

**O/0077/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**APPLICATION NO. 3651209**

**IN THE NAME OF DOOSAN MACHINE TOOLS CO. LTD**

**TO REGISTER**

**PUMA**

**AS A UK TRADE MARK FOR GOODS IN CLASS 7**

**AND**

**OPPOSITION THERETO UNDER No. 428006 BY PUMA SE**

## BACKGROUND AND PLEADINGS

1. On 4 June 2021, Doosan Machine Tools Co. Ltd.

**PUMA**

**Class 7:** *Lathes; CNC (computer numerical control) lathes; machining centers; turning center; electric discharge machine*

2. The Application was filed pursuant to the Withdrawal Agreement between the United Kingdom and the European Union and claims a priority date of 27 November 2012 from European Union trade mark number 11376209.
3. The Application was published for opposition purposes on 6 August 2021. On 8 November 2021, Puma SE (“**the Opponent**”) filed a notice of opposition. The Opposition was based originally on three grounds under the Trade Marks Act 1994 (“**the Act**”), namely: section 5(2)(b), section 5(3) and section 5(4)(a). The original claims included reliance on three UK trade marks: No. 779443 and No. 874725 (the word mark PUMA covering clothing and shoes in Class 25); and No. 1284274 (for the same word, lightly stylised, for goods in Class 9 that included clothing, shoes, spectacles and protective face shields for workers). The opposition also relied on one international registration designating the UK in respect of the figurative mark shown below, which is registered for various goods in Class 9 as set out in **Annex 1** at the end of this decision.



(IR No. 582886)

**Designation date:** 2 July 2008

**Date of protection of the international registration in UK:** 30 July 2009

4. The three UK trade marks had been registered for several decades and were subject to proof of use. For its section 5(2)(b) claims, Puma had relied upon IR No. 582886 and UK trade mark No. 1284274 – i.e. those trade marks that are registered for goods in Class 9.

5. The Applicant filed a Form TM8 notice of defence, which included a 3-page counterstatement denying the claims under each of the three original grounds. Matters proceeded to the evidence rounds: the Opponent filed evidence in chief; the Applicant's legal representatives then filed around 20 pages of written submissions, including critical analysis of the evidence filed by the Opponent (particularly around proof of use and reputation) and challenging the claimed similarity of goods. The evidence rounds ended and the Opponent requested an oral hearing. The registry set a date of 12 October 2022 for the hearing, but on 5 September 2022 the Applicant requested to reschedule the hearing to 9 November 2022 (a date agreed with the Opponent), and also requested leave to cross-examine one of the Opponent's witnesses, and that the hearing should take place in person, in London. On 7 September 2022, the Opponent's representatives reported that the Opponent wished to withdraw all of its filed evidence and to reduce the pleaded opposition case, including removal of the claims under sections 5(3) and 5(4)(a) of the Act. On 8 September 2022, the registry agreed to the reduction request and withdrawal of the evidence and accepted an amended Form TM7 and statement of grounds which showed what parts of the originally filed claims had been deleted.
6. Consequently, by the time of the oral hearing, the opposition claims rested only on grounds under section 5(2)(b) of the Act, relying only on one earlier trade mark, namely the IR 582886.
7. The amended statement of grounds included the following, where it marked its deletions in red:

**Opposition based on section 5(2)(b) - likelihood of confusion**

5. The Opponent submits that the marks covered by the UK designation of IR no. 582886 ~~and UK registration no. 1284274 are~~ is highly similar to the Application and protects similar goods which, accordingly, leads to a likelihood of confusion on the part of the relevant public.

The Marks

6. The Opponent's marks set out in paragraph 5 contain the word PUMA ~~in isolation or~~ together with a puma device. The Application consists of the word PUMA in a simple typeface. The Opponent therefore submits that the marks are highly similar.

### The Goods

7. The goods covered by the Application consist of “*Lathes; CNC (computer numerical control) lathes; machining centers; turning center; electric discharge machine*”. The goods covered by the Opponent’s marks set out in paragraph 5 are safety and protective clothing, ~~footwear and headgear and~~ measuring devices, apparatus and instruments. The goods are sold through the same trade channels, have the same customer base, are complimentary and originate from the same undertakings.

### Likelihood of confusion.

8. As a result of the high degree of similarity between the marks and the similarity between the goods, the Applicant’s use of the Application will result in a likelihood of confusion on the part of the public, which includes a likelihood of association, Customers of the Applicant and members of the public will be confused into believing that the goods provided under the Application originate from the Opponent, or that the Applicant is somehow associated with the Opponent.

