

O/719/21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 3503618 BY
CORAL TOOLS LIMITED
TO REGISTER:**

REBEL

AS A TRADE MARK IN CLASSES 8, 9, 16, 17, 21, 22, 25 & 35

AND

**OPPOSITION THERETO
UNDER NO. 422112
BY
WERA WERKZEUGE GMBH**

BACKGROUND & PLEADINGS

1. Coral Tools Limited (“the applicant”), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 23 June 2020. It was accepted and published in the Trade Marks Journal on 14 August 2020 in respect of the following goods and services:

Class 8: Hand tools; hand tools and implements (hand operated); hand-operated tools and implements for treatment of materials, and for construction, repair and maintenance; hand tools for use in painting, decorating and tiling; gardening tools; plaster trowels; axes; scrapers; blades [hand tools]; knives; palette knives; cutters; squeegees [hand-operated tools]; drywall finishing tools [hand tool]; glass scrapers [hand tools]; wire brushes; screwdrivers; threading tools; tile cutters, scribes; pliers, snips; hand saws, hand saw blades; hammers; planes; rasps; chisels; carpenter squares; edge tools; drills and drill extensions; expansive bits; hole saws; chalk line reels; extension bars for hand tools; extensions for hand tools; tool belts; tool aprons; tool holders; tool pouches for attachment to tool belts; scissors; parts and fittings for all the aforesaid goods.

Class 9: Measuring instruments; plumb bob and plumb bobs incorporating a self-chalking line; levels; measuring tapes; back support belts and knee pads; electrical outlets and switches, sockets and socket adapters; protective clothing, footwear and headgear; clothing, footwear and headgear for protection against injury or accident; safety clothing, footwear and headgear; high visibility clothing; overalls, including disposable clothing and overalls; protective boots and shoes; gloves for protection against accidents and injury; gloves for industrial use; safety goggles, glasses and face shields; hard hats; protective masks; respirators; ear plugs; thermometers; warning triangles and signs.

Class 16: Brushes, paint brushes; paint rollers, paint roller frames, paint roller extension poles; paint roller covers; paint roller trays; paint roller handles; paint pads; paint trays, paint scuttles, paint kettles; paint boxes; paint paddles; painting stencils; stencils; drawing templates; paint applicators in the nature of sponges; painting pencils; painting sets for children; painting mitts for applying paint; palettes for painters; pastes and other adhesives for stationery or household purposes; glue for stationery or household purposes; adhesive tape for stationary or household purposes; adhesive tape dispensers for household and office use; absorbent paper; drip mats of cardboard; drip mats of paper; drying towels of paper; kitchen rolls [paper]; paper handtowels; paper wipes; painters wipes; refuse bags of paper; chalk; handles made of plastic for paint brushes; painting sets for artists; artists' materials; art supplies; cutting mats made of plastic; powdered chalk; printed matter; books and cards on the subject of home improvement and repairs; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); stretch film and applicators for packaging; stationery; office and school supplies; staplers; drawing rulers; posters; paper labels; stickers; plastic bags; bags (garbage-) of paper or of plastics; note pads; pens, pencils, markers; parts, fittings and accessories for all the aforesaid goods.

Class 17: Masking tape and other adhesive tape for technical purposes; extruded plastics [semi-finished products]; plastics in extruded form used in production; plastics in extruded form for use in manufacture; caulk; garden hoses; tapes; sealants; plastic film, other than for wrapping.

Class 21: Brooms; brush holders; brushes for cleaning; brushes for cleaning cars; floor brushes; brushes for household purposes; combs for cleaning; articles for cleaning purposes; steel wool; painters gloves; sponges for spackling, sanding, printing, and wallpaper; gloves for gardening and household utility use; drink holders;

sponges; cleaning instruments and cloths; parts and fittings for all the aforesaid goods.


Class 22: Paper drop cloths; plastic sheeting for drop sheets; drop sheets (painter's protection covers) for use in painting.

Class 25: Articles of workwear; uniforms; overalls; belts.

Class 35: Advertising services; business information and administration services; operation and supervision of sales and promotional incentive schemes; business intermediary services for the sale and purchase of goods and services; auction services; the bringing together, for the benefit of others, of a variety of goods, namely hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes, enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the provision of on-line retail services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes, from an internet website; wholesale services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes; providing an on-line commercial information directory; organisation of exhibitions or trade fairs for commercial or advertising purposes; retail shop management.

2. Wera Werkzeuge GmbH (“the opponent”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is the proprietor of the following marks:

Trade Mark no.	EU014002075 ('075)
Trade Mark	Be a Tool Rebel
Goods Relied Upon	Classes 7, 8 & 9
Relevant Dates	Filing date: 27 April 2015
	Date of entry in register: 20 August 2015

Trade Mark no.	EU017142936 ('936)
Trade Mark	
Goods & Services Relied Upon	Classes 6, 7, 8, 9, 16, 18, 20, 21, 25, 26, 28, 32, 33 & 35
Relevant Dates	Filing date: 25 August 2017
	Date of entry in register: 09 February 2018

3. Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the

EUTMs remain the relevant rights in these proceedings. That is because the opposition was filed before the end of the Transition Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it existed before the end of the Transition Period.

4. For the purpose of this opposition, the opponent relies on all goods in Classes 7, 8 and 9 for the first earlier mark '075, and on all goods in relation to Classes 6, 7, 8, 9, 16, and 25 but only on some goods and services in Classes 18, 20 and 35 for the second earlier mark '936 as shown later in this decision.
5. Under Section 6(1) of the Act, the opponent's trade marks clearly qualify as earlier trade marks. Further, as the registration of the opponent's earlier marks were completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
6. In its amended notice of opposition,¹ the opponent argues that the competing marks are similar stating that "[t]he applied-for mark is wholly contained within the earlier trade mark." It also contends that the respective goods and services are "identical and highly similar". Therefore, registration of the contested mark should be refused under Section 5(2)(b) of the Act.
7. In response, the applicant filed a counterstatement, denying all the grounds and any likelihood of confusion between the marks.
8. Both parties filed submissions during the evidence rounds in these proceedings which will not be summarised but will be referred to as and where appropriate throughout this decision.

¹ The amendments were in relation to typographical errors for which the opponent was directed by the Tribunal to rectify with an amended TM7.

9. The opponent filed written submissions in lieu of a hearing. Neither side requested a hearing. Thus, this decision has been taken following a careful consideration of the papers.
10. In these proceedings, the opponent is represented by WP Thompson and the applicant by Potter Clarkson LLP.
11. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

Section 5(2)(b)

12. The relevant statutory provisions are as follows:

Section 5(2)(b) of the Act states:

“A trade mark shall not be registered if because-

[...]

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

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

13. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97),

Marca Mode CV v Adidas AG & Adidas Benelux BV (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 & SERVICES

14. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

15. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

16. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who

of course act for industry, put the goods or services in the same or different sectors.”

17. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

18. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

19. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

20. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

22. In *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34 (COA) the Court of Appeal decided that “the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods.”

23. In *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), the late Mr Justice Carr considered whether it was appropriate to take the class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods/services shown in the evidence. After considering the judgments of the High Court in the *Omega 1* [2010] EWHC 1211 (Ch) and *Omega 2* cases [2012] EWHC 3440 (Ch), the judge stated that in his (provisional) view, the class number should be taken into account where the meaning of the disputed term is not otherwise sufficiently clear and precise. In particular the judge stated that where “*the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services.*”

24. The competing goods and services to be compared are shown in the following table:

Opponent’s Goods First Earlier Mark ‘075	Applicant’s Goods & Services
Class 7: Mechanical tools; Mechanically-driven screwdrivers; Screwdriver inserts (bits) and socket sets being parts of machines or parts of mechanically	

<p>operated screwdrivers and associated chucks, holders, connectors and adapters being parts of or for use with electric tools; Storage containers being filled with the aforesaid goods and adapted thereto, of textile, plastic, leather, metal or a combination of these materials; Parts and spare parts for all of the aforesaid goods, included in class 7.</p>	
<p>Class 8: Hand tools (hand operated); Screwdrivers (hand-operated); Screwdriver inserts (bits) and socket sets and associated chucks, holders, connectors and adapters being parts of or for use with hand-operated tools; Storage containers being filled with the aforesaid goods and adapted thereto, of textile, plastic, leather, metal or a combination of these materials; Fittings for hand tools (hand-operated), namely screwdrivers bits and socket wrench bits; Parts, spare parts and accessories for the aforesaid goods, included in class 8.</p>	<p>Class 8: Hand tools; hand tools and implements (hand operated); hand-operated tools and implements for treatment of materials, and for construction, repair and maintenance; hand tools for use in painting, decorating and tiling; gardening tools; plaster trowels; axes; scrapers; blades [hand tools]; knives; palette knives; cutters; squeegees [hand-operated tools]; drywall finishing tools [hand tool]; glass scrapers [hand tools]; wire brushes; screwdrivers; threading tools; tile cutters, scribes; pliers, snips; hand saws, hand saw blades; hammers; planes; rasps; chisels; carpenter squares; edge tools; drills and drill extensions; expansive bits; hole saws; chalk line reels; extension bars for hand tools; extensions for hand tools; tool belts; tool aprons; tool holders; tool pouches for attachment to tool belts; scissors; parts and fittings for all the aforesaid goods.</p>
<p>Class 9: Measuring and testing apparatus, in particular torque wrenches and software relating thereto; Storage containers being filled with the aforesaid goods and adapted thereto, of textile, plastic, leather, metal or a combination of these materials; parts, Replacement parts and accessories for the aforesaid goods, Included in class 09.</p>	<p>Class 9: Measuring instruments; plumb bob and plumb bobs incorporating a self-chalking line; levels; measuring tapes; back support belts and knee pads; electrical outlets and switches, sockets and socket adapters; protective clothing, footwear and headgear; clothing, footwear and headgear for protection against injury or accident; safety clothing, footwear and headgear; high visibility clothing; overalls, including disposable clothing and overalls; protective boots and shoes; gloves for protection against accidents and injury; gloves for industrial use; safety goggles, glasses and face shields; hard hats; protective masks; respirators; ear plugs; thermometers; warning triangles and signs.</p>
	<p>Class 16: Brushes, paint brushes; paint rollers, paint roller frames, paint roller extension poles; paint roller covers; paint roller trays; paint roller handles; paint pads; paint trays, paint scuttles, paint kettles; paint boxes; paint paddles; painting stencils; stencils; drawing templates; paint applicators in the nature of sponges; painting pencils; painting sets for children; painting mitts for applying paint; palettes for painters; pastes and other adhesives for</p>

