

**O-674-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3274554  
BY QUALTEX UK LTD  
TO REGISTER THE FOLLOWING TRADE MARK:**

**ARHAUS**

**IN CLASSES 7, 8, 9, 11 AND 35**

**AND**

**OPPOSITION THERETO UNDER NO. 411667  
BY DOMU BRANDS LIMITED**

## Background and pleadings

1. On 1 December 2017, Qualtex UK Ltd (“the applicant”) filed trade mark application number 3274554 for the mark **ARHAUS** for goods and services in classes 7, 8, 9, 11 and 35. As will be seen, the goods and services for which registration is sought are extensive (and will be detailed later). The application was published for opposition purposes on 15 December 2017.

2. Registration of the mark is opposed by Domu Brands Limited (“the opponent”). Its sole ground of opposition is under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying on EU Trade mark (“EUTM”) registration 11607413, which was filed on 26 February 2013 and registered on 22 July 2013. The registration is for the mark **VonHaus**. It is relied upon in relation to goods and services covered by the registration in classes 6, 7, 8, 9, 11, 12, 14, 16, 18, 20, 21, 22 and 24 (as set out in the annex to this decision).

3. By virtue of having a filing date before that of the applied for mark, the opponent’s EUTM qualifies under section 6 of the Act as an earlier mark for the purpose of these proceedings. As the earlier mark completed its registration procedure less than five years before the publication of the applied for mark, it is not subject to the proof of use provisions set out in section 6A of the Act. The consequence of this is that the opponent is entitled to rely upon all of the goods covered by the earlier mark as identified in its statement of case as the basis for its opposition.

4. The opponent claims that the applied for mark is similar to its earlier mark and is for identical or highly similar goods and services, which it says will lead to a likelihood of confusion.

5. The applicant filed a counterstatement in which it accepts that the goods in the application are identical or similar to those covered by the earlier mark but denies that its class 35 services are similar to the opponent’s goods. The applicant further denies that the marks are similar or denies that there exists a likelihood of confusion. Where it is accepted that the goods are similar, the applicant states that the reason why there

is no likelihood of confusion is principally down to the differences between the respective marks.

6. The opponent is represented by Wilson Gunn. The applicant is represented by Osborne Clarke LLP. Aside from the respective statement of grounds and counterstatement, neither party filed written submissions or evidence. Neither party chose to be heard, nor did they file written submissions in lieu of a hearing.

### **Section 5(2)(b)**

7. 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.”

### **The principles**

8. The following principles are gleaned from the judgment 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 C3/03, *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.

- The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

- 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;
- The average consumer normally perceives the mark as a whole and does not proceed to analyse its various details;
- 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;
- Nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- 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;
- 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;
- 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;
- Mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

### **Comparison of goods and services**

9. In its notice of opposition, the opponent provides a (non-exhaustive) table for the purposes of comparing the goods and services. I will take this into account when I come to make the assessment. Beyond accepting similarity between the goods, and denying similarity between the applied for services and the earlier mark's goods (because it does not always follow that goods and their retail are similar), it makes no detailed submissions.

10. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*<sup>1</sup> that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

"29. In addition, the goods can be considered as identical when the goods designated by the earlier trade 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."

11. *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*<sup>2</sup> is also relevant. The CJEU stated at paragraph 23 of its judgment:

---

<sup>1</sup> Case T-133/05

<sup>2</sup> Case C-39/97

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

12. Guidance on this issue has also come from Jacob J in the *Treat* case<sup>3</sup>, 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;
- (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.

13. In relation to assessing whether the goods/services may be regarded as “complementary”, I refer to *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*<sup>4</sup> where it was stated that complementarity means that:

---

<sup>3</sup> [1996] R.P.C 281

<sup>4</sup> Case T-325/06. See also *Sanco SA v OHIM*, Case T-249/11.

“...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.”

## CLASS 7

14. The applicant seeks registration for the following goods in class 7:

**Machines and machine tools for kitchen, domestic and household use; machines and machine tools for use in cleaning; cleaning machines and apparatus; industrial and domestic cleaning machines and apparatus; industrial and domestic floor cleaning machines and apparatus; hard floor cleaning machines and apparatus; dry cleaning machines and apparatus for floors and carpets; machines and apparatus for applying cleaning preparations to carpets and floors; dust removing installations for cleaning purposes; vacuum cleaning machines and apparatus; vacuum cleaners; cleaning equipment and/or apparatus being parts of machines, for cleaning; spare parts and accessories for vacuum cleaners, including brushes, hoses, suction nozzles, electric fan units and filters; hand held vacuum cleaners; cordless vacuum cleaners; replacement bags of paper for vacuum cleaners; vacuum cleaner bags of paper, card and cardboard; vacuum control valves [parts of machines]; vacuum control valves [parts of motors]; vacuum packing machines; vacuum pump installations; robotic vacuum cleaners; apparatus for separating particles from an airflow; carbon brushes for electrical machines; carbon brushes for starter motors; floor tools for vacuum cleaners; electric hand tools; electric welding apparatus; brackets (bearing -) for machines; electric motors, and their parts, not for land vehicles; switched-reluctance motors; central vacuum cleaning installations; separators; separation apparatus for use in vacuum cleaners and other cleaning apparatus; steam cleaners [machines]; steam cleaning machines for carpets, garments, clothes, curtains; machines for carpet shampooing; wet-and-dry cleaning machines; floor polishers; pressure washers; electric gardening machines and tools; garden vacuums;**

lawnmowers; lawn and hedge trimmers; garden shredders; garden water pumps; parts and fittings for all the aforesaid goods; **washing machines, spin driers, spinning machines, tumble driers, combined washing machines and tumble driers, dishwashers, ironing machines**, handheld irons; steam stations; **drying machines; domestic machines for use in the processing or preparation of foodstuffs; electric laundry machines, apparatus and tools; electric kitchen machines**, fruit presses; electric juicers; **filtering machines; rope making machines**; apparatus and instruments for domestic use for peeling, cutting, slicing, grating, rasping, shredding and for chopping; **electric food preparation machines; machines for making pasta**; electric food mixers, blenders, liquidizers, crushers, food processors, food slicers and shredders, electric whisks, electric salad drainers, **coffee grinding machines**, electric can openers, electric knives and knife sharpeners, **beverage making machines; sharpening machines; aerated water making machines; garbage disposals; waste compacting machines**; electric tools for bricklaying and plastering; **drilling machines; drill chucks [parts of machines]; drilling bits [parts of machines]** mechanically operated hand-held tools; agricultural implements other than hand-operated; power tools; power tools forming attachments for vacuum cleaners; sanders; electric grinders; jigsaws; electric saws; spray guns; **spraying machines**; spraying apparatus for dispensing disinfectants and cleaning solutions; **fertilizing machines; knitting machines; sewing machines; blowing machines**; electric hammers; **hair dressing machines; hair cutting machines for animals**; electric window openers and closers; vehicle washing and/or polishing installations; aerating pumps for aquaria; air condensers; **pumps [machines]; air pumps; electric wax polishing machines; rinsing machines; woodworking machines**; incubators for eggs; **automatic vending machines**; robots; **bottle sealing and capping machines; boiler scale collectors; shearing machines for animals; picture making machines; cartridges for filtering machines; door openers and closers [machines]; break rings for casters**; fuel and gasoline dispensing pumps for service stations; parts and fittings for all the aforesaid goods.

