O/182/17

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3126493

BY NICHOLAS HAVERCROFT

TO REGISTER 'APPLE HELMET' AS A TRADE MARK IN CLASS 9

AND

OPPOSITION No. 405764

BY APPLE INC.

Background and pleadings

1. On 10th September 2015 ("the relevant date"), Mr Nicholas Havercroft ("the applicant") applied to register **Apple Helmet** in relation to the list of goods in class 9 set out in Annex A below. The list appears long, but it is highly duplicative. The goods of interest are, essentially, a range of protective and safety helmets, associated safety clothing, sports glasses and goggles, apparatus for recording sound and images, apparatus for measuring time, distances and personal information, and recording media of various kinds.

2. The application is opposed by Apple Inc. ("the opponent"). The opposition is based on the opponent's earlier registration of **APPLE** as an EU trade mark under No. 9783978 in relation to a very wide range of goods and services in classes 1, 2, 4, 5, 6, 7, 8, 9, 10, 1, 12, 14, 15, 16, 17, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 31, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 & 45. The earlier mark was applied for on 3rd March 2011 and registered on 20th October 2013. The opponent claims that (1) the applicant's goods in class 9 are similar to all the goods and services for which the earlier mark is registered, (2) the marks are similar, and (3) there is a likelihood of confusion on the part of the public. Consequently, registration of the applicant's mark would be contrary to s.5(2)(b) of the Trade Marks Act 1994 ("the Act").

3. The opponent claims that it is a world-renowned computer and consumer electronics company producing personal computers and a wide range of associated hardware, computer software, digital music and/or video players and other consumer electronic devices. Additionally, the opponent claims to provide a broad range of computer and telecommunications services. On this basis the opponent claims that **APPLE** is a well-known trade mark and has a reputation (and goodwill) in relation to a wide range of goods/services in classes 9, 14, 16, 28, 35, 37, 38, 41, 42 & 45, including, for example, *life-saving equipment* in class 9, *precious metals* and *jewellery* in class 14, *building construction services* in class 37 and *legal services* in class 45.

4. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of the reputation of the earlier and/or by detrimental to the

repute or distinctive character of the earlier mark. Further, use of the earlier mark would deceive the public into believing that the applicant is connected with the opponent. This would damage the opponent's goodwill. Consequently, use of the applicant's mark would be contrary to law and registration should be refused under s.5(3) or s.5(4)(a) of the Act.

5. The opponent further claims that **APPLE** is also entitled to protection as a well-known mark under article 6*bis* of the Paris Convention. The mark therefore qualifies as an earlier trade mark under section 6 of the Act. However, as the mark is registered for the goods/services for which it is claimed to be well-known it qualifies on the normal basis as an earlier trade mark. Therefore, the opponent is entitled to whatever protection is appropriate under s.5 of the Act, whether or not **APPLE** qualifies as an earlier mark by virtue of the Paris Convention. Consequently, this claim appears to be duplicative and unnecessary.

6. The applicant filed a counterstatement denying the grounds of opposition. In particular, the applicant noted that the opponent is a manufacturer of computers, telecommunications equipment and associated hardware whereas his business produced sports and industrial helmets. The applicant therefore disputed that use of the contested mark would lead to any of the consequences identified by the opponent.

7. Both side seek an award of costs.

Representation

8. The applicant is a litigant in person. The opponent is represented by Locke Lord, solicitors. Neither side asked for a hearing. Both sides filed written submissions.

Case Management

9. The opponent filed evidence in support of the opposition on 4th July 2016. It consisted of a witness statement by Mr Thomas La Perle with 102 paragraphs and 49 exhibits occupying 4 ring binders. Therefore, without seeking directions as

required by Tribunal Practice Notice 1/2015, the opponent filed evidence far in excess of the 300 pages. The applicant's counterstatement did not, in my view, make it clear whether he defended his mark for all the goods covered by the application, or only for sports and industrial helmets. Consequently, a case management conference ("CMC") was appointed for 9th August 2016. The applicant represented himself. The opponent was represented by John Olsen and Paolo Cerroni of Locke Lord.

10. Following the CMC I issued these directions:

> "i) [The applicant] should, by 15 August, confirm in writing to the registrar (copied to opponent) the goods [he] continue[s] to defend in the face of the opposition by Apple.
>
> ii) Apple should, by 30th August, identify the goods for which the earlier EU trade mark is registered that are claimed to be identical to the goods specified under (i) above (if any), and/or which goods/services represent its most similar goods/services (and therefore next best case) for the purposes of s.5(2)(b) ground of opposition.
>
> iii) Apple should, by 30th August, also identify which (if any) of the goods specified under (ii) above are covered by Apple's claim that the earlier EU mark has an enhanced distinctive character through use.
>
> iv) Apple should, by 30th August, also identify where in Mr La Perle's evidence there is an example of the use of the Apple word mark in relation to each of the goods/services specified under (iii) above.
>
> v) [The applicant] should, by 13th September, indicate whether [he] dispute[s] Apple's claim about the high level of distinctiveness of the APPLE mark in relation to the goods/services specified by the opponent under (iii) above. Further, if the denial goes only to the relevance of the enhanced distinctiveness of the APPLE mark in a particular market sector, such as the market for safety equipment, [the applicant] should make this clear."

