

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITIONS 91584 AND 91769**

**IN THE NAME OF DE'LONGHI SPA**

**TO TRADE MARK APPLICATIONS 2314377 AND 2314398**

**IN THE NAME OF HOME-TEK INTERNATIONAL LTD.**

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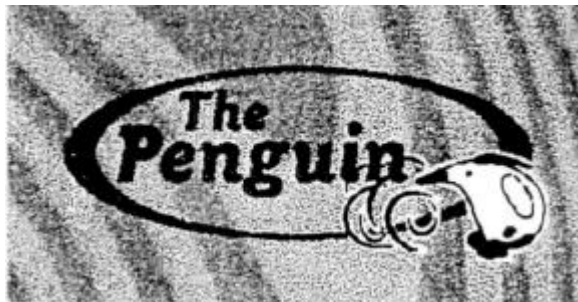
**DECISION**

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**The Oppositions**

1. On 30th October 2002 Home-Tek International Ltd (*“the Applicant”*) applied to register the following signs as trade marks for use in relation to *‘steam cleaning apparatus; hand held steam cleaning apparatus; and parts and fittings for all the aforesaid goods’* in Class 7:

Trade Mark Application 2314377



Trade Mark Application 2314398

**PENGUIN**

2. Both applications were opposed by De'Longhi SpA ("*the Opponent*") under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. The objections under Sections 5(3) and 5(4)(a) are no longer pursued. The objection under Section 5(2)(b) is maintained on the basis that use of the above marks in relation to goods of the kind specified in the applications for registration would conflict with the earlier trade mark rights of the Opponent under the following registrations:

UK Registered Trade Mark 1303781



registered in respect of:

*'installations and apparatus, all included in Class 11 for air conditioning'.*

UK Registered Trade Mark 1422347

**PINGUINO**

registered in respect of:

*'air-conditioning apparatus  
included in Class 11*

Community Trade Mark 2598001

**PINGUINO**

registered in respect of:

*'air-conditioning apparatus  
included in Class 11*

3. In its counter statement the Applicant defended the applications for registration on the bases: (1) that the marks in issue were not similar; and (2) that the goods in issue were completely different.

**The Evidence**

4. In each case the evidence in support of the opposition consisted of a witness statement of Stefano Beraldo with 5 exhibits. The witness statements and exhibits were for all practical purposes identical.

5. Mr. Beraldo identified himself as the legal representative of the Opponent and confirmed that his statements were based on his own knowledge and company records to which he had full and unrestricted access. He gave evidence as follows:

4. My company's PINGUINO brand was first used in the UK in or around 1990, the Mark PINGUINO and the Mark PINGUINO and penguin design being in continuous use in the UK from that time until the present day.

5. There are now produced and shown to me copies of various brochures, sales leaflets and other

advertising materials (marked **Exhibit SB1**) detailing the nature of the goods sold by my company to various outlets in the United Kingdom. Annual turnover figures for the United Kingdom and worldwide in relation to products bearing the PINGUINO Trade Mark are presented in **Exhibit SB2** attached hereto.

6. A significant amount of advertising has taken place in the UK in relation to the PINGUINO brand. Such advertisement has been in the form of television advertisements, radio advertisements, magazine and newspaper advertisements and leaflets. **Exhibit SB3** attached hereto details one such example of an advertising campaign demonstrating use of the Mark in the UK, including advertisements in the national press.

7. The PINGUINO Trade Marks have been used worldwide since at least 1991 and PINGUINO is one of my company's most successful and widely established brands. To support its marketing and promotion approach my company has successfully registered the Trade Mark in a large number of countries. Details of these registrations are attached marked **Exhibit SB4**.

8. The PINGUINO Marks are similar to the Home Tek International Limited application for THE PENGUIN and device as outlined in the Statement of Grounds for Opposition.

9. My Company's Marks comprise the well known Italian word for PENGUIN. The impact of our Registration No. 1303781 is reinforced by the picture of a penguin incorporated in our presentation of the word – the final 'O' being the body. This presentation highlights the similarities between our Mark and the Application in suit, in that the use of the final 'O' in the drawing creates the distinct possibility that our Mark could be seen as PINGUIN and penguin device. There can be no argument that PINGUIN and PENGUIN are not inherently confusable.

