O-590-18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3134054
BY RICHMOND TOYS LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS

&

IN CLASS 28
AND

IN THE MATTER OF OPPOSITION
THERETO UNDER No. 406429 BY
APPLE INC.

BACKGROUND

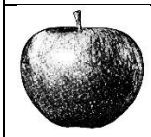
1) On 30 October 2015, Richmond Toys Limited (hereinafter the applicant) applied to register the series of two trade mark shown on the front cover in respect of the following goods in Class 28: Accessories for dolls; Baby playthings; Baby rattles; Bath toys; Bathing floats; Bathtub toys; Battery operated remote controlled toy vehicles; Building blocks [toys]; Building bricks [toys]; Children's playthings; Children's toys; Stuffed puppets; Stuffed toy bears; Stuffed toys; Tops (Spinning -) [toys];Toy aeroplane launching devices; Toy aeroplanes; Toy air vehicles; Toy aircraft; Toy airplanes; Toy animals; Toy bakeware; Toy bakeware and toy cookware; Toy blocks; Toy boats; Toy cars; Toy cookware; Toy food; Toy tool sets; Toy tools; Toy trucks; Toys; Toys for babies; Toys for infants; Toys incorporating money boxes; Wooden toy building blocks; wooden train sets; Dolls; Dolls' beds; Dolls' clothes; Dolls clothing; Dolls' clothing; Dolls' clothing accessories; Dolls' feeding bottles; Dolls for playing; Dolls' houses; Dolls' rooms; Fabric toys; Fancy dress outfits being children's playthings; Feeding bottles (Dolls' -); Fluffy toys; Furniture for dolls' houses; Hand puppets; Infant development toys; Infant toys; Infants' action crib toys; Infants' swing seats; Infants' swings; Inflatable toys; Jewellery for dolls; Jigsaw puzzles; Jigsaws; Multiple activity toys for babies; Pet toys; Play mats containing infant toys; Play mats for use with toy vehicles; Play motor cars; Play shops; Pull toys; Puppets; Push toys; Rag dolls; Rocking horses; Rocking horses on metal frames; Rocking toys; Scale model aeroplanes; Scale model airplanes; Scale model cars [playthings]; Scale model cars [toys]; Scale model kits [toys]; Scale model vehicles; model vehicles [playthings]; Scale model vehicles [toys]; Scale-model vehicles; Soap bubbles [toys]; Soft sculpture toys; Soft toys; Soft toys in the form of animals; Spinning tops [toys]; Stuffed animals [toys]; Stuffed bean-filled toys; Stuffed dolls;.

2) The application was examined and accepted, and subsequently published for opposition purposes on 15 January 2016 in Trade Marks Journal No.2016/003.

3) On 14 April 2016 Apple Inc. (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
APPLE	EU 9783978	03.03.11 20.10.13	28	Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; playing cards; electronic hand-held game

				units; musical toys, games and playthings; toy audio apparatus; toy musical boxes; toy musical instruments; toy record players for playing tunes and cassettes; musical games; battery operated toys; electronic toys; electric computer games, other than those adapted for use with television receivers; electrical and electronic amusement apparatus (automatic, coin/counter freed); electronic games being automatic, coin-freed or counter-freed (other than those adapted for use with television receivers); hand-held electronic games and apparatus (other than those adapted for use with television receiver only); video games other than those adapted for use with television receivers only; automatic and coin-operated amusement machines; computer game apparatus other than coin operated or those adapted for use with television receivers; video output toys and games; electronically operated toys; interactive computer toys and games; musical toys and games; stand alone video game machines incorporating a means of display; toy handheld electronic devices; toy computers (not working); toy mobile telephones (not working); parts and fittings for all the aforesaid goods.
	EU 9784299	03.03.11 30.03.12	28	Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; playing cards; electronic hand-held game units; musical toys, games and playthings; toy audio apparatus; toy musical boxes; toy musical instruments; toy record players for playing tunes and cassettes; musical games; battery operated toys; electronic toys; electric computer games, other than those adapted for use with television receivers; electrical and electronic amusement apparatus (automatic, coin/counter freed); electronic games being automatic, coin-freed or counter-freed (other than those adapted for use with television receivers); hand-held electronic games and apparatus (other than those adapted for use with television receiver only); video games other than those adapted for use with television receivers only; automatic and coin-operated amusement machines; computer game apparatus other

