

O-461-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3068797
BY KAIROS WATCHES LIMITED
TO REGISTER THE SERIS OF TWO TRADE MARKS
T-band / T band
IN CLASS 14
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 403399 BY
TISSOT S.A.**




BACKGROUND

1) On 15 August 2014, Kairos Watches Ltd (hereinafter the applicant) applied to register the series of two trade marks T-band / T band in respect of the following goods in class 14 "Watches; horological and chronometric instruments; watch bands; straps for wrist watches; watch straps; jewellery".

2) The application was examined and accepted, and subsequently published for opposition purposes on 12 September 2014 in Trade Marks Journal No.2014/038.

3) On 12 December 2014 Tissot S.A. (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Mark	Number	Date of application / registration	Class	Specification relied upon
	1409174	02.01.90 13.03.92	14	Watches and parts and fittings therefor; all included in Class 14.
	M 1101192	Date Protection Granted in EU: 06.11.12 Priority date: 19.09.11 Switzerland	35	Retail sale of timepieces and jewelry; retail sale by means of global computer networks of timepieces and jewelry; advertisement promotion (sponsoring) of cultural and sporting events.
	M 749521	Date Protection Granted in EU: 26.10.11 Switzerland	14	Watches of all types and parts thereof; movements for clocks and watches and parts thereof.
T TOUCH EXPERT	M 965401	Date Protection Granted in EU: 12.05.09 Switzerland	14	Precious metals and their alloys and goods in precious metals or coated therewith included in this class, jewellery, precious stones; horological and chronometric instruments.

b) The opponent relies upon the above marks to oppose the application. The opponent contends that the mark in suit is confusingly similar to its registered trade marks shown above. It states that the goods applied for in the mark in suit are similar or identical to those goods and services for which its marks are registered. The mark in suit would be confused with the opponent's marks and therefore it offends against section 5(2)(b) of the Act.

c) The opponent states that it has used its trade marks shown above in the UK since 1990 in relation to, *inter alia*, watches and watch straps. It has developed a reputation and goodwill in its business such that members of the public associate the above marks with the opponent. The

opponent contends that the mark in suit is similar to its registered trade marks shown above. The mark in suit would without due cause, take unfair advantage of or be detrimental to the distinctive character of the opponents' marks, in that it would cause tarnishing and/or loss of distinctiveness. The mark in suit would benefit from the opponent's power of attraction and ride on the coat tails of the opponent's reputation. The mark in suit therefore offends against section 5(3) of the Act.

d) The opponent contends that as a result of the goodwill and reputation it has developed in the UK by its use of the sign "T" on watches and watch straps since 1990 use of the mark in suit will amount to misrepresentation and damage to its goodwill and also loss of sales. The opponent has used the "T" sign in conjunction with words such as "RACE", "CLASSIC", "TOUCH", "SPORT" and "TREND". The mark in suit therefore offends against section 5(4)(a) of the Act.

e) The opponent also contends that the word "band" in the mark in suit is descriptive in relation to the goods and combining this word with the letter "T" does not result in a mark that, considered overall is capable of distinguishing the applicant's goods from those of other undertakings.

4) On 5 January 2015, the applicant filed a counterstatement which simply denied the grounds of opposition. It put the opponent to proof of use in respect of their marks UK 1409174 & M965401. The opponent contends that the letter "T" on its own is lacking in distinctive character and that the distinctive character in the opponent's marks is given by the stylisation or figurative character. Therefore the scope of protection is limited to these graphical representations.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 28 September 2015 when the opponent was represented by Mr Conway of Messrs Heseltine Lake LLP; the applicant was not represented and did not file written submissions.

OPPONENT'S EVIDENCE

6) The opponent filed two witness statements. The first, dated 27 May 2015, is by Michael Conway the opponent's Trade Mark Attorney. He provides the following exhibits:

- MC1: Dictionary definitions from the Collins English dictionary 3rd Edition updated in 1994, and the online version which shows the same definitions. The definition of "band" includes groups of people /musicians / Canadian Indians /tribe and also a thin strip of material used to encircle objects and hold them together; a strip of fabric or other material used as an ornament; distinguishing or reinforcing band on clothing amongst others. He also provides a definition of "wristband" which states "a band around the wrist esp. One attached to a watch or forming part of a long sleeve."
- MC2: Examples of commercial use of the word "band" in relation to watches. This shows use of the term "band" on Amazon when referring to the watch strap. It talks of band width, length, material etc.
- MC3: Examples of commercial use of the word "band" in relation to parts for watches such as watch straps. These are again from Amazon and again show watch straps being referred to by the term "band". Similar pages from eBay, watchbandcenter.com and Straps4watches show that the term "band" is synonymous with strap, although some pages refer to "watch strap band".

