

O-333-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2617125 BY  
MACALLY INTERNATIONAL CO., LTD TO REGISTER:**



**IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO. 103988 BY  
CASTORAMA FRANCE**

## BACKGROUND

1. On 10 April 2012, Macally International Co., Ltd (“the applicant”) applied to register the mark shown on the cover page of this decision. The application was published for opposition purposes on 20 July 2012 for a range of goods in class 9.

2. The application was opposed by Castorama France (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). As the opposition was only directed at certain goods in the application, the applicant elected to divide the application and the unopposed goods have now proceeded to registration under no. 3032053. The opposed goods are as follows:

Plugs, sockets and other contacts [electric connections]; Electric batteries.

3. The opponent relies upon the goods shown below in three International Registrations (“IR”) which designate the UK i.e.

(1) No. 810008 for the mark:



which designated the UK on 16 July 2003 (claiming an international convention priority date (from France) of 17 January 2003) with protection being conferred on 29 February 2004.

**Class 7** – Jack hammers; drills; screw-driving machines; grinding machines.

**Class 9** – Electric storage batteries; batteries.

(2) No. 776477 for the mark:

**MAC ALLISTER**

which designated the UK on 22 January 2002 (claiming an international convention priority date (from France) of 24 July 2001) with protection being conferred on 23 August 2002.

**Class 7** – Drilling hammers; drilling machines; screw-driving machines; grinding machines.

**Class 9** – Electric batteries; batteries.

(3) No. 799213 for the mark:

# MAC ALLISTER

which designated the UK on 24 January 2003 (claiming an international convention priority date (from France) of 5 August 2002) with protection being conferred on 7 September 2003.

**Class 9** – Photovoltaic cells and photocells.

4. Having claimed that the marks have been used upon all of the goods upon which it relies, in its Notice of opposition, the opponent states:

“The marks bear strong visual, phonetic and conceptual similarities. The first six letters in each mark are identical (MACALL). The marks both start with the prefix MAC followed by the two syllables ALLI/ALLY which are phonetically identical and the only difference between the signs is the end syllable STER in the earlier mark.

The goods designated in the contested application are identical or similar to those covered by the earlier mark...”

5. The applicant filed a counterstatement in which it denies that the opponent’s marks are similar to its own and puts the opponent to proof of use in relation to the goods upon which it bases its opposition. In relation to the competing goods at issue, the applicant admits that “Electric batteries” in its specification are identical to the goods in class 9 of nos. 776477 and 810008. It denies any similarity between its remaining goods and those relied upon by the opponent.

6. Both parties filed evidence and the opponent filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, the applicant filed written submissions in lieu of attendance at a hearing.

## EVIDENCE

### The opponent's evidence

7. This consists of two statements. The first is from Andrew Lee. Mr Lee is the Category Manager (power tools) for Kingfisher Sourcing Organisation ("KSO") based in China, a position he has held since 2010. Mr Lee states:

"3. KSO is the direct sourcing company of the Kingfisher Group and arranges the exportation of a variety of products which are then sold in B&Q Plc's stores in the UK and online to UK consumers from the website [www.diy.com](http://www.diy.com).

4. I confirm that during my time at KSO, KSO have exported into the UK a variety of MAC ALLISTER branded products to B&Q Plc, including electric batteries, electric power tools, electric drills and drivers, electric sanders and garden trimmers.

5. I confirm that KSO has exported MAC ALLISTER branded electric batteries, as well as other electronic powered MAC ALLISTER tools to B&Q Plc within the 5 year period preceding [the date of publication of the application]."

8. The second statement is from Rachael Clarke, who is General Legal Counsel at B&Q Plc. Ms Clarke explains that her company, like the opponent, is part of the Kingfisher Group, Europe's largest home improvement retailer and the third largest in the world. Ms Clarke states that her company:

"4...specialises in the sale and production of a wide variety of goods including do-it yourself (DIY) products, tools, building materials, home improvement and gardening supplies, as well as offering installation services to its customers."

9. Ms Clarke's company is, she explains, a licensee of "the trade mark MAC ALLISTER (the "Mark")", adding that a written licence agreement relating to the use of the Mark commenced on 1 February 2005; a copy of the licence is provided as exhibit 1. I note, inter alia, that: (i) the commencement date of the agreement is as indicated, (ii) the agreement has been signed by representatives of both parties, (iii) the trade mark is referred to as "MacAllister" and contains a provision in relation to it being "amended or updated by the proprietor from time to time", (iv) a wide range of products are named, (v) the relevant territory is the United Kingdom and (vi), the agreement is valid from the commencement date for one year and will be automatically renewed for successive periods of one year "unless either party gives to the other no less than 3 months notice of its wish to terminate the Agreement on the anniversary of the Commencement Date." Ms Clarke states:

"6...I can confirm that the opponent's mark has been used [by B&Q Plc as an authorised licensee] on a variety of products within the 5 year period preceding

[the date of the publication of the application], including use of the Mark on electric batteries.”