11. Having regard to the opponent's apparent 'kitchen sink' approach to the opposition, I also told the opponent that:

> "I expect the list of similar goods/services provided under (ii) above to be show a sense of proportionality and regard for costs. Therefore, I do not expect the list to cover all the registered goods/services that Apple considers to be similar to the applicant's goods, only those it considers to represent its best case."

12. On 12th August 2016, the applicant wrote indicating that he intended to defend his application in relation to all the goods applied for.

13. On 6th September 2016, the opponent responded pointing out that the applicant had not limited his list of goods, which still consisted of around 500 words. According to the opponent, this made the task of identifying which of its goods were identical or most similar to the applicant's goods rather arduous.[1] Therefore, the opponent did not comply with the direction set out in paragraph 10 (ii) above. Instead it reiterated that all the applicant's goods are identical or similar to the goods covered by the earlier mark. By way of example, the opponent provided tables comparing large swathes of the goods covered by class 9 of the earlier mark against the applicant's goods. No attempt was made to distinguish between identical and similar goods.

14. In response to the direction set out in paragraph 10(iii) above (that the opponent should specify the goods in relation to which the opponent claimed that the earlier mark had acquired an enhanced level of distinctiveness through use), the opponent response was that Apple's reputation was such that the mark had an enhanced level of distinctive for all the goods/services covered by the earlier mark, whether identical, similar or dissimilar to the goods covered by the application. However, the opponent also provided the following list of goods in class 9:

> *Scientific, nautical, surveying, checking (supervision), life-saving apparatus and instruments; photographic, cinematographic, optical, weighing, measuring, signalling and teaching apparatus and instruments;*

[1] This is probably because the list of goods/services for the earlier mark has nearly 12000 words.

apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission and/or reproduction of sound or images or other data; magnetic data carriers; recording discs; apparatus, instruments and materials for transmitting and/or receiving and/or recording sound and/or images; downloadable audio and video recordings featuring music, comedy, drama, action, adventure and/or animation; computers, tablet computers, computer terminals, computer peripheral devices; adapters, adapter cards, connectors and drivers; blank computer storage media; chips, discs and tapes bearing or for recording computer programs and software; random access memory, read only memory; solid state memory apparatus; electronic communication equipment and instrument; magnetic, optical, and electronic data storage materials and devices; computer memory devices: blank computer storage media; solid-state data storage devices; apparatus for data storage; hard drives; miniature hard disk drive storage units; pre-recorded vinyl records, audio tapes, audio-video tapes, audio video cassettes, audio video discs; audio tapes for sale with booklets; sound, video and data recordings; CD-ROMs: digital versatile discs; stereo headphones; in-ear headphones; stereo speakers; audio speakers: audio speakers for home; monitor speakers; speakers for computers; personal stereo speaker apparatus; radio receivers, amplifiers, sound recording and reproducing apparatus, electric phonographs, record players, high fidelity stereo apparatus, tape recorders and reproducing apparatus, loudspeakers, multiple speaker units, microphones: digital, audio and video players with multimedia and interactive functions; accessories, parts, fittings, and testing apparatus for all the aforementioned goods; digital audio and video devices: audio cassette recorders and players, video cassette recorders mid players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players; radios: audio, video and digital mixers; radio transmitters; car audio apparatus; digital music and/or video players; MP3 and other digital format audio players; cash registers, calculating machines, data processing equipment; computer hardware; computer networks: global positing systems,· navigation apparatus for vehicles (on board computers); global positioning system (GPS) devices, bags and cases adapted or shaped to contain cameras and/or video cameras;

mobile telephone covers; mobile telephone cases; mobile telephone cases made of leather or imitations of leather; mobile telephone covers made of cloth or textile materials; covers, bags and cases adapted or shaped to contain all of the aforesaid goods, made of leather, imitations of leather, cloth, or textile materials, bags and cases adapted or shaped to contain digital music and/or video players, hand held computers, personal digital assistants, electronic organizers and electronic notepads: holders, straps, armbands. lanyards and clips for portable and handheld digital electronic devices for recording organising, transmitting, manipulating, and reviewing text, data, audio images and video files; accessories, parts. fittings and testing apparatus for all of the aforesaid goods; automatic vending machines and mechanisms for coin-operated apparatus; facsimile machines, answering machines, telephone-based information retrieval software and hardware; fonts, typefaces, type designs and symbols in the form of recorded data; telecommunications apparatus and instruments; telecommunications equipment, apparatus and instruments; computer and electronic games; computer software and computer hardware apparatus with multimedia and interactive functions, computer gaming machines; microprocessors, memory boards, monitors, displays, keyboards, cables, modems, printers, videophones, disk drives: central processing units, circuit boards: integrated circuits; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; mousepads; batteries; rechargeable batteries; chargers; chargers for electric batteries: headphones; cameras; video cameras; telephones; cordless telephones, mobile telephones; parts and accessories for mobile telephones; portable digital electronic devices for data processing, information processing, storing and displaying data, transmitting and receiving data, transmission of data between computers, and software related thereto: handheld digital electronic devices for data processing, information processing, storing and displaying data, transmitting and receiving data, transmission of data between computers., and software related thereto; hand held computers, personal digital assistants, electronic organizers. electronic notepads; handheld and mobile digital electronic devices for the sending and receiving of telephone calls, faxes, electronic mail, video,

