

**O-153-20**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No. 3243709  
BY LANSERRING LTD  
TO REGISTER IN CLASSES 20, 35, 37, 40 & 42  
THE TRADE MARK  
LANSERRING LONDON**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 410666  
BY  
LANSERHOF GMBH**

## **BACKGROUND**

1) On 14 July 2017, Lanserring Ltd (hereinafter the applicant) applied to register the trade mark Lanserring London in respect of the following goods and services:

In Class 20: Assembled display stands; Assembled display units [furniture]; Back panels [parts of furniture]; Barstools; Bench seating; Bench tables; Benches; Benches [furniture]; Book holders [furniture]; Book rests [furniture]; Book shelves; Book stands [furniture]; Bottle racks; Buffets [furniture]; Cabinet doors; Cabinet fittings [not of metal]; Cabinets; Cabinets for display purposes; Cabinets for storage purposes; Cabinets for tea services; Cabinets for waste bins; Cabinets [furniture]; Ceramic knobs; Ceramic pulls for cabinets, drawers and furniture; Chairs; Chairs [seats]; Chests; Closets; Clothes racks [furniture]; Coat racks [furniture]; Cocktail units [furniture]; Consoles [furniture]; Containers, and closures and holders therefor, non-metallic; Counters [furniture]; Counters [tables]; Cupboard doors; Cupboard units; Cupboards; Display cabinets; Display furniture; Display units [furniture]; Drawers; Dressers; Dressing tables; Fitted cupboards; Fitted furniture; Fitted kitchen furniture; Food racks; Furniture; Furniture cabinets; Furniture chests; Furniture doors; Furniture fittings, not of metal; Furniture for display purposes; Furniture for kitchens; Furniture units for kitchens; Hinges, not of metal; Kitchen cabinets; Kitchen cupboards; Kitchen display units; Kitchen furniture; Kitchen tables; Kitchen units; Racks [furniture]; Seating furniture; Seats; Seats [furniture]; Serving trolleys; Shelf units [furniture]; Shelves; Shelving units; Shoe cabinets; Shoe racks; Side tables; Sideboards; Stools; Storage boxes [furniture]; Storage cabinets [furniture]; Storage cupboards [furniture]; Storage drawers [furniture]; Storage furniture; Storage units [furniture]; Table tops; Tables [furniture]; Tie racks; Units [furniture]; Wall chests; Wall cupboards; Wall partitions [furniture]; Wall shelves furniture; Wall units [furniture]; Wardrobe doors; Wardrobes; Wine racks; Wine racks [furniture]; Wooden furniture; Wooden shelving [furniture]; Work counters [furniture]; Work surfaces; Work tops [furniture]; Worktops.

In Class 35: The bringing together, for the benefit of others, of a variety of kitchen appliances, sanitary ware, baths, sink units, flooring, furniture, cupboards, kitchen units, tables, chairs, drawers, racks, storage, beds and bed surrounds enabling customers to conveniently view and purchase those goods in an interior design and retail furniture and accessories store; the bringing together, for the benefit of others, of a variety of kitchen appliances, sanitary ware, baths, sink units, flooring, furniture, cupboards, kitchen units, tables, chairs, drawers, racks, storage, beds and bed surrounds, enabling customers to conveniently view and purchase those goods from a furniture and accessories catalogue by mail order; the bringing together, for the benefit of others, of a variety of kitchen appliances,

sanitary ware, baths, sink units, flooring, furniture, cupboards, kitchen units, tables, chairs, drawers, racks, storage, beds and bed surrounds, enabling customers to conveniently view and purchase those goods online from an interior design, furniture and accessories website.

In Class 37: Installation of fitted furniture; Installation of kitchen appliances; Installation of kitchen cabinets; Installation of kitchen equipment; Installation of kitchens; Installation of laundry and kitchen equipment; Installation of lighting apparatus; Installation of lighting systems; Installation of shelving; Maintenance and repair of furniture; Maintenance, servicing and repair of household and kitchen appliances.

In Class 40: Cabinet making; Cabinet-making (custom manufacture); Custom manufacture of furniture.

