

O-397-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2607995
BY RICHMOND DESIGNS LIMITED
TO REGISTER THE TRADE MARK:**

RICHMOND
DESIGNING HOSPITALITY

IN CLASS 42

AND:

**OPPOSITION THERETO UNDER NO. 104062
BY DE SPIEGHEL TRADING COMPANY B.V.
& DE SPIEGHEL BEHEER B.V.**

BACKGROUND

1. On 25 January 2012, Richmond Designs Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 10 August 2012 for the following services in class 42:

Advisory services relating to interior design; consultancy services relating to interior design; consultation services relating to interior design; design services for building interiors; design services for the interior of buildings; design services relating to interior decorating for hotels; design services relating to interior decorating for offices; design services relating to interior decoration for homes; design services relating to shop interiors; design services relating to bars and restaurants; furnishing design services for the interiors of buildings; information services relating to the combination of colours, paints and furnishings for interior design; information services relating to the harmonisation of colours, paints and furnishings for interior design; interior design services; interior design services for boutiques; interior design services for shops; interior design services for the retail industry; interior design services for the hospitality industry; interior design services incorporating the principles of feng shui.

2. The application is opposed by De Spieghele Trading Company B.V. and De Spieghele Beheer B.V. (“the opponents”). The opposition, which is directed against all of the services in the application, is based upon grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). For their opposition under both grounds, the opponents rely upon all of the goods in the following trade mark registrations:

CTM no. 9918889 for the trade mark: **Richmond Interiors** applied for on 26 April 2011 and which completed its registration procedure on 12 August 2012:

Class 20 - Furniture, mirrors, picture frames and ornaments of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, not included in other classes; garment hangers; cushions.

Class 21 - Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware, including ornaments, not included in other classes; candlesticks.

CTM no. 9010431 for the trade mark: **Richmond Decoration** applied for on 7 April 2010 and which completed its registration procedure on 6 December 2010:

Class 11 - Apparatus for lighting and heating; lamps.

Class 16 - Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; paintings (pictures), framed or unframed.

Class 20 - Furniture, mirrors, picture frames and ornaments of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, not included in other classes; garment hangers; cushions.

Class 21 - Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware, including ornaments, not included in other classes; candlesticks.

In their notice of opposition the opponents state:

“2... Visually, the earlier marks and the application begin with the identical word RICHMOND. Further, aurally, the earlier marks and the application both reproduce the word RICHMOND which will be pronounced identically by consumers. The elements INTERIORS/DECORATION and DESIGNING HOSPITALITY are non-distinctive for the goods and services at hand and, as such, should be largely disregarded when assessing the similarity of the relevant marks...

3. The application is for services in class 42 which correspond directly to the goods protected in the earlier marks. As such, the goods and services are similar.”

In relation to their ground under section 5(3) of the Act, the opponents state that their trade marks have been put to extensive use in the EU: “in relation to household furniture and other related goods” since at least 2010. Use of the trade mark the subject of the application in the United Kingdom would, they say, take unfair advantage of, or be detrimental to, the distinctive character of their trade marks:

“5...by virtue of the later [trade mark] inevitably trading off the opponents' reputation in its earlier trade marks. In particular, the applicant will gain sales as a result of the association with the opponents' earlier marks. The applicant's use of the later mark in the UK in relation to the services covered by the application would also adversely affect and be detrimental to the opponents' successful and long standing business in the EU. The use of the applicant's mark will clearly reduce the capacity of the opponents' earlier marks to distinguish its goods. As a result, any use of the [the application] by the applicant in relation to the goods

(sic) covered by the application would not only be certain to risk certain confusion, it would blur the distinctiveness of the earlier marks that has been acquired and the opponents' have vigilantly protected its exclusivity in its earlier marks."

3. The applicant filed a counterstatement in which it denies the opponents' claims. Having incorrectly described the opponents' trade marks (they are presented in title rather than upper case), the applicant states:

"1...The contested mark consists of the word RICHMOND together with the distinctive words DESIGNING HOSPITALITY with an additional distinctive graphic device element. The stylisation and additional graphic device element of the contested mark, as well as the additional distinctive wording "DESIGNING HOSPITALITY" are both highly significant as it enables the respective marks, when compared and considered as a whole, to be sufficiently distinguished from one another to negate any potential likelihood of confusion on the part of the relevant public.

