

O-078-14

TRADE MARKS ACT 1994

In the matter of registration no 2147054B

in the name of Bauer Radio Limited

of the trade mark:

METRO RADIO

and the application for partial invalidation under no 84649

by Associated Newspapers Limited

Mr Simon Malynicz, of counsel, (instructed by Urquhart-Dykes & Lord LLP) appeared on behalf of Bauer Radio Limited.

Mr Adrian Speck QC (instructed by Bird & Bird LLP) appeared on behalf of Associated Newspapers Limited.

Hearing date: 29 January 2014.

1) The registered proprietor of the trade mark METRO RADIO is Bauer Radio Limited, hereinafter Bauer. The application for registration was filed on 3 October 1997 and the registration procedure was completed on 23 July 1999. It is registered for a number of services in classes 35, 38 and 41 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 15 January 2013, Associated Newspapers Limited, hereinafter Associated, filed an application for the invalidation of the registration in respect of *advertising services* in class 35. Applications for invalidation are covered by section 47 of the Trade Marks Act 1994 (the Act) which states:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A)* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration, (b) the registration procedure for the earlier trade mark was not completed before that date, or (c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or (b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community. (2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

3) Associated relies upon section 5(2)(b) of the Act, which states:

(2) A trade mark shall not be registered if because –

(a)

(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.

4) The earlier trade mark upon which Associated relies is United Kingdom registration no 1586405 of the trade mark METRO. The application for registration was filed on 28 September 1994 and the registration procedure was completed on 24 January 1997. The trade mark is registered for:

books, magazines, printed publications; all included in Class 16; but not including timetables and not including any such goods relating to railway systems; or printed publications for use in operating, servicing, and/or repairing motor vehicles, vehicle handbooks, and vehicle parts catalogues.

As per section 47(2A) of the Act, the registration is subject to proof of genuine use for the period from 16 January 2008 to 15 January 2013. Associated claims that in this period the trade mark had been used for *newspapers*, which it notes, in its statement of grounds, fall within the broader category *printed publications*.

5) Associated states that there are currently 13 sets of proceedings between the parties. In one of these, opposition no 97043, Associated states that Bauer has stated:

“...the Opponent’s earlier registration incorporates the word RADIO, which is also non-distinctive and descriptive in relation to the services which have been covered. Therefore, there is virtually no way to differentiate the marks, which would both be generally referred to as “METRO”.”

Associated states that this application is contingent on Bauer’s submission being accepted by the registrar.

6) Associated submits that should the registrar accept Bauer’s submissions in opposition no 97043 “that there is a likelihood of confusion under s.5(2)(b)

between the Earlier Trade Marks and the Registered Mark, then the same reason should be applied in this Action for the specified goods and services”¹.

7) Associated states that it relies upon *newspapers*, which fall within the broader category of *printed publications* in its earlier trade mark. It submits that *newspapers* and *advertising services* are highly similar. Associated submits that owing to the similarity of the respective trade marks and goods and services, there is a likelihood of confusion and *advertising services* should be removed from the class 35 specification of the registration.

8) Bauer filed a counterstatement. It requires proof of genuine use of Associated’s trade mark in respect of the good for which it has been claimed that there has been use².

9) Bauer denies that the respective goods and services are similar. It makes no submission in relation to the similarity of the respective trade marks.

10) The Bauer registration was subject to an application by Associated for revocation for non-use. In decision BL O/241/13 the registration was maintained in respect, inter alia, of *advertising services*. This decision is currently the subject of an appeal to the appointed person. Associated requested that this current application be heard and a decision issued rather than have the proceedings stayed pending the outcome of the appeal.

Evidence

11) Mary Catherine Ellington, regional director of Bauer Radio North East, submitted a witness statement on behalf of Bauer.

12) Evidence for Associated consists of witness statements made by Grant William Woodthorpe, Martin Thomas Smith, Philip Graham Offord (two statements) and Alison Jane Mifsud. Mr Woodthorpe is investment director for Metro, a division of Associated. Mr Smith is executive director of classified for Metro. Mr Offord is the finance director of Metro. Ms Mifsud is head of commercial projects at Metro.

¹ In the opposition proceedings Bauer only relies upon one trade mark, the one subject of this application. The issue relates to different goods and services, consequently, it is not possible to see how the outcome of those proceedings is pertinent to the likelihood of confusion. There may be some common elements in relation to the similarity of the trade marks but the comparison of the trade marks must be considered in relation to the respective goods and services.

² Inter alia, in relation to the requirement for proof of use, Bauer states that *printed publications* is too wide a specification to be maintained; if there is proof of use. However, Associated is only relying upon *newspapers*, which it submits fall within the broad category of *printed publications*.

Evidence for Bauer

13) Ms Ellington exhibits at MCE1 a page from Wikipedia for “advertising agency”. She notes that it gives a definition of an advertising agency:

“An advertising agency or advert agency is a service business dedicated to creating, planning, and handling advertising (and sometimes other forms of promotion) for its clients. An ad agency is independent from the client and provides an outside point of view to the effort of selling the client's products or services. An agency can also handle overall marketing and branding strategies and sales promotions for its clients.

Typical ad agency clients include businesses and corporations, non-profit organizations and government agencies. Agencies may be hired to produce television commercials and radio commercials as part of an advertising campaign.”