7) The second witness statement, dated 22 May 2015, is by Francois Thiebaud a Director of the opponent with whom he has been associated since 1996. He states that he is authorised to make the statement and that he has access to the opponent's records. I take the following from his statement:

- The opponent has advertised watches in various magazines in the UK, exhibit XY3 refers. In the January 2011 edition of *Metropolitan* a magazine for Eurostar trains, and also in *Business* magazine, dated October 2012 it uses its mark M 965401. In the magazine *Dive the World* dated April 2012 the advertising shows a mark "Sea- Touch" where the letter "T" is in a circle. This is not a registered trade mark. In all of these magazines and also GQ magazine dated July 2014, the advertisements feature an image with some similarity to that of M 1101192 but with significant differences in that instead of being at an angle the "cube of the registered mark was flattened out giving the letters a different look entirely (see below). No details regarding the distribution of either magazine were provided.



- The name "Tissot" receives considerable coverage as the brand sponsors a number of sporting events.
- The letter "T" is used on the crown, hands and strap of some watches. However the letter used differs significantly from that of 1409174 being a standard letter "T" as used in M 965401. The packaging also features the same "flattened cube" described above.
- The opponent has used a range of signs which have the letter "T" in common i.e. T-Classic; T-Sport; T-Trend; T-Pocket; T-Gold; T-Touch; T-Touch Expert; T-Race and T-Round. This is supported by exhibits XY10 & 11 which are catalogues from 2007/8 and 2013/14. It is not specified if these catalogues were used in the UK although they are in English. The same signs can also be found in exhibit XY12 which is a website said to be targeted at the UK consumer, and would appear to be dated 2014.
- Invoices included in exhibit XY13 show the following sales of watches into the UK. I note that none of the watches cost more than £300, while most cost less than £200.

Brand name	June 2010	June 2011	November 2012	April 2013	May 2014
T-Touch	11	1	2	8	12
T-Touch expert	2	6	36	2	31
T-Wave	6	7	0	3	1
T-One	1	0	1	0	0
T-Race	17	0	2	3	25
T_Tempo	0	3	0	0	0
T-Evocation	0	4	2	0	0

- Regarding use of mark 1409174 in the UK, Mr Thiebaud states that the logo is used in relation to some of the opponent's "Heritage" range of watches that have been sold in the UK since 2012. He refers specifically to model "PR 516 Automatic". At exhibit XY14 he provides screenshots from the opponent's website which shows the mark on the face, back and crown of the watch. In the same exhibit is a page from the opponent's website, dated 2014, offering the watch for sale priced £465. At exhibit XY15 he provides a page from the 2013/14 catalogue which shows model PR516 Automatic. He states that in the years 2012-2014 inclusive the opponent has averaged sales of CHF13,000 per annum of the Heritage PR516 Automatic in the UK. This equates to approximately £9285 or 20 watches per annum. At exhibit XY16 a sample of invoices dated December 2012, March 2013 and January 2014 to The Swatch Group in the UK are provided. These show a total of four watches being provided.
- The opponent also claims that mark 1409174 is used on the crown of other watches in the Heritage range and at exhibit XY17 an image is provided, but whilst it is possible to make out there is a letter "T" it is not clear that it is use of mark 1409174.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The first ground of opposition is based on section 5(2)(b) which reads:

"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."

10) An "earlier trade mark" is defined in section 6, the relevant part of which states:

"6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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."

11) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The applicant requested that the opponent provide proof of use and, given the interplay between the dates that the opponent's marks were registered/ granted protection in the EU (UK 1409174 on 13 March 1992 and M965401 on 12 May 2009), and the date that the applicant's mark was published (12 September 2014), the opponent's marks are subject to proof of use. Section 6A of the Act states:

"6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

(7) Nothing in this section affects –

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

12) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its marks has been made. In the instant case the publication date of application 3068797 was 12 September 2014, therefore the relevant period for the proof of use is 13 September 2009 – 12 September 2014. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

13) Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in

question". The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

14) Also in *Laboratoire de la Mer* Trade Mark [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Mummery L.J. stated that:

"31. After some hesitation I have reached a different conclusion from Blackburne J. on the application of the Directive, as interpreted in *Ansul* and *La Mer* , to the rather slender facts found by Dr Trott."

32. Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of *consumers and end users* of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.

33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions. The modest amount of the quantities involved and the more restricted nature of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on *that* market. That was sufficient use for it to be genuine use on the market and in *that* market the mark was being used in accordance with its essential function. The use was real, though modest, and did not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users."

15) Whilst Neuberger L.J. (as he then was) stated:

"48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be "genuine", the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the

European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

16) When considering the evidence filed I take into account the comments in *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

17) I also look to the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

18) As UK mark 1409174 offers the opponent its strongest case I shall concentrate initially upon this mark. In the instant case the evidence of the opponent is unchallenged. At the hearing Mr Conway contended that any use of a capital letter “T” in any font or style was sufficient to be accepted as use of mark 1409174. It is not necessary for me to consider this point as the opponent has provided evidence of use of the mark as registered. It is stated that since 2012 the mark has been used in the UK only in relation to a “Heritage” range of watches. Screenshots of this watch show that mark 1409174 is used on the face, back and crown (exhibit XY14). Also at the same exhibit is a printout from the opponent’s website offering the watch for sale priced £465 and the page shows that it is for delivery to the UK only. The watch is shown in the catalogue, at exhibit XY15, stated by Mr Thiebaud to be the opponent’s 2013/2014 catalogue. He also provides sales figures for 2012-2014 which show that an average of twenty watches a year were sold, corroborated by the sample of invoices at exhibit XY16. To my mind the opponent has clearly shown use of the mark 1409174 upon watches. I shall therefore continue to compare the opponent’s mark with the mark applied for.

19) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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 decision

20) 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.”

21) Watches and parts and fittings for watches are purchased by all members of the general public. Indeed many individuals own more than one watch as they are also used as a form of jewellery as well as being a functional item. Watches can vary enormously in price from the cheap and cheerful purchased in a supermarket for a few pounds to the type of watch worn by those with more money

than sense or taste which can cost many if not hundreds of thousands of pounds. They also range in complexity, some having additional dials to time thousands of a second and/or provide a reminder of time left. Initially the goods offered by both parties will be selected by eye from a shop window, advertisements on the internet or some other medium such as magazines, newspapers or flyers. Most of the goods will also be sold from shops. In all these instances the selection will initially be visual and so this aspect will be the most important element. When purchasing in a shop or if ordering by telephone aural considerations must be considered but the initial choice will still be made visually. I also take into account that the goods may be recommended by friends and acquaintances and again aural considerations must be taken into account. Even simple watches will not be purchased without a degree of consideration regarding size, style, colour etc although I accept that some will be purchased simply as a tool for keeping a rough track of time without any other consideration. The amount of care taken in the purchase will vary in relation to the cost of the item.

Comparison of goods

22) In the judgment of the 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”.

23) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.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.

24) The goods of the two parties are:

Applicant's goods	Opponent's goods
Watches; horological and chronometric instruments; watch bands; straps for wrist watches; watch straps; jewellery”.	Watches and parts and fittings therefor; all included in Class 14.

25) Clearly, “Watches; horological and chronometric instruments; watch bands; straps for wrist watches; watch straps” are identical to the opponent’s specification. When considering the applicant’s


specification for “jewellery” to the opponent’s specification for watches I take into account that many watches are sold as jewellery, being made from precious metals and stones and even formed into bracelets. The users will be the same, the physical nature can be reasonably similar the respective trade channels are similar with most jewellers selling watches and where they are in a self service position they would be in close proximity. These goods must be considered as being similar to a medium degree.

Comparison of trade marks

26) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The 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.”

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

Opponent’s trade mark	Applicants’ trade mark
	T-band

28) The opponent’s mark consists of the letter “T” is a slightly stylised version within a very plain border. The applicant’s mark consists of the letter “T” with the word “band”. The term “band” in relation to watches has a very clear descriptive meaning as it is extensively used to refer to the watch strap, see paragraph 6 of the evidence summary above. The marks are obviously visually and aurally similar as both begin with the letter “T”, although I accept that the applicant’s mark also has a descriptive element which provides a degree of visual and aural difference. Overall the marks are visually and aurally similar to at least a medium degree. Given the descriptive nature of the word “band” I believe that the marks are conceptually neutral, as the letter “t” does not have a meaning.

Distinctive character of the earlier trade marks

29) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or

lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

30) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

31) The opponent’s mark is a well known English letter “T” whose distinctive character lies within its whole. It is only slightly stylised and has a plain border to which most consumers will not give any trade mark significance. In relation to watches etc it has no meaning and as such it is inherently distinctive. Although use of the mark has been shown it is not sufficient in my opinion for the opponent to benefit from enhanced distinctiveness.

Likelihood of confusion

32) 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 keep in mind the distinctive character of the opponent’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 the fact that the average consumer rarely has the opportunity to make

direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods by predominantly visual means, although not discounting aural considerations and that the degree of care and attention they pay in selecting the goods will vary enormously depending upon cost;
- The respective specifications are identical for the most part, with only exception (jewellery) being similar to a medium degree.
- In comparing the mark in suit to the opponent's mark the competing trade marks have a medium degree of visual and aural similarity. Conceptually the marks are neutral, with no meaning.
- the opponent's earlier trade mark has an average level of inherent distinctiveness in relation to watches and parts and fitting therefor in class 14 but cannot benefit from an enhanced distinctiveness as the evidence of use was in not sufficient.

33) In view of the above and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods in class 14 provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in full.**

34) Given this finding I decline to consider the other grounds of opposition.

CONCLUSION

35) The opposition under Section 5(2)(b) has been successful.

COSTS

36) As the opponent has been successful it is entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side's statement	£300
Preparing evidence	£500
Attendance at a hearing	£500
TOTAL	£1500

65) I order Kairos Watches Limited to pay Tissot S.A. the sum of £1500. This sum 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 5th day of October 2015

**George W Salthouse
For the Registrar,
the Comptroller-General**