail services linked to the supply of specified types of goods.

12. Point (iii) comes from paragraph [66] of the Judgment of the CJEU in O2 Holdings Ltd v. Hutchison 3G UK Ltd C-533/06, EU : C : 2008 : 339. How is the task of considering all the circumstances in which a trade mark might be used, if it were

registered for retail services described in general terms, to be conducted? Presumably by envisaging real and significant performance of the functions of selecting an assortment of goods offered for sale and offering a variety of retail services aimed at inducing consumers to purchase goods of the type specified in the application for registration from the retail service provider rather than from a competitor: Praktiker Bau-und Heimwerkermärkte at paragraph [34]; Netto Marken-Discount at paragraph [33]. On reading paragraphs [25] and [26] of Apple Inc together with paragraphs [38] and [39] of Netto Marken-Discount it appears to me to be neither necessary nor appropriate to make any assumptions as to the extent to which the assortment will or may include goods that either have or have not been produced by or for the retail service provider. From that I infer that it is neither necessary nor appropriate to make any assumptions as to the branding which might be applied to any of the goods from time to time included in the assortment.

13. Due weight can as necessary be given to the particular features of the concept of ‘retail services’ that are connected with its wide scope, as confirmed by the CJEU in Praktiker Bau-und Heimwerkermärkte (with emphasis added):

[48] There is nothing to indicate that any problems resulting from the registration of trade marks for retail services could not be resolved on the basis of the two relevant provisions of the Directive, as they have been interpreted by the court. In that regard, it should be recalled that, according to the court’s case law, the likelihood of confusion must be assessed globally, taking into account all the factors relevant to the circumstances of the case (see Case C-251/95 *SABEL* [1997] E.C.R. I-6191 at [22], and Case C-39/97 *Canon* [1998] E.C.R. I-5507 at [16]). In the context of that global assessment, it is possible to take

into consideration, if need be, the particular features of the concept of “retail services” that are connected with its wide scope, having due regard to the legitimate interests of all interested parties.

I understand this to mean that a trade mark application or registration for ‘retail services’ should be interpreted and applied with due regard for the principle of proportionality when resolving the relative rights of the parties to proceedings under Articles 8(1)(b) and 9(1)(b) CTMR (Sections 5(2) and 10(2) of the 1994 Act).

14. Point (iv) concerns the weight to be given to ‘*complementarity*’ - as defined in the case law of the General Court - when assessing whether services are ‘*similar*’ to goods. In Oakley Inc. v. OHIM T-116/06, EU : T : 2008 : 399 the marks in issue were for all practical purposes identical (**O STORE** and **THE O STORE**) and the contested registration covered retail services in Class 35 pertaining to goods of the kind for which the relevant earlier trade mark was registered in Classes 18 and 25. The Court decided that the retail services in Class 35 were ‘*similar*’ to the goods in Classes 18 and 25 upon the following basis (with emphasis added):

[52] Regarding, third, the complementary nature of the services and goods in question, found to exist by the Board of Appeal in paragraph 23 of the contested decision, it should be pointed out that, according to settled case-law, complementary goods are those which are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may think that the same undertaking is responsible for both (see, to that effect, *SISSI ROSSI*, paragraph 49 above, paragraph 60; *PAM PLUVIAL*, paragraph 49 above, paragraph 94; and *PiraÑAM diseño original Juan Bolaños*, paragraph 49 above, paragraph 48).

- [53] In that regard, it must be pointed out that the goods covered by the earlier mark, that is, clothing, headwear, footwear, rucksacks, all-purpose sports bags, travelling bags and wallets, are identical to those to which the applicant's services relate.
- [54] Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of Praktiker Bau-und Heimwerkermärkte, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that 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. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.
- [55] Furthermore, the relationship between the goods covered by the earlier trade mark and the services provided in connection with retail trade in respect of goods identical to those covered by the earlier trade mark is also characterised by the fact that those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.
- [56] It follows that, because the services provided in connection with retail trade, which concern, as in the present case, goods identical to those covered by the earlier mark, are closely connected to those goods, the relationship between those services and those goods is complementary within the meaning of paragraphs 54 and 55 above. Those services cannot therefore be regarded, as the applicant claims, as being auxiliary or ancillary to the goods in question.
- [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.

