

O/748/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003673885

IN THE NAME OF FORESTIA

FOR THE TRADE MARK:

COBRA FASTENER

IN CLASS 6

AND

OPPOSITION THERETO UNDER NO. 600002222

BY AUSTRIALPIN GMBH

Background and pleadings

1. On 27 July 2021, FORESTIA (“the applicant”) filed application number 3673885 to register the trade mark shown on the cover page of this decision in the UK. The application, effectively a re-filing of pending European Union trade mark number 018294687, was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union (hereafter referred to as “Article 59”). The EU filing date was 24 August 2020 and so, in accordance with Article 59, the contested application is deemed to have the same filing date as the corresponding pending EU application. The UK application was published for opposition purposes on 19 November 2021 and registration is sought for the following goods:

Class 6: *Common metals and their alloys; Buildings of metal; Metal materials for construction; Modular building units (Metal -); Metal hardware; Fixing devices of metal; Screws of metal; Fasteners of metal [small items of hardware]; all of the above-mentioned goods being intended for the assembly, mounting and fixing of decking and deck boards; none of the above-mentioned goods being intended for plumbing and sanitaryware.*

2. On 16 February 2022, AUSTRIALPIN GmbH (“the opponent”) opposed the application (using the Fast-Track provisions) on the basis of Sections 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the International Registration (“IR”) set out below:

1429299

COBRA

International registration date: 18 April 2018

Designation date: 16 January 2019

Date of protection of the international registration in UK: 27 June 2019

The goods relied upon by the opponent are detailed at paragraph 18 below.

3. Under Section 6(1) of the Act, the opponent's mark clearly qualifies as an earlier trade mark. Further, as the opponent's mark had not completed its protection process more than five years before the filing/priority dates of the application, proof of use is not relevant in these proceedings as per Section 6A of the Act.

4. The opponent claims that the applicant's goods are identical or similar to the goods covered by the earlier mark and that the marks are identical or highly similar, leading to a likelihood of confusion. In particular, the opponent claims that the marks coincide in the word 'COBRA', which is distinctive for the goods in question, and that the word 'FASTENER' in the applicant's mark is descriptive and can play no part in distinguishing the marks.

5. The applicant filed a counterstatement denying the grounds of opposition.

6. Rules 20(1)-(3) of the Trade Marks Rules (the provisions which provide for the filing of evidence) do not apply to fast-track oppositions such as the present proceedings, but Rule 20(4) does. It reads:

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

7. 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.

8. No leave to file evidence was sought. Equally, no request for a hearing was made. Only the opponent filed submissions in lieu. This decision is taken following a careful consideration of the papers.

9. The applicant is represented by Stevens Hewlett & Perkins and the opponent by Harrison IP Limited.

10. 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.

Section 5(2)(b)

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

“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”.

12. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

14. When making the comparison, all relevant factors relating to the goods 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.”

15. 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.

16. The General Court (GC) confirmed in *Gérard Meric v OHIM*, 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 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”.

17. 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 GC 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.”

18. The goods to be compared are as follows:

The applicant's goods	The opponent's goods
<p>Class 6: <i>Common metals and their alloys; Buildings of metal; Metal materials for construction; Modular building units (Metal -); Metal hardware; Fixing devices of metal; Screws of metal; Fasteners of metal [small items of hardware]; all of the above-mentioned goods being intended for the assembly, mounting and fixing of decking and deck boards; none of the above-mentioned goods being intended for plumbing and sanitaryware.</i></p>	<p>Class 6: <i>Metal hardware and small items of metal hardware; buckles and fasteners of metal, precious metals or aluminium.</i></p> <p>Class 22: <i>Slings and bindings not of metal; braces, not of metal, for handling loads; non-metallic webbing straps for handling loads; straps for securing bundles; belt systems for securing freight.</i></p> <p>Class 26: <i>Buckles and fastenings for garments; webbing tapes.</i></p>

19. The only comment the applicant made as regard the comparison of goods is as follows:

“It is denied that the goods for which registration is sought are identical or similar. It is submitted that the application contains a wide range of goods which are clearly distinguishable from the opponent's goods, for example “Metal hardware and small items of metal hardware” are clearly different to “building of metal” and “modular building units (Metal)”.

