

O-186-13

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND
THE TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1106721
IN THE NAME OF**

RAYFILM S.R.O.

AND THE APPLICATION TO EXTEND PROTECTION IN THE UK TO



LABELS & MEDIA FOR QUALITY PRINTING

IN CLASSES 16, 17 AND 40

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 72413

BY

INNOVIA FILMS LIMITED

BACKGROUND

1. On 20 June 2011, the UK Trade Marks Registry was notified by WIPO of international registration (IR) 325004 (the above mark), in respect of which it had been designated under the relevant provisions of the Madrid Protocol.

2. The designation is in the name of RAYFILM s.r.o. (hereafter the applicant) and is applied for in respect of goods in classes 16 and 17 and services in class 40 of the Nice Classification System¹ as follows:

Class 16:

Self-adhesive paper, cardboard, paper, labels, sheets of paper and similar paper products, printed labels and paper sheets of paper for reprography and polygraphy purposes, stickers of all kinds.

Class 17:

Non-adhesive and self-adhesive films made of polyester, polypropylene, polyvinylchlorid for further mechanical processing, sheets made of films for reprographic and polygraphic purposes.

Class 40:

Mechanical processing (cutting, die-cutting, punching) of paper or foil products, industrial marking of labels and products made of foil.

3. Following acceptance and publication of the designation on 16 March 2012 by the Registry, Innovia Films Limited (the opponent) filed notice of opposition against the application.

3. The ground of opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4. The opposition is directed at all of the applicant's goods and services. The opponent relies upon the eight marks shown below.

| Mark details and relevant dates | Goods and Services |
|--|--|
| CTM: 1234616 MARK: RAYOART Filing date: 8 July 1999 Registration date: 16 June 2000 | Class 16 Plastic materials for packaging (not included in other classes). Class 17: Semi-manufactured plastic materials; plastic materials in the form of films, for other uses than packaging. |

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

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|--|---|
| <p>CTM: 1234640</p> <p>MARK: RAYOFOIL</p> <p>Filing date: 8 July 1999</p> <p>Registration date: 16 June 2000</p> | <p>Class 16 Plastic materials for packaging (not included in other classes).</p> <p>Class 17: Semi-manufactured plastic materials; plastic materials in the form of films, for other uses than packaging.</p> |
| <p>CTM: 5353032</p> <p>MARK: RAYOFACE</p> <p>Filing date: 3 October 2006</p> <p>Registration date: 30 August 2007</p> | <p>Class 16 Plastic and cellulosic films for wrapping.</p> <p>Class 17 Plastic and cellulosic films other than for wrapping.</p> <p>Class 42 Scientific and technological services and research and design relating thereto in the field of plastic and cellulosic films.</p> |
| <p>CTM: 5352968</p> <p>MARK: RAYOWEB</p> <p>Filing date: 3 October 2006</p> <p>Registration date: 6 September 2007</p> | <p>Class 16 Plastic and cellulosic films for wrapping.</p> <p>Class 17 Plastic and cellulosic films other than for wrapping.</p> <p>Class 42 Scientific and technological services and research and design relating thereto in the field of plastic and cellulosic films.</p> |
| <p>CTM: 5912092</p> <p>MARK: RAYOTHERM</p> <p>Filing date: 16 May 2007</p> <p>Registration date: 8 May 2008</p> | <p>Class 16 Plastic and cellulosic films for wrapping.</p> <p>Class 17 Plastic and cellulosic films other than for wrapping.</p> |
| <p>CTM: 8794042</p> <p>MARK: RAYOFORM</p> <p>Filing date: 5 January 2010</p> <p>Registration date: 24 May 2010</p> | <p>Class 16 Plastic and cellulosic films for wrapping.</p> <p>Class 17 Plastic and cellulosic films other than for wrapping.</p> <p>Class 42 Scientific and technological services and research and design relating thereto in the field of plastic and cellulosic films.</p> |

| | |
|---|--|
| TM: 1546190 MARK: RAYOFACE Filing date: 26 August 1993 Registration date: 8 July 1994 | Class 17: Semi-manufactured plastic materials being in the form of films; all included in class 17. |
| TM: 1546249 MARK: RAYOWEB Filing date: 27 August 1993 Registration date: 21 October 1994 | Class 17: Semi-manufactured plastic materials being in the form of films; all included in class 17. |