				than coin operated or those adapted for use with television receivers; video output toys and games; electronically operated toys; interactive computer toys and games; musical toys and games; stand alone video game machines incorporating a means of display; toy handheld electronic devices; toy computers (not working); toy mobile telephones (not working); parts and fittings for all the aforesaid goods.
	EU 9805631	11.03.11 05.03.12	28	Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; playing cards; electronic hand-held game units; musical toys, games and playthings; toy audio apparatus; toy musical boxes; toy musical instruments; toy record players for playing tunes and cassettes; musical games; battery operated toys; electronic toys; electric computer games, other than those adapted for use with television receivers; electrical and electronic amusement apparatus (automatic, coin/counter freed); electronic games being automatic, coin-freed or counter-freed (other than those adapted for use with television receivers); hand-held electronic games and apparatus (other than those adapted for use with television receiver only); video games other than those adapted for use with television receivers only; automatic and coin-operated amusement machines; computer game apparatus other than coin operated or those adapted for use with television receivers; video output toys and games; electronically operated toys; interactive computer toys and games; musical toys and games; stand alone video game machines incorporating a means of display; toy handheld electronic devices; toy computers (not working); toy mobile telephones (not working); parts and fittings for all the aforesaid goods.,
	EU 9805763	11.03.11 28.03.12	28	Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; playing cards; electronic hand-held game units; musical toys, games and playthings; toy audio apparatus; toy musical boxes; toy musical instruments; toy record players for playing tunes and cassettes;

				musical games; battery operated toys; electronic toys; electric computer games, other than those adapted for use with television receivers; electrical and electronic amusement apparatus (automatic, coin/counter freed); electronic games being automatic, coin-freed or counter-freed (other than those adapted for use with television receivers); hand-held electronic games and apparatus (other than those adapted for use with television receiver only); video games other than those adapted for use with television receivers only; automatic and coin-operated amusement machines; computer game apparatus other than coin operated or those adapted for use with television receivers; video output toys and games; electronically operated toys; interactive computer toys and games; musical toys and games; stand alone video game machines incorporating a means of display; toy handheld electronic devices; toy computers (not working); toy mobile telephones (not working); playing cards; electronic hand-held game units; musical toys, games and playthings; toy audio apparatus; toy musical boxes; toy musical instruments; toy record players for playing tunes and cassettes; battery operated toys; electronic toys; electric computer games, other than those adapted for use with television receivers; electrical and electronic amusement apparatus (automatic, coin/counter freed); video games other than those adapted for use with television receivers only; computer game apparatus other than coin operated or those adapted for use with television receivers; video output toys and games; electronically operated toys; interactive computer toys and games; stand-alone video game machines incorporating a means of display; toy computers (not working); toy mobile telephones (not working); Christmas crackers (bonbons); dolls; toy and novelty face masks; novelties in the form of souvenirs; snow glass balls; computer games apparatus, electronic games apparatus and video games apparatus, not included in other classes; board games; toy vehicles; seasonal ornamentation; balloons; parlour games; jigsaw puzzles;

				skateboards; ice skates; balls; baseball gloves; action figures and accessories to the action figures; card games; dolls' clothing and accessories not included in other classes, all for use with dolls; apparatus for projecting game balls; pinball game machines (toys); pool tables and cues, racks and balls; hockey games; toboggans and sledges; inflatable toy pools; inflatable balls, figures and mattresses, all for recreational use; remote controlled toy vehicles; toy robots being transformable; playtrays for young children; computer controlled exercise apparatus, other than for therapeutic use; stuffed toy animals, toy banks, model kits, rocking horses, darts, dartboards, toy trucks, electronically operated toy vehicles, bicycling pads, ride-on toy vehicles, scale model vehicles, trains, and air planes, model trains, model kits of vehicles, inflatable toys, doll clothes, and other toys and dolls, billiard tables, billiard balls, billiard cues and other billiard equipment, snow sleds, aerial discs, balls for games, weight lifting belts and other sporting and gymnastic implements, darts, parlor games, die cast models, golf balls, golf tees, golf ball markers, toy building blocks, toy boxes, computer game programs, lottery tickets, flying discs, puzzles, dog toys, cat toys, rocking horses, pinball machines, fishing rods and tackle; drones [toys]; game consoles; protective films adapted for screens for portable games; toys; portable games with liquid crystal displays; body-building apparatus; body rehabilitation apparatus; body-training apparatus; chest expanders [exercisers]; controllers for game consoles; controllers for toys; weight lifting belts [sports articles]; parts and fittings for all the aforesaid goods.