instant messaging, music, audiovisual and other multimedia works, and other digital data; telephones; handheld and mobile digital electronic devices for the sending and receiving of telephone calls, faxes, electronic mail, and other digital media; computer software; computer programs; pre-recorded computer programs for personal information management, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multi-media content, software featuring musical sound recordings, entertainment-related audio, video, text and multi-media content, computer software and firmware for operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; computer software for authoring, downloading. transmitting, receiving, editing, extracting; encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications, downloadable electronic publications in the nature of books, plays, pamphlets, brochures, newsletters, journals, magazines and periodicals on a wide range of topics of general interest; computer hardware and software for providing integrated telephone communication with computerised global information networks; electronic handheld devices for the wireless receipt, storage and/or transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information, software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store and/or associated with a personal computer or a server: computer software for the synchronization of data between a remote station or device and a fixed or remote station or device; sound effect apparatus and instruments (computer software); electronic tone generator (computer software); computer desktop utility software; screen saver software; software for detecting, eradicating and preventing computer viruses; software for data encryption; software for analysing and recovering data; software for computer system backup, data

processing, data storage, file management and database management; software for telecommunication and communication via local or global communications networks, including the Internet; intranets, extranets, television, mobile communication, cellular and satellite networks; software for creating and delivering electronic greeting cards, messages arid electronic mail; software for web design, creation, publishing and hosting: software for access to communications networks including the Internet; instructional material relating to the foregoing; computer disk holders; computer equipment for use with all of the aforesaid goods; electronic apparatus with multimedia functions for use with all of the aforesaid goods; electronic apparatus with interactive functions for use with all the aforesaid goods."

15. This list uses 1081 words, which is almost identical to the number of words used in the list of goods for class 9 of the opponent's earlier registration.[2] In essence, the opponent says that its mark has an enhanced level of distinctiveness through use in relation to all the goods covered by class 9 of the earlier trade mark.

16. The opponent's response to the direction set out in paragraph 10(iv) above (that it should identify where in Mr La Perle's evidence there is an example of the use of the Apple word mark in relation to each of the goods/services for which the mark is claimed to have an enhanced level distinctiveness through use), the opponent pointed to the whole of Mr Perle's statement and many of the exhibits. It is sufficient for present purposes to set out the opponent's identification of the evidence said to support the opponent's claim that APPLE has acquired an enhanced level of distinctiveness through use in relation to:

"Scientific, nautical, surveying, checking (supervision), life-saving apparatus and instruments"

17. According to page 15 of the opponent's representative's letter of 6th September 2016, evidence of use of the mark in relation to these goods could be found in 26 of

[2] However, the words are not in the same order. I also note that there is substantial duplication of terms. For example, 'computer hardware' is listed three times.

the 47 exhibits to Mr La Perle's statement.[3] Some of these documents contain information which is not product specific, such as sales and advertising figures.[4] The rest showed use of APPLE in relation to a range of consumer electronic devices, such as iPhone, iPad, iPod, Mac computers, APPLE watches, Apple TVs, and software application products for use with these goods, such as iTunes. I could not see any obvious connection between these goods and life-saving apparatus and instruments. Therefore, given the apparent similarity between *life-saving apparatus and instruments* and the goods of particular interest to the applicant, i.e. protective helmets and other types of protective equipment, I asked the opponent to identify which of the items listed on page 15 of its letter of 6 September 2016 it considered to be life-saving equipment. I pointed out that in the absence of a satisfactory answer, I was likely to hold that the opponent's mark has no reputation or enhanced distinctiveness for life-saving apparatus and instruments.