5. In its statement of grounds the opponent states:

“4. The opposed application consists of the word RAYFILM together with other non-distinctive subject matter. The dominant and distinctive component of the mark is RAYFILM. Film is also descriptive in relation to filmic products such as labels and all of the other goods and services covered by the opposed application. Consequently, when assessing the similarity and likelihood of confusion between the opposed trade mark and the previous registrations of the Opponent, emphasis should be placed on the distinctive first syllable of the Opponent’s mark - namely the prefix RAY. The Opponent has traded for many years in connection with filmic products such as labels under a variety of trade marks all of which contain the prefix RAYO. Assessed individually, or together as a family of trade marks, there is risk of association and consequent confusion between the opposed mark and the various trade marks of the Opponent relied upon in this opposition.”

6. On 14 August 2012 the applicant filed a counter statement in which denies the ground of opposition.

7. Four of the opponent's marks are earlier marks, which, in principle, are subject to proof of use because, at the date of publication of the application, they had been registered for five years.² However, at section 5 of its counter statement the applicant has answered “NO” when asked if it requires the opponent to provide proof of use. Therefore I need consider it no further.

8. Neither party filed evidence in the proceedings, though both filed submissions during the period allowed for filing evidence. Neither party requested a hearing or filed written submissions in lieu.

DECISION

9. Section 5(2)(b) of the Act reads as follows:

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

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

Section 5(2)(b) case law

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, 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 great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks 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.”

Family of marks

11. The opponent’s submissions, set out at paragraph 5 above, indicate that the opponent seeks to rely on a family of marks. In *Miguel Torres SA v OHIM -T-287/06* the General Court stated:

“81 However, according to the above case-law, the likelihood of confusion attaching to the existence of a family of earlier marks can be pleaded only if both of two conditions are satisfied. First, the earlier marks forming part of the ‘family’ or ‘series’ must be present on the market. Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series.”

12. The opponent has filed no evidence to show what use it has made of all, or indeed any, of the marks on which it seeks to rely. Absent evidence of use, I reject any claim to a family of ‘RAYO’ branded marks.

The opponent’s best case

13. The opponent relies on eight earlier marks. The marks which represent the opponent’s best case are CTM8794042 and CTM1234640 which are the closest in terms of construction and letter sequence and represent the widest range of goods and services. If the opponent cannot succeed in respect of these marks it is in no better position with regard to the remaining earlier rights claimed.

The average consumer and the nature of the purchasing act

14. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

15. The average consumer of the goods and services at issue may be a member of the general public purchasing printer labels or a professional seeking scientific and technological services in the field of plastic and cellulosic films. The cost of the goods and services will vary from as little as a few pounds to many thousands of pounds for the commissioning of professional services. The level of attention paid by the consumer will vary accordingly. I would expect an individual or organisation purchasing professional services at high cost to pay considerably more attention to the purchase than a consumer purchasing printer labels.

Comparison of goods and services

16. In comparing the goods and services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

17. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* in which the CJEU stated, at paragraph 23 of its judgment:

“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.”

18. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (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 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, taking into account how goods/services are classified in trade.

19. I also bear in mind the decision in *El Corte Inglés v OHIM* Case T-420/03, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi [2005] ECR II-685)”

20. I also take note of the case of *Les Éditions Albert René V Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM) T-336/03*, where it was held:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

21. Additionally, there is the guidance provided in *Avnet Incorporated v Isoact Limited - [1998] F.S.R. 16 (HC)*:

“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 meanings attributable to the rather general phrase.”