	stationery or household purposes; glue for stationery or household purposes; adhesive tape for stationary or household purposes; adhesive tape dispensers for household and office use; absorbent paper; drip mats of cardboard; drip mats of paper; drying towels of paper; kitchen rolls [paper]; paper handtowels; paper wipes; painters wipes; refuse bags of paper; chalk; handles made of plastic for paint brushes; painting sets for artists; artists' materials; art supplies; cutting mats made of plastic; powdered chalk; printed matter; books and cards on the subject of home improvement and repairs; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); stretch film and applicators for packaging; stationery; office and school supplies; staplers; drawing rulers; posters; paper labels; stickers; plastic bags; bags (garbage-) of paper or of plastics; note pads; pens, pencils, markers; parts, fittings and accessories for all the aforesaid goods.
	Class 17: Masking tape and other adhesive tape for technical purposes; extruded plastics [semi-finished products]; plastics in extruded form used in production; plastics in extruded form for use in manufacture; caulk; garden hoses; tapes; sealants; plastic film, other than for wrapping.
	Class 21: Brooms; brush holders; brushes for cleaning; brushes for cleaning cars; floor brushes; brushes for household purposes; combs for cleaning; articles for cleaning purposes; steel wool; painters gloves; sponges for spackling, sanding, printing, and wallpaper; gloves for gardening and household utility use; drink holders; sponges; cleaning instruments and cloths; parts and fittings for all the aforesaid goods.
	Class 22: Paper drop cloths; plastic sheeting for drop sheets; drop sheets (painter's protection covers) for use in painting.
	Class 25: Articles of workwear; uniforms; overalls; belts.
	Class 35: Advertising services; business information and administration services; operation and supervision of sales and promotional incentive schemes; business intermediary services for the sale and purchase of goods and services; auction services; the bringing together, for the benefit of others, of a variety of goods, namely hand tools and

	<p>implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes, enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the provision of on-line retail services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes, from an internet website; wholesale services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes; providing an on-line commercial information directory; organisation of exhibitions or trade fairs for commercial or advertising purposes; retail shop management.</p>
<p align="center">Opponent's Goods & Services Second Earlier Mark '936</p>	<p align="center">Applicant's Goods & Services</p>
<p>Class 6: Empty storage containers and transport containers of metal, in particular boxes, cases, assortment boxes and magazines for tools and tool inserts; Parts, replacement parts and accessories for all of the aforesaid goods, included in class 6.</p>	
<p>Class 7: Mechanical tools; Mechanically-driven screwdrivers; Screwdriver inserts (bits) and socket sets being parts of machines or parts of mechanically operated screwdrivers and associated chucks, holders, connectors and adapters being parts of or for use with electric tools; Storage containers and transport containers being filled with the aforesaid goods and adapted thereto, of textile, plastic, leather, metal or a combination of these materials; Parts, replacement parts and accessories for the aforesaid goods, included in class 7.</p>	

<p>Class 8: Hand tools; Screwdrivers (hand-operated); Screwdriver; Screwdriver inserts, bits and socket wrench bits and associated chucks, holders, connectors and adapters being parts of or for use with hand-operated tools; Hammers [hand tools]; Ratchets, Angle keys, Hand-operated torque tools; Storage containers and transport containers being filled with the aforesaid goods and adapted thereto, of textile, plastic, leather, metal or a combination of these materials; Parts, replacement parts and fittings for all of the aforesaid goods, included in class 8.</p>	<p>Class 8: Hand tools; hand tools and implements (hand operated); hand-operated tools and implements for treatment of materials, and for construction, repair and maintenance; hand tools for use in painting, decorating and tiling; gardening tools; plaster trowels; axes; scrapers; blades [hand tools]; knives; palette knives; cutters; squeegees [hand-operated tools]; drywall finishing tools [hand tool]; glass scrapers [hand tools]; wire brushes; screwdrivers; threading tools; tile cutters, scribes; pliers, snips; hand saws, hand saw blades; hammers; planes; rasps; chisels; carpenter squares; edge tools; drills and drill extensions; expansive bits; hole saws; chalk line reels; extension bars for hand tools; extensions for hand tools; tool belts; tool aprons; tool holders; tool pouches for attachment to tool belts; scissors; parts and fittings for all the aforesaid goods.</p>
<p>Class 9: Measuring and testing apparatus, in particular torque wrenches and software relating thereto; voltage testing screwdrivers; Storage containers and transport containers being filled with the aforesaid goods and adapted thereto, of textile, plastic, leather, metal or a combination of these materials; Clothing, headwear and footwear for protection against accident or injury; Eye protection; Gloves for protection against accidents; Protective work wear; Parts, replacement parts and fittings for all of the aforesaid goods, included in class 9.</p>	<p>Class 9: Measuring instruments; plumb bob and plumb bobs incorporating a self-chalking line; levels; measuring tapes; back support belts and knee pads; electrical outlets and switches, sockets and socket adapters; protective clothing, footwear and headgear; clothing, footwear and headgear for protection against injury or accident; safety clothing, footwear and headgear; high visibility clothing; overalls, including disposable clothing and overalls; protective boots and shoes; gloves for protection against accidents and injury; gloves for industrial use; safety goggles, glasses and face shields; hard hats; protective masks; respirators; ear plugs; thermometers; warning triangles and signs.</p>
<p>Class 16: Paper; Cardboard (cardboard) and goods of paper and cardboard, namely carrier bags and packaging material, stationery pads, ring-binders, flags, posters, signs, calendars, pencil pots and clipboards; Stationery; Office articles (except furniture), Parts, replacement parts and fittings for all of the aforesaid goods, included in class 16.</p>	<p>Class 16: Brushes, paint brushes; paint rollers, paint roller frames, paint roller extension poles; paint roller covers; paint roller trays; paint roller handles; paint pads; paint trays, paint scuttles, paint kettles; paint boxes; paint paddles; painting stencils; stencils; drawing templates; paint applicators in the nature of sponges; painting pencils; painting sets for children; painting mitts for applying paint; palettes for painters; pastes and other adhesives for stationery or household purposes; glue for stationery or household purposes; adhesive tape for stationary or household purposes; adhesive tape dispensers for household and office use; absorbent paper; drip mats of cardboard; drip mats of paper; drying towels of paper; kitchen rolls [paper]; paper handtowels; paper wipes; painters wipes; refuse bags of paper; chalk; handles made of plastic for paint</p>

	brushes; painting sets for artists; artists' materials; art supplies; cutting mats made of plastic; powdered chalk; printed matter; books and cards on the subject of home improvement and repairs; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); stretch film and applicators for packaging; stationery; office and school supplies; staplers; drawing rulers; posters; paper labels; stickers; plastic bags; bags (garbage-) of paper or of plastics; note pads; pens, pencils, markers; parts, fittings and accessories for all the aforesaid goods.
	Class 17: Masking tape and other adhesive tape for technical purposes; extruded plastics [semi-finished products]; plastics in extruded form used in production; plastics in extruded form for use in manufacture; caulk; garden hoses; tapes; sealants; plastic film, other than for wrapping.
Class 18: Tool bags, tool belt bags and tool belts of textile, plastic, leather or a combination of these materials; Tool boxes of textile, plastic, leather or a combination of these materials; Bags and containers and carrying straps, in particular for transport of tools and tool parts.	
Class 20: Empty storage containers of plastic, in particular boxes, cases, assortment boxes and magazines for tools and tool inserts.	
	Class 21: Brooms; brush holders; brushes for cleaning; brushes for cleaning cars; floor brushes; brushes for household purposes; combs for cleaning; articles for cleaning purposes; steel wool; painters gloves; sponges for spackling, sanding, printing, and wallpaper; gloves for gardening and household utility use; drink holders; sponges; cleaning instruments and cloths; parts and fittings for all the aforesaid goods.
	Class 22: Paper drop cloths; plastic sheeting for drop sheets; drop sheets (painter's protection covers) for use in painting.
Class 25: Headgear; Clothing; Footwear; Waist belts; Work clothes; Workclothes; Parts, replacement parts and fittings for all of the aforesaid goods, included in class 25.	Class 25: Articles of workwear; uniforms; overalls; belts.