15. The opponent's specification is also a broad one, I note that it includes:

Machine and machine tools for kitchen, domestic and household use (and their parts and fittings)

16. The consequence of the above is that everything that I have emboldened in the applied for goods are identical because they are undoubtedly machines of one type or another, or are parts/fittings for them.

17. The opponent's specification also includes:

Floor cleaning apparatus and machines; vacuum cleaners; (and their parts and fittings)

18. The consequence of the above is that everything I have underlined (some of which is also emboldened) in the applied for specification is identical because they are floor cleaning apparatus (or could be), or are parts/fittings for them.

19. Of the remaining goods in class 7, I note that the opponent's specification covers: "electrical apparatus and machines for kitchen and laundry use" which therefore encompasses, and is consequently identical to:

Handheld irons; steam stations; fruit presses; electric juicers; apparatus and instruments for domestic use for peeling, cutting, slicing, grating, rasping, shredding and for chopping; electric food mixers, blenders, liquidizers, crushers, food processors, food slicers and shredders, electric whisks, electric salad drainers, electric can openers, electric knives and knife sharpeners

20. The opponent's mark also covers power tools which therefore encompasses (or else is highly similar to), and is consequently identical, to:

Electric hand tools; electric tools for bricklaying and plastering; mechanically operated hand-held tools; agricultural implements other than hand-operated; power tools; sanders; electric grinders; jigsaws; electric saws; electric hammers; lawn and hedge trimmers

21. The applied for term “fuel and gasoline dispensing pumps for service stations” has a direct counterpart in the opponent’s specification and is, therefore, identical. The same applies to “aerating pumps for aquaria”, “air condensers”, “vehicle washing and/or polishing installations”, “spray guns; spraying apparatus for dispensing disinfectants and cleaning solutions”, “lawnmowers” and “garden vacuums”.

22. The applied for “pressure washers” falls within the ambit of “vehicle washing and/or polishing installations” and is consequently identical.

23. The applied for “electric welding apparatus” falls within the ambit of the opponent’s power tools and is consequently identical. If it is wrong to have found identity on the inclusion basis, I would still consider the goods to be highly similar on account of their similar function, trade channels, uses and users to other types of power tools.

24. The applied for “robots” are types of machines (covered by the opponent’s mark) and are identical on that basis. A robotic vacuum cleaner (covered by the opponent’s specification) is essentially a type of robot (specifically to conduct vacuum cleaning) and is therefore identical to that term also, or else they must be highly similar.

25. The opponent’s specification covers “shredders (machines)” which could be for use in the garden environment and which is consequently identical to “garden shredders”.

26. I consider “electric window openers and closers” and “incubators for eggs” to be types of machines (in the case of incubators for eggs, this will be particularly so for such goods used on an industrial scale). Given that the opponent’s mark covers machines, the goods are identical. The opponent’s mark also covers motors, which electric window openers/closers essentially are, so there is in any event identity (or high similarity) on this basis also.

27. The final term is “garden water pumps” which I consider to be highly similar to “aerating pumps for aquaria” covered by the earlier mark. This is because garden pumps could well be used in ponds and they serve a very similar purpose, will have a similar nature, methods of use and trade channels to the opponent’s goods.

## CLASS 8

28. The applicant seeks registration for the following goods in class 8:

**Hand tools and implements (hand operated); gardening tools (hand operated); hand operated equipment used in agriculture, horticulture and forestry; cutting, drilling, grinding and sharpening hand tools; fastening and joining tools; lifting tools and implements; crow bars; pestle and mortar for pounding; mastic gun; socket set; hand drills, screwdrivers, axes, saws and saw blades; hoes, diggers, garden tools, shears, pliers, clamps, chisels, scissors, rakes, picks, hammers, hand drills, punches; riveters; trowels; tongs; files; planers; grinders; shovels; spades; scythes; knives (other than cutlery); hand tools for bricklaying and plastering; non-electric can openers; irons [non-electric hand tools]; perforating tools [hand tools]; non-electric pizza cutters; scrapers [hand tools]; sharpening instruments; fire tending implements; hand pumps; steam irons; abrading instruments; food preparation implements, kitchen knives; food slicers, choppers and shredders; food processor [hand operated]; cutlery; disposable tableware (cutlery) made of plastics; boxes for cutlery [fitted]; steak knives; razor blades; cassettes for razor blades; razor blade dispensers; safety razor blades (Dispensers for -); electric shavers; beard clippers; shaving cases; razor cases; electric hair straighteners; hair cutting and removal implements; hair styling appliances; curling tongs; hair clippers for personal use; hair-removing tweezers; nail files; nail clippers; manicure tools; pedicure tools; parts and fittings for all the aforesaid goods.**

29. The opponent relies on goods in class 8 as follows:

Hand tools and implements; hand operated equipment used in agriculture, horticulture and forestry, for the construction of machines, apparatus and vehicles, and for structural engineering; cutlery; shears and knives for garden use; tools for planting flowers (hand-operated gardening tools); tongs; shovels; spades; scythes; saws; hand pumps; steam irons.

30. All of the goods I have emboldened in the applied for specification fall within one or other of the above terms or have identical counterparts.

31. In relation to “electric hair straighteners; hair cutting and removal implements; hair styling appliances; curling tongs; hair clippers for personal use” the opponent points towards its class 7 goods, I assume its hair cutting and hairdressing machines. I agree that such goods have a similar purpose, channels of trade and nature, and will either be in competition or are complementary. The goods are highly similar. In relation to “razor blades; cassettes for razor blades; razor blade dispensers; safety razor blades (Dispensers for -); electric shavers; beard clippers; shaving cases; razor cases” the same goods in the earlier mark are highlighted, but I consider there is a less strong link here, but the goods are still similar to a medium degree. In relation to “hair-removing tweezers; nail files; nail clippers; manicure tools; pedicure tools” the relationship is less again; any similarity here is of a very low level.

32. In relation to: “pestle and mortar for pounding; non-electric can openers; non-electric pizza cutters; food processor [hand operated] and fire tending implements” the opponent relies on its hand tools. Whilst I have some reservations about how similar the goods are, the applicant has accepted similarity so it is suffice to say that there is at least a low degree of similarity.

33. In relation to: “food preparation implements, kitchen knives; food slicers, choppers and shredders; steak knives” the same goods are relied upon with the same resultant level of similarity. However, I additionally note that these goods are also similar to at least a medium degree to the opponent’s cutlery, which would include knives. Cutlery is also similar to the applied for term “boxes for cutlery [fitted]” given the clear complementary relationship in play.