### **Applicant’s defence**

8. The 8 September 2022 email from the registry to the parties, which accepted the changes to reduce the scope of the Opponent’s claims, noted that the Applicant in its Form TM8 counterstatement (paragraphs 4 – 6) denies the similarity of the goods at issue in the remaining section 5(2)(b). The Applicant also contests the similarity of the goods at paragraph 19 of its submissions, dated 13 July 2022, filed during the evidence rounds. The registry stated that it would be content to regard as deleted the elements of the counterstatement and submissions that relate to the grounds no longer relied on. Neither party raised any objection to that approach.

### **The hearing and representation**

9. An oral hearing of the opposition was held before me by video conference on 9 November 2022. Daniel Bailey, an attorney at the law firm Appleyard Lees IP LLP, attended the hearing for the Opponent.. Michael Edenborough KC, instructed by Dehns, attended the hearing as counsel for the Applicant. Both sides filed a skeleton argument in advance of the hearing. I have read all the papers filed and refer to their contents where I consider it warranted to do so.

## DECISION

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

*“... 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.”*

### Status and use of IR 582886

11. IR 582886 has been protected in the UK since 2009, and its date of application for registration predates that of the Application (even taking account of the latter’s November 2012 priority date). IR 582886 thus falls within the meaning of an “earlier trade mark”, as defined in section 6(1)(a) of the Act. IR 582886 had been protected in the UK for over a decade when the Applicant filed the Application in the UK. However, since the 2012 date of the priority claimed for the Application is less than five years after the registration procedure for IR 582886 (“**the earlier trade mark**”) was completed in 2009, the use provisions under section 6A of the Act are not engaged.<sup>1</sup>

### Case law principles

12. The principles to be borne in mind when considering section 5(2)(b) of the Act are well established and derive from the following decisions of the Court of Justice of the European Union (“the CJEU”):

*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

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<sup>1</sup> The application was filed pursuant to article 59 of the Withdrawal Agreement because the registration of the EUTM from which it claims priority was still pending at the end of the transition period (23:00 on 31 December 2021) – hence the priority date extends as far back as 2012 for what appears to be a new application.

13. The principles are that:
- (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.

### **Comparison of the marks**



14. The first requirement in section 5(2)(b) is that the contested mark must be similar to the earlier mark. In the present case, the Applicant admits in its counterstatement that the parties' marks are similar.<sup>2</sup> However, it is still relevant to determine the nature and level of similarity.
15. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.<sup>3</sup> 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 (CJEU) stated in *Bimbo*<sup>4</sup> 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."*
16. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown in the following table:

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2 Paragraph 4 of its counterstatement.

3 *Sabel BV v Puma AG*, Case C-251/95

4 *Bimbo SA v OHIM*, Case C-591/12P (paragraph 34)

<p><b>The Opponent's earlier registered mark:</b></p>	
<p><b>The Applicant's contested trade mark:</b></p>	

17. The Opponent's position is that the marks are highly similar. The Opponent submits that its earlier mark consists of the word PUMA in a simple block typeface together with a puma device, and that the contested mark consists of the word PUMA in a simple block typeface. The Opponent then submits that accordingly, the marks are phonetically identical and visually and conceptually highly similar.
18. I find that the marks are identical in their verbal element "PUMA", and the differences between the light stylisations of that word in the respective marks (one squatter than the other) is far from remarkable and may be considered negligible. On the other hand, the leaping cat device is clearly far from negligible: it is a prominent and distinctive aspect of the Opponent's earlier mark and plays a significant role in the overall impression of that mark. However, in my view, the word element remains more dominant in the overall impression of the Opponent's earlier mark on account of the following considerations: (i) its central position in the mark (ii) the tendency of consumers more readily to recall brands by their names, more so than by devices and (iii) that the word PUMA informs the average consumer about the leaping cat – i.e. that it is a puma, as opposed to a panther, jaguar or other type of cat.
19. Since the device will not be voiced, the marks are indeed aurally identical. The leaping cat device constitutes a notable visual difference, but the level of visual similarity is higher than medium given that the marks share the (practically) identical distinctive and dominant word element. While the applied-for mark does not have the concept of a leaping cat, that concept is subordinate to the basic concept shared by the marks – the idea of a puma; there is a high degree of conceptual similarity. I find that the marks may be considered highly similar overall, certainly similar to a higher than medium degree.



## Comparison of goods

20. The second requirement in section 5(2)(b) is that the goods must be identical or similar. In the present case, the parties' goods are not identical and the Applicant denies that they are similar.

