

**O-549-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL  
REGISTRATION NO. 1334209  
BY MILLS INTERNATIONAL TRADING PTY LTD FOR PROTECTION OF THE  
FOLLOWING TRADE MARK IN CLASS 7:**

**EDISONS**

**AND**

**OPPOSITION THERETO  
UNDER NO. 409979 BY EDISON S.P.A.**

## BACKGROUND & PLEADINGS

1. On 24 August 2016, MILLS INTERNATIONAL TRADING PTY LTD (“the holder”) designated the above International Registration (“IR”) for protection in the UK. It was accepted and published in the Trade Marks Journal on 9 June 2017 in respect of the following goods:

**Class 7:** Chain saws; cement mixers (machines); lawn and garden tilling machines; powered garden trimmers; hedge trimmers (machines); power operated hedge trimmers; hammer drills; power hammers; power operated hammers; powered hammers; electric jacks; jacks (machines); lifting jacks (other than hand-operated); power operated jacks; electric lawnmowers; lawnmowers (machines); ride-on lawnmowers (machines); log splitters (machines); power-operated apparatus for the maintenance of lawns; lawn mowing attachments [machines] for vehicles; machines for use in the preparation of lawns; motor driven lawn mowers; power operated lawn edging tools; drill machines; electric drilling machines; electric welding machines; machines for use in grass cultivation; nailing machines; high pressure washers; electric saws; power saws; saw blades (parts of machines); saw blades for use with power tools; saw chains; saws (machines); shredders (machines); tillers (machines); tree pruners (machines); apparatus for electric welding; gas welding apparatus; gas welding machines; machines for welding (electric); machines for welding (gas); welding apparatus, electric; welding apparatus, gas-operated; welding current generators; welding machines, electric; electric winches; winches; welders, electric; plasma cutting machines; loading ramps; brush cutters (machines).

2. On 9 August 2017, the IR was opposed in full by Edison S.p.A. (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the opponent relies upon the following trade mark:

European Union Trade Mark (“EUTM”) 11980729:

EDISON

Filing date: 12 July 2013

Registration date: 16 January 2015

The opponent indicates that it relies upon all goods and services for which its earlier mark is registered, namely:

**Class 4:** Electrical energy, Oil, Fuel, Hydrocarbon fuels, Combustible gases, Methane gas, Propane gas, Natural gas, Gas for lighting, Coal, Fuels derived from tar, Gasoline, Kerosene, Naphtha, Diesel fuels, Additives for fuels, Benzene, Benzol, Coking coal, Cutting fluids, Ethanol, Gas oil, Lanolin, Industrial oils and greases; Lubricants; Dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; Candles, wicks (lighting).

**Class 7:** Alternators; Exhausters, Belts for motors and engines, Bicycle dynamos, Mixing machines, Air compressors, Machines for the compression, exhaustion and blowing of gas, Centrifugal machines, Power operated saws, Motorised excavators, Cutters, Punching machines, Apparatus for welding, Extractors for mines, Fuel pumps, Fuel conversion pumps, Fuel savers, Aerators, Belts for machines, Bulldozers; Centrifuges (machines); Coalcutting machines; Concrete mixers [machines]; Condensing installations; Control cables for machines, engines or motors; Materials handling machines; Crushing machines; Electric scissors; Derricks; Drainage machines; Drilling machines; Dynamos; Earth moving machines; Electric hammers; Elevator belts; Elevators [lifts]; Motors and engines (except for land vehicles); Excavators; Extractors for mines; Filtering machines; Foundry machines; Fuel conversion apparatus for internal combustion engines; Blowing machines for the compression, exhaustion and transport of gases; Aerators; Generators (current -); Electrical generators; Mincing machines; High pressure washers; Hydraulic engines and motors; Hydraulic turbines; Igniting magnetos; Machine tools; Metalworking machines; Milling machines; Mine borders; Molding machines; Oil refining machines; Ore treating machines; Pneumatic hammers; Basket presses; Propulsion mechanisms other than for land vehicles; Pulleys (parts of machines); inflators; Robots (machines); Roller bearings; Separators; Sewage pulverisers; Steam/oil separators; Stone working machines; Transmission chains other than for land vehicles; Pneumatic tube conveyors; Hydraulic turbines; Turbocompressors; Valves (parts of machines); compacting machines for waste; Garbage disposals, waste disposal machines; Electrical generators using solar cells.

