

O-290-16

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS IN THE MATTER OF
INTERNATIONAL REGISTRATION NOS 1201182 AND 1201181
IN THE NAME OF PHILIP MORRIS BRANDS SARL**

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 34:

MARK 10

&

MARKTEN

**AND IN THE MATTER OF OPPOSITION NOS 402823 & 402824
THERETO BY
GRE GRAND RIVER ENTERPRISES DEUTSCHLAND GMBH**

BACKGROUND

1) Philip Morris Brands Sarl (“the applicant”) requested protection in the United Kingdom of the following two International Registrations (“IR”) on 22 November 2013 and 29 November 2013 respectively (the first mark has a priority date of 20 June 2013 and the second 11 June 2013):

- i) **MARK 10**

- ii) **MARKTEN**

Both IRs were published on 18 July 2014 for the following goods:

Class 34: Tobacco, raw or manufactured; tobacco products, including cigars, cigarettes, cigarillos, tobacco for roll-your-own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus; tobacco substitutes (not for medical purposes); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays, pipes, pocket apparatus for rolling cigarettes, lighters; matches; electronic apparatus for tobacco, particularly electronic cigarettes, tobacco products and tobacco substitutes; electric vapor generators for tobacco, tobacco products and tobacco substitutes; heating apparatus for the preparation for consumption and the consumption of tobacco and tobacco products; electric heating apparatus for the preparation for consumption and the consumption of tobacco and tobacco products.

2) The designations of the IRs are opposed, in full, by GRE Grand River Enterprises Deutschland GmbH (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following European Union Trade Mark (‘EUTM’):

EUTM No: 9148628

MARK ADAMS NO 1

Class 34: Unprocessed tobacco, processed tobacco and tobacco products, included in class 34, in particular cigarettes, cigars, cigarillos, fine cut tobacco, pipe tobacco, chewing tobacco, snuff, cigarettes containing tobacco substitutes, not for medical purposes; smokers' articles, in particular tobacco tins, cigarette cases, cigarette holders, ashtrays (all the aforesaid goods not of precious metal or coated therewith), cigarette papers, cigarette tubing, cigarette filters, smoking pipes, pocket apparatus for rolling cigarettes, lighters, included in class 34; matches; cigarette cases of precious metal; cases (cigarette -), of precious metal; cigarette holders of precious metal; cigar cases of precious metal and wood; boxes (cigar -), of precious metal; cigar holders of precious metal.

Filing Date: 02 June 2010

Date of completion of registration procedure: 15 November 2010

3) The applicant filed a counterstatement in defence of each IR denying the grounds of opposition.

4) Both parties filed submissions; only the opponent filed evidence. Neither party requested to be heard. I therefore make this decision after careful consideration of the papers before me.

Opponent's evidence

5) This takes the form of a witness statement in the name of Jandan M Aliss, a trade mark attorney at Nucleus IP Limited, the opponent's representative in these proceedings. It consists, for the most part, of submissions which I will not detail here but will bear in mind and refer to, as appropriate, in the decision which follows. In terms of factual information, Ms Aliss states that the opponent's mark is often abbreviated to MARK 1. Exhibit 2 shows the results of an internet search for the phrase "mark 1 cigarettes".

DECISION

6) Section 5(2)(b) of the Act provides:

"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,

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

The opponent's EUTM qualifies as an earlier trade mark under the above provisions. Further, given the date on which it completed its registration procedure, it is not subject to proof of use, as per Section 6A of the Act.