21. The Applicant's Goods are the following goods in Class 7:

*Lathes; CNC (computer numerical control) lathes; machining centers; turning center; electric discharge machine*

22. The Form TM7 (Notice of opposition) filed by the Opponent, indicated by its ticked response to Q1 under Section A, that it sought to rely on all goods covered by its earlier trade mark. The full specification of the earlier trade mark (IR No. 582886) is set out in Annex 1 at the end of this decision. The list of goods specified there is relatively extensive; however, in the Opponent's amended statement of grounds (which I have set out at my paragraph 7 above), the Opponent states its case based on the similarity claimed to exist between the Applicant's goods and the following goods under its earlier mark, namely "*safety and protective clothing, measuring devices, apparatus and instruments.*" Likewise, the Opponent's skeleton argument refers to the following goods under its earlier mark as being similar to the Applicant's Goods: "*... in particular, protective clothing, measuring devices, apparatus and instruments (the Opponent's Goods).*" I have highlighted those goods by underlining the corresponding terms in the specification set out at Annex 1. At the hearing, Mr Bailey gave oral argument around the similarity between the Applicant's Goods and protective clothing and measuring instruments. I asked Mr Bailey whether he could confirm that the Opponent's claimed similarity of goods rested on the goods that he addressed at the hearing and as set out above. Mr Bailey confirmed that to be the case. In the circumstances, my comparison of the goods is only between the following goods:

<b>The Applicant's Goods</b>
<b>Class 7:</b> <i>Lathes; CNC (computer numerical control) lathes; machining centers; turning center; electric discharge machine</i>

**Opponent's goods**

**Class 9:** *clothing for protection against accidents; measuring apparatus and instruments*

23. In considering whether goods are similar, I note the following points:

Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

- (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.
- (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

24. All relevant factors relating to the goods should be taken into account, which include, inter alia:<sup>5</sup>

- the physical nature of the goods or acts of service;
- their intended purpose;
- their method of use / uses;
- who the users of the goods and services are;
- the trade channels through which the goods or services reach the market;
- in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

<sup>5</sup> See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case.

- whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors)

or

- whether they are complementary to each other. Complementary signifying that *“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”*.<sup>6</sup> I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.<sup>7</sup>

25. When interpreting the terms in a specification I bear in mind:

- (i) that it is *“necessary to focus on the core of what is described..”* and that *“... trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise”*, although *“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”*;<sup>8</sup>
- (ii) where *“the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services”*;<sup>9</sup>
- (iii) the following applicable principles of interpretation:

*“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*

*(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

<sup>6</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

<sup>7</sup> *Kurt Hesse v OHIM*, Case C-50/15 P

<sup>8</sup> *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

<sup>9</sup> *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

(3) *An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

(4) *A term which cannot be interpreted is to be disregarded.*<sup>10</sup>

### **The Applicant's Goods:**

26. On a quick search of the internet for a description of what is a *lathe*, I note that it is a powered machine tool that rotates a workpiece about an axis of rotation to perform various operations such as spraying or cutting, sanding, drilling, and turning, with tools that are applied to the workpiece to create an object with symmetry about that axis. Lathes are used for instance in woodturning, metalworking and glass-working. This matches both my own understanding of those goods and the submission by the Opponent in its skeleton argument that the Applicant's Goods "are tools for cutting, shaping and machining wood, metal and other materials."
27. Although not addressed in the papers or at the hearing, I understand – again from consulting Google - that a *machining center* is a computer-controlled machine tool that can perform different operations like milling, boring, and drilling, quickly and accurately. It consists of an automatic tool-changing mechanism that enables it to use multiple cutting tools during the machining process. Google also informs me that *turning centers* and lathe machinery look much the same, but the terms usually refer to slightly different machine tools. Lathes can usually only turn on two axes, while turning centers can be more advanced. I learn (from Wikipedia) that *electrical discharge machining* is also known as spark machining, spark eroding, wire burning or wire erosion. It is a metal fabrication process whereby a desired shape is obtained by using electrical discharges (sparks) to remove material from the work piece by a series of rapidly recurring current discharges between two electrodes.
28. All of this aligns with the Opponent's general description of the Applicant's Goods and with Mr Edenborough's references at the oral hearing to the Applicant's Goods being central to a fabrication technique that removes layers of material to create the desired shape - a subtractive manufacturing process.

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10 See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms).

### **The Opponent's submissions on similarity**

29. The Opponent's skeleton argument in relation to the comparison of the respective goods is that the Applicant's Goods are similar to the Opponent's Goods "*in particular, protective clothing, measuring devices, apparatus and instruments*". Its argument in support of that position is developed in the following terms:

"12. There is a close connection between the goods, in the sense that the Opponent's Goods are indispensable to the correct usage of the Opposed Goods. Due to the potentially dangerous nature of the Opposed Goods, users of those goods would wear safety clothing and equipment when they are operating them.