In Class 42: Design consultancy; Design of furniture; Design of interior decor; Design of kitchens; Design services; Design services for furniture; Design services relating to interior decorating for homes; Design services relating to interior decoration; Designing of furniture; Draftsman's services; Draftsman's services in the nature of technical drawing; Draughtsman's services; Drawing (Engineering -); Drawing up of engineering drawings; Technical drawing; Technical engineering; Surveying services; Kitchen design; Kitchen design services; Furniture design; Engineering drawing services.

2) The application was examined and accepted, and subsequently published for opposition purposes on 28 July 2017 in Trade Marks Journal No. 2017/030.

3) On 30 October 2017 Lanserhof GmbH (hereinafter the opponent) filed notice of opposition. The opponent in these proceedings is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
LANSERHOF	EU 15319395	07 April 2016 26 July 2016	20	Furniture and furnishings; Statues, figurines, works of art and ornaments and decorations, made of materials such as wood, wax, plaster or plastic, included in the class; Animal housing

				and beds; Containers, and closures and holders therefor, non-metallic; Displays, stands and signage, non-metallic; Ladders and movable steps, non-metallic; Animal horns; Mother-of-pearl, unworked or semi-worked; Tortoiseshell; Whalebones; Ivory; Yellow amber; Meerschaum; Beds, bedding, mattresses, pillows and cushions; Clothes hangers and clothes hooks; Frames; Paper picture frames; Mirrors (silvered glass).
			35	Business analysis, research and information services; Business assistance, management and administrative services; Commercial trading and consumer information services; Advertising, marketing and promotional services; Business management; Business administration; Clerical services.
			37	Building, construction and demolition; Extermination, disinfection and pest control; Rental of tools, plant and equipment for construction and demolition; Vehicle service, repair, maintenance and refuelling; Building maintenance and repair; Plumbing installation, maintenance and repair; Alarm, lock and safe installation, maintenance and repair; Lift and elevator installation, maintenance and repair; Computer hardware and telecommunication apparatus

				<p>installation, maintenance and repair; HVAC (Heating, ventilation and air conditioning) installation, maintenance and repair; Furniture maintenance and repair; Re-inking and refilling of toner cartridges; Cleaning and care of fabric, textile, leather, fur and goods made thereof; Clock repair; Glazing, installation, maintenance and repair of glass, windows and blinds; Rental of cleaning and washing machines and equipment; Tyre maintenance and repair; Construction services.</p>
			40	<p>Food and beverage treatment; Custom manufacture and assembly services; Energy production; Printing, and photographic and cinematographic development; Air and water conditioning and purification; Duplication of audio and video recordings; Metallurgical processing.</p>
			42	<p>Design services; IT services; Testing, authentication and quality control; Science and technology services; Medical and pharmacological research services; Technical consultancy in relation to research services relating to foods and dietary supplements; Computer software design; Computer hardware development.</p>
LANS MEDICUM	EU 10981298	21 June 2012 10 October 2012	35	<p>Advertising; Business management; Business administration; Office functions.</p>

LANS Special Care	EU 16561524	07 April 2017 21 July 2017	35	Advertising, marketing and promotional services.
LANS med detox	EU 16683401	05 May 2017 22 August 2017	35	Advertising, marketing and promotional services;

4) The opponent contends that the mark in suit is similar to its LANS family of trade marks. It contends that the word LANS is the dominant element in its marks listed above. The opponent contends that the mark in suit has no natural meaning and is likely to be perceived as “LANSER” and “RING”. The opponent contends that the goods and services of the two parties are identical and / or highly similar and as such there is a likelihood of confusion. As such the mark in suit offends against Section 5(2)(b) of the Act. Originally the opponent also relied upon section 5(3) and 5(4)(a), but as no evidence was filed by the opponent these grounds were struck out.

5) On 16 May 2019 the applicant filed a counterstatement basically denying all the grounds of opposition. The applicant contends that the opponent’s mark will be seen as the letter “w”, also it did not put the opponent to proof of use.

6) Neither side filed evidence, but both seek an award of costs in their favour. Neither side wished to be heard, but both provided submissions either with the counterstatement or filed in lieu of a hearing. I shall refer to these as and when necessary in my decision.

## **DECISION**

7) The only ground of opposition is under section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because -

(a) .....

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

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

8) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

9) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks having been applied for prior to the applicant’s mark. The mark in suit was published on 28 July 2017 at which point none of the opponent’s marks had been registered for over five years and the proof of use provisions therefore do not apply.

10) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.



## Comparison of goods and services

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

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

12) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für 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”.

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

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

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

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

15) 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 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”.

16) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

17) I also note that if the similarity between the goods is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for*

*Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

18) Thus, where the similarity between the respective goods / services is not self-evident, the opponent must show how, and in which respects, they are similar.

19) The applicant’s specification in class 20 (shown in full earlier in this decision) can be summarised as being furniture. In my opinion, this specification is fully encompassed within the opponent’s class 20 specification of “Furniture and furnishings; Displays, stands and signage, non-metallic; Beds, bedding, mattresses, pillows and cushions; Containers, and closures and holders therefor, non-metallic; Ladders and movable steps, non-metallic;” under its mark EU 15319395. **The class 20 goods of the two parties are therefore identical.**

20) In my view the applicant’s class 35 services (shown in full earlier in this decision) can be summarised as “Retail services in relation to furniture, floorings, kitchens and bathrooms and associated accessories and services”. The opponent opposed this class of service using four marks which are registered for the following class 35 services:

- 15319395: Business analysis, research and information services; Business assistance, management and administrative services; Commercial trading and consumer information services; Advertising, marketing and promotional services; Business management; Business administration; Clerical services.
- 10981298: Advertising; Business management; Business administration; Office functions.
- 16561524: Advertising, marketing and promotional services.
- 16683401: Advertising, marketing and promotional services.

21) The opponent claimed that the “Advertising, marketing and promotional services” are similar to the retail services of the applicant but does not provide any reasoning as to why they believe this to be the case. The opponent has failed to provide any evidence to support this claim, and it is not obvious to me why there is any connection between the provision of advertising services and retailing. Whilst retailers engage in marketing and advertising they do not offer such services to third parties. **I find the class 35 services of the two parties to be not similar.**

22) I next turn to the class 37 services of the applicant which are set out fully earlier in this decision. These services are in summary: “Installation of fitted furniture, kitchens (including appliances, equipment and cabinets), shelving, laundry equipment, lighting apparatus and systems; *Maintenance, servicing and repair of furniture*, household and kitchen appliances”. The opponent’s mark 15319395 includes under class 37 “Building maintenance and repair; Building, construction and demolition; Plumbing installation, maintenance and repair; Furniture maintenance and repair; Construction services; HVAC (Heating, ventilation and air conditioning) installation, maintenance and repair”. The opponent’s services covers building and construction services in general which would include all of the applicant’s services. To my mind, the opponent’s services encompass the whole of the applicant’s specification and the class **37 services must therefore be regarded as identical.**

23) The applicant’s class 40 services of “Cabinet making; Cabinet-making (custom manufacture); Custom manufacture of furniture” are clearly encompassed within the opponent’s class 40 services of “Custom manufacture and assembly services” under its mark 15319395 and **must be regarded as identical.**

24) Lastly, I turn to the applicant’s class 42 services. In my opinion, these fall into two groups, firstly design services (Design consultancy; Design of furniture; Design of interior decor; Design of kitchens; Design services; Design services for furniture; Design services relating to interior decorating for homes; Design services relating to interior decoration; Designing of furniture; Kitchen design; Kitchen design services; Furniture design), and secondly technical services (Draftsman's services; draftsman's services in the nature of technical drawing; Draughtsman's services; Drawing (Engineering); Drawing up of engineering drawings; Technical drawing; Technical engineering; Surveying services; Engineering drawing services). In my opinion, the first group of services is fully encompassed by the class 42 specification under the opponent’s mark 15319395 of “Design services” whilst the second group would be fully encompassed by the terms “technology services; Science

services; IT services” also found in the class 42 specification of the opponent’s mark 15319395. The **class 42 services of the two parties must therefore be regarded as identical.**

### **The average consumer and the nature of the purchasing decision**

25) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which these goods and services 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.”

26) The goods and services sought to be registered cover a vast array of items. These goods in class 20 are, broadly speaking furniture which will be purchased by the public at large including businesses. To my mind, such goods will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial selection is therefore primarily visual. I accept that such goods may be researched or discussed with a member of staff. Therefore, aural considerations must also be taken into account. To my mind, when selecting such goods the average consumer will pay an above average attention to the item to ensure that it is compatible to their requirements and the correct size for the intended user. Businesses will pay much the same level of attention as the public on such items.