20. The opponent denies the applicant's claim contending that there is obvious identity and/or complementarity between the goods in question. It states as follows:

“The respective fittings and hardware may be required for proper use of the final product or because the end product cannot serve its intended purpose if the fittings are not included in the final product. In that case, the public and

relevant consumers would expect the metal fittings to be produced by, or under the control of, the original manufacturer.

We have demonstrated that the users will be equivalent or complementary, all being metal products and the building cannot be assembled without its fittings and appropriate hardware. The users are the same – consumers who are buying metal hardware or buying a metal unit provided with its own specific hardware. The manufacturers and trade channels are or can therefore be the same”.

21. For the sake of clarity, the limitation “*all of the above-mentioned goods being intended for the assembly, mounting and fixing of decking and deck boards; none of the above-mentioned goods being intended for plumbing and sanitaryware*” in the applicant’s specification does not prevent the competing goods from being similar. This is because the opponent’s specification is not limited in any way, and so the opponent’s goods could, in theory, cover goods *for the assembly, mounting and fixing of decking and deck boards*.

22. The term *Metal hardware* is included in both specifications. These goods are self-evidently identical.

23. The term *Fasteners of metal [small items of hardware]* in the applicant’s specification is identical to *fasteners of metal, precious metals or aluminium* in the opponent’s specification. These goods are identical.

24. The terms *Fixing devices of metal; Screws of metal* in the applicant’s specification are encompassed by the term *small items of metal hardware* in the opponent’s specification. These goods are identical on the principle outlined in *Meric*.

25. The term *Metal materials for construction* in the application includes building metal material which can be used for the construction of *decking and deck boards*. When comparing these goods with the opponent’s *metal hardware and small items of metal hardware and buckles and fasteners of metal, precious metals or aluminium*, the

nature of the goods can be considered the same (goods of metal). Further the goods target the same users (traders or those who wish to build their own decking), are likely to be produced by the same companies, coincide in trade channels and are complementary in the sense explained by the opponent. These goods are similar to a medium degree.

26. Similar considerations apply to the terms *buildings of metal* and *modular building units (Metal -)*. These goods are likely to be used together with the opponent's *metal hardware and small items of metal hardware and buckles and fasteners of metal, precious metals or aluminium in the assembly, mounting and fixing of decking and deck boards* so that one good 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. These goods are similar to a medium degree.

27. Finally, *common metals and their alloys*. Had the applicant listed common metals and their alloys without the limitation "*all of the above-mentioned goods being intended for the assembly, mounting and fixing of decking and deck boards*", I would have been inclined to find that the term *common metals and their alloys* (a) refers to unprocessed or semi-processed metals and alloys for unspecified use and (b) cannot be considered similar to the opponent's finished products of metal on the basis that raw materials subject to a transformation process are essentially different from the finished products that incorporate, or are covered by, those raw materials, in terms of nature, aim and intended purpose.¹ However, the limitation "*all of the above-mentioned goods being intended for the assembly, mounting and fixing of decking and deck boards*" means that the term *common metals and their alloys* in the application cannot refer to raw material but must be interpreted as referring to finished goods which are for assembly, mounting and fixing of decking and deck boards and are intended for direct purchase by the final consumer. These goods are similar to a medium degree.

¹ T-270/10, KARRA

Average consumer

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

29. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

30. The average consumer of the competing goods is a member of the general public or a trade person.

31. The average consumer is likely to obtain the goods through self-selection from a shelf, catalogue or online equivalent. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may be an aural aspect to the selection process, such as word-of-mouth recommendations or discussions with retail staff. When selecting the goods, the average consumer will pay attention to factors such as costs, compatibility and safety concerns. These factors suggest that the average consumer is likely to pay a medium degree of attention when selecting the products.

Comparison of marks

32. 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.”