Furthermore, the Opponent's Goods are for cutting, shaping and machining wood, metal and other materials, accordingly, the users of the Opponent's Goods would use measuring devices, apparatus and instruments, whilst operating the Opposed Goods to ensure the size, shape, and tolerances are accurate. Accordingly, the Opponent's Goods will be in very close proximity to the Opposed Goods when they are in use.

13. The Opposed Goods are used to make, inter alia, common everyday items ranging from bowls and boxes to components for engines. In both circumstances, the users of the Opposed Goods will use the Opponent's Goods, in particular, items such as spring or electronic sliding calipers (measuring instruments), to ensure that they are the correct size.

14. The Opponent's Goods have the same users and would be distributed via the same trade channels as the Opposed Goods. The relevant goods would be made by the same manufacturers and sold via the same general and specialist hardware stores, and they would be sold in close proximity to each other."

### **The Applicant's submissions on similarity**

30. Whether, or to what degree, there may be said to be similarity between the goods is an issue of particular significance in determining the present opposition. As such, I consider it warranted to detail points made in Mr Edenborough's skeleton argument. He states firstly that it is not self-evident that the goods are similar. I agree. Mr Edenborough referred me to the view of Mr Hobbs KC, sitting as an Appointed Person in the case of Raleigh International Trade Mark [2001] RPC 11:

“20. If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their "similarity" (whether or not the objection is directed to the use of an identical mark): Canon paragraph 22. Paragraph 23 of the judgment in Canon indicates that it is appropriate to consider the pattern of trade with reference to factors such as those (uses, users and physical nature of the relevant goods and services; channels of distribution, position in retail outlets, competitive leanings and market segmentation) identified by Jacob J. in *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RP.C. 281 at 296, 297.”

31. Mr Edenborough described as “hollow assertion” the Opponent’s claimed similarity of goods, and noted that the Opponent adduced no evidence to support its allegations that the respective goods are sold through the same trade channels, have the same customer base, are complementary and originate from the same undertakings. It ought to have been straightforward for the Opponent to file evidence to substantiate its claims. I agree. This is significant not only because the goods are not self-evidentially similar, but also because the Opponent had been put on notice that the Applicant denied the claimed similarity (for instance in the submissions filed during the evidence rounds).
32. At the hearing Mr Bailey invited me to consider, for instance, a consumer visiting a store such as *B&Q* or *Homebase* in order to buy a lathe, perhaps as a hobbyist wood-worker. Conscious of the risk of injury in operating machinery, the consumer might, Mr Bailey submitted, seek also to buy protective clothing and may also purchase calipers to assist with accurate measuring and that such goods would “be sold in close proximity to” the lathes. Firstly, I am not satisfied that the respective goods are sold on shelves alongside one another (as the case law anticipates). If that were so, then it would have been straightforward to show that in evidence. Secondly, a hardware store might sell a wide range of goods – from drill bits to ladders and even bird seed to padlocks. It is not, in my view, a sufficient premise for finding of similarity that the goods may be sold in a hardware store. There is, anyway, no evidence on the point.
33. Moreover, there is no evidence on the necessity of wearing particular *clothing for protection against accidents* while operating a lathe or any of the other of the Applicant’s Goods. However, even proceeding on the basis that it may be sensible, or even in some cases required, to wear, for instance gloves, while using the Applicant’s Goods, there is no

evidence, nor can it be assumed that respective goods would be made by the same manufacturers. There is no evidence on trade channels at all – whether as to origin or market outlets. I do not accept therefore that the goods are complementary as described in case law, since even if protective clothing or measuring instruments were considered to be important for the use of the Applicant's Goods, I do not find that the connection between the goods is close such that customers would think that the responsibility for those goods lies with the same undertaking.

34. Likewise, it has not been shown in evidence that the goods have the same users. What is clear is that the goods are different in their physical nature, intended purposes and methods of use and do not compete with one another as alternative goods. These clear points strongly weigh against a finding of similarity. Coupled with the lack of evidence to substantiate the claimed similarity - despite there being no obvious or self-evident similarity, and despite that point having specifically been contested by the Applicant - **my primary conclusion is that the goods are not similar**. I should perhaps add that if, despite the apparent focus of the case argued at the hearing, the Opponent intended to rely upon any of the other goods set out at Annex 1, then its position is generally weaker, since most of the remaining goods are even more dissimilar to the Applicant's Goods. An exception to this may be *workmen's protective faceshields, protective eyewear and masks for worker*, included in the specification at Annex 1. These goods appear more or less on a par with the protective clothing goods (whose similarity I have considered). Moreover, not only were these goods not mentioned at the hearing, but I also note that "safety and protective headgear" is expressly deleted from the Opponent's amended statement of grounds.

35. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49. ... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover, I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

36. Since **my primary finding** is that the goods are not similar at all, there is no likelihood of

confusion to be considered; **the section 5(2)(b) opposition claim must fail** and it is redundant to consider the other usual aspects of such a claim (including, indeed the similarity of the marks). However, for the sake of completeness, I will consider the alternative position that there is a degree of similarity between the goods.

37. In my view, noting the absence of any relevant evidence, the strongest factor that could contribute to a finding of similarity in this case, would be the potential for shared users. I accept that a user of a lathe may need to check the measurement of the workpiece as its material is gradually removed; they may even wear items to protect parts of their body. Mr Edenborough argued against a finding of similarity simply because goods may be used together – he referred, if I recall correctly, to a work surface and lighting also being likely used with, but not being similar to a lathe. I also note the observation by Daniel Alexander Q.C. (as he then was), sitting as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

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

38. In my estimation - and purely as a notional position very much secondary to my primary finding that the goods are not similar – the most generous construction would afford the goods only a very low degree of similarity. The goods relied on by the Opponent are apt to be used by a vast range of users and in highly varied circumstances, so the potential factor of shared user is not a compelling one. However, on the premise that there is a degree of similarity between the goods, then the likelihood of confusion has to be considered and I shall continue to consider all the usual aspects of the ground.

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

39. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them. 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.<sup>11</sup> In *Hearst Holdings Inc*,<sup>12</sup> 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 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 word “average” denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median.”*

40. The Opponent’s *clothing for protection against accidents* are perhaps most likely to be used by those working on tasks that entail particular physical risks. This would likely be mainly business users, but there may be situations in which members of the general public at large may choose to purchase such goods – either as part of an ongoing hobby or for a particular DIY or maintenance task. The Opponent’s *measuring apparatus and instruments* would cover various goods from a sophisticated electronic device, to simple calipers or a tape measure. Dependent on the sophistication of those goods, the average consumer will be a business user or a member of the general public at large. The average consumer for the Applicant’s *CNC (computer numerical control) lathes; machining centers; turning center; electric discharge machine* will be a business concerned with manufacturing. The same average consumer would also arise in respect of *Lathes*, but I accept that there will be members of the general public who may also acquire a lathe for hobby purposes.
41. The purchasing process will entail the average consumer browsing the goods in physical retail outlets, or from images online or in a catalogue and where they will see the marks used as labelling or branding and in advertising. The purchase process is therefore a primarily visual one. Aural considerations may also play a limited part, such as on the basis of word-of-mouth recommendations, so I also take into account the aural impact of the marks in the assessment. However, case law suggests that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods.<sup>13</sup>
42. The respective goods will vary in price according to their sophistication, but in general the

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11 *Lloyd Schuhfabrik Meyer*, Case C-342/97

12 *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)

13 See for example paragraphs 68 and 69 of the ruling of the General Court in *Quelle AG v OHIM*, Case T-88/05.

Applicant's Goods are likely to be less expensive than the Opponent's Goods. In all cases the goods are likely to be purchased infrequently. In selecting and buying protective clothing, the average consumer will take account of factors such as finding approximately the right size and suitable material for the safety purpose applicable to their task. Choosing measuring instruments will reflect the size and shape of what is to be measured and the degree of accuracy required. Purchase of the Applicant's *CNC (computer numerical control) lathes; machining centers; turning center; electric discharge machine* will likely entail a good deal of careful consideration on the part of the average consumer. Likewise, even the Applicant's *Lathes* will involve a good degree of attention, even if the lathe is a simple one. The consumer will wish to ensure that it is suitable and adequate for their purposes and will be making the purchase only rarely, possibly just once.

43. In buying the Applicant's Goods, the level of attention will be high. In purchasing the Opponent's goods, the level of attention may be lower than that, factoring in that the goods may be as mundane as a tape measure or pair of gloves, but in general, given the safety aspect of the clothing and the infrequency of the purchases, and the potential for a measuring instrument to be sophisticated, the average consumer may be expected to exercise at least a medium degree of attention.