18. The opponent responded on 23rd September 2016 pointing that according to Wikipedia:

> "*Lifesaving is the act involving rescue, resuscitation and first aid. It often refers to water safety and aquatic rescue; however, it could include ice rescue, flood and river rescue, swimming pool rescue and other emergency medical services." Accordingly, the Opponent submits that "life-saving equipment" is there for* (sic) *any equipment, tool or item of any sort that can enable an individual to save the life of themselves or another, or be used to assist the rescue of themselves or another, for example by calling for help, sharing their location or finding a way to safety."*

It continued:

> *"The Opponent submits that a number of its products offer life-saving functionalities such that they can be deemed as life saving equipment, including, inter alia, the iPhone, iPad, iPod Touch, Apple Watch and Mac computer devices."*

[3] Exhibits TLP-3, 18,19,20,21, 22, 23, 24,25,26, 27,28, 29,32,33,34,35,36,38,39,40,43,44, 45, 46 & 47
[4] Exhibit TLP-20, 46 and 47

“For example, as is discussed further below, the iPhone, iPad, iPod Touch, Apple Watch and Mac computer devices enable users to make calls and contact people and even enable users to make emergency calls without any network signal, using the various telephone, messaging and video calling functionalities. Further, these devices also enable people to make themselves seen for example using the light and torch features of these devices, which can also be used to signal Morse code and offer an SOS feature for this very purpose (where the SOS message can be signalled in Morse code using the flash light on these Apple devices).”

“*Furthermore, the Opponent notes that there is a very large body of independent evidence available online, including press articles from leading international news sources, detailing instances where the Opponent's products, including for example the iPhone device, have indeed saved people's lives.*

19. The opponent provided some information about five articles that had appeared on various websites describing how the iPhone, or software applications run on it, had, could, or might in the future, save lives. One article appears to have described the use of an iPhone to call emergency services. Another describes a software application for an iPhone that provides a guide to life-saving procedures, and another application which reminds diabetics to test their blood sugar level. A third article describes another software application for iPhones that enables users to sign up to be an organ, eye or tissue donor, and therefore help save someone’s else’s life. The articles themselves are not in evidence. From the limited descriptions provided, I cannot tell what connection the other two articles made between the iPhone and life-saving.

20. The applicant responded to these submissions (1) disputing that the opponent’s goods could properly be described as life-saving equipment, (2) pointing out that communications devices, such as an iPhone can be used after an accident to call for assistance, whereas protective clothing is used to prevent injury, and (3) identifying

numerous reports of misuse of mobile phones resulting in accidents and injuries to drivers and pedestrians.

21. I return to the merits of these arguments below. I record here that, in my view, neither side fully co-operated with case management. The opponent appears to have positively resisted or, at best, paid mere lip service to my directions that it should focus its case in a clear and proportionate manner.

The evidence

22. Much of the opponent's evidence is of dubious relevance or is irrelevant because it is dated after the relevant date, or relates to marks other than APPLE, or relates to the opponent only in a corporate sense, or relates to territories outside the EU. The remainder of the opponent's evidence played virtually no part in the decision set out below. Therefore there is no need to provide the customary summary of this evidence and attempting to do so would be disproportionate to any benefit. Instead I will deal with the opponent's evidence to the very limited extent that it is necessary to do so at the appropriate point in my analysis of the opponent's case.

23. The applicant filed no evidence, at least in the required form of a witness statement, affidavit, statutory declaration, or in any other form than that would be acceptable to a court.[5]

Section 5(2)(b)

24. Section 5(2)(b) of the Act is as follows:

> "5(2) A trade mark shall not be registered if because-
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is

[5] As required by Rule 64 of the Trade Mark Rules 2008

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

Comparison of goods

25. The applicant's goods can be broken down into the following categories:

- Protective and safety helmets, including helmets for sports;
- Bags adapted to carry such goods;
- Protective clothing, including face shields;
- Sports glasses and goggles;
- Apparatus for recording, transmission and re-producing sound, images, health data, distance, time and financial data;
- Recording media, including discs, DVDs, tapes and substrates;
- Cleaning apparatus for recording devices and for discs;
- Safety restraints, other than for vehicle seats and sports equipment.

26. The opponent's earlier EU trade mark was registered in 2013, which is less than 5 years before the date of publication of the contested mark. Therefore, the proof of use provisions in s.6A of the Act do not apply. This means that the opponent can rely on the registration of the earlier mark for all the goods/services for which it is registered without having to show that it has used the mark in relation to any of those goods/services. As Kitchen L.J. explained in *Roger Maier and Another v ASOS*:[6]

> "78. .....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a

[6] [2015] EWCA Civ 220

small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion."

27. The table below sets out the applicant's goods by category[7] together with the closest descriptions of goods I can find from the registration of the earlier mark.

Applicant's goods	Opponent's goods
[1] Protective and safety helmets, including helmets for sports	[1] Life-saving apparatus and instruments
[2] Bags adapted to carry protective and safety helmets	[2] Covers, bags and cases adapted or shaped to contain [life-saving apparatus and instruments], made of leather, imitations of leather, cloth, or textile materials
[3] Protective clothing, including face shields	[3] Life-saving apparatus and instruments
[4] Apparatus for recording, transmission and re-producing sound, images, health data, distance, time and financial data	[4] Apparatus for recording, transmission or reproduction of sound or images; recording apparatus; chronographs [time recording apparatus]; distance recording apparatus; portable digital electronic devices for data processing, information processing, storing and displaying data, transmitting and receiving data, transmission of data between computers, and software related thereto; electronic devices that enable the user to keep track of or manage personal information
[5] Recording media, including discs, DVDs, tapes and substrates	[5] Electronic magnetic recording media

