

O/551/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3635910
IN THE NAME OF CRISTIAN DUDAS
TO REGISTER AS A TRADE MARK**



IN CLASS 16

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER OP600001870
BY KONRAD HORNSCHUCH AG**

BACKGROUND AND PLEADINGS

1. On 03 May 2021, Cristian Dudas (“the applicant”) applied to register trade mark number UK3635910 for the mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 02 July 2021, in respect of the following goods:

Class 16: *Paper towels; Paper face towels; Towels of paper; Paper hand towels; Paper hand-towels; Face towels of paper; Drying towels of paper; Hand towels of paper; Hygienic hand towels of paper; Towels of paper for cleaning purposes; Towels of paper for removing make-up; Paper; Paraffined paper [waxed paper]; Stencil paper [mimeograph paper]; Paper stock [printing paper]; Graph paper; Gummed paper; Paper emblems; Paper signs; Directory paper; Thermal paper; Honeycomb paper; Opaque paper; Calligraphy paper; Paper doylies; Paper tablecloths; Paper pads; Paper clasps; Parchment paper; Greaseproof paper; Toilet paper; Paper folders; Paper ribbons; Duplicating paper; Note papers; Wax paper; Tissue papers; Paper bags; Corrugated paper; Paper board.*

2. The application is opposed by Konrad Hornschuch AG (“the opponent”) under the fast-track procedure. The opposition was filed on 23 August 2021 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application. The opponent relies upon the following marks:

d-c-home

UK trade mark registration number 3377747

Filing date: 22 February 2019

Registration date: 31 May 2019

Registered in Classes 6, 8, 12, 16, 1, 18, 19, 20, 24, and 27

Relying on the following goods only in Class 16, namely:

Printed matter; wall decals; Stickers [stationery]; Stationery and Teaching materials (except apparatus); Printing and bookbinding equipment; Bookbindings; Bookbinding covers.

(Mark 1); and

Hornschuch d-c-home

UK trade mark registration number 915939598

Filing date: 17 October 2016

Registration date: 07 February 2017

Registered in Classes 16, 17, 20, 21, 24 and 27

Relying on the following goods only in Class 16, namely:

Decorative stickers; Wall tattoos; Decorative elements for walls; Self-adhesive decorative elements of cardboard for walls; Pictures; Self-adhesive foil pictures.

(Mark 2).

3. The opponent submits that the mark applied for is highly similar to the earlier trade marks, and that the goods covered by the marks are identical or highly similar. As a result, it submits that there is a risk of confusion between the marks on the part of the public, including a likelihood of association. Accordingly, it submits that the application be rejected, and an award of costs be made in favour of the opponent.

4. The applicant filed a counterstatement denying the claims. He submits that the marks are not highly similar, and while his own mark includes a logo, the opponent's marks do not. He further submits that the goods being provided by the opponent are different to his own goods.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 No. 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

7. In an official letter dated 11 March 2022, in accordance with Tribunal Practice Notice 2/2013, the parties were allowed until 25 March 2022 to seek leave to file evidence and/or request a hearing and until 11 April 2022 to provide written submissions.¹

8. Only the opponent filed written submissions which will not be summarised, but will be referred to as and where appropriate during this decision. This decision has therefore been taken following a careful perusal of the papers.

9. In these proceedings, the opponent is represented by Forresters IP LLP and the applicant is a litigant in person.

My Approach

10. I note that in the opponent's written submissions dated 11 April 2022, the opponent only makes submissions in relation to the first earlier mark (Mark 1) and that no mention is made of Mark 2, as relied upon on form TM7². Mark 1 comprises the letter/word combination **d-c-home**, which is the element in common with the applicant's mark and is encompassed in its entirety within Mark 2, **Hornschuch d-c-home**. As the Class 16 goods in Mark 1 are also more akin to the contested mark

¹ The Tribunal held the preliminary view that additional information was required before the TM8 and counterstatement filed by the applicant on 28 October 2021 could be admitted into the proceedings. Accordingly, in official letters dated 23 November 2021 and 11 January 2022 respectively, the applicant was invited to file an amended form TM8. As no response was received by the given deadlines, following further review, the Registry was of the view that the applicant's counterstatement was sufficient to allow the case to proceed, which was communicated to the parties in the official letter dated 11 March 2022. I duly note the submissions made by the opponent in paragraphs 5 -12 of its written submissions dated 11 April 2022 with regard to the content of the applicant's counterstatement.

