

BL O-410-19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3308259

BY BUSINESS PRESENT LIMITED

TO REGISTER:

solance

AS A TRADE MARK IN CLASSES 8 & 21

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 413455 BY

METALLWARENFABRIK MARKTOBERDORF GMBH & CO. KG

BACKGROUND & PLEADINGS

1. On 2 May 2018, Business Present Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the goods shown in paragraph 14 below.

The application was published for opposition purposes on 18 May 2018.

2. The application has been opposed in full by Metallwarenfabrik Marktoberdorf GmbH & Co. KG (“the opponent”) under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to its objections based upon sections 5(2)(b) and 5(3) of the Act, the opponent relies upon all the goods (shown in paragraph 14 below) in an International Registration designating the European Union (“IREU”) no.1236514 for the word **SILENCE** which designated the EU on 30 July 2014 (claiming an international convention priority date of 31 January 2014 from an earlier filing in Germany) and which was granted protection in the EU on 29 December 2015.

3. Insofar as its objection based upon section 5(3) of the Act is concerned, the opponent states that its trade mark enjoys a reputation in relation to all the goods upon which it relies. In addition to claiming that:

“the similarity between the [trade mark being relied upon] and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks”,

it goes on to explain why, in its view, all the goods for which registration is sought would take unfair advantage of, or be detrimental to the reputation or distinctive character of its trade mark, i.e.:

Unfair advantage:

“By virtue of the risk of consumer confusion between the marks...the Applicant's use...will inevitably take advantage of the goodwill and reputation built up in the Earlier Trade Mark.

The Applicant will benefit from the attractive force to bring in customers built up by the Opponent in the Earlier Trade Mark through many years of considerable investment, with the result that the Applicant's marketing of its own goods is made easier and it will sell more of its own products.

The honest practice in commercial matters is to take a licence from the brand owner or avoid using an identical or confusingly similar brand.

By seeking to use and register the Mark Applied For, in defiance of the Opponent's requests not to, the Applicant will inevitably gain an unfair commercial advantage.”

Detriment to reputation

“The Opponent will have no control over the use of the Mark Applied For. But the Opponent has acquired a reputation among retail consumers and the trade for the high quality of its goods sold under the Earlier Trade Mark.

Use of the Mark Applied For by the Applicant, or its Licensees, for goods which are below the high quality of the Opponent's goods may confuse such consumers and the trade that the Opponent's goods have dropped in quality.

Such confusion will inevitably cause a detriment to the reputation of the Earlier Trade Mark.”

Detriment to distinctive character

“Detriment to the distinctive character, also referred to as 'dilution', 'whittling away' or 'blurring', will be caused to the Earlier Trade Mark by use and registration of the Mark Applied For in relation to the relevant goods and services. The Earlier Trade Mark will no longer be capable of arousing the same immediate association with the Opponent in the mind of the consumer. This will lead to a weakening of the Earlier Trade Mark's ability to identify the goods for which it is registered, used and has a reputation, as coming from the Opponent and/or under its control and therefore to a weakening of the Earlier Trade Mark's commercial power of attraction.

This is likely to lead to a change in the economic behaviour of the consumer. Consumers will no longer see the Earlier Trade Mark, upon the relevant goods, as denoting the Opponent. Consumers will no longer equate the Earlier Trade Mark as a guarantee of high quality that they have come to expect from the Opponent. Sales of the Opponent's goods under the Earlier Trade Mark will suffer. This will damage the Opponent's business.”

4. Finally, in relation to its claim based upon section 5(4)(a) of the Act, the opponent relies upon the use of the word SILENCE since at least 2014 “throughout the EU, including the UK” in relation to “household, kitchen, and/or cooking equipment and accessories.”

5. The applicant filed a counterstatement in which the basis of the opposition is denied. It states:

“10. It is denied that the applicant's class 8 goods are similar to the opponent's goods.”

