

O-352-17

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3153245
FOR THE TRADE MARK**

PICTAR

**IN CLASS 9
OWNED BY THE RUNNINGMAN (UK) LTD**

AND

**THE OPPOSITION THERETO
UNDER NO. 600000472
BY LUXALAN S.à.r.l.**

Background and pleadings

1. This trade mark opposition concerns an application by The Runningman (UK) Ltd¹ (“the applicant”) to register the trade mark PICTAR. The application was filed on 4 March 2016, for the following goods:

Class 9: Photographic apparatus and instruments; photographic equipment; photographic cameras; digital cameras; compact digital cameras; photographic equipment for use with mobile phones; holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus; software and applications for mobile devices; computer application software for mobile phones; photographic flash apparatus; camera lenses; electronic imaging devices; portable communications apparatus.

2. Following the publication of the application in the *Trade Marks Journal* on 27 May 2016, it was opposed by Luxalan S.à.r.l. (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), based upon its earlier International Trade Mark Registration number 1290802 which designates the EU, for the mark PICTACT. Protection for the earlier mark was requested in the EU on 24 December 2015 and was granted on 5 January 2017.

3. The earlier mark is protected in classes 9, 39, 43 and 45. It was confirmed at the hearing that the opponent relies only upon the class 9 goods of its earlier mark. These are:

Computer software; computer software development tools; computer software for use as an application programming interface (API) for computer software which facilitates online services for social networking, building social networking applications and for allowing the retrieval, uploading to a server, downloading, access to and management of data; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and

¹ Assigned to the applicant from Sean Blair Justin Henry on 5 July 2016.

communication networks; computer software for wireless network communications; telecommunications apparatus for use with mobile networks; communication software for connecting computer network users; communication software for connecting global computer networks; software for creating, facilitating, and managing remote access to and communication with local area networks and global networks; computer game software downloadable from a global computer network; networking, discussion and information software downloadable from a global computer network; computer programs for connecting remotely to computers or computer networks; software for searching and retrieving information across a computer network; computer game software downloadable via a global computer network and wireless devices; computer software and telecommunications apparatus, including modems, to enable connection to databases, computer networks and the internet; computer software for use in providing multiple user access to a global computer information network; application software; application software for smartphones; downloadable computer software applications; computer application software for mobile phones; software and applications for mobile devices; computer software for application and database integration.

4. Section 5(2)(b) of the Act states that:

“(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.”

5. The opponent claims that the marks are visually and phonetically very similar (it claims that no conceptual comparison can be made as they have no meaning), and

the goods in class 9 are similar or identical, causing a likelihood of confusion between the parties' marks.

6. The applicant denies the claim in its defence and counterstatement, save for an admission that the parties' *software and applications for mobile devices and computer application software for mobile phones* are identical.

7. Both parties are professionally represented. The applicant filed evidence and the opponent filed written submissions during the evidence rounds. The matter came to be heard at a video conference hearing before me on 17 July 2017 at which the opponent was represented by Mr Olivier Laidebeur, of Office Freylinger S.A., its trade mark attorneys. The applicant was represented by Mr Simon Cooper of Adamson Jones, its trade mark attorneys.

Evidence

8. The applicant's evidence is filed by Mr Cooper. Rather than give a summary of the applicant's evidence here, I will refer to it as and when necessary during this decision. This is because the evidence goes to matters of channels of trade of the goods, decisions of the EUIPO and General Court, and the existence of third party software applications ('apps') which include PIC in their names. The evidence will be referred to in relation to the comparison of goods and the likelihood of confusion.

Decision

9. The following principles to be borne in mind when considering section 5(2)(b) of the Act 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.

Comparison of goods

10. The law requires that goods and services be considered identical where one party's description of its goods or services encompasses the specific goods or services covered by the other party's descriptions (and vice versa): see *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T-33/05, the General Court ("GC").

11. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

12. 'Complementary' was defined by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

13. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

14. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

15. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and

natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

16. The goods to be compared are:

Earlier mark	Application
<p><i>Computer software; computer software development tools; computer software for use as an application programming interface (API) for computer software which facilitates online services for social networking, building social networking applications and for allowing the retrieval, uploading to a server, downloading, access to and management of data; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; computer software for wireless network communications; telecommunications apparatus for use with mobile networks; communication software for connecting computer network users; communication software for connecting global computer networks; software for creating, facilitating, and managing remote access to and communication with local area networks and global networks; computer game software downloadable from a global computer network; networking, discussion and information software downloadable from a global computer network; computer programs for connecting remotely to</i></p>	<p><i>Class 9: Photographic apparatus and instruments; photographic equipment; photographic cameras; digital cameras; compact digital cameras; photographic equipment for use with mobile phones; holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus; software and applications for mobile devices; computer application software for mobile phones; photographic flash apparatus; camera lenses; electronic imaging devices; portable communications apparatus.</i></p>

computers or computer networks; software for searching and retrieving information across a computer network; computer game software downloadable via a global computer network and wireless devices; computer software and telecommunications apparatus, including modems, to enable connection to databases, computer networks and the internet; computer software for use in providing multiple user access to a global computer information network; application software; application software for smartphones; downloadable computer software applications; computer application software for mobile phones; software and applications for mobile devices; computer software for application and database integration.

17. As stated above, both parties have cover for *software and applications for mobile devices and computer application software for mobile phones*. These goods are identical.

18. The opponent's position is that the applicant's photographic goods are similar to its goods because modern photographic apparatus is digital and composed of electronic components and software. Further, photographic equipment for use with mobile phones needs software to be installed on the mobile phone for the equipment to work. Mr Laidebeur submitted that the majority of photographs are taken by mobile phone and that apps are used to edit photographs and to share them. The opponent refers to a decision of the EUIPO² in which it was found that "nowadays a software is usually an essential component of a photographic apparatus."

² No.1845/2005 opposition B569519

19. The applicant takes the view that its photographic goods are used for taking photographs and so are very different to computer software. The applicant makes the following observations:

- The nature of the goods differs. The applicant's goods have the form of complex electronic apparatus and related hardware accessories, whereas the opponent's goods consist of computer code, either provided on an electronic data carrier or downloadable to a computer or mobile phone.
- The method of use differs because the applicant's goods are for taking photographs, whereas the opponent's goods provide a software application for a computing device to achieve a particular function. This point also seems to cover the intended purpose of the respective goods.
- The end user could be the same (general public/photographers).
- In terms of complementarity, although software is commonly used to edit or share photographs, no evidence has been presented of software sold for use with photographic apparatus.

20. The applicant submits that its goods would be sold by specialist photographic or mobile phone shops, or in specialist photographic or mobile phone accessories sections of large electrical consumer product stores. In contrast, the applicant submits, the opponent's goods would be sold by specialist IT stores, online from app stores, or in specialist software sections of large electrical consumer product stores. The applicant submits that the distribution channels are different and to support these submissions, Mr Cooper has filed exhibits (SMC03, SMC04, SMC05, SMC06 and SMC07) which comprise prints from the website of Curry's, the UK electrical consumer products retailer. These were printed on 17 March 2017. They show that goods are categorised into discrete areas on the website – Kitchen Appliances, Small Appliances, TV & Entertainment, Cameras, Audio, Computing, PC Accessories, Phones and Smart Tech, with further subcategories under each category heading. For example, under Cameras, there are sub-categories for

Interchangeable Lens Cameras, Digital Compact Cameras, Camcorders, CCTV, Photographic Accessories, and Optics. Under PC Accessories, Software is a sub-category, which is further sub-categorised as Internet Security and Antivirus, Business & Home Office, Creative, Education, Leisure & Reference, and Downloads.