14) Ms Ellington notes that the entry goes on to distinguish between different kinds of advertising agencies such as full service, creative, specialised, in-house, interactive, search engine, social media, healthcare communications, medical education and “other”. She notes that the entry goes on to give a breakdown of the main advertising services provided by advertising agencies: creative, account services, media buying and production.

15) Exhibited at MCE2 are pages downloaded from the Internet giving brief details of advertising agencies working in the United Kingdom. Exhibited at MCE3 are single pages from the Internet relating to four of the advertising agencies referred to in MCE2.

16) Ms Ellington refers to the Wikipedia entry in relation to media buying, which states:

“The *media services* department's employees are the people who have contacts with the suppliers of various creative media. For example, they will be able to advise upon and negotiate with printers if an agency is producing flyers for a client. However, when dealing with the major media (broadcast media, outdoor, and the press), this work is usually outsourced to a media agency which can advise on *media planning* and is normally large enough to negotiate prices down further than a single agency or client can. They can often be restrained by the client's budget, in which, the media strategy will inform the creative team what media platform they'll be developing the ad for.

Modern agencies might also have a media planning department integrated, which does all the spot's planning and placements”

Exhibited at MCE4 is a list of media agencies. Exhibited at MCE5 are single pages from the Internet relating to four of the agencies referred to in MCE4. The page relating to brayleino (page 18) advises that it is expert at “creating TV and radio commercials, outdoor, press and DM campaigns”.

17) Ms Ellington states that advertising services are subject to the standard rate of VAT whilst newspapers are zero rated. Exhibited at MCE6 is a copy of an HMRC notice in relation to “[z]ero rating of books etc”; this shows that newspapers are zero rated. Included in the list of zero rated goods are advertising leaflets and handbills.

Evidence for Associated

18) Mr Woodthorpe states that at the *Metro* newspaper the provision of advertising services is split between the display advertising team, the classified advertising team and the local franchise teams. The display advertising team has 17 staff containing management, account managers, planners and digital specialists. The team is organised to complement its primary clients, media agencies, who generate approximately 90% of the display advertising business. The other 10% of the display advertising business comes directly from clients, often small companies. Display advertisements usually appear in the news, sport and entertainment section called *Life & Style*; these can be booked on a national basis with Associated or on a regional basis through Associated’s franchise partners. Mr Woodthorpe’s team sells advertising in the London edition of *Metro* and nationally in the ten regional editions of the newspaper. Exhibited at GWW-1 are examples of display advertising from *Metro* and other newspapers. Mr Woodthorpe states that as display advertising is a more expensive form of print advertising, advertising agencies and media buyers work quite closely with the display advertising teams in newspapers to plan their clients’ advertising campaigns.

19) Mr Woodthorpe started working in print media in 1991 and worked for a number of media agencies, Zenith, JWT, O&M and Mindshare, before joining Associated in 2000. He has, therefore, experience in both the buying and selling of advertising in regional and national newspapers. Mr Woodthorpe states that one of the key rôles of a media agency is to negotiate the purchase of advertising for their clients. He states that agencies have specialists in different media. Mr Woodthorpe states that print advertising sets out more terms and conditions of an offer or details of a product than television and radio advertisements which are more “brand led”. He states that media agencies are usually organised with planning and “strategic” teams working with clients. Mr Woodthorpe states that buying teams also work with clients but also work closely with “media-owner counterparts” such as Associated. He states that the design of the advertisement is almost always created by a creative agency; sometimes a media agency is connected to a creative agency but most often the two are separate.

20) Mr Woodthorpe states that the client works with the media agency on media plans for their campaigns. He states that if a client and “planner” decide to run a print media campaign, part of the media agency’s rôle is to determine where and when the campaign should run. Mr Woodthorpe states that different newspapers differentiate themselves to advertisers through their different readership profiles.

21) Mr Woodthorpe states that newspapers that are sold have a smaller advertising content than free newspapers such as *Metro*. He states that advertisers will consider the demographics of newspapers in order to decide where to advertise. A number of ways are used to determine in which newspaper to put a display advertisement; at a high level looking at the highest readership in the target demographic. Exhibited at GWW-4 is information from Nielsen showing the amount of display advertising across a number of newspapers in September 2012. The table shows that *Metro London* had the largest amount of display advertising of the newspapers shown. Overall national display advertising was over £700 million in every year from 2008 to 2012.

22) Mr Smith is responsible for a team that deals with clients who are interested in placing classified advertising in *Metro*, *Evening Standard* and approximately 100 regional newspapers. At *Metro* there are approximately 100 people in the classified advertising team; 55 to 60 of these sell advertising in the newspapers. The rest of the team are comprised of digital sales, non-sales managers, customer services, production (including design and placement if needed), training and marketing. Exhibit MTS-1 contains material relating to classified advertisements in *Metro*. Exhibit MTS-2 contains material relating to classified advertising in four other newspapers. Exhibit MTS-3 contains examples of classified advertising from *Metro*, *The Mail on Sunday*, *The Times* and *Evening Standard*.

23) Mr Smith states that nowadays newspapers offer potential advertisers multiple channels for their adverts; these include running adverts on the newspaper’s website or advertising through mobile devices. Mr Smith states that from his experience newspaper online advertising began to be more widely sold from 2003/2004. He states that advertising on mobile devices began to be developed about a year after the Apple iPhone launched in 2007 and is still in its early stages³. Today 90% of advertising sales of *Metro* are from print advertising.