## CLASS 9

34. The applicant seeks registration for the following goods in class 9:

**Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and**

teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; junction boxes; fuses; fuse boxes; capacitance boxes; terminal boxes; control boxes [electric]; converters; transformers; electrical power supplies; **apparatus and instruments for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; memory cards and memory card readers; cassettes**; electrical armatures; armatures for use in electrical apparatus; batteries; mains chargers; battery chargers; battery cases; apparatus for connecting and charging portable and handheld electronic devices; plugs, sockets and other contacts [electrical connections]; plugboards; plug connectors and adapters; **audio connectors**; electrical adaptors; **audio leads**; electrical leads; electrical extension leads; electrical wires and cables; pattresses; signal splitters; alarms and warning equipment; **headphones and earphones; telephones; videophones; smart phones; microphones; radios; remote controls; portable and handheld electronic devices for transmitting, storing, manipulating, recording, and reviewing text, images, audio, video and data, including via global computer networks, wireless networks, and electronic communications networks and electronic and mechanical parts and fittings therefor; audio players; apparatus for televisions; televisions; set-top boxes; transmitting and receiving apparatus for television broadcasting**; access control systems and apparatus; electronic monitoring and control apparatus; lighting monitoring and control apparatus; boiler monitoring and control apparatus; security monitoring and control apparatus; network monitoring and controlling apparatus; temperature monitoring and controlling apparatus; **measuring apparatus; tape measures; rules [measuring equipment]; kitchen scales**; alarm apparatus, alarm monitoring and control apparatus; electronic alarms; electronic protection equipment; electronic locking instruments; **closed-circuit television (CCTV); monitors; cameras; camera cases; camera lenses; camera stands**; fire-extinguishing apparatus; **calculating machines, data processing equipment; computers; computer software; computer hardware; computer screens; computer peripherals; computer network hubs, switches and routers; blank digital storage media; blank electronic**

**storage media; blank smart cards; data storage apparatus; DVD players and drives; USB cables, hardware, hubs and adapters; adapter cards; WiFi communication apparatus; WiFi locators, port replicators, extenders; smart cards and smart cartridges; data cartridges; plug-in cartridges [electronic]; portable hard disk drives; touch screens; touch screen pens; electrical sensors; integrated circuits; electronic circuit boards; circuit testers; power cables; power lines; power line protectors and conditioners; power line transmission apparatus; docking stations; computer stands; printers; printer stands; printer components and accessories; speakers; wireless speakers; digital electronic components and accessories, namely, holsters, carrying cases, and skins [fitted plastic films]; covers and carry cases for computers, telephones, wearable telecommunications devices and electric book readers; electronic key fobs and tags; MP3 players; MP4 players; portable media players; video players; cases and covers for digital media players; global positioning system (GPS) devices; wearable telecommunication devices; smartbands; smart bracelets; smartwatches; electronic book readers; dust masks; egg timers; TV stands; wall-mounted products for televisions and other audio visual apparatus; head-mounted video display apparatus; parts and fittings for all the aforesaid goods.**

35. The opponent's specification covers a number of broad terms, including:

Apparatus for recording, transmission, reception, processing or reproduction of sound, images and/or data; nautical, photographic, cinematographic, measuring and photocopying apparatus and instruments; electronic apparatus and instruments, all for processing, logging, storing, transmission, reception, display and/or printout of data; computers; computer hardware; computer software; magnetic data carriers; data processing equipment;

36. One way or the other, the terms I have emboldened in the applicant's specification are encompassed within the opponent's terms, or else are highly similar. Furthermore, the terms I have underlined either have direct counterparts, or are encompassed by terms within the respective specifications and are also identical.

37. That leaves a few categories of goods that I group together as follows:

Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; junction boxes; fuses; fuse boxes; capacitance boxes; terminal boxes; control boxes [electric]; converters; transformers; electrical power supplies; electrical armatures; armatures for use in electrical apparatus; plugs, sockets and other contacts [electrical connections]; plugboards; plug connectors and adapters; electrical adaptors; electrical leads; electrical extension leads; electrical wires and cables; pattresses; signal splitters; integrated circuits; electronic circuit boards; circuit testers; power cables; power lines; power line protectors and conditioners; power line transmission apparatus

38. The above terms are all types of electrical apparatus used, essentially, as part of a wiring system for home or industrial premises. I consider there to be at least a medium degree of similarity with goods for the transmission of data etc as it is now the case that data can be passed through electrical wiring. This is therefore likely to create some similarity in purpose and channels of trade and some degree of both competition and complementarity, depending on the goods involved.

39. In relation to “battery cases”, these are similar to at least a medium degree to the opponent’s batteries, due, at least, to their channels of trade and complementarity.

40. In relation to: “access control systems and apparatus; electronic protection equipment; electronic locking instruments; electrical sensors” these, in my view, are highly similar to the opponent’s alarms as they serve a similar purpose, or are complementary, and will be sold through the same trade channels.

41. There is nothing in the opponent’s class 9 specification that gets close to dust masks, however, in its table the opponent refers to its goods in classes 7 and 8 (presumably its tools) as being similar. The applicant has accepted similarity. In my view there is a complementary relationship with such goods although, without evidence, it is difficult to assess how heightened this relationship is. I find there to be a low degree of similarity here.

42. Again, there is nothing in the opponent's class 9 specification that gets close to the opponent's "electronic key fobs and tags". The opponent points towards its class 6 specification which includes keys. This may give rise to a degree of complementarity and sharing of trade channels, however, I again place the degree of similarity at a low level.

43. Finally, I deal with the various control apparatus which tie to a number of pieces of monitoring apparatus e.g. "boiler monitoring and control apparatus". I have found the monitoring aspect to be identical because the opponent's specification covers monitoring apparatus and equipment. The control apparatus is clearly an adjunct to the respective monitoring equipment (which, as covered by the opponent's mark, encompasses all the types covered by the applicant's specification), so there is a clear complementary relationship, they all push towards the same purpose and they will be sold through the same trade channels.

#### CLASS 11

44. The applicant seeks registration for the following goods in class 11:

Apparatus, installations and equipment for lighting, heating, steam generating; cooking, grilling, drying, ventilating, filtering, airing, water supply and sanitary purposes; lamps; fans; pocket torches; heating elements; lighting elements; cooling elements; cooling appliances and installations; electric radiant heaters [for household purposes]; Gas water heaters [for household use]; Oil, coal and gas stoves [space heaters for household use]; sanitary ware; bathroom installations and fittings; baths; showers; sauna and steam bath installations; water closets; wash basins; bidets; showers; shower enclosures; shower trays; shower heads; shower handsets; shower hoses; taps; toilets; toilet seats; cisterns; tanks; heaters; dehumidifiers; radiators; radiator fans; boilers; ovens; cookers; cooker hoods; hobs; microwave ovens; barbecues; electric cooking utensils; electric pressure cooking saucepans; plate warmers; toasters; kettles; installations and apparatus, all for refrigerating, freezing and air conditioning; fridges; freezers; electric wine coolers; water and air purifying apparatus and filters; water softeners; disinfecting apparatus; chandeliers; lights; electric lights

for Christmas trees; night lights; lamps shades; lamp holders; lamp bases; light bulbs; bicycle lights; garden lighting; lanterns for lighting garden sprinklers [automatic]; ice cream makers; bread makers; coffee roasters; electric cafetieres; coffee machines; catering urns; beverage cooling apparatus; electric deep fryers; electric food steamers; sink units; hair dryers; electric sandwich makers; hot water bottles; ice boxes; electric blankets, (not for medical purposes); steriliser and sterilisation apparatus and equipment; parts and fittings for all the aforesaid goods.