27) The class 35 services sought to be registered are, broadly speaking, retail services in relation to furniture, floorings, kitchens and bathrooms and associated accessories and services”. The consumer for such services will be the public at large including businesses and these services will typically be advertised in brochures and magazines, on the internet and of course on the shop front. The initial selection is therefore primarily visual. I accept that such services may be researched or discussed

with a member of staff and word of mouth recommendations also come into play. Therefore, aural issues must be considered. To my mind, when selecting such a retail service the average consumer will pay an above average degree of attention to who the provider of the service is, if only to ensure the goods are of the kind and quality required as usually they involve considerable expenditure.

28) Earlier in this decision I summarised the class 37 services as being “Installation of fitted furniture, kitchens (including appliances, equipment and cabinets), shelving, laundry equipment, lighting apparatus and systems; Maintenance, servicing and repair of furniture, household and kitchen appliances”. Given that such items tend to be somewhat expensive, I suggest that the installer would be chosen with some care. Such services would be required by the general public, including businesses, who would pay an above level of attention to the selection of the provider. These services will typically be advertised in brochures and magazines, on the internet and of course, if applicable on the front of the premises. The initial selection is therefore primarily visual. I accept that such services may be researched or discussed with a member of staff and word of mouth recommendations also come into play. Therefore, aural issues must be considered.

29) The class 40 services applied for are “Cabinet making; Cabinet-making (custom manufacture); Custom manufacture of furniture”. Such services would be sought by the general public including businesses and would be found via advertising in magazines, and the internet but also by word of mouth. Although the main selection is therefore primarily visual, aural issues must be considered. These types of service are a considered purchase as custom items are made to order not taken off the shelf. The average consumer will pay an above average level of attention to the selection.

30) Lastly, I turn to the class 42 services. At paragraph 24 above I split the applicant’s specification into two parts and referred to them as “design” and “technical”. Although such services will be mostly used by businesses, but the general public will also occasionally use services such as kitchen design or interior décor design, or even surveying and technical drawing as part of a building project. Such services will be chosen with above average care as mistakes are likely to be very expensive and/or dangerous. Such services will typically be advertised in brochures and magazines, on the internet and of course, if applicable, on the front of the premises. The initial selection is therefore primarily visual. I accept that such services may be researched or discussed with a member of staff and word of mouth recommendations also come into play. Therefore, aural issues must be considered.

## Comparison of trade marks

41) The opponent is relying upon four marks in this opposition. Mark EU 15319395 is used against all of the goods and services applied for, whilst marks EU 10981298, EU 16561524 and EU 16693401 are only in opposition to the class 35 services.

42) 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 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.”

43) It would be wrong, therefore, to dissect the trade marks artificially, 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 created by them. The marks to be compared are:

Opponent's trade mark		Applicant's trade mark
EU 15319395	<b>LANSERHOF</b>	<b>LANSERRING LONDON</b>
EU10981298	<b>LANS MEDICUM</b>	
EU16561524	<b>LANS Special Care</b>	
EU16683401	<b>LANS med detox</b>	

44) I shall first consider the opponent's mark EU 15319395 to the mark in suit. Clearly, they share the same first five letters LANSER but the endings are completely different with the opponent's mark

ending in HOF compared to the mark in suit ending of RING and the word LONDON. The opponent contends that its mark and the mark in suit both have as the distinctive and dominant element the term LANS and that for reasons not stated they believe that the average consumer will split the words into two parts LANS- ERHOF and LANS-ERRING. I flatly reject such a suggestion and can see no reason why the average consumer would seek to split either word. The distinctive and dominant element of the applicant's mark is clearly the word LANSERRING. Neither word has, as far as I am aware any meaning for any of the goods or services involved in the instant case. Both would probably be regarded as surnames of the founder of the company or simply the chosen name of the company. The average consumer is well versed in differentiating between surnames or company names, and I believe that this will be the case here. The term LONDON in the mark in suit adds very little to the mark providing only a geographical location for this particular arm of the company. One might expect there to be a LANSERRING ROME etc. There is a low degree of visual and aural similarity. Neither mark has any conceptual meaning and so both are neutral in this respect whether they are seen as a name or a made up word.