24) Classified advertising is generally cheaper than display advertising. *Metro*’s classified advertising is sold primarily as print advertising. Mr Smith goes on to give evidence about the cost of classified advertising and the sources from where potential advertisers can get information about costs of advertising and information about the newspaper.

³ As the date of application for Bauer’s trade mark was 3 October 1997, these forms of advertising are not pertinent to the proceedings.

25) Mr Smith states that about 63% of his team's classified advertising sales are to the larger top 50 advertising agencies such as Adgenda Media and Penna, whose rôle is to broker advertising deals between businesses and the publisher. He states that classified advertising agencies tend to specialise in particular areas, such as travel or property. Mr Smith states that his team also markets to these media agencies. Exhibited at MTS-9 is a marketing presentation that was prepared for Korean Air by his team.

26) Mr Smith states that approximately 30% of *Metro's* classified advertising is placed directly by individuals or businesses. He states that these advertisements could range from an advert for a psychic to a double-page spread for an estate agency.

27) Mr Smith states that usually artwork for classified ads is supplied in final format by the advertising agency. Smaller advertisements, up to credit card size, can be generated automatically through the booking software which creates "the design through a member of the classified team". Mr Smith states that infrequently his team provide the artwork or images for ads and Associated has in-house designers who provide an advertising design service.

28) Mr Smith comments upon the tracking of advertising effectiveness.

29) Ms Mifsud states that the business model of *Metro* is based on generating advertising revenue.

30) Ms Mifsud states that the commercial projects team for *Metro* is dedicated to the creation and management of advertising campaigns for companies wishing to advertise in *Metro*, and the associated website. At *Metro* there are currently four commercial project managers and two digital managers in her team. Ms Mifsud states that as far as she is aware other newspapers will have similar teams.

31) Ms Mifsud states that unlike the typical campaign coordinated by the display and classified teams, the artwork and copy generated for advertising campaigns developed and delivered by the commercial projects team is usually done using in-house resources at *Metro*. *Metro* has two in-house print advertising designers who spend approximately 70% of their time creating artwork for the team of Ms Mifsud. She states that at times the team might out-source some of the creative work to an external design agency but work would be presented to the client as being designed by *Metro's* team. Ms Mifsud states that the material exhibited at AJM-1 consists of examples of advertisements created for campaigns developed by her team. The artwork was produced by *Metro*, either in-house or by an external creative agency instructed by *Metro*.

32) Ms Mifsud states that her team are involved in the following types of campaign: brand to hand, branded content, advertorials, commission generating partnerships, reader offers, reader shopper nights and cover wraps.

33) In brand to hand, free samples of a product are handed out with *Metro*. *Metro* creates the whole campaign and will create teaser advertisements in *Metro* and arrange the logistics for distributing the product. Exhibited at AJM-3 is material relating to a brand to hand promotion for Snickers chocolate bars which shows the advertising strategy, including advertorials and sponsored pages. All the advertisements for the campaign were produced in-house. Exhibited at AJM-4 is material relating to a brand to hand campaign for Belvita breakfast bars.

34) Branded content uses editorial content in *Metro* to promote an undertaking. Ms Mifsud works in collaboration with the *Metro* editorial staff to produce advertising content that is written in *Metro*'s house style but which meets the client's brief. She states that it is always made clear that the content is an advertisement. Ms Mifsud states that it is a more subtle form of advertisement as it resembles the rest of the editorial content in *Metro*. Branded content articles typically take the form of a half page or full page spread. Ms Mifsud states this form of advertising is produced completely in-house. Examples of branded content are exhibited at AJM-1 at pages 3 and 4.

35) A cover wrap is a display advertisement that takes the form of a front and back cover placed over *Metro*'s usual front cover. Ms Mifsud states that it is not common for her team to manage an in-house production of such advertisements; it worked with ING Direct in 2012 to produce the artwork for a campaign which included a cover wrap as well as other advertising material. Material relating to this is exhibited at AJM-6.

36) The nature of advertorials, reader offers and reader shopper nights are readily understood and it is not necessary to rehearse Ms Mifsud's statement in relation to these.

37) In commission generating partnerships, *Metro* creates the artwork for advertisements and places them in unfilled advertising spaces in the newspaper. The placement is at the editor's discretion but a company can reach an agreement with *Metro* for the placing of a minimum number of days advertising. The client does not pay directly for the artwork generation and placement in *Metro*, revenue is taken through a share of all revenue generated by the client as a result of the advertisement.

38) Ms Mifsud states that, as far as she is aware, *The Times*, *The Daily Mail*, *Evening Standard* and *The Guardian* offer comparable advertising services to those offered by her team at *Metro*. Exhibited at AJM-14 to AJM-16 is material relating to "creative solutions" advertising services that are provided by a number of newspapers. Exhibited at AJM-17 is material relating to *The Guardian* offering readers' offers and partnerships with advertisers.

Proof of use of earlier trade mark

39) Mr Offord gives evidence in relation to the genuine use of METRO in relation to newspapers.

40) *Metro* is a “free-to-consumer” newspaper and has since 2009 been the third most read newspaper in the United Kingdom. It is published from Monday to Friday. METRO is used on the masthead of the newspaper and within the newspaper. Examples of use from 1999 to 2012 are exhibited at PGO-1.