15. The General Court continues, on the basis of reasoning to that effect, to regard retail services and goods of the kind to which they pertain as '*similar*'. Eni SpA v. OHIM T-599/11, EU : T : 2014 : 269 at paragraphs [33] to [58] is a recent example of this. The Judgment is notable for its refusal to accept that the approach to '*similarity*' adopted in Oakley Inc could or should be subject to further refinement on taking account of OHIM's approach to '*similarity*' as explained in its President's Official Communications of 12 March 2001 (No.3/01) and 31 October 2005 (No.7/05) and in its published Guidelines for Opposition.

16. There is tension between the two approaches. OHIM has proposed: (i) that retail services in general (i.e. not linked to the sale of any particular goods) are not similar to any goods capable of being sold at retail; (ii) that retail services concerning the sale of particular goods are similar (to a low degree) to those particular goods; (iii) that retail services related to the sale of particular goods are not similar to other goods. By contrast, the approach adopted in Oakley Inc and in subsequent Judgments of the General Court may be thought to envisage a finding of '*similarity*' whenever and because it can be said (as per paragraph [54] of Oakley Inc.) that: 'the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which

are specifically provided when those goods are sold. ... Such services, which are provided with the aim of selling certain specific goods would make no sense without the goods’.

17. OHIM’s appeal to the CJEU in OHIM v. Sanco SA C-411/13P, EU : C : 2014 : 315 was evidently brought with a view to obtaining specific guidance as to the criteria which should be applied for the purpose of determining whether services are ‘*similar*’ to goods. In that case, the proprietor of a figurative mark registered for use in relation to ‘*meat, poultry and game; meat extracts*’ in Class 29 and ‘*live animals*’ in Class 30 opposed a later application to register a somewhat similar figurative mark for use in relation to ‘*chickens*’ in Class 29, ‘*advertising, commercial agencies, franchising, export and import; wholesaling and retailing of all kinds of foodstuffs and selling via global computer networks of foodstuffs of all kinds*’ in Class 35 and ‘*transport, storage and distribution of chickens*’ in Class 39. The Opposition Division at OHIM allowed the opposed application to proceed to registration for ‘*advertising, commercial agencies, franchising, export and import*’ in Class 35 and ‘*transport, storage and distribution of chickens*’ in Class 39 and its decision to that effect was subsequently upheld by the Second Board of Appeal at OHIM: Case R 1075/2010-2 (17 February 2011). The Board of Appeal determined that the services in question were not similar to goods of the kind for which the earlier trade mark was registered in Classes 29 and 30. On that basis it held that the opposed application for registration was not objectionable under Article 8(1)(b) CTMR (equivalent to Section 5(2)(b) of the 1994 Act), without it being necessary to compare the signs in issue.

18. The General Court found that the Board of Appeal had erred in its approach to the assessment of ‘*similarity*’ and concluded that the decision under appeal should be annulled without proceeding to determine whether the opposition should or should not have succeeded in relation to the services in question: Sanco SA v. OHIM T-249/11, EU : T : 2013 : 238. The reasoning of the Board of Appeal was found to be flawed on the following basis (with emphasis added):

