

**BL O/458/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3330094**

**BY**

**UK CMTM INTERNATIONAL CO., LTD**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 07, 08 & 09:**

**CMTM**

**AND**

**OPPOSITION THERETO (NO. 414167)**

**BY**

**C.M.T. UTENSILI S.P.A.**

## **Background and pleadings**

1. UK CMTM INTERNATIONAL CO., LTD, (hereafter “the applicant”) applied to register the trade mark:

CMTM

in the UK on 08 August 2018. It was accepted and published in the Trade Marks Journal on 24 August 2018, for a range of goods in classes 07, 08 and 09. However the opposition was raised only against the goods applied for in classes 07 and 08. The opponent later restricted the scope of the opposition to just a part of the class 07 goods and all of the class 08 goods. This opposition is therefore only directed at the following goods:

**Class 07:** Cutting machines; Hoists; Screwdrivers, electric; Cutters [machines]; Socket spanners [machines]; Torque spanners [machines]; Welding machines, electric; Saws [machines]; Electric hammers; Hand-held tools, other than hand-operated; Electric hand drills; Machines and apparatus for polishing [electric].

**Class 08:** Fleshing knives [hand tools]; Spanners [hand tools]; Hand tools, hand-operated; Hollowing bits [parts of hand tools]; Agricultural implements, hand-operated; Screwdrivers, non-electric; Harpoons; Cutting tools [hand tools]; Awls; Wrenches [hand tools]; Abrading instruments [hand instruments]; Nippers.

2. C.M.T. Utensili S.p.a. (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
3. The opposition is based on two earlier rights. Firstly, earlier International registration (IR) designating the European Union no. 892306, which designated the EU on 10 January 2006 (claiming an international convention priority date of 07 September

2005 from an earlier filing in Italy) and which was granted protection in the EU on 05 July 2007, for the mark:



4. The opponent relies on all of the goods for which the earlier mark is protected, namely:

**Class 07:** Machines and machines tools; tools for drilling, boring, electric milling, mortising machines and pantographs; parts of machines and machine tools, namely, router bits, boring bits, routers, dowel drills, chucks, router cutters, countersinks, drills bits, collets, saw blades; routers (spindle moulding machines); all adaptors for machine tools included in this class.

**Class 08:** Hand-operated hand tools and implements, namely, chucks, milling cutters, tips for piercing, planes, pliers.

5. The opposition is also based on European Union Trade Mark (EUTM) no. 4923397, which was filed on 24 February 2006 and registered on 18 May 2007 for the mark:



6. The opponent relies on all of the goods for which the earlier mark is registered, namely:

**Class 07:** Mechanical hand tools for electric milling machines, saws, pantographs, woodworking machines, mortising machines, planing machines, drilling machines and drills; tools, including end mills, end mills with reversible cutters, circular blades, circular blades for joints, milling cutters, blade holders, planer blades, reversible cutters, drills, drilling heads, drill bits, countersink drill bits, elastic collet chucks, drill chucks, drill bit collets and drill bit attachments.

**Class 08:** Non-mechanical hand tools, including milling cutters, blades, planer blades, cutters, countersinks, chucks, drilling bits, grippers.

7. Given the dates of registration and protection, the opponents marks qualify as earlier marks in accordance with section 6 of the Act and are both subject to the proof of use provisions contained in Section 6A.
8. In its statement of grounds, the opponent claims that the contested mark is similar to the earlier marks and covers identical and similar goods in classes 07 and 08. There is therefore a likelihood of confusion including a likelihood of association.
9. In its counterstatement the applicant states that the respective marks are not similar, and neither are the goods. As such, there will be no likelihood of confusion. The applicant also puts the opponent to proof of use of both of the earlier marks on which it relies.
10. The opponent filed written submissions in lieu which I will not summarise here, but will refer to where necessary, later in my decision.
11. As no hearing was requested, this decision is taken following a careful perusal of the papers.
12. Throughout the proceedings the applicant has been represented by RevoMark, whilst the opponent has been represented by J A Kemp.

