

**O-230-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3052887  
IN THE NAME OF MAGNUM PACKAGING (NE) LTD  
IN RESPECT OF THE TRADE MARK:**



**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO 500652 BY ASTROCROFT LTD**

## Background and pleadings

1. Trade mark no. 3052887 shown on the cover page of this decision, stands registered in the name of Magnum Packaging (NE) Ltd (“the proprietor”). It was applied for on 25 April 2014 and completed its registration procedure on 8 August 2014. It is registered for the following goods:

**Class 8** - Disposable tableware [cutlery] made of plastics.

**Class 16** - Bags (garbage -) of paper or of plastics; bags made of plastics for packaging; bags of plastics for lining refuse bins; carrier bags; dustbin bags; dustbin liner bags of plastic; film (plastic cling -) extensible, for palletization; greaseproof paper; paper bags; plastic bin liners; plastic cling film, extensible, for palletization; carrier bags; films for wrapping foodstuffs; paper; paper bags; paper bags for packaging; paper for wrapping and packaging; plastic bags for packaging; wrapping paper; carrier bags; films for wrapping foodstuffs; paper; paper bags; paper bags for packaging; paper for wrapping and packaging; plastic bags for packaging; wrapping paper.

**Class 21** - Containers for household or kitchen use; cups; cups of paper or plastic; drinking cups; foil food containers; gloves for household purposes; household or kitchen utensils and containers; foil food containers.

2. On 16 October 2014, Astrocroft Ltd (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The relevant provisions read as follows:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) 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,

(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.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

2E) 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.

.....

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

And:

“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,

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

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.”

3. The applicant directs its application against all of the goods in the proprietor’s trade mark. It relies upon the goods (shown below) in registration no. 2572304 for the trade mark:



which was applied for on 15 February 2011 and for which the registration process was completed on 11 November 2011:

**Class 8** - Hand tools and implements (hand-operated); cutlery; side arms; razors.

**Class 16** - Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

**Class 21** - Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; un-worked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

The trade mark shown above qualifies as an earlier trade mark under the above provisions. As the applicant’s earlier trade mark had not been registered for more than five years when the application for invalidation was filed, it is not subject to proof of use, as per section 47(2)(2A) of the Act. As a consequence, the applicant is entitled to rely upon all of the goods it claims.

4. The applicant states:

“2. The challenged mark comprises just the words MY CHOICE! in plain letters on a simple oval background. The background is so simple and generic that it has no distinctive character and the mark must be considered as the words “MY CHOICE” followed by conventional punctuation in the form of an exclamation mark (!).

4. The goods covered by the challenged registration are clearly identical to those of the prior mark.

5. Both the prior mark and the challenged mark predominantly comprise the words MY CHOICE and as a result they are highly similar to each other from visual and phonetic standpoints. They are conceptually identical. The slightly different stylisation and other elements are of low relevance and would not be sufficient to render the marks different or prevent confusion in use. For example the small “.co.uk” is a top level domain name and it is accepted that these have no distinctive character and are disregarded by users...”

5. The proprietor filed a counterstatement in which the basis of the invalidation is denied. As these are the only comments I have from the proprietor, they are reproduced below in full. The proprietor states:

“3. The proprietor contests the [applicant’s] assertion that the challenged mark comprises just the words MY CHOICE! on a simple generic background. The challenged mark consists of a logo of which the phrase “MY CHOICE” is one part, the other parts being the uppercase font of the characters, the exclamation mark, and the white coloured type against a black, oval-shaped background. In particular, the white uppercase text against the black background is a dominant feature of the mark.

4. The earlier mark consists of a logo of which the phrase “mychoice.co.uk ” is one part, the other parts being the lowercase font of the characters, the way in which the “m” and the “y” of “my” are linked together, and the purple and black colouring of the type against a white background. In particular, the purple colouring of the “my” and the check mark are dominant features of the mark.

8...The dominant and distinctive components of the earlier mark include the lowercase script, the lack of a space between the words “my” and “choice”, the fact that the “m” and “y” are joined together and are coloured purple, next to the word “choice” in black type. The dominant and distinctive components of the challenged mark include the bold white text, against a solid black background, the oval shaped background and the upper case font.

9. The two marks in question share the words “MY CHOICE”. These words have a low degree of distinctiveness when applied to the goods in classes 8, 18 (sic) and 21 since the consumer of those goods has a choice as to which goods they will purchase. When marks share an element with a low degree of distinctiveness, the assessment of likelihood of confusion focuses on the impact of the non-coinciding components on the overall impression of the

marks, taking into account the similarities/differences and distinctiveness of the non-coinciding components.