41) *Metro* was launched in central London on 16 March 1999. Exhibited at PGO-2 is data in relation to when it was launched in other towns and cities in the United Kingdom; the last being Aberdeen on 23 May 2012. It is now available in 52 towns and cities. *Metro* turned its first operational profit in September 2003 and is still profitable. Since 2000/2001 revenue from advertising in *Metro* has exceeded £25 million in each year.

42) It is not necessary to recount more of the witness statements of Mr Offord as the issue in relation to use relates solely to genuine use of METRO for *newspapers* from 16 January 2008 to 15 January 2013; which is clearly established. As Bauer’s trade mark was filed on 3 October 1997 and *Metro* was launched on 16 March 1999, there is no issue of enhanced distinctiveness at the date of the filing of the application of Bauer.

Findings of fact

43) Associated has established genuine use of its trade mark in the material period in respect of *newspapers*.

44) The evidence of Associated establishes that although on many occasions the sole rôle of the newspaper in relation to advertising is to provide a space for the advertisement, on other occasions the newspaper will be instrumental in designing both the advertisement and the campaign. It is, in effect, supplying services that a stand-alone advertising agency would. The evidence shows that this is the case across the newspaper industry and not just the case with *Metro*; exhibits include material from *Daily Mail* publications, *The Sun*, *The Times*, *The Sunday Times*, *London Evening Standard* and *The Guardian*. The exhibits of Ms Mifsud emanate from after the date of the filing of Bauer’s registration, 3 October 1997. However, there is nothing to suggest that this was not the position at this time also; and it would seem unlikely that this was not the case at that time. In his skeleton argument, Mr Malynicz submitted that Ms Mifsud’s “evidence is to be taken with a pinch of salt”. There is nothing to suggest that her evidence should be taken with a pinch of salt. If Bauer wanted to challenge it, it could have requested to file additional evidence and/or sought the cross-examination of Ms Mifsud.

Comparison of goods and services

45) 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 tradeⁱ”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaningⁱⁱ. In *YouView TV Limited v Total Limited* [2012] EWHC 3158 (Ch) at paragraph 12 Floyd J stated:

“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.”

Consideration should be given as to how the average consumer would view the goods and servicesⁱⁱⁱ. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods and services^{iv}. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^v. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{vi}. Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

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

In *Sandra Amalia Mary Elliott v LRC Products Limited* BL O/214/13, Mr Daniel Alexander QC, sitting as the appointed person, considered complementarity (and the general issues in relation to similarity of goods) in relation to the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06:

“17. First, the starting point for the analysis of similarity is the wording of the Act and the Directive. These require the tribunal to determine whether or not the respective goods are “identical or similar” but they do not specify the criteria by reference to which similarity is to be assessed. In the well-established guidance from the Court of Justice on this issue originating in *Canon*, to which the Hearing Officer referred, the Court has not suggested that every case requires assessment of whether the respective goods or services are complementary. To the contrary, the Court has regularly made it clear that all relevant factors relating to the goods or services themselves should be taken into account, of which complementarity is but one (see e.g. in *Boston*).

18. Second, the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in *Boston* as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.

19. Third, the Hearing Officer said at [32]:

As stated above, the legal definition of ‘complementary’, as per *Boston*, is that the goods must be “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”. It is not sufficient that the goods “can” be used together; nor is it sufficient that they are sold together.

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*.

21. Moreover, it is necessary to view the quotation from *Boston* in the context of the facts of that case where the dispute over similarity turned in part on whether the goods were used together for a rather specific medical procedure. The Court of First Instance said at [77]-[87]:

Similarity between the products

77 According to consistent case-law, in order to assess the similarity of the products or services concerned, all the relevant features of the relationship that might exist between those products or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*Sunrider v OHIM*, paragraph 27 above, paragraph 85; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services*

and Distribution v OHIM - Gómez Frías (euroMASTER), paragraph 31).

78 As regards the assessment of the similarity of the goods at issue, the Board of Appeal found, in paragraphs 22 to 24 of the contested decision, that, owing to their functional differences, apparatus for placing a suture, on the one hand, and hollow fiber oxygenators with detachable hard-shell reservoir, on the other hand, have a different method of use, are not in competition with each other and are not interchangeable. However, the Board found, in essence, that the goods at issue were closely linked to the goods of the intervener in so far as they had a certain complementary character, since they could be used simultaneously in the field of medicine, for example during surgery. They might also be purchased through the same distribution channels and be found in the same points of sale, so that the relevant public could be led to believe that they came from the same undertaking.

79 Those findings must be upheld.

80 In this respect, it must be noted that the goods bearing the earlier trade mark and those covered by the mark applied for both concern the medical field and are therefore intended to be used in the context of a therapeutic treatment.

81 In addition, as the Board of Appeal rightly pointed out, all the goods covered by the mark applied for have a certain complementary relationship with those bearing the earlier trade mark.

82 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).

83 It is also true that, as OHIM moreover acknowledged, apparatus for placing a suture cannot be considered to be indispensable or important for the use of hollow fiber oxygenators with detachable hard-shell reservoir.

84 However, it is clear that apparatus for placing a suture and hollow fiber oxygenators with detachable hard-shell reservoir can be considered to be complementary where, in surgery which has required an incision and during which an oxygenator has been used, the surgeon uses apparatus for placing a suture. Thus, in the course of a single, very specific procedure, namely a surgical operation, two apparatus, namely an oxygenator and apparatus for placing a suture, might be used, one bearing the trade mark CAPIOX and the other the trade mark CAPIO.

