

O/197/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2560828
BY OXFORD BROOKES UNIVERSITY

AND

OPPOSITION THERETO UNDER NO 101577
BY BROOKES (UK) LIMITED

IN THE MATTER OF application
No 2560828 by Oxford Brookes
University and opposition thereto
under No 101577 by Brookes (UK) Ltd

Background

1. Application No 2560828 stands in the name of Oxford Brookes University (“OBU”), seeks registration of the trade mark BROOKES and was applied for on 7 October 2010. Registration was originally sought for a range of goods and services in classes 9, 12, 14, 16, 18, 21, 25, 26, 28, 35, 38, 41, 42 and 43.

2. Following publication in the *Trade Marks Journal*, various notices of opposition to the registration were filed. OBU later requested various amendments to its application and all but one of the opposition actions were later withdrawn. The opposition that remains was filed by Brookes (UK) Ltd (“BUK”). The opposition was against certain goods and services in classes 9, 25 and 35 only. In response to a letter from the Trade Marks Registry, BUK advised that the amendments did “not allow” BUK’s opposition to be withdrawn.

3. Whilst BUK has indicated its intention to continue with its opposition as originally filed, it has not provided any submissions or other explanation of its continued opposition in respect of goods in class 25. The application for registration of goods in class 25 has been removed in its entirety as a result of the amendments made to the application. This part of the opposition therefore falls away and I shall say no more about it.

4. That leaves OBU’s application in respect of goods and services in classes 9 and 35. Following amendment, the specification of goods and services now sought is as follows:

Class 9

Scientific, surveying, photographic, cinematographic, weighing, measuring, signalling, supervision, teaching, instructional and educational apparatus and instruments; teaching, instructional and educational apparatus and instruments provided online via the internet or any other interactive electronic platforms [for the purposes of e-learning]; educational programmes; sound recordings and audio-visual recordings; digital and pre-recorded videotapes, cassettes, compact discs and DVDs, laser discs, phonographic records; podcasts; vodcasts (video casts); data carriers including discs, memory devices and cards; pre-recorded data carriers including discs, memory devices and cards; recording discs; calculating machines, data processing equipment and computers; recorded media; computer hardware and firmware; computer software; computer software programs; software downloadable from the Internet; electronic publications, periodicals and magazines; digital music; computer games equipment adapted for use with an external display screen or monitor; computer games programs; video games programs; mouse mats; mobile phone accessories; magnets (decorative); advertising boards [mechanical or luminous]; access control cards [encoded or magnetic]; banking cards [encoded or

magnetic]; security passes [magnetic]; bags for photography, filming or sound recording apparatus (adapted); cartoons (animated).

Class 35

Accountancy; administration of business affairs; business advisory service; business management consultancy services; research services relating to business; research services relating to marketing; licensing of the goods and services of others (commercial administration of the-); benchmarking; careers counselling and advice (other than education and training advice); charitable services, namely business management and administration; compilation of statistical data for use in scientific research; distribution of prospectuses and other promotional materials related to higher education; production of video recordings for promotional purposes; advertising; promotional marketing; retail services in the field of clothing, stationery, printed matter, computer equipment and peripherals, home entertainment products, trinkets and other memorabilia related to higher education, substances for laundry use and cleaning, soaps, perfumery, essential oils, cosmetics, hair lotions, body care products and beauty care, toiletries, eau de colognes, candles and wicks for lighting, keyrings (of metal), hand tools and implements (hand operated), cutlery, razors, calculating machines, data processing equipment and computers, microscopes, chemistry apparatus, computer software, jewellery, precious stones, artistic objects, decorative objects, tableware (except cutlery), articles made of precious metals or coated therewith, mugs, tankards, trophies, belt buckles, boxes, photo frames, hair brushes, cufflinks, tiepins, watches, cufflink boxes, wrapping paper, address books, folders for papers, notepads, bags of paper or plastic for packaging, gift tags, ring binders, pencil boxes, clipboards, gift boxes, writing paper and envelopes, box files, calendars, envelopes, erasing products, files, fountain pens, greeting cards, pen cases, pencil holders, pencil sharpeners, pencils, pen holders, pens, postcards, posters, table napkins of paper, lithographic works of art, index cards, leather and imitations of leather, and goods made of these materials and not included in other classes, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, pocket wallets, purses, attaché cases, luggage, bags, briefcases, credit card holders, cheque book holders, personal organisers, furniture, mirrors, picture frames, frame mouldings, plugs (wooden stakes), non-metallic boxes, goods of glass, porcelain and earthenware for household and kitchen use, works of art of glass, porcelain and earthenware, combs, chinaware, glassware, porcelain ware and earthenware, bowls and pots, crystal glassware, decorative enamel boxes, textile products, textile material, curtains, blinds, household linen, table linen and bed linen, fabric furniture covers, handkerchiefs, napkins, place mats, fabrics, footwear (not shoes for athletics), headgear, sports and leisurewear, headwear, lace and braid, buttons, hooks and eyes, pins and needles, eyelets, badges, brooches, sewing boxes, thimbles, carpets, rugs, mats and matting, games and playthings, toys, soft toys, plush toy, cuddly toys, gymnastic and sporting articles not included in other classes, decorations for Christmas trees, sporting equipment, electronic games and puzzles, playing cards, chemistry sets, apparatus for physical exercises, scientific games, coffee, tea, coca, sugar, rice, artificial coffee, confectionery, flours, fine pastries and condiments, biscuits, sweets, fresh fruits and vegetables, seeds, natural plants and flowers, house plants, nursery plants, potted plants, flower bulbs, shrubs, herbs, logs, Christmas trees, ornamental trees, alcoholic beverages (except beers),