**Class 9:** Solar panels.

**Class 11:** Solar collectors for heating, Heat accumulators, Steam accumulators, Atomic piles, Nuclear reactors, Autoclaves, Pressure cooking saucepans, electric, Bath installations, Bread-making machines; Burners, flues, chromatography apparatus for industrial purposes, electric coffee makers, coffee filters, gas condensers, chilling apparatus and installations, apparatus for dehydrating food waste, desalination installations, extermination apparatus, distillation apparatus, drying devices, fuel economisers, heating apparatus and installations, fans for air conditioning, bathroom accessories, domestic fireplaces, flues, freezers, furnaces, not for laboratory use, gas boilers, heat pumps, humidifiers, hydrants, hydromassage apparatus, ice boxes, incinerators, ionisation apparatus for the treatment of air, dryers, boilers, treatment installations for fuel and nuclear material, installations for the processing of nuclear fuel and nuclear material, installations for the purification of waste water, electric radiators, refining towers for distillation, refrigerating apparatus and machines, refrigerators, heat regenerators, roasters, safety accessories for water or gas apparatus and tubes, showers, washbasins, solar furnaces, solar thermal collectors for heating, steam boilers, installations for steam generating, sterilisers, stoves, installations for ventilating and air conditioning, taps (faucets), thermostat valves (parts of heating installations), toilets (water closets), projectors, thermal solar panels for heating, water conduits and installations, water distribution installations; Water filtration apparatus, Apparatus for water suction, Water or gas apparatus and pipes (regulating accessories for-), Water or gas apparatus and pipes (safety accessories for -), Water purification installations, Watering machines for agricultural purposes, Pipes and tubes for sanitary installations, Thermal solar panels.

**Class 16:** Paper, cardboard and goods made from these materials, not included in other classes; Printed matter; Bookbinding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Instructional and teaching material (except apparatus); Printers' type; Printing blocks.

**Class 35:** Import-export agencies in the field of energy; Management support and consultancy in the energy sector.

**Class 36:** Insurance; Financial affairs; Monetary affairs; Real estate affairs in relation to industrial installations.

**Class 37:** Construction, repair and installation of industrial installations for generation and distribution of electrical energy; Construction, repair and installation of industrial installations for extraction, refinement and distribution of fuel; Construction, repair and installation of industrial installations for generation and distribution of water.

**Class 39:** Distribution of energy; Distribution of gas, electricity and fuels; Distribution and supply of water; Transport; Transport of refuse; Warehouse and storage services; Storage and warehousing of electricity, gas, fuel and water; Warehousing and Storage of waste; Rental of energy installations to others; Rental of energy networks and lines to others; Rental of water distribution installations; Rental of networks and conduits for electricity, gas, fuel and water; rental of storage units.

**Class 40:** Production of energy; Generation and production of electricity; Production and generation of gas, fuel, motor fuel, petroleum and hydrocarbons; Treatment of gas, fuel, petroleum, refuse and water; Refinement of gas, fuel, motor fuel, petroleum and hydrocarbons; Environmental reclamation and soil reclamation; Decontamination; Waste treatment services and Water; Treatment of materials for the generation of electricity, natural gas and motor fuel; Drilling of oil wells; Drilling in natural gas fields; Rental of equipment for treatment of gas, fuel, petroleum, refuse and water; Rental of equipment for drilling in natural gas fields or of oil wells.

**Class 41:** Education; Organisation of conferences as well as of seminars, workshops, lectures and other similar educational meetings; Providing recreation facilities; Sporting and cultural activities.

**Class 42:** Research in the field of construction, repair and installation of industrial installations for the generation and distribution of electrical energy and of industrial installations for extraction, refinement and distribution of fuels; Prospecting for hydrocarbons, gas, petroleum and water.