45. The opponent's specification contains the terms:

Equipment and instruments for heating, lighting, cooling, cooking, drying, refrigerating, freezing, sanitising, ventilating, filtering, purifying, deodorising, evaporating and sterilising

46. I take the view that all of the applied for goods fall within the ambit of one or other of the broad terms set out in the opponent's specification. The goods are identical.

### CLASS 35

47. The applied for services cover retail and wholesale services associated with a long list of goods. It has been held a number of times that a complementary relationship may exist between retailing on the one hand, and the goods the subject of that retail service on the other. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and methods of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law concerning retail services v goods. He said that:

"9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main

reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are '*similar*' to goods are not clear cut."

48. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>5</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>6</sup>, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*<sup>7</sup>, Mr Hobbs concluded that:

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

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

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

---

<sup>5</sup> Case C-411/13P

<sup>6</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>7</sup> Case C-398/07P

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

49. I have been through the long list of retail and wholesale services for which the applicant seeks registration. As the applicant pointed out in its counterstatement, it does not follow in every case that retail services are to be regarded as similar to the goods the subject of the retail service. In the list that follows I have indicated my view in the following three categories:

- i) The services I have struck through are regarded as not similar either because there are no corresponding goods (or anything particularly close to them) covered by the earlier mark or have little or no pronounced relationship.
- ii) The services I have emboldened have corresponding goods (or goods close to them) and for which the relationship between them and their respective retail/wholesale service is such that the relationship is sufficiently pronounced (including, for example, that the goods are often sold as own brands in a trader's retail outlet) that there exists at least a medium degree of similarity.
- iii) The services I have underlined have corresponding goods (or something close to them) but the relationship is less sufficiently pronounced, such that there is only a low degree of similarity.

~~Retail and wholesale services connected with the sale of chemicals used in industry and agriculture, chemicals used in horticulture and forestry, unprocessed artificial resins, unprocessed plastics, tempering and soldering preparations, adhesives used in industry; retail and wholesale services connected with the sale of paints, varnishes, lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, metals in foil and powder form for use in painting, decorating, printing and art; retail and wholesale services~~

~~connected with the sale of bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, silicone fluids and resins, silicone varnishes, polishes, sanitizing wipes, non-medicated soaps, disinfectants, preparations for destroying vermin, fungicides, herbicides; retail and wholesale services connected with the sale of industrial oils and greases, lubricants, dust absorbing, wetting and binding compositions, fuels (including motor spirit) and illuminants, candles and wicks for lighting; retail and wholesale services connected with the sale of common metals and their alloys, ores, gold solder, silver solder metal materials for building and construction, metal brackets and hinges, metal gas cylinders, transportable buildings of metal, non-electric cables and wires of common metal, ironmongery and small items of metal hardware, metal cable clips, metal containers for storage or transport, cans, safes, bins, boxes, nuts, bolts, screws, hooks, catches, fasteners, barrels, nails, hinges, padlocks, windows, blinds, doors, locks (non-electric) and keys, ladders, shelving (not being furniture), greenhouses, cloches, huts and portable sheds and frames (all made of common metal), pipes, tubes, hoses, metal valves, metal washers, articles for use as plumbing fittings, materials for use in plumbing, metallic foil for wrapping and packaging, wine racks, metal and wire rope, metal casters, cat flaps, fasteners, barrels, chains for animals, metal letter boxes, metal ferrules, parts and fittings for all the aforesaid goods; retail and wholesale services connected with the sale of machines and machine tools for kitchen, domestic and household use, machines and machine tools for use in cleaning, cleaning machines and apparatus, industrial and domestic cleaning machines and apparatus, industrial and domestic floor cleaning machines and apparatus, hard floor cleaning machines and apparatus, dry cleaning machines and apparatus for floors and carpets, machines and apparatus for applying cleaning preparations to carpets and floors, dust removing installations for cleaning purposes, vacuum cleaning machines and apparatus, vacuum cleaners, cleaning equipment and/or apparatus being parts of machines, for cleaning, spare parts and accessories for vacuum cleaners, including brushes, hoses, suction nozzles, electric fan units and filters, hand held vacuum cleaners, cordless vacuum cleaners, replacement bags of paper for vacuum cleaners, vacuum cleaner bags of paper, card and cardboard, vacuum control valves [parts of machines], vacuum control valves [parts of motors], vacuum packing machines, vacuum pump installations, robotic vacuum cleaners,~~

apparatus for separating particles from an airflow, carbon brushes for electrical machines, carbon brushes for starter motors, floor tools for vacuum cleaners, electric hand tools, electric welding apparatus, brackets (bearing -) for machines, electric motors, and their parts, not for land vehicles, switched-reluctance motors, central vacuum cleaning installations, separators, separation apparatus for use in vacuum cleaners and other cleaning apparatus, steam cleaners [machines], steam cleaning machines for carpets, garments, clothes, curtains, machines for carpet shampooing, wet-and-dry cleaning machines, floor polishers, pressure washers, electric gardening machines and tools, garden vacuums, lawnmowers, lawn and hedge trimmers, garden shredders, garden water pumps, parts and fittings for all the aforesaid goods, washing machines, spin driers, spinning machines, tumble driers, combined washing machines and tumble driers, dishwashers, ironing machines, handheld irons, steam stations, drying machines, domestic machines for use in the processing or preparation of foodstuffs, electric laundry machines, apparatus and tools, electric kitchen machines, fruit presses, electric juicers, filtering machines, rope making machines, apparatus and instruments for domestic use for peeling, cutting, slicing, grating, rasping, shredding and for chopping, electric food preparation machines, machines for making pasta, electric food mixers, blenders, liquidizers, crushers, food processors, food slicers and shredders, electric whisks, electric salad drainers, coffee grinding machines, electric can openers, electric knives and knife sharpeners, beverage making machines, sharpening machines, aerated water making machines, garbage disposals, waste compacting machines, electric tools for bricklaying and plastering, drilling machines, drill chucks [parts of machines], drilling bits [parts of machines] mechanically operated hand-held tools, agricultural implements other than hand-operated, power tools, power tools forming attachments for vacuum cleaners, sanders, electric grinders, jigsaws, electric saws, spray guns, spraying machines, spraying apparatus for dispensing disinfectants and cleaning solutions, fertilizing machines, knitting machines, sewing machines, blowing machines, electric hammers, hair dressing machines, hair cutting machines for animals, electric window openers and closers, vehicle washing and/or polishing installations, aerating pumps for aquaria, air condensers, pumps [machines], air pumps, electric wax polishing machines, rinsing machines, woodworking machines, incubators for eggs, automatic vending machines, robots, bottle sealing and capping machines,