Ms Clarke adds that sales of products sold bearing the Mark continues to “today” i.e. the date of her statement which is April 2013. Sales of goods to consumers bearing the mark have, she explains, been made both in store and online from her company’s website [www.diy.com](http://www.diy.com). Ms Clarke comments that use of the Mark has been made on a variety of products including power tools, batteries, chargers and garden machinery, evidence of which can, she states, be found in exhibit 2. She adds:

“8. The examples [in exhibit 2] provide evidence of use of the Mark on batteries and battery chargers, as well as a selection of electrical goods which include a chargeable battery; for example electric drills and drivers, sanders and garden trimmers.”

10. Exhibit 2 consists of pages downloaded from [www.diy.com](http://www.diy.com) on 23 April 2013 (i.e. after the publication date of the application). It shows the word Mac Allister and the mark the subject of no. 810008 being used upon or in relation to: (page 16) a 10.8V battery for use in conjunction with a power tool, (17) a 10.8V Powersurge charger for use in conjunction with power tools, (18) a 10.8V portable power source for use with MP3 players, digital cameras, GPSs and mobile phones, (19) a 36V battery & charger for use with garden power tools, (20, 21, 22, 26, 27 and 30) various powered drills, (23 and 35) powered impact drivers, (24) a powered palm sander, (25, 36 and 38) cordless grass/hedge trimmers, (28) a powered multi tool starter kit, (29) a powered multi-function tool, (31) a cordless impact wrench, (32) a powered jigsaw, (33) a cordless screwdriver, (34) a powered circular saw, (37) a powered brush cutter and (39), a 10.8V torch. All the prices shown are in £ sterling.

11. Exhibit 3 is described by Ms Clarke as:

“9...images of artwork that have been used for the packaging of various power tools featuring the Mark. The images show that these products include a detachable electric battery which has been sold both with the product and as an individual product. This artwork was approved by the respective buyers well before [the date of the publication of the application]...”

The artwork provided is of poor quality. Whilst it does, as Ms Clarke states, relate to a range of power tools, and whilst it may indicate that which Ms Clarke suggests, I am unable to discern if that is indeed the case given the poor quality of the copies provided. In addition, as far as I can tell, it only contains references to the mark the subject of no. 810008. The approval dates range from 2009 to 2011 i.e. all before the publication date of the application. I infer that the individuals named in the exhibit are the buyers to which Ms Clarke refers.

12. Exhibit 4 is described by Ms Clarke as:

“10...[providing] a breakdown of some of the MAC ALLISTER battery shipments that have been made to [B&Q Plc] and the opponent. The total number of battery units imported to the UK prior to [the date of publication of the application] in this document amounts to 1296”.

This exhibit contains, inter alia, references to what appears to be 16 orders. All but two of the orders are dated after the date of the publication of the application. The two that are from before that date are from 30 September 2007 and 30 March 2009. The first is described as “14.4V LI-ION DRILL BATTERY PACK” and is for an “Order QTY” of 1008. The second is described as “MAC 7.2V LI-ION BATTERY PACK” and is for an “Order QTY” of 288. Although after the material date, I note that items 1-5 are all described as “MAC 10.8V BATTERY”, whereas items 6-14 contain no reference to the letters MAC.

13. Exhibit 5 consists of what Ms Clarke describes as:

“11...a breakdown of sales figures from 2009-2010...for individual battery packs sold and branded with the Mark...”

The exhibit indicates that in the period mentioned, 2730 battery packs (the entries for which all contain the prefix MAC) were sold with sales amounting to £19,668.90

14. Ms Clarke describes exhibit 6 as providing:

“12...a breakdown of sales figures from [week 12] 2009 to [week 21] 2012 for battery powered tools sold and branded with the Mark...These products were MAC ALLISTER branded products and include goods which contain a chargeable battery.”

The exhibit indicates that in the period mentioned, 161151 units (the entries for which all contain the prefix MAC) were sold with sales amounting to £5,089,873.

15. Ms Clarke explains that exhibit 7 provides:

“13...a breakdown of sales for garden tools and machinery that were made by [B&Q Plc] between 2010 and 2012. These products were MAC ALLISTER branded products and include goods which are cordless and contain a chargeable battery, for example the MAC ALLISTER hedge trimmer and cordless grass trimmer.”

Sales quantities for a range of goods are provided for 2010, 2011 and 2012, the references for which are all preceded by either the word MACALLISTER or the prefix MAC (or both). Of the two items specifically mentioned by Ms Clarke, I note that two entries in 2012 have been highlighted, with sales amounting to 16,495 units.

16. Ms Clarke states that exhibit 8 consists of:

“14...examples of purchase orders made [prior to the date of publication of the application] for various MAC ALLISTER branded gardening tools.”

The exhibit contains three purchase orders all from B&Q Plc to KSO and all from 2011. The orders are in respect of 600 garden power chainsaws, 2,880 garden power trimmers and 648 garden power lawnmowers. All of the goods are described as MACALLISTER and all appear to be destined for the UK.

