

O-186-18

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3245989
IN THE NAME OF LORD FOR TRADE & INDUSTRY S.A.E**

FOR THE TRADE MARK



IN CLASS 8

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 502033 BY SWISSLOGO AG**

BACKGROUND & PLEADINGS

1. On 25 July 2017, LORD FOR TRADE & INDUSTRY S.A.E (“the registered proprietor”) applied to register the above trade mark. It now stands registered for the following goods:

Class 8: *Blades, namely razor blades; disposable razors; Shaving blades; Shaving cases; Cartridges containing razor blades; Cartridges for razor blades.*¹

2. The application was published for opposition purposes on 13 October 2017 and achieved registration on 22 December 2017.

3. On 12 April 2018, Michael Keith Ching (Mr) & Grace Mary Ching t/a Leach's applied to have the contested trade mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon s. 5(2)(b) of the Act and is directed against all of the goods for which the contested mark is registered.

4. The application relies upon United Kingdom Trade Mark (“UKTM”) 2263911, which was filed on 10 March 2001 and has a registration date of 19 October 2001. It comprises a series of six marks, as follows:

BIG BEN

big ben

Big Ben

B	b	B
I	i	i
G	g	g

B	b	B
E	e	e
N	n	n

At the time the cancellation application was filed, UKTM 2263911 stood in the name of Michael Keith Ching (Mr) & Grace Mary Ching t/a Leach's. The ownership of the mark has since transferred to SWISSLOGO AG² (hereafter “the applicant”). In a letter dated

¹ These represent the goods which remain following a partial surrender initiated by the registered proprietor via form TM23 filed on 21 June 2018.

² As per an assignment which took effect from 22 October 2018.

11 March 2019, the applicant's representative explained that the original cancellation applicant is the director of the mark's existing proprietor and confirmed that the existing proprietor wished to continue the action³.

5. In its application for invalidation, the applicant indicates that it wishes to rely upon some of the goods for which its mark is registered, namely:

Class 8: *Hand tools and implements (hand-operated); cutlery*

6. The cancellation applicant submits that as the competing marks both contain the dominant words BIG BEN and given that the respective goods in class 8 are identical or similar, there is a likelihood of confusion.

7. The proprietor filed a counterstatement in which it denies "all the claims and allegations"⁴ made by the applicant.

8. The cancellation applicant in these proceedings is represented by Tennant IP and the registered proprietor by Trademarkit LLP. Only the applicant filed evidence. Neither party requested a hearing, nor did either elect to file written submissions in lieu.

9. This decision is taken following a careful reading of all the papers, which I will refer to, as necessary.

10. The application 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,

³ An official letter dated 7 February 2019 explained that the new applicant for invalidation should be aware of, and accept, liability for costs reflective of the whole proceedings, in the event that the application is unsuccessful.

⁴ See paragraph 1 of the proprietor's Statement of Case.

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

11. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), 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.”

12. In accordance with section 6 of the Act, the applicant’s mark qualifies as an earlier trade mark. As the mark had been registered for five years or more on the date of the application for invalidation, it is subject to the proof of use requirements contained in ss. 47(2A)-(2E) of the Act. In its application, the cancellation applicant indicated that it had used its earlier mark in respect of the goods listed at paragraph 4. In its notice of defence, the proprietor asked the applicant to provide evidence in support of this claim. The relevant period for proof of use is 13 April 2013 to 12 April 2018.

Evidence

13. The applicant’s evidence comprises a statement of use filed by its representative, Michael Tennant of Tennant IP, dated 15 August 2018. The statement of use is supported by exhibits MT1 to MT5 and written submissions were filed alongside. It is worth noting that the statement of use template populated by the applicant can be used by proprietors in opposition proceedings as a means to set out their evidence. It provides an opportunity for a statement of truth (which, in this case, has been suitably