6. In these proceedings, the opponent is represented by Gill & Gill (“GG”) and the applicant by Withers & Rogers LLP (“WR”). Both parties filed evidence with the opponent filing written submissions in reply to the applicant's evidence. While neither

party requested a hearing, the applicant filed written submissions in lieu of attendance.

EVIDENCE

7. The opponent's evidence-in-chief consists of a witness statement from Armin Ledermann (accompanied by four exhibits); Mr Ledermann is the Commercial Manager of RÖSLE GmbH & Co KG, which is a subsidiary company of the opponent. The applicant's evidence comes from Mark Caddle, a trade mark attorney at WR. The opponent replied to the applicant's evidence in written submissions from GG dated 23 April 2019.

8. For reasons which will shortly become clear, I do not intend to provide a traditional summary of the evidence filed here. However, for the avoidance of doubt, I confirm I have read all the evidence and submissions and will, to the extent I consider it necessary, comment upon it later in this decision.

DECISION

9. The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act which 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,

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 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 European Union trade

mark or international trade mark (EC), in the European Union) 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.

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

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

(b)...

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

10. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), 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.”

11. The trade mark relied upon by the opponent qualifies as an earlier trade mark under the above provisions. Given the interplay between the dates on which the opponent’s trade mark was granted protection and the publication date of the application for registration, this earlier trade mark is not subject to the proof of use provisions.

The objection based upon section 5(2)(b) of the Act

12. I shall deal first with the above objection.

Case law

13. The following principles are gleaned from the decisions of the courts of the European Union 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 greater degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks 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

14. The competing goods are as follows:

The opponent's goods	The applicant's goods
<p>Class 21 - Household, kitchen, or barbecue utensils, receptacles, or containers; mugs; frying pans; cooking skewers, of metal; chicken roasting dishes; bread boards; bread bins; butter dishes; cooking pot steam inserts; hot pots, not electrically heated; pot lids, or dish covers; closures for pot lids; egg cups; egg prickers; egg crackers; buckets; dinner services and cookware; cruets; cruet stands; chopsticks; bottle openers; ice cube molds [moulds]; molds [kitchen utensils]; fruit presses, non-electric, for household purposes; spice sets; baskets for domestic use; grill covers; grills [cooking utensils]; grill supports; tea glass holders and tea glasses; heat-insulated containers for beverages; beverage coolers, non-electric; cheese mills and graters, non-electric; coffee filters, non-electric; coffee pots; coffeepots, non-electric; coffee grinders, hand-operated; coffee percolators, non-electric; coffee services [tableware]; pitchers; potato mashers; cheese-dish covers; candle extinguishers; candle holders; candle rings; garlic presses [kitchen utensils]; cookery molds [moulds]; cooking utensils, non-electric; cauldrons; cooking pots; corkscrews; cake molds [moulds]; kitchen utensils; milk frothers,</p>	<p>Class 8 - Sharpening steels; Blade knives; Bread knives (non-electric-); Butchers' knives (non-electric-); Carving knives; Chef knives; Fruit knives; Garden knives; Gardeners' knives; Household knives; Japanese chopping kitchen knives; Kitchen knives; Mincing knives [hand tools]; Palette knives; Paring knives; Peeling knives; Potato peelers [knives]; Razor knives; Table cutlery [knives, forks and spoons]; Boxes for cutlery [fitted]; Boxes adapted for cutlery; Vegetable knives (non-electric-); Vegetable peelers [hand operated knives]; Cake cutters; Cuticle nippers; Cuticle scissors; Cuticle tweezers; Pizza cutters [non-electric]; Fingernail clippers; Fingernail polishers [electric and non-electric]; Nail clippers; Nail clippers [electric and non-electric]; Nail files, non-electric; Nail nippers [hand tools]; Nail polishers (non-electric-); Nail scissors; Cuticle scissors; Gardening shears and scissors; Hair cutting scissors; Scissors for household use; Scissors for kitchen use; Cuticle tweezers; Tweezers; Hair-removing tweezers; Pedicure sets; Pedicure implements; Can openers, non-electric; Cheese slicers; Cheese knives.</p>