10. The application in suit is directed to cleaning apparatus. Our Marks are protected for air purifying (cleaning) apparatus. There is an obvious overlap and substantial potential for confusion. In addition my

Company produces steam cleaning apparatus, and is world renowned for so doing. This is evidenced in **Exhibit SB5** attached hereto. The public will expect steam cleaning apparatus bearing the Mark in suit to have originated with my Company.

11. Should the Applicant succeed in securing registration of the Application in suit, my company stands to suffer significant inconvenience and damage in light of the investment in, and use of, the PINGUINO brand to date.

6. The Applicant elected to file no evidence in answer.

### **The Hearing Officer's Decision**

7. The oppositions were determined without recourse to a hearing. This was done with the consent of the parties. The Applicant filed short written observations in support of its position. The Opponent made no observations in support of its objections to registration.

8. The oppositions were rejected for the reasons given in a written decision issued by Mr. David Landau on behalf of the Register of Trade Marks on 25 August 2004 (BL 0-262-04). He ordered the Opponent to pay the Applicant £800 as a contribution towards its costs of the Registry proceedings.

9. The Hearing Officer was generally unimpressed by the evidence filed on behalf of the Opponent:

10) ... Somewhat unhelpfully, parts of the evidence of De'Longhi relate to air conditioning apparatus sold under the signs Pinguinone and Pinguinone and device. There is no pleading in respect of these signs and the equipment sold under them and so I do not see what bearing they have upon

the case. Mr. Beraldo states that the Pinguino brand was first used in the United Kingdom in 1990 and has been in continuous use since that date.

11) Exhibited at SB2 is a chart of what are described as “air con sales”. Mr. Beraldo states that this shows annual turnover figures for the United Kingdom and the rest of the world in relation to products bearing the Pinguino trade mark. As there is no indication of sales in the United Kingdom or the European Union, I cannot see that these figures can assist me.

12) Various material relating to the Pinguino air conditioners is exhibited at SB1. Certain of the material advises that the air conditioning units can also be used as dehumidifiers and air heaters. However, there is no indication of the dates from when the material emanates other than an advertisement from H&V News, which is dated 25 May 1991. Exhibited at SB3 are details of an advertising campaign for Pinguino, all of the material relates to 1991. Also exhibited at SB 3 are two pages headed “Analisi standard”. The document is in Italian. No explanation of what the details of the document are supposed to signify are given. There is no reference to Pinguino or even De’Longhi in the document. I have no idea what De’Longhi expects me to make of this unexplained document.

13) Exhibited at SB4 are a list of Pinguino trade marks from across the world. I cannot see how these have any bearing upon the case. At SB5 pages downloaded from the Internet on 21 October 2003 are exhibited. These show that De’Longhi, at that time, made steam cleaners under the names Sanisteam, Steam It Clean and Scopa.

10. He went on to observe: *‘There is no indication of publicity since 1991’* (paragraph 14); *‘The exhibited evidence of use stops in 1991’* (paragraph 16); *‘I have nothing to suggest that the De’Longhi trade marks are distinctive of the goods’* on the basis of use (paragraph 16) and *‘On the evidence before me I could*

*not conclude that there is any residual goodwill or reputation. If De'Longhi had sold various air conditioners that were still in operation this might establish residual goodwill. I have no evidence to this effect'* (paragraph 16).

11. He did not at any point in his decision consider whether either of the Applicant's marks were '*similar*' to any of the Opponent's earlier trade marks. He rejected the objection to registration under Section 5(2)(b) on the basis that the goods in issue could not be regarded as '*similar*' for the purposes of the relevant statutory test:

19) The goods of the application are for steam cleaning. The goods of the earlier registration are for air conditioning. The purpose and the use are completely different. Consequently, the user will also be completely different; someone who wishes to clean against someone who wishes to lessen the temperature. One would not substitute an air conditioner for a steam cleaner, they are not in competition. I can see no way that the respective goods are complementary to each other. In my experience cleaning apparatus is not mixed with air conditioning apparatus at point of sale. If for sale in a large retail establishment, the respective goods are not likely to be in the same area. The best that can be said of De'Longhi's claim of similarity is that the respective goods are likely to be powered by electricity; which is hardly a firm foundation for similarity. De'Longhi seems to argue that because under other brand names it produces steam cleaning apparatus, that such goods must be similar to air conditioners. The very fact that it uses different brand names suggests the very opposite. That some undertakings produce a large number of goods does not make them similar. On the De'Longhi logic an electric razor and a deep fat fryer are similar, as I know of at least one major electrical goods producer which produces both types of goods.