- [31] In this respect the Court notes, first, that the Board of Appeal was correct to find that meat, poultry, game, meat extracts and live animals differed from advertising, commercial agencies, franchising and export and import by their nature, their intended purpose and their method of use. The abovementioned goods and services are neither interchangeable nor competing, which is indeed not disputed by the applicant.
- [32] As regards the distribution channels, the Board of Appeal found, without it being challenged by the applicant, that they were different on the ground that it was unlikely, even impossible, that a farm or a poultry plant would be used to provide the services of advertising, commercial agencies, franchising or export and import to undertakings. In the light of those goods and services, the Board of Appeal could find without erring that the distribution channels of those goods and services were distinct.
- [33] However, as set out in paragraph 21 above, in assessing the similarity of the goods and services, it is also necessary to take into account whether those goods and services are complementary.
- [34] In this respect, the Board of Appeal found that the goods of the earlier mark and the services of advertising, commercial agencies, franchising and export and import were not even complementary because the nature, method of use and distribution channels of the goods such as chickens and live animals had no connection with those services, which

the consumer would perceive easily (see paragraph 23 of the contested decision).

- [35] Accordingly, the Board of Appeal found that, from the point of view of the relevant public, the goods and services concerned were not complementary, on the ground that there was no connection between their nature, their method of use and their distribution channels.
- [36] However, as set out at paragraph 22 above, the complementarity between the goods and services in the context of a likelihood of confusion does not rely on the existence of a connection between the goods and services at issue in the mind of the relevant public from the point of view of their nature their method of use and their distribution channels but on the close connection between those goods and services, in the sense that one is indispensable or important for the use of the other in such a way that the public might think that the responsibility for the production of those goods or provision of those services lies with the same undertaking.
- [37] It follows that the Board of Appeal could not reject the existence of a complementarity between the goods and services concerned on the sole ground that there was no connection between their nature, their method of use and their distribution channels. By proceeding in that way, it again took into account the nature, method of use and distribution channels of the goods and services at issue without deciding on the importance of one for the use of the other from the point of view of the relevant public.
- [38] As regards, in particular, the connection between the method of use of those goods and the method of use of those services raised by the Board of Appeal, it must be noted that that criterion does not enable full appreciation of the indispensability or importance of those goods and services for each other which requires analysis of the complementarity between those goods and services. The fact that the method of use of a product or service is unrelated to the method of use of another product or service does not imply in each case that the use of one is not important or indispensable for the use of the other.

[39] Accordingly, it should be stated that the Board of Appeal did not correctly examine, inter alia, whether, from the point of view of a professional purchaser of chickens or of meat, the services of advertising, commercial agencies, franchising or export and import were important during the purchase of chickens or meat to the extent that he would think that the responsibility for the production of those goods or provision of those services lies with the same undertaking.

...

[42] That error resulted in the Board of Appeal not taking into account all factors relevant to the assessment of the similarity of the goods and services in question. In the absence of an analysis taking into account all factors relevant to the assessment of the existence of a similarity between the goods and services at issue, the contested decision must be annulled in that regard.

...

[61] However, the Board of Appeal could not automatically exclude the existence of a complementarity between the goods of the earlier mark and the services of transport, storage and distribution of chickens. Such complementarity must be found between at least chickens and the transport, storage and distribution of chickens.

[62] In assessing the similarity of the goods and services at issue, the Board of Appeal had to take into account all the relevant factors relating to the relationship between the goods and services at issue. Thus, notwithstanding the difference between, on the one hand, chicken meat and live chickens and, on the other, the transport, storage and distribution of chickens as regards their nature, their intended purpose, their method of use and whether they are in competition with each other, the Board of Appeal should have deemed them to have some degree of complementarity. It is apparent from the taking into account of all relevant factors in assessing the similarity of those goods and services that the Board

of Appeal erred in considering that those goods and services were in no way similar.

[63] It is therefore necessary to annul the contested decision in so far as it holds that the goods of the earlier mark are not in any way similar to the services of transport, storage and distribution of chickens of the mark applied for.

19. The Judgment of the General Court stands for three inter-related propositions. First, as part of the overall assessment of ‘*similarity*’ it is necessary to consider whether there is ‘*complementarity*’ between the goods and services in issue. Second, there is ‘*complementarity*’ when the goods and services in issue are closely connected 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 same undertaking is responsible for manufacturing those goods or providing those services. Third, ‘*complementarity*’ as thus defined is not adequately addressed by adopting a checklist approach to the factors conventionally taken to have a particular bearing on the question of ‘*similarity*’ between goods and services: see paragraph [4] above.