<p>non-electric; knife rests for the table; shakers; blenders, non-electric, for household purposes; mills for domestic purposes, hand-operated; boxes for dispensing paper towels, of metal; pans, for use in kitchen; salt and pepper mills, hand-operated; pepper pots; cabarets [trays]; cookie [biscuit] cutters; graters for kitchen use; beaters, non-electric; blenders, non-electric; mixing spoons [kitchen utensils]; salad bowls; salt cellars; spatulas [kitchen utensils]; bowls [basins]; gravy boats; scoops [tableware]; whisks, non-electric, for household purposes; sieves [household utensils]; napkin rings; strainers; siphon bottles for carbonated water; cutting boards and supports for the kitchen; pressure cookers [autoclaves], non-electric; basting spoons, for kitchen use; dish covers; dishes; strainers and sieves [household utensils]; table plates; trays for domestic purposes; tableware, other than knives, forks and spoons; tea services [tableware]; cups; tea infusers and tea balls; tea caddies; teapots; tea strainers; pastry cutters; domestic rolling pins; soup tureens; pot lids; pots; oven gloves; pie servers; cake platters with or without covers; funnels; woks [pots or pans]; brushes [except for painting]; dishwashing brushes; barbecue hand-operated</p>	<p>Class 21 - Containers for household or kitchen use; Frying pans; Cutting boards for the kitchen; Knife boards; Cooking pot sets; Cooking pots and pans [non-electric]; Cooking utensils, non-electric; Rice cooking pots [non-electric]; Skewers for use in cooking; Pot lids; Ice buckets; Egg cups [not of precious metal]; Cruet stands for oil and vinegar; Bottle openers [hand-operated]; Garlic presses [kitchen utensils]; Mills for domestic purposes, hand-operated; Pepper mills; Salt mills; Spatulas [kitchen utensils]; Ladles, for kitchen use; Whisks, non-electric, for household purposes; Sponges (for household and cosmetic purposes); Strainers for household purposes; Oven gloves; Woks (non-electric-); Knife blocks; Aluminum water bottles; Reusable stainless steel water bottles; Drinking bottles for sports; Flasks; Flasks for travellers; Drinking flasks; Hip flasks; Liqueur flasks; Travel mugs; Coffee travel mugs; Insulated mugs; Insulated travel mugs; Insulated vacuum bottles; Insulated bottles; Insulated bottles [flasks]; Coffee glasses; Coffee cups; Coffee mugs; Coffee scoops; Coffee pots; Coffee services of ceramic; Coffee services of china; Coffee services, not of precious metal; Coffee pots not of precious</p>
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<p>cleaning instruments for grills; tea cloths, cloths for cleaning, cleaning wipes; articles for cleaning purposes; hand-operated cleaning instruments; spatulas for cleaning tanks and containers [kitchen utensils]; dishwashing brushes; sponge holders; soap holders; soap dispensers; hand-operated graters for kitchen use.</p>	<p>metal; Teacups; Teapots; Tea sets; Tea saucers; Tea bag rests; Carving forks; Nut crackers not of precious metal.</p>
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15. 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:

“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”.

16. 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 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.

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”), stated that “complementary” means:

“...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”.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC stated:

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

19. In its Notice of opposition, the opponent states:

“The respective goods are identical household, kitchen, and cooking equipment and accessories, or they are at the very least highly similar.”

20. As I mentioned earlier, in its counterstatement, the applicant replied to the above stating:

“10. It is denied that the applicant’s class 8 goods are similar to the opponent’s goods.”

21. In paragraph 23 of its submissions filed in lieu of a hearing, the applicant identifies a range of goods in classes 8 and 21 of its application which it considers are “dissimilar” to the goods upon which the opponent relies. In relation to what it regards as the “remaining services (sic) in classes 8 and 21...” in paragraph 25 of its submissions, it goes on to conclude that “due to the dissimilarities between the marks, a likelihood of confusion on the part of the public does not exist.”