² See page 11 of 20 of form TM7, dated 23 August 2021; and paragraph 3 of the opponent's written submissions dated 11 April 2022.

than those covered by Class 16 of Mark 2, it follows that Mark 1 represents the opponent's strongest case. In the event that I find a likelihood of confusion in respect of Mark 1, any finding of confusion in respect of the remaining mark does not further the opponent's case. If, however, I find no likelihood of confusion between the applicant's mark and the opponent's Mark 1, it follows that the same finding will apply to Mark 2 on the basis that it shares a lesser degree of similarity with the contested application. I will therefore focus my assessment under section 5(2)(b) on the opponent's Mark 1 only, which going forward, I will refer to as "the opponent's mark". If required, I will address this point further when considering any final remarks at the conclusion of this decision.

DECISION

11. Although the UK has left the European Union, 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 Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

Section 5(2)(b)

12. The opposition is based upon Section 5(2)(b) of the Act, which reads as follows:

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

...

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

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

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK), European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

...”

14. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the trade mark had not been registered for more than five years at the date the application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon it in relation to all of the goods indicated without having to prove that genuine use has been made of them.

15. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well

informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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

16. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.³

17. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- “(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;

³ Paragraph 23

(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.”

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

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.⁴

19. The goods to be compared are:

Opponent’s goods	Applicant’s goods
<p><u>Class 16</u> <i>Printed matter; wall decals; Stickers [stationery]; Stationery and Teaching materials (except apparatus); Printing and bookbinding equipment; Bookbindings; Bookbinding covers.</i></p>	<p><u>Class 16</u> <i>Paper towels; Paper face towels; Towels of paper; Paper hand towels; Paper hand-towels; Face towels of paper; Drying towels of paper; Hand towels of paper; Hygienic hand towels of paper; Towels of paper for cleaning purposes; Towels of paper for removing make-up; Paper; Paraffined paper [waxed paper]; Stencil paper [mimeograph paper]; Paper stock [printing paper]; Graph paper; Gummed paper; Paper emblems; Paper signs; Directory paper; Thermal paper; Honeycomb paper; Opaque paper;</i></p>

⁴ Paragraph 82

	<p><i>Calligraphy paper; Paper doylies; Paper tablecloths; Paper pads; Paper clasps; Parchment paper; Greaseproof paper; Toilet paper; Paper folders; Paper ribbons; Duplicating paper; Note papers; Wax paper; Tissue papers; Paper bags; Corrugated paper; Paper board.</i></p>
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20. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁵

21. In *Gérard Meric v OHIM*, Case T-133/05, the GC stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.⁶

22. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

⁵ Paragraph 5

⁶ Paragraph 29

"... 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."⁷

23. In its written submissions, the opponent submits that the term "printed matter" as included in its Class 16 specification is extremely broad and as such, all of the products in the later application fall under printed matter as they are paper goods.⁸ It provides a further, more specific comparison of the goods covered, and concludes that the goods of the applicant are either identical or similar to a high degree to those of the opponent.⁹

24. The applicant has not provided any specific comparison in relation to the goods at issue.

25. I will now set out my own considerations of the comparison of goods in Class 16, grouping them together where this is appropriate, as per *Separode*.

26. I consider that all of the following goods may be construed as being items of stationery:

"Paper; Stencil paper [mimeograph paper]; Paper stock [printing paper]; Graph paper; Gummed paper; Paper emblems; Paper signs; Directory paper; Thermal paper;

⁷ Paragraph 12

⁸ See the opponent's written submissions dated 11 April 2022, paragraph 19.

⁹ *Ibid*, paragraphs 20 – 24.

Opaque paper; Calligraphy paper; Paper pads; Paper clasps; Paper folders; Duplicating paper; Note papers”.