boiler scale collectors, shearing machines for animals, picture making machines, cartridges for filtering machines, door openers and closers [machines], break rings for casters, fuel and gasoline dispensing pumps for service stations, parts and fittings for all the aforesaid goods; retail and wholesale services connected with the sale of hand tools and implements (hand operated), gardening tools (hand operated), hand operated equipment used in agriculture, horticulture and forestry, cutting, drilling, grinding and sharpening hand tools, fastening and joining tools, lifting tools and implements, crow bars, pestle and mortar for pounding, mastic gun, socket set, hand drills, screwdrivers, axes, saws and saw blades, hoes, diggers, garden tools, shears, pliers, clamps, chisels, scissors, rakes, picks, hammers, hand drills, punches, riveters, trowels, tongs, files, planers, grinders, shovels, spades, scythes, knives (other than cutlery), hand tools for bricklaying and plastering, non-electric can openers, irons [non-electric hand tools], perforating tools [hand tools], non-electric pizza cutters, scrapers [hand tools], sharpening instruments, fire tending implements, hand pumps, steam irons, abrading instruments, food preparation implements, kitchen knives, food slicers, choppers and shredders, food processor [hand operated], cutlery, disposable tableware (cutlery) made of plastics, boxes for cutlery [fitted], steak knives, razor blades, cassettes for razor blades, razor blade dispensers, safety razor blades (Dispensers for -), electric shavers, beard clippers, shaving cases, razor cases, electric hair straighteners, hair cutting and removal implements, hair styling appliances, curling tongs, hair clippers for personal use, hair-removing tweezers, nail files, nail clippers, manicure tools, pedicure tools, parts and fittings for all the aforesaid goods; retail and wholesale services connected with the sale of scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, junction boxes, fuses, fuse boxes, capacitance boxes, terminal boxes, control boxes [electric], converters, transformers, electrical power supplies, apparatus and instruments for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, memory cards and memory card readers, cassettes, electrical armatures, armatures for use in electrical apparatus, batteries, mains chargers, battery chargers, battery cases,

apparatus for connecting and charging portable and handheld electronic devices, plugs, sockets and other contacts [electrical connections], plugboards, plug connectors and adapters, audio connectors, electrical adaptors, audio leads, electrical leads, electrical extension leads, electrical wires and cables, pattresses, signal splitters, alarms and warning equipment, headphones and earphones, telephones, videophones, smart phones, microphones, radios, remote controls, portable and handheld electronic devices for transmitting, storing, manipulating, recording, and reviewing text, images, audio, video and data, including via global computer networks, wireless networks, and electronic communications networks and electronic and mechanical parts and fittings therefor, audio players, apparatus for televisions, televisions, set-top boxes, transmitting and receiving apparatus for television broadcasting, access control systems and apparatus, electronic monitoring and control apparatus, lighting monitoring and control apparatus, boiler monitoring and control apparatus, security monitoring and control apparatus, network monitoring and controlling apparatus, temperature monitoring and controlling apparatus, measuring apparatus, tape measures, rules [measuring equipment], kitchen scales, alarm apparatus, alarm monitoring and control apparatus, electronic alarms, electronic protection equipment, electronic locking instruments, closed-circuit television (CCTV), monitors, cameras, camera cases, camera lenses, camera stands, fire-extinguishing apparatus, calculating machines, data processing equipment, computers, computer software, computer hardware, computer screens, computer peripherals, computer network hubs, switches and routers, blank digital storage media, blank electronic storage media, blank smart cards, data storage apparatus, DVD players and drives, USB cables, hardware, hubs and adapters, adapter cards, WiFi communication apparatus, WiFi locators, port replicators, extenders, smart cards and smart cartridges, data cartridges, plug-in cartridges [electronic], portable hard disk drives, touch screens, touch screen pens, electrical sensors, integrated circuits, electronic circuit boards, circuit testers, power cables, power lines, power line protectors and conditioners, power line transmission apparatus, docking stations, computer stands, printers, printer stands, printer components and accessories, speakers, wireless speakers, digital electronic components and accessories, namely, holsters, carrying cases, and skins [fitted plastic films], covers and carry cases for computers, telephones, wearable telecommunications devices and electric book readers, electronic key

fobs and tags, MP3 players, MP4 players, portable media players, video players, cases and covers for digital media players, global positioning system (GPS) devices, wearable telecommunication devices, smartbands, smart bracelets, smartwatches, electronic book readers, dust masks, egg timers, TV stands, wall-mounted products for televisions and other audio visual apparatus, head-mounted video display apparatus, parts and fittings for all the aforesaid goods; **retail and wholesale services connected with the sale of apparatus, installations and equipment for lighting, heating, steam generating, cooking, grilling, drying, ventilating, filtering, airing, water supply and sanitary purposes, lamps, fans, pocket torches, heating elements, lighting elements, cooling elements, cooling appliances and installations, electric radiant heaters [for household purposes], Gas water heaters [for household use], Oil, coal and gas stoves [space heaters for household use], sanitary ware, bathroom installations and fittings, baths, showers, sauna and steam bath installations, water closets, wash basins, bidets, showers, shower enclosures, shower trays, shower heads, shower handsets, shower hoses, taps, toilets, toilet seats, cisterns, tanks, heaters, dehumidifiers, radiators, radiator fans, boilers, ovens, cookers, cooker hoods, hobs, microwave ovens, barbecues, electric cooking utensils, electric pressure cooking saucepans, plate warmers, toasters, kettles, installations and apparatus, all for refrigerating, freezing and air conditioning, fridges, freezers, electric wine coolers, water and air purifying apparatus and filters, water softeners, disinfecting apparatus, chandeliers, lights, electric lights for Christmas trees, night lights, lamps shades, lamp holders, lamp bases, light bulbs, bicycle lights, garden lighting, lanterns for lighting garden sprinklers [automatic], ice cream makers, bread makers, coffee roasters, electric cafetieres, coffee machines, catering urns, beverage cooling apparatus, electric deep fryers, electric food steamers, sink units, hair dryers, electric sandwich makers, hot water bottles, ice boxes, electric blankets, (not for medical purposes), steriliser and sterilisation apparatus and equipment, parts and fittings for all the aforesaid goods; retail and wholesale services connected with the sale of precious metals and their alloys, jewellery, precious and semi-precious stones, horological and chronometric instruments; retail and wholesale services connected with the sale of paper and cardboard, printed matter, bookbinding material, photographs, stationery and office requisites, except furniture, adhesives for stationery or household purposes, artists'**

and drawing materials, paintbrushes, instructional and teaching materials, plastic sheets, films and bags for wrapping and packaging, printers' type, printing blocks; retail and wholesale services connected with the sale of unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials, plastics and resins in extruded form for use in manufacture, packing, stopping and insulating materials, insulation tape, flexible pipes, tubes and hoses, not of metal; **retail and wholesale services connected with the sale of leather and imitations of leather, animal skins and hides, luggage and carrying bags, umbrellas and parasols ponchos, bags for shopping, trolleys, aprons, walking sticks, whips, harness and saddlery, collars, leashes and clothing for animals;** retail and wholesale services connected with the sale of building materials (non-metallic), non-metallic rigid pipes for building, asphalt, pitch and bitumen, non-metallic transportable buildings, monuments, not of metal; **retail and wholesale services connected with the sale of furniture, mirrors, picture frames, containers, not of metal, for storage or transport, foot spas and foot massagers, bin liners;** **retail and wholesale services connected with the sale of household or kitchen utensils and containers, colanders, combs and sponges, brushes [except paintbrushes], brushmaking materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass [except glass used in building], glassware, porcelain and earthenware, abrasive pads for kitchen purposes, basins [receptacles], baskets for domestic use, basting spoons [cooking utensils], beaters, non-electric, beer mugs, beer glasses, beer tankards, blenders, non-electric, for household purposes, bottle openers, electric and nonelectric, bottles, bowls [basins], bread baskets, domestic, bread bins, bread boards, brooms, broom handles, dustpans, brush goods, buckets, candelabra [candlesticks], candle extinguishers, candle jars [holders], candle rings, carpet sweepers, cauldrons, ceramics for household purposes, champagne buckets, champagne flutes, china ornaments, chopsticks, cleaning instruments, hand-operated, clothes-pegs, cloths for cleaning, cleaning articles, coasters, not of paper and other than table linen, cocktail shakers, cocktail stirrers, coffee filters, non-electric, coffee grinders, handoperated, coffee percolators, non-electric, coffeepots, non-electric, coffee services [tableware], containers for household or kitchen use, cooking pots, cooking pot sets, cooking skewers of metal, cooking**

