

O-215-17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 062 769 FOR THE
TRADE MARK RADAR IN THE NAME OF OLIVER CARL WALLACE ASHLEY

AND

IN THE MATTER OF OPPOSITION THERETO BY RADO UHREN AG (RADO
WATCH CO LTD)

Background and pleadings

1. Oliver Carl Wallace Ashley (the applicant) applied to register the trade mark RADAR in the UK under No 3 062 768 on 25th July 2014. It was accepted and published in the Trade Marks Journal on 23rd October 2015 in respect of a number of goods and services, the following of which are the subject of these proceedings:

Class 14:

Precious metals and their alloys; jewellery, precious stones; horological and chronometric instruments; key rings; watches; clocks.

Class 35:

Retail services and the bringing together for the benefit of others of horological and chronometric instruments, watches, clocks.

2. Rado Uhren AG (Rado Watch Co Ltd) (Montres Rado S.A.) (the opponent) partially oppose the trade mark on the basis of Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Mark RADO under No 1 488 874. The following goods in Class 14 are relied upon in this opposition: Watches; parts and fittings for all the aforesaid goods; all included in Class 14. A further earlier trade mark is relied upon, namely an International Registration designating the European Union

RADO

No 1 035 353: S W I T Z E R L A N D .

3. The following services in Class 35 are relied upon in this opposition: Retail sale services for watches, clocks, timepieces, chronometric instruments and their parts and jewelry products.
4. Under Section 5(2)(b), the opponent argues that the respective goods and services are identical or similar and that the marks are similar. Under Section 5(3), the opponent argues that it has used its earlier trade marks extensively throughout the United Kingdom for many years and has built up a significant reputation, in particular in respect of watches and their parts in Class 14. The opponent argues that the public would make a link between the RADO trade marks and the applicant's RADAR trade mark. As such it would be detrimental to, or would take unfair advantage of, the distinctive character or repute of the earlier trade marks.
5. The applicant filed a counterstatement denying the claims made (and requesting that the opponent provides proof of use of its earlier trade mark relied upon). In more detail, the applicant argues that although it accepts that the goods and services are identical or similar, the marks, due to the obvious concept of RADAR are sufficiently distinct for there to be no likelihood of confusion. Likewise, no link would be established between them.

6. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate.
7. A Hearing took place on Tuesday 7th March 2017, with the opponent represented by Martin Krause of Haseltine Lake LLP and the applicant by Phillip Harris of Lane IP Limited.

Evidence

Opponent's evidence

8. This is a witness statement, dated 22nd July 2016 from Mr Marc Monachon, the Head of Procurement for the opponent. The following relevant points are contained therein:
 - The Rado business was established in Switzerland in 1917, with the Rado name first registered as a trade mark in 1951.
 - The Rado business now operates 101 monobrand stores throughout the world and distributes products to over 140 countries worldwide. The business is now owned by the Swatch group and is one of the Group's largest brands in terms of sales revenue.
 - Rado produces an extensive range of watches (a list of 13 collections is provided in the witness statement).
 - Rado also produces a number of special edition watches.
 - Exhibit RU3 is a copy of the Rado product catalogue for 2015/2016. Distribution information is not provided.
 - The average price of RADO watches range between £1000 - £5000.
 - Exhibit RU4 consists of extracts from the www.rado.com website which provide information about the materials from which Rado watches are made. It is noted that Rado watches are innovative in this regard as they are made from ceramics.
 - The Rado name appears on the face, case back and clasp or buckle of all its watches. Further, it is branded and/or engraved on the interior of Rado watches.
 - Rado products are sold through over 191 retail outlets across the UK, including Harrods.
 - During the period 2010 – 2016, sales of Rado products in the UK totalled £27.5 million.
 - Rado products are advertised extensively across the UK. A list of publications and websites within which Rado watches were included is provided at Exhibit RU5. Examples of the advertisements are also included. It is noted that the publications within which adverts have appeared include national newspapers such as the Daily Telegraph and the Independent on Sunday.
 - Exhibits RU6 – RU9 consists of a sample range of advertisements which appeared on UK websites or in UK printed publications in the years 2012-2015. It is noted that there are examples of adverts that have appeared in publications with a notable circulation. GQ Magazine and Top Gear are examples which enjoy a circulation of 100,000+.

- Exhibit RU11 is a summary of Rado's involvement in the tennis industry. The exhibit includes photographs of the Rado brand in use at tennis tournaments. In respect of the UK, Rado is the official watch partner of the Aegon Tennis Championship and has been the official timekeeper at the London Queen's Club event from 2012-2015.
- The company also has a presence on social media websites such as Facebook, Twitter, Google+ and Instagram. It also offers downloadable applications for the iPhone.