22. The applicant’s position is, therefore, that there is no similarity between the opponent’s goods and its goods identified in paragraph 23 of its submissions and, on a fair reading, a tacit acceptance that while the remaining goods in its application are similar to the opponent’s goods in class 21, it does not matter because the competing trade marks are so different. Ordinarily, I would have conducted a line-by-line comparison to resolve the matter. However, as even a cursory review of the competing specifications reveals that the vast majority of the applicant’s goods in class 21 are identical (either literally or on the *Meric* principle) to the opponent’s goods and a significant portion of its goods in class 8 are likely to be regarded as similar (to varying degrees) to the opponent’s goods, I shall proceed on the basis most favourable to the opponent i.e. that its goods are either identical or highly similar to all of the applicant’s goods. If the opponent is unable to succeed on this basis, it will, of course, be in no better position if its goods are not considered to be similar at all to those of the applicant (in which case there can be no likelihood of confusion), or if they are only to be regarded as similar to a lower degree. I shall return to this point when I consider the likelihood of confusion.

The average consumer and the nature of the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 “average” does not denote some form of numerical mean, mode or median.”

24. In its Notice of opposition, the opponent states:

“...when the mark is used orally, or listed in trade directories or on-line search results. Oral use of the mark, particular in word of mouth recommendations by members of the public to their friends and family, is an extremely important source of new sales for the Opponent and their SILENCE brand of household, kitchen, and cooking equipment and accessories.

...They are purchased by the average consumer for both domestic and professional use but they are relatively modest cost and so consumers would not spend a particularly long time in examining the products and the brands. There would be a relatively low degree of attention by consumers to the marks when compared with more expensive items in the field of household and kitchen uses such as ovens, tables, furniture.”

25. In its submissions, the applicant states:

“8. In the present case, the Applicant's Goods are directed at the public at large as well as business customers with specific professional knowledge or expertise. The degree of attention of the relevant public will therefore range from low to high. However, when it comes to the Opponent's Goods, it is likely that consumers will examine the goods with particular scrutiny, either because of the expensive retail price of the items, or because matters of style, compatibility, utility and safety will be of concern.”

26. As the opponent's specification is not limited in any way, the applicant's references to price etc. are not relevant. Regardless, I agree that the average consumer of the goods at issue will be members of the general public as well as professional users. As the opponent's evidence shows that such goods are likely to be selected: (i) from the shelves of bricks-and-mortar retail outlets, (ii) from wholesalers, and (iii) from the pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, I accept that such goods may, as the opponent suggests, also be the subject of word-of-mouth recommendations and, as a consequence, that aural considerations must be taken into account.


27. As to the degree of care the average consumer will display when selecting such goods, the opponent suggests that given their likely cost the average consumer's level of attention is likely to be relatively low, whereas the applicant suggests a range of attention spans are likely to come into play. In my experience, the cost of the goods at issue can vary considerably. For example, in my experience, one may pay either a relatively small amount or a couple of hundred pounds for a frying pan. As the cost of the item rises or if the item is to be used in a professional context, I would expect the degree of attention paid by the average consumer to its selection to increase accordingly. However, one would expect a fairly low degree of attention to be paid by the same average consumer to the selection of, for example, a coffee mug for everyday use. I shall return to this point later in my decision.

Comparison of trade marks

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

29. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
SILENCE	

30. It is this aspect of the case which attracted a good deal of the party's competing submissions. While I do not intend to record them here, I have taken them all into account in reaching the conclusions which follow.

31. The opponent's trade mark consists of the word "SILENCE" presented in block capital letters. The word and its meaning will be very well-known to the average consumer. As no part of the word is highlighted in any way, the overall impression the opponent's trade mark conveys and its distinctiveness lies in the single word of which it is composed.