wines, spirits and liqueurs, sparkling wines, champagne wines and champagne, enabling customers to conveniently view and purchase those goods in a retail store or over the internet; and excluding retail services in the field of goods related to cycling or goods for cyclists' use.

5. The opposition is founded on grounds under sections 5(1), 5(2)(a) and 5(4)(a) of the Act. In respect of the objections under sections 5(1) and 5(2)(a), BUK relies on the following trade mark:

Mark and No	App/Regn Date	Specification
2320174 BROOKES	9 January 2003 24 August 2007	Class 35 The bringing together, for the benefit of others, of a variety of clothing, footwear and headgear, (being industrial work wear, protective wear and safety wear), ear plugs, ear defenders, ear protectors, protective visors, safety helmets, gloves for protection against accident and/or injury, protective face shields, protective face shields adapted for use with helmets, protective masks, welding masks, filters for use in protective masks, respirators for protective purposes, safety harnesses, safety ropes, fall arrest apparatus, fall arrest blocks, batteries, bulbs, tarpaulin, tie-down straps, security chains, warning lights, warning lamps, security lights, security lamps, alarms, sound alarms, smoke alarms, security alarms, fire alarms, intruder alarms, timers, digital timers, torches, step ladders, cable reels, closed circuit television cameras, scaffold sheeting, fire retardant sheeting, fire bells, adhesive tape for floors, packing tape, masking tape, electrical tape, anti-slip tape, hazard warning tape, hazard warning cones, hazard warning signs, hazard warning barriers, traffic cones, protective knee pads, lamp brackets, cone brackets, key cabinets, tool pouches, engraving machines, temporary traffic signs, danger signs, fire exit signs, safety signs, information signs, pedestrian control signs, traffic control signs, detachable scaffolding signs, Data Protection Act complaint CCTV signs, first aid signs, bandages, plaster, dressings, wipes for medical use, eye wash, eye wash kits, eye wash dispensers, resuscitators, pulse readers, medicated creams, medicated ointments, medicated gels, medicated salves, soap dispensers, gel dispensers, cleaner dispensers, plastic bowls, plastic buckets, air freshener, brushes, brush heads, polish dispensers, tissue dispensers, toilet roll, toilet roll dispensers, food hygiene packs, kits and refills therefor, first aid packs, kits and refills therefor, industrial work bags, regulatory notices, regulatory wall charts, enabling customers to conveniently view and purchase those goods; provision of information to customers and advice and assistance in relation to the

		selection of goods; customer loyalty schemes; advertising and promotional services including direct mail advertising; setting up, organisation, administration, operation and supervision of customer loyalty, sales, incentives and promotional activity schemes; information, consultancy and advisory services relating to the aforesaid services.
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6. In respect of the objection under section 5(4)(a), which again is directed only at certain goods and services in classes 9 and 35, BUK claims to have used the mark BROOKES throughout the UK since at least 1999 in relation to the following services:

Retail services connected with the sale of a variety of clothing, footwear and headgear, being industrial work wear, protective wear, safety wear and promotional clothing, and with work safety equipment such as ear plugs, ear defenders, ear protectors, protective glasses, protective visors, safety helmets, gloves for protection against accident and/or injury, protective face shields, protective face shields adapted for use with helmets.