[7] See the decision of the Appointed Person in *Separode Trade Mark,* BL O-399-10, and the judgment of the CJEU in *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau*,[2007] ETMR 35, at paragraphs [30] to [38]

[6] Cleaning apparatus for recording devices and for discs	[6] Accessories, parts, fittings, and testing apparatus for [sound recording apparatus]
[7] Safety restraints, other than for vehicle seats and sports equipment	[7] Life-saving apparatus and instruments; parts, fittings for [life-saving apparatus and instruments]
[8] Sports glasses and goggles	[8] Optical apparatus

28. The goods set out in rows 4 and 5 above are plainly identical.

29. In *Gérard Meric v OHIM,*[8] the General Court stated that:

> "29. …..the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM-Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

30. I find that *cleaning apparatus for recording devices and for discs* is included within *accessories….for sound recording apparatus.* Similarly, *sports glasses and goggles* are included in *optical apparatus.* Therefore the goods set out in rows 6 and 8 of the table set out in paragraph 27 above must also be considered to be identical.

31. The opponent relies on the definition of 'life-saving' from Wikipedia as the basis of its submission that it covers any act "*involving rescue, resuscitation and first aid".* The applicant points out that protective helmets and clothing are intended to prevent accident and injury rather than save lives through "*rescue, resuscitation and first aid".* I accept the applicant's submission. The goods are not identical.

[8] Case T- 133/05

32. Turning to the question of whether they are similar, I note that in the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*,[9] the court stated at paragraph 23 of its judgment that:

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

33. The purpose of *life-saving apparatus and instruments* appears to be to save lives in the event of accidents or emergencies. The purpose of *protective and safety helmets, including helmets for sports* and *protective clothing, including face shields* is to protect the body from injury and thus reduce the risk of serious or life threatening injuries. The purposes are similar. The goods at issue can all be classified at a high level as 'safety equipment'. Both categories of goods also include some that may be worn on the body, e.g. helmets v neck braces, abdominal protectors v life rings. To this extent, the respective goods are similar in nature. However, the nature of other examples of life-saving apparatus, such as fire extinguishers, would have much less in common with the physical nature of protective clothing. Similarly, many of the goods would have different methods of use, but a few would be similar, e.g. helmets v neck braces. The goods are unlikely to be in competition. There may be an element of complementarity between the goods, but the opponent's representatives have not identified any (despite having filed 45 pages of written submissions). The users of the goods may overlap in that businesses that provide protective clothing for their staff may also be consumers of life-saving apparatus, such as fire extinguishers or first aid apparatus. Overall I find the goods set out in rows 1 and 3 of the table at paragraph 27 above to be similar to a medium degree. By extension, this also applies to the bags for these goods as described in row 2 of the table in question.

[9] Case C-39/97

34. I find that *safety restraints, other than for vehicle seats and sports equipment* covers parts and fittings for stretchers and must therefore be considered identical to *parts, fittings for life-saving apparatus and instruments.*

Case law relating to the global assessment of the likelihood of confusion

35. The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of marks

36. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*[10] 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

[10] Case C-591/12P

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."

37. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

38. The marks consist of, or contain, the word APPLE. They are visually, aurally and conceptually similar to this extent. The applicant's mark also includes, as the second element, the word HELMET. This creates a visual and an aural distinction compared to the word APPLE alone. It does not make much difference to the conceptual similarity between the marks because the meaning of APPLE HELMET is no more than the sum of its parts. That is to say that APPLE has the same meaning alone as it does as part of APPLE HELMET, i.e. a fruit. The meaning of HELMET is well known and adds a second and distinct conceptual element to the contested mark. However, bearing in mind that HELMET is descriptive of protective helmets and goods for use with such helmets, the word HELMET will only provide a distinctive conceptual difference from APPLE alone when used in relation to the other goods within the applicant's list of goods, such as recording media.

39. I therefore find that APPLE is the dominant and most distinctive element of the applicant's mark. As APPLE is the first word in the applicant's mark, this remains true (albeit to a lesser degree) even where HELMET is not merely descriptive of the goods of their characteristics.

40. Overall, I find that the marks are similar to a high degree.

Distinctive character of earlier mark

41. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV*[11] the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

42. The word APPLE is not descriptive of any of the goods covered by the earlier mark and set out in the table at paragraph 27 above. On the other hand it is not an invented or fancy word and therefore of an exceptionally high degree of inherent distinctiveness. I find that it is mark with a normal degree of inherent distinctive in relation to the goods at issue.