33. 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. The respective marks are shown below:

The applicant's mark	The opponent's earlier mark
COBRA FASTENER	COBRA

34. The opponent's mark consists of the word 'COBRA' presented in capital letters in a standard font. As there are no other elements in the mark, the overall impression lies in the word itself.

35. The applicant's mark is in word-only format and consists of the two words 'COBRA' and 'FASTENER'. Collins English dictionary defines 'FASTENER' as “a device such

as a button, zipper, or small hook that fastens something, especially clothing". The goods covered by the application covers *Fasteners of metal [small items of hardware]* for which the word 'FASTENER' is clearly descriptive. However, even in relation to the other goods covered by the specification, namely *Common metals and their alloys; Buildings of metal; Metal materials for construction; Modular building units (Metal -); Metal hardware; Fixing devices of metal; Screws of metal*, the word 'FASTENER' has descriptive connotations, because the goods are all intended for the assembly, mounting and fixing of decking and deck boards. Consequently, the average consumer will understand the word 'FASTENER' as a reference to the fact that the goods need to be 'fastened' that is to say joined, attached, and/or assembled together. Given its descriptive connotations and the fact that it is placed at the end of the mark, the word 'FASTENER' is less distinctive than the word 'COBRA' which is the distinctive and dominant component of the mark.

36. Visually and aurally, the marks coincide in the element 'COBRA' which is the only element of the opponent's mark and is included as a visually identifiable element at the beginning of the applicant's mark. They differ in the last element (and its pronunciation) of the applicant's mark, the word 'FASTENER'. Whilst the word 'FASTENER' is longer than the shared element 'COBRA', the latter is likely to attract the consumer's attention more because the initial part of a mark tends to be more focused upon. Therefore, the marks are visually and aurally similar to a medium degree.

37. Conceptually, the word 'COBRA' refers to as a specific kind of snake. There is a conceptual link between the marks to the extent that both marks will be associated with the same kind of the snake, i.e. a cobra. The applicant's mark contains the additional element 'FASTENER' however, this element will be understood as referring to a characteristic of the goods (see above). It follows that (a) the words 'COBRA' and 'FASTENER' will not be perceived as a logical and conceptual unit, (b) the meaning of the word 'COBRA' - which retains an independent distinctive role within the applicant's mark - is the same in both marks and (c) any additional concept conveyed by the word 'FASTENER' is descriptive and will be perceived as an element of limited trade mark significance. The marks are conceptually similar to a high degree.

Distinctive character of earlier mark

38. 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).”

39. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

40. The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation. Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness *per se*. The word ‘COBRA’ has no

descriptive or allusive qualities in relation to the goods at issue. Therefore, I find that that the earlier mark enjoys a medium level of inherent distinctive character.

Likelihood of confusion

41. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

42. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

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

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).”

43. Earlier in my decision I found that the goods are identical or similar to a medium degree. The average consumer will select the goods visually – although I do not discount aural considerations – with a medium degree of attention. Furthermore, the marks display a medium degree of visual and aural similarity and a high degree of conceptual similarity on account of the coincidence in the distinctive word element ‘COBRA’. The earlier mark is distinctive to a medium degree.

44. Taking all of the above into account, my conclusion is that there is a likelihood of both direct or indirect confusion because the differences between the signs are confined to a non-distinctive or secondary element of the mark, namely the word ‘FASTENER’ which will be understood as descriptive. Indeed, it is highly conceivable that the relevant consumers will either overlook the word ‘FASTENER’ by giving it no trade mark significance or perceive the contested mark as a sub-brand and/or a variation of the earlier mark. There is a likelihood of confusion.

OUTCOME

45. The opposition is successful. The application will be refused.

COSTS

46. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in fast-track opposition proceedings are governed by Tribunal Practice Notice 2 of 2015. In the circumstances, I award the opponent the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing and filing a TM7:	£250
Preparing submissions in lieu:	£250
Official fees:	£100
Total	£600

47. I therefore order FORESTIA to pay AUSTRIALPIN GmbH the sum of £600. 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 1st day of September 2022

**Teresa Perks
For the Registrar**