20) The claim that the respective goods are similar is hopeless. They are quite patently not similar in any

shape or form. To succeed under section 5(2)(b) of the Act the goods have to be similar; that is what the Directive states, it is what the Act states. It is what is pointed out in Sabel BV v. Puma AG [1998] RPC 199:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, ‘there exists a likelihood of confusion on the part of the public’.”

As the respective goods are not similar, the claim under section 5(2)(b) cannot succeed and is dismissed.

12. It appears from the terms in which he expressed himself that the Hearing Officer found it unnecessary to assess the similarity of the marks in issue because he found it impossible for an objection under Section 5(2)(b) of the Act to succeed when the goods in issue are ‘*air-conditioning apparatus*’ and ‘*steam cleaning apparatus*’.

### **The Appeal**

13. The Opponent gave notice of appeal to an Appointed Person under Section 76 of the Act contending: (1) that the Hearing Officer had erred by not assessing the objection to registration under Section 5(2)(b) in accordance with the ‘principle of interdependence’; and (2) that the objection to registration should either be upheld on appeal or remitted to the Registrar for further consideration by a different hearing officer. These contentions were developed in argument at the hearing before me.



## **Identity ? Similarity ? No Similarity**

14. The objection to registration that I am now considering must be interpreted and applied in accordance with the provisions of Article 4(1) of the Trade Marks Directive (Council Directive 89/104/EEC of 21st December 1988):

### **Article 4**

#### **Further grounds for refusal or invalidity concerning conflicts with earlier rights**

1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:
  - (a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;
  - (b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

The key concepts for present purposes are those encapsulated by the words '*identical*', '*identity*' and '*similarity*'

15. Sub-paragraph (a) dispenses with the need to establish the existence of a likelihood of confusion when the degree of '*similarity*' between the marks and the goods or services in issue is effectively 100% i.e. they are '*identical*'. In such cases '*a likelihood of confusion shall be presumed*' (see Article 16(1) of the TRIPs Agreement) and the protection afforded to the earlier trade mark is regarded as '*absolute*' (see the 10th recital to the Directive).

16. Sub-paragraph (b) confirms that in cases where the degree of ‘*similarity*’ between the marks and the goods or services in issue is effectively less than 100%, it must be determined whether ‘*there exists a likelihood of confusion on the part of the public*’. The determination must be made in accordance with the guidance provided by the 10th recital to the Directive:

whereas it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion;

whereas the likelihood of confusion, the appreciation of which depends on numerous elements and in particular on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for such protection.

These statements have unquestionably had a controlling effect on the interpretation of sub-paragraph (b).

17. It is firmly established that the appreciation of a likelihood of confusion depends on numerous elements which need to be considered globally, taking account of all factors relevant to the circumstances of the case: Case C-251/95 SABEL BV v. Puma AG [1997] ECR I-6191, paragraph 22.

18. This leads on to the ‘principle of interdependence’ affirmed by the ECJ in Case C-39/97 Canon KK v. Metro Goldwyn Mayer Inc [1998] ECR I-5507 at paragraph 17 and re-affirmed in Case C-342/97 Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV [1999] ECR I-3819 at paragraph 19 in the following terms:

That global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital in the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified (see *Canon*, paragraph 17).

19. The reference in the recital to '*recognition of the trade mark on the market*' emphasises the need to take account of the greater or lesser capacity of the protected trade mark to indicate that the goods or services with reference to which it is (or will be) used have originated under the control of a single undertaking which is responsible for their quality. The stronger the mark, the greater the differences between the parties' marks or trading activities may need to be in order to avoid a likelihood of confusion: SABEL paragraph 24; Canon paragraphs 18 and 19; Lloyd Schuhfabrik paragraphs 20 and 21; Case C-425/98 Marca Mode CV v. Adidas AG [2000] ECR I-4861 paragraphs 38 to 41. Conversely the weaker the mark, the smaller the differences that may suffice to avoid a likelihood of confusion: SABEL paragraph 25; The European Ltd v. The Economist Newspaper Ltd [1998] FSR 283 (CA) at p. 290 per Millett LJ; Reed Executive Plc v. Reed Business Information Ltd [2004] RPC 40, p. 767 (CA) at paragraphs 83 to 86 per Jacob LJ.