#### **Distinctive character of the earlier trade mark**

44. The distinctive character of the earlier mark must be considered. The more distinctive an earlier mark, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik*<sup>14</sup> 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 ...*

*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-*

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14 *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97  
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*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).”*

45. The distinctive character of a trade mark can be appraised only, first, by reference to the goods specified in the registration and, secondly, by reference to the way it is perceived by the relevant public.<sup>15</sup> Registered trade marks possess varying degrees of inherent distinctive character: perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. In the present case, the word PUMA is not an invented word, so is not of the highest distinctiveness, but nor does it allude to any characteristic of the Opponent's goods. The word aspect may therefore be considered to furnish at least a medium degree of distinctiveness to the earlier mark. The leaping cat device also contributes to the distinctiveness of the mark overall, such that the mark as a whole may be considered inherently distinctive to a high degree. There is no evidence that the earlier mark has ever been used in respect of the Opponent's Goods. There is therefore no enhancement to the distinctive character of the earlier mark through use.

### **Conclusion as to likelihood of confusion**

46. I now turn to reach a conclusion as to the likelihood of confusion if the parties' marks were used concurrently in respect of their respective goods. This requires a realistic appraisal of the net effect of the similarities and differences between the marks and the goods in issue, giving the similarities and differences as much or as little significance as the relevant average consumer would attach to them, noting that such a consumer is taken to be reasonably well-informed and reasonably observant and circumspect. I note that I have found that the average consumer in the present case will exercise at least a medium degree of attention in purchasing the goods (and a high degree for all of the Applicant's Goods).

47. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or

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15 *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91

related.

48. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of making a global assessment of all relevant factors in accordance with case law principles, especially those outlined at my paragraph 13 above.
49. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public,<sup>16</sup> occasional confusion by a small minority is not sufficient to find a likelihood of confusion. The relative weight of the factors is not laid down by law, but is a matter of judgment for the tribunal on the particular facts of each case.<sup>17</sup> The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person; it involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade and, it is often very difficult to make such prediction with confidence.<sup>18</sup>
50. The strongest factor weighing in favour of the Opponent's claim is the strong similarity between their marks – where I have found them aurally identical, visually similar to a higher than medium degree, and to share a clear common concept of a puma, and that overall the marks may be considered similar to a high degree.
51. While the earlier mark is high in distinctive character on its inherent characteristics, some of that distinctive character rests on the device element, which is not an element shared with the Applicant's contested trade mark. Nonetheless, the shared word aspect contributes at least a medium degree of distinctiveness to the earlier mark.
52. On the other hand, I have progressed to consider whether there is a likelihood of confusion only based on a secondary (alternative) finding allowing for a degree of similarity premised on shared users. However, even on this premise, any such similarity is in my view very low given the significant factors against similarity (nature, purpose, method of use, non-competitive, and not shown to be complementary nor to be sold alongside each other, nor to share manufacturers or channels of trade).
53. I also take into account that the marks are not identical, but differ in the absence / presence of the prominent and distinctive leaping cat device. Although visual considerations may be

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16 Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at §34

17 See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O-079-17, (*Rochester Trade Mark*).

18 Again see comments of Iain Purvis as the Appointed Person, *ibid*.

particularly influential in the purchasing act, and my primary finding is that the marks are visually similar to a higher than medium degree, the difference arising from the leaping cat device is not likely be overlooked and I anyway find that the similarity of the marks is not sufficient in a multifactorial assessment to offset a very low degree similarity in goods. Mr Edenborough highlighted a short extract from Canon paragraph 24: "the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion" (my emphasis). In the present case the Opponent has adduced no evidence that earlier mark has acquired a reputation or an enhanced distinctive character through use in respect of the goods relied on (or at all), which might potentially have been assisting factor to argue a greater likelihood of confusion.

54. No likelihood of confusion arises where a later mark merely calls to mind the earlier mark (mere association). As emphasised by James Mellor QC, sitting as the Appointed Person in *Eden Chocolat*<sup>19</sup>: "... it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element." It is also clear that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion" and that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.<sup>20</sup>
55. I find there is no likelihood of confusion, whether direct or indirect.

**OUTCOME:** The opposition is unsuccessful and subject to any successful appeal of this decision, trade mark application No. 3651209 may proceed to registration.

## **COSTS**

56. The Applicant has successfully defended the opposition and is entitled to a contribution towards its costs. Costs are usually based on the guidance in Tribunal Practice Notice 2/2016, but Mr Edenborough submitted that factors in the present case warranted an award departing from the usual scale of costs. Mr Edenborough's skeleton argument made the following points:

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<sup>19</sup> Case BL O-547-17 *Duebros Limited v Heirler Cenovis GmbH* (27 October 2017) at paragraph 81.4.

<sup>20</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16]

“17. The attack upon the credibility of the evidence was to demonstrate that the conclusions proposed in the statements of grounds were overstated beyond the normal bounds of stretching the facts to support one’s case. The fact that the purportedly probative value of the evidence was vastly overstated undermines the probity of the Opposition itself. The fact that all the evidence, not just that of Mr Bailey, was withdrawn so readily when the application for cross examination was made indicates that the evidence’s fundamental weaknesses were manifestly apparent to Puma and that there was no appetite to defend the indefensible.