22. Where appropriate I will, for the purposes of comparison, group related services together in accordance with the decision in *Separode Trade Mark BL O-399-10 (AP)*:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

23. The goods and services to be compared are as follows:

| The opponent’s goods and services | The applicant’s goods and services |
|--|---|
| <p>Class 16 Plastic and cellulosic films for wrapping. Plastic materials for packaging (not included in other classes).</p> <p>Class 17 Plastic and cellulosic films other than for wrapping. Semi-manufactured plastic materials; plastic materials in the form of films, for other uses than packaging.</p> <p>Class 42 Scientific and technological services and research and design relating thereto in the field of plastic and cellulosic films.</p> | <p>Class 16: Self-adhesive paper, cardboard, paper, labels, sheets of paper and similar paper products, printed labels and paper sheets of paper for reprography and polygraphy purposes, stickers of all kinds.</p> <p>Class 17: Non-adhesive and self-adhesive films made of polyester, polypropylene, polyvinylchlorid for further mechanical processing, sheets made of films for reprographic and polygraphic purposes.</p> <p>Class 40: Mechanical processing (cutting, die-cutting, punching) of paper or foil products, industrial marking of labels and products made of foil.</p> |

24. The users of the parties' goods in class 16 may be members of the general public or professionals. The opponent's goods are made of plastic whereas the applicant's goods are specifically made of paper. The uses of the goods are different. The opponent's goods are for packaging while the applicant's goods are specifically for 'reprography and polygraphy purposes'. These goods are not likely to be available from the same shelves or areas even if they are available in the same store or website. The goods are neither complimentary nor in competition. Taking all of these factors into account I find the parties' goods in class 16 to be dissimilar.


25. The goods in class 17 of the opponent's specification, 'Plastic and cellulosic films other than for wrapping', include the applicant's goods in class 17. In accordance with *Meric* these are identical goods.

26. When making a finding with regard to the parties' services in classes 42 and 40 I must consider the core meaning of those services in accordance with the judgment in *Avnet*. The opponent's services in class 42 are 'Scientific and technological services' and 'research and design' services, both in respect of 'plastic and cellulosic films'. The applicant's services are for the purpose of 'mechanical processing' of foil products and 'industrial marking' of paper and foil products. In the absence of any submissions from the opponent to explain why it considers the applicant's services in class 40 to be similar to its own services; and having considered the nature of the services, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which the competing services coincide. As a consequence, the applicant's services in class 40 are not, in my view, similar to any of opponent's services.

27. In the case of goods and services which are dissimilar, I need not go on to consider the similarity of the marks, since the test for assessing whether or not there is a likelihood of confusion is a cumulative one.³ The remainder of this decision is made in relation to the goods in class 17 which I have found to be identical.

Comparison of marks

28. The marks to be compared are as follows:

| The opponent's mark | The applicant's mark |
|---|--|
| <p style="text-align: center;">RAYOFOIL</p> <p style="text-align: center;">RAYOFORM</p> |  |

29. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components⁴, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

³ *Vedial SA v Office for Harmonisation in the Internal Market (OHIM) C-106/03*

⁴ *Sabel v Puma AG, para.23*

30. In its submissions the opponent states:

“The goods of the opposed application concern in many respects films, or goods or services which are either very similar to films or which in fact are films.

Consequently, in the opposed application, the suffix of the main word mark, namely - FILM is entirely non-distinctive.

The strapline “labels and media for quality printing” is also entirely non-distinctive.

The logo element, such as it is, comprising an oblong shaded area and a small triangle is also non-distinctive.

The dominant and distinctive component of the trade mark under opposition is the prefix of the main word mark, namely RAY-.

The dominant and distinctive component of the Opponent’s trade marks relied upon in this opposition is, in all cases, the prefix RAYO-.

Consequently, the appropriate assessment to be made in determining whether the opposed application should be refused under Section 5(2)(b) is whether the marks RAY- and RAYO- are confusably [sic] similar. In our submission, they clearly are highly similar both visually and phonetically, and also conceptually.”

31. The applicant’s mark consists of the seven letter word ‘RAYFILM’ shown in white block capitals and presented on a dark blue rectangular background. To the right of the word is a yellow right angled isosceles triangle. Below the rectangle, in smaller block capital letters are the words ‘LABELS AND MEDIA FOR QUALITY PRINTING’. I have no hesitation in concluding that these words in the applicant’s mark are not distinctive in the context of the goods as the phrase merely describes the nature of the goods being provided. The rectangle and triangle are unlikely to be afforded a great deal of significance by the average consumer. It is the word ‘RAYFILM’ which is the dominant and distinctive element of the mark in its totality.

32. The opponent’s marks are both presented as single words in plain block letters and are eight letters long. The distinctiveness of the marks rests in their totalities.