[11] Case C-342/97

43. The opponent's case is that the mark has acquired an enhanced degree of distinctiveness as a result of the use of the mark by the opponent. In its written submissions the opponent's representatives appear to suggest that APPLE has become highly distinctive through such use, almost irrespective of the goods or services at issue. I do not accept this submission. As Neuberger J. (as he then was) stated in *Premier Brands UK Ltd v Typhoon Europe Ltd:*[12]

> "Another issue of principle between the parties arises from Mr Bloch's contention on behalf of TEL that "the defensive marks have no reputation whatsoever" in that there is no suggestion that the public associate the mark TY.PHOO with any goods other than tea, and that, accordingly, it follows that the defensive marks "are entitled to the most limited protection" only. In this connection, it is accepted on behalf of Premier that, in connection with its claim under Section 10(2), the "likelihood of confusion" and the "likelihood of association with the trade mark" is limited to confusion between (a) the TYPHOON sign, in the way in which it is used and in connection with the goods with which it is used by TEL, and (b) the mark TY.PHOO limited to the goods in connection with which each of the defensive marks is registered.
>
> However, although he accepted that the reputation which has been built up over the past century or so for the TY.PHOO mark in relation to tea plays no part in the exercise required to be carried out under Section 10(2), Mr Arnold contended that the extent of the protection to be accorded to a mark with no reputation depends upon the distinctiveness of the mark, which can either be inherent or acquired, and in this connection he relied on observations of the ECJ in Sabel [1999] RPC 199 at 224, *Canon [1999] RPC 117* at 132 (paragraph 18) and *Lloyd [1999] All ER (EC) 587* at 598 (paragraph 20).
>
> In my judgment, the dispute between the parties in this connection is more apparent than real. I accept that the three decisions of the ECJ to which I have referred support the proposition advanced by Mr Arnold on behalf of Premier. However, it seems to me that they do not detract from what may

[12] [2000] FSR 767

fairly be said to be the fundamental point made by Mr Bloch on behalf of TEL on this aspect, namely that, in connection with a particular registered mark, the less use it has had in connection with the goods for which it is registered, the less distinctiveness it is likely to have acquired, and, therefore, the more the protection claimed for it has to be limited to its inherent distinctiveness. To my mind, that proposition is really no more than the corollary of the principle (accepted by both parties) that the greater the exposure and use of a particular registered mark, the greater its reputation is likely to be, and therefore the greater the protection likely to be afforded to it." (emphasis added)

44. It follows that APPLE can only be accepted as having acquired an enhanced level of distinctiveness in relation to the goods set in the table in paragraph 27 if it has shown sufficient use of the mark in relation to those goods so as to have that effect. It appears to be common ground (and is obvious anyway) that APPLE has been used on very substantial scale in relation to a range of consumer electrical devices such as the iPad, iPhone, iPod, Apple Watch, etc. I therefore find that APPLE has indeed acquired a highly distinctive character in relation to:

"Apparatus for recording, transmission or reproduction of sound or images; portable digital electronic devices for data processing, information processing, storing and displaying data, transmitting and receiving data, transmission of data between computers, and software related thereto; electronic devices that enable the user to keep track of or manage personal information."

45. The opponent's representatives submit that this list should include *life-saving apparatus and instruments.* The arguments in favour of this proposition are set out in paragraphs 18 and 19 above. In *YouView TV Ltd v Total Ltd*,[13] Floyd J. (as he then was) stated that:

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the

[13] [2012] EWHC 3158 (Ch)

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."

46. The correct approach, therefore, is to give the phrase *life-saving apparatus and instruments* its ordinary, natural or core meaning. Approaching the matter this way, I find that the phrase covers goods the primary or main purpose of which is to save lives. I therefore reject the submission made on behalf of the opponent that the phrase should be taken to cover "*any equipment, tool or item of any sort that can enable an individual to save the life of themselves or another".* On this logic, a garden spade would be classified as a weapon because it could be used to inflict a serious injury. That would be absurd.

47. The opponent's representatives provided some examples of journalists purportedly referring to the iPhone as a life-saving device. In fact two of the three examples which include any details about the articles in question, describe software applications for use on the iPhone rather than the iPhone itself. Further, neither of these applications, in use, have the direct effect of saving anyone's life. One provides diabetic users with a reminder to take steps to prevent illness, and the other provides all users with a channel through which to sign up for organ or tissue donation. The third article relates to the use of an iPhone to call for help in an emergency. These three articles are nowhere near sufficient evidence to show that the trade, or average consumers of consumer electronic devices, would naturally refer to an iPhone as *life-saving apparatus* (or instrument)*.* In my view, that is not an ordinary, natural or core description of a smart phone.

48. I therefore find that the opponent has not shown any use of APPLE in relation to *life-saving apparatus or instruments.* It follows that there is no use in relation to any of the goods set out in the table in paragraph 27 above, except for:

> "Apparatus for recording, transmission or reproduction of sound or images; portable digital electronic devices for data processing, information processing, storing and displaying data, transmitting and receiving data, transmission of data between computers, and software related thereto; electronic devices that enable the user to keep track of or manage personal information."

I must therefore approach the assessment of the likelihood of confusion on the basis that the earlier mark has only a normal level of distinctiveness in relation to the remainder of the goods in question.