20. The reasoning of the General Court in that connection was challenged in OHIM’s pleas in law and main arguments on appeal to the CJEU:

1. ...

2. The General Court infringed Article 8(1)(b) CTMR since it examined the complementarity of goods and services by reference to the importance of a product or a service ‘for the purchase’ of another product or service from the point of view of the relevant public. The General Court failed to consider whether the complementarity of the goods and services is based on an interaction which is such that their

use in conjunction with one another is, in strictly objective terms, necessary or desirable.

3. The General Court infringed Article 8(1)(b) CTMR in concluding that certain complementary goods and services are automatically similar, despite the low degree of similarity in question, without ascertaining whether the differences arising from other factors were such as to neutralise that complementarity.

These contentions called for clarification of the nature and content of the requirement for ‘*similarity*’ and the meaning and effect to be given to the concept of ‘*complementarity*’ in the implementation of that requirement. The guidance provided by the CJEU was emphatic, to the effect that the appeal should be dismissed by way of a reasoned order for being in part manifestly inadmissible and for being manifestly unfounded as to the remainder.

21. The second of OHIM’s pleas in law and main arguments was rejected as manifestly unfounded in paragraphs [60] to [67] of the reasoned order, where the CJEU determined that in paragraphs [36] to [40] of the Judgment under appeal the General Court had applied settled case law correctly for the purpose of remedying a significant error in the approach to assessment adopted by the Board of Appeal. The third of OHIM’s pleas in law and main arguments was rejected as manifestly unfounded in paragraphs [68] to [78] of the reasoned order, where the CJEU refuted the suggestion that the Judgment of the General Court provided for a finding of ‘*similarity*’ to be based solely upon the existence of ‘*complementarity*’. In paragraphs [44] and [45] of the reasoned order it was affirmed that the General Court’s approach to the assessment of ‘*similarity*’ involved

consideration of a variety of factors and did not proceed upon the premise that a product and a service given over to that product should automatically be regarded as '*similar*'.

22. It is clear from paragraphs [43], [52] and [53], in the context of paragraphs [21] and [22] of the reasoned order, that the General Court was right to require the existence of even a small ('*meme faible*') degree of '*complementarity*' to be taken into account as part of the overall assessment of '*similarity*' between goods and services. However, I do not think that detracts from the previously accepted position that a finding of '*no similarity*' may legitimately be made despite the existence of '*a degree of complementarity*' if '*that complementarity is not sufficiently pronounced for it to be accepted that, from the consumer's point of view, the goods are similar within the terms of Article 8(1)(b) of Regulation No.40/94*' as stated in Assembled Investments (Proprietary) Ltd v. OHIM T-105/05, EU : T : 2007 : 170 at paragraphs [30] to [35], upheld on appeal in Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd C-398/07P, EU : C : 2009 : 88 at paragraphs [34], [35]. Taken together, the Judgment of the General Court and the reasoned order of the CJEU in Sanco SA appear to me to confirm that it is obligatory to give effect to the propositions noted in paragraph [19] above and to do so on the basis that there is no rule that '*complementarity*' always or necessarily equals '*similarity*' for the purposes of Article 8(1)(b) CTMR/Section 5(2)(b) of the 1994 Act.