### **Evidence**

13. The opponent submitted evidence of use in the form of a witness statement of Mr Marcello Tommassini, the Chief Executive Officer of C.M.T. Utensili S.p.a. the opponent company, along with nine exhibits labelled MT1 - MT9. The witness statement is dated 05 February 2019.
14. In his witness statement, Mr Tommassini sets out his position in his company and provides background information about the opponent's business. The opponent was founded in 1962 in Italy. The opponent manufactures and sells a wide range of

power tools and their parts and a variety of hand tools, mostly but not exclusively for use in woodworking. The opponent's products are sold globally and throughout the EU.

15. The opponent's principle trade marks, which are used in relation to all of its products, are the CMT logo and CMT Orange Tools logo which are the subject of EU 4923397 and IR 892306, the earlier marks relied upon in this opposition. The opponent has used the EU mark in the EU since 1994 and the IR in the EU since 2005. The opponent states that it has made genuine use of the earlier marks during the relevant period of time.

16. Mr Tommassini goes on to summarise the contents of the exhibits accompanying his witness statement:

- **MT1:** provides information about the opponent and its products in the form of extracts from the company website.
- **MT2:** provides figures showing the value of sales of goods using the earlier marks in all of the EU member states between 2013 and 2017. Sales grew from 11.5 million euros in 2013 to 20.2 million euros in 2017.
- **MT3:** provides a list of sales in a number of EU member states, notably Poland, France and the UK between 2013 and 2018. It also gives information on sales in Italy but, limited by page restriction on evidence, only gives figures for the years 2014, 2016 and 2018.
- **MT4:** provides a number of sample invoices dated across the relevant period, showing orders from customers in Italy, Poland, UK and France.
- **MT5:** provides promotional material. The principal means of promoting and ordering the opponent's goods are by way of the company's catalogue which is available electronically, in hard print and also searchable on the company website. MT5 also provides sample extracts from the opponent's English

language catalogues from 2014/2015 and 2018. The exhibit also includes some sample pages from the 2016/2017 catalogue.

- **MT6:** shows copies of the front pages of the opponent's French and Polish catalogues for various years across the relevant period.
- **MT7:** provides information about the opponent's distribution of its products through UK companies, with extracts from the opponent's website and the websites of UK dealers selling the opponent's goods. This exhibit also includes examples of online retailers selling the opponent's goods to customers in the UK.
- **MT8:** provides information about the opponent's attendance at trade shows to promote and raise awareness of its brand. The exhibit includes images or promotional materials relating to the opponent's attendance at trade shows in Hanover in 2013 and 2017 and Cologne in 2018.
- **MT9:** shows use of the CMT logo mark throughout the relevant period. Whilst the opponent states that the IR combined logo mark, incorporating the element 'CMT' and the words 'ORANGE TOOLS', is the more commonly used of the two earlier marks, they claim that the evidence shows that both are used on the goods and throughout the relevant period.

## **Decision**

### **Proof of use**

17. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v*

*Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase

of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de*

*minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”:

19. As the earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

20. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant’s challenge to the Board of Appeal’s conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant’s argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guilford, and thus a finding which still left open the possibility of conversion of the community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as

establishing that “genuine use in the Community will in general require use in more than one Member State” but “an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State.” On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon’s analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

21. The General Court (“GC”) restated its interpretation of *Leno* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.
22. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant 5-year period. In making the assessment I am required to consider the relevant factors, including:
  - a) The scale and frequency of the use shown;
  - b) The nature of the use shown;

- c) The goods for which use has been shown;
- d) The nature of those goods and the market(s) for them; and
- e) The geographical extent of the use shown.

23. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

24. According to section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for mark. Consequently, the relevant period begins on 25 August 2013 and ends on 24 August 2018.

25. The evidence in MT1 is comprised of historical information about the opponent. The opponent appears to be focussed largely on the manufacture of woodworking tools. In Mr Tommassini’s Witness Statement, he states that his company “*manufactures and sells a wide range of power tools and their parts, and a variety of hand tools. Mostly but not exclusively for use in relation to woodworking*”. MT1 refers to the opponent company as ‘CMT’, and the ‘CMT ORANGE TOOLS’ mark (the IR) can be seen on display. The webpages in MT1 are all in English and are dated 30 January 2019, the date on which the pages were printed. None of the pages include information with dates falling within the relevant period however.