2. Furthermore, the services applied for in class 42 of the contested mark are sufficiently dissimilar to the completely different and unrelated goods of the opponents' earlier trade marks in classes 11, 16, 20 and 21..."

Having categorised the opponents' goods as: "those which could be used in everyday life within the household environment", the applicant comments upon the opposition based upon section 5(3) of the Act in the following terms:

"4. The applicant has used, or intends to use, the contested mark on specific services relating to extensive interior design projects for high end international hotel groups, whereby the hotel group engages the applicant's services when deciding to completely refit and/or refurbish a chain of hotels in the UK and numerous other countries worldwide. We submit that the use, or intended use, of the contested mark by the applicant within these areas of business is unlikely to cause public confusion as there are significant differences between the respective parties trading activities and products, differences which will be obvious to the relevant consumer as the point of purchase and/or use for the respective products is completely different. As a result of the different commercial areas in which each party operates, we submit that the contested mark is highly unlikely to take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponents' earlier marks."

4. Whilst only the opponents filed evidence, both parties filed written submissions during the evidence rounds. Although neither party has asked to be heard, the opponents filed written submissions in lieu of attendance at a hearing. I will refer to the various submissions filed, as necessary, below.

The Opponents' evidence

5. This consists of a witness statement from AR Tiggeler, a director of De Spiegel Beheer B.V. The main facts emerging from Mr Tiggeler's statement are:

- The trade marks RICHMOND INTERIOR and RICHMOND DECORATION have been used in Europe since at least 2007;
- The opponents' goods have been promoted at international fairs held in Paris in 2007, 2011 and 2012; in Peterborough in 2007; in Brussels in 2007 and in Frankfurt in 2011 and 2012;
- In the period 2006-2011, sales under the trade marks in Ireland, the United Kingdom, Spain, Germany, France, Austria, Switzerland and "other EU countries" amounted to approximately £10.3m, of which £7.5m represented sales in France and £905k sales in the United Kingdom;
- In the period 2006-2011 some £450,000 was spent promoting the trade marks in the EU (although the total of the annual figures provided actually amount to £340,000).

Mr Tiggeler states:

"7. Given the substantial sales and expenditure on advertising highlighted above, my company has gained a reputation within the EU in respect of the marks."

DECISION

6. Sections 5(2)(b) and 5(3) of the Act read as follows:

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

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

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

(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would

take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

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

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the opponents are relying upon the trade marks shown in paragraph 2 above, which constitute earlier trade marks under the above provisions. Given the interplay between the date on which the application was published and the date on which the opponents’ trade marks completed their registration procedure, the earlier trade marks are not subject to proof of use, as per section 6A of the Act.

The opposition based upon section 5(2)(b)

Section 5(2)(b) – case law

9. 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 Court of Justice of the European Union (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.”

The correct approach to the comparison

10. In its submissions, the applicant refers to, for example, the “nature of the business of the opponent” and, inter alia, comments upon the goods upon which the earlier trade marks are used and the services upon which it uses or proposes to use its trade mark. However, the applicant appears to appreciate that this is not the correct approach, as at various points in its submissions it refers to the “notional” position. As the earlier trade marks are not subject to the proof of use requirements, the actual goods upon which the earlier trade marks may be used or the actual services upon which the applicant may be using or intending to use its trade mark are not relevant. In reaching a conclusion under section 5(2)(b) of the Act, what I must do is, inter alia, compare the goods for which the earlier trade marks are registered to the services for which the applicant seeks registration.

The average consumer and the nature of the purchasing process

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services and then to determine the manner in which these goods and services will be selected by the average consumer in the course of trade. In its submissions, the opponents state:

“3...In this instance, the goods and services in question are not technical in nature, nor are they highly specialised. They are directed at members of the general public and, as a result, the level of attention which consumers will employ when assessing the goods and services will be normal.”