Section 5(2)(b) – case law

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

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 be dominated by one or more of its components;

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

9) The goods to be compared are:

Opponent's goods	Applicant's goods (for both IRs)
<p>Class 34: Unprocessed tobacco, processed tobacco and tobacco products, included in class 34, in particular cigarettes, cigars, cigarillos, fine cut tobacco, pipe tobacco, chewing tobacco, snuff, cigarettes containing tobacco substitutes, not for medical purposes; smokers' articles, in particular tobacco tins, cigarette cases, cigarette holders, ashtrays (all the aforesaid goods not of precious metal or coated therewith), cigarette papers, cigarette tubing, cigarette filters, smoking pipes, pocket apparatus for rolling cigarettes, lighters, included in class 34; matches; cigarette cases of precious metal; cases (cigarette -), of precious metal; cigarette holders of precious metal; cigar cases of precious metal and wood; boxes (cigar -), of precious metal; cigar holders of precious metal.</p>	<p>Class 34: Tobacco, raw or manufactured; tobacco products, including cigars, cigarettes, cigarillos, tobacco for roll-your-own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus; tobacco substitutes (not for medical purposes); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays, pipes, pocket apparatus for rolling cigarettes, lighters; matches; electronic apparatus for tobacco, particularly electronic cigarettes, tobacco products and tobacco substitutes; electric vapor generators for tobacco, tobacco products and tobacco substitutes; heating apparatus for the preparation for consumption and the consumption of tobacco and tobacco products; electric heating apparatus for the preparation for consumption and the consumption of tobacco and tobacco products.</p>

10) In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

11) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

12) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267, Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

13) In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

14) Finally, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (*Meric*), the General Court ('GC') stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15) The applicant's 'Tobacco, raw or manufactured' is identical to the opponent's 'processed tobacco and unprocessed tobacco'.

16) The opponent's specification includes 'tobacco products' at large (the phrase 'in particular...' which follows that term does not narrow the scope of the broad term 'tobacco products' but rather simply highlights certain of the goods which fall within that broad term). Those goods are identical to the applicant's 'tobacco products, including cigars, cigarettes, cigarillos, tobacco for roll-your-own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus' (as regards the latter two terms, 'kretek' and 'snus', I understand that these are a type of cigarette and tobacco respectively).

17) The applicant's 'tobacco substitutes (not for medical purposes)' are clearly highly similar to the opponent's 'cigarettes containing tobacco substitutes, not for medical purposes'. They are similar in nature and the trade channels, purpose and users are the same.

18) The opponent's 'smokers' articles, in particular...' are identical to the applicant's 'smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays, pipes, pocket apparatus for rolling cigarettes, lighters'.

19) The respective 'matches' are, obviously, identical.

20) This leaves the applicant's 'electronic apparatus for tobacco, particularly electronic cigarettes, tobacco products and tobacco substitutes; electric vapor generators for tobacco, tobacco products and tobacco substitutes; heating apparatus for the preparation for consumption and the consumption of tobacco and tobacco products; electric heating apparatus for the preparation for consumption and the consumption of tobacco and tobacco products'. There is no identity between these goods and any of the opponent's goods. However, the opponent's 'tobacco products' such as cigarettes, for example, have the same purpose and method of use as the applicant's goods, they are all aimed at smokers and are in competition. There is a high degree of similarity between the aforementioned goods.

Average consumer and the purchasing process

21) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

22) The average consumer of the relevant goods is the smoking portion of the general public. Although they may be purchased reasonably frequently, many of the goods at issue (e.g. 'tobacco' and 'tobacco products' etc.) are, in the light of increasing government taxation, not insignificant in terms of cost. Further, as it is likely that a number of factors such as flavour, aroma and strength are likely to play a part in the consumers purchasing decision, I find that a reasonable degree of attention (at least) is likely to be paid by the consumer during the purchase of the majority of the goods. The exception to this would be in relation to very inexpensive items such as 'matches' which are generally purchased purely for their functional purpose attracting a much lower degree of attention.

23) As to the manner in which the goods are likely to be selected, I note that, at the relevant date, tobacco products were prohibited from being displayed in the UK in larger retailers such as supermarkets¹, requiring the consumer to request the goods orally.² In those circumstances, aural considerations are particularly important. However, the ban did not extend to smaller establishments such as newsagents and corner shops until 2015 (i.e. until after the relevant date). In these smaller premises, the goods are still likely to have been visible to the consumer (albeit most likely from behind a counter) before being requested orally. Bearing all of this in mind, it seems to me that both aural and visual considerations are important as regards the respective goods which are, or contain, tobacco.