20. The reference in the recital to *'the degree of similarity between the mark and the sign and between the goods or services identified'* relates directly to the main intended effect of the 'principle of interdependence': that recognisable degrees of similarity between marks and recognisable degrees of similarity between goods or services should be assessed cumulatively when considering whether the likelihood of confusion identified as the specific condition for protection is present or not.

21. It is central to the 'principle of interdependence' that *'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'*. This makes it necessary to enquire whether:

$$X \text{ times } Y \text{ equals } Z$$

where X is the degree of similarity between the marks in issue, Y is the degree of similarity between the goods or services in issue and Z is the existence of a likelihood of confusion.

22. In essence, a claim for protection under sub-paragraph (b) raises a single composite question: are there similarities (in terms of marks and goods or services) that would combine to give rise to a likelihood of confusion in the event of concurrent use of the marks in issue in relation to goods or services of the kind specified? The question falls to be determined from the view point of the average consumer of the goods or services concerned. The average consumer is for this purpose deemed to be reasonably well-informed and reasonably observant and circumspect. Since it is not possible for similarities between marks to eliminate

differences between goods/services or for similarities between goods/services to eliminate differences between marks, the purpose of the assessment must be to determine the net effect of the given similarities and differences. These must be given as much or as little significance as the average consumer would have attached to them at the date as of which the relative rights of the parties fall to be determined.

23. This does not prevent a finding of ‘*no likelihood of confusion*’ by reason of ‘*no similarity*’ between the marks in issue. Hence the ruling in paragraphs 53 and 54 of the Judgment of the ECJ in Case C-106/03 P Vedial SA v. OHIM (12 October 2004):

53. After making a comparative study, at paragraphs 48 to 59 of the judgment under appeal, of the two marks in the visual, aural and conceptual senses, the Court of First Instance concluded, as stated at paragraph 65 of the judgment, that the marks could in no way be regarded as identical or similar for the purposes of Article 8(1)(b) of Regulation No. 40/94.

54. Having found that there was no similarity between the earlier mark and the mark applied for, the Court of First Instance correctly concluded that there was no likelihood of confusion, whatever the reputation of the earlier mark and regardless of the degree of identity or similarity of the goods or services concerned.

I see no reason to doubt that a finding of ‘*no likelihood of confusion*’ may also be made by reason of ‘*no similarity*’ between the goods or services in issue.

24. However, pre-emptive findings to that effect should only be made when the degree of dissimilarity between the marks in issue or the degree of dissimilarity

between the goods or services in issue is clearly sufficient, in and of itself, to preclude the existence of a likelihood of confusion. The required degree of dissimilarity is identified in Part 2 of the Opposition Guidelines published by the Community Trade Marks Office in final form in March 2004 (available at <http://oami.eu.int/EN/mark/marque/pdf/guidelines-oppo-fv.pdf>). As noted in the Conclusion to Chapter 2B:

... in assessing the likelihood of confusion, all factors are relevant and interrelated. Consequently, the examination may be closed due to a dissimilarity of the goods at issue only if the same conclusion would have been reached even if the signs were identical and the earlier mark was highly distinctive. This has to be expressly mentioned in the decision.

and in the Conclusion to Chapter 2C:

... due account must be taken of the principle that all factors of likelihood of confusion are interrelated with each other. This means that a conclusion of dissimilarity of signs, without taking into account the other factors of likelihood of confusion in the specific case, can only be arrived at if the same conclusion would have been reached even if the goods and services were identical and the earlier mark was highly distinctive. This has to be expressly mentioned in the decision.