<p>Class 35: Advertising, marketing and promotional services; Retailing and wholesaling, including via the internet, in relation to storage containers and transport containers of metal, textile, plastic, leather or a combination of these materials; Retailing and wholesaling, including via the internet, in relation to mechanically operated tools and tool inserts, hand-operated tools and tool inserts, measuring and testing apparatus; Retailing and wholesaling, including via the internet, in relation to paper, cardboard and goods of paper and cardboard, namely carrier bags and packaging material, stationery pads, ring-binders, flags, posters, signs, calendars, pencil pots and clipboards, stationery, office articles; Retailing and wholesaling, including via the internet, in relation to [...] tool bags, tool cases, tool belt bags and tool belts; Retailing and wholesaling, including via the internet, in relation to crockery, cookware and containers; Retailing and wholesaling, including via the internet, in relation to headgear, clothing, footwear, belts, workwear, professional clothing; Retailing and wholesaling, including via the internet, in relation to clothing, headgear and footwear for protection against accidents or injuries, eye protectors, ear protectors, gloves for protection against injury, protective work clothing.</p>	<p>Class 35: Advertising services; business information and administration services; operation and supervision of sales and promotional incentive schemes; business intermediary services for the sale and purchase of goods and services; auction services; the bringing together, for the benefit of others, of a variety of goods, namely hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes, enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the provision of on-line retail services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes, from an internet website; wholesale services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes; providing an on-line commercial information directory; organisation of exhibitions or trade fairs for commercial or advertising purposes; retail shop management.</p>
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25. Both parties made submissions in relation to the identity and/or similarity of the goods and services for each of the earlier marks, which I have considered in this decision.

26. I note that the applicant with its submissions admits the following:

“The Applicant submits that the only overlap is within Classes 8 and 9 [regarding the first earlier mark ‘075].

More specifically, the Applicant concedes that there is overlap in relation to the goods covered by Class 8.

As for Class 9, the only overlapping goods are “measuring instruments”. [...]

The Applicant concedes that there is some overlap between the goods covered by the Opponent’s earlier right [second earlier mark ‘936] and those covered by Classes 8, 9, 16, 21, 25 and 35 of the contested application.”

27. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.²
28. I will begin by considering the opponent’s position in relation to the goods of the first earlier mark ‘075, before then moving on to consider the position of goods and services with the second earlier mark ‘936.

First Earlier Mark ‘075

Hand tools; screwdrivers

29. The above applicant’s contested terms are identical to the opponent’s on the basis that they are identically worded or ostensibly the same.

² *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Hand tools and implements (hand operated); hand-operated tools and implements for treatment of materials, and for construction, repair and maintenance; hand tools for use in painting, decorating and tiling; gardening tools; plaster trowels; axes; scrapers; blades [hand tools]; knives; palette knives; cutters; squeegees [hand-operated tools]; drywall finishing tools [hand tool]; glass scrapers [hand tools]; wire brushes; screwdrivers; threading tools; tile cutters, scribes; pliers, snips; hand saws, hand saw blades; hammers; planes; rasps; chisels; carpenter squares; edge tools; drills and drill extensions; expansive bits; hole saws; chalk line reels; extension bars for hand tools; extensions for hand tools; scissors; parts and fittings for all the aforesaid goods

30. These contested terms in Class 8 are encompassed by the opponent's broad terms "hand tools" and "parts, spare parts and accessories for the aforesaid goods, included in class 8", which include a wide range of products. Consequently, I find that the respective goods are identical under the *Meric* principle. If there is any doubt about certain terms and them being identical, they would nevertheless be highly similar.

Tool belts; tool aprons; tool holders; tool pouches for attachment to tool belts

31. These contested terms in Class 8 relate to wearable storage solutions for tools, whereas the opponent's "storage containers being filled with the aforesaid goods and adapted thereto, of textile, plastic, leather, metal or a combination of these materials" relate to standalone tool organisers and storage containers. Although the competing terms differ in nature, they share the same purpose, namely keeping the tools organised and secure. Also, there is an overlap in users, method of use, and trade channels. I consider, therefore, that there is a medium degree of similarity between the respective goods.
32. I will also consider if there is a similarity between the contested terms and the opponent's "[...] accessories for the aforesaid goods, included in class

8". The opponent's goods, in my view, involve accessory sets for hand tools, such as multi-bit sets containing an assortment of accessories, including holders, sockets and joints, all of which can be used as add-ons attached to hand tools. The nature, purpose and method of use are different, and there is no competition. Even if tool aprons or tool belts were used to carry other accessories, they are not considered important for their use. Thus, the respective goods are not complementary. The users and trade channels overlap. I conclude that the respective goods are similar to a low degree.

Measuring instruments; plumb bob and plumb bobs incorporating a self-chalking line; measuring tapes

33. The contested term "*measuring instruments*" in Class 9 is self-evidently identical to the opponent's term "*measuring and testing apparatus, in particular torque wrenches and software relating thereto*". I note that the phrase "*in particular*" of the latter term does not limit the scope of the opponent's goods, but instead, it inserts an example of an item included in that category of goods.³ Therefore, the opponent's term also encompasses the contested terms "*plumb bob and plumb bobs incorporating a self-chalking line; levels; measuring tapes*" in Class 9, which are all considered tools for measuring, thereby being *Merici* identical.

³ This is supported by the General Court in *Durferrit GmbH v OHIM (Nu-Tride)*, Case T-224/01, in paragraph 41, where it states that: "[...] In that regard, it should be recalled, as the applicant rightly stated without being contradicted on the point by either OHIM or the intervener, that the 'inorganic salts' category of goods covered by the earlier mark also includes goods which do not consist of or comprise cyanide. In fact it is clear from the use of the term 'in particular' in those products' descriptions that cyanide is given merely as an example. [...]"

Back support belts and knee pads; protective clothing, footwear and headgear; clothing, footwear and headgear for protection against injury or accident; safety clothing, footwear and headgear; high visibility clothing; overalls, including disposable clothing and overalls; protective boots and shoes; gloves for protection against accidents and injury; gloves for industrial use; safety goggles, glasses and face shields; hard hats; protective masks; respirators; ear plugs

34. The opponent claims similarity between the contested goods in Class 9, stating that: “[t]he goods claimed in the Application are used in connection with those claimed in the Earlier Registration, to allow them to operate or to make their use safe. The goods concerned therefore have the same use, users and they are complementary.” Even though such goods could be used simultaneously and in conjunction with the opponent’s, I am unaware and have no evidence that “[...] 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”⁴. Further, the competing goods are different in nature, purpose, and method of use, even if they primarily target the same users, such as craftspeople or professionals in the construction industry. That said, the respective goods may potentially overlap in trade channels, albeit they may not be sold in particularly close proximity. Consequently, I find that the goods at issue are similar to only a very low degree.

Electrical outlets and switches, sockets and socket adapters

35. The opponent claims similarity for the contested terms on the basis that they “are used in connection with those claimed in the Earlier Registration, to allow them to operate or to make their use safe. The goods concerned therefore have the same use, users and they are complementary.” However, there is no evidence to support this, and the opponent does not

⁴ *Kurt Hesse v OHIM*, Case C-50/15 P.

specify in its submissions which goods from its specification are considered to be similar to the above contested terms. The applicant's goods in Class 9 enable electrical equipment to connect to the electricity supply. They do not have the same nature or purpose as the goods in the earlier specification. The respective goods have different methods of use, and although they might be found in the same stores, they are unlikely to be found in close proximity. Moreover, I do not find that the respective goods are "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."⁵ Therefore, I am unable to identify any goods in the opponent's specification that would be similar to these specific items, or if I am wrong on this finding, they are similar to a very low degree.

Thermometers

36. The contested goods in Class 9 are intended to measure temperature. However, there are no similar or counterpart goods to the opponent's specification. Also, the respective goods differ in nature, purpose, users, method of use and trade channels. Therefore, I find them to be dissimilar.

Warning triangles and signs

37. These contested terms in Class 9 cover items that are used in order to secure a traffic accident site or to indicate potential safety risks. The competing goods do not overlap in nature, purpose, users, and method of use. Although there might be the potential that the respective goods could be found in the same stores, I note that this is very unlikely. Thus, there is no similarity between the respective goods or if there is one it will be very low.

⁵ As per *Boston Scientific Ltd v OHIM*, Case T-325/06.

Brushes, paint brushes; paint rollers, paint roller frames, paint roller extension poles; paint roller covers; paint roller trays; paint roller handles; paint pads; paint trays, paint scuttles, paint kettles; paint boxes; paint paddles; painting stencils; stencils; drawing templates; paint applicators in the nature of sponges; painting mitts for applying paint; palettes for painters; handles made of plastic for paint brushes; painting mitts for applying paint

38. The opponent claims that part of the above contested terms, namely “*brushes, paint brushes; paint rollers; painting stencils; stencils*”, in Class 16 are *Meri*c identical to its broad term “*hand tools*” in Class 8, and part similar. The contested terms in Class 16 are all goods intended to be used in conducting various painting tasks. Therefore, the purpose of the contested goods differs from the earlier term “*hand tools*” in Class 8, where goods are intended to perform tasks, such as drilling, shaping, cutting and piercing, or the rest of the goods in the earlier specification. Also, the respective goods differ in nature, and method of use. Nevertheless, the users could be the same, and the goods may be sold in the same shops but not in very close proximity. The contested goods are not in competition with the opponent’s goods. I find them to be similar to a low degree.

Brooms; brush holders; brushes for cleaning; brushes for cleaning cars; floor brushes; brushes for household purposes; combs for cleaning; steel wool; sponges; sponges for spackling, sanding, printing, and wallpaper

39. The opponent claims that the above contested terms in Class 21 are *Meri*c identical to its broad term “*hand tools*” in Class 8. The contested goods are intended to have a cleaning function instead of the opponent’s “*hand tools*” in Class 8, which are used to perform tasks that I have mentioned in the previous paragraph. They are different in nature, purpose, and method of use. However, I find that the users may be the same, and it is likely the respective goods to be sold through the same trade channels but not in very close proximity. Consequently, I find that the respective goods are similar to a low degree to the opponent’s goods.