Average consumer and the selection process

49. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.[14]

50. For this purpose the applicant's goods fall into two categories: (1) protective helmets, bags adapted for such goods, other types of protective clothing, sports glasses and goggles and safety restraints, and (2) apparatus for recording, transmission or reproduction of sound, images or data, cleaning apparatus for sound recording apparatus, and recording media.

51. Average consumers of the goods in the first category may be members of the general public, such as a sportsman or woman, or a workman or woman, or a business purchasing protective or safety equipment for use in a commercial context.

[14] *Lloyd Schuhfabrik Meyer,* CJEU, Case C-342/97

Irrespective of the identity of the user, the safety requirements associated with goods in the first category, is likely to mean that average consumers will pay an above average level of attention during the selection process.

52. Average consumers of the goods in the second category may also be members of the general public or a business. Irrespective of the identity of the user, there are no factors associated with goods in the second category which lead me to believe that average consumers are likely to pay an above (or below) average level of attention during the selection process.

53. There is nothing to indicate that the applicant's goods will be selected in a way that differs from the usual means of selection. I will therefore proceed on the basis that the goods will be selected primarily through visual means, e.g. catalogues, websites etc. but that aural means may also play a part in the selection process, e.g. word of mouth orders and recommendations.

Likelihood of confusion

54. I remind myself that in assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.[15] This means that I must consider the effect of the applicant's use of APPLE HELMET in relation to any apparatus for recording, transmission or reproduction of sound, images or data, cleaning apparatus for sound recording apparatus, and recording media covered by the descriptions of goods in the application, not just the applicant's stated intention to use of the mark in relation to video and sound recording apparatus etc. for use as accessories for protective helmets.

55. I also remind myself that when considering a word mark comprised of two words, the identity or similarity of the first word to an existing trade mark is often more important than the impact of the second word.[16] This is because the beginnings of

[15] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited,* Case C-533/06, the CJEU at paragraph 66 of the judgment
[16] See *Enercon GmbH v OHIM,* T-472/07

marks usually make more of an impression on UK consumers, who read from left to right.

56. Taking into account, in particular:

- That the respective marks are highly similar;
- That the respective goods must be considered to be identical, except for protective helmets, bags therefor, and protective clothing;
- That in respect of protective helmets and bags adapted for carrying such goods, the word HELMET is descriptive and therefore does little or nothing to distinguish the commercial source of the goods;
- That the earlier mark is highly distinctive through use in relation to apparatus for recording, transmission or reproduction of sound, images and certain types of data;
- That the earlier mark has a normal degree of distinctiveness for the remainder of the goods set out in the table at paragraph 27;
- That the average consumer will pay an above average degree of attention when selecting protective helmets/clothing, sports glasses/goggles and safety apparatus, and an average level of attention when selecting the remainder of the applicant's goods;

- I find that use of the applicant's mark in relation to any of the goods in the application will result in a likelihood of confusion on the part of the public, including the likelihood of association.

57. I find that even where the average consumer realises that the marks are different, he or she is likely to believe that the common distinctive word APPLE indicates that they are variant marks used by the same undertaking, or by economically connected undertakings. For example, that APPLE HELMET when used in relation to protective helmets and related goods identifies the same undertaking that uses APPLE as a trade mark in relation to life-saving apparatus. For the reasons I gave earlier, it makes no difference that the opponent has not yet used APPLE in relation to the *life-saving apparatus* for which it is registered.

Outcome

58. The opposition under s.5(2)(b) succeeds in full.

59. There is no need to consider the opponent's alternative grounds of opposition under s.5(3) or s.5(4)(a), or whether the opponent's earlier mark is a well-known mark under the Paris Convention (or for which goods/services) so as to 'double qualify' the mark as an 'earlier trade mark' under s.6 of the Act.

60. Subject to appeal, the application is refused.

Costs

61. The opponent has succeeded and would normally be entitled to a contribution towards its costs. However, I bear in mind that the opponent filed a substantial volume of evidence without first seeking directions as required by Tribunal Practice Notice 1/2015. Further, it was unable or unwilling to comply with the case management directions I gave at the CMC on 9th August 2016. The applicant's own failure to fully co-operate with the spirit of those directions does not justify or excuse the opponent's failure to do so.

62. More generally, the opponent's 'kitchen sink' approach to its pleadings and 'scatter gun' approach to its evidence has unnecessarily overcomplicated what should have been a straightforward opposition. This was exacerbated by a tendency to make profuse and generally poorly focused written submissions.

63. This approach has no doubt added substantially to the necessary cost of this opposition and must have made it more difficult for the applicant – a litigant in person – to understand the strength of the opposition he was being confronted with.

64. There is no doubt that Section 68 of the Trade Marks Act 1994 and Rule 67 of the Trade Mark Rules 2008 give the registrar a wide discretion to award reasonable costs. The Office's practice is to award costs based on a published scale, but as the published Manual of Trade Mark Practice makes clear, awards may be made above

or below scale costs where the circumstances justify it.[17] Litigants who approach opposition proceedings before the Office without showing the required sense of focus and proportionality, and who are unwilling or unable to respond positively to case management directions intended to address these matters, should not expect to recover or pay costs on the usual basis.