24) Turning to the remaining goods which do not contain tobacco, such as the various smokers' articles and electric vapour generators for tobacco substitutes, these are likely to be self-selected from retail shelves and/or websites or may be requested orally over a counter. As such, both visual and aural considerations are also important in respect of these goods.

Comparison of Marks

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

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

¹ The Tobacco Advertising and Promotion (Display) (England) Regulations 2010 (as amended by the Tobacco Advertising and Promotion (Display and Specialist Tobacconists)(England)(amendment) Regulations 2012), The Tobacco Advertising and Promotion (Display) (Wales) Regulations 2012, The Sale of Tobacco (Display of Tobacco Products and Prices etc.) (Scotland) Regulations 2013, The Tobacco Advertising and Promotion (Display) Regulations (Northern Ireland) 2012.

² There are, though, are a number of exclusions in the regulations such as the consumer being able to ask to see the goods or that there may be opportunity to view leaflets bearing images of the goods.

that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26) It would be wrong, therefore, to artificially to dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

27) Before I compare the marks, it is necessary to deal with a point raised by the opponent in its evidence. The opponent claims that its mark is often abbreviated to MARK 1 and it provides evidence to support this. It draws my attention to this evidence when arguing that the marks at issue are similar. As the applicant rightly points out, however, the ground of opposition before me under section 5(2)(b) of the Act is based solely on the earlier mark MARK ADAMS NO 1. Accordingly, this is the mark which I must the base the comparison on and no other; the manner in which the opponent has used its mark is irrelevant.

28) I will deal firstly with the applicant’s MARKTEN mark. The trade marks to be compared are as follows:

Opponent’s mark	Applicant’s marks
MARK ADAMS NO 1	MARKTEN

29) The applicant’s mark is presented as the single word MARKTEN in plain block capitals. The opponent argues that it is dominated by the word MARK. I disagree. Whilst the average consumer may break the mark down into the two words ‘MARK’ and ‘TEN’ (as opposed to only perceiving one seven letter word), the presentation of the mark as a single word is such that there are no dominant elements.

30) In relation to its own mark, the opponent argues that this is also dominated by the word MARK. Whilst it is true that the word MARK is presented as a separate word in a prominent position at the beginning of the mark, it naturally combines with the following word ADAMS to form a full personal name. In my view, it is the combination MARK ADAMS, which carries the greatest weight in the mark’s overall impression. The second element of the mark, NO 1, also contributes to the mark’s overall impression but to a lesser extent, given (in particular) its relative size and positioning within the mark as a whole.

Visual comparison

31) The opponent submits that the most eye-catching part of both marks is the word ‘MARK’ as this is the first word/syllable and therefore the marks are visually highly similar. I accept that it is a general rule of thumb that the beginnings of marks tend to have the greatest impact on the average consumer’s perception.³ However, each case must be assessed on its merits. Although there is a point of visual coincidence owing to MARK being at the beginning of both marks, this is tempered by all other

³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 [81] - [83].

aspects of the marks being visually very different. Furthermore, those differences are all the more prominent given that the opponent's mark is much longer than the applicant's mark. I find that the degree of visual similarity between the marks is very low overall.

Aural comparison

32) The opponent makes no mention of the NO 1 element of its mark in its submissions on aural similarity. It states that its mark will simply be pronounced as MARK ADAMS. It also contends that 'the "A" in "Adams" and "E" in "Ten" sound the same and that "ADAMS" and "TEN" sound very much alike'. The applicant submits that the opponent's mark may be pronounced as MARK ADAMS NUMBER ONE or possibly MARK ADAMS NO ONE.