21. Mr Cooper states that software is a separate class of goods, typically supplied by different companies, and presented separately by retailers. He states that although many electronic goods use software to function, such software is supplied integrally with the goods and not sold separately. He notes that the opponent has not shown any evidence of software sold for use with photographic apparatus. Mr Cooper submits that it is even less likely that software would be supplied separately for the other goods in the applicant's specification, which are photographic or mobile phone accessories.

22. Mr Cooper exhibits a copy of the decision referred to by the opponent (No.1845/2005, dated 27 May 2005). I note that this was a decision by the opposition division of the EUIPO. The quotation from the opponent should be seen in the context of the rest of the paragraph in the decision, which states that goods could be considered complementary to computer software for the reason quoted by the opponent, but equally there can be differences in the nature and the usual origins of the goods. At the hearing, Mr Cooper referred to a decision of the EUIPO's Fourth Board of Appeal, *SAS GROUPE v SAS INSTITUTE INC.*, Case R 1832/2014-4:

“26 The contested goods in Class 9 ‘Photographic, cinematographic, optical and teaching apparatus and instruments’ are all products of a different nature and with a different purpose (e.g. for recording photographic or cinematographic images, for seeing, for teaching, etc.) compared to the nature and purpose of the appellant's software which is to control the functioning of hardware. These goods do not have the same function and method of use, nor do they share the same targeted public or distribution channels. Consumers interested in these apparatus or instruments will purchase them in a shop or the dedicated area of a department store specialised in photos or cameras or at an optician. The software of the

opponent however will be purchased in specialised stores for IT products or directly from a provider which would also provide training regarding the installation and use of the software. These goods are dissimilar to the goods of the appellant.

27 The same applies to the contested ‘Apparatus for recording, transmission or reproduction of sound or images ; Magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media’. These are apparatus, devices and supports for communicating audio or video information. However, the relevant public to which the opponent’s business-centred software are addressed will not consider that these goods are produced by the same company. They are not distributed through the same channels and do not perform the same function. They are therefore dissimilar.”

23. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC considered the issue of similarity between computer programs and other electronic goods and services:

“69 Next, the Court must reject the applicant’s argument that all the goods and services covered by the Community trade mark application are linked, in one way or another, to ‘computers’ and ‘computer programs’ (Class 9) covered by the earlier trade mark. As the defendant rightly points out, in today’s high-tech society, almost no electronic or digital equipment functions without the use of computers in one form or another. To acknowledge similarity in all cases in which the earlier right covers computers and where the goods or services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark. Such a position would lead to a situation in which the registration of computer hardware or software would in practice exclude subsequent registration of any type of electronic or digital process or service exploiting that hardware or software....”

24. I remind myself that case law states that I must consider the core meaning of terms in the specifications. Although mobile phones include cameras, the core meaning of the applicant's photographic cameras; digital cameras; compact digital cameras; photographic flash apparatus and camera lenses is that they are goods for taking photographs, not mobile phones. They differ in nature, purpose and methods of use compared to computer software, and are not in competition. The opponent's argument appears to rest on perceived complementarity and channels of trade. I find the applicant's evidence of separate channels of trade persuasive but, even without this, my knowledge as a consumer tells me that photographic equipment and software are sold in different areas of large electrical stores.

25. As pointed out by the GC, computer software is used in every part of modern life. Computer software is not automatically similar to goods which use computer software to operate. Mr Laidebeur submitted that the position in 2005 (when *Les Éditions Albert René v OHIM* was decided, although the relevant date was 7 November 1997) is very different to today (strictly, the relevant date in these proceedings is 2016) as regards photographic apps and software because the practice of taking photographs on mobile phones is so much more prevalent. However, it is also possible to take the view that if computer software permeated life in 2005 (1997), the GC's words must apply with even more force today. The opponent has filed no evidence at all. There is no evidence before me about separate computer software for use with cameras. Applying *Boston Scientific*, I do not accept that the average consumer of the goods listed in the previous paragraph of this decision would view computer software or apps as sufficiently closely connected to those goods and conclude that the responsibility for those goods lies with the same undertaking. Consequently, there is no similarity between the opponent's goods and the applicant's *photographic cameras; digital cameras; compact digital cameras; photographic flash apparatus and camera lenses*.