utensils, nonelectric, coolers [ice pails], corkscrews, electric and non-electric, cruets, crushers for kitchen use, non-electric, crystal [glassware], cups, cutlery trays, cutting boards for the kitchen, decanters, deep fryers, non-electric, deodorising apparatus for personal use, dish covers, dishes, disposable table plates, drinking glasses, drinking straws, drinking vessels and barware, dustbins, earthenware, egg cups, figurines [statuettes] of porcelain, ceramic, earthenware or glass, fitted picnic baskets, including dishes, flasks, flower pots, food steamers, nonelectric, frying pans, funnels, gardening gloves, garlic presses [kitchen utensils], glass bowls, glasses [receptacles], glass, unworked or semi-worked, except building glass, gloves for household purposes, graters for kitchen use, grills [cooking utensils], heat-insulated containers, heat-insulated containers for beverages, hip flasks, holders for flowers and plants [flower arranging], hot pots, not electrically heated, ice cube molds [moulds], indoor aquaria, indoor terrariums [plant cultivation], ironing board covers, shaped, ironing boards, rotary washing lines, clothes drying hangers, kettles, non-electric, kitchen containers, kitchen grinders, non-electric, kitchen utensils, lunch boxes, sandwich boxes, mills for domestic purposes, hand-operated, mixing spoons [kitchen utensils], mops, mugs, mug sets, nail brushes, napkin holders, napkin rings, oven mitts, paper plates, pastry cutters, pepper mills, hand-operated, perfume vaporizers, pie servers, pitchers, polishing apparatus and machines, for household purposes, non-electric, porcelain ware, potholders, pot lids, pots, pottery, pressure cookers [autoclaves], non-electric, rolling pins, domestic, salad bowls, salt cellars, saucers, scoops [tableware], services [dishes], shaving brushes, shaving brush stands, soap boxes, soap dispensers, soap holders, soup bowls, spatulas [kitchen utensils], spice sets, statues of porcelain, ceramic, earthenware or glass, strainers for household purposes, sugar bowls, table plates, tableware, other than knives, forks and spoons, tankards, teapots, tea services [tableware], toilet brushes, toilet cases, toilet paper dispensers, toilet utensils, toothbrushes, towel rails and rings, trays for domestic purposes, utensils for household purposes, vases, vegetable dishes, washtubs, waste paper baskets, watering devices, wine coolers, wine decanters, wine glasses, window-boxes, works of art of porcelain, ceramic, earthenware or glass, jars,

**jugs, bottles, vases, planters, plaques, oven gloves, canister sets, cake tins, baking tins, household storage containers, food storage containers, food storage jars, household trays, food servers, chinaware, decorative china, cafetieres, pedal bins, laundry bins, laundry baskets, bathroom articles, shower articles, dusters, wipes and skins of chamois, all for cleaning purposes, buckets, ice scrapers, steel wool, non-metallic utensils and hollowware, including water bottles, non-electric kettles, water carrying utensils for camping and picnicking, and metal picnic trays, glass fibre cloths and mats, for use in the repair of motor vehicle bodies and of the like, cup holders, dispensers and dispensing apparatus, toilet plungers, deodorising apparatus, parts and fittings for all the aforesaid goods; retail and wholesale services connected with the sale of ropes and string, nets, tents and tarpaulins, awnings of textile or synthetic materials, sails, sacks for the transport and storage of materials in bulk, padding, cushioning and stuffing materials, except of paper, cardboard, rubber or plastics, raw fibrous textile materials and substitutes therefor; all of the aforesaid including on-line retail and wholesale services.**

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

50. It is necessary for me to determine who the average consumer is for the respective goods/services. 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*<sup>8</sup>, 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.”

---

<sup>8</sup> [2014] EWHC 439 (Ch)

51. For reasons that will become apparent, I will not detail the average consumer and the nature of the purchasing process for each and every term covered by the specifications. For most of the goods and services the average consumer will be a member of the general public. The nature of the selection process will vary depending on what is involved. However, I would not pitch the nature of the selection process as of the highest level for any of the goods and services. Neither would I say that any of the goods would be subject to a very casual selection process. Some may represent slightly more considered purchases than the norm – for example the selection of power tools, computers, vacuums cleaners etc. Some goods may have slightly less consideration than the norm e.g. audio cables. The rest, and likely the majority, will have a normal degree of care and consideration, not materially higher or lower than the norm.

52. Some of the goods could also be purchased by business users, such as the various machines in class 7. Some could be more carefully considered, but the terms would also cover more simplistic items also. The care and attention used to select such goods may be slightly higher than the norm for such users.

53. The selection processes will typically involve looking at the goods and services online, in the high street, in brochures, leaflets and advertisements etc. This suggests a process that involves the eye more than the ear, so that the visual similarities/differences are more important. However, I will not exclude the aural similarities/differences completely from my assessment, although I should say that none of the goods/services are of the type where aural considerations are particularly acute.

### **Comparison of marks**

54. 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* 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.<sup>9</sup>

55. It would be wrong, therefore, to artificially dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

56. The respective marks are: **ARHAUS v VonHaus**

57. Although I bear in mind that the notional and fair use of marks sometimes includes use in different casing to the way in which a mark is filed, it would be wrong in the case before me to include within the realms of notional and fair use a manner which gives greater prominence (as a separate component) of HAUS within ARHAUS, or one in which Von and Haus in VonHaus is blended together in a way which prevents those two components being seen as such.

58. In terms of overall impression, ARHAUS will be seen as a single word and is consequently the only thing which contributes to its overall impression. HAUS does not stand out within this overall impression as a particular component of the mark.

59. The overall impression of VonHaus will be based upon the two words Von and Haus conjoined, neither of which dominate the other.

60. Visually, that both marks end with the same four letters -HAUS/-Haus creates a point of similarity. However, the visual differences that are created by the different beginnings AR-/Von, the different structure of a single word against two (conjoined)

---

<sup>9</sup> C-591/12P, para. 34

words and the fact that HAUS does not greatly stand out in the applied for mark means that, overall, any visual similarity is at a low level.

61. Aurally, ARHAUS will be pronounced as ARE-HOUSE or AR-HOWS, whereas VonHaus will be articulated as VON-HOUSE or VON-HOWS. Both are, therefore, two syllable articulations, with the ending being the same but the beginnings being different. I consider this equates to a medium degree of aural similarity.