4) The grounds of opposition are in summary:

a) the opponent contends that the mark applied for and its marks are similar and that all the goods applied for in class 28 are identical and/or similar. As such it contends that the application offends against Section 5(2)(b) of the Act.

b) The opponent contends that it has a reputation under its mark in respect of cutting edge goods and as such use of the mark in suit upon goods applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark. The opponent has invested in creating its reputation which the applicant is attempting to free-ride upon. Use of the mark in suit could tarnish the earlier mark, as well as dilute its capacity to distinguish the opponent's goods.

c) The opponent claims that it has goodwill and reputation in the signs contained within marks 9783978 and 9784299 and that use of the mark in suit will result in misrepresentation which would harm the opponent's reputation and so offends against section 5(4)(a) of the Act.

d) The opponent also relies upon section 56 although it is not clear how this improves its case.

4) On 23 November 2017 the applicant filed a counterstatement, subsequently amended, which basically denied all the grounds pleaded. The applicant did not request proof of use (pou). The applicant did acknowledge that the opponent had a reputation for cutting edge electronic goods when it stated: "Apple Inc. states in point one of the statement that they are a world renowned computer and consumer electronics company etc. We totally agree with this,,"

5) Both parties filed evidence and both seek an award of costs in their favour. Neither side wished to be heard but both provided written submissions which I shall refer to as and when necessary.

DECISION

6) The first ground of opposition is under 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."

7) 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."

8) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier filed trade marks. The interplay between the date of the instant mark being published (15 January 2016) and the opponent's marks being registered (5 March 2012, 28 March 2012, 30 March 2012 and 20 October 2013) means that the pou requirements do not bite.

9) When considering the issue under section 5(2)(a) 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 process

10) 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.

11) The applicant's goods in class 28 can be, broadly summed up, as traditional toys as opposed to the opponent's goods of (broadly) games, toys and playthings. The average consumer for such goods will be the public at large. Such goods will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial selection is therefore primarily visual. I accept that more expensive items may be researched or discussed with a member of staff. The latter, along with personal recommendations, bring aural considerations into play.

12) Clearly, the average consumer's level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items such as a toy car the average consumer will pay attention to considerations such as whether it is age appropriate, whether it is produced to meet safety standards, whether the child will be allergic to the toy. **Overall the average consumer for these types of goods is likely to pay an average degree of attention to the selection of such goods.**

Comparison of goods

13) To my mind the opponent's strongest case under this ground is its mark EU 9783978. I shall therefore conduct the comparison tests using this mark. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

"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".

14) Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.

15) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 Vedial V OHIM France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

17) The specifications of both sides are reproduced below for ease of reference:

Opponent's goods	Applicant's goods
Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; playing cards; electronic hand-held game units; musical toys, games and playthings; toy audio apparatus; toy musical boxes; toy musical instruments; toy record players for playing tunes and cassettes; musical games; battery operated toys; electronic toys; electric computer games, other than those adapted for use with television receivers; electrical and electronic amusement apparatus	Accessories for dolls; Baby playthings; Baby rattles; Bath toys; Bathing floats; Bathtub toys; Battery operated remote controlled toy vehicles; Building blocks [toys]; Building bricks [toys]; Children's playthings; Children's toys; Stuffed puppets; Stuffed toy bears; Stuffed toys; Tops (Spinning -) [toys];Toy aeroplane launching devices; Toy aeroplanes; Toy air vehicles; Toy aircraft; Toy airplanes; Toy animals; Toy bakeware; Toy bakeware and toy cookware; Toy blocks; Toy boats; Toy cars; Toy cookware; Toy food; Toy tool sets; Toy tools; Toy trucks; Toys; Toys for babies; Toys for infants; Toys incorporating money boxes; Wooden toy building blocks; wooden train sets;