7. OBU filed a counterstatement in which it admits the marks are identical but denies the respective goods and services are similar such that there is no likelihood of confusion. It also denies the claims made under section 5(4)(a) of the Act.

8. Both parties filed evidence and neither requested to be heard. Neither party filed written submissions in lieu of attendance at a hearing. I will refer to the evidence as necessary later in my decision.

Decision

The objections under sections 5(1) and 5(2)(a) of the Act.

9. The relevant sections of the Act state:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

10. An “earlier trade mark” is defined in section 6 of the Act. It states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(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.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

11. In determining the question under section 5(2)(a), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead

rely upon the imperfect picture of them he has kept in his mind and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

12. BUK relies on its registration No 2320174 as shown above. It qualifies as an earlier trade mark under the above provisions. The earlier mark completed its registration process less than five years before the publication date of the mark for which registration has been applied, and thus, under the provisions of section 6A of the Act, BUK is not required to prove use of its earlier mark.

Comparison of marks

13. There is no dispute that the respective trade marks are identical.

Comparison of goods and services

14. BUK's earlier mark is registered in respect of services in class 35. It opposes OBU's application under both sections 5(1) and 5(2)(a) for the following goods in class 9: *optical apparatus and instruments in the form of safety glasses*. The continued objection in respect of these goods takes no account of the amendment to the specification in this class made by OBU. It is clear from the wording of the respective specifications that they are not identical and I can see nothing in the specification of the earlier mark that would lead me to conclude that they are similar to the goods as are now included within OBU's application.

15. That leaves BUK's opposition to OBU's application under section 5(1) and 5(2)(a) of the Act insofar as it seeks registration for certain services in class 35. I take into account 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 trade¹". Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning². Consideration should be given as to how the average consumer would view the services³. In assessing the similarity of services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary⁴.

16. I have to consider the respective specification of services on a notional and fair basis and bear in mind the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

"67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed."

17. I am also mindful of the findings of the Court of First Instance (now General Court) in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

"71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of

¹ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

³ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

⁴ *Altecnic Ltd's Application* [2002] RPC 34

the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

18. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28, Jacob J gave advice as to how similarity should be assessed. He identified the following factors to be taken into account:

- (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.”

19. In *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, Jacob J further stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meaning attributable to the rather general phrase.”

20. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (*OHIM*) Case T-325/06 the General Court stated:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for

those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM- Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05, *Saint-Gobain Pam v OHIM –Promamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM –Bolaños Sabri (PiraNam diseño original Juan Bolaños)* [2007] ECR-1-0000, paragraph 48).”

21. Finally, in *Gérard Meric v OHIM*, Case T-133/05, the General Court said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

22. The respective services to be compared are:

BUK’s earlier mark	OBU’s application
<p>The bringing together, for the benefit of others, of a variety of clothing, footwear and headgear, (being industrial work wear, protective wear and safety wear), ear plugs, ear defenders, ear protectors, protective visors, safety helmets, gloves for protection against accident and/or injury, protective face shields, protective face shields adapted for use with helmets, protective masks, welding masks, filters for use in protective masks, respirators for protective purposes, safety harnesses, safety ropes, fall arrest apparatus, fall arrest blocks, batteries, bulbs, tarpaulin, tie-down straps, security chains, warning lights, warning lamps, security lights, security lamps, alarms, sound alarms, smoke alarms, security alarms, fire alarms, intruder alarms, timers, digital timers, torches, step ladders, cable reels, closed circuit television cameras, scaffold sheeting, fire retardant sheeting, fire bells, adhesive tape for floors, packing tape, masking</p>	<p>retail services in the field of clothing, stationery, printed matter, computer equipment and peripherals, home entertainment products, trinkets and other memorabilia related to higher education, substances for laundry use and cleaning, soaps, perfumery, essential oils, cosmetics, hair lotions, body care products and beauty care, toiletries, eau de colognes, candles and wicks for lighting, keyrings (of metal), hand tools and implements (hand operated), cutlery, razors, calculating machines, data processing equipment and computers, microscopes, chemistry apparatus, computer software, jewellery, precious stones, artistic objects, decorative objects, tableware (except cutlery), articles made of precious metals or coated therewith, mugs, tankards, trophies, belt buckles, boxes, photo frames, hair brushes, cufflinks, tiepins, watches, cufflink boxes, wrapping paper, address books, folders for papers,</p>