Drip mats of cardboard; drip mats of paper; painters wipes

40. Although there are no counterpart terms in the opponent's specification, the contested goods in Class 16 may be sold in the same shops as the opponent's, such as "*hand tools*". As a result, there may likely be an overlap in users. However, I note that the competing goods are different in nature, purpose, and method of use. In addition, they are not in competition nor complementary. Therefore, I find that the respective goods are similar to a very low degree.

Painting pencils; painting sets for children; drawing rulers

41. The contested terms in Class 16 cover goods that are meant to be used mainly for recreational purposes (painting/drawing), as opposed to the goods covered in the opponent's specification. In addition, the competing goods differ in nature, purpose, method of use, users, and trade channels. Therefore, I find them to be dissimilar.

Pastes and other adhesives for stationery or household purposes; glue for stationery or household purposes; adhesive tape for stationary or household purposes; adhesive tape dispensers for household and office use

42. Although there are no counterpart terms in the opponent's specification, the above goods in Class 16 may overlap in trade channels and users with the opponent's "*hand tools*". However, the respective goods differ in nature, purpose, and method of use. Also, they are not in competition or complementary with each other. Consequently, I find them to be similar to a very low degree.

Absorbent paper; drying towels of paper; kitchen rolls [paper]; paper handtowels; paper wipes; refuse bags of paper; chalk; painting sets for artists; artists' materials; art supplies; cutting mats made of plastic; powdered chalk; printed matter; plastic materials for packaging (not included in other classes); stretch film and applicators for packaging; stationery; office and school supplies; staplers; posters; paper labels; stickers; plastic bags; bags (garbage-) of paper or of plastics; note pads; pens, pencils, markers; parts, fittings and accessories for all the aforesaid goods

43. The contested terms in Class 16 are products, most of which are stationery items, that are sold in different stores from the opponent's. They differ in nature, purpose, method of use, trade channels and users. I consider the respective goods to be dissimilar.

Books and cards on the subject of home improvement and repairs; instructional and teaching material (except apparatus)

44. The contested term "books and cards on the subject of home improvement and repairs" in Class 16 involves items with learning content or guides focusing on and limited to the subject of home improvement and repairs. The contested goods "instructional and teaching material (except apparatus)" are items typically consisting of a collection of resources that promote teaching and learning. The opponent's goods in Class 16 are consumables, whereas the applicant's goods are not. The competing goods may also have different nature and purposes. For example, the applicant's goods are meant to teach, guide, and inform users in contrast to the opponent's, which are all office supplies or equipment. For these reasons, the contested terms differ in nature and purpose from the opponent's goods in Class 16, such as "stationery". Further, there is no seeming overlap in users, method of use and trade channels. I do not find the respective goods to be in competition or complementary. Consequently, I find the goods to be dissimilar.

45. For completeness, I will address the similarity between the contested term “*books and cards on the subject of home improvement and repairs*” in Class 16 and the term “*hand tools*” of the earlier mark in Class 8. The respective goods are of a completely different nature and method of use. However, the purpose is the same other than at a very general level of assisting to conduct and complete DIY projects. There is an overlap in trade channels to the extent that the competing goods might all be sold in DIY stores, but I note that they will be placed in different parts. If there is any complementarity between the respective goods that is insufficiently pronounced. There is no competition between the respective goods. I find that the respective goods to be similar to a very low degree.

Masking tape and other adhesive tape for technical purposes; caulk; tapes; sealants

46. The contested goods in Class 17 differ from the opponent’s goods, such as “*hand tools*” or “*mechanical tools*”. The nature of the competing goods is different as they are made from different materials. Although the contested terms may be used for DIY works, such as joining objects together and filling gaps, they will fulfil a different purpose compared to the opponent’s goods. Also, the method of use is likely to be different and there is no competition or complementarity. However, there will be a degree of overlap in both users and channels of trade. I note that the respective goods will be sold not in a very close proximity from each other. These goods are similar to a low degree.

Garden hoses

47. There is no obvious similarity between the contested term in Class 17 and the earlier mark’s specification. The competing goods have different nature, purpose, users, methods of use. There is no aspect of competition or complementarity between the competing goods.

Extruded plastics [semi-finished products]; plastics in extruded form used in production; plastics in extruded form for use in manufacture; plastic film, other than for wrapping

48. I can see no real similarity between these contested goods in Class 17 and the goods of the earlier specification. They have a different nature and purpose. Also, they are not in competition, and will not share users or trade channels.

Articles for cleaning purposes; cleaning instruments and cloths; parts and fittings for all the aforesaid goods

49. The above terms in Class 21 are items for cleaning. Although they differ in nature, purpose and method of use from the opponent's specification, the users will coincide at a general level. It is likely that the competing goods will be sold in the same shops, albeit perhaps not in very close proximity. They are similar to a very low degree.

Drink holders

50. I can see no meaningful similarity between the above goods in Class 21 and those of the earlier mark. In the absence of any evidence to the contrary, none of the above goods strike me as overlapping in nature, purpose, method of use, trade channels, and users. Consequently, there is no similarity.

Painters gloves; gloves for gardening and household utility use

51. The contested goods "painters gloves; gloves for gardening and household utility use" in Class 21 are used to provide hand protection from paint, or during gardening and household use. It can be argued that the contested terms may be used in conjunction with earlier goods, such as "hand tools" in Class 8, during the completion of DIY works, but they will serve a different purpose from the earlier mark's goods. The competing goods also

differ in nature and method of use from the opponent's, but the users may coincide. They may be sold in the same shops, but I note that the "*painters gloves*" goods are likely to be found in closer proximity with the opponent's goods than the "*gloves for gardening and household utility use*" goods. Thus, I find that the applicant's goods "*painters gloves*" are similar to a low degree to the opponent's, and the "*gloves for gardening and household utility use*" are similar to a very low degree.

Paper drop cloths; plastic sheeting for drop sheets; drop sheets (painter's protection covers) for use in painting

52. The opponent asserts similarity between its goods and the opposed ones in Class 22. The contested goods are used as a protective cover to prevent, for example, paint spills and drips for DIY works. The competing goods are different in nature, but they may coincide in the general purpose of conducting DIY projects. In addition, they are sold in home improvement or DIY stores as the opponent's goods, likely in close proximity. As a result, the users coincide between the respective goods. However, I do not consider the respective goods to be in competition, and there is no element of complementarity with each other. Therefore, I find that they are similar to a low degree.

Articles of workwear; uniforms; overalls; belts

53. The contested terms in Class 25 include heavy-duty clothing used for manual labour. Although such goods may be used in connection with the earlier goods in Class 8, they are of different types, and they do not coincide in nature, purpose, and method of use. However, there will be a degree of overlap in both users and channels of trade. It is also likely that the competing goods are used together in the course of DIY projects, but I note that complementary does not arise with such use. Last, the competing goods are not in competition. Therefore, these goods are similar to a very low degree.

54. Before I consider the applicant's services in Class 35, which include retail services, I will delineate the relevant case law and principles, applicable in the case at hand.
55. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose, and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.
56. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said at paragraph 9 of his judgment that:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut.”

57. However, on the basis of the European Courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, at paragraphs 30 to 35 of the judgment, upheld on appeal in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd*, Case C-398/07P, Mr Hobbs concluded that:

“i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).”

The bringing together, for the benefit of others, of a variety of goods, namely hand tools and implements, extensions for hand tools, measuring instruments, [...], enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the provision of on-line retail services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, [...], brushes, paint rollers, [...], brooms, and articles for cleaning purposes, from an internet website; wholesale services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, [...], brushes, paint rollers, paint applicators, [...], brooms [...]

58. The above contested terms in Class 35 are provided, in broad terms, with the aim of selling DIY tools via various retail routes, including telephone,

mail and online. That said, the nature of the contested services differs from the earlier mark's goods. The former ones are offered by a retail operator for the sale and purchase of goods by the end users, whereas the latter ones are the physical products as such. Moreover, the method of use and purpose differs between the goods and the services in question. On the one hand, the hand tools and measuring instruments are all tools of some sort, intended to be used by the users to complete manual operations. On the other hand, the respective services are intended to enable the end-users to purchase such items by interacting with them either online or on physical premises. At an overarching level, the ordinary method of retailing such goods to the public creates a link where consumers are likely to believe that the same commercial undertaking could offer both the goods and the retail services. Therefore, I find that the complementarity, in this case, is sufficiently pronounced. Considering all these factors, there is a medium degree of similarity between the respective goods and services.

The bringing together, for the benefit of others, of a variety of goods, namely [...] personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, [...], brooms, and articles for cleaning purposes, enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the provision of on-line retail services connected with the sale of [...] personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, [...], brooms, and articles for cleaning purposes, from an internet website; wholesale services connected with the sale of [...], personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, [...], brooms, and articles for cleaning purposes

59. Previously in this decision I have found that there is only low or very low degree of similarity between the physical goods the subject of the above

retail services and the goods of the earlier mark. Notwithstanding that it is not necessary for the retailed goods to be identical to the goods of the earlier mark to find similarity between retail services and physical goods, I nevertheless find only a very low similarity for the retailing of the respective goods in Class 35.

The bringing together, for the benefit of others, of a variety of goods, namely [...] surface protection products, plastic film, [...], enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the provision of on-line retail services connected with the sale of [...] surface protection products, plastic film, [...], from an internet website; wholesale services connected with the sale of [...] surface protection products, plastic film, [...]

60. There is no direct relationship between the opponent's goods and the above contested services. Consequently, there is no similarity between the contested services and the goods of the earlier specification.

Advertising services; business information and administration services; operation and supervision of sales and promotional incentive schemes; providing an on-line commercial information directory; organisation of exhibitions or trade fairs for commercial or advertising purposes; retail shop management

61. I can see no obvious aspect of similarity between the above contested services in Class 35 and the opponent's goods, nor has the opponent made any submissions to the contrary. Therefore, I find them to be dissimilar.