11. Seven other registrations including the words “MY CHOICE” coexist on the register in classes 8, 16 and 21. In *Harrods Application* (1935) 52 RPC 65 it was stated that, “It is a well recognised principle that has to be taken into account in considering the possibility of confusion arising between any two trade marks, that, when those two marks contain a common element which is also contained in a number of other marks in the same market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by other features.”

12. The non-coinciding components of the two marks comprise mainly the figurative aspects of the marks such as the font, the font case, the colours used and the arrangement of the letters. The assessment of likelihood of confusion therefore focuses on the visual impact of the two marks. Visually, the two marks are not at all similar and give a very different overall impression.”

6. Neither party filed evidence. Whilst neither party asked to be heard, the applicant filed written submissions in lieu of attendance at a hearing.

### **Section 5(2)(b) – case law**

7. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles:**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) 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;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **The average consumer and the nature of the purchasing process**

8. 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. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

9. With the exception of “film (plastic cling -) extensible, for palletization” and “plastic cling film, extensible, for palletization” (which are identical) in the proprietor's specification in class 16, the average consumer for which is likely to be an

undertaking using such goods as part of, for example, a transport business, the average consumer for all of the remaining goods is a member of the general public. My own experience tells me that while aural considerations cannot be ignored, as such goods are, in the main, the subject of self selection from the shelves of a retail establishment on the high street or from the pages of a catalogue or website, visual considerations are likely to dominate the selection process. As the goods at issue are disparate, compare, for example, cutlery (the cost of which can vary considerably) and bin bags (which will always be inexpensive), the degree of care a member of the general public will display when selecting such goods will also vary considerably, ranging from very low (e.g. bin bags) to above the norm (e.g. expensive cutlery).

10. Turning now to those goods I have identified above as being more likely to be selected by a commercial undertaking, in the absence of evidence or submissions to assist me, I intend to proceed on the basis that the average consumer is likely to obtain such goods from commercial suppliers and wholesalers, having also inspected, for example, publications and websites but which are more likely than not to be directed at those in the trade. As recommendations from one business to another are also possible, aural considerations must also be kept in mind, although they are, in my view, likely to be a less important aspect of the process. Given the importance of ensuring the goods selected will perform to the commercial tolerances likely to be required and the more significant costs that are likely to be involved, I would expect a business user selecting the goods I have identified to pay a fairly high degree of attention during the selection process.

### Comparison of goods

11. The competing goods are as follows:

<b>Applicant's goods</b>	<b>Proprietor's goods</b>
<p><b>Class 8</b> - Hand tools and implements (hand-operated); cutlery; side arms; razors.</p> <p><b>Class 16</b> - Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.</p> <p><b>Class 21</b> - Household or kitchen utensils and containers (not of precious metal or</p>	<p><b>Class 8</b> - Disposable tableware [cutlery] made of plastics.</p> <p><b>Class 16</b> - Bags (garbage -) of paper or of plastics; bags made of plastics for packaging; bags of plastics for lining refuse bins; carrier bags; dustbin bags; dustbin liner bags of plastic; film (plastic cling -) extensible, for palletization; greaseproof paper; paper bags; plastic bin liners; plastic cling film, extensible, for palletization; carrier bags; films for wrapping foodstuffs; paper; paper bags; paper bags for packaging; paper for wrapping and packaging; plastic bags for packaging; wrapping paper; carrier bags; films for wrapping foodstuffs; paper; paper bags; paper bags for packaging; paper for wrapping and packaging;</p>



<p>coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; un-worked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.</p>	<p>plastic bags for packaging; wrapping paper.</p> <p><b>Class 21</b> -Containers for household or kitchen use; cups; cups of paper or plastic; drinking cups; foil food containers; gloves for household purposes; household or kitchen utensils and containers; foil food containers.</p>
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12. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] 11R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

14. 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”) stated that “complementary” means:

“...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”.

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

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

“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).”

16. In approaching this comparison, I note that whilst the proprietor has provided submissions on the similarity of the competing trade marks and the distinctiveness of the applicant’s earlier trade mark, it has remained silent on the similarity (or otherwise) of the competing goods. As the proprietor has not denied the applicant’s claim that the competing goods are identical, it would, in my view, be permissible for me to proceed on the basis that is the case. For the sake of completeness however, and as the applicant has specifically addressed this issue in its written submissions, I will conduct a comparison on a class-by-class basis. As the applicant points out, a number of the terms in the proprietor’s specifications in classes 16 and 21 appear on a number of occasions. For the avoidance of doubt however, I will refer to the specifications in these classes in the form in which they stand registered.

## **Class 8**

17. The proprietor's *Disposable tableware [cutlery] made of plastics* are included within the term *cutlery* in the applicant's specification in this class and are identical on the principles outlined in *Meric*.