<p>tape, electrical tape, anti-slip tape, hazard warning tape, hazard warning cones, hazard warning signs, hazard warning barriers, traffic cones, protective knee pads, lamp brackets, cone brackets, key cabinets, tool pouches, engraving machines, temporary traffic signs, danger signs, fire exit signs, safety signs, information signs, pedestrian control signs, traffic control signs, detachable scaffolding signs, Data Protection Act complaint CCTV signs, first aid signs, bandages, plaster, dressings, wipes for medical use, eye wash, eye wash kits, eye wash dispensers, resuscitators, pulse readers, medicated creams, medicated ointments, medicated gels, medicated salves, soap dispensers, gel dispensers, cleaner dispensers, plastic bowls, plastic buckets, air freshener, brushes, brush heads, polish dispensers, tissue dispensers, toilet roll, toilet roll dispensers, food hygiene packs, kits and refills therefor, first aid packs, kits and refills therefor, industrial work bags, regulatory notices, regulatory wall charts, enabling customers to conveniently view and purchase those goods; provision of information to customers and advice and assistance in relation to the selection of goods; customer loyalty schemes; advertising and promotional services including direct mail advertising; setting up, organisation, administration, operation and supervision of customer loyalty, sales, incentives and promotional activity schemes; information, consultancy and advisory services relating to the aforesaid services.</p>	<p>notepads, bags of paper or plastic for packaging, gift tags, ring binders, pencil boxes, clipboards, gift boxes, writing paper and envelopes, box files, calendars, envelopes, erasing products, files, fountain pens, greeting cards, pen cases, pencil holders, pencil sharpeners, pencils, pen holders, pens, postcards, posters, table napkins of paper, lithographic works of art, index cards, leather and imitations of leather, and goods made of these materials and not included in other classes, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, pocket wallets, purses, attaché cases, luggage, bags, briefcases, credit card holders, cheque book holders, personal organisers, furniture, mirrors, picture frames, frame mouldings, plugs (wooden stakes), non-metallic boxes, goods of glass, porcelain and earthenware for household and kitchen use, works of art of glass, porcelain and earthenware, combs, chinaware, glassware, porcelain ware and earthenware, bowls and pots, crystal glassware, decorative enamel boxes, textile products, textile material, curtains, blinds, household linen, table linen and bed linen, fabric furniture covers, handkerchiefs, napkins, place mats, fabrics, footwear (not shoes for athletics), headgear, sports and leisurewear, headwear, lace and braid, buttons, hooks and eyes, pins and needles, eyelets, badges, brooches, sewing boxes, thimbles, carpets, rugs, mats and matting, games and playthings, toys, soft toys, plush toy, cuddly toys, gymnastic and sporting articles not included in other classes, decorations for Christmas trees, sporting equipment, electronic games and puzzles, playing cards, chemistry sets, apparatus for physical exercises, scientific games, coffee, tea, coca, sugar, rice, artificial coffee, confectionery, flours, fine pastries and condiments, biscuits, sweets, fresh fruits and vegetables, seeds, natural plants and flowers, house plants, nursery</p>
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	plants, potted plants, flower bulbs, shrubs, herbs, logs, Christmas trees, ornamental trees, alcoholic beverages (except beers), wines, spirits and liqueurs, sparkling wines, champagne wines and champagne, enabling customers to conveniently view and purchase those goods in a retail store or over the internet; and excluding retail services in the field of goods related to cycling or goods for cyclists' use
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23. The specification of BUK's earlier mark includes the bringing together, for the benefit of others, of a range of specified goods enabling customers to conveniently view and purchase those goods. OBU's specification is for retail services enabling customers to conveniently view and purchase specified goods in a retail store or over the internet. Despite the difference in the wording, both specifications are for services which enable a customer to view and purchase various goods at an outlet of some sort. This does not, however, of itself, make the respective services necessarily identical or similar.

24. Whilst certain goods supplied under the respective services may be everyday ones used by the general public and widely available in any number of stores, other goods are more technical and may be available only through specialist suppliers. Still others may be subject to licensing laws and available only through licensed outlets to a limited clientele. The nature of the service, therefore, is likely to differ depending on the particular goods involved which will result in there being different trade channels and different customers. Where, however, there is identity in the particular goods being offered under the respective services, the nature, uses, users and trading channels of the services, will correspond.