33) I will firstly consider the position allowing for articulation of the whole of the opponent's mark. In my view, NO 1 will likely be perceived as shorthand for "number one" and therefore the opponent's mark, as a whole, will be pronounced MARK ADAMS NUMBER ONE. The parties appear to agree that the applicant's mark will be pronounced as MARK-TEN. Although the first syllable of the marks is identical and it is the first syllable which tends to have the greater impact on the ear, the other five syllables of the opponent's mark do not share any resemblance to the second syllable of the applicant's mark and certainly none, on any reasonable view, can be described as sounding "very much alike". On the contrary, they are aurally quite distinct. This results, in my view, in an overall degree of aural similarity which is very low. Further, even if the opponent's view that its mark would simply be pronounced as MARK ADAMS alone is correct, the overall aural similarity would still be low.

Conceptual comparison

34) The opponent submits:

"...The trade marks are conceptually very similar, since they are dominated by the word "MARK", which is seen either as a common first name or as an abbreviation of "trade mark" and both have numbers as the additional matter. Furthermore, the number "TEN" is obviously quite close to the "number 1" of the trade mark "MARK ADAMS No 1"."

The applicant submits:

"It is submitted that the Applicant's mark MARKTEN will either be perceived by consumers as the Dutch term 'markten', meaning 'market' or as the conjoined English words "mark" and "ten". In either case, the mark is likely to be perceived as somewhat unusual."

And

"In the case of the Opponent's mark, the element MARK is combined with the term ADAMS, which is itself a common surname. Therefore, it is submitted that consumers seeing the mark MARK ADAMS NO 1 will see the element

MARK as being a first name, with ADAMS being a surname. The element “NO 1” may either be seen as “number one” or as “no one”....

By contrast, the ‘MARK’ part of MARKTEN is not immediately understood as a name, it can mean a number of things including being part of a made up word, and therefore it is submitted the marks are conceptually very different.”

I see no reason why the word MARK in the opponent’s mark would be perceived as an abbreviation for the word ‘trade mark’. As the applicant points out, it is followed by a common surname, ADAMS, thereby leading the consumer to perceive the word MARK as a forename. As to the NO 1 element, this will be perceived as meaning number one. The opponent’s mark, as a whole, will therefore be perceived as a full personal name (MARK ADAMS) followed by number 1 (NO 1).

35) Whilst the applicant appears to agree with the opponent that its mark may be perceived as the two words “mark” and “ten” conjoined, it also submits that it may be perceived as a single word. My own view is that the latter scenario is more likely. However, I will consider both possibilities. In the event the mark is perceived as a single word, it is one with which the consumer is unlikely to be familiar, portraying no concept at all (I do not consider that the Dutch meaning of ‘market’ will be apparent to the average UK consumer). On that basis, there is no conceptual similarity between the marks.

36) I will now consider the position in the event the mark is perceived as the two words MARK and TEN conjoined. One potential meaning of MARK is, as the opponent states, a common forename. However, I am not persuaded that this is how the consumer will perceive the word MARK in the context of the applicant’s mark as a whole. There is nothing, such as a common surname following the word MARK or a possessive ‘s’, to lead the consumer to construe it as a person’s name. To my mind, the word MARK portrays no clear meaning in the applicant’s mark and when combined with the word TEN, the meaning of the mark as a whole is also unclear (aside from the fact that it makes reference to the numeral 10). Bearing these conclusions in mind, I find that, if there is any conceptual similarity between the marks, this stems solely from both making a reference to a numeral but this factor alone is far from sufficient to deem the marks conceptually similar. Taking account, in particular, of the opponent’s mark sending a clear conceptual message of a personal name which is absent from the applicant’s mark, the respective marks are not conceptually similar overall.

37) I will now address the similarities between the opponent’s mark and the applicant’s MARK 10 mark. These are set out in the table below:

Opponent’s mark	Applicant’s mark
MARK ADAMS NO 1	MARK 10

38) I bear in mind my earlier comments at paragraph 30 regarding the opponent’s mark.