62. Conceptually, the average consumer will see ARHAUS as either an invented word, or a foreign word, the meaning of which is not known. I do not agree that they will see any significance in the word HAUS (as being German for the word house) even in relation to goods/services for use in the home. This would reflect an artificial approach on the part of the average consumer in circumstances where HAUS does not really stand out in the overall impression of the mark. VonHaus, equally, has no clear meaning as a whole, however, I accept that some average consumers may recognise Von as being a common surname prefix used in a number of European countries, so the whole may be seen as a name. Further, because Haus will be recognised as a component part of the earlier mark, there is greater chance that some average consumers (although not many) may recognise it as the word house in German. However, due to the vagueness of the concept as a whole, and due to most average consumers likely regarding the mark as just invented (or a combination of foreign words, the meaning of which is not known), I will proceed on the basis that there is neither conceptual similarity nor dissimilarity.

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

63. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

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

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

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).<sup>10</sup>

64. There is no evidence from the opponent, so I have only the inherent characteristics of the earlier mark to consider. The earlier mark has no clear meaning or relationship at all, let alone in relation to any of the goods the mark covers. It is entitled to a reasonably high level of inherent distinctive character.

### **Conclusions on likelihood of confusion**

65. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and now come to a global assessment. As the CJEU stated:

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The

---

<sup>10</sup> C-342/97, paras. 22-23

interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.<sup>11</sup>

66. There are two types of confusion that must be considered:

- direct confusion, where one mark is mistaken for another; and
- indirect confusion, where the similarities lead the consumer to believe that the goods or services come from the same, or a related, undertaking.

67. I will consider the matter firstly from the perspective of the goods I have found to be identical. This is important because of the interdependency principle set out earlier (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). Some of the (identical) goods will be subject to a slightly higher than normal level of attention during the selection process, some just a normal level, and others (although not large in number) a slightly lower than average level. Whilst imperfect recollection is always an important factor to keep in mind, it is particularly important in relation to the latter category of goods I have identified (those with a slightly lower than average level of attention). However, even accounting for this, I still conclude that there is no likelihood of direct confusion. The overall structure of the respective marks and the degree of similarities that arise from that (particularly bearing in mind the one word v two (conjoined) words and the fact that HAUS does not stand out in ARHAUS) means that in my view the average consumer is unlikely to misremember or miss-recall one as the other, or vice versa. This is so notwithstanding the reasonably high degree of inherent distinctiveness in the earlier mark and the slightly less than normal level of care and consideration being applied to some of the goods. There is no direct confusion.

---

<sup>11</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97, para. 17

68. In terms of indirect confusion, this was dealt with 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).”

69. In my view it is not likely that the similarities that exist between the marks would indicate to the average consumer that the (identical) goods come from the same (or related) undertaking. This is due principally to the roles that the common letters - HAUS/Haus play in the marks. Blending into a single word as part of the applied for mark and as an individual word (albeit conjoined to another) in the earlier mark. In fact, the average consumer may even struggle to see any real commonality. Even if they did spot the commonality, I note that the applicant states that this would be put down to co-incidence because the word signifies HOUSE, and would therefore be an unsurprising co-incidence for goods to be used in the home. Whilst I do not come to my view for the same reasons (because the average consumer is unlikely to make such a detailed assessment), they would instead put the similarity down to co-incidence on the basis that they just happen to share some letters. There is no likelihood of indirect confusion.

70. Given the above findings, it follows that there is no likelihood of confusion in relation to the other goods and services.

71. I think it worthwhile making one fall-back finding. If I am held to be wrong in relation to my assessment of confusion in relation to identical goods and that I should have held that there was direct and/or indirect confusion, I would not in such circumstances have extended that finding to any of the retail/wholesale services applied for, or to any of the goods where the degree of similarity is medium or lower. This is because of the interdependency principle and my view that the distance between the goods/services, coupled with the distance between the marks, would not lead to confusion, be it direct or otherwise.

## **OUTCOME**

72. Subject to appeal, the applied for mark may proceed to registration in respect of all of its goods and services.

## **COSTS**

73. The applicant has been successful and is entitled to a contribution towards its costs. The only engagement from the applicant was to consider the statement of grounds and file a counterstatement. For this I award the sum of £350.

74. I therefore order Domu Brands Limited to pay Qualtex UK Ltd the sum of £350. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 24<sup>th</sup> day of October 2018**

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**

## **Annex - opponent's goods (as relied upon)**

Class 6: Bins; boxes; nuts; bolts; screws; hooks; catches; fasteners; barrels; nails; hinges; locks (non-electric) and keys therefor; ladders; shelving (not being furniture); greenhouses; cloches; huts and portable sheds (all made of common metal); articles for use as plumbing fittings and materials for use in plumbing; metallic foil for wrapping and packaging; wine racks.

Class 7: Machine and machine tools for kitchen, domestic and household use; electrical apparatus and machines for kitchen and laundry use; floor cleaning apparatus and machines; vacuum cleaners; machines for carpet shampooing; floor polishers; hard floor cleaners; dry cleaning apparatus for floors and carpets; apparatus and machines for applying cleaning preparations to floors and carpets; steam cleaners; handheld vacuum cleaners; steam cleaner for garments, clothes, curtains, and other consumer materials; cordless vacuum cleaners; wet-and-dry cleaning machines; robotic vacuum cleaners; central vacuum cleaning installations; floor tools for vacuum cleaners; accessories for vacuum cleaners and other cleaning machines; attachments for vacuum cleaners; power tools; power tools forming attachments for vacuum cleaners; drilling machines; sanders; grinders; air-driven screwdrivers and jigsaws; blowing machines; electric hammers; spray guns; saws; shredders [machines]; garden vacuums; can openers (electric); washing machines; spin driers; dishwashers; drying machines; fruit presses; electrical juicers; ironing machines; spraying machines; spraying apparatus for dispensing disinfectants and cleaning solutions; electric blenders; food processors; electric crushers and grinders; waste disposals; waste compacting machines; hair cutting machines for animals; lawn mowers; electric knives; vegetable peeling machines; electric whisks; aerated water making apparatus; separators; separation apparatus for use in vacuum cleaners and other cleaning apparatus; apparatus for separating particles from an airflow; motors (other than for land vehicles); electric motors for use in domestic appliances; switched-reluctance motors; parts and fittings for all the aforesaid goods; steam cleaner for garments, clothes, curtains, and other consumer materials; lawnmowers; cultivating machines; electric trimming machines; electric motors; drilling, cutting and grinding machines; hairdressing machines; washing machines; drying machines; spinning machines; spraying machines; fertilizing machines; knitting machines; sewing

machines; electric blenders and whisks for household purposes; mechanically operated hand-held tools; electric can openers; vacuum cleaners; electric coffee grinders; dishwashers; waste disposals; vehicle washing and/or polishing installations; aerated beverage making machines; aerating pumps for aquaria; air condensers; air pumps; electric knives; waste compacting machines; electric wax polishing machines; woodworking machines; fuel and gasoline dispensing pumps for service stations; parts and fittings for all the aforesaid.

Class 8: Hand tools and implements; hand operated equipment used in agriculture, horticulture and forestry, for the construction of machines, apparatus and vehicles, and for structural engineering; cutlery; shears and knives for garden use; tools for planting flowers (hand-operated gardening tools); tongs; shovels; spades; scythes; saws; hand pumps; steam irons.