18. This has two consequences, which are independent of each other.

19. First, and most obviously, all the time and effort expended by Doosan in considering the evidence that had been filed by Puma, along with the time and effort in considering and addressing the widely drafted Form TM7 and its associated SoG were wasted. The needlessness of the futile exercise was highlighted by the fact that, when pressed, Puma dropped all and any reliance upon the wider grounds of opposition and the evidence that purportedly supported those wider grounds. Thus, at a minimum, all the costs above and beyond what would have been expended if the Opposition had relied solely upon the single ‘886 mark and the single s. 5(2)(b) ground without any supporting evidence (i.e. alleging solely a pure paper conflict), ought to be recoverable by an off-the-scale award of costs.

20. It is always difficult to prove a hypothetical, however, it is submitted that a reasonably fair estimate of the wasted costs may be ascertained from considering the attached invoices, which all relate to the consideration of the now-withdrawn evidence. In particular (including edited commentary from the invoices):

20.1 Invoice 20 January 2022 – detailed assessment of opposition, preparing and filing counterstatement – £2,230

20.2 Invoice 26 April 2022 – noting and reviewing evidence filed by other side – £1,550

20.3 Invoice 29 July 2022 – conducting an in-depth review of evidence filed on behalf of PUMA £3,000.

20.4 Invoice 23 September 2022 – proposed cross-examination request,

withdrawal of grounds, off-the-scale costs – £2,405

21. While not everything specified on those four invoices relates directly to the extra work caused by the grounds and evidence that were eventually withdrawn, it is clear that the vast majority of the work detailed on those four invoices was wasted, and so ought in principle to be recoverable by Doosan.

22. Secondly, the probity of commencing the Opposition in the first place is put in grave doubt. Two of the three potential grounds were supported by spurious evidence that was abandoned at the first hint of criticism. The third ground, namely the s. 5(2)(b) ground that depends upon the identity or similarity of the goods in question, is patently flawed given the obvious dissimilarity between the relevant goods in this case. If an argument were to be advanced that was designed to show the similarity of the goods, as detailed above, then evidence would be needed to support that case, yet none was ever adduced (not even in the now-withdrawn evidence). A further aggravating factor is the apparent reliance upon all the goods in Annex 1, when the vast majority of them are even more dissimilar than those pleaded in the amended statement of grounds. Taken together, it is a reasonable inference that there was no bona fide belief that the Opposition was well founded; rather, it is, and always has been, extremely speculative, relying more upon bluster than any credible underlying substance. Commencing such ill-fated proceedings ought to be discouraged, as it wastes the time and effort of all concerned not least the IPO's, and so ought to be punished by an award of off the-scale costs in favour of the needlessly-vexed party in any event.

23. The justification for awarding off-the-scale costs is that the behaviour of which complaint is made was unreasonable. It is submitted that the filing and the withdrawing of the evidence and the commencement of speculative proceedings amount to unreasonable behaviour that merit an off-the-scale award of costs in favour of Doosan.”

57. Mr Bailey's position was that it was reasonable for the Opponent to have advanced claims based on an argued similarity of goods, particularly in light of the obvious similarity between the marks, and that the Opponent withdrew its evidence and significantly reduced its claims only to avoid the cost of cross-examination, being content to proceed with just the section 5(2)(b) claim and based only on IR No. 582886, removing the necessity for evidence of use.

58. I also note the following guidance from Tribunal Practice Notice (TPN 4/2007)

“TPN 2/2000 recognises that it is vital that the Comptroller has the ability to award costs off the scale, approaching full compensation, to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour. Whilst TPN 2/2000 provides some examples of unreasonable behaviour, which could lead to an off-scale award of costs, it acknowledges that it would be impossible to indicate all the circumstances in which a Hearing Officer could or should depart from the published scale of costs. The overriding factor was and remains that the Hearing Officer should act judicially in all the facts of a case. It is worth clarifying that just because a party has lost, this in itself is not indicative of unreasonable behaviour

6. TPN 2/2000 gives no guidance as to the basis on which the amount would be assessed to deal proportionately with unreasonable behaviour. In several cases since the publication of TPN 2/2000 Hearing Officers have stated that the amount should be commensurate with the extra expenditure a party has incurred as the result of unreasonable behaviour on the part of the other side. This "extra costs" principle is one which Hearing Officers will take into account in assessing costs in the face of unreasonable behaviour.