26. The applicant's specification includes *holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus*. These appear to be 'selfie sticks', to use the vernacular. Such goods operate using Bluetooth or apps (application software), which need to

be installed on the mobile phone. There is, therefore, a complementary relationship between the applicant's goods and the opponent's software, particularly the opponent's *computer application software for mobile phones*. Selfie sticks require specific apps and those apps are redundant without selfie sticks. The purpose of both is to enable the taking of photographs remotely. They are similar to a moderate degree. The applicant's *photographic apparatus and instruments; photographic equipment* encompass *holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus*, so, to the extent that these goods cover *holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus*, they are also moderately similar to the opponent's goods in terms of purpose and complementarity. As with selfie sticks, it appears likely that any photographic equipment for use with mobile phones will require an app to function. Therefore, following the same logic, *photographic equipment for use with mobile phones* is also moderately similar to the opponent's goods.

27. The remaining goods in the applicant's specification are *electronic imaging devices* and *portable communications devices*. The latter is a wide term which covers laptops, tablets and mobile phones. There is no explanation as to the nature of electronic imaging devices. These also seem to be covered by such goods; at least, one may use them to create images electronically. Laptops, tablets and mobile phones all require the installation or downloading of apps and computer software, frequently brand or model-specific. They are strongly complementary.

Average consumer and the purchasing act

28. 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*.

29. Mr Cooper submitted that the average consumer for the applicant's goods will be of the more sophisticated type, in terms of levels of expertise and attention during purchase. The parties' goods will vary in technological complexity and cost. Cameras are relatively expensive and infrequent purchases. The purchasing process will entail a reasonably high level of attention. In contrast, *holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus* (selfie sticks) are not expensive and will cause no more than a moderate degree of attention to be paid during purchase. Both parties have cover for *software and applications for mobile devices and computer application software for mobile phones*. Apps are consumer purchases, frequently without charge, and would entail no more than a medium level of attention. Although I bear in mind the potential for aural use of the marks during the selection process, it is my view that the process will be overwhelmingly visual, as a result of the average consumer's examination of website information, literature and product packaging.

Comparison of marks

30. 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 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.”

31. 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.

32. The parties' marks are:

Opponent's mark	Applicant's mark
PICTACT	PICTAR

33. They both consist of single words which comprise the sole aspect of their overall impressions. They are similar in length (7 and 6 letters), with the first 5 letters being identical and in the same sequence. They are visually similar to a good degree.

34. Both marks consist of two syllables, the first of which will be pronounced the same: PIC, as in the word 'pick'. The opponent submits that the second syllables are also very similar in sound. I disagree. TAR and TACT sound different when spoken in English. TAR has a long vowel sound, as in CAR, whilst TACT has a short vowel, a CK sound (the C) and a final T sound. In English, all of the letters in TACT are articulated. The net effect of the identically sounding first syllable, but different sounding second syllable, is that the marks have a low to medium degree of aural similarity.

35. Both PICTACT and PICTAR are invented words. Although invented words have no concept, they can be evocative of an idea³. The applicant submits that the average consumer would immediately recognise PIC as a prefix commonly used to refer to pictures (photographs) in the names of apps. To support this submission, Mr Cooper has filed the results of a search for 'photo' in the Apple App Store (Exhibit SMC08). He states that the following brand names were presented in the first 20 screens (120 apps) of the results:

³ *Usinor SA v OHIM*, Case T-189/05.

Pic Joiner, PicsArt Photo Studio, PicCollage, Split Pic, Piclay, Piclab, Pic Stitch, Instamag – Pic Collage, Split Pic Pro, PicShop Lite, Photo pic.ture, 4 Pics 1 Word, PiciBooth, Video Collage – Vid pic Collage, PicCells, Pic Collage Kids, PICSPLAY, and Photo Collage – Pic Editor.