Visual similarities

33. Any visual similarity between the applicant’s mark and each of the opponent’s marks rests in the presence of the letters ‘RAY’ at the beginning of all three marks. The applicant’s mark continues with the letters ‘FILM’. The opponent’s marks continue with the letters OFOIL (which has three letters in common with the second part of the applicant’s mark) and OFORM (which has two letters in common with the second part of the applicant’s mark). None of the marks have a break between any of the letters. All three marks are likely to be considered invented words by the average consumer.

34. Taking all of these factors into account I find there to be a moderate degree of visual similarity between the applicant’s mark and the opponent’s marks.

Aural similarities

35. The applicant's mark will be pronounced 'RAY-FILM'. The opponent's marks will be pronounced 'RAY-O-FOIL' and 'RAY-O-FORM'. The addition of the letter 'O' in the opponent's marks adds an extra syllable to the opponent's marks which is not present in the application. Taking these factors into account I find there to be a low degree of aural similarity.

Conceptual similarities

36. The applicant's mark and each of the opponent's marks consist of single invented words. It is possible within each of the marks to discern known English words i.e. RAY, FILM, FORM and FOIL. However, the presentation of each mark is a single made up word which incorporates one or more of these word elements. In my view, the average consumer will, even where they recognise a particular element of the mark to be a known word, consider each of the marks to be an invented word. Consequently, they have no meaning and are thus conceptually distinct.

Distinctive character of the earlier mark

37. In determining the distinctive character of a trade 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 trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

38. The opponent's earlier marks consist of the invented words 'RAYOFOIL' and 'RAYOFORM'

The marks in their totalities do not serve to describe the goods at issue, nor are they non-distinctive for those goods. Consequently, the marks possess a high level of inherent distinctive character.

Likelihood of confusion

39. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁵ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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 vice versa.

40. I have found that the marks share a moderate degree of visual similarity and a low level of aural similarity. I have also found the parties' marks to be conceptually distinct. I have identified a high level of inherent distinctive character in the opponent's earlier marks. In respect of the parties' goods and services I concluded that the goods in class 17 are identical according to the principles provided in *Meric*.

⁵ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27.

41. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/027⁶, that the first parts of words catch the attention of consumers. However, it is also clear that each case must be decided on its merits considering the marks as wholes. In this case the fact that the first (or only) three letters of each mark are the same does not mean that the overall impression the marks give the average consumer is one of similarity.

42. In my view the fact that the first three letters 'RAY' are present at the start of the applicant's seven letter mark and at the start of both of the opponent's eight letter marks, is not, of itself, sufficient for a finding of a likelihood of confusion. I must also take account of the additional elements in both marks when considering the marks in their totalities.

43. Given the nature of the goods in class 17 it is more likely that the average consumer will be a professional buying film for further mechanical processing or for reprographic/polygraphic purposes. As I have concluded above, in the case of goods and services which are dissimilar, I need not go on to consider the similarity of the marks.⁷ In respect of the remaining goods, in my view the differences between the parties' respective marks are such that, even if the goods were identical and were frequent, low priced purchases deserving of a lower than average level of attention, the marks in their totality are sufficiently different that there is no likelihood of confusion, whether direct (where one mark is mistaken for the other) or indirect (where the average consumer believes the respective goods and services originate from the same or a linked undertaking). The differences between the marks outweigh the similarities. Consequently, in the case of goods bought by professionals, who will be paying a higher level of attention there will be no likelihood of confusion.

Conclusion

44. The opposition fails.

COSTS

45. The opposition having failed, the opponent, is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place and that no evidence or written submissions in lieu of a hearing were filed. I make the award on the following basis:

| | |
|---|-------------|
| Preparing a statement and considering the other side's statement: | £300 |
| Official fee: | £200 |
| Total | £500 |

46. I order Innovia Films Limited to pay RAYFILM s.r.o. the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of May 2013

**Ms AI Skilton
For the Registrar, The Comptroller General**

⁶ *El Corte I és OHIM – Go lez Cabello al d Iberia Lineas Aéreas de Espal al(MUNDICOR) [2004] ECR II –I 965, paragraph 81*

⁷ *The test is a cumulative one, see Vedial SA v OHIM C-106/03*