85 It follows that, even though the applicant claims that the goods at issue cannot be considered to be similar simply because they are both used in the field of medicine, which, according to the applicant, is the case of nearly all goods of significance, the goods at issue are similar because they are in fact in a certain complementary relationship and specifically target certain professionals in the medical sector. In addition, in the present case, contrary to what the applicant claims, the goods at issue are not similar solely because they are used in the field of medicine, but because they could be used in the same, very specific surgical operation, namely open-heart surgery.

86 Finally, the products at issue can in fact be found in the same distribution channels, such a criterion being relevant for the purposes of the assessment of the similarity of the goods (*PiraÑAM diseño original Juan Bolaños*, paragraph 82 above, paragraph 37; see also, to that effect, *SISSI ROSSI*, paragraph 82 above, paragraph 65; and *PAM PLUVIAL*, paragraph 82 above, paragraph 95).

87 Accordingly, given the close link between the products in question as regards their end users, the fact that they are to some extent complementary and the fact that they may be distributed via the same distribution channels, the Board of Appeal was right to find that the applicant's goods and those of the intervener were similar (see, to that effect, *Case T-388/00 Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 56).

22. The Court of First Instance was not attributing decisive importance to the question of whether the goods in that case were complementary in determining the overall question of whether they were similar.

23. In the present case, because of the way in which the case was presented to the Hearing Officer, the issue of whether the goods were complementary assumed excessive importance which may have diverted

the Hearing Officer's attention from other, no less important, considerations in the evaluation of similarity. That requires me on this appeal to scrutinize the approach taken by the Hearing Officer in considering the evidence by reference to the test of similarity more closely than would ordinarily be warranted by the REEF principles on an appeal of this kind."

46) Mr Speck prayed in aid the decision in BL O/241/13 at paragraph 51 et seq:

".....The very purpose of a commercial radio station is to advertise; that is how the owners make their profits. Advertising runs through the warp and weft of a commercial radio station. Equally, in relation to websites, the commercial model is often based on advertising. It would no doubt surprise Google to discover that it is not providing advertising services. If the diffusion of advertisements were not an advertising service one would wonder what services are being supplied by those companies that supply outside advertising; whether on hoardings, bus stops, on the walls of tube stations, at sports arenas etc. Advertising is not just about creation of advertisements; it is also about the diffusion of the advertisements. The two are mutually dependent. The obiter dictum comments of HHJ Birss have been considered, however, in the context of the use shown by Bauer and the judgments of Floyd J and Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267^{vii}, the diffusion of the advertising is an advertising service. (For a commercial radio station or commercial website, advertising is the purpose of the services, as it creates the income for the owner.)

52) *Advertising, marketing and promotional services* are all part and parcel of the same service. The advertising that Bauer has undertaken is by means of the radio or the Internet. It is not considered that limiting the service to the use of these media would represent a genuine category or sub-category. **Consequently, the class 35 part of the specification is maintained in relation to both the revocation and the opposition."**

He argued that if the diffusion of advertising is an advertising service, then, for consistency, it must be held that *advertising* and *newspapers* are similar; on the basis that advertising also runs through the warp and weft of newspapers. This argument is effectively that advertisements are essential to newspapers, the diffusion of advertising is an advertising service, according to the earlier decision, therefore *newspapers* must be similar to *advertising*. This is a syllogistic argument. To a great extent this argument is based on a sleight of hand that effectively conflates *newspapers* with *advertising*.

47) Mr Malynicz prayed in aid guidelines from OHIM and two decisions of the boards of appeal of OHIM. In the guidelines the following appears:

“Advertising services consist of providing others with assistance in the sale of their goods and services by promoting their launch and/or sale, or of reinforcing the client’s position in the market and acquiring competitive advantage through publicity. In order to fulfil this target, many different means and products might be used. These services are provided by specialised companies which study their client’s needs and provide all the necessary information and advice for the marketing of their products and services, and create a personalised strategy regarding the advertising of their goods and services through newspapers, web sites, videos, the internet, etc. It is worth mentioning that the nature and purpose of advertising services are fundamentally different from the manufacture of goods or from the provision of many other services. Therefore, advertising is generally dissimilar to the goods or services being advertised. The same applies to the comparison of advertising services versus goods that can be used as a medium for disseminating advertising, such as DVDs, software, printed matter, flyers and catalogues.”

The decisions of the boards of appeal upon which he relied are R 1534/2011-4 and R 1319/2010-1.

48) Mr Malynicz accepted that the guidelines and the decisions of the boards of the appeal are not binding but prayed in aid the arguments put forward in them. The following parts of the two decisions are noted:

“22. The contested services in Class 35 ‘advertising’ are dissimilar to the opponent’s goods in Class 16, ‘publications, newspapers,...’. ‘Advertising’ concerns the activity of producing advertisements for commercial products or services. Both activities are fundamentally different from the printing of the goods in Class 16 covered by the earlier mark. Although these goods may appear in advertisements and although advertisements may appear in publications and newspapers, the professional public requiring advertising services will not conclude that an advertising agency also operates as the enterprise that prints the goods in Class 16. The goods have a different nature, intended purpose and method of use and they are not complementary or in competition with the contested services in Class 35 (see decision of 18 March 2011, R 1039/2010-4, ‘shakti Ayurveda Center (FIG. MARK) / AYUSHAKTI’, para. 11; decision of 31 March 2011, R 974/2010-1, ‘HEI HOTELS & RESORTS / Hi! Hotels international (FIG.MARK) et al.’, paras.17-20).”

