

O-348-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3056247
BY INDUSTRIAL TOOLING PRODUCTS (UK) LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 7:**



AND

**OPPOSITION THERETO (NO. 402754) BY
INDUSTRIA DE TURBO PROPULSORES S.A.**

Background and pleadings

1. The above trade mark was filed by Industrial Tooling Products (UK) Limited (“the applicant”) on 20 May 2014. It was published for opposition purposes on 27 June 2014. Registration of the mark is opposed by Industria De Turbo Propulsores S.A. (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on Community trade mark (“CTM”) registration 3975893, which was filed on 6 August 2004 and registered on 29 November 2005. In view of all this, this case boils down to an alleged conflict between the following marks and goods:

Applied for mark	Earlier mark
 <p>Class 7: Cemented carbide cutting tools;Blades for power tools;Extension bars for power tools;Burrs [power tools];Countersinks [power tools];End mills [power tools];Adapters for machine tools;Annular hole cutters [machine tools];Auger bits for use with powered tools;Awls [powered tools];Blades for powered tools;Boring tools (machine-) with slides;Boring tools [machine tools];Boring tools operated by machines;Broaches [machine tools];Broaching tools;Carbide burs [machine tools];Cemented carbide tips [tools for machines];Cemented carbide tools [machine];Ceramic tips [tools for machines];Ceramic tools for machines;Circle cutting tools for use with machines;Core bits [machine tools];Countersinking tools for machines;Countersinks being machine tools;Cutters being machine tools;Cutting inserts for machine tools;Cutting tools [machine] in the form of drill bits;Cutting tools [machine] in the form of end mills;Cutting tools [machine] made of sintered materials based on nitrides;Cutting tools being parts of machines;Cutting tools being power-operated;Cutting tools for use in powered hand-held tools;Diamond cutting tools for machines;Discs for cutting for use with power tools;Drill bits</p>	 <p>Class 7: Machines and machine tools.</p> <p>nb: The earlier mark is registered for a wider range of goods (and services), but the goods listed above are the only ones relied upon by the opponent in these proceedings.</p>

for rotary power tools;Drilling tools for use with machines;Drills for machine tools;Electric power tools; all the aforesaid tools to be used for metalworking and woodworking.	
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2. Given its date of filing, the opponent's mark constitutes an earlier mark in accordance with section 6 of the Act. I note that the earlier mark was registered more than five years before the date on which the applicant's mark was published. This means that the earlier mark is subject to the proof of use provisions contained in section 6A of the Act and would, ordinarily, mean that the opponent is required to prove that it has made genuine use of its mark. If the opponent has not made genuine use then it cannot rely on the earlier mark at all. If the opponent has made only partial use, it can only rely on the goods partially used. In its statement of case the opponent made a statement of use claiming that it had made genuine use of its mark in relation to all the goods upon which it relies.

3. The applicant filed a counterstatement denying the ground of opposition. Despite the earlier mark being subject to the proof of use requirements, the applicant did not ask the opponent to provide proof of use. As I will come on to, this has a significant impact upon these proceedings.

4. The applicant is self represented. The opponent is represented by Urquhart-Dykes & Lord LLP. Both sides filed written submissions rather than evidence of fact. I will take the submissions into account when determining the various matters that need to be determined. Neither side requested a hearing or filed written submissions in lieu of attendance.

Section 5(2)(b)

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

“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.”

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

7. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

8. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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.”

9. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

10. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

11. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... 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) (IPTRANSLATOR)* [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.”

12. Even if goods are not worded identically, they can still be considered identical if one term falls within the ambit of another (or vice versa), as per the judgment in *Gérard Meric v OHIM*, Case T-133/05 where the General Court stated that:

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

13. In its written submissions, the opponent states that the applicant’s goods fall within the ambit of its goods (machines and machine tools) and, so, they must be considered identical as per the *Gerard Meric* case. If they are not identical then the

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

opponent submits that they are similar due to the existence of a clear complementary relationship. In its written submissions, the applicant states that there is “clear separation of the opponent’s trade mark classification claims made by the definitive nature of its entry in the register”. It is not altogether clear from this statement what the applicant’s argument really is, but its position is clearer when one looks at what it said in its counterstatement:

“The Applicant seeks registration of the mark for their products and business in the wholesale distribution of tooling (drill bits, saw blades, router cutters) to retailers in the woodworking and upvc/aluminium window manufacturing industries which is in no way related to the Opponent’s industry of Industrial and Aeronautical manufacture/service/support (aerospace engines) and is not available through the same markets / trade channels.

The alleged similarity in this case is not justified as both parties operate in totally separate industries, albeit both defined by the scope of the IPO’s Class 7: Machines and Machine Tools, being a very wide classification.”