45) In spite of my earlier finding that the services in class 35 are not similar I will compare the marks relied upon under this category in case I a found to have erred in the comparison of the services. Clearly, the three marks EU10981298, EU16561524 and EU16683401 will be seen as LANS marks, as the dominant and distinctive element of all three is the initial word LANS which is then followed by words which either suggest something medical (MEDICUM) even though it has no actual meaning in English, or words which allude to medical services (Special Care and Med Detox). Although the mark in suit and the opponent's mark share the initial first three letters LANS there are no other visual or aural similarities, and so they must be considered to be similar only to a very low degree. As the word LANS has no meaning in English in regard to any of the goods or services as far as I am aware, the average consumer will simply consider the word LANS to be the name of the person /company as opposed to the mark in suit identifying the person / company supplying the goods and services as LANSERRING. The additional words merely add to the overall differences.

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

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as



coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

47) None of the opponent’s marks appear to have any meaning in regard of the goods and services covered by the instant case. To my mind, the earlier marks all **have an average degree of inherent distinctiveness**. The opponent has shown no use of the marks in terms of turnover and advertising figures and it does not comment on its market share in any sector. **As such it cannot benefit from an enhanced degree of distinctiveness through use in relation to the goods and services for which they are registered.**

### **Likelihood of confusion**

48) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public including businesses who will select the goods and services by predominantly visual means, although I do not discount aural considerations. The level of attention paid to each of the goods and services is reflected in the table below.
- the opponent's marks are all similar to the mark in suit to at a low degree, with significant differences.
- the opponent's marks have an average degree of inherent distinctiveness and none can benefit from an enhanced distinctiveness through use in relation to the goods and services upon which they rely.
- The similarity of the goods and services of the two parties is shown below:

	15319395.	10981298: 16561524: 16683401:	Attention paid
Class 20	identical	n/a	Above average
Class 35	Not similar	Not similar	Above average
Class 37	identical	n/a	Above average
class 40	identical	n/a	Above average
Class 42	identical	n/a	Above average

49) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which

has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

50) In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

51) I also consider the issue of indirect confusion, and take into account the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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.

52) I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

53) It is accepted that a degree of similarity of goods or services is essential for there to be a finding of a likelihood of confusion. I look to *Waterford Wedgwood plc v OHIM – C-398/07 P* (CJEU); and also *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some

minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

54) I take into account the views expressed in *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, where the Court of Justice of the European Union stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as

to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to ‘marks in a series’.”

55) Also in *Harman International Industries, Inc v OHIM*, Case C-51/09P, the Court of Justice of the European Union found that:

“Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common”.

56) Whilst in *El Corte Inglés, SA v OHIM*, Case T-39/10, the General Court found that:

“54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 *Fusco v OHIM – Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 *Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena)* [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 *Rossi v OHIM – Marcorossi (MARCOROSS)*, not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P *Becker v Harman*

International Industries [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.”

57) As no use has been shown of the opponent’s marks they cannot be considered to be a family of marks. In view of all of the above, and allowing for the concept of imperfect recollection, there is no likelihood of consumers being directly or indirectly confused into believing that any of the goods or services and provided by the applicant are those of the opponent or provided by an undertaking linked to it under any of the opponent’s marks. This is because the average consumer is well used to differentiating between names so even if the level of attention paid was less than I have indicated no confusion would occur. Even if the marks are not seen as a name but as made up words, there is still such a difference between all of the opponent’s marks and the mark in suit that there is no likelihood of confusion directly or indirectly. **The opposition under Section 5(2) (b) therefore fails entirely.**

## CONCLUSION

58) The opposition under section 5(2)(b) failed in respect of all the goods and services applied for in respect of all four of the marks relied upon. The mark in suit will be registered for all the goods and services for which it sought registration.

## COSTS

59) As the applicant has been successful it is entitled to a contribution towards its costs. I note that the applicant was professionally represented.

Preparing a statement and considering the other side’s statement	£200
Provision of submissions	£800
TOTAL	£1,000

60 ) I order Lanserhof GmbH Ltd to pay Lanserring Ltd the sum of £1,000. This sum 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 this 11<sup>th</sup> day of March 2020**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**