“ 14 In Class 16, the contested mark covers printed matter in general and specific printed products, such as newspapers, booklets and pamphlets. These goods are different in nature and methods of use from any of the services covered by the earlier mark. The applicant’s goods in Class 16 and the opponent’s services in Class 35 do not target the same consumers. Whereas the applicant’s goods are addressed to the general

end consumer, the opponent's services target professional consumers or companies. In fact, only undertakings or public bodies are interested in starting an advertising campaign in order to foster the sale of a product or a service."

In the first decision the board of appeal stated:

"the professional public requiring advertising services will not conclude that an advertising agency also operates as the enterprise that prints the goods in Class 16."

There is a premise that the only users of advertising services are "the professional public". This excludes individuals who may advertise, in particular using classified advertisements. The board of appeal limits the provision of advertising to advertising agencies. It gives no basis for either of these premises. Mr Malynicz accepted that media agencies as well as advertising agencies supply advertising services. In the second decision the board of appeal states:

the opponent's services target professional consumers or companies. In fact, only undertakings or public bodies are interested in starting an advertising campaign in order to foster the sale of a product or a service."

The decision has a premise that only undertakings or public bodies purchase advertising; clearly this does not apply to classified advertisements. It also limits the advertising to a campaign.

49) On the basis of the evidence filed by Associated, the views of the boards of appeal do not assist. The views do not appear to be based on evidence and there is nothing to show that they are aware of how newspapers operate in the United Kingdom. The guidelines of OHIM cannot be a substitution for an application of the principles which have been laid down in the case law. The issues also have to be considered within the context of the evidence that has been filed.

50) Mr Malynicz also prayed in aid the obiter remarks of HHJ Birss QC in *Yell v Louis Giboin and others* [2011] EWPC 9 at paragraph 116. These are obiter comments which do not relate to the issue of similarity between *advertising services* and *newspapers* and HHJ Birss did not have the benefit of evidence in relation to advertising and newspapers; not surprisingly as this was not an issue. Consequently, the remarks of HHJ Birss are not pertinent to these proceedings.

51) *Advertising services* are a service that uses various media, *newspapers* are products; consequently, the nature of the respective goods and services is not the same⁴.

⁴ In his skeleton argument Mr Malynicz submitted: "One is a service consisting of the design of text and artwork for promotional activity, the other consists of the printing of publications. One is

52) The purpose of *advertising services* is to facilitate and effect advertising. The economic model of newspapers, as demonstrated in the evidence, is based on both advertising and possibly sales. Where the newspaper is free, the economic model is dependent upon advertising. One of the purposes of newspapers, on an economic level, is to advertise. In the case of free newspapers, which must be considered as well as paid for newspapers, the essential purpose of the newspaper is to facilitate advertising. Consequently, *advertising services* and *newspapers* to some extent share a common purpose. (*Metro* is a free newspaper. However, the references to free newspapers do not occur because of this. The references to free newspapers occur because they are present in the market and in considering similarity they have to be taken into account, along with paid for newspapers.)

53) *Newspapers* are a medium for *advertising services*, they are not in competition with them.

54) *Advertising* is indispensable to the viability of a newspaper rather than the functioning of a newspaper in terms of content. It is clearly not on a par in these terms with news agency services and photo agency services. A newspaper could be published without advertisements; it is just unlikely to have any economic viability without advertising. *Advertising* is not dependent upon *newspapers*; there are many other media and means of advertising. However, the absence of this rigid mutuality does not mean that the respective goods and services are not complementary; as shown by the findings in *Boston Scientific Ltd* and *Sandra Amalia Mary Elliott*. Mr Alexander, above, comments that a perceived complementarity does not make goods similar per se. He refers to wine and wine glasses; a matter that was dealt with by the GC and CJEU in *Assembled Investments (Proprietary) Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-105/05* and *Waterford Wedgwood plc v Assembled Investments (Proprietary) Ltd and Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07 P* respectively. The evidence shows that there is more than an economic link between *newspapers* and *advertising*; *newspapers* are active in both selling *advertising* and to some extent designing *advertising*; as per the evidence of Ms Mifsud. *Newspapers* in relation to advertising are not just the newsagent's window into which a card is placed; in terms of both the work that newspapers undertake in relation to *advertising* and in relation to the economic importance of *advertising*. Therefore, the position is different to that of wine and the wine glass; where vintners and glass producers have no meeting point until the wine is decanted into the glass. Mr Malynicz submitted that the respective goods and services could not be complementary as they are intended for different publics. He prayed in aid the judgments of the GC in *Mundipharma GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 76/09* at paragraph 30:

fungible, the other is not". It is not understood how one could be fungible and the other not as fungible means mutually interchangeable.

“It should be noted that there is nothing in the file that invalidates the Board of Appeal’s finding, supported by OHIM in its response, that, in essence, the relevant public for ‘storage, distribution, delivery and packaging of pharmaceutical, sanitary and dietetic preparations’ is made up of professionals, while the end consumer of pharmaceutical preparations will buy them, inter alia, from a pharmacy without using those services. As has already been mentioned in paragraph 26, the applicant does not dispute the Board of Appeal’s finding that the relevant public for which the services and goods are intended is different. By definition, goods and services intended for different publics cannot be complementary (see, to that effect, *easyHotel*, paragraphs 57 and 58).”

and *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-316/07 at paragraph 58:

“That case-law definition implies that complementary goods or services can be used together, which presupposes that they are intended for the same public. It follows that there can be no complementary connection between, on the one hand, the goods and services which are necessary for the running of a commercial undertaking and, on the other, the goods and services produced or supplied by that undertaking. Those two categories of goods or services are not used together since those in the first category are used by the relevant undertaking itself whilst those in the second are used by customers of that undertaking.”