12. The average consumer of all of the opponent’s goods will be a member of the general public. In my experience, such goods will be selected by predominantly visual means having encountered the goods in, for example, retail stores on the high street and on-line, as well as in brochures, magazines and advertisements. The cost of the opponents’ goods will vary markedly; compare, for example, the cost and importance of a comb (in class 21) with the cost and importance of a suite of furniture (in class 20). Whilst I would expect the average consumer of the former to pay a low degree of attention to their selection, this degree of attention will increase significantly (to at least reasonably high) when the same consumer is considering items such as furniture, the selection of which is likely to involve a not insignificant financial outlay and will also engage other considerations such as choice of material, size, style and suitably with existing items.

13. The applicant’s services are, broadly speaking, interior designs services. Where a term in its specification is unlimited, the average consumer will be either a member of the general public or a business user. The services which fall into this category are:

“Advisory services relating to interior design; consultancy services relating to interior design; consultation services relating to interior design; design services for building interiors; design services for the interior of buildings; design services relating to interior decoration for homes; furnishing design services for the interiors of buildings; information services relating to the combination of colours, paints and furnishings for interior design; information services relating to the harmonisation of colours, paints and furnishings for interior design; interior design services; interior design services incorporating the principles of feng shui.”

In relation to the services which remain i.e.


“Design services relating to interior decorating for hotels; design services relating to interior decorating for offices; design services relating to shop interiors; design services relating to bars and restaurants; interior design services for boutiques; interior design services for shops; interior design services for the retail industry; interior design services for the hospitality industry”,

the average consumer is more likely to be a business user.

14. As to how the services will be selected by a member of the general public, interior design services are encountered in much the same way as are the opponents’ goods i.e. in retail settings on the high street and on-line and in various publications and printed matter; as a consequence, visual considerations are, once again, likely to dominate the selection process. Although there is no evidence as to how a business will select such services, I think that visual considerations are also likely to be to the fore, the business concerned encountering the services being offered on, for example, web sites and in trade journals and advertising material directed at the trade. As to the degree of attention paid to the selection of such services, the potential cost and importance of choosing the most suitable interior design service leads to me to conclude that a member of the general public will pay a reasonably high degree of attention to the selection of such services. This level of attention is, in my view, likely to increase significantly when one considers the position from the perspective of a business selecting an entity to undertake the interior design of, for example, a hotel or retail outlet, and the potential costs that are likely to be in play in such circumstances.

Comparison of trade marks

15. The competing trade marks are as follows:

The opponents’ trade marks	The applicant’s trade mark
Richmond Interiors Richmond Decoration	

16. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective trade marks.

Distinctive and dominant components

17. The opponents’ trade marks consist of the words “Richmond” and “Interiors”/“Decoration”; both trade marks are presented in title case. As the words “Interiors” and “Decoration” will, save perhaps for some of the goods in class 16, be seen by the average consumer as descriptors, it is the word “Richmond” which is the distinctive and dominant element of both trade marks.

18. As to the applicant’s trade mark, this consists of the word “RICHMOND” presented in upper case, above the words “DESIGNING HOSPITALITY” also presented in upper case but in a much smaller font; the trade mark as a whole is presented in an unremarkable type face. Although the parties disagree over the distinctive qualities of the phrase “DESIGNING HOSPITALITY” (my own view is that if it has any distinctive character, it must be at a fairly low level), given the size and positioning of the word “RICHMOND” in relation this phrase, it is the word “RICHMOND” which is the dominant and distinctive element of the applicant’s trade mark.

The visual, aural and conceptual comparison

19. As both parties’ trade marks contain the word “Richmond”/“RICHMOND” as their distinctive and dominant elements, and bearing in mind what I consider to be the descriptive and non-distinctive nature of the elements which accompany this word (which leads me to further conclude that these additional elements are unlikely to be articulated when the competing trade marks are referred to) there is, in my view, a high degree of visual and aural similarity between the competing trade marks. Insofar as conceptual similarity is concerned, as the word RICHMOND is, in my view, likely to evoke surnominal or geographical connotations (or both) in the mind of the average consumer, the degree of conceptual similarity is also high.