65. In view of the opponent's behaviour, I will order the applicant to pay the opponent the cost of the official opposition fee, but no more. I therefore order Mr Nicholas Havercroft to pay Apple Inc. the sum of £200. This should be paid within 14 days from the end of the period allowed for appeal.

Dated this 12TH day of April 2017

Allan James
For the Registrar

[17] See paragraph 5.6 of the Tribunal section of the Manual of Trade Mark Practice

Annex A

Helmets for motorcyclists; Sports eyewear; Sports glasses; Crash helmets; Diving helmets; Helmets for bicycles; Safety helmets; Protection helmets for sports; Abdomen protectors for protection against injury [other than parts of sports suits or adapted for use in specific sporting activities]; Sports goggles; Sport bags adapted [shaped] to contain protective helmets; Protective face-shields for protective helmets; Riding helmets; Helmets (Riding -); Solderers' helmets; Protective helmets; Helmets (Protective -);Safety restraints, other than for vehicle seats and sports equipment; Restraints (Safety -), other than for vehicle seats and sports equipment; Helmets (Protective -) for sports; Protective helmets for sports; Goggles for sports; Sports (Goggles for -); Head guards for sports; Video streaming devices; Devices for streaming media content over local wireless networks; Helmets for motorcyclists; Motorcycle helmets; Sports helmets; Crash helmets; Diving helmets; Helmets for bicycles; Safety helmets; Recording discs; Recording disks; Protection helmets for sports; Magnetic data carriers, recording discs; Audio recording apparatus; Electronic magnetic recording media; Film recording apparatus; Image recording apparatus; Magnetic recording charts; Magnetic recording discs; Magnetic recording tapes; Optical recording media; Portable sound recording apparatus; Recording apparatus; Recording discs [magnetic]; Recording substrates [magnetic]; Recording substrates [optical]; Sound recording tapes; Tape recording machines; Apparatus for recording, transmission or reproduction of sound or images; Sport bags adapted [shaped] to contain protective helmets; Protective face-shields for protective helmets; Instruments for recording heart activity [for scientific purposes]; Apparatus for recording images; Apparatus for recording sound; Compact discs, DVDs and other digital recording media; Riding helmets; Helmets (Riding -); Sound recording discs; Solderers' helmets; Protective helmets; Helmets (Protective -); Sound recording carriers; Time clocks [time recording devices]; Clocks (Time -) [time recording devices]; Chronographs [time recording apparatus]; Helmets (Protective -) for sports; Protective helmets for sports; Sports (Protective helmets for -); Time recording apparatus; Sound recording apparatus; Head cleaning tapes [recording]; Sound recording strips;

Strips (Sound recording); Cleaning apparatus for sound recording discs; Distance recording apparatus; Recording distance (Apparatus for); Digital recording media; Sound and picture recording apparatus; Sound and video recording and playback machines; Sound recording and sound reproducing apparatus and instruments; Football helmets; Apparatus for speech recording and replaying; Electronic machines for recording financial operations; Recording devices for sound and image carriers; Helmets for motorcyclists; Motorcycle helmets; Sports helmets; Crash helmets; Diving helmets; Helmets for bicycles; Safety helmets; Recording discs; Recording disks; Protection helmets for sports; Magnetic data carriers, recording discs; Audio recording apparatus; Electronic magnetic recording media; Film recording apparatus; Image recording apparatus; Magnetic recording charts; Magnetic recording discs; Magnetic recording tapes; Optical recording media; Portable sound recording apparatus; Recording apparatus; Recording discs [magnetic]; Recording substrates [magnetic]; Recording substrates [optical]; Sound recording tapes; Tape recording machines; Apparatus for recording, transmission or reproduction of sound or images; Sport bags adapted [shaped] to contain protective helmets; Protective face-shields for protective helmets; Instruments for recording heart activity [for scientific purposes];Apparatus for recording images; Apparatus for recording sound; Compact discs, DVDs and other digital recording media; Riding helmets; Helmets (Riding -); Sound recording discs; Solderers' helmets; Protective helmets; Helmets (Protective -); Sound recording carriers; Time clocks [time recording devices]; Clocks (Time -) [time recording devices]; Chronographs [time recording apparatus]; Helmets (Protective -) for sports; Protective helmets for sports; Sports (Protective helmets for -); Time recording apparatus; Sound recording apparatus; Head cleaning tapes [recording]; Sound recording strips; Strips (Sound recording -); Cleaning apparatus for sound recording discs; Distance recording apparatus; Recording distance (Apparatus- for); Digital recording media; Sound and picture recording apparatus; Sound and video recording and playback machines; Sound recording and sound reproducing apparatus and instruments; Football helmets; Apparatus for speech recording and replaying; Electronic machines

for recording financial operations; Recording devices for sound and image carriers.