### **The applicant’s evidence**

17. This consists of two witness statements, both from Louise Westbury, a trade mark attorney at Cleveland LLP, the applicant’s professional representatives. Insofar as the second statement is concerned, as it simply clarifies from where the information contained in Ms Westbury’s first statement was obtained and to whom it was passed, there is no need for me to comment upon it any further here. In her first statement Ms Westbury states that she is authorised by the applicant to make her statement on its behalf, she adds:

“4. In this statement, the following products which have been sold in the UK under the mark of the application by the applicant or with its consent are referred to as the opposed goods...”

5. The applicant owns the “Macally group”, which is worldwide. The applicant has established individual branches of its business in different areas of the world. Its branch in Europe is called “Teklink”. Teklink sells the opposed goods under the mark of the application in the UK through distributors in the UK (and not to consumers directly)...”

18. The information in exhibit LW1 was obtained by Teklink from its records. It is described by Ms Westbury as:

“6...a list of the volume in Euros of sales [by Teklink] to UK distributors of the opposed goods...”

The quantity and value of goods sold is as follows:

<b>Year</b>	<b>Sales Volume</b>	<b>Gross Sales (€)</b>
2004	1172	26,252
2005	4240	88,777
2006	4782	109,753
2007	4750	110,588
2008	3216	77,023
2009	3369	41,897
2010	533	10,388

2011	3803	18178
<b>Total prior to 2012</b>	<b>25,865</b>	<b>482,856</b>
2012	1345	6266
2013	2885	12,277

19. Exhibit LW2 consists of pages downloaded from a range of websites on 16 October 2013, the vast majority of which relate to the applicant. The purpose of this exhibit is, explains Ms Westbury, to:

“7...illustrate the nature of the opposed goods...”

20. Ms Westbury explains that exhibit LW3 is:

“8...a selection of invoices and other sales documents [taken from the records of Teklink] showing sales of the opposed goods (and other goods) to UK retailers...”

This exhibit consists of, inter alia, a range of invoices from Teklink Europe BV to, inter alia, a range of undertakings in the UK. The dates of the documents range from 2005 to 2012. The invoices bear the name macally in the format shown below, as well as in this format but without the word peripherals and as “Macally Peripherals”.



The invoices etc. are in relation to a wide range of goods. A number of the entries in the invoices have, I note, been highlighted. I infer that this highlighting is intended to draw attention to those goods in the invoices which the applicant considers to fall within the category of the opposed goods.

21. Ms Westbury explains that exhibit LW4 consists of:

“9...a selection of photographs of the opposed goods. These photographs were taken [after the date of the publication of the application] but they illustrate the opposed goods as sold before that date...”

Where visible, inter alia, the word “Macally”, “MACALLY”, “Macally Europe” and [www.macally-europe.com](http://www.macally-europe.com) can be seen as can the composite mark in paragraph 20 above (albeit without the word Peripherals”). There is, as far as I can tell, no use of the mark in the exact form in which it was applied for.



22. The final exhibit, LW5, consists of what Ms Westbury describes as:

“10...copies of the applicant’s 2003/2004, 2005 and 2007 product brochures used in the UK, showing the opposed goods (and other goods).”

The mark is shown in the composite format mentioned above (but without the word Peripherals), as Macally, for example in: “The Macally BTMicro...” and in the web address shown above.

23. That concludes my summary of the evidence filed to the extent that I consider it necessary.

## **DECISION**

24. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

25. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

26. In these proceedings, the opponent is relying upon the three trade marks shown in paragraph 3 above, all of which qualify as earlier trade marks under the above provisions. As all of the earlier trade marks had protection conferred upon them more than 5 years before the publication date of the application in suit i.e. 20 July 2012, all the earlier trade marks are subject to proof of use, as per section 6A of the Act. In its Notice of opposition, the opponent indicates that its earlier marks have been used upon

all of the goods upon which it relies, and in its counterstatement, the applicant has put the opponent to proof of these claims. The relevant sections of the Act read as follows:

**“6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Section 100 of the Act is also relevant and reads:

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

### **Proof of use**

27. The opponent states that its earlier marks have been used in relation to:

#### **No. 810008**

Class 7 – Jack hammers; drills; screw-driving machines; grinding machines.

Class 9 – Electric storage batteries; batteries.

#### **No. 776477**

Class 7 – Drilling hammers; drilling machines; screw-driving machines; grinding machines.

Class 9 – Electric batteries; batteries.

#### **No. 799213**

Class 9 – Photovoltaic cells and photocells.

28. In reaching a conclusion, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of the publication of the application for registration i.e. 21 July 2007 to 20 July 2012. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

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

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

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

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

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

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

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the

economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

29. The only submissions I have on the proof of use issue are from the applicant. Whilst it is neither necessary nor appropriate for me to repeat the applicant’s detailed critique of the opponent’s evidence here, I will keep all of the applicant’s submissions in mind when reaching a conclusion. What follows gives, I think, a flavour of the applicant’s position:

The use conditions have not been met in respect of all or some of the goods relied upon by the opponent;

The opponent’s evidence provides no information on advertising or promotion or other marketing activity relating to goods sold under the earlier marks other than pages from the website of B&Q Plc;

The opponent’s evidence provides no information as to the volume or value of the market in the goods relied upon, nor of the share of that market occupied by the goods relied on sold under the earlier marks;