36. I consider that the use of PIC in some of the results refers more obviously to an abbreviation for picture than in others, depending on the other elements with which it is combined. It is important to bear in mind that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. Viewed as wholes, PIC is too disguised in either mark to bring to mind the concept of pictures or photography, certainly immediately. Consequently, neither mark has a concept. There is no conceptual similarity between the marks.

37. I will factor in the various levels of similarity when I make the global assessment as to whether there is a likelihood of confusion⁴.

Distinctive character of the earlier mark

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁵ 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 *WindsurfingChiemsee 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

⁴ As per BL O/193/15 *Aire Limpio*, Ms Anna Carboni, sitting as the Appointed Person.

⁵ Case C-342/97.

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).”

39. The opponent has not filed any evidence of use of its mark, so I have only the inherent position to consider. I found above that PICTACT is an invented word and does not evoke ‘picture’. I find that the earlier mark has a high degree of inherent distinctive character because it does not describe or allude to the goods or any characteristic of the goods.

Likelihood of confusion

40. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that some of the goods are not similar. Where there is no similarity between the goods, there can be no likelihood of confusion (*Canon and Waterford Wedgwood plc v OHIM*, Case C-398/07, CJEU). Consequently, the opposition fails in respect of *photographic cameras; digital cameras; compact digital cameras; photographic flash apparatus and camera lenses*.

41. It is a rule of thumb that the attention of average consumers is usually directed to the beginning of marks⁶. The general rule does not apply if the beginning of the marks is non-distinctive or descriptive. I have made a finding above that PIC is too

⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, GC.

disguised in the marks to be perceived as a reference to pictures (or photographs). The common first five letters is, therefore, a factor in the opponent's favour, as is the strength of the distinctive character of the earlier mark. The good degree of visual similarity is not offset by any differing conceptual hook. There is potential for imperfect recollection in the case of the identical goods, apps and software, which are subject to no more than a medium level of attention by the average consumer. There is a likelihood of confusion in relation to the applicant's *software and applications for mobile devices* and *computer application software for mobile phones*.

42. In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. I have found that there is a strong complementary relationship between the applicant's *electronic imaging devices* and *portable communications apparatus* and the opponent's goods (the opponent has cover for all types of software). I find that a combination of the strength of the complementary relationship, the distinctiveness of the earlier mark, the good level of visual similarity in what is primarily a visual purchase, and the lack of any differing conceptual hook will cause a likelihood of confusion which is not sufficiently mitigated by the reasonable level of attention paid during the purchasing process.

43. I also found that there is a complementary relationship between, in particular, the opponent's *computer application software for mobile phones* and the applicant's *holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus*. Additionally, there is similarity of purpose. These goods are not expensive and will entail no more than a moderate degree of attention during purchase; the earlier mark is highly distinctive, there is a good deal of visual similarity in what is overwhelmingly a visual purchase, and there is no differing conceptual hook to pull against the potential for imperfect recollection. I find that there is a likelihood of confusion in relation to the applicant's *holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus*.

44. Since the applicant's terms *photographic apparatus and instruments; photographic equipment; photographic equipment for use with mobile phones* encompass *holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus*, it means that, to the extent that these goods cover *holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus* and *photographic equipment for use with mobile phones*, there is also a likelihood of confusion. However, *photographic apparatus and instruments; photographic equipment* are wide terms which cover goods which are not similar to the opponent's goods, such as cameras, flashes, lenses and tripods.