As such, applying the principle set out in *Meric*, I find the above contested goods to be identical to the opponent’s broader term “*Stationery and Teaching materials (except apparatus)*”.

27. I consider that the principal use of the following contested goods would be for decoration or wrapping and packaging purposes:

“Honeycomb paper; Paper ribbons; Tissue papers¹⁰; Paper bags; Corrugated paper; Paper board”.

I do not regard them as being printed matter as submitted by the opponent, however, there is likely to be an overlap with the users of the opponent’s “*Stationery and Teaching materials (except apparatus)*”, and they are likely to be sourced from the same trade channels, such as stationers and post offices. I do not consider it unreasonable that the average consumer would expect the competing goods to be provided from the same or economically linked undertakings. Taking all of this into account, I find there to be a medium degree of similarity between the opponent’s “*Stationery and Teaching materials (except apparatus)*” and the applicant’s “*Honeycomb paper; Paper ribbons; Tissue papers; Corrugated paper; Paper board*”.

28. I cannot agree with the opponent that all paper goods would automatically fall under the umbrella of “*printed matter*”.¹¹ In my view, the average consumer would perceive the following paper items included in the applicant’s specification as being for use for cleaning and/or hygiene purposes:

¹⁰ Although usually referred to in the singular rather than the plural, I consider the term “*tissue papers*” to be the coloured sheets of paper often used for gift wrapping, rather than paper handkerchiefs which are commonly referred to as “*paper tissues*”.

¹¹ The Collins English Dictionary online defines the term “*printed matter*” as “*material that has been printed or published, such as newspapers, magazines, or books*”. <Printed matter definition and meaning | Collins English Dictionary (collinsdictionary.com)>, accessed 10/06/2022.

“Paper towels; Paper face towels; Towels of paper; Paper hand towels; Paper hand-towels; Face towels of paper; Drying towels of paper; Hand towels of paper; Hygienic hand towels of paper; Towels of paper for cleaning purposes; Towels of paper for removing make-up; Toilet paper”.

Taking my guidance from *YouView*, to interpret the above goods as “*printed matter*” would involve an unnatural straining of the English language. The competing goods are different in nature and purpose, and are neither complementary to, nor in competition with, each other. I consider that the aforementioned goods are dissimilar to the opponent’s “*printed matter*”.

29. I consider that the purpose of the following goods of the applicant’s specification would be primarily for use in baking or for wrapping foods items:

“Paraffined paper [waxed paper]; Parchment paper; Greaseproof paper; Wax paper”.

As outlined for the paper goods listed under paragraph 28, I consider that the applicant’s goods above to be distinct from the opponent’s “*printed matter*”, being different in nature, purpose and method of use, as well having different channels of trade. I therefore consider that the applicant’s “*Paraffined paper [waxed paper]; Parchment paper; Greaseproof paper; Wax paper*” are dissimilar to the opponent’s “*printed matter*”.

30. To my mind, the applicant’s “*Paper doylies; Paper tablecloths*” are used to adorn and/or protect crockery and tables either in the home or in a catering or hospitality environment. They are different in nature, method of use and purpose to the opponent’s “*printed matter*”. In line with *YouView*, I find the contested goods to be dissimilar to the opponent’s “*printed matter*”.

31. A degree of similarity between the goods is essential for there to be a finding of likelihood of confusion. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

32. I therefore find there to be no likelihood of confusion for those goods which I found to be dissimilar.

The average consumer and the nature of the purchasing act

33. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he was then) 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”.¹²

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

35. Neither the opponent nor the applicant has made any submissions in regard to the average consumer of the respective goods.

¹² Paragraph 60

36. In my view, the average consumer for the competing goods will most likely be the general public, although I acknowledge that the goods may also be aimed at businesses and educational establishments.

37. Both parties' goods are sold through a range of channels including supermarkets, department stores and stationers, as well as online. In retail and wholesale outlets, the goods will be displayed on shelves where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. The selection process will, in my view, be a predominantly visual one, although aural considerations will play a part. Although the price of the goods can vary, on balance it seems to me that the cost of the purchase is likely to be relatively low and the goods will be purchased reasonably frequently. Considered overall, I find that the level of attention will be no more than medium when selecting the goods.