23. I now turn to consider the Hearing Officer's approach to the present opposition to registration in Class 35. The opposition depended for its success upon a finding to the effect that the distinctiveness of the trade mark **BOO!** for '*handbags*' in Class 18 and '*shoes for women*' in Class 25 would be exploited by use of the mark **MissBoo** for the

purpose of distinguishing WFL's retail services from those of other retailers with an attendant likelihood of confusion across the whole spectrum of retail services covered by the Listed Services. However, on reading paragraphs [47] to [49], [59] and [61] of the Hearing Officer's decision it appears to me that, in lieu of making any finding to that effect, she assessed the likelihood of confusion by reference to the goods to which the Listed Services were linked (in accordance with the ruling of the CJEU in Praktiker Bau- und Heimwerkermärkte) and dealt with the objection under Section 5(2)(b) as if the application for registration in Class 35 was an application to register **MissBoo** for use as a trade mark in relation to such goods. She was prompted to assimilate the retail services in issue with the goods to which they were linked by the observations of the General Court in paragraph [54] of its Judgment in Oakley Inc.: 'The GC upheld OHIM's decision that the goods in classes 18 and 25 were similar to the services as there was a complementary relationship between the retailing of the goods and the goods themselves' (paragraph [48]). In the result, she omitted to resolve the objection directly by reference to the Listed Services in Class 35 for which service mark protection had actually been requested.

24. TVG maintains that even though the Hearing Officer's reasoning with regard to the application for registration in Class 35 may appear to have been over-abbreviated, her decision ought to be upheld on the basis that she could not have come to the conclusion she did in relation to that application without actually determining that all of the Listed Services were, in themselves, '*similar*' to '*handbags*' and '*shoes for women*' in accordance with the law as laid down in the Judgment of the General Court in Oakley Inc. As against that, WFL maintains that the Hearing Officer wrongly conflated '*complementarity*' with '*similarity*' on the basis of paragraph [54] of Oakley Inc and in

doing so failed to apply the correct test for determining whether the goods and services in issue were ‘*similar*’ so as to give rise to the existence of a likelihood of confusion. I accept WFL’s submissions to that effect. WFL further maintains that the outcome of Oakley Inc shows that the reasoning of the General Court with regard to ‘*complementarity*’ and ‘*similarity*’ was confined to situations where the marks in issue are (virtually) identical and the retail services in issue are linked to goods which are in their own turn (virtually) identical to those for which the earlier trade mark is protected by registration. I do not accept WFL’s submissions to that effect. The rival positions of the parties as developed in argument at the hearing before me showed that the issue on which they were divided was the test for ‘*complementarity*’ and its impact upon the assessment of ‘*similarity*’ as between goods and retail services.

25. For the reasons I have given in paragraphs [9] to [22] above, I consider that the application for registration in Class 35 had to be disentangled from the application for registration in Class 18. The former needed to be treated as non-prescriptive with regard to the branding of any goods and the latter as non-prescriptive with regard to the branding of any services. And it had to be recognised that even if ‘*handbags*’ in Class 18 were sufficiently ‘*similar*’ to the Listed Goods in Class 18 to support an objection to registration under Section 5(2)(b), it would not necessarily follow that ‘*handbags*’ in Class 18 and ‘*shoes for women*’ in Class 25 were sufficiently ‘*similar*’ to all or most or any of the Listed Services in Class 35 to support an objection to registration under that Section. In that regard, the assessment of ‘*similarity*’ had to proceed substantively upon the premise that the Listed Services in Class 35 could not simply be characterised as dealing in goods of the kind to which they were linked. On the contrary, they had to be

seen as involving real and significant performance of the functions of selecting an assortment of goods offered for sale and offering a variety of retail services aimed at inducing consumers to purchase goods of the kind specified. And then, from that perspective, it was necessary to give effect to the propositions noted in paragraph [19] above and to do so on the basis that there is no rule that '*complementarity*' always or necessarily equals '*similarity*' for the purposes of Section 5(2)(b). In evaluating whether and, if so, to what degree retail services across the spectrum covered by the Listed Services were '*similar*' to '*handbags*' in Class 18 and '*shoes for women*' in Class 25, it was necessary, in keeping with the principle of proportionality, to consider the greater or lesser likelihood that a single economic undertaking would naturally be regarded as responsible for providing not only goods of that kind, but also retail services of the kind in question. The degree to which retail services within the spectrum were found on evaluation to be '*similar*' to such goods would be a co-variable with the degree of '*similarity*' between the signs in the overall assessment of the existence or otherwise of a likelihood of confusion.