Although the licence agreement (exhibit 1) refers to use of the mark “MacAllister” “as amended or updated by the opponent from time to time”, there is no indication that either of the earlier marks i.e. MAC ALISTER or the MAC ALLISTER and device mark is a mark resulting from amendment or update by the opponent of the mark “MacAllister”;

No evidence has been provided of use upon photovoltaic cells and photocells;

The fact that goods include a chargeable battery might influence whether or not the consumer purchases them, but the consumer is nonetheless purchasing electrical goods and is not purchasing a chargeable battery per se. Use of the mark “MacAllister” or variants thereof for electrical goods which include a chargeable battery is not in itself use for any other good relied upon;

Use on garden tools and machinery are not relevant as these goods are not relied upon by the opponent;

Use on chargers and battery chargers are not relevant as these goods are not relied upon by the opponent.

30. The first issue I need to consider is the Agreement provided by Ms Clarke as exhibit 1, and whether any use that may have been made of the marks is with the opponent’s

consent. As I mentioned above, the agreement is between the opponent and B&Q Plc and has been signed on behalf of both. It commenced on 1 February 2005, and notwithstanding the termination provisions in Schedule 3 of the Agreement, there is nothing to suggest that the Agreement is not still in force. The Territory is defined in Schedule 2 as the United Kingdom and Schedule 1 includes, inter alia, a list of licensed products which would include the goods upon which the opponent relies in these proceedings. The trade marks that have been licensed also appear in Schedule 1; the Agreement refers specifically to only one mark i.e. “MacAllister”, however, in the Definitions section of the Agreement, the following appears in relation to “Trade Marks”:

“the trade mark set out in Schedule 1, as amended or updated by the Proprietor from time to time.”

As this provision allows the opponent to amend or update the mark “MacAllister” from time to time, and as the marks relied upon by the opponent in these proceedings i.e. MAC ALLISTER (word only) and the MAC ALLISTER and device mark would, in my view, all fall into the category of amendments or updates, I am satisfied that any use B&Q Plc may have made of the marks was with the consent of the opponent, Castorama France.

31. Having reached that conclusion, I must now go on and determine upon what goods the opponent has used its marks. As far as I can tell, and as the applicant points out, no evidence has been provided by the opponent which shows use upon “photovoltaic cells” and “photocells”. That being the case, the opposition based upon IR 799213 (which relies solely on these goods) is dismissed.

32. I note that in her statement, Ms Clarke states that the marks have been used within the relevant period on a variety of products, including “electric batteries” (paragraph 6) and “batteries, chargers” (paragraph 8). I also note that a number of the exhibits focus specifically on such goods, for example, “battery shipments” (exhibit 4) and “individual battery packs” (exhibit 5). Given the nature of the goods being opposed i.e. “plugs, sockets and other contacts [electric connections]; electric batteries”, it appears to me that it is the opponent’s goods in class 9 which would (if it has made genuine use of its marks in relation to such goods) offer it the best prospect of success. I will, as a consequence, consider these goods first and only go on to consider the other goods relied upon in class 7 (which relates to goods which include a rechargeable battery), if I consider it necessary to do so.

33. Having explained that he has held his position since 2010, Mr Lee states that during his time at KSO (and within the relevant period), KSO “have exported into the UK a variety of MAC ALLISTER branded products to B&Q Plc including...electric batteries...” Exhibit 2 to Ms Clarke’s statement consists of pages downloaded on 23 April 2013 (i.e. after the relevant period) from B&Q’s website [www.diy.com](http://www.diy.com); it contains references to, inter alia, a 10.8V battery for use in conjunction with a power tool (page 16), a 10.8V portable power source for use with MP3 players, digital cameras etc. (page 18) and a 36V battery and charger for use with garden power tools (page 19). The prices are

shown in £ Sterling, the goods are described as “Mac Allister” and the mark the subject of no. 810008 can be seen on, inter alia, each of the pages. Exhibit RC4 consists of what Ms Clarke describes as “a breakdown of some of the MAC ALLISTER battery shipments that have been made to the company and the opponent”. The exhibit contains references to sixteen shipments which occurred between 30 September 2007 and 15 June 2013. Of the sixteen shipments, only two occurred within the relevant period. These were as follows:

“14.4V LI-ION DRILL BATTERY PACK”

1008 of these battery packs were supplied, with a total value of \$29,232.

The second shipment, dated, 30 June 2009, was in respect of:

“MAC 7.2V LI-ION BATTERY PACK”.

288 of these battery packs were supplied, with a total value of \$2,764.

In its submissions, the applicant states in relation to the first shipment:

“12(a)...There is nothing other than Ms Clarke’s mere assertion to show that the mark “MacAllister” or a variant thereof was used in relation to these packs.”

In relation to the second shipment, the applicant states:

“12(b)...There is no reason to assume that MAC stands for MAC ALLISTER and there is nothing other than Ms Clarke’s mere assertion to show that the mark “MacAllister” or a variant thereof was used in relation to these packs.”