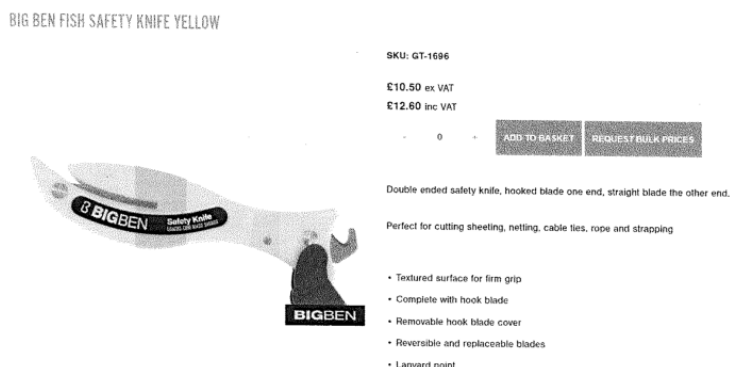
completed) and its admissibility was clarified in a letter from the registry dated 20 August 2018, which reads as follows:

“It is noted that the applicant has used a pro forma which is normally used in opposition proceedings where an applicant has requested the opponent provide proof of use evidence. As the statement of use meets all the necessary requirements, the Tribunal has admitted the document into the proceedings.”

14. The following statements are made within the applicant’s statement of use:

- The earlier mark has been used throughout the UK in relation to *hand tools in class 8, including safety knives*⁵;
- Sales of goods bearing the mark are made mostly online;
- Sales of safety knives bearing the mark “Big Ben” began in 2008. Between 2016 to 2018, 1742 knives were sold in the UK, generating a biannual turnover of £18,291 in respect of “this specific product line”⁶. The recommended retail price for the safety knife is £10.50.

15. Exhibits MT1 to MT5 are screenshots of webpages and a catalogue extract showing various goods for sale bearing the “Big Ben” mark. Exhibit MT1 shows an undated webpage displaying the ‘BIG BEN FISH SAFETY KNIFE YELLOW’ on sale for £10.50⁷ (excluding VAT). In addition to their inclusion in the item description, the words “BIG BEN” are displayed twice on or alongside the item itself, as seen below:



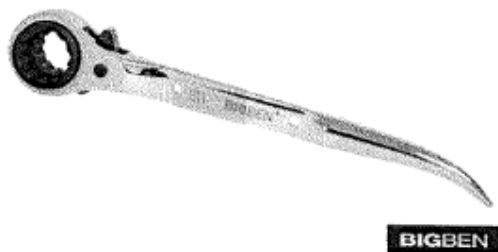
⁵There is no indication from the applicant in its evidence or submissions that its mark has been used in relation to cutlery, despite originally listing this in its application as one of the goods it wishes to rely upon.

⁶ See question 6 of the applicant’s statement of use.

⁷ <http://leachs.net/scaffolding-tools/saws-hammers/leach-s-fish-safety-knife-yellow>

16. The webpage enclosed at exhibit MT2 is headed “BIGBEN” and displays an image of a ‘RESCUE SAFETY KNIFE’ with a product code and description⁸. The words ‘Big Ben’ do not feature in the product description and do not appear to be made out on the item itself. The exhibit is undated and there is no indication as to the item’s cost or availability.

17. At exhibit MT3, a webpage shows a ‘19/23MM STEEL SEMI-FLUSH SHORT PODGER RATCHET’ on sale for £40.15 (excluding VAT)⁹. It provides an image of a ratchet bearing the BIG BEN mark and a brief product description. The page is undated.



18. Exhibit MT4 shows a webpage offering the ‘BIG BEN ALL TITANIUM 7/16” BI-HEX BOX SPANNER’ in a variety of specifications with prices ranging from £87.15 to £88.21 per unit (excluding VAT).¹⁰ The mark has not been applied directly to the spanner. The exhibit is undated.

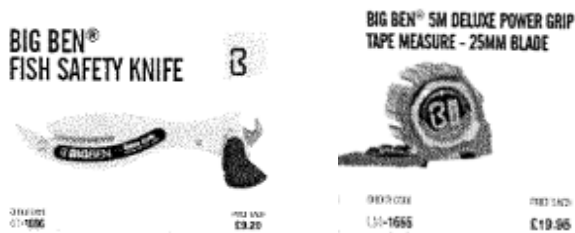
19. Enclosed at exhibit MT5 is a two-page catalogue extract headed ‘LEACH’S HAND TOOLS’. A total of fourteen products are displayed, specifically photographs, order codes and prices. Two of the products’ descriptions begin ‘BIG BEN’. The first is a ‘BIG BEN® 5M DELUXE POWER GRIP TAPE MEASURE – 25MM BLADE’ costing £19.95 (excluding VAT) and the second is a ‘BIG BEN® FISH SAFETY KNIFE’ costing £9.20 (excluding VAT). The words ‘BIG BEN’ are clearly embossed on the safety knife. It is unclear whether the words are inscribed on the tape measure. The applicant has not offered an indication as to when the catalogue was in circulation. I note the exhibit