Comparison of marks


38. 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 in *Bimbo SA v OHIM* Case C-591/12P, 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.”¹³

¹³ Paragraph 34

39. 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.

40. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
<p>d-c-home</p>	

41. In its written submissions, the opponent submits that the dominant and distinctive element of both marks is the letters D and C since the remainder of the marks of both parties are descriptive. It describes the figurative element of the applicant's mark as "a logo of a house or trees".

42. In his counterstatement, the applicant submits that there is "nothing highly similar on the trade mark name, as I got a logo image as well". (sic)

Overall impression

43. The opponent's mark consists of the letters "d" and "c" and the plain word "home", with a hyphen between each of the letters and the word element. The whole is presented in a standard black font in lower case, without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore rests in the letters and word combination.

44. The applicant's mark comprises a figurative element, which consists of a series of straight lines which together form what I perceive to be a simplistic representation of a building with a pitched roof. Beneath and central to the illustration are the letters and words "DC Home & Kitchen Products", presented in title case, in a standard font. Underneath the aforementioned words is the strapline "WE MAKE YOUR LIFE EASIER", presented in capital letters, in a much smaller, standard font. The whole of the above is positioned in the centre of a pink rectangular background, with the rectangular shape running horizontally. In my view, it is the combination of the logo and the words "DC Home & Kitchen Products" which dominate. The strapline, due to its reduced size and position, plays a much lesser role in the overall impression of the mark. I consider the pink background to be a purely decorative element which does not add to the trade mark message conveyed by the words and logo and as such does little to contribute to the overall impression of the mark.

Visual comparison

45. Both marks contain the same two letter and word combination d-c-home/DC Home positioned at the start of each of the respective marks, however, they are presented in markedly different styles. The opponent's mark, which is encompassed in its entirety within the applicant's mark, is all in lower case and hyphenated. Meanwhile, the letters DC in the applicant's mark are presented in capitals and there is a space between the conjoined letters and the first word Home, which is followed by the additional words "& Kitchen Products", which is presented as a unit in title case. Further, the applicant's mark contains the strapline and figurative element, as previously described, which is not present in the earlier mark, and all of which visually differentiates between the earlier and later marks. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. Considering the marks as a whole, I find there to be a low degree of visual similarity between them.

Aural comparison

46. The figurative element of the later mark would not be articulated. The common element in both marks are the letters “DC” and the word “Home” (d-c-home), which would be pronounced identically in both marks as DEE CEE HOME. The words “& Kitchen Products” in the applicant’s mark will also be voiced, the whole being read as DEE CEE HOME AND KIT-CHIN PROD-UCTS. The opponent’s submits that the contested mark would be abbreviated to only “DC Home”. In my view, the average consumer would not unnaturally separate the “& Kitchen” element, which together with the previous word “Home” form a unit, although I consider it feasible that there may be a proportion of consumers who would not pronounce the word “Products”. I therefore consider there to be a medium degree of aural similarity between the marks. If I am wrong in this and, as submitted by the opponent, there are some consumers who articulate the mark only as “DC Home”, I consider the proportion of those consumers to be insignificant. However, I agree that it is unlikely that a significant proportion of the average consumer would voice the words “WE MAKE YOUR LIFE EASIER” in the later mark. If the strapline were to be pronounced, it would serve to reduce the aural similarities between the marks, resulting in a low degree of similarity between them.

Conceptual comparison

47. While acronyms and abbreviations may provide different meanings depending on the context in which they are used, the combined letters “DC”/“d-c” *solus* have no singular clear significance for the average UK consumer. The applicant makes reference to the letters as being the initials of his (real) name, Dudas Cristian, however unless the average consumer of the goods at issue were aware of this fact, any such link would not be made. Even if the letters DC in the contested mark were recognised as the applicant’s initials, they do not have any clear and recognisable semantic content.¹⁴ The words “Home & Kitchen Products” in the applicant’s mark clearly describes the intended purpose of the goods at issue, i.e. items to be used in the home and kitchen. These words are reinforced by the figurative element which alludes to a building or home, while the additional strapline is a marketing slogan extolling the virtues of the products and the provider’s aim to make life easier for the consumer of

¹⁴ See *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, at 84 – 87.

the goods. In the opponent's mark, the word "home" also alludes to products which are designed for domestic use. No conceptual comparison can be made of the common letters DC/d-c. Overall, I consider that in view of the shared concept of "home", the marks are conceptually similar to a low to medium degree.