26. Exhibit MT2 is comprised of a single sheet of paper listing all of the EU member states, with columns for the years 2013 – 2017 and a set of figures for each member state for each year. There is no indication as to what the figures represent and there is no sign of the marks at issue. The opponent states that MT2 reflects sales of its products. There is no indication of currency, but I will assume that the sales of the opponent’s goods are in Euros. The figures are quite impressive, with around €11 million sales across the EU in 2013, including €243,000 in the UK. Rising to over €20

million sales across the EU in 2017 with almost half a million euros worth of sales in the UK alone. The opponent has sold its goods in every EU member state with the exception of Slovakia.

27. Exhibit MT3 is comprised of lists of sales to companies in Italy, Poland, France and the UK. No specific products are listed and the marks at issue are not present on these lists. The figures involved are significant and appear to support the level of sales established in MT2.
28. Exhibit MT4 is comprised of a number of sample invoices which are dated, fall within the relevant period and show specific goods that have been ordered. The invoices are all headed with the earlier IR mark and the company name. The invoices show sales in Italy, France, Poland and UK. While the Italian and French invoices are not in English, the UK and Polish invoices list the goods ordered in English.
29. Exhibit MT5 is comprised of promotional material and catalogues. The first document is the opponent's 2014/15, 50th anniversary catalogue. This is in English and the earlier IR mark is displayed prominently. The earlier EUTM mark is present on the front page. Within the catalogue, the opponent refers to itself as 'CMT' or the 'CMT Team'. Both earlier marks are displayed. The contents page of the catalogue shows that the goods provided include: Saw blades; Jig saw blades; Tools with bore and knives; Router bits and sets; Router cutters and chucks; Dowel drills; Bits for hand power tools; Display cabinets and spare parts and Router table systems. The exhibit also contains a copy of pages from the opponent's 2016/17 catalogue, in English. This catalogue lists 'Blades and cutting tools' as products on offer. The opponent's 2018 catalogue is also in English and lists the same goods on offer plus spare parts and some accessories. The elements 'CMT' and 'ORANGE TOOLS' are used in combination in the majority of cases but the stylised 'CMT' element which forms the earlier EUTM is displayed on some pages in isolation.
30. Exhibit MT6 comprises much of the same information as shown in MT5 but from the French catalogues from 2016/17 and 2018, and the Polish versions from the same years. All show the opponent's goods as set out in MT5 and the earlier IR mark is shown.

31. Exhibit MT7 is comprised of UK distributor webpages showing the opponent's goods for sale in pounds sterling. The earlier IR mark is displayed. The goods on offer are referred to as 'CMT' products, e.g. 'The CMT pocket-pro drilling starter set' and 'Tomaco sales team are pleased to announce that they will be selling the CMT range through a network of key dealers throughout the UK'; 'CMT 160mm TCT Saw Blade – CMT products are manufactured by...'. Not all of the webpages are dated, but the information showing the Tomaco webpages are from a 2016 catalogue.
32. Exhibit MT8 contains pictures of a trade stand in an exhibition hall. The opponent states that this is from an event in 2013 in Hanover, Germany. The earlier IR mark is clearly visible in all of these pictures and in some instances the stylised EUTM 'CMT' mark is shown sitting above the words 'ORANGE TOOLS' rather than alongside it as it is in the IR mark. There are also pictures from the same exhibition in Hanover in 2017 and the earlier IR mark is predominant. The exhibit also includes pictures of goods, some of which show 'CMT' without the words 'ORANGE TOOLS' but with other elements, e.g. a power hand tool labelled as the 'CMT11'. The exhibit also includes additional pictures of a trade stand at an event hall, which the opponent has labelled as Cologne in 2018. The IR mark predominates on this stand, however there are instances of the earlier EU mark in isolation (page 256 of the evidence for example).
33. Exhibit MT9 includes images of the earlier EU mark stamped on the side of certain tools including drill bits. Pages 262-265, 269, 270, 273, 275 and 276 of the evidence specifically show the 'CTM' element in isolation. This information is undated.
34. The evidence of use appears to support a finding that the opponent has used both of the earlier marks on which it relies, across the relevant period of time. As the opponent has stated, the majority of use shown is that of the earlier IR, however it is the case that the earlier EU mark is also shown in use. I note that the IR mark is essentially a combination of the EU mark with the words 'ORANGE TOOLS' added to it and as such, when the IR mark is shown in use, this use can also be said to show the EUTM in use<sup>1</sup>. The opponent has shown that it sells a large number of its