Comparison of goods and services

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

The opponents’ goods	The applicant’s services
Class 11 - Apparatus for lighting and heating; lamps.	Class 42 - Advisory services relating to interior design; consultancy services relating to interior design; consultation

<p>Class 16 - Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; paintings (pictures), framed or unframed.</p> <p>Class 20 - Furniture, mirrors, picture frames and ornaments of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, not included in other classes; garment hangers; cushions.</p> <p>Class 21 - Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware, including ornaments, not included in other classes; candlesticks.</p> <p>NB: The goods in classes 20 and 21 of both earlier trade marks are identical.</p>	<p>services relating to interior design; design services for building interiors; design services for the interior of buildings; design services relating to interior decorating for hotels; design services relating to interior decorating for offices; design services relating to interior decoration for homes; design services relating to shop interiors; design services relating to bars and restaurants; furnishing design services for the interiors of buildings; information services relating to the combination of colours, paints and furnishings for interior design; information services relating to the harmonisation of colours, paints and furnishings for interior design; interior design services; interior design services for boutiques; interior design services for shops; interior design services for the retail industry; interior design services for the hospitality industry; interior design services incorporating the principles of feng shui.</p>
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21. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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.

22. In its submissions the opponents state:

“9. The services claimed in the application overlap with the goods covered by the earlier trade marks. The goods complement the services claimed in the application. The design services which are claimed by the applicant will be provided together with the opponents’ goods. For example, lighting, paintings, furniture and household equipment are required, or at least considered, for the applicant to provide its services. The goods covered by the earlier marks will be used, or at least referred to, in the provision of the services in class 42 [OAMI opposition no. B287765 dated 20 December 2002 refers]. There is also a natural business extension from providing design services into providing goods related to the field in question [OAMI opposition no. B409179 dated 28 November 2002 refers].”

23. In its submissions, the applicant states:

“13...Even if one considers the notional position, bearing in mind the additional classes relied upon by the opponent, the respective end users are significantly different and it would be far fetched to argue otherwise.

14. As regards the respective methods of use, the sale and completion of its interior design services by the applicant is clearly different to any methods of use that the opponent may employ in relation to its goods, either actually in relation to the general domestic furniture or notionally based on the scope of the goods covered by the opponent’s earlier trade marks.

15. It is obvious that the applicant and opponent are not in competition with each other. In fact, their respective core businesses are completely unrelated and non-competitive. It is also clear that the respective services of the applicant and the goods of the opponent are not offered in the same or even remotely similar trade and distribution channels.

16. It is also far fetched and highly speculative to argue that the respective businesses are complementary...The scope of the opponents' earlier trade marks does not extend to the applicant's core business in the context of any related services..."

24. Having referred to the decision of the GC in Case T-76/09 - *Mundipharma GmbH, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, in which the court held that: "Storage, distribution, delivery and packaging of pharmaceutical, sanitary, and dietetic preparations" in class 39 were not complementary to: "Pharmaceutical and veterinary preparations, and sanitary products for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants"; in class 5, the applicant states:

"17...In the present case the respective services of the applicant and goods of the opponent are not complementary in the sense that there is a close connection between them i.e. that one is indispensable or important for the use of the other in such a way that consumers may think the responsibility for the production of the goods or for the provision of those services lies with the same undertaking. Furthermore, as these goods and services are neither interchangeable nor substitutable, they are not in competition."

25. In their submissions filed in lieu of attendance at a hearing, the opponents point to the registrar's own guide to cross-searching which indicates that "Design of e.g. fitted kitchens and bedrooms" in class 42 may be considered similar to a trade in "Fitted kitchens and bedroom furniture etc." in class 20. They also refer to two further oppositions decision of OAMI. In the first of these decisions (no.B1170101 dated 10 November 2009), the Opposition Division stated:

"Class 42

The applicant's services *design services namely design of interior and exterior of building structures; architecture relating to the design of interior and exterior décor* are similar to the opponent's goods in class 20, to the extent that it is not at all uncommon to come across furniture, decoration items and accessories as well as decoration and interior design services promoted and offered through the same channels. These goods and services are also complementary",

and in no B1492670 (dated 15 February 2010) the Opposition Division stated:

