

**O-477-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003304965**

**BY BVG GROUP LIMITED**

**TO REGISTER THE TRADE MARKS (SERIES OF 2):**

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**maxivac**

**AND**

**MAXIVAC**

**IN CLASS 7**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 413893 BY**

**SWISSLOGO AG**

## BACKGROUND AND PLEADINGS

1. On 19 April 2018, BVG Group Limited (“the applicant”) applied to register the trade marks (series of 2) shown on the cover page of this decision in the UK. The application was published for opposition purposes on 29 June 2019. Registration is sought for the following goods:

Class 7      Electric cleaning and polishing apparatus; vacuum cleaners; electric pumps and sprayers.

2. The application is opposed by SWISSLOGO AG (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on UK registration no. 3045500 for the mark **max vac**. The opponent’s mark was filed on 6 March 2014 and was registered on 13 June 2014. The opponent relies on all goods for which it’s mark is registered, namely:

Class 7      Hand held vacuum cleaners for industrial purposes; vacuum cleaners for industrial purposes; dust exhausting installations and dust removing installations for cleaning purposes.

Class 11     Dust removing and dust absorbing installations for ventilation purposes.

3. The opponent submits that the respective goods are identical or similar and that the marks are similar.

4. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Tennant IP Limited and the applicant is represented by Richard R Halstead & Co. Ltd. The opponent filed written submissions during the evidence rounds dated 6 February 2019. The applicant filed evidence in the form of the witness statement of Daniel Price dated 4 April 2019. The opponent filed submissions in reply dated 6 June 2019. No hearing was requested and only the applicant filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

6. As noted above, only the applicant filed evidence in the form of the witness statement of Daniel Price dated 4 April 2019, which was accompanied by 3 exhibits. Mr Price is the Managing Director – Core Retail of the applicant.

7. The opponent filed two sets of written submissions during the evidence rounds and the applicant filed written submissions in lieu of a hearing.

8. I have read all of the evidence and submissions and, whilst I do not propose to summarise them here, I have taken them into consideration and will refer to them below where necessary.

## **PRELIMINARY ISSUES**

9. Firstly, I note that a great deal of the applicant's evidence relates to their prior use of the applied for mark, which Mr Price states dates back to 2010. In his statement, Mr Price states:

“This evidence collectively shows that use of the Applicant's trademark was substantial and geographically extensive well before the filing date of the Opponent's mark, rather than being incidental and confined to a particular location within the United Kingdom. It therefore follows that if, as the Opponent alleges, the respective marks are too similar and the respective goods are also too similar, it would be open to the Applicant to seek revocation of the Opponent's mark within the five year period allowed since it was registered expiring on 13<sup>th</sup> June 2019. However, I consider that doing so would constitute an unnecessary expense and is a position the Applicant would only take if forced to do so in these proceedings by an unwillingness on the part of the Opponent to concede that the respective goods and the respective trade channels are different, even if the respective trademarks are somewhat similar, and also that the Applicant is entitled to registration by virtue of long and substantial use of the maxivac trademark.”

10. I assume that the applicant's reference to an application for "revocation" was intended to be a reference to an application for invalidity on the basis of a prior unregistered right. For the avoidance of doubt, the fact that the applicant claims to have used its mark prior to the opponent's mark being applied for/registered, is not a defence in law to the opposition under section 5(2)(b). Tribunal Practice Notice 4/2009 explains this as follows:

*"The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark.*

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

11. The applicant has not sought to invalidate the opponent's mark based on its claim to an earlier unregistered right and, according to Mr Price, has made a conscious decision not to do so. Section 72 of the Act provides that registration shall be taken as prima facie evidence of the validity of a registered trade mark. The opponent's trade mark must be regarded as validly registered and, in these circumstances, the law requires priority to be determined according to the filing dates of the applications for registration. This means that the opponent's mark has priority.

12. In its counterstatement, the applicant has made reference to unrelated proceedings involving the opponent before the EUIPO and stated:

“The Opponent is therefore taking contrary positions in these proceedings which is akin to bad faith in that its submissions to the EUIPO were either true or were untrue. If they were true then the Opponent cannot now argue that the respective trade channels are closer than they actually are, and if they were untrue then the Opponent acted in bad faith when seeking registration before the EUIPO.”

13. The proceedings before the EUIPO concerned a different trade mark and were based upon different grounds. An allegation of bad faith is a serious one and not one that should be made lightly. In any event, the opponent does not seek to rely on the EUTM that was in issue in that case, but rather a UK trade mark, and so whether the EUTM was properly registered is irrelevant to these proceedings.