(automatic, coin/counter freed); electronic games being automatic, coin-freed or counter-freed (other than those adapted for use with television receivers); hand-held electronic games and apparatus (other than those adapted for use with television receiver only); video games other than those adapted for use with television receivers only; automatic and coin-operated amusement machines; computer game apparatus other than coin operated or those adapted for use with television receivers; video output toys and games; electronically operated toys; interactive computer toys and games; musical toys and games; stand alone video game machines incorporating a means of display; toy handheld electronic devices; toy computers (not working); toy mobile telephones (not working); parts and fittings for all the aforesaid goods.	Dolls; Dolls' beds; Dolls' clothes; Dolls clothing; Dolls' clothing; Dolls' clothing accessories; Dolls' feeding bottles; Dolls for playing; Dolls' houses; Dolls' rooms; Fabric toys; Fancy dress outfits being children's playthings; Feeding bottles (Dolls' -); Fluffy toys; Furniture for dolls' houses; Hand puppets; Infant development toys; Infant toys; Infants' action crib toys; Infants' swing seats; Infants' swings; Inflatable toys; Jewellery for dolls; Jigsaw puzzles; Jigsaws; Multiple activity toys for babies; Pet toys; Play mats containing infant toys; Play mats for use with toy vehicles; Play motor cars; Play shops; Pull toys; Puppets; Push toys; Rag dolls; Rocking horses; Rocking horses on metal frames; Rocking toys; Scale model aeroplanes; Scale model airplanes; Scale model cars [playthings]; Scale model cars [toys]; Scale model kits [toys]; Scale model vehicles; model vehicles [playthings]; Scale model vehicles [toys]; Scale-model vehicles; Soap bubbles [toys]; Soft sculpture toys; Soft toys; Soft toys in the form of animals; Spinning tops [toys]; Stuffed animals [toys]; Stuffed bean-filled toys; Stuffed dolls;.

18) The terms “Games and playthings” and “toys” included in the opponent’s specification encompasses the entirety of the applicant’s specification as per *Meric* (see paragraph 16 above). **The specifications must therefore be regarded as identical.**

Comparison of trade marks

19) 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."

20) The marks of the two parties are as follows:

Applicant's marks	Opponent's mark
 	EU 9783978: **APPLE**

21) The marks of the two parties both share exactly the same first element, the word "Apple". The fact that one is in lower case does not affect the outcome. The applicant's marks then both have a second element in the word "TOYS" where the letter "O" is replaced by the image of an apple. Clearly, when used upon class 28 goods the word "toys" would simply be viewed as a descriptive element, and the device element merely reinforces the word "Apple" as the distinctive and dominant element in the marks.

22) In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

> “81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.
>
> 82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.
>
> 83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.”

23) Visually there are differences but also similarities such that the marks are similar to a high degree. Phonetically, the beginnings of the marks are identical the only difference being the marks in suit have a second element which describes the actual goods. The marks are phonetically similar to a high degree. In terms of conceptual meaning, the word APPLE is a well-known dictionary word with a clear meaning. The additional aspects of the marks in suit do not alter the initial conceptual image. The marks must be regarded as having a high degree of conceptual similarity. **Overall, the marks are similar at a high degree.**

Distinctive character of the earlier trade mark

24) 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)."

25) The word "APPLE" has no meaning for the class 28 goods (toys and playthings). Despite the applicant accepting in its counterstatement that the opponent had reputation with regard to electronics, the opponent also filed evidence which it claimed showed its use of its marks in respect of games. However, these were electronic games which can only be played upon the opponent's computers, phones and tablets. The mark "Apple" is clearly inherently distinctive to an average degree in respect of class 28 goods and the evidence filed is not sufficient to persuade me that the opponent's mark should enjoy enhanced distinctiveness. **I find that the opponent's mark has an average degree of inherent distinctiveness but cannot benefit from enhanced distinctiveness through use.**

Likelihood of confusion

26) 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, who will select the goods by predominantly visual means, although not discounting aural considerations, and that they will pay at least an average degree of attention to the selection of such goods.

- the opponent's mark (EU 9783978) has an average degree of inherent distinctiveness, but cannot benefit from an enhanced distinctiveness through use.

- The marks are similar to a high degree.

- The class 28 goods of the two parties are identical.

40) Taking all of the above into account there is a likelihood of consumers being confused into believing that the class 28 goods applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) in respect of these goods succeeds.**

CONCLUSION

41) The opposition under Section 5(2)(b) was successful in relation to all the goods in class 28. As this earlier trade mark leads to the opposition being successful in its entirety, there is no need to consider the remaining trade marks upon which the opposition is based. Further, my determination is so clear cut under this ground there is no need to consider the remaining grounds as they do not materially improve the opponent's position.

COSTS

42) As the opponent has been successful it is entitled to a contribution towards its costs. I have however taken into account that the witness statement of Mr La Perle and its exhibits was clearly not specially prepared for this case but was clearly one which was “on the shelf” and merely amended in terms of numbers and main details and copied for the purposes of this case.

Expenses	£200
Preparing a statement and considering the other side’s statement	£300
Preparing evidence & filing written submissions	£200
TOTAL	£700

44) I order Richmond Toys Limited to pay Apple Inc. the sum of £700. 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 24th day of September 2018

George W Salthouse
For the Registrar,
the Comptroller-General