34. Of the sixteen shipments referred to in this exhibit, six include the prefix MAC; only one shipment in the relevant period includes this prefix. In view of this, one could infer that those not identified by the MAC prefix were, for example, unbranded. This exhibit also contains a reference to a “MAC 10.8V BATTERY” shipment dated 6 August 2012. Although just outside the relevant period, the order for this shipment is, given the proximity in the dates, highly likely, in my view, to have been placed within the relevant period. This shipment relates to 1500 batteries packs with a value of \$25,305. As to the applicant’s comments to the effect that Ms Clarke’s statement consists of “mere assertion”, I note the guidance in Tribunal Practice Notice (TPN 5/2007) entitled “Procedure for parties to challenge evidence filed in inter partes trade mark disputes”. The relevant parts read as follows:

“1. The purpose of this Tribunal Practice Notice is to set out procedures for parties to challenge factual evidence filed by the other side in inter partes disputes. It is normally unacceptable for parties to invite a Hearing Officer to disbelieve the factual evidence of a witness without that witness having had the opportunity to respond to the challenge either by filing further written evidence or

by answering the challenge that his or her evidence is untrue in cross-examination. The tactic of raising such challenges without notice at oral hearings has drawn the following comment from Richard Arnold Q.C. as the Appointed Person in EXTREME Trade Mark BL O/161/07).

"Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] BusLR 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically)."

35. Ms Clarke's evidence is provided in the form of a witness statement, is signed and is accompanied by a statement of truth. Ms Clarke explains that the information in her statement comes from either her own knowledge or from her company's records. As Ms Clarke's evidence is clearly not incredible, I intend to approach the applicant's submissions on the basis that what it is asking me to do is not to disbelieve Ms Clarke's evidence, but, to use the words of the Appointed Person in *Extreme*, not to consider it uncritically.

36. Exhibit 5 consists of sales from 2009 to 2010 for what Ms Clarke describes as "individual battery packs sold and branded with the Mark." This exhibit consists of nine entries. All of the entries are prefixed MAC. In the period mentioned, 2730 battery packs have been sold with a value of £19,668.

37. In reaching a conclusion, I begin by reminding myself that the relevant period is 21 July 2007 to 20 July 2012. The opponent's evidence indicates that it together with B&Q Plc, are members of the Kingfisher Group, which is, inter alia, Europe's largest home improvement retailer. The opponent and B&Q Plc entered into a trade mark licensing agreement in February 2005, in which the opponent granted B&Q Plc a non-exclusive



licence to use the mark MacAllister in the UK on a wide range of goods (including those relied upon by the opponent in these proceedings). There is no evidence to suggest the agreement, which allows the opponent to amend or update its mark from time to time, is not still in force.

38. Having already concluded that Ms Clarke's evidence is not incredible, it indicates that in April 2013 B&Q Plc were using the trade mark Mac Allister and the MAC ALLISTER device mark on its website [www.diy.com](http://www.diy.com) on a range of, broadly speaking, power tools and also for, inter alia, battery packs for such goods. Ms Clarke's evidence further indicates that between 2007 and 2009 some 1296 "MAC ALLISTER" battery units were imported into the UK with a value of \$31,996. There was also, I noted above, a shipment of 1500 "MAC 10.8V" batteries dated 6 August 2012 amounting to some \$25,305. Sales of individual battery packs between 2009 and 2010 (which Ms Clarke states bore the Mark) amounted to 2730 units with a total sales value of £19,668.90. Although he provides no exhibits in support, in his statement Mr Lee confirms that KSO have exported into the UK a variety of MAC ALLISTER branded products to B&Q Plc including electric batteries, adding that MAC ALLISTER branded electric batteries have been exported to B&Q Plc within the relevant period. Finally, Ms Clarke's evidence indicates that between 2009 and 2012, B&Q Plc, sold a wide range of, inter alia, power tools which bore the Mark and which contained a chargeable battery, with volume and sales amounting to 161151 and £5,089,873, respectively.

39. As is so often the case in proceedings before the Tribunal, the opponent's evidence is far from perfect (and the quality of many of the copies is very poor). In her statement, Ms Clarke describes "the Mark" as "MAC ALLISTER". Whilst I have already concluded that this format and that of the MAC ALLISTER device mark falls within the definition of updates and amendments included in the agreement, there is, as far as I can tell, no use shown of the mark in this exact format in the evidence (although there is use of the device mark). That said, in its written submissions, the applicant states:

"9(b) The applicant does not dispute that B&Q Plc's use of the marks MacAllister and MAC ALLISTER is allowed under the licence and might be use for the purposes of s6A..."

40. In addition, the evidence from [www.diy.com](http://www.diy.com) is all from after the relevant period and there is, as the applicant points out, no evidence provided of, for example, advertising or marketing activities undertaken by the opponent, nor is there any information on the size of the market in the goods relied upon.