Second Earlier Mark '936

62. All of the competing terms in Class 8⁶ and part of Class 9⁷ of the second earlier mark '936 corresponds to the specification of the first earlier mark '075. Thus, the analysis and findings that I have delineated above in paragraphs 29-30, and 33, 35-37 of this decision for the competing terms are equally applicable here for the second earlier mark '936. I will now move on to consider any additional terms covered by the second earlier mark '936 that may give rise to similarity with the contested goods.

Tool belts; tool aprons; tool holders; tool pouches for attachment to tool belts

63. The findings in paragraphs 30-31 of this decision apply here. For completeness, I will address the similarity between the opponent's "*tool bags, tool belt bags and tool belts of textile, plastic, leather or a combination of these materials*" in Class 18 (as covered by the '936 mark only) and the contested goods. The competing goods may share the same nature and general purpose. Although the competing goods can be used to carry tools, the method of use is different. The contested goods are wearables in contrast to the opponent's goods which are receptacles. There is an overlap in users and trade channels with the respective goods sold in close proximity. I find the contested goods "*tool belts*" in Class 8 to be highly similar to the opponent's "*tool belts of textile, plastic, leather or a combination of these materials*" in Class 18. Likewise, the applicant's "*tool*

⁶ These are in relation to "*Hand tools; screwdrivers; hand tools and implements (hand operated); hand-operated tools and implements for treatment of materials, and for construction, repair and maintenance; hand tools for use in painting, decorating and tiling; gardening tools; plaster trowels; axes; scrapers; blades [hand tools]; knives; palette knives; cutters; squeegees [hand-operated tools]; drywall finishing tools [hand tool]; glass scrapers [hand tools]; wire brushes; screwdrivers; threading tools; tile cutters, scribes; pliers, snips; hand saws, hand saw blades; hammers; planes; rasps; chisels; carpenter squares; edge tools; drills and drill extensions; expansive bits; hole saws; chalk line reels; extension bars for hand tools; extensions for hand tools; tool belts; tool aprons; tool holders; tool pouches for attachment to tool belts; scissors; parts and fittings for all the aforesaid goods*".

⁷ These are in relation to "*Measuring instruments; plumb bob and plumb bobs incorporating a self-chalking line; measuring tapes; electrical outlets and switches, sockets and socket adapters; thermometers; warning triangles and signs*".

pouches for attachment to tool belts” are reasonably high in similarity to the opponent’s “*tool belts of textile, plastic, leather or a combination of these materials*” in Class 18. As for the applicant’s “*tool aprons*”, I find them to be similar to the opponent’s “*tool belts of textile, plastic, leather or a combination of these materials*” in Class 18 to a medium to high degree. Last, the contested “*tool holders*” are similar to the opponent’s “*tool bags*” in Class 18 to a medium to high degree.

Back support belts and knee pads; protective clothing, footwear and headgear; clothing, footwear and headgear for protection against injury or accident; safety clothing, footwear and headgear; high visibility clothing; overalls, including disposable clothing and overalls; protective boots and shoes; gloves for protection against accidents and injury; gloves for industrial use; safety goggles, glasses and face shields; hard hats; protective masks; ear plugs

64. The contested terms “*protective clothing, footwear and headgear; clothing, footwear and headgear for protection against injury or accident; safety clothing, footwear and headgear; gloves for protection against accidents and injury; safety goggles [...]*” in Class 9 are identical to the opponent’s “*clothing, headwear and footwear for protection against accident or injury; eye protection; gloves for protection against accidents; protective work wear*” as being identically worded or ostensibly the same.
65. The remaining terms, namely “*back support belts and knee pads; high visibility clothing; overalls, including disposable clothing and overalls; protective boots and shoes; gloves for industrial use; [...] glasses and face shields; hard hats; protective masks; respirators; ear plugs*” are encompassed by the opponent’s broad terms mentioned above. Consequently, I find the respective goods to be identical in accordance with the *Merck* principle.

66. As previously shown in paragraphs 38-39 of this decision, part of the contested terms in Class 16⁸ and 21⁹ is similar to a low degree to the opponent's goods. These findings apply here to the second earlier mark '936.

Stationery

67. The contested term is self-evidently identically worded to the term of the earlier specification. Thus, the respective goods are identical.

Painting pencils; painting sets for children; pastes and other adhesives for stationery or household purposes; glue for stationery or household purposes; adhesive tape for stationary or household purposes; adhesive tape dispensers for household and office use; chalk; painting sets for artists; artists' materials; art supplies; cutting mats made of plastic; powdered chalk; printed matter; plastic materials for packaging (not included in other classes); stretch film and applicators for packaging; office and school supplies; staplers; drawing rulers; posters; paper labels; stickers; note pads; pens, pencils, markers; parts, fittings and accessories for all the aforesaid goods

68. The contested terms in Class 16 are stationery items of some sort. These can be readily included by the opponent's broad term "stationery" covering various goods in relation to office products. Therefore, I find them identical based on the *Meric* principle.

⁸ These are: "Brushes, paint brushes; paint rollers, paint roller frames, paint roller extension poles; paint roller covers; paint roller trays; paint roller handles; paint pads; paint trays, paint scuttles, paint kettles; paint boxes; paint paddles; painting stencils; stencils; drawing templates; paint applicators in the nature of sponges; painting pencils; handles made of plastic for paint brushes; painting mitts for applying paint; palettes for painters".

⁹ These are: "Brooms; brush holders; brushes for cleaning; brushes for cleaning cars; floor brushes; brushes for household purposes; combs for cleaning; steel wool; sponges; sponges for spackling, sanding, printing, and wallpaper."

Painters wipes

69. The contested goods in Class 16 are intended to provide a cleaning result by removing paint, whereas the opponent's goods in the same Class have no such features. There is no overlap between the respective goods with regard to nature, purpose and method of use. I note that they may share users and trade channels with the earlier goods by being available in the same shops but not likely in close proximity. Last, there is no competition or complementarity between the respective goods. I find them to be similar to a very low degree.

Absorbent paper; drip mats of cardboard; drip mats of paper; drying towels of paper; kitchen rolls [paper]; paper handtowels; paper wipes

70. The contested goods in Class 16 are all intended to be used as absorbents for various uses. The opponent's goods in Class 16 cover "*paper; Cardboard (cardboard) and goods of paper and cardboard, namely carrier bags and packaging material, stationery pads, ring-binders, flags, posters, signs, calendars, pencil pots and clipboards*". I note that the earlier specification contains the word "*namely*". Guidance on how to treat this word is contained in the addendum to the Trade Mark Registry's Classification Guide, which reads as follows:

"Note that specifications including "namely" should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above "dairy products namely cheese and butter" would only be interpreted as meaning "cheese and butter" and not "dairy products" at large. This is consistent with the definitions provided in Collins English Dictionary which states "namely" to mean "that is to say" and the Cambridge International Dictionary of English which states "which is or are"." (Emphasis added)

In this regard, the opponent's terms "[...] *goods of paper and cardboard*" are limited to "*carrier bags and packaging material, stationery pads, ring-*

binders, flags, posters, signs, calendars, pencil pots and clipboards". I consider that there is a broad similarity in the general nature between the contested goods and the earlier "*cardboard and goods of paper and cardboard*" in that they are made of the same material. That said, the competing goods serve different purpose with the contested goods used for keeping the surfaces dry or protect from spillage, whilst the opponent's for stationery use. Moreover, the respective goods differ in methods of use, users, and trade channels. The competing goods are not in competition nor complementary. Therefore, I find them similar to a very low degree.

Plastic bags; bags (garbage-) of paper or of plastics; refuse bags of paper

71. These are all different types of bags used to carry and transfer a wide variety of items, including waste. There is similarity between the applicant's "*plastic bags*" and the opponent's "*[paper/cardboard] carrier bags*" in Class 16. The competing terms could share the same general purpose, especially when they are used as shopping bags, though the applicant's term "*plastic bags*" does not coincide in nature. The method of use, users, and trade channels may be the same. Although the competing goods are not complementary, they may be in competition. Therefore, I find the respective goods to be similar to at least reasonably high degree.
72. I will now consider if there is any similarity between the opponent's "*[paper/cardboard] carrier bags*" and the applicant's "*bags (garbage-) of paper or of plastics; refuse bags of paper*". Despite the same general nature, namely they can be made of paper, and users they may share, they serve a different purpose. However, I note that they may be sold in the same shops but most likely not in close proximity. Therefore, I find only a very low degree of similarity between the competing goods.
73. For completeness, I note that the opponent's "*bags [...], in particular for transport of tools and tool parts*" in Class 18, contain the broad term "*bags*" followed by the example "*transport of tools and tool parts*". The broadness of the term "*bags*" means that it includes within its ambit

shopping bags, albeit those made of materials other than paper or plastic. Whilst there is no similarity with the contested “*refuse bags*”, there is some similarity with the contested “*plastic bags*”, which could also be for shopping. Whilst the material of the goods differs, the purpose and method of use are similar, they could be offered through similar trade channels, and there is an aspect of competition. I consider the contested “*plastic bags*” in Class 16 to be similar to the opponent’s “*bags*” in Class 18 to a medium degree.

74. In terms of the contested terms “*books and cards on the subject of home improvement and repairs; instructional and teaching material (except apparatus)*” in Class 16, the same findings apply here as in the first earlier mark ‘075 shown in paragraphs 44-45 of this decision.