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<sup>1</sup> Applying the criteria set out by Mr Richard Arnold Q.C. (as he then was) in *Nirvana Trade Mark*, BL O/262/06

goods across the EU territory. It has shown that substantial sales have been made in every EU member state other than Slovakia, between 2013 and 2017 and that these sales amount to tens of millions of euros in sales income. Whilst some of the opponent's goods might be considered to be relatively expensive, many of the goods at issue, e.g. drill bits, knives or dowel drills, can be said to be moderately priced, and in such context, sales of €20 million euros in 2017 can be said to be significant. The opponent has shown evidence through pictures of professional trade stands, that it has promoted its products at trade events and exhibitions. The catalogue evidence has shown the breadth of the opponent's range of goods since at least 2014.

35. The use shown in evidence is clearly trade mark use intended to distinguish the goods of the opponent from other goods which have a different origin. I find the use shown in evidence to be use of the marks intended to create or preserve a place in the relevant market. There has been real commercial exploitation of the marks, in order to create and maintain a market share. The scale and frequency of use of the marks has been established. There has been regular and consistent use of the marks throughout the relevant period. The marks have however, only been shown in use on a part of the goods on which the opponent relies.

36. I conclude therefore, that the evidence submitted by the opponent is sufficiently clear and detailed and is sufficiently solid to prove genuine use of the marks relied upon. Accordingly, I find that there has been genuine use of the opponent's earlier marks on a part of the goods relied upon during the relevant period.

37. I note that, aside from comments made in its counterstatement, the applicant has made no submissions and does not therefore appear to refute any of the evidence provided by the opponent to show genuine use of its earlier marks.

### **Fair Specification**

38. I now need to determine a fair specification to reflect the use made. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

39. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot

reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

40. For the purposes of this opposition the opponent has relied upon:

Earlier EUTM:

**Class 07:** Mechanical hand tools for electric milling machines, saws, pantographs, woodworking machines, mortising machines, planing machines, drilling machines and drills; tools, including end mills, end mills with reversible cutters, circular blades, circular blades for joints, milling cutters, blade holders, planer blades, reversible cutters, drills, drilling heads, drill bits, countersink drill bits, elastic collet chucks, drill chucks, drill bit collets and drill bit attachments.

**Class 08:** Non-mechanical hand tools, including milling cutters, blades, planer blades, cutters, countersinks, chucks, drilling bits, grippers.

And:

Earlier IR:

**Class 07:** Machines and machines tools; tools for drilling, boring, electric milling, mortising machines and pantographs; parts of machines and machine tools, namely, router bits, boring bits, routers, dowel drills, chucks, router cutters, countersinks, drills bits, collets, saw blades; routers (spindle moulding machines); all adaptors for machine tools included in this class.

**Class 08:** Hand-operated hand tools and implements, namely, chucks, milling cutters, tips for piercing, planes, pliers.

41. Within the class 07 specification of the earlier EU mark the term '*tools, including...*' is very broad and encompasses a wide range of products. Within the earlier IR class 07 specification, the terms '*Machines*' and '*all adaptors for machine tools included in this class*' are also considered to be very broad in nature.
42. The opponent has stated that the majority of its goods are intended for use in woodworking and wood cutting but that they also produce other tools and products not intended for woodworking or cutting. I note that in exhibit MT4, the Polish and English versions of invoices list goods such as: Shank for hole saw metal; drills; bits; w/knife; pair knives; precision guide; hole saw for plastic; hole saw for steel/aluminium; saw blades; adaptor; kinetic dust extractor; torx screw; mini replaceable knife. However, in exhibit MT5 the English version catalogue of the opponent states in the welcome page: "*Choose from a wider range of innovative and state-of-the-art woodworking tools...*" "*This catalogue contains CMT's highest dedication to the professional woodworker*" and "*our highly skilled engineers and operators are eager to design it for you to assist you with your woodworking operations*". Exhibit MT5 lists sections of the catalogue covering specifically: Saw blades; Jig saw blades; Tools with bore and knives; Router bits and sets; CNC router cutters and chucks; Industrial dowel drills; Bits for hand power tools; Power tools and accessories; Display cabinets and spare parts.
43. Exhibit MT5 also includes the following text "*After 50 years of success...in manufacturing woodworking tools*". However, page 184 (MT5) of the evidence shows something called a CMT11, which is a power tool that has several applications and