⁸ <http://www.bigbensafety.com/product-ranges/range-three/rescue-safety-knife>

⁹ <https://leachs.net/scaffolding-tools/scaffold-spanners-ratchets/19-23mm-steel-semi-flush-short-podger-ratchet>

¹⁰ <http://leachs.net/scaffolding-tools/scaffold-spanners-ratchets/big-ben-titanium-bi-hex-box-spanner>

provides a 2018 copyright notice, but whether this was before the end of the relevant period cannot be determined on the basis of the exhibit alone.



DECISION

Proof of use

20. Section 5(2)(b) has application in invalidation proceedings because of the provisions of s.47 of the Act. The first issue is whether, or to what extent, the applicant has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“47. – [...]

(2) The registration of a trade mark may be declared invalid on the ground-

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed”.

21. Section 100 of the Act is also relevant. It states that:

“100. 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”.

22. The case law on genuine use was summarised by Arnold J in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018):

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C- 141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]- [51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at

[37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

23. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not, therefore, genuine use.

Variant use

24. I begin by addressing the matter of variant use. Section 46(2) of the Act provides for use of trade marks in a form differing in elements which do not alter the distinctive character of the mark as registered. In *Nirvana Trade Mark*¹¹, Richard Arnold Q.C. (as he then was), as the Appointed Person, considered the law in relation to the use of marks in different forms and summarised the s.46(2) test as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

25. Although this case was decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum*¹², it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered.

26. In *hyphen GmbH v EU IPO*¹³, the General Court ("GC") held that use of the mark shown on the left below constituted use of the registered mark shown on the right:



¹¹ Case BL O/262/06

¹² *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

¹³ Case T-146/15

27. The court set out the following approach to the assessment of whether additional components are likely to alter the form of the registered mark to a material extent.

“28. [...] a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29. For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30. It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31. It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their

weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).

32. It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009”.

28. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In this instance, the Court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.

29. In *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, Professor Ruth Annand, sitting as the Appointed Person, stated:

“16. A word trade mark registration protects the word itself (here BENTLEY) written in any normal font and irrespective of capitalisation and, or highlighting in bold (see e.g. Case T-66/11, *Present-Service Ullrich GmbH & Co. KG v. OHIM*, EU:T:2013:48, para. 57 and the cases referred to therein, BL O/281/14,).”

30. The earlier mark, as registered, comprises a series of six variations of the words ‘BIG BEN/big ben/Big Ben’, varying to the extent of their respective alignments and which specific letters are capitalised. Although I acknowledge that the mark has been reproduced as registered, in word-only format, throughout the evidence, in several of the applicant’s exhibits, its mark is displayed as follows:



BIGBEN

The words 'BIG BEN' are presented in an unremarkable white font, atop a rectangular black background. Although the words seem to be presented without a space between them, at least one which is identifiable, the first word (BIG) is displayed in bold and the second (BEN) is not, which is likely to encourage consumers to interpret the mark as a composition of two independent words, rather than a single word of six letters.

31. The first question to be answered is where the distinctive character of the registered trade mark lies. Given that each registered series mark comprises only two words, their distinctive character lies in the unit formed by the combination of these words. In my view, the same can be said of the above variant. Nothing turns on the presentation of the text in white and the adopted background does little to alter the mark's distinctive character; instead, it is more likely to be seen merely as a banal surrounding to the mark itself. On that basis, I am satisfied that the mark has been used in an acceptable format, or in other words, a format which does not alter the distinctive character of the mark as registered.