3. In its written submissions, the opponent says of the competing marks:

*“3. ...The Applicant’s mark EDISONS is so close to the earlier mark EDISON that, for identical and closely similar goods, it is obvious that they would be directly mistaken for one another.*

*For the other similar goods, there is also a likelihood of direct confusion, due to the lack of any visual, aural or conceptual means to differentiate between the marks.”*

4. In its counterstatement, the holder denies the basis of the opposition, stating specifically:

*“3. It is not admitted that there is similarity between the mark the subject of the earlier registration and the mark the subject of the application.*

*4. it is denied that registration No. 11980729 is similar to an earlier mark and registered for similar goods to the earlier mark”.*

5. The holder in these proceedings is represented by Kilburn & Strode LLP and the opponent is represented by Haseltine Lake LLP. The holder filed submissions during the evidence rounds; the opponent filed written submissions in lieu of a hearing. This decision is taken following a careful reading of all the papers which I will refer to, as necessary.

#### **Preliminary issue - Statement of case**

6. I note the holder’s submission regarding the opponent’s alleged failure to provide a full statement of case (both at pleadings stage and during the evidence rounds). It

suggests that the registry, in response, deem the above opposition inadmissible. The holder cites various guidance taken from the Trade Mark Rules (2008), the Trade Marks Manual and Tribunal Practice Notices 2/2004 and 4/2000. It also refers specifically to question five of the form TM7, which the opponent opted not to complete.

7. To provide clarification for both parties, I refer to the TM7 itself, which is aptly headed '*Notice of opposition and **statement of grounds***' (my emphasis). Essentially, the form does not require a supplementary statement of case as it is constructed and worded in such a manner that parties provide adequate (and relevant) information simply by correctly completing it.

8. Question five of the TM7 states:

“Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.”

9. While this question allows the opposing party an opportunity to provide additional information, it is by no means a mandatory requirement. The tribunal has reviewed the pleadings and is satisfied that ample information has been provided to enable it to reach an effective decision.

## **DECISION**

10. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

11. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. With a filing date of 12 July 2013, the opponent’s mark qualifies as an earlier trade mark under the provisions outlined above. In accordance with section 6A of the Act, as it had not been registered for five years or more at the publication date of the IR, it is not subject to the proof of use requirements.

### **Section 5(2)(b) - Case law**

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

### **The principles:**

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

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

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

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

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

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

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

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

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

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

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

### **Comparison of goods**

14. I begin by noting that the holder seeks to establish a clear distinction between the parties' goods based on the respective settings in which they are actually used, claiming specifically that, for the most part, the goods of the application will be used in a domestic setting whereas the opponent's goods will be used in an industrial setting.

15. In *Oakley v OHIM*, Case T-116/06, it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks, ...cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors...”

In accordance with the above case law, both parties' full range of goods and/or services contained within their specifications will be considered without limit to the current markets they may target.

16. I have reviewed each specification in its entirety and the goods comparison provided by each party, which I will refer to as necessary. Given the nature of the holder's goods, I find it sufficient for the purposes of this comparison to consider only the goods in class 7 for which the opponent's mark is registered, since the goods and services in the other classes put the opponent in no better position.

17. The opponent concludes that all goods in the opposed application are either similar or identical to those for which the opponent's earlier mark is registered. The holder, on the other hand, submits that:

*"28. ...the goods in the Application are not similar nor identical to any of the goods on which the Opposition is based."*

18. When conducting a goods comparison, I refer to *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-133/05, in which the General Court (GC) stated:

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

19. I am also guided by the relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity which were as follows:

(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.

20. In respect of the complementary relationship between goods, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

21. For the purposes of considering the similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O/399/10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

22. I agree with the opponent’s findings in respect of the goods displayed in the table below, which it concludes are identical. Where appropriate, I have made reference to the term(s) in the opponent’s specification where I find there to be identity in accordance with *Meric*.