39) Again, the opponent argues that the word MARK is the dominant element of the applicant's mark. Although the word MARK is at the beginning of the mark, it occupies only a slightly greater portion of the mark as a whole than the numeral 10. In my view, the two elements contribute roughly equally to the overall impression of the mark.

Visual comparison

40) As the opponent submits, there are points of visual coincidence between the marks since both share the word MARK at the beginning and both contain the numeral 1. The opponent also argues that the 'O' in its mark is visually similar to the '0' in the applicant's mark. I accept that those similarities exist between the marks however, all other aspects of the marks differ. In my view, the points of coincidence are outweighed by the visual differences, which are, again, all the more pronounced given the much longer length of the opponent's mark than the applicant's mark. Overall there is a very low degree of visual similarity.

Aural and conceptual comparison

41) My considerations and conclusions in paragraphs 33 and 36 above are equally applicable here. Accordingly, the respective marks are aurally similar to a very low or low degree and they are not conceptually similar overall.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

43) There is no evidence before me to show that the opponent's mark has acquired an enhanced level of distinctiveness through use. Accordingly, I must make the

assessment on the basis of the marks inherent qualities alone. The opponent submits that its mark is of a high level of distinctiveness since it is not descriptive of the goods covered by its specification. I agree that the mark is clearly not descriptive or allusive of the goods. However, I would not put the level of distinctiveness at high. As I have already indicated, the element MARK ADAMS will be perceived as a personal name and the NO 1 element as meaning number one. I do not consider the latter element to be particularly high in distinctive character and the consumer is accustomed to seeing personal names used as signs of trade origin. On the whole, I consider the mark to be possessed of a normal (i.e. neither high nor low) degree of distinctive character.

Likelihood of confusion

44) I must now remind myself of all my earlier findings and feed them into the global assessment of the likelihood of confusion and, when conducting that assessment, I must also keep in mind the following established principles:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods or services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V*), and;
- iii) the more distinctive the opponent's mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).

45) Earlier in this decision I found the following:

- The respective goods are either identical or highly similar.
- A reasonable degree of attention (at least) is likely to be paid during the purchase of the majority of the goods with the exception of very inexpensive, and purely functional items, such as 'matches', where the degree of attention is likely to be much lower.
- Both visual and aural considerations are important.
- The opponent's mark and the applicant's MARKTEN mark are visually similar to a very low degree, aurally similar to a very low or low degree (the former applies if the whole of the opponent's mark is pronounced and the latter if only the MARK ADAMS element is pronounced), and they are not conceptually similar overall.
- The opponent's mark and the applicant's MARK 10 mark are visually similar to a very low degree, aurally similar to a very low or low degree (the former applies if the whole of the opponent's mark is pronounced and the latter if only the MARK ADAMS element is pronounced), and they are not conceptually similar overall.
- The opponent's mark is possessed of a normal (neither high nor low) degree of distinctive character.

46) Drawing together all of my findings, I find that the *already* very low degree of visual similarity and very low/low degree of aural similarity between the respective marks is counteracted even further by the fact that the opponent's mark conjures up an immediately graspable concept which is not shared by either of the applicant's marks.⁴ Accordingly, notwithstanding the identity of certain of the goods and high degree of similarity between others, there is neither a likelihood of direct nor indirect confusion in respect of either of the applicant's marks.

47) **The opposition fails.**

COSTS

48) As the applicant has been successful, it is entitled to an award of costs. In approaching the award, I bear in mind that, although two counterstatements were filed, their content was identical. I also take account of the proceedings being consolidated prior to the applicant filing its written submissions. Using the guidance provided in Tribunal Practice Notice 4/2007, I award costs to the applicant on the following basis:

Considering the notices of opposition and filing the counterstatements	£200
Considering the opponent's evidence and filing written submissions	£300
Total:	£500

49) I order GRE Grand River Enterprises Deutschland GmbH to pay Philip Morris Brands Sarl 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 16th day of June 2016

**Beverley Hedley
For the Registrar,
the Comptroller-General**

⁴ See, for example, *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* (2003) ECR Case T-292/01.