41. Although individual parts of the evidence are clearly open to criticism, when considered as a totality, the evidence indicates that the opponent has used the word mark Mac Allister and the MAC ALLISTER device mark within the relevant period for, inter alia, a range of power tools and what appears to be (primarily) battery packs for such goods. I am (as it appears is the applicant), satisfied that use of Mac Allister is use of MAC ALLISTER, and although the website information provided in exhibit 2 is after the relevant period, its relative proximity to the relevant period is, in my view, sufficient

for me to infer that this is how the opponent's marks were likely to have been used during the relevant period. Whilst the opponent's evidence indicates that the bulk of its sales are in relation to power tools which include a rechargeable battery, it is also clear that during the relevant period, battery packs were exported by KSO to B&Q Plc and that these were then sold to consumers. Although the only evidence I have of sales in the relevant period took place between 2009 and 2010 and amounted to some 2730 units with a value of £19,668.90, as I noted above, a further shipment of 1500 battery packs (with a sales value of \$23,305) took place on 6 August 2012 (i.e. just after the relevant period) and shipments continued to take place into mid to late 2013.

42. Although I have no evidence to assist me, my own experience tells me that whilst the market for batteries at large in the UK must be a sizeable one, the market for battery packs for use with power tools is likely to be significantly smaller (although still, I think, sizeable). Whilst the use provided in relation to battery packs for power tools is small and sporadic, it is well established that use need not be quantitatively significant for it to be deemed genuine. In my view, there is nothing to suggest that the opponent's use has been token; indeed the opposite is true; all the evidence suggests that the opponent has used its marks to guarantee the identity of the origin of its battery packs from those of others. Taking all of the above into account, I am satisfied that the opponent has made genuine use of its MAC ALLISTER word mark and MAC ALLISTER and device trade mark and that this use has been (primarily) in relation to battery packs for power tools. Having reached that conclusion, I must now determine what constitutes a fair specification. Both marks are registered in class 9. For "electric storage batteries: batteries" (no. 810008) and "electric batteries; batteries" (no. 776477).

43. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, the court stated the following in relation to determining what constitutes a fair specification:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

In *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 the Court of First Instance (now the GC) stated:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

Finally, In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL-O-345/10, Mr Geoffrey Hobbs Q.C., sitting as the appointed person stated:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

44. In my view, the average consumer would describe the goods upon which the opponent has used its mark in class 9 as battery packs for power tools. They would not, I think, seek to sub-define them further, perhaps by reference to the goods with which they may be used. As battery packs for power tools is a sub-category of the goods for which the opponent’s marks are registered, this, in my view, represents a fair specification and it is this specification which I will use for the purposes of comparison.

Whilst it may be considered that this is too narrow an interpretation of the use the opponent has made of its marks, and I ought to have allowed the opponent to rely upon either a broader description or indeed its specification as registered, for reasons that will become apparent later in this decision, even if I were to consider the position on the basis of the goods for which the opponent's marks are registered, such an approach would not impact on the overall result of the opposition.

### **Conclusions on proof of use**

**45. As no use has been shown on “photovoltaic cells and photocells”, the opponent has not, insofar as IR no. 799213 is concerned, satisfied the proof of use requirements and, as a consequence, this registration will play no further part in the proceedings. Given my conclusions above, the goods as expressed in the opponent's specifications in class 9 for IR nos. 810008 and 776477 are, in my view, overly broad and it is on the basis of “battery packs for power tools” upon which the I will make the comparison.**

### **Section 5(2)(b) – case law**

46. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

#### **The CJEU cases**

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

#### **The principles**

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### **Comparison of goods**

47. The competing goods are as follows:

<b>Opponent's goods in class 9 (following proof of use)</b>	<b>Applicant's goods</b>
Battery packs for power tools.	Plugs, sockets and other contacts [electric connections]; electric batteries.

48. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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.

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

"... 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."

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, in which 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 T-110/01 Vedral 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).”

In relation to complementary goods and services, the comments of the Court of First Instance (now the GC) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

49. As “electric batteries” in the applicant’s specification would encompass the goods upon which I found the opponent has made genuine use of its mark i.e. battery packs for power tools, the competing goods are identical on the principles outlined in *Merix*. As to the opposed goods which remain, in its submissions, the opponent states:

“As to [the opposed goods save for electric batteries], all these goods designate electrical accessories which permit an electrical device/appliance to be connected to the electric power.”



And:

“In order to transmit the energy/power it creates, a battery is required to be in contact through a metallic connector, with the device it is chargers. Such metallic pieces are called **plugs, sockets** or more generally **contacts**. As a consequence, the goods are complementary.”

In its submissions, the applicant states:

“22. As a matter of plain fact, the opposed goods...have different natures, purposes and methods of use from the goods relied on and are not in competition with the goods relied on.

23. The applicant admits that, as asserted by the opponent, the opposed goods each permit an electric device or appliance to be connected to electric power...

24. Further, from experience, the Office will be aware that electric connections are displayed in one area of or on one set of shelves in shops which sell such goods, and are displayed in one area of brochures and websites which offers such goods, and those areas are separate from those displaying the goods relied on, such that electric connections and the goods relied on are not sold side-by-side.”

50. All of the opposed goods which remain are electric connections of one sort or another. While it appears to me that the physical nature of the competing goods may differ, there are obvious similarities in both the intended purpose and method of use of the competing goods. In addition, as it may be necessary for battery packs for power tools to be used with specific plugs and specific connectors, the users may be the same as may the trade channels through which the goods reach the market. There is also, in the circumstances I have described above, an element of complementarity between the competing goods. Considered overall, I think there is at least a reasonable degree of similarity between the opposed goods which remain and the opponent’s battery packs for power tools.