## **Class 16**

18. The proprietor's *Bags (garbage -) of paper; greaseproof paper; paper bags; paper; paper bags; paper bags for packaging; paper for wrapping and packaging; wrapping paper; paper; paper bags; paper bags for packaging; paper for wrapping and packaging; wrapping paper*

and:

*Bags made of plastics for packaging; film (plastic cling -) extensible, for palletization; plastic cling film, extensible, for palletization; films for wrapping foodstuffs; plastic bags for packaging, films for wrapping foodstuffs, plastic bags for packaging,*

are identical to *paper, cardboard and goods made from these materials, not included in other classes* and *plastic materials for packaging (not included in other classes)* respectively in the applicant's specification in this class on the *Meric* principle.

19. The proprietor's goods in this class which remain are i.e. *Bags (garbage -) of plastics; bags of plastics for lining refuse bins; carrier bags; dustbin bags; dustbin liner bags of plastic; plastic bin liners; carrier bags; carrier bags*. The applicant argues that these goods are similar to *plastic materials for packaging* in its specification in this class. However, as *carrier bags* and *dustbin bags* in the proprietor's specification may be made of paper, they too are identical on the *Meric* principle to *Paper...and goods made from these materials...* in the applicant's specification. Although the remaining goods i.e. bags or liners of plastic for garbage or for lining bins are not identical to goods that would be included in the phrase "*Paper...and goods made from these materials...*", in the applicant's specification, they are, given the similarity in their respective users, intended purpose, method of use, trade channels and the degree of competition that exists between them, similar, in my view, to the applicant's goods identified to the highest degree.

## **Class 21**

20. The proprietor's *Containers for household or kitchen use; cups; cups of paper or plastic; drinking cups; foil food containers; household or kitchen utensils and containers; foil food containers* are either literally identical to *Household or kitchen utensils and containers (not of precious metal or coated therewith)* in the applicant's specification, or if not literally identical, are identical on the *Meric* principle. That leaves *gloves for household purposes* in the proprietor's specification to consider. In its submissions, the applicant states:

"8... For example, [the above named goods] would be sold through the same channels of trade as the goods *Household or kitchen utensils and containers...*"

21. The term *gloves for household purposes* would include, for example, rubber gloves, gloves for polishing and dusting and oven gloves. In relation to those goods upon which the applicant relies (shown above), while the users of the competing goods may be the same, that degree of generality tells one little. The nature of the competing goods is different, as is their intended purpose and method of use. Whilst the goods are not in competition with one another or complementary in any meaningful way, I accept that the trade channels may be the same and that some of the goods that fall within the general phrase *gloves for household purposes* may be retailed in similar parts of, for example, a supermarket. In this regard, the applicant's best prospect of success lies, in my view, with goods such as oven gloves which, in my experience, it is not unusual to find sold in close proximity to the applicant's *household or kitchen utensils and containers...* The applicant's specification also includes *articles for cleaning purposes*. Although the nature, intended purpose and method of use of these goods differs to the proprietor's *gloves for household purposes* and whilst these goods are neither in competition with or complementary to one another, once again, in my experience, it is not unusual to find such goods sold in the same area of a supermarket. In view of the above conclusions, there is, in relation to the competing goods I have identified, in my view, a degree of similarity (albeit low) resulting from the shared trade channels at, (at least), the retail level.

22. In summary, all of the proprietor's goods are either identical, or if not identical, are similar to the applicant's goods, albeit to varying degrees.

### **Comparison of trade marks**

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

24. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks. The competing trade marks are as follows:

Applicant's trade mark	Proprietor's trade mark
	

25. In reaching the conclusions which follow, I will keep in mind, but do not intend to record here, all of the applicant's written submissions. The proprietor's trade mark consists of the words MY CHOICE presented in white in upper case followed by an exclamation mark also in white. These words and punctuation mark are presented against a black oval background. In my view, the overall impression of the proprietor's trade mark is dominated by the words MY CHOICE. While the proprietor argues that these words "have a low distinctive character" (a point the applicant accepts in its written submissions), the fact remains that both parties agree that the words MY CHOICE have some distinctive character (a point with which I agree and to which I will return later in this decision). While the punctuation mark will not go unnoticed, appearing as it does after the words MY CHOICE (and as it is commonplace for undertakings to use such a punctuation mark as a form of emphasis), it is neither a distinctive nor dominant element of the proprietor's trade mark and has a much lower relative weight in the overall impression the trade mark creates. Finally, the oval background is entirely banal and will have little relative weight in the overall impression the proprietor's trade mark conveys.