14. There are two points to make in relation to the applicant’s submission. Firstly, the fact that the opponent may operate in the aeronautical industry is not strictly pertinent because the goods it relies on have no form of limitation to that field. Whilst two terms listed later in its specification are limited, it remains the case that the goods on which it relies (and also the bulk of its other goods) have no form of limitation and it would be wrong to apply a limitation simply because other goods are limited.

15. The second point ties to the first. The applicant appears to appreciate that the goods relied on by the opponent are wide in scope, but considers reliance on them to be unjustified. However, despite this, it remains the fact the applicant did not ask the opponent to provide proof of use. The applicant ticked “NO” in response to the question “Do you want the opponent to provide proof of use?” The impact of this is that the applicant has neither denied nor not admitted the opponent’s statement of use, so meaning that the opponent was not required to file evidence to support its statement of use³. Consequently, the opponent is able to rely on its earlier mark for the goods on which it relies. Whilst I appreciate that the applicant is without legal representation, it should nevertheless have been left in little doubt as to the situation given that the notice of counterstatement includes the following warning:

“If you do not request “proof of use” the opponent’s statement of use will be accepted with the consequence that the earlier mark(s) may be relied upon for all the goods/services identified in the statement of use.”

16. The opponent is, therefore, able to rely on the term “machines and machine tools” without limitation.

17. These are the goods for which the applicant seeks registration:

Cemented carbide cutting tools; Blades for power tools; Extension bars for power tools; Burrs [power tools]; Countersinks [power tools]; End mills [power

³ As per rule 20(2)(c) of the Trade Marks Rules 2008, as amended.

tools]; Adapters for machine tools; Annular hole cutters [machine tools]; Auger bits for use with powered tools; Awls [powered tools]; Blades for powered tools; Boring tools (machine-) with slides; Boring tools [machine tools]; Boring tools operated by machines; Broaches [machine tools]; Broaching tools; Carbide burs [machine tools]; Cemented carbide tips [tools for machines]; Cemented carbide tools [machine]; Ceramic tips [tools for machines]; Ceramic tools for machines; Circle cutting tools for use with machines; Core bits [machine tools]; Countersinking tools for machines; Countersinks being machine tools; Cutters being machine tools; Cutting inserts for machine tools; Cutting tools [machine] in the form of drill bits; Cutting tools [machine] in the form of end mills; Cutting tools [machine] made of sintered materials based on nitrides; Cutting tools being parts of machines; Cutting tools being power-operated; Cutting tools for use in powered hand-held tools; Diamond cutting tools for machines; Discs for cutting for use with power tools; Drill bits for rotary power tools; Drilling tools for use with machines; Drills for machine tools; Electric power tools; all the aforesaid tools to be used for metalworking and woodworking.

18. A large number of the above goods are specifically identified as machine tools. Even when not so identified, it is clear that they could be used in conjunction with some form of machine. I agree with the opponent's submission that the resulting situation is consistent with the judgment in *Gérard Meric* which, as stated earlier, states that when comparing goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play. The applied for goods fall within the ambit of "machines and machine tools" and on this basis they must be considered identical.

19. In coming to this finding I have borne in mind that in the *IP Translator* case the Court of Justice of the European Union ("CJEU") called for clarity in specifications. Whilst the term machines and machines tools can be said to lack clarity on the basis of its breadth, in circumstances where it is simply a question of whether X falls within the ambit of Y then I consider it appropriate to give the earlier mark the protection for which it is registered. Of course, and as already stated, had the applicant put the opponent to proof of use then the position may have been different. That the applicant did not put the opponent to proof is down to it and is not something that can be overlooked now.

20. One final point is that even if some of the applied for goods are not, strictly speaking, machine tools, then I agree with the opponent that the goods are highly similar to machine tools (and also machines). I also note that the applicant has offered to add a limitation to its goods excluding those used in the aeronautic field; this does not assist as the goods will still be considered identical (the relied on goods of the earlier mark not being limited) given the assessments I have made.

Average consumer and the purchasing act

21. 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. 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.”

22. The applied for goods consist of tooling for use in metalworking and woodworking. This is the perspective from which the opponent’s goods must be considered because I have found identical goods to be in play. Whilst these are not everyday consumer items, they could still be purchased by members of the general public for undertaking projects and hobbies at home. The goods could also be purchased by specialist tradespeople. Either way, the goods are unlikely to be frequent purchases and attention will be paid to the precise requirements of the tooling. This means that there is likely to be an above average level of care (at least for some of the goods), albeit, not of the very highest level. The goods may be selected from the shelves of specialist stores or DIY stores, from websites, perused in brochures etc. It may also be that the customer requests the goods aurally at a trade counter or, indeed, via an assistant in store. Whilst there may be a slight skew towards the purchase being more visual than aural, the aural impact of the marks is still important to consider in the overall assessment.

Comparison of marks

23. 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.”