### **The average consumer and the nature of the purchasing decision**

51. 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. It is, I think fair to say, that in their respective submissions, both parties focused more on the opponent’s goods in class 7 than the goods in class 9. Whilst in those circumstances, the parties agreed that the average consumer was either a member of the general public or a professional workman, they disagreed about the degree of care such an average consumer would take when selecting the goods, with the opponent characterising it as average and the applicant as at least high (in the case



of a member of the general public). As to how the goods will be selected, the applicant stated:

“36...because the opposed goods and the goods relied on are goods which will be self selected by consumers, from websites, brochures or shelves.”

52. In my view, the average consumer of the goods in class 9 now in issue i.e. electric connections and battery packs for power tools is still either a member of the general public or a professional user. Such goods are, most likely, to be the subject of self selection from the shelves of a conventional retail establishment on the high street and from brochures and websites. As a consequence, the purchasing act is likely to be a predominantly visual one. That said, as there may, for example, be compatibility issues to be consider, the average consumer may (if the opportunity exists) seek advice from a sales assistant, indicating that aural considerations may also feature in the selection process. As to the degree of care taken during the selection of the competing goods in class 9, one would expect than an average consumer selecting, for example, a rechargeable battery pack or electrical connection for, for example, a power tool or mobile device to pay at least a reasonable level of attention to their selection. As the cost and potential complexity of, for example, the battery pack or connection increases, the need not only to ensure it is compatible with the device concerned, but also to ensure it has the necessary characteristics that the average consumer requires, suggests a somewhat higher level of attention will be paid in those circumstances.

### Comparison of marks

53. The marks to be compared are:

Opponent's marks	Applicant's mark
MAC ALLISTER 	

54. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

55. The opponent relies upon the two marks shown above. However, as both marks have been used on battery packs for power tools, (and whilst I am mindful of the comments of Norris J in *Lonsdale Sports Ltd v Erol* [2014] R.P.C. 15 in relation to the

Tribunal selecting a “best case” mark without recourse to the parties), it is, given the not insignificant degree of stylisation present in the second mark, quite clearly, in my view, the word mark MAC ALLISTER which offers the opponent the best prospect of success and it is this mark I will use for the purposes of comparison. Although the opponent’s mark is presented with a space between the C in MAC and the A in ALLISTER, this is, in my view, likely to go largely unnoticed by the average consumer. In my view, the average consumer will, despite, the space, see the mark as a unified whole; there are, as a consequence, no distinctive and dominant elements; the distinctiveness of the mark lies in its totality.

56. Turning to the applicant’s mark, this consists of two elements. The first is the device (which the applicant explains is a stylised letter M) and which appears at the beginning of the mark. Whilst I do not agree with the opponent’s submissions to the effect that this would be seen: “as a decorative element and clearly not identified as an indication of the origin of the goods”, I have my doubts that the average consumer will see it as a letter M. Regardless, it is, in my view, a distinctive element of the applicant’s mark. The second element is the word MACALLY presented in upper case in an unremarkable typeface. It too is, as far as I am aware, a distinctive element. Given its size in relation to the device which accompanies it, it is the dominant element of the applicant’s mark.

57. When considered from a visual perspective, the opponent’s mark consists of eleven letters, whereas the applicant’s mark consists of a distinctive device and a word which consists of seven letters. The competing marks share the letters MACALL in the same order but differ in their respective endings i.e. Y v ISTER. When considered as totalities, there is, in my view, a moderate degree of visual similarity between the competing marks. As to the degree of aural similarity, it is well established that when an average consumer refers to a mark which consists of a word and device, they are most likely to use the word element. In its submissions, the opponent states:

“Furthermore, these six letters [MACALL] are followed respectively by the letters I in MAC ALLISTER and Y in MACALLY. These letters are pronounced almost identically, which accentuates these aural similarities.”

In its submissions, the applicant states:

“33. While both MACALLY and MAC ALISTER begin with the letters MAC, those letters are likely to be elided in speech with “ally” [in the application], so that the [applicant’s mark] is likely to be pronounced “m”kally” whereas “mac” will always be separated from “allister” in the earlier trade mark.

34. The mark MAC ALLISTER has one more syllable than MACALLY and that syllable ISTER has a definite and clear sound.”

58. I agree that the word elements of the competing marks differ by one syllable. However, the first three syllables in MAC ALLISTER are, if not identical, highly similar to the totality of the word element of the applicant’s marks. Whilst I accept that the word

elements have different endings, there remains, in my view, a higher than average degree of aural similarity between the word elements of the competing marks.

59. Finally, in relation to the conceptual comparison, having stated that MAC “is a well known prefix to Scottish and Irish surnames” and that “all consumers in the UK will identify this element, the opponent states:

“Furthermore, ALLY is the diminutive of the first name ALLISTER. Here again, consumers in the United Kingdom are aware of this. Therefore, the contested mark MACALLY will be, without any doubt, be perceived as the diminutive of the earlier marks invoked MAC ALLISTER.”