Class 9: Wall mounting products for televisions and all other audio visual products; stands for televisions; stands for printers; television stand including glass television stand with integrated brackets; teaching apparatus and instruments; nautical, photographic, cinematographic, measuring and photocopying apparatus and instruments; batteries; calculators; computers; computer hardware; computer software; apparatus for recording, transmission, reception, processing or reproduction of sound, images and/or data; magnetic data carriers; data processing equipment; data terminals; electronic apparatus and instruments, all for processing, logging, storing, transmission, reception, display and/or printout of data; radio receiving and transmitting apparatus; electrical intercommunications apparatus and instruments; satellite transmitters and receivers; sound amplifying and sound reproducing apparatus and instruments; digital versatile disc players; gramophone records; photographic films; magnetic tapes; compact discs; cassettes; television sets; video recorders; recording head cleaning tapes; loudspeakers; megaphones; karaoke apparatus and instruments; video game cartridges; video telephones; fire extinguishing apparatus; fire alarms; fire blankets; answering machines; binoculars; camcorders; cameras; contact lenses; electrical door bells; alarms; security lights; smoke detectors; luminous beacons; spectacle frames; sunglasses; vehicle breakdown warning triangles; weighing apparatus and instruments; breathing apparatus for underwater swimming; life-belts; life jackets; divers' apparatus; life-

saving apparatus and equipment; bullet proof waistcoats; barometers; buoys; metal detectors; distance measuring apparatus; dog whistles; dosage dispensers; magnetic encoders; magnetic encoded cards and cards bearing machine readable information; identity cards; smart cards; cards bearing magnetic data media; floppy disks; tyre gauges; gas testing instruments; protective helmets; holograms; magnets; telephone apparatus and instruments; telephones; mobile telephones; telephone handsets; adapters for use with telephones; battery chargers for use with telephones; hands free kits for phones; bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; aerials; micro processors; keyboards; modems; monitoring (other than in-vivo monitoring) apparatus and instruments; parts and fittings for all the aforesaid goods; laptop computer bags; egg timers.

Class 11: Equipment and instruments for heating, lighting, cooling, cooking, drying, refrigerating, freezing, sanitising, ventilating, filtering, purifying, deodorising, evaporating and sterilising; refrigerating apparatus and machines; refrigerators; freezers; chillers; beverage cooling apparatus; water coolers; ice-makers; ice boxes; drying apparatus; laundry dryers; hair dryers; hand dryers; hand drying apparatus for washrooms; hand and face dryers; water heaters; water filtering apparatus; water purifying apparatus; electric kettles; pressure water tanks; sterilizers; cookers; cooking apparatus; microwave ovens; electric pressure cookers; rice cookers; toasters; deep fryers; electric frying pans; waffle makers; sandwich toasters; table top grills; hotplates; food warmers; plate warmers; barbecues; rotisseries; coffee makers; espresso machines; coffee percolators; coffee roasters; coffee filters; bread makers; toaster ovens; electric yoghurt makers; air conditioning apparatus; air conditioners; ceiling fans; free-standing fans; electric fans for personal use; air cooling apparatus; air sterilisers; disinfectant apparatus; extractor hoods; filters, being parts of household or industrial installations; heat pumps; heat exchangers; heating apparatus; hot water heating installations; wash hand basins; parts and fittings for the aforesaid goods; taps (faucet); mixer taps (faucets).

Class 12: Parts and fittings included in Class 12 for vehicles; bicycles; perambulators; pushchairs (baby carriages); wheelchairs; wheelbarrows; trolleys (carriages); pet guards; bicycle carriers; bicycle pumps; scooters.

Class 14: Clocks; watches; horological and chronological apparatus and instruments; jewellery and imitation jewellery; jewellery cases (caskets), not of precious metal.

Class 16: Paper; cards; printed plastic cards; printed cards; cheque books; address stamps; modelling materials; greetings cards; table linen of paper; teaching materials; terrestrial globes; tickets and timetables; paper tissues for removing make up; paper towels; wrapping paper; writing slates and tablets; cardboard; cardboard articles; printed matter; periodical publications; books; magazines; newspapers; photographs; stationery; adhesives materials; tapes; paint brushes; office requisites; copying and recording paper; drawing and painting instruments and requisites; easels; paintings; posters; postcards; bags for microwave cooking; paper replacement bags for vacuum cleaners; bags of paper or of plastics; plastic cling film; toilet paper; albums and almanacs; blackboards; bookends; bubble packs; catalogues; chalk; erasing articles; fountain pens and nibs; paperweights; photograph holder (other than frames).

Class 18: Leather and imitation of leather, and goods made of these materials and not included in other classes; animal skins; hides; trunks and travelling bags; umbrellas, parasols and walking sticks; luggage bags; suitcases; cabin bags; garment carriers; washbags; trolley bags; briefcases; pilot bags; attache cases; handbags; vanity bags; folio cases; back-packs; shopper bags; garment carriers and bags; straps, pouches; holdalls; umbrellas; parasols; walking sticks; bags and articles made from leather or from imitation leather.

Class 20: Bedroom furniture; beds; mattresses; living room furniture; sofas; chairs; dining room furniture; dining sets; tables; chairs; kitchen furniture; garden furniture sets; tables; chairs; loungers; bathroom furniture; wardrobes; mirrors; picture frames; chests of drawers; cupboards; plate racks; wickerwork; shelves; tables; computer trolleys; armchairs; settees; seats; easy chairs; bedding (except linen); bed bases; bed frames; works of art of wood, wax, plaster, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; coats hangers; garment covers (wardrobes); cushions; pillows; curtain rings; curtain rods; carpet rods; curtain holders, not of textile material; boxes made of wood and boxes made of plastic; letter boxes, not of metal or masonry;

toy chests; flower pot pedestals; flower stands; newspaper display stands; umbrella stands; clothes hooks (non metallic); furniture casters (non metallic); baskets not of metal; wickerwork; office furniture; garden furniture; cases of wood or plastic; photograph frames; blinds of paper.

Class 21: Trash cans; salt and pepper mills; wine coolers; insulated water flasks; household or kitchen utensils and containers; tableware; crockery including plates, cups, saucers, mugs, bowls, dishes, glasses; glassware; earthenware; pots; pans; saucepans; vases; storage containers; coffee pots; teapots; money boxes; porcelain; bread boards; bread bins; cutting and chopping boards; cake tins; biscuit tins; trays; soap dishes; soap dispensers; napkin holders and rings; boxes; egg cups; perfume sprayers; table utensils; cruets; tableware; butter dishes; bottle openers; candlesticks; baskets; waster bins and containers; litter bins; ornaments and giftware of china, glass, terracotta, porcelain or earthenware; cookware and bakeware and oven gloves; electric make-up removing appliances; aquaria tanks; coffee grinders.

Class 22: Ropes (non-metallic); string and nets; windbreaks made of textile materials, for beach or garden use; tents; packaging bags [sacks] of plastic for bulk storage.

Class 24: Upholstery fabric for the home, including bedroom, living room, dining room, kitchen, garden, and bathroom; fabrics for textile use; bed and table covers; cotton fabrics (other than for clothing); sheets; duvets; bed linen; household linen; table linen (textile); bath linen; curtains of textile; upholstery fabrics; wall hangings of textile; cushion covers; furniture covering of plastic, leather and textile; upholstery fabrics.