32. I now return to consider genuine use and the extent to which it has been established. The applicant claims to have used its mark throughout the UK in respect of *hand tools in class 8, including safety knives* and states that it sold 1742 safety knives bearing the "Big Ben" mark between 2016 and 2018, generating a biannual turnover of £18,291. The accompanying exhibits are, however, undated and there is no real illustration of consumer engagement to support the sales figures. That said, I have no reason to doubt the accuracy of the sales and turnover figures provided by the applicant in respect of *safety knives* and am willing to accept them as fact. In regard to the exhibits, whilst they are, regrettably, undated, the statement of use populated by the applicant specifically states that the supporting documents should show the mark in use *during the relevant period*¹⁴. In the absence of any evidence to the contrary, or a challenge made by the other side, I am therefore also willing to accept that the goods displayed within the exhibits were available for purchase online and via catalogue during the relevant period. Even if the webpages and catalogue extract originate from after the relevant period, they would have been so close to the relevant period that it is

¹⁴ Question 4 of the statement of use reads: "Please provide a list of examples of the mark in use in the relevant period and indicate against each such entry the goods/services for which you claim it shows use of the mark." In reply, the applicant provides details on exhibits MT1 to MT5.

reasonable to conclude, on the balance of probabilities, that they are representative of what occurred, and what was available, *during* the relevant period. When assessed alongside the relevant case law, I reach the view that, collectively, the information and evidence provided by the applicant is sufficient to demonstrate genuine use. As to the sufficiency of use, whilst not hugely substantial in what is likely to be a considerable market, the sales and turnover figures provided by the applicant are, to my mind, significant enough, particularly as they relate exclusively to only one of its products. With that in mind, I am satisfied that it has shown use made for the purpose of creating or maintaining a (small) share of the market. Specifically *which* goods it has shown use for is a matter to which I now turn.

Fair specification

33. In terms of devising a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Geoffrey Hobbs Q.C., as the Appointed Person, summed up the law as being:

“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”.

34. Carr J summed up the relevant law in regard to fair specifications in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch). This was a revocation case, but the same principles apply here:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].”

35. Though the applicant claims to have used its mark in respect of *hand tools including safety knives*, the only indication of sales and turnover it provides is solely in respect of *safety knives*. Though the exhibits indicate that additional ‘hand tools’ (spanners or ratchets, for example) were listed online during the relevant period, without further clarification or a declaration of related sales, I cannot be certain of the goods’ availability for purchase, nor can I assess their commercial impact. I am not satisfied that the exhibits, in isolation, are sufficient to demonstrate a wider use, particularly to an extent that would allow the applicant to rely on *hand tools* at large. Weighing all factors, particularly the limited nature of its reference to sales and turnover, I consider that a fair specification for the applicant would read as follows:

Safety knives

The listed goods are all that the applicant can rely upon for the purpose of these proceedings.

Section 5(2)(b) - Case law

36. The following principles are gleaned from the decisions of the courts of the European Union 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 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

37. The competing goods, all proper to class 8, are as follows:

Cancellation applicant's goods	Registered proprietor's goods
<i>Safety knives</i>	<i>Blades, namely razor blades; disposable razors; Shaving blades; Shaving cases; Cartridges containing razor blades; Cartridges for razor blades.</i>

38. The applicant's comments regarding the similarity of the respective goods are still relevant following the determination of a fair specification. In its written submissions, it

makes the following statements in support of its contention that the competing goods are similar:

“30. The applicant’s marks have been used in relation to hand tools. Included within this area are knives and safety knives, that are the most suitable goods to cross compare with the goods listed in the Proprietor’s mark.

...

32. It is submitted that for the goods in question, there is no doubt that the relevant users are the general adult public, given the legal restrictions in sales of knives and razor blades. ...

...

34. ...Both knives and razors, are characterised by have (sic) a sharpened edge that carries the main function of cutting things.

35. Knives can be used as a substitute for razors; consumers can use a knife to perform the function of a razor, namely shaving. Whilst this is not a normal function for safety knives, that the Applicant uses their mark upon, the fact that safety knives and shaving knives are highly similar, means that there is a danger of association between the trade origin of razors and safety knives that contain a highly similar mark by the average consumer.”

39. In its counterstatement, the proprietor submits that the respective goods cannot be considered as similar or complementary¹⁵. It offers no further clarification.

40. When assessing similarity, I am guided by the relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, which were as follows:

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

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

¹⁵ See paragraph 5 of the Statement of Case filed alongside official form TM8

(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.

41. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

42. In relation to understanding what terms used in specifications mean or cover, the case law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade” and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning¹⁶.

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

¹⁶ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

"12. ...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."

44. It is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O/399/10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

Blades, namely¹⁷ razor blades; disposable razors; Shaving blades; Cartridges containing razor blades; Cartridges for razor blades

45. The above goods are to be compared with the applicant's *safety knives*. The use of the respective goods is, in my view, not similar. I would categorise the above as implements and accessories used for shaving. The dictionary definition of razors seems to accord with my own understanding¹⁸ and there is no evidence before me to show that razors (or, indeed, razor blades) are used for any other purpose. Such goods are predominantly selected for personal grooming purposes, specifically to remove unwanted hair, whereas safety knives are typically used as tools for cutting through materials or opening boxes, for example. There is likely to be a point of coincidence in the respective users of the goods, both primarily utilised by the general public, and I note the applicant's comments regarding the legal age for purchase, which I accept.

¹⁷ The applicant's mark is not registered for blades at large. Use of the word 'namely' in a trade mark specification limits the preceding term to that which follows it, in this case, it limits 'blades' to razor blades

¹⁸ "A razor is a tool that people use for shaving" (<https://www.collinsdictionary.com/dictionary/english/razor>)

However, given that razors are generally used domestically, there may be an opportunity for a distinction in users as safety knives are also purchased on a wider scale to suitably equip professionals operating in maintenance or facilities management, for example. Even where there is an overlap in users, however, this is somewhat superficial given that the overlap is with the public at large. There is likely to be a correlation, albeit a limited one, in the goods' physical nature, insofar as each will inevitably incorporate a blade of some description, though I would not expect the proprietor's shaving blades or razor blades to be compatible with the applicant's safety knives. I do not see a real opportunity for similarity in the trade channels through which the goods reach the market. To my knowledge, razors are often distributed via traditional retail outlets such as supermarkets or pharmacies, whereas safety knives reach the market more so via trade catalogues and the like, alongside other hand tools. Similarly, I find it highly unlikely that the goods would be sold alongside one another, or even that they would commonly be sold in the same establishment. Though I note the applicant's submission that knives can be used as a substitute for razors, to find that the goods were competitive would, in my view, be an extremely liberal interpretation of their respective purposes. Applying the goods' natural definitions, I find it highly unlikely that consumers could consider one a suitable or realistic alternative to the other. The goods cannot be said to be complementary in line with the relevant case law; they are not used simultaneously, nor are they indispensable for the use of one another. Moreover, to my mind, consumers would not expect the same undertaking to provide both. All things considered, notwithstanding a shared physical characteristic and the possibility for identical users, I do not find the competing goods to be similar.

Shaving cases

46. In my view, shaving cases are even further removed from the applicant's goods than those assessed in the previous paragraph. Shaving cases, to my knowledge, refers to cases used to store, and sometimes transport, one's shaving equipment (razors, shaving blades, cartridges etc). They share the same points of difference with safety knives as the proprietor's remaining goods, insofar as they are used for different purposes, do not share the same channels of trade, will not be sold in any degree of proximity and are not competitive nor complementary. Shaving cases share a further difference in that there is a clear distinction in the physical nature of the respective

goods, where I can see no opportunity for similarity whatsoever. On that basis, I conclude that the respective goods are not similar.

47. In light of my findings, it follows that the application for invalidation cannot succeed as at least a degree of similarity in the competing goods and/or services is necessary to engage a likelihood of confusion. The matter was summarised by Lady Justice Arden in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where she stated:

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

Conclusion

48. The invalidity action has failed and, subject to any successful appeal, registration no. 3245989 will remain on the register.

Costs

49. As the registered proprietor has been successful, it is entitled to a contribution toward its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the proprietor on the following basis:

Considering the other side’s statement
and preparing a counterstatement:

£200

Considering the evidence:

£200¹⁹

¹⁹ This amount is below the scale indication published in Tribunal Practice Notice 2/2016 since the registered proprietor filed no evidence or submissions in response to those filed by the cancellation applicant.

Total:

£400

50. I order SWISSLOGO AG to pay LORD FOR TRADE & INDUSTRY S.A.E the sum of £400. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 9 April 2019

**Laura Stephens
For the Registrar**