25. With the above in mind, I consider the respective services to be identical where the goods being brought together, or retail services offered, enable customers conveniently to view and purchase the following goods:

BUK's earlier mark	OBU's application
a variety of clothing, footwear and headgear, (being industrial work wear, protective wear and safety wear)	clothing, footwear (not shoes for athletics), headgear, headwear
safety helmets, gloves for protection against accident and/or injury	clothing, headgear, headwear
industrial work bags	bags

26. Insofar as the following services are applied for by OBU, I do not consider them to be similar to any of those included within the earlier mark:

Retail services in the field of computer equipment and peripherals, home entertainment products, trinkets and other memorabilia related to higher education, substances for laundry use, perfumery, essential oils, cosmetics, hair lotions, beauty care, eau de colognes, candles and wicks for lighting,

keyrings (of metal), cutlery, razors, calculating machines, data processing equipment and computers, microscopes, chemistry apparatus, computer software, jewellery, precious stones, artistic objects, decorative objects, tableware (except cutlery), articles made of precious metals or coated therewith, mugs, tankards, trophies, belt buckles, boxes, photo frames, hair brushes, cufflinks, tiepins, watches, cufflink boxes, wrapping paper, address books, folders for papers, notepads, bags of paper or plastic for packaging, gift tags, ring binders, pencil boxes, clipboards, gift boxes, writing paper and envelopes, box files, calendars, envelopes, erasing products, files, fountain pens, greeting cards, pen cases, pencil holders, pencil sharpeners, pencils, pen holders, pens, postcards, table napkins of paper, lithographic works of art, index cards, leather and imitations of leather, animal skins, hides, trunks, umbrellas, parasols and walking sticks, pocket wallets, purses, attaché cases, luggage, briefcases, credit card holders, cheque book holders, personal organisers, furniture, mirrors, picture frames, frame mouldings, plugs (wooden stakes), non-metallic boxes, goods of glass, porcelain and earthenware for household and kitchen use, works of art of glass, porcelain and earthenware, combs, chinaware, glassware, porcelain ware and earthenware, bowls and pots, crystal glassware, decorative enamel boxes, textile products, textile material, curtains, blinds, household linen, table linen and bed linen, fabric furniture covers, handkerchiefs, napkins, place mats, fabrics, lace and braid, buttons, hooks and eyes, pins and needles, eyelets, badges, brooches, sewing boxes, thimbles, carpets, rugs, mats and matting, games and playthings, toys, soft toys, plush toy, cuddly toys, gymnastic articles not included in other classes, decorations for Christmas trees, electronic games and puzzles, playing cards, chemistry sets, apparatus for physical exercises, scientific games, coffee, tea, coca, sugar, rice, artificial coffee, confectionery, flours, fine pastries and condiments, biscuits, sweets, fresh fruits and vegetables, seeds, natural plants and flowers, house plants, nursery plants, potted plants, flower bulbs, shrubs, herbs, logs, Christmas trees, ornamental trees, alcoholic beverages (except beers), wines, spirits and liqueurs, sparkling wines, champagne wines and champagne, enabling customers to conveniently view and purchase those goods in a retail store or over the internet;

27. Whilst each of the respective services have a degree of commonality in that they involve retailing, their natures are likely to differ given the divergence in the actual goods being offered for sale which will lead to distinct retail outlets and specialisms. In each case, in my view, the uses, users and trade channels differ from those included within the earlier mark and they are not complementary. The respective services are not similar.

28. That leaves the following services of the application to be considered:

Retail services in the field of printed matter, substances for cleaning, soaps, hand tools and implements (hand operated), posters, goods made of leather or of imitation leather, travelling bags, sports and leisurewear, sporting articles and sporting equipment enabling customers to conveniently view and purchase those goods in a retail store or over the internet

and I go on to consider each in more detail against those services of the earlier mark which I consider provides BUK with its strongest case.

BUK's earlier mark	OBU's application
The bringing together, for the benefit of others, of regulatory notices and regulatory wall charts	Retail services in the field of printed matter and posters

As regulatory notices and regulatory wall charts are printed matter and can often take the form of posters, the respective services in respect of such goods will be identical.