These are clear statements of the law by the GC and must be followed. However, the identification of the users by Mr Malynicz is one that limits the relevant public to one set of persons, the readers. There are two relevant publics for *newspapers*: the readers and the advertisers, which will include advertising agencies as well as persons using a newspaper’s own advertising services⁵. The GC considered the issue of complementarity where there are two publics in *Sanco, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-249/11. Complementarity must be considered in relation to either of the relevant publics. Taking into account the relevant public as being advertisers, the position of advertising in newspapers, the rôle of the newspaper in acting in a creative fashion in relation to advertising; advertisers would think that the responsibility for *newspapers* and *advertising services* lies with the same undertaking. The respective goods and services are complementary.

55) As per the above finding re complementarity, one of the sets of users are the same for *newspapers* and *advertising services*.

⁵ Similarly the Google search engine has two relevant publics: those using the search engine and those advertising when the results appear.

56) The analysis of similarity of goods and services can lead to a mechanistic approach in which legal tests supplant commercial reality. Mr Alexander outlined what has to be considered in deciding whether goods are similar. Taking into account the various points where *advertising services* and *newspapers* cross, the respective goods and services are similar to a moderate degree.

Comparison of trade marks

57) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{viii}. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components^{ix}; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

There cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^x. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{xi}.

58) The trade marks to be compared are METRO and METRO RADIO.

59) The consumer's attention is normally directed to the beginnings of words or trade marks^{xii}. There is nothing to gainsay this rule of thumb in the respective trade marks. METRO is unlikely to be divided up by the average consumer, its distinctiveness lies in its entirety. RADIO, in the trade mark of Bauer, will indicate to the average consumer the medium through which the services are supplied. Consequently, the distinctive component is the METRO component. Visually and phonetically the respective trade marks are identical in respect of METRO. There is no evidence as to whether metro will have any particular meaning to the public at large. Some might make an association with various public transport systems. Some may be aware of the use of metro in relation to the underground train systems in cities such as Madrid and Paris. In the absence of any conclusive evidence as to whether metro will have any meaning for the average consumer, the position in relation to conceptual similarity is neutral. The RADIO

component of Bauer's trade mark brings visual, phonetic and conceptual differences. However, owing to the nature of this component, it does not have a great deal of effect on the similarity of the trade marks. The respective trade marks enjoy a good deal of similarity.

Average consumer, nature of purchasing decision and standard for likelihood of confusion

60) The average consumer "is deemed to be reasonably well informed and reasonably circumspect and observant"^{xiii}. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs) Joined Cases T-117/03 to T-119/03 and T-171/03* the GC stated:

"49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (BUDMEN, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."

61) The key relevant public in this case for both goods and services, as identified above in relation to the similarity of goods and services, are advertisers. Advertisers will be interrogating details of the cost, size and nature of advertisements. The purchasing decision will be primarily visual. Most advertisers will be spending a reasonable sum of money and will be concerned about the demographic that the advertising or the newspaper will appeal to as well as circulation figures. However, there will also be classified advertisers who will be less sophisticated. Even with the less sophisticated advertisers the purchasing decision will be a relatively careful one; so limiting the effects of imperfect recollection.

Likelihood of confusion

62) It is necessary to consider the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xiv}. In this case the respective trade marks enjoy a good deal of similarity.

63) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xv}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xvi}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from the goods or services of other undertakings^{xvii}. METRO is neither descriptive nor allusive of *newspapers*. It enjoys a good deal of inherent distinctiveness.

64) In *Adelphoi Limited v DC Comics (a general partnership)* BL O/440/13 Professor Annand, sitting as the appointed person stated

“21. As for the services, e.g., broadcasting, whilst I agree with Mr. Malynicz that the average consumer would include business consumers or professionals as well as the general public, the likelihood of confusion must be assessed in relation to the part of the public whose attention is lower (see e.g., Case T-448/11, *Golden Balls Ltd v. OHIM*, 16 September 2013, para. 26), although in any event, the Hearing Officer relied on an average consumer (reasonably well informed and reasonably circumspect and observant) paying an average level of attention (para. 41).”

Consequently, it is necessary to consider the lowest common denominator, in relation to the relevant public; the classified advertisement purchaser. Even with this public there is a reasonably careful purchasing decision.

65) Taking into account the similarity of the trade marks, the similarity of the goods and services and in particular the interface between *advertising services* and *newspapers*, whilst bearing in mind the limited effects of imperfect recollection, there is a likelihood of confusion and the registration is to be cancelled in respect of *advertising services*. In relation to *advertising services*, in accordance with section 47(6) of the Act, the registration is deemed never to have been made.