25. Short of that, the degree of dissimilarity is a factor to be taken into account as part of the global assessment envisaged by the case law I have summarised above. I am reinforced in that view by the recent Judgments of the Court of First Instance in Case T-296/02 Lidl Stiftung & Co. KG v. OHIM (15th February 2005) at paragraph 59:

... it must be concluded that the goods in question are more dissimilar than they are similar. However, the differences between them are not sufficient of themselves to exclude the possibility of a likelihood of confusion, in particular where the mark applied for is identical to an earlier mark which is particularly distinctive (see paragraph 48 above).

and Case T-169/03 Sergio Rossi SpA v. OHIM (1st March 2005) at paragraphs 67 and 68:

67. Accordingly, the Board of Appeal's finding that the differences between the goods outweigh the similarities must be upheld.

68. However ... the goods do have some points in common, in particular the fact that they are sometimes sold in the same sales outlets. The differences identified between the goods are therefore not so great as to rule out, by themselves, the possibility of a likelihood of confusion, particularly where the mark applied for is identical to an earlier mark which is distinctive to a particularly high degree (see paragraph 53 above).

26. As between marks, the criteria for determining whether there is '*similarity*' conducive to the existence of a likelihood of confusion are well-known and I do not need to repeat them here. There is '*similarity*' to be assessed under Article 4(1)(b) when there are elements of visual, aural or conceptual resemblance that may enable the later mark to exploit the distinctiveness of the earlier mark.

27. As between goods and services, the criteria for assessing whether there is '*similarity*' conducive to the existence of '*a likelihood of confusion*' remain loosely defined. In Canon at paragraph 23, the ECJ stated:

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 end users and their method of use and whether they are in competition with each other or are complementary.

28. Paragraphs 44 to 47 of the Advocate General's Opinion shed further light on the position adopted by the Court:

44. ... In assessing the similarity of the goods or services it will be helpful to have regard to the factors suggested by the United Kingdom and French Governments.

45. According to the United Kingdom Government, the following type of factors should be taken into account in assessing the similarity of goods or services:

- (a) the uses of the respective goods or services;
- (b) the users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the 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 in competition with each other: that 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;



46. Whilst recognising that that list of factors is not exhaustive, the United Kingdom Government observed at the hearing that it nevertheless indicates a common denominator which should be present in all factors taken into account in assessing the similarity of goods or services: namely that the factors are related to the goods or services themselves.

47. The French Government likewise considers that, in assessing the similarity of the goods and services, the factors to be taken into account should include the nature of the goods or services, their intended destination and clientele, their normal use and the usual manner of their distribution.

The factors identified in paragraph 45 of the Advocate General's Opinion were derived from the judgment of Jacob J. in British Sugar plc v. James Robertson & Sons Ltd [1996] RPC 281 at pp. 296, 297.

29. By applying such criteria the decision taker can assess the relatedness of the areas of trading activity involved in the comparison. That is a matter which has a direct bearing on the likelihood or otherwise of confusion. It is ultimately a matter of perception.

30. I consider that there is '*similarity*' to be assessed under Article 4(1)(b) when the nature of the goods or services in issue or the context and manner in which they are supplied or used may enable the later mark to exploit the distinctiveness of the earlier mark. The need for evidence in relation to this aspect of the objection to registration was emphasised in Canon at paragraph 22:

It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. ... Article 4(1)(b) provides that the likelihood of

confusion presupposes that the goods or services covered are identical or similar.

Such evidence is needed in order to substantiate the proposition that people in the market for goods or services of the kind in issue would be likely to see a link between them and attribute responsibility for their quality to a single undertaking or economically linked undertakings if they were marketed under the same trade mark or distinctively similar trade marks.

31. The operation of Article 4(1)(b) is clearly not confined to situations in which the parties are (or will be) traders engaged in a common field of activity under the mark(s) in issue. Quite how far beyond that the objection can extend consistently with the concept of '*similarity*' between goods and services is a matter on which there is room for more than one view. Pending further guidance from the ECJ on that point, I think the right course is to avoid the pre-emptive approach to determination (see paragraphs 23 and 24 above) in cases where there is room for doubt as to the conclusiveness of the degree of dissimilarity between the goods or services in issue.

### **The Present Case**

32. I am troubled by two aspects of the present case. First, the evidence filed on behalf of the Opponent was inadequate for the purpose of providing the Hearing Officer with the material required for a fully informed assessment of the degree of '*similarity*' between the goods in issue (see Canon paragraph 22). Second, it appears to me that the Hearing Officer underestimated the position when he found that '*the best that can be said of De'Longhi's claim of similarity is*

*that the respective goods are powered by electricity'* and that the goods in issue are '*quite patently not similar in any shape or form*'.