appears to be a tool that is not intended solely to be used on wood. Pages 186-190 of the evidence also list a number of products that are not necessarily for use in woodworking. Accessories such as lubricant, rulers and bags are also provided by the opponent. Page 214 (MT6) of the evidence comprises a page from the website of Machinery4wood which includes the following statement: “*The CMT Orange Tools brand is known throughout the world woodworking community as the premium brand of woodworking cutting tools.*”

44. The evidence points to a finding that the opponent is a well-known and highly regarded producer of tools and equipment for use in woodworking and wood cutting. The opponent has acknowledged that the majority of the goods it produces are for use in the woodworking industry. However, there is some evidence to show that the opponent also produces and sells tools and other products which are not intended to be used for working with wood.
45. Following analysis of the opponent’s evidence, I do not accept that the opponent has shown genuine use on a sufficiently broad range of goods such that I can accept the terms ‘*tools, including...*’, ‘*Machines*’ and ‘*all adaptors for machine tools included in this class*’. The term ‘*tools, including...*’ is unlimited in its scope and essentially covers every kind of tool. The evidence has shown that the opponent produces a variety of tools and hand tools, some powered and others not. However clearly the opponent does not produce every possible kind of tool on the market. For the same reasons, the terms ‘*Machines*’ and ‘*all adaptors for machine tools included in this class*’ cover an unlimited range of machines and adaptors for machine tools, and the opponent’s evidence cannot be said to support this position.
46. In coming to a conclusion regarding a fair specification in respect of both earlier marks, I remind myself of the finding set out above (paragraph 39), in *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot

reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration.

47. The opponent has shown that its business is not limited solely to woodworking and wood cutting tools, but also produces and sells, albeit to a much lesser extent, tools and equipment which can be used for other purposes. Based on the information shown in evidence, I conclude that fair specifications for the earlier marks are:

Earlier EUTM:

**Class 07:** Mechanical hand tools for electric milling machines, saws, pantographs, woodworking machines, mortising machines, planing machines, drilling machines and drills; end mills, end mills with reversible cutters, circular blades, circular blades for joints, milling cutters, blade holders, planer blades, reversible cutters, drills, drilling heads, drill bits, countersink drill bits, elastic collet chucks, drill chucks, drill bit collets and drill bit attachments.

**Class 08:** Non-mechanical hand tools, including milling cutters, blades, planer blades, cutters, countersinks, chucks, drilling bits, grippers.

And:

Earlier IR:

**Class 07:** Machines tools; tools for drilling, boring, electric milling, mortising machines and pantographs; parts of machines and machine tools, namely, router bits, boring bits, routers, dowel drills, chucks, router cutters, countersinks, drills bits, collets, saw blades; routers (spindle moulding machines).

**Class 08:** Hand-operated hand tools and implements, namely, chucks, milling cutters, tips for piercing, planes, pliers.

## **Section 5(2)(b) of the Act**

48. Section 5(2)(b) of the Act is as follows:

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

(a) ....

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

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

49. The following principles are gleaned from the decisions of the CJEU 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

50. I will begin by comparing the earlier EUTM with the contested mark, as this earlier mark contains broader specifications of goods and the marks are likely to be found more similar than the earlier IR might be, due to additional verbal elements in the IR. I will consider the earlier IR later in my decision.

### **Comparison of goods and services**

51. In the judgment of the Court of Justice of the European Union 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”.

52. 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.

53. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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”.