26. The opposition to the application in Class 35 has yet to be determined in accordance with those considerations. It is not open to this tribunal to remove one of the two levels of decision taking built into Section 76 of the 1994 Act by resolving objections to registration de novo on appeal. That is what would happen if I proceeded to determine the opposition to the application in Class 35 without any sufficient underpinnings in the decision under appeal to enable me to do so. The application and the opposition to it should, in my view, be the subject of a fresh determination by the Registrar.

Conclusion

27. For the reasons I have given:

[1] WFL's Appeal against the Hearing Officer's refusal of its application for registration in Class 18 is dismissed.

[2] WFL's Appeal against the Hearing Officer's refusal of its application for registration in Class 35 is allowed and her decision with regard to that part of Trade Mark Application No. 2526406 is set aside.

[3] Opposition No. 100472 to Trade Mark Application No. 2526406 in Class 35 is remitted to the Registrar for determination by a different hearing officer.

[4] The Hearing Officer's decision as to the costs of the opposition proceedings in the Registry is set aside.

[5] The costs of the appeal under Section 76 of the Trade Marks Act 1994 are to be treated as costs incurred in the opposition proceedings and the question of how and by whom they are to be paid is reserved for determination by the Registrar as part of his decision on costs at the conclusion of the proceedings in the Registry.

That is my decision on this appeal.

Geoffrey Hobbs QC

2 September 2014

Carl Steele of Ashfords LLP appeared on behalf of WFL.

Philip Stephenson of Bailey Walsh & Co. LLP appeared on behalf of TVG.

The Registrar did not take part in the Appeal.

ANNEX A

Opponent's goods		Applicant's goods and services
Handbags	To be identical to	<u>Handbags, bags</u>
Handbags	To be highly similar to	Travelling bags, shopping bags, beach bags
Handbags	To be reasonably similar to	Cases, trunks, <u>satchels</u> , pouches, rucksacks, briefcases, wallets, <u>key cases, credit card cases, purses</u> and back packs
Handbags	To be of low similarity to	<u>Belts</u>
Shoes for women	To be similar to	<u>Handbags</u>
Handbags and women's shoes	To be similar to	Retail shop services relating to items of clothing; the bringing together, for the benefit of others, a variety of goods, namely <u>bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs</u> ; articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, <u>footwear</u> , headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling customers to conveniently view and purchase those goods by mail order or by means of telecommunications; the bringing together, for the benefit of others a variety of goods, namely <u>bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters, enabling</u>

	<p>customers to conveniently view and purchase those goods; retail services connected with <u>bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters; mail order retail services connected with <u>bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters; electronic shopping retail services connected with <u>bags, belts, cases, trunks and travelling bags, satchels, pouches, rucksacks, shopping bags, beach bags, handbags, briefcases, wallets, key cases, credit card cases, purses, back packs, articles of clothing, lingerie, bras, pants, thongs, stockings, tights, suspender belts, camisoles, dressing gowns, negligees, corsets, night dresses, sleep shirts, sarongs, shoulder wraps, shorts, leggings, footwear, headgear, belts, trousers, shorts, jeans, wristbands, headbands, hats, gloves, jackets, coats, jumpers, shirts, t-shirts, sweaters, vests, trousers, skirts, waistcoats, waterproof clothing, bathing costumes, pyjamas, undergarments, scarves, socks, suits, dresses, blouses, sun visors, anoraks, articles of clothing for leisurewear, articles of clothing for casualwear, articles of clothing for sportswear, articles of outer clothing, articles of weatherproof clothing, blazers, denims, jerseys, knitwear, parkas, sweatshirts, tops, and windcheaters.</u></u></u></p>
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