33. I recognise that different consumer needs and requirements are fulfilled by air conditioning apparatus on the one hand and steam cleaning apparatus on the other. I am not satisfied that the two types of apparatus would generally or invariably reach consumers through different outlets or different sections of the same outlet. From a technical point of view, both types of equipment are designed to provide fluid flow (gas in the form of air, water in the form of steam) under temperature controlled conditions using pumps, compressors and heat exchangers in electro-mechanical assemblies designed to perform the desired function. I do not accept that the design and manufacture of air conditioning equipment is so far removed from the design and manufacture of steam cleaning equipment as to make them entirely unrelated areas of industrial activity or that people in the market for such equipment would unhesitatingly have thought that to be the case in October 2002. I consider, on the basis that the degree of dissimilarity between the two types of equipment is not sufficient, in and of itself, to preclude the existence of a likelihood of confusion, that the objection to registration should not have been determined on the pre-emptive basis adopted by the Hearing Officer in the paragraphs of his decision that I have quoted in paragraph 11 above. To that extent the appeal is, in my view, well-founded.

34. That leaves the Opponent in an awkward position. The evidence relating to use of the earlier trade marks suffers from the deficiencies identified by the Hearing Officer (see paragraphs 9 and 10 above). The Opponent has not attempted

to suggest otherwise on appeal. In view of the weaknesses in the evidence, the distinctiveness of the earlier marks falls to be assessed without any additional weighting for use.

35. The earlier trade marks 'speak Italian' to those by whom they are likely to be seen and heard. In doing so they prompt recollections of the English word PENGUIN. The concept of a PENGUIN and the expression of it in Italian give the marks a relatively high degree of distinctive character. The depiction of a penguin reinforces the message of the verbal matter in the earlier device mark.

36. The opposed trade marks 'speak English' to those by whom they are likely to be seen and heard. They use the English word PENGUIN to prompt recollections of a penguin. The depiction of a penguin reinforces the message of the verbal matter in the opposed device mark.

37. The degree of similarity between the marks in issue is appreciably less than 100%. I think it is conducive to the existence of a likelihood of confusion, but within a narrower range than could have been the case if the distinctiveness of the earlier marks was shown to have been amplified through use and the marks in issue were effectively identical.

38. The critical question is (and was from the outset of the opposition proceedings) whether people in the market for the goods in issue would be likely to see a link between them and attribute responsibility for their quality to a single undertaking or economically linked undertakings if they were marketed concurrently under the marks in issue.

39. Having commented on the similarity of the marks in issue, Mr. Beraldo went on to make the following assertions in relation to the goods in issue:

There is no obvious overlap and substantial potential for confusion.

In addition my Company produces steam cleaning apparatus and is world renowned for so doing. This is evidenced in Exhibit SB5 attached hereto.

The public will expect steam cleaning apparatus bearing the Mark in suit to have originated with my Company.

As the Hearing Officer pointed out in his decision, Exhibit SB5 simply contained pages downloaded from the Internet on 21 October 2003 indicating that at that point in time the Opponent was manufacturing and marketing steam cleaning equipment under the designations **SANISTEAM**, **STEAM IT CLEAN** and **SCOPA**.

40. These assertions in Mr. Beraldo's witness statements seem to treat it as self-evident that (in the terms I have used in paragraph 21 above) X times Y equals Z. However, that is not self-evident in the circumstances of the present case. Without evidence sufficient to substantiate that proposition the objection to registration could not succeed. The evidence on file is plainly not sufficient to substantiate that proposition (and here I would refer, in particular, to what was said by the ECJ in Canon at paragraph 22). The objection to registration must therefore be rejected.

## **Conclusion**

41. The appeal is dismissed. Since I have no reason to believe that the Applicant has incurred costs in this connection, the appeal is dismissed with no order as to costs.

Geoffrey Hobbs Q.C.

20 May 2005.

Ms. Anna Edwards-Stuart instructed by Messrs. Murgitroyd & Company appeared as Counsel on behalf of the Opponent.

The Applicant was not represented.

The Registrar was not represented.