54. The parties’ respective goods, taking account of the fair specifications set out in paragraph 47 above, are:

Opponent’s goods	contested goods
<p><b>Class 07:</b> Mechanical hand tools for electric milling machines, saws, pantographs, woodworking machines, mortising machines, planing machines, drilling machines and drills; end mills, end mills with reversible cutters, circular blades, circular blades for joints, milling cutters, blade holders, planer blades, reversible cutters, drills,</p>	<p><b>Class 07:</b> Cutting machines; Hoists; Screwdrivers, electric; Cutters [machines]; Socket spanners [machines]; Torque spanners [machines]; Welding machines, electric; Saws [machines]; Electric hammers; Hand-held tools, other than hand-operated; Electric hand drills; Machines</p>

<p>drilling heads, drill bits, countersink drill bits, elastic collet chucks, drill chucks, drill bit collets and drill bit attachments.</p> <p><b><u>Class 08:</u></b> Non-mechanical hand tools, including milling cutters, blades, planer blades, cutters, countersinks, chucks, drilling bits, grippers.</p>	<p>and apparatus for polishing [electric].</p> <p><b><u>Class 08:</u></b> Fleshing knives [hand tools]; Spanners [hand tools]; Hand tools, hand-operated; Hollowing bits [parts of hand tools]; Agricultural implements, hand-operated; Screwdrivers, non-electric; Harpoons; Cutting tools [hand tools]; Awls; Wrenches [hand tools]; Abrading instruments [hand instruments]; Nippers.</p>
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55. Applying the *Meric* principle, the contested class 07 goods ‘Hand-held tools, other than hand-operated; Electric hand drills’ wholly encompass the earlier ‘Mechanical hand tools for electric milling machines, saws, pantographs, woodworking machines, mortising machines, planing machines, drilling machines and drills’ and are therefore identical.
56. The contested ‘cutting machines; Cutters [machines]’ wholly encompass the earlier ‘milling cutters’ and ‘reversible cutters’ and are therefore considered to be identical.
57. The contested ‘Saws [machines]’ are considered to share purpose, channels of trade, manufacturer and end-user with the earlier ‘Mechanical hand tools for saws’ ‘milling cutters’ and ‘reversible cutters’. These goods are found to be similar to a medium degree.
58. Use of the term ‘including’ in specifications does not have a limiting effect (unlike the use of namely) and therefore all of the goods listed after ‘including’ are merely considered to be indicative of the goods for which protection is sought. Accordingly, within the class 08 specification of the earlier EUTM, the term ‘Non-mechanical hand tools, including...’ encompasses a very wide range of hand tools. The contested class 07 ‘Hoists; Screwdrivers, electric; Socket spanners [machines]; Torque

spanners [machines]; Electric hammers'; are mechanical hand tools which may be said to share purpose, channels of trade, manufacturer and end-user with the earlier 'Non-mechanical hand tools...'. These goods are found to be similar to a medium degree.

59. The contested 'Machines and apparatus for polishing [electric]' are goods which are used to produce a smooth and polished surface. The earlier 'Mechanical hand tools for electric milling machines and planing machines; milling cutters, planer blades' are goods that are used to mill or plane a surface. Milling is the process of grinding, pressing, cutting or processing something; planing is the process of levelling, smoothing or cutting something. As all of these goods are intended to smooth or level a surface, they can be said to share to, some degree, purpose. They may also be found to share channels of trade, manufacturer and end-user. These goods are therefore found to be similar to a medium degree.

60. The contested 'Welding machines, electric' are goods used to join together pieces of metal or plastic by melting them with heat. None of the earlier goods of the EUTM can be said to be similar to electric welding machines. They do not share nature, purpose or end-user. It is also unlikely that they would share manufacturer or channels of trade. These goods are therefore dissimilar.

61. The earlier class 08 goods 'Non-mechanical hand tools, including...' comprise a very wide range of goods and can be said to wholly encompass all of the contested class 08 goods with the exception of 'harpoons'. A harpoon is a barbed spear or missile, used as a weapon for hunting large fish and whales. None of the earlier goods of the EUTM can be said to be similar in any way to a harpoon, and as such these goods are found to be dissimilar.

62. With the exception of 'harpoons', all of the contested goods in class 08 are found to be identical to the earlier class 08 goods.

63. In conclusion, some of the contested goods have been found to be identical and some to be similar to a medium degree. The contested goods 'Welding machines, electric' and 'Harpoons' have been found to be dissimilar.