"Contested services in classes 42: When comparing the applicant's *design services relating to interior decoration; interior design services*; the Office considers that they are remotely similar to the opponent's goods in class 20. *Interior designing and decorating* are services provided by institutions or individuals who are concerned with making a room more attractive by adding ornament, colour, etc., or by proposing solutions for the distribution of a room

and the arrangement of the furniture. The opponent's goods are among others *furniture for the home*. Although the nature of the goods and services are different, they still belong to similar field of activities, they share similar purposes and are complementary. The applicant's *interior designing and decoration services* are commonly offered in the same sales outlets as the opponent's *furniture for the home*. It should be noted that companies such as those which manufacture furniture also develop interior design services in their retail areas. These are services offered without the need to necessarily buy the specific products. Therefore, a certain link between these goods and services cannot be denied."

26. The opponents conclude:

"3.8. The above decisions illustrate that the goods protected in class 20 of the earlier marks are similar to the services claimed in class 42 of the application. They belong to the same field of activities, namely decoration of interiors and therefore have similar purposes. Providers of interior design services are likely to offer furniture, as well as other decorative items, in conjunction with their services."

27. In relation to complementary goods and services, the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

"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-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48)."

In reaching a conclusion, I will also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying to rigid a test when considering complementarity.

28. In reaching a conclusion on the similarity of the goods and services at issue in these proceedings, I have no evidence which assists me; I have, therefore, only my own knowledge and the parties' submissions to guide me. In their submissions, the opponents draw my attention to, inter alia, the registrar's guide to cross searching. Whilst this is only a guide, it does reflect my own experience i.e. when one selects, for example, furniture for one's bedroom or kitchen, it is not unusual to find that in the retail settings in which the goods are selected, the undertaking under whose trade mark the furniture is being sold also provides an interior design service under the same trade

mark. In my experience, such undertakings also provide both furniture and interior design services for use in a commercial setting under the same trade mark. Whilst the nature of the goods and services at issue in these proceedings is different and they are not in competition with one another, they may have the same users and share a similar purpose. There is, in my view, quite a close connection between (at least) furniture in class 20 of the opponents' earlier trade marks and all of the applicant's interior design services. The competing goods and services are, in my view, complementary, and as a consequence, are similar to a reasonable degree.

Distinctive character of the earlier trade marks

29. I must now assess the distinctive character of the earlier trade marks. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

30. Although the opponents have provided the witness statement of Mr Tiggeler in support of their claim to, inter alia, enhanced distinctive character, this statement suffers from a number of defects. For example, in his statement Mr Tiggeler does not: (i) provide any exhibits showing how the trade marks are actually used, (ii) indicate to which classes in its registrations the turnover figure in the UK relates (in this regard, it should be recalled that the opponents' claim is to have used their trade marks in relation to "household furniture and other related goods") and (iii), provide any indication of how much of the amount spent on promoting the trade marks relates to promotion in the UK.

31. Whilst in its submissions the applicant appears to accept that the opponents have "at best a minimal reputation in the UK in relation to its furniture and associated products", even if I assume that the trade marks have been used in an acceptable format, and the turnover in the UK is all in relation to, for example, furniture, given what is likely to be the size of the market for furniture in the UK, this level of turnover would, in my view, do nothing to improve the distinctive character of the opponents' trade marks beyond their inherent characteristics. When considered on the basis of their inherent characteristics and consisting as they do of the word "Richmond" (which, as I mentioned above is likely to have surnominal/geographical connotations) and accompanied as they are by words which will be considered descriptive, results, in my view, in the opponents' earlier trade marks possessing an average degree of inherent distinctive character.

Likelihood of confusion

32. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the earlier trade marks as the more distinctive these trade marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

33. Earlier in this decision I concluded that: (i) the average consumer of the goods and services at issue is either a member of the public or a business user, (ii) visual considerations are likely to dominate the selection process, (iii) the average consumer's level of attention when selecting the goods and services at issue will vary from low to at least reasonably high, (iv) the word "Richmond"/"RICHMOND" is the distinctive and dominant element of both parties' trade marks, (v) the competing trade marks are visually, aurally and conceptually similar to a high degree, (vi) the competing goods and services are similar to a reasonable degree and (vii), the earlier trade marks are inherently distinctive to an average degree and the evidence of use provided is insufficient to establish that the inherent distinctiveness has been enhanced.