45. Tribunal Practice Notice 1/2012 on 'Partial Refusals' ("the TPN") refers to Mann J's judgment in *Giorgio Armani SpA v Sunrich Clothing Ltd*⁷:

"Mann J considered the correct approach to arriving at a fair specification in opposition proceedings where there were grounds for partial refusal and where he had concluded that the application of the metaphorical "blue pencil" by the hearing officer was not appropriate and no unconditional restriction had been offered by the applicant. He considered the application of the principles applied by Mr Arnold in *SENSORNET* and said:

"52. [...] there is no case law binding on me which deals with the point I have to decide, and I have to decide it on the footing of the statutory provisions as to applications and amendment, such rules of procedure as govern the proceedings, and on the footing of normal requirements of procedural and substantive fairness. Mr Arnold's views do not really deal with this sort of situation [...]. So far as they indicate that the Hearing Officer has to take the specification as he or she finds it, he is not dealing with a case where there needs to be a debate in inter partes proceedings about the scope of the permitted registration. If applied too literally the concept would prevent the proper resolution of part of the real dispute.

⁷ [2010] EWHC 2939 (Ch).

53. What the present situation involves is the proper identification and resolution of the dispute arising out of the opposition, and the following points apply:

(i) Since this case was one of partial opposition (in terms of the goods covered), Article 13 requires that there be registration of the mark in relation to goods in relation to which the mark was not opposed. The available procedures should enable that to be done fairly and efficiently.

(ii) [...] the proper scope of registration [...] is the [potential area of dispute]. In some cases it will not be a real area of dispute because the answer is obvious - it might be possible to isolate the permissible part by blue pencilling that which is not admissible, or it might be obvious that a plain express qualification ("save for [the goods in respect of which the opposition succeeded]") will do the trick, in which case there is no real area of dispute there either. On the other hand, it might be that the answer to that part of the case is more disputed - particular formulations might be objected to as falling on one side of the line or the other. Procedures ought to allow for all these possibilities."

Mann J went on to consider the range of procedures that could be adopted in which a dispute as to residual wording could be determined, as referred to by Mr Geoffrey Hobbs, sitting as the Appointed Person in *Citybond Trade Mark* [2007] RPC 13. The range of procedures identified are from the applicant deciding to limit its application to some different specified wording in an unconditional amendment application to a deferment of the question of alternative wording to the stage after consideration of the formulated objection, with other possibilities in between. He concluded by stating that the hearing officer should provide a mechanism for ensuring that he/she is able to give a ruling as to what was left of the registration after a successful opposition."

46. The situation in the present proceedings which I have described in paragraph 44 above seems to fall squarely within paragraph 52 (ii) of *Giorgio Armani* with regard to the plain express qualification. The TPN sets out the practice to be applied in such cases:

“3.2.2 Defended Proceedings

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered "men's and boys' clothing", thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the 'blue pencilling' approach or the 'save for' type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will

simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal.”

47. I will follow the approach set out in paragraph 3.2.2(b): the ‘save for’ exclusion. The application may proceed for the following goods:

Photographic apparatus and instruments; photographic equipment; but not including any such goods being photographic equipment for use with mobile phones or holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus; photographic cameras; digital cameras; compact digital cameras; photographic flash apparatus; camera lenses.

Outcome

48. The opposition is successful against the following goods:

Photographic apparatus and instruments being photographic equipment for use with mobile phones or holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus; photographic equipment being photographic equipment for use with mobile phones or holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus; photographic equipment for use with mobile phones; holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus; software and applications for mobile devices; computer application software for mobile phones; electronic imaging devices; portable communications apparatus.

49. The application may proceed to registration for:

Photographic apparatus and instruments; photographic equipment; but not including any such goods being photographic equipment for use with mobile phones or

holders adapted for mobile phones, in which the combination of holder and mobile phone functions as a camera or a photographic apparatus; photographic cameras; digital cameras; compact digital cameras; photographic flash apparatus; camera lenses.

Costs

50. Bearing in mind the coverage of goods for which the application may proceed to registration (rather than the number of words contained in the specification), the parties have each achieved a roughly equal measure of success. Therefore, I order each side to bear its own costs.

Dated this 26th day of July 2017

**Judi Pike
For the Registrar,
the Comptroller-General**