14. The applicant has made reference to various other marks which include the word MAX currently on the Register. I refer the applicant to the decision of the General Court (“GC”) in *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, when it was stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71).”

15. It is clear from the case law that when assessing the likelihood of confusion under section 5(2), it is necessary to consider the potential for conflict between the applied for mark and the earlier mark in light of all the relevant circumstances. The existence of other trade marks on the Register is not pertinent to the matter before me.

16. Similarly, the applicant has made reference to the fact that there is no evidence of confusion, notwithstanding the fact that it has been using its mark for some time prior to registration. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

17. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

18. If, as the applicant states, the parties are, in practice, targeting different markets then this may very well be the reason that no confusion has occurred. In any event,

consumers who are confused may never know that they have been confused and may not, therefore, report it to the party from which they purchased goods. I do not, therefore, consider this to be relevant to the decision I must make.

## **DECISION**

19. Section 5(2)(b) of the Act states as follows:

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

(a)...

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

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

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if

registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

21. Given its filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. I note that, although the applicant has not formally requested that the opponent prove use of its mark, in his witness statement, Mr Price requests that the opponent provide such evidence. However, as the opponent’s trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. There is no obligation upon the opponent to demonstrate that it’s mark has been used and the opponent can rely upon all of the goods it has identified.

### **Section 5(2)(b) – case law**

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

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

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



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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, 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

23. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<u>Class 7</u> Hand held vacuum cleaners for industrial purposes; vacuum cleaners for industrial purposes; dust exhausting installations and dust removing installations for cleaning purposes.	<u>Class 7</u> Electric cleaning and polishing apparatus; vacuum cleaners; electric pumps and sprayers.
<u>Class 11</u> Dust removing and dust absorbing installations for ventilation purposes.	

24. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, 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."

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

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

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

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

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

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

26. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

27. For the avoidance of doubt, my assessment is a notional assessment of the similarity between the goods covered by the parties’ respective specifications. The particular markets or sectors targeted by the parties are irrelevant for the purposes of my assessment unless it is apparent from their specifications<sup>1</sup>.

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<sup>1</sup> *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

28. “Hand held vacuum cleaners for industrial purposes” in the opponent’s specification will fall within the broader categories of “electric cleaning [...] apparatus” and “vacuum cleaners” in the applicant’s specification. I note that the applicant has made much of the fact that these goods in the opponent’s specification are directly targeted at the industrial sector. Indeed, as the applicant points out, the opponent mentioned this in unrelated EUIPO proceedings. However, whilst some of the terms in the opponent’s specification are limited to being for “industrial purposes” the terms in the applicant’s specification are not limited to the domestic market and would, therefore, cover both domestic and industrial cleaning apparatus. Consequently, the fact that some of the opponent’s goods are limited to the industrial market does not prevent a finding of similarity, or indeed, identity between them.

29. “Electric [...] polishing apparatus” in the applicant’s specification does not, to my mind, cover vacuum cleaners. It also would not cover the other dust removing goods in the opponent’s specification. Vacuum cleaners are not, ordinarily, capable of being used for polishing. The method of use and nature of the goods are likely to differ. However, the Cambridge English Dictionary defined “polish” as “the act of cleaning something by rubbing it<sup>2</sup>”. This term would, therefore, cover certain cleaning apparatus. The goods may overlap in channels of trade as the applicant’s polishing apparatus may form part of a range of cleaning products provided by the same undertaking (such as an industrial cleaning equipment supplier). There may be overlap in user. I consider the goods to be similar to a medium degree.

30. “Electric pumps and sprays” in the applicant’s specification covers a broad range of goods. However, I accept the opponent’s submissions that this would include pumps and sprays used in the cleaning process (such as carpet cleaning equipment). Indeed, the applicant confirms that its own mark has been used in respect of both vacuum cleaners and carpet and upholstery washers and cleaners, suggesting an overlap in trade channels for such goods. I consider there to be an overlap in both user and trade channels. However, the method of use and nature of the goods are likely to differ. I consider the goods to be similar to a medium degree.

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<sup>2</sup> <https://dictionary.cambridge.org/dictionary/english/polish?q=polishing>

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

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

32. In its written submission, the opponent states:

“43) Without repeating the arguments set out when analysing the respective users of the goods in question, it is reasonable to suggest that the average consumer would include a person with an interest in cleaning, be it a professional within the cleaning industry or a member of the public with respect to both parties use of “vacuum cleaners”.