26. The applicant's trade mark consists of the words "my" (presented in purple) and "choice" (presented in black); both are in lower case and the letters "m" & "y" of the word "my" are elided. To the right of these words is a device of a tick (presented in the same colour purple as the word "my") and below the letter "i-c-e-" of the word "choice" there appears the top level domain name .co.uk presented in black. Like the proprietor's trade mark, the overall impression created by the applicant's trade mark will be dominated by the words mychoice. While the device of a tick and the domain name will not go unnoticed, as they are self evidently descriptive/non-distinctive, their relative weight in the overall impression created will be low.

27. Applying those conclusions to the comparison at hand, there is, despite their differing presentations, still a fairly high degree of visual similarity between the competing trade marks. As the exclamation mark (in the proprietor's trade mark) and the device of a tick (in the applicant's trade mark) are unlikely to be verbalised when the trade marks are referred to orally, the competing trade marks are arguably aurally identical. However, even if in line with the current trend the applicant's trade mark is articulated in full i.e. as the five syllable phrase my-choice [dot] co [dot] uk, there remains, in my view, a fairly high degree of aural similarity between them. Finally, in the absence of any other elements which alter the conceptual impression they convey, the prominence in the competing trade marks of the words MY CHOICE/mychoice leads to conceptual identity.

### **Distinctive character of the applicant's earlier trade mark**

28. I must now assess the distinctive character of the applicant's trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, 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. As the applicant has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. As I mentioned above, in its submissions, the applicant states:

“3...The words MY CHOICE themselves are, when taken alone, also of low distinctive character...”

29. As I explained earlier, I agree with the parties that the words MY CHOICE have a low distinctive character. While the presentation of the applicant's trade mark does not change the overall impression it creates, the elided nature of the presentation of the letters “m” and “y” in the word “my” does, in my view, elevate the trade mark's inherent distinctive character, although not to the extent that it materially improves the applicant's position.

### **Likelihood of confusion**

30. In determining whether there is a likelihood of confusion, a number of factors need to be borne 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. As I mentioned above, it is also necessary for me to factor in the distinctive character of the applicant's trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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. Earlier in this decision I concluded that:

- the competing goods are either identical or similar to varying degrees;
- The average consumer is, in the main, a member of the general public who will select the goods by predominately visual means and who will, depending on the goods at issue, display a varying degree of attention (ranging from low to above the norm) when doing so;
- In relation to those goods for which the average consumer is more likely to be a business user many of the same considerations apply, although such a consumer is likely to pay a fairly high degree of attention when selecting the goods at issue;
- The overall impression of both trade marks will be dominated by the words MY CHOICE/mychoice;

- The competing trade marks are visually and aurally similar to a fairly high degree (if not aurally identical) and conceptually identical;
- The applicant's trade mark is possessed of only a low degree of inherent distinctive character.

31. Insofar as the low inherent distinctive character of the applicant's trade mark is concerned, in *Formula One Licensing BV v OHIM*, Case C-196/11P, the CJEU held that:

"41. ....it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii)."

32. In addition, the fact that the applicant's trade mark has only a weak inherent distinctive character does not preclude a likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation

in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

33. I have found all of the competing goods to be either identical or similar to varying degrees. Proceeding on the basis that, contrary to my primary conclusion, the average consumer will pay a high level of attention to the selection of all the goods at issue, the various visual/descriptive/non-distinctive differences between the competing trade marks are, in my view, insufficient to offset the fact that, despite their weak inherent distinctive character, the overall impression of both trade marks will be dominated by the words MY CHOICE/mychoice. Even in relation to those goods which are only similar to a low degree i.e. *gloves for household purposes*, this will, in my view, result in a likelihood of direct confusion i.e. where one trade mark is mistaken for the other. However, even if that conclusion is considered to be in error, and the various differences are considered to be sufficient to avoid direct confusion, there remains, in my view, the likelihood of indirect confusion i.e. the average consumer will assume that the goods come from undertakings which are economically linked.

34. In reaching the above conclusions I have not overlooked the fact that that the applicant’s trade mark is presented in a range of colours. In *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96] Kitchin LJ stated:

“A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours.”

35. As it would be legitimate for the proprietor to present its trade mark in a range of colours (including one or more of the colours in the applicant’s trade mark), the fact that its trade mark is presented in black and white is not a point which assists it.

36. Finally, insofar as the proprietor points to (without providing evidence of) what it states is “seven other registrations including the words MY CHOICE” co-existing on the register in class 8, 16 and 21, the comments of Jacob J (as he then was) in *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 are relevant. He stated:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

## **Conclusion**

37. The application has been successful and, subject to any successful appeal, the registration will, under the provisions of section 47(6) of the Act, be deemed never to have been made.



## **Costs**

38. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement:	£200
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Written submissions:	£200
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Application fee	£200
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<b>Total:</b>	<b>£600</b>
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39. I order Magnum Packaging (NE) Ltd to pay to Astrocroft Ltd the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 21<sup>st</sup> day of May 2015**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**