Costs

66) Bauer required Associated to furnish proof of use of its trade mark for *newspapers*. Associated has based its application purely on *newspapers*. Bird & Bird wrote to Urquhart-Dykes & Lord making it clear that Associated was only relying upon *newspapers*, seeking confirmation that Bauer really wanted to put Associated to proof of use in respect of these goods. Urquhart-Dykes & Lord replied that it was entitled to request proof of use and that Associated could surrender the other goods in its registration. This is an application for invalidation by Associated, not an application for revocation for non-use by Bauer. The only issue at play relates to the goods for which it is claimed that there has been use. The only proof of use that Associated was required to furnish relates to *newspapers*. The proceedings are not concerned with any other goods of the earlier registration. Bauer must have known that Associated had made genuine use of its earlier trade mark for *newspapers*; it does not deny that it knew of this use. Mr Malynicz submitted that *printed publications*, which encompasses *newspapers*, is much wider than the latter term and so Bauer put Associated to proof of use for *printed publications*. There is simply no sense or logic to this. The parameters of the case in relation to proof of use were defined by the claim to proof of use. In these circumstances, Mr Speck requested an award of costs outwith the scale in respect of the evidence for proof of use; which is effectively the witness statements of Mr Offord. An award of costs outwith the scale, when Bauer full well knew of the use by Associated, is appropriate. Mr Speck suggested a sum of £5,000. Bird & Bird were required, at the hearing, to furnish written details of the costs of the statements of Mr Offord. Bauer were allowed a week to comment upon the quantum of the costs in relation to this evidence.

67) In a letter dated 4 February 2014, Bird & Bird advised that its fees in respect of the first witness statement of Mr Offord were £5,275 and £683. The second witness statement of Mr Offord was born of a refusal of confidentiality in relation to an exhibit to the first statement. It is not appropriate to award costs in relation to this statement. Bird & Bird also referred to the cost of Mr Speck reviewing the witness statements of Mr Offord, £628.75 and £227.25 respectively. Bird & Bird requested the actual costs of the witness statements and counsel's fees. There will be no compensation in relation to the second witness statement. At the hearing Mr Speck requested £5,000 as a contribution towards the costs. This was the submission of Mr Speck and Associated is tied to it.

68) Urquhart-Dykes & Lord wrote to Bird & Bird on 30 January 2014 asking if Associated had supplied evidence of use of the METRO trade mark in relation to newspapers in the last five years. Bird & Bird responded that it had provided proof of use in relation to the trade mark in proceedings that were the subject of decision BL O/254/11; this decision, inter alia, dealt with genuine use of registration no 1586405. Bird & Bird wrote in the above letter that before Associated's evidence was submitted the issue of genuine use in relation to *newspapers* was not an issue between the parties. However, the decision shows

that evidence in relation to use for *newspapers* was included in the witness statement of Richard Mead; at the hearing the other party accepted that there had been genuine use in relation to *newspapers*. Bird & Bird noted in its letter that Mr Mead left *Metro* in 2011.

69) Consequent upon Mr Mead's departure, it was appropriate for Associated to furnish a witness statement from another person, as there may have been a request for cross-examination and different periods are in play. A simple check of the Intellectual Property Office's website would have found BL O/254/11. Bauer could have requested a copy of the file from the Intellectual Property Office, which would have included the all the non-confidential matter. In a letter of 11 February 2014 from Urquhart-Dykes & Lord to Bird & Bird, it was noted that Bird & Bird had not supplied a copy of evidence from BL O/254/11, as noted above it could have requested a copy of the evidence from the Intellectual Property Office. In a letter of 11 February 2014 Urquhart-Dykes & Lord considered that the quantum of costs to be excessive taking into account that Associated had filed evidence in relation to proof of use in BL O/254/11. It does not challenge that the costs were incurred but that the amount claimed is excessive. The costs were incurred by Associated in relation to evidence that Bauer knew full well would serve no purpose. It is difficult to disagree with Mr Speck that the request for proof of use was an action that he characterised as being bloody minded. Bauer set this particular hare running and must bear the consequences for its course of action. As per the submission of Mr Speck, an award of £5,000 will be made in respect of the evidence filed in relation to proof of use.

70) Mr Malynicz sought costs outwith the scale on the basis that this application was an abuse of process, owing to the allegedly contradictory position that Associated took in relation to BL O/241/13. There is no inherent contradiction in the application for partial revocation for non-use of one of Bauer's trade marks and a claim of likelihood in confusion between *newspapers* and *advertising*. The criteria for genuine use and similarity of goods and services are different. The submission of Mr Malynicz in relation to this is without merit.

71) Associated, having been successful, is entitled to a contribution towards its costs. Costs are awarded upon the following basis:

Official fee	£200
Preparing a statement and considering the other side's statement:	£300
Preparing evidence and considering and commenting on the other side's evidence (including the off the scale award):	£6,000
Preparing for and attending a hearing:	£1,000
Total:	£7,500

Bauer Radio Limited is ordered to pay Associated Newspapers Limited the sum of £7,500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 14th February 2014

**David Landau
For the Registrar
the Comptroller-General**

ⁱ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

ⁱⁱ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

ⁱⁱⁱ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^{iv} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 and *The Sunrider Corporation v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-221/12* para 30 et seq.

^v *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{vi} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- (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.”

^{vii} “In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

^{viii} *Sabel BV v Puma AG* Case C-251/95.

^{ix} *Sabel BV v Puma AG* Case C-251/95.

^x *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

^{xi} *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xii} *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-336/03:

“75 It should be noted in this regard that the attention of the consumer is usually directed to the beginning of the word (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-0000, paragraph 83).”

^{xiii} *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

^{xiv} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{xv} *Sabel BV v Puma AG* Case C-251/95.

^{xvi} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xvii} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.