7. Any claim for cost approaching full compensation or for "extra costs" will need to be supported by a bill itemising the actual costs incurred.”

59. Having considered the parties’ submissions above, I am aware that I have not seen or dealt with the evidence previously filed but subsequently withdrawn. I therefore have no insight as to the merit, overstatement or otherwise of its content. It may well be that Mr Bailey simply wished to avoid the cost that may have arisen from cross-examination, had that request been allowed.
60. I am also aware that it is far from uncommon practice for claims before this tribunal to be made on grounds (such as sections 5(3) and 5(4)(a) in this case) that may have little hope of materially improving an Opponent’s prospect of success beyond what may or may not be achieved on the basis of a section 5(2)(b) ground. It is also quite common for claims to be made based on multiple earlier trade marks, where it is obvious that one of those offers the opponent its best case, such that success stands or falls based on that mark.
61. Similarly, there is, in some quarters, a poor habitual practice of alleging similarity based on all goods or services under an earlier trade mark where the claimed similarity in respect of some of those goods or services is not obvious or explained. (Tribunal Practice Notice



(1/2018) is in part a response to that issue; whether or not to intervene on such points at the pleadings stage is partly at the discretion and judgement of the caseworker; in the present case, there has been no casework intervention on the similarity of the goods.)

62. I can also see that it may in some circumstances not be unreasonable, when faced with the prospect of cross-examination, to re-evaluate whether it is necessary to pursue all claims (including those that depend vitally on evidence).
63. However, in the present case, the Applicant's counterstatement could not have been clearer in denial of the similarity of the respective goods and it expressly challenged the Opponent to prove the bases of claimed similarity – that the respective goods are sold through the same trade channels, have the same customer base, are complementary and originate from the same undertakings. Mr Edenborough submitted that the Opponent never filed any such evidence, and Mr Bailey did not contradict that submission.
64. It is clear that the Opponent has been obliged to expend needless effort, time and money in addressing matters that the Opponent has easily discarded ahead of a hearing or substantive decision. Factoring in the objections as I have discussed above, I agree that this is a case in which it would be just and fair to make in favour of the Applicant an award of costs that goes beyond the ordinary scale costs. While the Opponent might have conducted its case in a more efficient and focused way, I do not consider it to have been so unreasonably conducted as to warrant full reimbursement of the costs given in the invoices referenced above. I make my award of costs taking matters in the round, and account of tasks including considering the statement of grounds and preparing a counterstatement, responding to the evidence filed, requesting cross-examination and preparing for and attending the oral hearing requested by the Opponent.
65. I order Puma SE to pay Doosan Machine Tools Ltd the sum of **£6000** (six thousand pounds. This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order by the appellate tribunal).

**Dated this 25<sup>th</sup> day of January 2023**

*Matthew Williams*

**For the Registrar**

## Annex 1

### Full list of goods specified under the earlier trade mark - IR 582886

**Class 9:** *Physical, chemical, optical, photographic apparatus, devices and instruments (included in this class); measuring, signaling, monitoring, emergency and teaching apparatus and instruments, apparatus and instruments for recording, transmitting and reproducing sound and images; media with sound and/or image recording; magnetic recording media; sound recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, pocket calculators, data processing equipment and computers; fire extinguishers; measuring, signaling and regulating apparatus and devices used for measurements taken in sports medicine as well as for measurements taken during sports events; teaching apparatus and instruments used in the field of sports medicine; spectacles, spectacle lenses and spectacle frames, contact lenses, ergometric devices in the form stationary bicycles, stationary rowing machines, wrist ergometers, ergometers for use in weightlifting and ergometers for running tracks or belts, also with calculators or computers, contact and signaling devices in the form of indications and signs fashioned by means of a needle or by digital electronic indications, with input signal generators and memories, also with connections to different signal generators used in human medicine; calculators and ergometers used for processing signals from the aforesaid instruments and devices, with electronic chronometers, also with daily performance meters; pedometers particularly for verification and determination of runner performance, altimeters, odometers, measuring devices for geographical maps, anemometers, directional compasses, binoculars, telescopes; clothing for protection against accidents, including footwear, special clothing used for rescue, workmen's protective faceshields, protective eyewear and masks for workers; helmets, including protective helmets for motorcyclists and cyclists; special containers (covers, sheaths, cases) adapted to the apparatus and instruments included in this class; signaling whistles, including dog whistles; vehicle breakdown warning triangles; breathing apparatus for underwater swimming, swimming belts and floats for swimming; angle meters and protractors (measuring instruments); timers (time switches); entertainment apparatus as complementary apparatus for television receivers; bags used for storing photographic equipment and bags for photographic reporters (included in this class).*