Masking tape and other adhesive tape for technical purposes; tapes

75. The contested terms “*masking tape and other adhesive tape for technical purposes*” and “*tapes*” in Class 17 are similar to the opponent’s term “*stationery*” in Class 16. The general purpose of the former terms is to stick surfaces together with at least one side of the goods being coated with an adhesive material. The opponent’s term may include items, such as tapes, but for stationery purposes under the relevant Class, as opposed to the applicant’s goods which are intended for technical purposes. Therefore, they do not share the same purpose other than at a more general level. However, the general nature and users of the competing goods are likely to overlap. Their methods of use may also be the same as the competing goods could be used, in effect, in the same way. Although I recognise that the opponent’s goods are more likely to be sold in stationery shops, whereas the applicant’s goods are more likely to be sold in hardware shops or DIY stores, there may be an overlap in trade channels. Thus, I consider the goods to be similar to a medium degree.

Extruded plastics [semi-finished products]; plastics in extruded form used in production; plastics in extruded form for use in manufacture; plastic film, other than for wrapping

76. There are no counterpart or similar goods to the opponent's specification. The contested goods in Class 17 and the goods in the earlier specification differ in nature, purpose, users, method of use, and trade channels. It is my view that there is no similarity or, if there is any, it is of a very low degree.

Caulk; sealants

77. The contested goods in Class 17 are intended to provide surface protection usually from fluids by filling gaps. Although these goods are different in nature, purpose, and method of use, they may overlap in users and trade channels. They may be found in the same DIY outlets as the opponent's "hand tools". Therefore, the similarity is of a low degree.

Garden hoses

78. As shown previously in paragraph 47 of this decision, the contested term is dissimilar to the opponent's goods for this earlier mark '936.
79. For the terms "articles for cleaning purposes; drink holders; cleaning instruments and cloths; parts and fittings for all the aforesaid goods" in Class 21, the same findings apply here as in the first earlier mark '075, shown in paragraph 49-50.

Painters gloves; gloves for gardening and household utility use

80. The contested goods in Class 21 are purpose-specific and different types of gloves, whereas the opponent's "gloves for protection against accidents" in Class 9 are used as protective equipment against accidents. The respective goods may share the same nature (e.g. fabric, leather or plastic) and method of use, but they differ in purpose. The users may be the same

and the respective goods may be sold in the same shops in close proximity. I consider there to be a degree of competition, although this may be at a fairly low level. There is no complementarity between the respective goods. Consequently, I find these goods to be similar to a medium degree.

Paper drop cloths; plastic sheeting for drop sheets; drop sheets (painter's protection covers) for use in painting

81. The same finding as shown in paragraph 52 of this decision applies to the case of the second earlier mark '936. Thus, for the same reasons I consider the competing goods to be similar to a low degree.

Articles of workwear; uniforms; overalls; belts

82. These contested goods in Class 25 are encompassed by the opponent's broad terms "*clothing; waist belts; work clothes; workclothes*" in the same Class. Therefore, the goods are identical in accordance with *Meric*.

Advertising services

83. The contested services in Class 35 are identical to the opponent's specification as they are identically worded.

The bringing together, for the benefit of others, of a variety of goods, namely hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes, enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the provision of on-line retail services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes, from an internet website; wholesale services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, surface protection products, plastic film, brooms, and articles for cleaning purposes

84. The contested services in Class 35 are considered to be services relating to the retailing of various goods via various routes. The opposed services are considered to be identical to the opponent's "retailing and wholesaling, including via the internet, in relation to storage containers and transport containers of metal, textile, plastic, leather or a combination of these materials; retailing and wholesaling, including via the internet, in relation to mechanically operated tools and tool inserts, hand-operated tools and tool inserts, measuring and testing apparatus; retailing and wholesaling, including via the internet, in relation to paper, cardboard and goods of paper and cardboard, namely carrier bags and packaging material, stationery pads, ring-binders, flags, posters, signs, calendars, pencil pots and clipboards, stationery, office articles; retailing and wholesaling, including via the internet, in relation to headgear, clothing, footwear, belts, workwear, professional clothing; retailing and wholesaling, including via

the internet, in relation to clothing, headgear and footwear for protection against accidents or injuries, eye protectors, ear protectors, gloves for protection against injury, protective work clothing”, as part of the retailed products coincide with the contested specification. In more detail, the identical counterparts found in the opposed specification, which are the subject of retailing, are: *hand tools; measuring instruments; personal protective equipment; clothing; footwear; gloves; and containers*. Therefore, these competing terms are identical as they are identically worded or ostensibly the same.

85. Further, the retailing services relating to *“brushes”, “paint rollers”, and “tapes”* in the applicant’s specification will be similar to a low degree to the opponent’s retailing services of *“hand tools”* and the retailing services relating to *“tapes”* in the applicant’s specification will be similar to a medium degree to the opponent’s retailing services of *“stationery”*.

86. In relation to the contested services relating to the retailing of *“articles for cleaning purposes”* and *“brooms”*, there is a very low degree of similarity between the physical goods being retailed and the goods of the earlier mark. I find only a very low similarity for the retailing of the respective goods in Class 35.

87. In relation to the retailing services relating to *“surface protection products; plastic film”* of the contested mark, there is no apparent similarity of the applicant’s retailed goods and the retailed goods of the earlier mark. Although the products retailed are not similar, the retail services per se share the same nature and method of use. Because of the dissimilarity of the goods being retailed, there is no overlap in the purpose of the services other than at a very general level. Consequently, the contested services are similar to a very low degree.

Operation and supervision of [...] promotional incentive schemes; organisation of exhibitions or trade fairs for commercial or advertising purposes

88. The opponent's "advertising, marketing and promotional services" are similar to the "operation and supervision of [...] promotional incentive schemes; organisation of exhibitions or trade fairs for commercial or advertising purposes". They share the same general nature aiming at business promotion and marketing. Although the applicant's services appear to be more specialised ones, the respective services serve the same purpose, i.e. promotion and advertising. The method of use, users and trade channels will likely intersect, and there may be both competition and complementarity between these services. Therefore, I find the respective services to be highly similar.

Business information and administration services; operation and supervision of sales [...]; business intermediary services for the sale and purchase of goods and services; retail shop management

89. The above contested services are concerned with carrying out the day-to-day functions of a business, such as administration, shop and sales management. Also, the business intermediary services are business-to-business services that involve the creation of a distribution channel with the assistance of an intermediary in order for the given goods and services to reach the final users. Although the "operation and supervision of sales" services relate to the retailing of goods, the focus is at a business level and not at a customer's one. The opponent's services relate to advertising and retail services and online ordering for various goods. Therefore, they are different in nature, purpose, method of use, users and trade channels. I find these services to be dissimilar or, if I am wrong, they are similar to a very low degree.

Auction services; providing an on-line commercial information directory

90. The competing services are fundamentally different in nature, purpose, method of use, and users. The trade channels will differ, and the services are neither in competition nor complementary. Therefore, they are dissimilar.

AVERAGE CONSUMER AND THE PURCHASING ACT

91. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

“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.”

92. The average consumer of the goods and services at issue will be either a member of the general public or specialised customers (professionals and businesses), such as mechanics or building contractors. In relation to the goods, they cover a range of widely available and low cost and/or reasonably expensive items, including tools, stationery and equipment, such as pliers, brushes, brooms, and protective clothing. The average consumer is likely to obtain the goods through self-selection from shelves in hardware shops, DIY stores, stationery shops or other specialist

suppliers, catalogues, or online equivalents. When selecting the goods, the average consumer will pay attention to factors, such as cost and suitability. 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. Given the breadth of the price of the goods and the frequency/infrequency of purchase, the attention paid by members of the general public will range from slightly lower to slightly higher than average, depending on the exact goods. In contrast, professional consumers may pay a slightly higher than average degree of attention to ensure the product chosen is fit for purpose.

93. As for the retail and wholesale services of the given goods, the selection process will be based on factors such as (stock) availability of the desired product range, price, quantity, and quality. Primarily, the average consumer's encounter with the given services will be on a visual level, such as signage on premises, promotional material, and website use. The process, therefore, will be primarily visual, but the word of mouth or recommendations may also play a role. The degree of attention paid to the selection of a retailer will be average, taking into account commercial considerations.
94. For the Class 35 services relating to "*business information and administration services; operation and supervision of sales and promotional incentive schemes; business intermediary services for the sale and purchase of goods and services; auction services; providing an on-line commercial information directory; organisation of exhibitions or trade fairs for commercial or advertising purposes; retail shop management*", the average consumer will select the service provider, based on reviews, cost, and suitability, while they may also consult the service provider before making the final decision. The selection process will be predominantly visual, with the average consumer selecting the retail service following a visual inspection of the shops or website, or promotional material, though I do not discount the aural considerations.

Given the more specialist nature of the services, I consider that the average consumer will pay a slightly higher than average degree of attention in choosing the service provider.


COMPARISON OF TRADE MARKS

95. 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.”

96. 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.

97. The marks to be compared are:

Earlier Marks	Contested Mark
<p data-bbox="440 248 619 286"><u>1. Mark '075</u></p> <p data-bbox="408 353 651 392">Be a Tool Rebel</p>	
<p data-bbox="440 483 619 521"><u>2. Mark '936</u></p> 	<p data-bbox="1015 658 1123 696">REBEL</p>

Overall Impression

98. The opponent in its submissions claims that:

“9. The word “TOOL” has a descriptive meaning in relation to the goods concerned, while the elements “BE” and “A” are common words which only have a meaning in conjunction with the words that follow. The word “REBEL” is therefore the dominant element of the mark. The applied-for mark is the word “REBEL” in plain text. [...]

18. The earlier trade mark is a logo with the words WERA TOOL REBELS along with depiction of tools. The word “TOOL” has a descriptive meaning in relation to the goods concerned, as well as the depictions of tools. The word “WERA” has smaller dimensions compared to “TOOL REBELS”. Phonetically and conceptually, the word “REBELS” is therefore the dominant element of the mark.”