#### **Average consumer and the purchasing act**

64. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

65. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

66. The goods at issue are hand tools and cutting/sawing machines. Whilst some of the goods concerned may be relatively expensive and purchased infrequently, this cannot be said to be the case for all of the goods, some of which will be moderately priced and purchased on a more frequent basis, e.g. drill bits. The relevant public will be both the general public and the professional consumer in the woodworking, joinery and building industries.

67. I consider that the member of the public will pay no more than an average degree of attention during the selection process for the goods at issue; whilst it can be said that

the professional consumer may pay a higher than average level of attention during the selection, to ensure that the product chosen is fit for purpose.

68. The average consumer is likely to purchase the goods from specialist suppliers either in a retail premises or from a website or catalogue. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural element to the purchase of these goods, given that advice may be sought from sales representatives or by telephone.

### **Comparison of marks**

69. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the 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 that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

71. The marks to be compared are:

Earlier EU mark	Contested mark
	CMTM

72. The earlier EU mark is a figurative mark combining the letters 'CMT' which are presented in a heavy bold type face and capital lettering, with an inverted triangular element positioned at the centre point of the letter 'M' in the 'CMT' element. The letter string 'CMT' can be said to be the dominant and more distinctive element in the mark. The triangle shaped element is likely to be overlooked, but where it is perceived, due to the size and dominance of the letters 'CMT' it will play a much lesser role in the mark. The overall impression in the earlier mark is that of the letter string 'CMT'.

73. The contested mark is comprised of the letter string 'CMTM' which is presented in a fairly standard type-face and capital lettering. The overall impression lies in the mark as a totality.

### **Visual similarity**

74. The marks at issue share the letters 'CMT' presented in an identical order. The marks differ in the heavier font and the triangular shaped element that is presented at the centre of the letter 'M' of the earlier mark, and in the final letter of the contested mark, a letter 'M' which has no counterpart in the earlier mark. The earlier mark is dominated by the letter string 'CMT'. The three letters of the earlier mark are wholly contained within, and form the beginning of, the contested mark. As such, the marks can be said to be visually similar to a high degree.

### **Aural similarity**

75. The opponent's earlier mark is likely to be articulated as *SEE/EM/TEE*. The applicant's contested mark is likely to be articulated as *SEE/EM/TEE/EM*. As the earlier mark is identically replicated in the contested mark and forms the first three of four syllables in the contested mark, the marks are found to be phonetically similar to a high degree.

### **Conceptual similarity**

76. Conceptually, both marks are acronyms with no particular meaning or association with the goods at issue. As such, the marks can be said to be conceptually neutral and therefore cannot be found to share any conceptual similarity.

77. In conclusion, the marks have been found to be visually and aurally similar to a high degree and conceptually neutral.

### **Distinctive character of the earlier trade mark**

78. 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 *WindsurfingChiemsee 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).”

79. The opponent has not claimed that its earlier mark has enhanced distinctive character through use, I therefore have to consider only the question of inherent distinctive character.

80. The opponent’s mark is comprised of the acronym ‘CMT’ with some stylisation in the form of a triangular element placed above the letter ‘M’. The letter string ‘CMT’ has no obvious meaning or association with the goods concerned. I therefore conclude that the earlier mark is inherently distinctive to at least a medium degree.

### **Likelihood of Confusion**

81. I now draw together my earlier findings into a global assessment of the likelihood of confusion, keeping in mind the legal principles established previously (see paragraph 49 above).

82. 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 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 marks side by side but must instead rely upon the imperfect picture of them he has retained in his mind.

83. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, whilst indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods/services down to the responsible undertakings being the same or related.