BUK's earlier mark	OBU's application
The bringing together, for the benefit of others, of eye wash	Retail services in the field of substances for cleaning

Given that eye wash is a substance which cleans the eye, I consider the respective services in relation to these goods to be identical.

BUK's earlier mark	OBU's application
The bringing together, for the benefit of others, of soap dispensers	Retail services in the field of soap.

Soap is used to cleanse whilst a dispenser is used to enable the soap to be accessed. Given, however, that soap may come in liquid form and will often be sold in a receptacle which is used not only to contain that liquid but which is adapted for use as a dispenser, there is some complementarity between these goods such that there is a degree of similarity between the respective retail services.

BUK's earlier mark	OBU's application
The bringing together, for the benefit of others, of engraving machines	Retail services in the field of hand tools and implements (hand operated)

I consider OBU's services in the field of hand tools and implements (hand operated) to be included within such services relating to engraving machines as included within BUK's earlier mark as such machines can take the form of a hand operated implement for engraving.

BUK's earlier mark	OBU's application
The bringing together, for the benefit of others, of industrial work wear, protective wear and safety wear	Retail services in the field of goods made of leather or of imitation leather

The retailing of goods made of leather or imitations of it could include the retailing of such goods as leather aprons for e.g. welders, cobblers or blacksmiths and OBU's services in relation to these goods will therefore be identical to those of BUK's earlier mark.

BUK's earlier mark	OBU's application
The bringing together, for the benefit of others, of industrial work bags	Retail services in the field of travelling bags

Travelling bags are used, as the name implies, by travellers to store their clothing or other personal items during a journey or whilst away from home. Industrial work bags are used by workers to carry such items as tools, equipment or materials to or at a job. Whilst the respective services relate to bags which are used to carry things from A to B, their natures are likely to differ, due to the purpose of the bags themselves, as will the users and trading channels. I do not consider these services to be similar (though I have already found BUK's services to be similar to OBU's in relation to bags simpliciter as per *Meric*).

BUK's earlier mark	OBU's application
The bringing together, for the benefit of others, of ear protectors, ear defenders, safety helmets, safety harnesses, protective face shields.	Retail services in the field of sports and leisure wear, sporting articles and sporting equipment

Whilst the items for retail as covered by BUK's earlier mark are items perhaps most commonly used in the construction industry, they have not been so limited. Ear protectors and ear defenders are also items that may be used in gun sports. Similarly, safety helmets and safety harnesses are items used in e.g. rock climbing and abseiling and protective face shields are used in e.g. fencing and cricket. I find the respective services to be identical.

29. Given the identity of both the trade mark and the services, the opposition brought under section 5(1) of the Act succeeds in respect of the following services;

Retail services in the field of clothing, footwear (not shoes for athletics), headgear, headwear, sports and leisure wear, bags, printed matter, posters, substances for cleaning, hand tools and implements (hand operated), goods made of leather or imitations of leather, sporting articles, sporting equipment.

30. As for the remaining services, a likelihood of confusion can only occur where the services are similar. I have found there to be similarity in respect of retail services in the field of soap. In considering whether there is a likelihood of confusion, various factors have to be taken into account. There is the interdependency principle, whereby a lesser degree of similarity between the trade marks may be offset by a greater degree of similarity between services, and vice versa. As I have already indicated, in this case the respective marks are identical and thus there is nothing by which the average consumer of the services can distinguish the trade marks.

31. I also have to consider the distinctive character of the earlier trade mark as the more distinctive it is, the greater the likelihood of confusion. The distinctive character can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the services for

which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings.

32. In this case, the mark is the word BROOKES. In her evidence filed on behalf of OBU, Ms Natasha Louise Williams, deputy head of Legal Services employed by OBU since 2003, exhibits, at NLW2, printouts from the www.britishsurnames.co.uk website. I am given no information of when the information was downloaded (nor, for that matter, the date the information was uploaded) however, I doubt the information contained therein will have changed to any appreciable extent between whenever it dates from and the relevant date. The printout confirms what I have no doubt will be known by many: BROOKES is a surname. According to the printout, BROOKES is ranked at number 392 in the list of most common surnames in the UK and is shared by some 0.033 per cent of the UK population. Whilst it will be known as a surname, the evidence indicates it is not a particularly common one and I consider it to have an average level of distinctiveness.