The applicant's evidence

9. This is a witness statement, dated 13th October 2016, from Claire Lorraine Keating, a trade mark attorney at Lane IP Limited, the representatives of the applicant in these proceedings. Ms Keating explains that the opponent's trade mark, as demonstrated on its own website, is pronounced RAH DOH. The pronunciation located on the website is exhibited on a physical USB at Exhibit CLK1 and the pronunciation is noted.

Proof of use

10. Relevant statutory provision: Section 6A:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) 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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

11. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(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 to distinguish the goods or services

from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Conclusions on the evidence

13. The evidence demonstrates extensive use in a large number of retail outlets. The sales figures provided are relatively high. There is extensive evidence of advertising activities and also sponsorship deals relating to time keeping in

the tennis industry. The opponent has clearly used its earlier trade marks in respect of watches and retail services thereof.

DECISION - Section 5(2)(b)

14. Sections 5(2)(b) of the Act is as follows:

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

(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”.

Comparison of goods and services

15. Some of the contested goods and services, i.e. watches and retail services for watches are identical to the goods and services on which the opposition is based. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods and services listed above. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the earlier trade marks. If the opposition fails, even where the goods/services are identical, it follows that the opposition will also fail where the goods/services are only similar.

Comparison of marks


16. 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 the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

17. 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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

18. The respective trade marks are shown below:

<p>RADO</p>  <p>RADO S W I T Z E R L A N D</p>	<p>RADAR</p>
<p>Earlier trade marks</p>	<p>Contested trade mark</p>

19. Before comparing the respective trade marks, I must first appraise their distinctive and dominant components. In respect of the earlier trade marks, this is clearly RADO in each instance; it is the sole element of the word only trade mark and the largest and most distinctive element of the figurative trade mark. With regards to the contested trade mark, it is comprised of only one element and so this is its distinctive and dominant element.

20. The marks coincide visually in respect of the letters RAD. They differ in all other respects. The degree of visual similarity is pitched as being low to medium.

21. Aurally, the later trade mark will be pronounced as RAY-DAH. In respect of the earlier trade mark, the applicant has filed evidence to demonstrate that it is pronounced as RAH-DOH. However, it could also be RAY-DOH. In respect of the latter aural option, the trade marks are similar to a medium to high degree.

22. Conceptually, RADO is an invented element and is meaningless. Switzerland will be understood as referring to the European country. According to Collins, Radar is a way of discovering the position or speed of objects such as aircraft or ships when they cannot be seen, by using radio signals. This is considered to be a clear and unequivocal meaning. The trade marks are not conceptually similar.

Average consumer and the purchasing act

23. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the

likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

24. 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.”

25. The consumer for watches will be the public at large, purchasing the products from a store or in the online environment. As such, both visual and aural considerations are potentially important. Watches can vary wildly in terms of price and so the level of attention expected to be displayed during the purchasing process will reflect this. For example, one would expect it to be fairly high in respect of a luxury item. However, in any case, even a cheaper item would be reasonably considered as factors such as look, colour, function will all be relevant.

Distinctive character of the earlier trade mark

26. 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).”

27. The opponent claims that it enjoys an enhanced distinctive character (and so, degree of protection) as a result of its use of the earlier trade marks. On perusal of the evidence, it is clear that the use that has been made is impressive, in terms of sales and advertising. The earlier trade marks are clearly well established in the UK. They enjoy an above average degree of distinctive character.

GLOBAL ASSESSMENT – Likelihood of Confusion.

28. 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

29. The goods and services are identical. The trade marks are visually similar to a low to medium degree and aurally similar potentially to a medium to high degree. The earlier trade marks are also distinctive to an above average degree. All of these factors weigh in the opponent's favour. However, in *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

30. Though it is true that a conceptual difference does not always overcome visual and aural similarities¹, it is considered that in respect of RADO and RADAR, the concept in the later trade mark is immediate and powerful. It is a differentiating hook that entirely sets it apart from the earlier trade mark. It is considered that this, together with the reasonable degree of attention likely to

¹ *Nokia Oyj v OHIM*, Case T-460/07

be shown during the purchasing process, that is highly likely to negate against any of the trade marks being imperfectly recalled. There is no likelihood of direct confusion.