34. In my view, the high degree of similarity in the competing trade marks is, in circumstances where the goods and services are similar to a reasonable degree, sufficient to lead to a likelihood of (at least) indirect confusion i.e. where the average consumer (be it a member of the general public or a business user) assumes that the competing goods and services are provided by undertakings which are economically linked. However, when one bears in mind the descriptive/non-distinctive nature of the words/phrases which accompany the word "Richmond"/"RICHMOND" in both parties' trade marks, direct confusion i.e. where one trade mark is mistaken for the other is, in my view, also a real possibility.

Conclusion under section 5(2)(b)

35. In view of the above conclusions, the opposition to the application based upon section 5(2)(b) of the Act succeeds in full.

The objection based upon section 5(3) of the Act

36. Having succeeded in full under section 5(2)(b) of the Act, there is, strictly speaking, no need for me to consider this ground of opposition. However, for the sake of completeness, I will deal with it briefly.

37. The principles to be applied when determining an objection under this ground were summarised by the Hearing Officer, Allan James, in BL O-179-11 as follows:

“(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors Corp v Yplon SA* [2000] RPC 572 (CJEU), paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU), paragraph 51.

(c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10 (CJEU), paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and between the respective goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; *Intel*, paragraph 57.

(f) Where a link is established, the owner of the earlier mark must also establish that it has resulted in the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68: whether this is the case must also be assessed globally, taking account of all the relevant factors; *Intel*, paragraph 79.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel*, paragraphs 76 and 77.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal SA and others v Bellure NV and others* - C-487/07 (CJEU), paragraph 40.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; *L'Oreal*, paragraph 41."

38. It is accepted that the reputation of a Community trade mark in one member state can be sufficient to establish the requisite reputation for the purpose of section 5(3) of the Act - *PAGO International GmbH v Tirol Milch registrierte Genossenschaft mbH Case C-302/07*. In its submission the applicant states:

"25...We do not disagree that the opponent has a reputation in some member states in relation to the goods covered by [the earlier trade marks]. However, the evidence provided by the opponent clearly shows that its primary markets (based on sales) are France and Germany.

26...One must conclude that the UK market makes up a small percentage of the opponents' EU sales, with France and Germany providing by far the largest markets for its products. It is fanciful for the opponent to claim that they enjoy a substantial reputation in the UK when their own evidence suggests the contrary. "

39. I have already commented on the opponents' evidence in paragraphs 30 and 31 above and concluded that its use in the UK was insufficient for it to benefit from an enhanced distinctive character. Although the applicant doesn't "disagree" that the earlier trade marks have acquired a reputation in some member states and even if I disregard the shortcomings in the evidence I identified earlier, there is nothing in the opponents' evidence to indicate that any reputation they may enjoy in, for example, France, will have come to the attention of the average consumer in the UK. The opposition based upon section 5(3) of the Act falls at the first hurdle and is dismissed accordingly. In reaching this conclusion, I am mindful that in the period 2006-2011, the opponents also achieved a turnover of £450k in Ireland i.e. in addition to a turnover of £905k in the UK in the same period. Even assuming that any reputation the opponents may have acquired in Ireland has "spilt over" into the UK (which is far from certain), this still, in my view, leaves the opponents a long way short of establishing that it has the sort of reputation referred to in *General Motors*.

Overall conclusion

40. The opposition based upon section 5(2)(b) succeeds in full but fails under section 5(3) of the Act.

Costs

41. As the opponents have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponents on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Opposition fee:	£200
Preparing evidence and submissions:	£500
Written submissions:	£300
Total:	£1200

42. I order Richmond Designs Limited to pay to De Spieghel Trading Company B.V. and De Spieghel Beheer B.V. the sum of **£1200**. 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 3rd day of October 2013

C J BOWEN
For the Registrar
The Comptroller-General