44) With respect to domestic cleaning products, including the Opponent's prior registered “dust removing installations for cleaning purposes”. Then we would expect the average consumer to have a medium/low degree of attention when purchasing products.

45) With respect to industrial cleaning products, including the Opponent's prior registered “vacuum cleaners for industrial purposes”, it is submitted that the average consumer would have a higher degree of attention.”

33. The applicant has made submissions about the markets targeted by the parties. In the case of the opponent's "hand held vacuum cleaners for industrial purposes" and "vacuum cleaners for industrial purposes" I agree that the average consumer will be a professional in the cleaning industry. However, the opponent's other goods, as well as all of the applicant's goods, will be applicable to both industrial and domestic markets. Consequently, the average consumer for the goods will be both professionals in the cleaning industry and members of the general public. A number of factors will be taken into consideration when purchasing the goods such as effectiveness of the product and any specific qualities such as being cordless or light-weight. I accept that professionals may pay a higher degree of attention when purchasing the goods (particularly where industrial equivalents are more expensive) than members of the general public. Overall, I consider that at least a medium degree of attention will be paid during the purchasing process.

34. The goods are most likely to be obtained from retail outlets (such as homeware stores or specialist cleaning suppliers) or their online or catalogue equivalents. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods given that advice may be sought from sales assistants and orders may be placed by telephone.

### **Comparison of trade marks**


35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight

in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

36. 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.

37. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade marks
max vac	 MAXIVAC (series of 2)

38. The opponent's mark consists of two words MAX and VAC. The overall impression lies in the combination of these words. The applicant's marks both consist of conjoined word MAXIVAC. The first mark in the series has some minor stylisation but, as a word only mark can be used in any standard typeface, this stylisation is not significant for the purposes of my comparison. The overall impression lies in the conjoined word itself.

39. Visually, the marks coincide in the presence of the letters MAX and VAC in both marks. They differ due to the additional letter "I" in the applicant's mark. Although the applicant's mark is conjoined, the consumer is likely to separate the words into MAXI and VAC. I consider the marks to be visually highly similar.

40. Aurally, the opponent's mark will be pronounced MAX-VAK and the applicant's mark will be pronounced MAX-EEE-VAK. There is, therefore, an additional syllable in the applicant's mark created by the presence of the additional letter "I". I consider the marks to be aurally highly similar.

41. Conceptually, the applicant submits that there is a distinction to be drawn between the words MAX and MAXI. In his witness statement, Mr Price states:

"[...] I also wish to point out that the term "maxi" is not commonly used as a shortened form of the term "maximum", as in road signs denoting maximum headroom, which invariably referred to "max headroom", but rather as an indicator of relative size, capaciousness or performance, as in maxi dress and sanitary products for women."

42. To my mind, Mr Price's argument is flawed. It appears to me that the use of the word MAXI in all of the examples provided by Mr Price are references to the word maximum, whether it be maximum strength, size or height. I consider that the words MAX and MAXI in both marks will be identified by the consumer as abbreviations for the word "maximum". The applicant submits that the word VAC, in this context, is an abbreviation for "vacuum" and "vacuum cleaner". I agree. I consider that this meaning will be identified in both marks. I consider the marks to be conceptually identical.

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

43. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-



108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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).”

44. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

45. The opponent has not claimed that its mark has acquired enhanced distinctive character and has filed no evidence to support such a claim. I have, therefore, only the inherent position to consider. I have already found that the word MAX will be recognised by the consumer as a shortening of the word “maximum” and that the word VAC, in the context of cleaning products, will be recognised as a shortening of the word “vacuum” or “vacuum cleaner”. The mark will therefore be highly allusive for vacuum cleaners. For these goods, it will be inherently distinctive to a low degree. For the opponent’s other goods, the mark will be more distinctive but to no more than a medium degree.

### **Likelihood of confusion**

46. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

47. I have found the marks to be conceptually identical and visually and aurally similar to a high degree. I have found the earlier mark to have a low degree of inherent distinctive character for vacuum cleaners, with a higher degree of inherent distinctive character for other products (but to no more than a medium degree). I have identified the average consumer to be a member of the general public or a professional in the cleaning industry who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that at least a medium degree of attention will be paid during the purchasing process. I have found the parties' goods to be identical or similar to a medium degree.