Having explained the origin of the word MACALLY (which I need not repeat here), the applicant states, inter alia:

“41. It is unlikely that, as suggested by the opponent, the word MACALLY will be seen as a surname, since surnames beginning with Mac (or Mc) are presented as one word with an initial capital and a capital first letter of the second element of the name.

42. It is unlikely that the word MAC ALLISTER will be seen as a surname [for the reasons mentioned above] and because MAC ALLISTER is two.”

The applicant disagrees that ALLY is a diminutive of the forename ALLISTER arguing that even if it is:

“44...that is no reason to suppose that the mark MACALLY will be seen as the forename MacAlly since surnames beginning with Mac (or Mc) are not expected to end with a forename or the diminutive of a forename.

45. In suggesting that MACALLY will be seen as a surname, the opponent is without good cause asking the Office to suppose that consumers will make several assumptions, each of which assumptions is unlikely to be made individually and the coincidence of which is extremely unlikely.”

60. I have already concluded that the opponent’s mark will, despite the spacing, be seen as a unified whole. Despite the spacing and presentation in upper case, as the average consumer is, in my experience, likely to be very familiar with the surname MacAllister, that, in my view, is how they will interpret the opponent’s mark i.e. as the surname MacAllister. Similarly, my first impression of the word MACALLY in the applicant’s mark was as a surname. Whilst it is possible my reaction may be atypical, I think that is unlikely. Of course, if I am wrong, the average consumer is, in those circumstances, likely to treat the word MACALLY in the applicant’s mark as an invented word. However, I intend to proceed on the basis that as both the opponent’s mark and the word element of the applicant’s mark are likely to create a surnominal concept in the

mind of the average consumer, the competing marks are conceptually similar at least to that extent.

### **Distinctive character of the opponent's earlier trade mark MAC ALLISTER in Class 9**

61. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. Although I have concluded that the opponent's evidence is sufficient for it to be satisfy the proof of use provisions in relation to "battery pack for power tools" in class 9, given the nature and content of the evidence provided, I have no hesitation concluding when considered in relation to these goods the inherent characteristics of the mark have not been enhanced to any material extent. Considered in that context and consisting as it does of what, in my view, will be seen by the average consumer as a surname, the opponent's earlier mark is, in my judgement, possessed of a no higher or lower than normal degree of distinctive character.

### **Likelihood of confusion**

62. 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 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.

63. Having determined that it was IR no. 776477 MAC ALLISTER and in particular the goods in class 9 of this registration which offered the opponent its best prospect of success, I further concluded that:

- the opponent has, within the relevant period, made genuine use of the mark mentioned in relation to battery packs for power tools in class 9;

- the average consumer of the goods at issue is a member of the general public or a professional user who will select the goods by predominantly visual means and will pay at least a reasonable level of attention when doing so;
- the competing goods are either identical (electric batteries) or at least similar to a reasonable degree (the remaining goods);
- the opponent's mark has no dominant or distinctive elements; the distinctiveness lying in the mark as a whole;
- whilst both the device and word elements of the applicant's mark are distinctive elements, it is the word MACALLY which is the dominant element of the applicant's mark;
- the competing marks are visually similar to a moderate degree, aurally similar to a somewhat higher than average degree and conceptually similar to the extent that both will be construed as surnames;
- the use the opponent has made of its mark in class 9 has not improved its inherent characteristics to any material extent with the result that it is possessed of a no higher or lower than normal degree of inherent distinctive character.

64. As I have already explained, in my view, the opponent's mark will, despite its presentation and spacing, be construed by the average consumer as a surname. I have, despite the applicant's submission to the contrary, also concluded that the word element of its mark will be construed in the same manner i.e. as a surname. Surnames are a traditional form of trade mark; it is well established that the average consumer is accustomed to distinguishing between them, even when they share similarities. That, in my view, is the position here. Notwithstanding the degree of similarity I have found in the competing marks and the identity and similarity in the competing goods, I have little difficulty in concluding that the overall differences in the competing marks is more than sufficient to avoid a likelihood of either direct or indirect confusion. Although I have reached this conclusion in relation to a notional average consumer paying at least a reasonable level of attention during the selection process, I would have reached the same conclusion had I concluded that a lower level of attention was appropriate. In addition, should I be found to be wrong in my conclusion that the word element of the applicant's mark would be seen as a surname, as the word MACALLY is, in those circumstances, unlikely to convey any other concrete meaning to the average consumer, it is likely to be treated as an invented word, resulting in the competing marks being conceptually distinct. For the avoidance of doubt, I should say that in reaching the above conclusions, the applicant's evidence does not, for the reasons mentioned in the opponent's submissions, assist the applicant.

## Conclusion

**65. The opposition to the application fails, and subject to any successful appeal, the application will proceed to registration.**

## Costs

66. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but making no award to the applicant in respect of the preparation of its evidence which played no part in these proceedings, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent's statement (including filing an amended counterstatement):	£400
Considering the opponent's evidence:	£500
Written submissions:	£300
<b>Total:</b>	<b>£1200</b>

67. I order Castorama France to pay to Macally International Co., Ltd the sum of **£1200**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 31st day of July 2014**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**