99. However, the applicant counterargues that:

“The overall impression of the Opponent’s [first earlier] mark [‘075] resides in the mark in its entirety – and REBEL will not stand out as having a dominant or distinctive role within it.

[...] The words within the slogan BE A TOOL REBEL “hang together” because together they have a meaning and within that mark, the word REBEL does not have its own independent and distinctive character.”

100. The contested mark consists of the word “REBEL” presented in capital letters and standard font. Registration of a word mark protects the word itself presented in any normal font and irrespective of capitalisation.¹⁰ The overall impression of the mark lies in the word itself.

101. The first earlier mark ‘075 consists of the phrase “Be a Tool Rebel”, appearing in title case and standard font. None of the words within that phrase stand out as separate components. Whilst the word components “Be a” may act as a form of qualifier to the words “Tool Rebel”, I recognise that the word “Tool” may be perceived as descriptive of the goods/services and the word “Rebel” will be taken as an important part of the mark that invites what one to be. Consequently, it is my view that the overall impression of the opponent’s mark lies in the unit formed by the combination of the words, but I note the importance of the word “Rebel” in the given phrase.

102. The second earlier mark ‘936 is a figurative mark consisting of word and various figurative elements. The word elements “TOOL REBELS” appear in the centre of the mark, capitalised and stylised in a silver font, imitating a metallic look. They are enclosed into a shield device with a green background and two crossed screwdrivers (devices) placed above these word elements. Another two devices, acting as shield supporters, appear at each side of the shield with a wrench to the right and a spanner to the

¹⁰ See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

left. Further, a top banner in grey colour is placed above the shield with the word “Wera” appearing in black and standard font and title case. The word “Wera” is smaller in size than the other word elements of the mark. A pair of dark grey wings is attached to each side of the banner. There is also a bottom grey banner and light grey tribal shapes that mantle the figurative elements. The words “TOOL REBELS” and the shield device make a roughly equal contribution and have the greatest weight in the overall impression, with the word “Wera” playing a less prominent role. The rest of the device elements have some but even less relative weight in the overall impression of the mark.

Visual Comparison

Contested mark and earlier mark ‘075

103. There is a visual overlap between the fourth word element “Be a Tool Rebel” of the earlier mark and the contested word mark “REBEL”. However, there are no counterparts of the words “Be a Tool” in the contested mark. I note that these diverging elements appear at the beginning of the earlier mark, a position generally considered to have more impact due to consumers in the UK reading from left to right, although I keep in mind this is just a rule of thumb.¹¹ Taking into account the points of the overall impression, I find the marks to be similar to a low to medium degree.

Contested mark and earlier mark ‘936

104. The contested mark, “REBEL”, incorporates all the letters (except for the last) of the second word component “TOOL REBELS”, which (alongside the shield device) has the greatest weight in the overall impression of the earlier mark. The font and colour divergence of these word elements will play no material role due to the notional and fair use of the contested word mark in any standard font, case, and colour. All other elements present in

¹¹ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

the earlier mark are absent in the applicant's mark, introducing some notable visual differences. Taking into account the overall impression of the marks and the similarities and differences, I find there is a low to medium degree of visual similarity.

Aural Comparison

105. The applicant claims that its mark "would simply be articulated as "rebel" with two syllables. It can be pronounced in two ways depending on whether the consumer sees it as a noun (/ˈrɛb(ə)l/) or as a verb (/rɪˈbɛl/)."

Contested mark and earlier mark '075

106. The first earlier mark consists of the phrase "Be a Tool Rebel" and will be pronounced as "BEE-UH-TOOL-RE-BUHL". The entire contested word mark, "REBEL", is pronounced within the opponent's mark. Although the applicant's point is that the contested mark can be verbalised in two ways, there is no evidence from consumers. Having said that, this is a relatively subtle difference, and I do not attach much weight to it. The main aural difference between the competing marks is that the opponent's mark is longer than the applicant's, namely five syllables in contrast to two. Taking into account the overall impressions, I consider that the marks are aurally similar to a low to medium degree.

Contested mark and earlier mark '936

107. The second earlier mark comprises of three word elements, namely "TOOL REBELS" and "Wera". The first two word elements will be articulated as "TOOL- RE-BUHL", whereas the last is a foreign language word, and the UK average consumer may attempt to pronounce it as "WE-RA". The only common phonetic element that the competing marks share is the word REBEL/REBELS, save for the 'S' letter. However, there are no phonetic counterparts of the word elements "TOOL" and "WERA" of the earlier mark in the contested mark. In addition, I do not consider that the average consumer will attempt to articulate the figurative elements in the earlier

mark. Last, I have already outlined above the importance of the word components in the overall impression of the second earlier mark and disagree with the applicant's submissions that the word elements "'tool rebels'" would not stand out to the average consumer and would therefore not necessarily be articulated, whereas WERA, being in a darker font and at the top within a banner, signals to the consumer that this is the key part to focus on and to refer to the product as." Taking into account the overall impressions, I consider that the marks are aurally similar to a low to medium degree.

Conceptual comparison

108. The contested word mark is the dictionary word "REBEL", which is a well-known word to the UK average consumer and will be seen as someone who opposes authority. In agreement with the applicant's submissions, the word REBEL may be perceived either in its noun or verb form.
109. Although the first earlier mark '075 is a phrase and the second earlier mark '936 is a composite mark, both contain the word Rebel/REBELS, creating a conceptual commonality between the competing marks. I note that the word Rebel/REBELS, while being particularly memorable in the first earlier mark and sharing the greatest weight with the word component "TOOL" and the shield device in the second earlier mark, will form a conceptual hook in conjunction with the word "Tool/TOOL", which, as noted earlier, will be seen as descriptive of the goods/services.
110. Having said that, there are points of conceptual differences between the competing marks. In the first earlier mark '075, there is no conceptual counterpart for the "Be a Tool" part which will be understood as an inducement. Further, in the absence of evidence, the word "Wera", appearing in the second earlier mark, will be perceived as an invented or a foreign language word with no identifiable concept. Also, the shield device, having a greater weight as delineated above, will be seen as such, and the tool devices of the second earlier mark, which contribute less to

the overall impression, will be suggestive of the range of products of the goods/services of the mark. Therefore, considering all the factors and the points of the overall impression, I consider there to be a medium degree of similarity between the competing marks on a conceptual level.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARKS

111. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

112. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent

distinctive character, such as invented words which have no allusive qualities.

113. The opponent has not shown use of its marks and, thus, it cannot benefit from any enhanced distinctiveness; hence, I have only the inherent distinctiveness of the earlier marks to consider. I bear in mind that only the common elements between the respective marks should be considered to evaluate the relevant (to the question of confusion) distinctiveness.¹² In this regard, the figurative/device elements and the foreign word “Wera” add to the distinctiveness of the second earlier mark ‘936, but I note that there are no counterparts in the contested mark, so this is unlikely to increase the likelihood of confusion. As for the words “Be a Tool” in the first earlier mark and the word “TOOL” in the second earlier mark, they will be treated as allusive/suggestive of the goods and services in question.
114. As I have discussed above, the word element “Rebel/REBELS”, which is the only component that the respective marks have in common, is a dictionary word with the meaning that I have identified earlier in this decision. Notably, the average consumer will be familiar with this ordinary term, but it is not descriptive or suggestive of the registered goods and services. Therefore, I find that the first earlier mark ‘075 is inherently distinctive to a medium degree, whilst the second earlier mark ‘936 may be more distinctive on account of the figurative elements, but the common element is likewise distinctive to a medium degree.

LIKELIHOOD OF CONFUSION

115. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred previously in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree

¹² See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

of similarity between the marks, and vice versa.¹³ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon what may be an imperfect recollection of them.¹⁴

116. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., sitting 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.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

¹³ See *Canon Kabushiki Kaisha*, paragraph 17.

¹⁴ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

I note that the categories identified above by Mr Purvis Q.C. are not exhaustive.¹⁵

117. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and

¹⁵ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

118. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting 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.

119. Earlier in this decision I have concluded that:

- The goods and services at issue range from being dissimilar to identical;
- the average consumer of the parties' goods and services is a member of the general public or specialised customers (professionals and businesses). For the members of the general public, the level of attention paid will range from slightly lower to slightly higher than average, and, for the specialised customers, slightly higher than average. However, for the set of services in Class 35, which I have identified as being more specialist, the degree of attention will be slightly higher than average. The selection process is predominantly visual without discounting aural considerations;
- the contested mark and the earlier mark '075 are visually and aurally similar to a low to medium degree and conceptually similar to a medium degree;
- the contested mark and the earlier mark '936 are visually and aurally similar to a low to medium degree and conceptually similar to a medium degree;
- the first earlier mark '075 has a medium degree of distinctiveness and the second earlier mark '936, whilst having a more distinctive character, boosted by the figurative elements, has a medium degree of distinctiveness from the perspective of the common element.

120. The likelihood of confusion does not arise in relation to the application's goods and services which are dissimilar to the earlier marks. **The opposition cannot succeed against dissimilar goods and is dismissed insofar as it concerns the following goods and services:**

First Earlier Mark '075

Class 9: Thermometers; warning triangles and signs.

Class 16: Painting pencils; painting sets for children; drawing rulers; absorbent paper; drying towels of paper; kitchen rolls [paper]; paper handtowels; paper wipes; refuse bags of paper; chalk; painting sets for artists; artists' materials; art supplies; cutting mats made of plastic; powdered chalk; printed matter; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); stretch film and applicators for packaging; stationery; office and school supplies; staplers; posters; paper labels; stickers; plastic bags; bags (garbage-) of paper or of plastics; note pads; pens, pencils, markers; parts, fittings and accessories for all the aforesaid goods.