Distinctive character of the earlier marks

48. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

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

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

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

50. Registered trade marks can possess varying degrees of inherent distinctive character, being low where they are allusive or suggestive of a character of the goods and services, whereas invented words usually have the highest degree of distinctive character. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

51. While the word “home” is allusive of the goods, the “d-c-“ element has no particular meaning attached to it. Generally, a two letter combination is not strikingly distinctive, neither is it particularly weak in cases where there is no proven connection between those letters and the goods for which the mark is registered. Overall, I consider the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

52. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

53. It is clear then that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

54. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the

responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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:

(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).”

55. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

56. Earlier in this decision, I found that:

- All the contested goods except for those listed in paragraphs 28 – 30 of this decision are identical or similar to a medium degree to the opponent's goods.
- The average consumer of the goods will be the general public or businesses and educational establishments, with the selection process being a predominantly visual one, although aural considerations will play a part. No more than a medium degree of attention will be paid during the selection process;
- The competing trade marks are visually similar to a low degree and are aurally similar to a medium degree where the strapline in the applicant's mark is not articulated. To those consumers who also voice the strapline "WE MAKE YOUR LIFE EASIER", the aural similarities are reduced, resulting in a low degree of similarity between the marks. The marks are conceptually similar to a low to medium degree;
- The earlier mark is inherently distinctive to a medium degree.

57. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view, the average consumer will notice and recall the visual and aural differences between the marks. I do not consider there is any likelihood of direct confusion as the differences between the marks are too great for confusion to arise. I find this even where the respective goods are held to be identical, which offsets a lesser degree of similarity between the marks.

58. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), 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.

59. Bearing in mind the competing factors in my decision and the principle of interdependency between them, given the identity/similarity of goods and that the earlier mark is encompassed in its entirety within the contested mark, notwithstanding the medium degree of distinctive character of the earlier mark, I consider that a significant proportion of consumers would assume that different stylisation and the addition of the words “& Kitchen Products”, along with the strapline and figurative element, represents either a sub-brand or brand extension of the opponent’s mark. I find that there is a likelihood of indirect confusion in relation to all the goods for which I found similarity.

60. The opposition under section 5(2)(b) succeeds in respect of the following goods in Class 16:

Paper; Stencil paper [mimeograph paper]; Paper stock [printing paper]; Graph paper; Gummed paper; Paper emblems; Paper signs; Directory paper; Thermal paper; Honeycomb paper; Opaque paper; Calligraphy paper; Paper pads; Paper clasps; Paper folders; Paper ribbons; Duplicating paper; Note papers; Tissue papers; Paper bags; Corrugated paper; Paper board.

61. The opposition fails in respect of the remaining goods.

Conclusion

62. The opponent has been partially successful. Subject to any successful appeal, the application by Cristian Dudas may proceed to registration in respect of the following goods in Class 16:

Paper towels; Paper face towels; Towels of paper; Paper hand towels; Paper hand-towels; Face towels of paper; Drying towels of paper; Hand towels of paper; Hygienic hand towels of paper; Towels of paper for cleaning purposes; Towels of paper for removing make-up; Paraffined paper [waxed paper]; Paper doylies; Paper tablecloths; Parchment paper; Greaseproof paper; Toilet paper; Wax paper.

Costs

63. Both parties have enjoyed a share of success, and I note that although the applicant was invited to complete the costs pro-forma, this was not completed and returned¹⁵. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice (“TPN”) 2 of 2015. Considering the balance of success is roughly equal, adopting a “rough and ready” approach to the matter, I have concluded that both parties should bear their own costs.

Dated this 28th day of June 2022

**Suzanne Hitchings
For the Registrar,
the Comptroller-General**

¹⁵ See official letter dated 11 March 2022.