32. The applicant's trade mark also consists of a single word. Its lower case letters are, for the most part, presented in an unremarkable cursive script in bold and, despite its stylisation, the third character will, I am satisfied, be regarded by the average consumer as a stylised letter "l". Although given its size and positioning this letter "l" will contribute to the overall impression conveyed, as such flourishes are commonplace in trade marks and likely to be very familiar to the average consumer, considered overall, it is the word "solance" that dominates the overall impression the applicant's trade mark conveys and it is in that word the overwhelming majority of its distinctiveness lies.

I will now assess the competing trade marks with those conclusions in mind.

The visual comparison

33. The competing trade marks consist of seven letters in which the letters in the first, third and fifth to seventh letter positions are identical. As notional and fair use of the opponent's trade mark would include its use in a cursive script, that apparent point of difference does not assist the applicant. Although the stylised letter "l" will catch the average consumer's eye, weighing the similarities and differences, results in what I regard as a fairly high degree of visual similarity.

The aural comparison

34. As the word "SILENCE" will be so well-known to the average consumer, the manner in which it will be articulated is predictable. Although the same is not true of the applicant's trade mark, as both trade marks consist of two syllables i.e. "SILENCE" and "so-lance" and as both syllables have obvious aural similarities, it once again results in what I regard as a fairly high degree of aural similarity.

The conceptual comparison

35. The word “SILENCE” and its meaning will be so well-known to the average consumer as not to require any further explanation here. That is not the case in relation to the word the subject of the applicant’s trade mark, which both parties agree has no meaning. Thus the opponent’s trade mark is likely to convey a clear conceptual message to the average consumer whereas the applicant’s trade mark will convey none.

Distinctive character of the earlier trade mark

36. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought 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.

37. In its Notice of opposition, the opponent states:

“The Earlier Trade Mark, SILENCE, is fanciful in relation to the household, kitchen and/or cooking equipment and accessories for which it is registered and therefore has a high degree of inherent distinctive character for those goods. In addition...the Earlier Trade Mark has acquired enhanced distinctive character by virtue of the longstanding use and reputation that the Opponent has built up in the mark a number of years, in respect of the goods for which it is registered.”

38. In its submissions, the applicant states:

“11...Whereas consumers of the SILENCE mark , which alludes to a noise cancelling function...”

39. While the applicant’s comment may, just, find traction in relation to some of the opponent’s goods, the applicant appears to accept that even if that is the case, the opponent’s trade mark is, at worst, allusive. I agree. Although it consists of a well-known word with a well-known meaning, considered absent use, it is, in my view, possessed of an average degree of inherent distinctive character.

40. As to the opponent’s claim to enhanced distinctive character, I remind myself that the material date for this assessment is the date of the filing of the applicant’s trade mark i.e. 2 May 2018 and that it is only use in the UK that is relevant. While I bear in mind the applicant’s criticisms of the opponent’s evidence, I note that in his statement, Mr Ledermann indicates that the “SILENCE” trade mark has been used in the EU since June 2014 and in the UK since December 2014. Having listed a range of goods on which the “SILENCE” trade mark has been used (i.e. cookware, thermometers, casserole ware, sauté pans, frying pans, serving pans, stock pots, steamers, saucepans, stewing pans, grilling pans, crêpes pans, woks, splatter guards, fish pans and glass lids), if I understand his evidence correctly, he further states that in the period 2013/2014 to 2017/2018, use in the UK amounted to €12,059/246 pieces.

41. Given the likely size of the market in the UK for the goods specifically identified by Mr Lederman which, in my view, is likely to run into many tens if not hundreds of millions of pounds each year, on the basis of the evidence provided, I am unable to conclude that the opponent’s “SILENCE” trade mark enjoys an enhanced level of distinctive character beyond that mentioned above.

Likelihood of confusion

42. 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact 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.

43. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related. Earlier in this decision I concluded that:

- I would proceed on the basis that the competing goods are identical or highly similar;
- the average consumer is a member of the public or a professional user who is likely to select the goods at issue using a mixture of visual and aural considerations (but in which visual considerations are likely to dominate) and who will display varying degrees of attention during that process;
- the competing trade marks are visually and aurally similar to a fairly high degree and while the opponent's trade mark will convey a concrete conceptual message to the average consumer, the applicant's trade mark will convey none;
- the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character which, on the basis of the evidence provided, has not been enhanced by its use in the UK.

44. As I explained above, there are, in principle, two types of confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain

Purvis Q.C., as the Appointed Person, explained the difference in the following manner:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

45. In my view indirect confusion has no part to play in these proceedings; the average consumer will either mistake the competing trade marks or they will not. In its submissions, the applicant referred me to the decision of the CJEU in *The Picasso Estate v OHIM*, Case C-361/04 P, in which the court found:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

46. However, in reaching a conclusion I remind myself that in *Nokia Oyj v OHIM*, Case T-460/07, the GC stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established

(see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

47. I shall proceed on the basis most favourable to the opponent i.e. that the competing goods are identical or similar to a high degree and the average consumer will pay only a low degree of attention during the selection process (thus making him or her more susceptible to the effects of imperfect recollection). However, even proceeding on that basis, having reminded myself of the fairly high degree of visual and aural similarity between the competing trade marks, I am satisfied that the very clear conceptual message conveyed to the average consumer by the opponent’s trade mark (which is likely to fix itself in the average consumer’s mind and act as a hook to aid the average consumer’s recall), is sufficient to “counteract the visual and phonetic similarities” between the competing trade marks, such that there is no likelihood of direct confusion. Having reached that conclusion, the opposition based upon section 5(2)(b) of the Act fails and is dismissed accordingly.

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

48. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L’Oreal v Bellure* and *Case C-323/09, Marks and Spencer v Interflora*. The law appears to be 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, 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*.
- (c) It is necessary 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 Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the 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) Where a link is established, the owner of the earlier mark must also establish 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 relevant factors; *Intel, paragraph 79*.

(f) 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 risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) 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*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any

financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

49. Once again, I will proceed on the basis most favourable to the opponent i.e. that by the relevant date the use it had made of its "SILENCE" trade mark since June 2014 in the EU in relation to the goods identified in Mr Ledermann's statement is sufficient to satisfy the threshold criteria mentioned in *General Motors*. However, even proceeding on that basis in relation to identical and highly similar goods, the conceptual difference between the competing trade marks is, in my view, so stark that upon seeing the applicant's trade mark the opponent's trade mark would not be called to mind. As there will be no link, there can be none of the adverse consequences for the opponent envisaged by section 5(3) of the Act and, as a consequence, the opposition under this head also fails.

The opposition based upon section 5(4)(a) of the Act

50. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but

it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

51. For the final time I will proceed on the basis most favourable to the opponent i.e. that by the date the applicant’s trade mark was filed, the trade conducted by the opponent under its “SILENCE” trade mark in the UK since December 2014 in relation to the goods identified in Mr Ledermann’s statement was sufficient to have generated a protectable goodwill. However, as the trade mark relied upon is the same as that I have already dealt with under section 5(2)(b) of the Act, there will, in my view be no misrepresentation, for the same reasons, without which there can be no damage and the opposition based upon section 5(4)(a) of the Act fails accordingly.

Overall conclusion

52. The oppositions based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act have all failed and, subject to any successful appeal, the application will proceed to registration.

Costs

53. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the above guidance, I award costs to the applicant on the following basis:

Reviewing the Notice of opposition and filing a counterstatement:	£300
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Preparing evidence and considering and commenting upon the opponent’s evidence:	£500
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Written submissions: £500

Total: £1300

54. I order Metallwarenfabrik Marktoberdorf GmbH & Co. KG to pay to Business Present Limited the sum of **£1300**. This sum is to be paid within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 16 July 2019

C J BOWEN

For the Registrar