48. I note the applicant's submissions in its counterstatement, where it states as follows regarding consumers being used to seeing MAX used as a prefix in trade marks:

"4) [...] In turn, this strongly suggests that consumers are well used to differentiating between these various trademarks having a common prefix, even where they are used in respect of identical goods, because they know that the term "max" is a descriptive prefix in common use and therefore look for other distinguishing factors which together combine to form a sufficiently distinctive trademark for differentiating the goods of one enterprise from those of another."

49. Notwithstanding my comments above about the irrelevance of other marks on the Register, even if it is correct that consumers are used to the word MAX being used as a prefix, the present proceedings relate to marks which not only share the common word MAX (albeit with the addition of an “I” in the applicant’s mark) but also both include the word VAC. This would leave only the presence of the letter “I” to assist the consumer in differentiating between the two marks.

50. Bearing in mind the principle of imperfect recollection and the conceptual identity and high degree of visual and aural similarity between the marks, I am satisfied that the average consumer will mistakenly recall the marks for each other. I recognise that for some goods the opponent’s mark will only be distinctive to a low degree. However, the weak distinctive character of an earlier trade mark does not prevent a likelihood of confusion<sup>3</sup>. I consider that the similarities between the marks are such that they will be mistakenly recalled as each other notwithstanding the fact that at least a medium degree of attention will be paid during the purchasing process. I, therefore, consider there to be a likelihood of direct confusion.

## **FINAL REMARKS**

51. In its counterstatement, the applicant also states:

“A further point is that by virtue of the long use of the Trade Mark by the Applicant, the Applicant is now entitled to registration, more especially given that through inaction or ignorance on the part of the Opponent since registration of the Opponent’s mark in 2014, the Opponent has acquiesced to the continued use of the Trade Mark and allowed concurrent use in the intervening period.”

52. I now turn to the position regarding these defences.

53. Section 48(1) of the Act states as follows:

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<sup>3</sup> *L’Oréal SA v OHIM*, Case C-235/05 P

“48(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right –

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.”

54. Statutory acquiescence does not apply to these proceedings because the provisions relate to the owner of an earlier trade mark acquiescing (for more than five years) to the use of a later registration. In the present case, the application is not yet registered and therefore section 48(1) does not apply.

55. That leaves only common law acquiescence. Guidance on the application of common law acquiescence as a defence in trade mark proceedings can be found in Kerly’s Law of Trade Marks and Trade Names:

“17-107 The issue was considered by the English High Court, sitting as a EU trade mark court, in Marussia Communications Ireland Ltd v Manor Grand Prix Racing, in which Males J relied on the decision of the CJEU in Martin y Paz in coming to the conclusion that defences of estoppel and acquiescence were not available to defendants under the EUTM. The defendant in that case did not argue that substantive national defences were not available to defeat infringement claims, but instead contended that estoppel and acquiescence were procedural matters which fell within art. 129(3) of the EUTM Regulation. That contention was rejected by the court. As the law stands in the UK therefore, national defences of estoppel and acquiescence are not available to defendants in trade mark matters.”

56. It is, therefore, clear that this defence is not applicable in the present proceedings.

57. It is not entirely clear whether the applicant's reference to allowing concurrent use was intended as a pleading of honest concurrent use. However, for the sake of completeness, I will address this point. The *Budweiser* case shows that honest concurrent use may be relevant in trade mark opposition and cancellation proceedings. Further, it also states that circumstances that give rise to this defence would have to be exceptional<sup>4</sup>. For a defence of honest concurrent use to succeed, I would need to be satisfied that the parties have traded in circumstances that the relevant public have been exposed to both marks and have been able to differentiate between them without confusion as to trade origin. The evidence filed by the applicant in this case is limited. The opponent's mark was filed and registered in 2014, and even if they have used it continuously since that date, this would be a period of only 5 years coexistence. There is no suggestion that it was used prior to that date. This is, certainly, low and far from the exceptional circumstances in the *Budweiser* case. I, therefore, dismiss this line of argument.

## CONCLUSION

58. The opposition is successful, and the application is refused.

## COSTS

59. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£800** calculated as follows:

Preparing a statement and considering The applicant's statement	£200
Preparing two sets of written submissions And considering the applicant's evidence	£500

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<sup>4</sup> Paragraph 76, *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09

Official fee £100

**Total £800**

60. I therefore order BVG Group Limited to pay SWISSLOGO AG the sum of £800. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 15th day of August 2019**

**S WILSON**

**For the Registrar**