33. BUK has filed evidence to show the use made of its mark. This evidence takes the form of a single, short, witness statement from Ian Brookes, its managing director. There are no exhibits attached to the witness statement.

34. Mr Brookes states BUK's business was established in 1999 as a direct mail supplier of workwear, work safety equipment and promotional clothing to customers throughout the UK. He states that customers purchase products by telephone, by mail order catalogue and through a website.

35. Mr Brookes states that "our sales of goods under the retail trade mark BROOKES since 1999 have averaged £2.0 per annum" (whilst this figure is somewhat surprising, I note that it is clearly presented and has been entered by hand). Mr Brookes refers to how the mark is 'prominently displayed' in the catalogue and on the website but, as indicated above, he has not exhibited any material that would allow me to judge this. On the basis of the evidence filed, I am unable to find that the distinctiveness of the earlier mark will have been enhanced through its use.

36. Taking into account the identity of the trade marks and the similarity of services, I consider there is a likelihood of confusion in respect of the following services:

Retail services in the field of soap.

37. The opposition brought under section 5(1) and 5(2)(a) of the Act fails in respect of all other services, which I have found not to be identical or similar.

The objection under section 5(4)(a) of the Act

38. Section 5(4)(a) of the Act states:

"5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in the Act as the proprietor of an “earlier right” in relation to the trade mark.”

39. The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position and stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

40. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first.”

41. I note from the relevant case-law that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature. However, being a small player does not necessarily prevent the law of passing-off from being relied upon.

42. In terms of what is required by way of evidence to prove the existence of a goodwill, I note the judgment of Pumfrey J in *South Cone Inc v Jack Bessant*,

Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership) [2002] RPC 19 (“*South Cone*”) where he stated:

“27 There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28 Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

43. As to the relevant date, a similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the General Court in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the General Court stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its nonregistered national mark before the date of filing, in this case 11 March 2000.”

44. As a consequence BUK must establish that at the date of the filing of the application for registration, 7 October 2010, it had a protectable goodwill in the United Kingdom.

45. I have set out above the content of BUK's evidence. The sales figures as given and e.g. the absence of any evidence showing how the mark may have been used, on which goods and when, the absence of any details of any promotion or advertising (and related expenditure) and absence of evidence from the trade or public mean that whilst Mr Brookes states that BUK has built up ‘considerable brand recognition, with associated reputation and goodwill’ under the mark in the UK, it has singularly failed to demonstrate this. The opposition brought under section 5(4)(a) fails.

Alternative specification

46. In a letter dated 15 March 2012, OBU put forward an alternative specification of services to exclude “retail services in the field of clothing, footwear (not shoes for athletics), headgear, sports and leisurewear, headwear” from its application. I have found the opposition based on section 5(1) of the Act to be successful against these services. Whether such services are removed from the specification of the application at the request of OBU or removed from it as a result of my decision, the outcome is the same.

Summary

47. The opposition succeeds on grounds brought under section 5(1) of the Act in respect of the following services:

Retail services in the field of clothing, printed matter, substances for cleaning, hand tools and implements (hand operated), posters, goods made of leather and imitations of leather, bags, footwear (not shoes for athletics), headgear, sports and leisurewear, headwear, sporting articles and sporting equipment, enabling customers to conveniently view and purchase those goods in a retail store or over the internet.

48. The opposition succeeds on grounds brought under section 5(2)(a) of the Act in respect of the following services:

Retail services in the field of soaps enabling customers to conveniently view and purchase those goods in a retail store or over the internet.

49. The opposition fails against all other goods and services of the application on which it was brought.

Costs

50. BUK’s opposition was filed against goods and services in classes 9, 25 and 35 only. It did not amend the basis of its action in any way or file any submissions so as to take into account changes made to the application by OBU. It sought, and was granted extra time to file evidence of use of its earlier mark on the premise that it had a “significant volume of evidence to collect and collate” and it also indicated its intention to file evidence in reply. In the event, the only evidence it filed was a single, short witness statement with no exhibits. OBU also filed evidence in the form of a single witness statement. Whilst OBU’s evidence was much more detailed and was accompanied by a significant number of exhibits, little of it was relevant to the issues to be decided in these proceedings.

51. Taking all matters into account, and in view of the fact that both parties have achieved a measure of success, I consider each should bear its own costs in these proceedings.

Dated this 11th day of May 2012

**Ann Corbett
For the Registrar
The Comptroller-General**