24. 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 marks to be compared are:



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25. The applied for mark is made up of the letters “iTP”, the letters UK, and the get-up (including the colour contrast) applied to those components. None are truly separate elements performing independent roles, but, nevertheless, I consider the letters iTP to have the greatest relative weight in the overall impression. The get-up is far from negligible as it gives the mark a particular visual impact, so this aspect still plays a role. The letters UK have least relative weight, although, again, given that they blend into the mark as a whole, they will not be ignored in my assessment. The opponent’s mark has two principle elements, the letters ITP and the circular device element. I consider that they make a roughly equal contribution to the overall impression of the mark.

26. Visually, the fact that both marks contain the letters ITP/iTP provides some similarity. However, there are a number of visual differences, notably, as the applicant points out, the absence/addition of the circular device element. There are other differences including the lower case “i” in the applicant’s mark (the I being uppercase in the opponent’s mark), the get-up of the applicant’s mark, and the addition of UK. Having regard to all the similarities and differences, together with my assessment of the overall impression of the respective marks, I consider there to be a medium level of visual similarity.

27. Aurally, the opponent’s mark will be articulated as EYE-TEA-PEA. In terms of the applied for mark, some average consumers will articulate it in an identical way as s/he may drop the UK element. However, even if this were not so, the addition of the extra articulation YOU-KAY at the end of the mark, and bearing in mind that this additional element has least relative weight in its overall impression, means, in my view, that the marks are still aurally similar to a reasonably high degree.

28. Conceptually, the primary significance of both marks will be that of the letters themselves, albeit, purely as a letter combination with no meaning beyond being letters. There is a high degree of conceptual similarity on this basis.

Distinctive character of the earlier marks

29 The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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).”

30. No evidence has been filed by the opponent so I have only the inherent distinctiveness of the earlier mark to consider. The letters ITP have no specific meaning (beyond being letters). However, letters are often used in various trades as acronyms for one thing or another. The letters would not strike the average consumer as highly distinctive, but nor do I consider it appropriate to pitch distinctiveness at only a low level. I come to the view that the ITP element is averagely distinctive. It could be said that the device element adds to the inherent distinctiveness of the mark as a whole, however, whilst this may be so, this does not increase the likelihood of confusion because it is the distinctiveness of the common element that matters. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C., sitting as the Appointed Person, pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

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

31. For the purposes of my assessment, the relevant distinctiveness (of the point of similarity) is, thus, of an average level.

Likelihood of confusion

32. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

33. There are two types of relevant confusion to consider. Direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods come from the same, or related, trade source). The better case here is indirect confusion because the visual impact of the circular device in the earlier mark, together with the degree of care and attention being used, means that it is unlikely that one mark will be directly mistaken for the other, even taking into account the principle of imperfect recollection, and even bearing in mind that the goods are identical.

34. In terms of indirect confusion, this was summed up by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted 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).”

35. I bear in mind that the three categories of indirect confusion identified by Mr Purvis QC are just illustrative – he stated that indirect confusion “tends” to fall in one of them. The categories should not, therefore, be considered a straightjacket.

36. That there is identity between the goods is an important point because a lesser degree of similarity between the marks may be offset by a greater degree of similarity (in this case identity) between the goods. In its submissions the applicant highlights the various differences between the marks, particularly the circular device in the opponent’s mark. However, even if this difference were noticed and recalled, I come to the view that the common use of the letters ITP/iTP will signify to the average consumer that the identical goods in play are the responsibility of the same or an economically linked undertaking. The different casing (and the other differences) may be overlooked due to imperfect recollection. The average consumer will believe that for the identical goods in play, no one else would use the letters ITP other than the opponent. Put another way, the letter commonality will not be put down to a co-incidental use, but will be put down to shared economic origin. The applied for mark will be seen as some form of brand variant of the earlier mark. **There is a likelihood of indirect confusion. The opposition succeeds.**

37. There are two points submitted by the applicant that I have not yet commented upon. The first is that the earlier mark is a CTM and, thus, will be used internationally in the Community. The second is that the applicant claims to have been trading itself for 30 years in the UK. Neither of these points helps. A CTM is as valid in the UK as a national mark is. In terms of the prior use of the applicant, no evidence has been provided to show this and, in any event, prior use (as opposed to honest concurrent use) is not a defence under section 5(2)(b)⁴. Even if there had been honest concurrent use, a defence on this basis would only arise in the most exceptional of circumstances.

Costs

38. The opponent has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

Official fee - £100

Preparing a statement and considering the other side’s statement - £300

Written submissions (filed at the evidence stage) – £400

Total - £800

⁴ For more information on this, see Tribunal Practice Notice 4/2009.

39. I therefore order Industrial Tooling Products (UK) Limited to pay Industria De Turbo Propulsores S.A. the sum of £800. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of July 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**