31. However, this is not the end of the matter. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

32. Though the above list is non exhaustive, it is considered that category a) identified above cannot apply as the marks do not have a common “element” as such; rather they share some common letters – RAD. As such, it is difficult to see how a consumer upon viewing RADAR would assume it must be a new mark of RADO. In respect of categories b) and c), it is clear that neither apply here. There is no likelihood of indirect confusion. The opposition, in so far as it is based upon Section 5(2)(b) fails.

Section 5(3) – Reputation

Legislation

32. Section 5(3) states:

“(3) A trade mark which-
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

33. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be

assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

34. Bearing in mind the above, in order to show that it has a reputation, a trade mark must demonstrate that it is known by a significant part of the public. It is noted that one of the earlier trade marks is a European Union Trade Mark. As such, it is noted that in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, the CJEU held that:

“20. By its first question, the national court in essence asks the Court, first, to clarify the meaning of the expression ‘has a reputation in the Community’, by means of which, in Article 9(1)(c) of the regulation, one of the conditions is

laid down which a Community trade mark must fulfil in order to benefit from the protection accorded by that provision and, second, to state whether that condition, from a geographical point of view, is satisfied in a case where the Community trade mark has a reputation in only one Member State.

21. The concept of 'reputation' assumes a certain degree of knowledge amongst the relevant public.

22. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, *General Motors*, paragraph 24, with regard to Article 5(2) of the directive).

23. It cannot be required that the Community trade mark be known by a given percentage of the public so defined (*General Motors*, by way of analogy, paragraph 25).

24. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (*General Motors*, by way of analogy, paragraph 26).

25. In examining this condition, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it (*General Motors*, by way of analogy, paragraph 27).

26. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers.

27. Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community (see, by way of analogy, *General Motors*, paragraph 28).

28. It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries (*General Motors*, paragraph 29).

29. As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

30. The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

35. In *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), Geoffrey Hobbs QC, as a Deputy Judge of the High Court held that:

“76. Article 9(1)(c) provides protection for Community trade marks which have a reputation “in the Community”. Kenwood suggested that this means a reputation across the Community as a whole or at least a large area of it. I do not agree. In the case of a trade mark registered at the national level, protection of the kind provided by art.9(1)(c) can be claimed for trade marks which have a reputation in the sense that they are known by a significant part of the public concerned by the products or services covered by that trade mark in the territory of registration. Since the territory of registration is part of the Community, the trade mark has a reputation in the Community. The trade mark does not cease to have a reputation in the Community if the national registration is either subsumed within a Community trade mark registration under art.34(2) of the CTMR on the basis of a valid claim to seniority or duplicated by a Community trade mark registration. In principle, a Community trade mark should not receive less protection than a national trade mark with a reputation in the same territory. I think that the aim should generally be to prevent conflict occurring in any substantial part of the Community and that the United Kingdom can for that purpose be regarded as a substantial part of the Community, with or without the addition of France and Germany. It thus appears to me that Whirlpool's Community trade mark has a reputation in the Community.”

36. It is clear from the above that a reputation in the UK is enough to demonstrate a reputation in the Community.

37. Bearing in mind the evidence filed by the opponent as summarised earlier, it is considered clear that the opponent enjoys a reputation in its earlier trade marks in respect of watches and the retail thereof. The nature of this reputation appears to be in respect of innovation: the opponent pioneered the use of ceramic material in its watches. Its watches are also relatively expensive (upwards of £5000) which places them at the relatively more luxurious end of the market. The first hurdle is therefore cleared.

The Link

38. I must therefore assess whether or not the later trade mark will call the earlier trade marks to mind, in other words, to create a link between them. The respective trade marks have already been compared above: they are visually and aurally similar, yet conceptually different. It is also taken into account that the goods and services are identical and that the prospective consumers clearly overlap. As to the strength of the opponent's reputation, it is considered that this is notable, though not overwhelming.
39. Bearing in mind all of the factors listed above, it is considered that the conceptual difference between the trade marks is notable. Its effect is strong and immediate. The result being that it is difficult to see how a consumer on noting RADAR, will bring to mind the invented word RADO. The opposition based upon Section 5(3) also fails.

COSTS

40. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering other side's statement - £400

Preparing evidence and considering other side's evidence - £750

Preparing for and attendance at a Hearing - £750

TOTAL - £1900

41. I therefore order Rado Uhren AG (Rado Watch Co Ltd) (Montres Rado S.A.) to pay Oliver Carl Wallace Ashley the sum of £1900. The above sum should 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 May 2017

Louise White

For the Registrar,