84. I have already found that:

- the goods are identical; similar to a medium degree or dissimilar;
- the marks are visually and aurally similar to a high degree, and conceptually neutral;
- the average consumer will be a member of the general public or a professional;
- the general public consumer can be expected to be paying an average level of attention when selecting the goods at issue; the professional consumer will likely pay a higher than average level of attention;
- during the selection process, the visual and aural considerations will both be important however the visual element will likely play the greater role;
- the earlier mark has at least a medium degree of inherent distinctiveness;

85. Having weighed up all of the factors, I conclude that, for those goods which have been found to be identical and similar to a medium degree, there is a likelihood of direct confusion between the marks. The average non-professional consumer will be paying an average level of attention during the purchasing act and some products at issue will not be particularly expensive. The acronym 'CMT' has been found to be inherently distinctive to at least an average degree and has no obvious meaning or conceptual hook. Where the triangular shaped element in the earlier mark may go unnoticed, the earlier mark can be said to be wholly contained within the contested mark, with only the final letter of the later mark creating a difference between them. The contested mark is presented in a fairly standard script and font, however allowing for notional and fair use, it is not inconceivable that the applicant may present the mark 'CMTM' in an identical font and type face as that shown in the earlier mark. Applying the principle of imperfect recollection, I conclude that a consumer of the opponent's goods bearing the earlier EUTM may, when later faced

with the contested mark, or vice-versa, mistake one mark for the other. I find that the differences between the marks will go unnoticed.

86. As I have found that there is a likelihood of confusion between the opponent's earlier EUTM and the applicant's later mark, in respect of only a part of the contested goods, I must now consider the opponent's other earlier right in this matter (IR no.892306), with regard to the contested goods found to be dissimilar to the earlier EUTM goods, namely 'Welding machines; electric' in class 07 and 'Harpoons' in class 08.

87. In considering the marks at issue, the opponent's earlier IR is less similar to the contested mark than its' earlier EUTM, as the IR mark contains additional verbal material.

88. The goods which I have concluded constitute a fair specification (see paragraph 47 above) for the earlier IR are:

**Class 07:** Machines tools; tools for drilling, boring, electric milling, mortising machines and pantographs; parts of machines and machine tools, namely, router bits, boring bits, routers, dowel drills, chucks, router cutters, countersinks, drills bits, collets, saw blades; routers (spindle moulding machines).

**Class 08:** Hand-operated hand tools and implements, namely, chucks, milling cutters, tips for piercing, planes, pliers.

89. None of these earlier goods can be said to share nature, purpose, channels of trade, manufacturer or end-user with the contested 'Welding machines, electric' in class 07 or 'Harpoons' in class 08. Therefore, I find these goods to be dissimilar to all of the goods of the earlier IR.

## **Conclusion**

90. The opposition has been partially successful, there is a likelihood of confusion in respect of a part of the goods under opposition. The application is therefore, subject to appeal, partially refused in respect of:

**Class 07:** Cutting machines; Hoists; Screwdrivers, electric; Cutters [machines]; Socket spanners [machines]; Torque spanners [machines]; Saws [machines]; Electric hammers; Hand-held tools, other than hand-operated; Electric hand drills; Machines and apparatus for polishing [electric].

**Class 08:** Fleshing knives [hand tools]; Spanners [hand tools]; Hand tools, hand-operated; Hollowing bits [parts of hand tools]; Agricultural implements, hand-operated; Screwdrivers, non-electric; Cutting tools [hand tools]; Awls; Wrenches [hand tools]; Abrading instruments [hand instruments]; Nippers.

91. The application may proceed to registration for all of the goods applied for in class 09, which were not opposed, and for: 'Dust removing installations for cleaning purposes; Pumps [machines]; Lace making machines; Mixing machines; water separators; drain cocks; Agricultural machines' in class 07, to which the initial opposition was withdrawn.

92. Subject to appeal, the application may also proceed to registration for those goods found to be dissimilar to the opponent's earlier goods in both of the earlier marks, namely 'Welding machines, electric' in class 07 and 'Harpoons' in class 08.

## **Costs**

93. The opponent has been largely successful and is entitled to a contribution towards its costs, which are sought on the usual scale (contained in Tribunal Practice Notice 2/2016). I award the opponent the sum of £1100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee for opposition	£100
Preparing the statement of case and considering the counterstatement	£200
Preparing evidence	£500
Preparing written submissions in lieu of a hearing	£300
Total	£1100

94. I therefore order UK CMTM INTERNATIONAL CO., LTD, to pay C.M.T. Utensili S.p.a. the sum of £1100. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 08<sup>th</sup> day of August 2019**

**Andrew Feldon  
For the Registrar  
The Comptroller-General**