Class 17: Extruded plastics [semi-finished products]; plastics in extruded form used in production; plastics in extruded form for use in manufacture; plastic film, other than for wrapping; garden hoses.

Class 21: Drink holders.

Class 35: Advertising services; business information and administration services; operation and supervision of sales and promotional incentive schemes; providing an on-line commercial information directory; organisation of exhibitions or trade fairs for commercial or advertising purposes; retail shop management; the bringing together, for the benefit of others, of a variety of goods, namely [...] surface protection products,

plastic film, [...], enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the provision of on-line retail services connected with the sale of [...] surface protection products, plastic film, [...], from an internet website; wholesale services connected with the sale of [...] surface protection products, plastic film, [...].

Second Earlier Mark '936

Class 9: Thermometers; Warning triangles and signs.

Class 16: Instructional and teaching material (except apparatus).

Class 17: Extruded plastics [semi-finished products]; plastics in extruded form used in production; plastics in extruded form for use in manufacture; plastic film, other than for wrapping; garden hoses.

Class 21: Drink holders.

Class 35: Business information and administration services; operation and supervision of sales [...]; business intermediary services for the sale and purchase of goods and services; retail shop management; the bringing together, for the benefit of others, of a variety of goods, namely [...] surface protection products, plastic film, [...], enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the

provision of on-line retail services connected with the sale of hand tools and implements, extensions for [...] surface protection products, plastic film, [...], from an internet website; wholesale services connected with the sale of [...] surface protection products, plastic film, [...]; auction services; providing an on-line commercial information directory.

121. As for the remaining goods and services, the earlier marks differ in one or more points, thus, I will evaluate them separately.

First Earlier Mark '075

122. In terms of the first earlier mark '075, taking into account the doctrine of imperfect recollection and the factors I have delineated above, I find that there is no likelihood of direct confusion. Based on the visual and aural differences between the marks, it is unlikely the average consumer will misremember that the one mark is a single word and the other is a phrase. The phrase has no counterpart in the later mark. Although the word "Tool" is considered to describe the relevant goods/services, it does provide a contribution to the overall impression of the earlier mark. Additionally, it is established that the consumer's attention is usually directed towards the beginnings of trade marks. Therefore, in this case, the different beginnings between the marks are likely not to go unnoticed. Consequently, even when considering the doctrine of imperfect recollection, there will be no direct confusion.

123. Nevertheless, having identified that the marks are different, the average consumer will, in my view, assume that the respective marks originate from the same or economically linked undertakings. Notably, the consumer, whilst recalling the difference created by the words "Be a Tool", due to the identity and/or similarity between the competing goods and services, the conceptual hook generated by the importance of the common word

“REBEL”, and the medium distinctive character of the earlier mark, will perceive the competing marks as variants used by the same or economically linked undertakings. Thus, I consider that there will be a likelihood of indirect confusion. This is so, for the goods and services that I found identical and similar ranging from low to high degree. However, this finding does not apply to those goods and services where I found similarity to be of a very low degree which will, bearing in mind the interdependency between the various factors, counter a likelihood of confusion whether direct or indirect.

Second Earlier Mark ‘936

124. In relation to the second earlier mark ‘936, taking into account all the factors that I have analysed, I am persuaded that there is no likelihood of direct confusion. The various visual differences between the marks, such as the presence of the additional words “TOOL” and “Wera” and the various devices found in the opponent’s mark, the predominantly visual purchasing process, and although the difference between the singular (REBEL) and plural form (REBELS) in the marks may well be lost by virtue of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other.
125. However, I find that there is a likelihood of indirect confusion. Although the average consumer will recognise the differences between the marks in question, the marks will be seen as indicative of alternatives from the same or economically linked undertakings. Essentially, when encountering the marks, the average consumer will consider the applicant’s mark REBEL to be a sub-brand of the opponent’s figurative mark containing the word component “REBELS”, which together with the word component TOOL and the shield device have the greatest weight in the overall impression. I consider that there is a likelihood of indirect confusion regarding those goods and services that I have found to be identical and similar ranging from low to a high degree. This finding does not apply to those goods and

services of very low similarity, which will counter any likelihood of confusion.

OUTCOME

126. Part of the opposition under Section 5(2)(b) **succeeds and the application will be refused for the following goods and services:**

Class 8: Hand tools; hand tools and implements (hand operated); hand-operated tools and implements for treatment of materials, and for construction, repair and maintenance; hand tools for use in painting, decorating and tiling; gardening tools; plaster trowels; axes; scrapers; blades [hand tools]; knives; palette knives; cutters; squeegees [hand-operated tools]; drywall finishing tools [hand tool]; glass scrapers [hand tools]; wire brushes; screwdrivers; threading tools; tile cutters, scribes; pliers, snips; hand saws, hand saw blades; hammers; planes; rasps; chisels; carpenter squares; edge tools; drills and drill extensions; expansive bits; hole saws; chalk line reels; extension bars for hand tools; extensions for hand tools; tool belts; tool aprons; tool holders; tool pouches for attachment to tool belts; scissors; parts and fittings for all the aforesaid goods.

Class 9: Measuring instruments; plumb bob and plumb bobs incorporating a self-chalking line; levels; measuring tapes; back support belts and knee pads; protective clothing, footwear and headgear; clothing, footwear and headgear for protection against injury or accident; safety clothing, footwear and headgear; high visibility clothing; overalls, including disposable clothing and overalls; protective boots and shoes; gloves for protection against accidents and injury; gloves for industrial use; safety goggles, glasses and face shields; hard hats; protective masks; respirators; ear plugs.

Class 16: Brushes, paint brushes; paint rollers, paint roller frames, paint roller extension poles; paint roller covers; paint roller trays; paint roller handles; paint pads; paint trays, paint scuttles, paint kettles;

paint boxes; paint paddles; painting stencils; stencils; drawing templates; paint applicators in the nature of sponges; painting pencils; painting sets for children; painting mitts for applying paint; palettes for painters; pastes and other adhesives for stationery or household purposes; glue for stationery or household purposes; adhesive tape for stationary or household purposes; adhesive tape dispensers for household and office use; chalk; handles made of plastic for paint brushes; painting sets for artists; artists' materials; art supplies; cutting mats made of plastic; powdered chalk; printed matter; plastic materials for packaging (not included in other classes); stretch film and applicators for packaging; stationery; office and school supplies; staplers; drawing rulers; posters; paper labels; stickers; plastic bags; note pads; pens, pencils, markers; parts, fittings and accessories for all the aforesaid goods.

Class 17: Masking tape and other adhesive tape for technical purposes; caulk; tapes; sealants.

Class 21: Brooms; brush holders; brushes for cleaning; brushes for cleaning cars; floor brushes; brushes for household purposes; combs for cleaning; steel wool; painters gloves; sponges for spackling, sanding, printing, and wallpaper; gloves for gardening and household utility use; sponges.

Class 22: Paper drop cloths; plastic sheeting for drop sheets; drop sheets (painter's protection covers) for use in painting.

Class 25: Articles of workwear; uniforms; overalls; belts.

Class 35: Advertising services; operation and supervision of [...] promotional incentive schemes; the bringing together, for the benefit of others, of a variety of goods, namely hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, [...] enabling customers to conveniently view and purchase those goods from an Internet web

site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the provision of on-line retail services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, [...], from an internet website; wholesale services connected with the sale of hand tools and implements, extensions for hand tools, measuring instruments, personal protective equipment, clothing, overalls, footwear, gloves, brushes, paint rollers, paint applicators, containers, adhesive tapes, [...]; organisation of exhibitions or trade fairs for commercial or advertising purposes.

127. Part of the opposition **fails, and the application will proceed to registration for the following goods and services:**

Class 9: Thermometers; warning triangles and signs; electrical outlets and switches, sockets and socket adapters.

Class 16: Absorbent paper; drip mats of cardboard; drip mats of paper; drying towels of paper; kitchen rolls [paper]; paper handtowels; paper wipes; painters wipes; refuse bags of paper; books and cards on the subject of home improvement and repairs; instructional and teaching material (except apparatus); bags (garbage-) of paper or of plastics.

Class 17: Extruded plastics [semi-finished products]; plastics in extruded form used in production; plastics in extruded form for use in manufacture; garden hoses; plastic film, other than for wrapping.

Class 21: Articles for cleaning purposes; drink holders; cleaning instruments and cloths; parts and fittings for all the aforesaid goods.

Class 35: Business information and administration services; operation and supervision of sales [...]; operation and supervision of sales [...]; business intermediary services for the sale and purchase

of goods and services; auction services; business intermediary services for the sale and purchase of goods and services; auction services; providing an on-line commercial information directory; the bringing together, for the benefit of others, of a variety of goods, namely [...] surface protection products, plastic film, brooms, and articles for cleaning purposes, enabling customers to conveniently view and purchase those goods from an Internet web site or by means of telecommunications or by means of a global network or by mail order catalogue or from a retail store; the provision of on-line retail services connected with the sale of hand tools and implements, extensions for [...] surface protection products, plastic film, brooms, and articles for cleaning purposes, from an internet website; wholesale services connected with the sale of [...] surface protection products, plastic film, brooms, and articles for cleaning purposes.

COSTS

128. In terms of costs, whilst both parties had achieved a measure of success, proportionately, the opponent was more successful than the applicant. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs to the opponent on the following basis, offsetting an amount to allow for the success of the applicant:

Official application fees	£100
Preparing a statement and considering the counterstatement	£100
Filing written submissions	£200
Filing submissions in lieu	£100
Total	£500

129. I, therefore, order Coral Tools Limited to pay Wera Werkzeuge GmbH the sum of £500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of September 2021

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General