Holder’s goods	Opponent’s goods	
Chain saws  I reach the same conclusion in relation to: <b>electric saws; power saws</b> and <b>saws (machines)</b>	Power operated saws; electric saws; power saws	Identical

Hammer drills; drill machines; electric drilling machines	Drilling machines	Identical
Lawn and garden tilling machines; tillers (machines)  I reach the same conclusion in relation to: <b>machines for use in the preparation of lawns</b>	Earth moving machines	Identical
Electric welding machines; apparatus for electric welding; gas welding apparatus; gas welding machines; machines for welding (electric); machines for welding (gas); welding apparatus, electric; welding apparatus, gas-operated; welding current generators; welding machines, electric; welders, electric	Apparatus for welding	Identical
High pressure washers	High pressure washers	Identical
Cement mixers (machines);	Mixing machines; concrete mixers [machines]	Identical
Power operated hammers; powered hammers  I reach the same conclusion in relation to: <b>power hammers</b>	Electric hammers; pneumatic hammers	Identical

I will consider each of the holder's remaining goods in turn.

**Electric lawnmowers; lawnmowers (machines); ride-on lawnmowers (machines); lawn mowing attachments [machines] for vehicles; motor driven lawn mowers**

23. The fundamental purpose and, therefore, an essential function of each of the above goods, is to cut, specifically grass. "Cutters", from the opponent's specification,

has a seemingly wider remit likely to comprise goods which are suitable for cutting a variety of materials, including grass. In my view, the term “cutters” is broad enough to include lawnmowers (effectively machines for cutting grass) and so, the goods are identical. Even if I am wrong on that and the term “cutters” would not include lawnmowers, the term would at the very least include other types of machines or powered tools which could be used to cut grass. This would result in an overlap in the use of the respective goods. In my view, from this perspective, there is likely to be an overlap in their users, and inevitably some similarity in the goods’ physical nature as all are machinery items with a cutting mechanism. There may also be some similarity in their trade channels and in-store locations. I do not find the goods to be directly competitive, although there could be a complementary relationship forming a range of machines to cut grass. On balance, I find the goods to be similar to a medium degree.

**Powered garden trimmers; hedge trimmers (machines); power operated hedge trimmers; power operated lawn edging tools; tree pruners (machines); brush cutters (machines); power-operated apparatus for the maintenance of lawns; machines for use in grass cultivation**

24. Again, my primary finding is that the goods are identical on the basis of inclusion within the broad term “cutters”, which would include goods for cutting hedges, trees etc. As per lawnmowers assessed above, I would, if my primary finding is incorrect, still find that the above goods are similar to a medium degree. Furthermore, the above goods are likely to share users, trade channels and some physical attributes with “power operated saws” from the opponent’s specification. Each of the goods could also be operated in a garden environment and have a similar purpose and trade channel. In my view, this reaffirms the finding that the degree of similarity rests at a medium level (if I am wrong on identity).

**Electric jacks; jacks (machines); lifting jacks (other than hand-operated); power operated jacks; electric winches; winches; loading ramps**

25. The opponent’s mark is registered for “materials handling machines”. When approached literally, this clearly grants it protection for machines which handle materials. Being placed in class 7 indicates that the above goods are articles of

machinery and each, by nature, will inevitably be required to handle, if not transport, a variety of materials. Thus, the above goods fall within the ambit of the opponent's registration. If this is not sufficient to render the goods identical under *Meric*, I find them to be similar to a fairly high degree based on their respective uses, users and channels of trade, which are likely to be very similar.

### **Plasma cutting machines**

26. In accordance with the *Meric* approach, the above could appropriately be categorised as "cutters", for which the opponent's mark is registered, leading to a finding of identical goods. If this conclusion is too liberal and a plasma cutting machine would not be classed as a cutter, I make the following observations in respect of the goods' similarity, based on the guidance provided in *Treat*. As its name suggests, the above provides a similar function to the opponent's "cutters", i.e. each is intended to cut. To my knowledge, plasma cutting machines are predominantly used to cut metal. "Cutters" could also refer to machinery or tools which cut metal, resulting in a highly similar use. There will be some similarity in the goods' users. If the goods are not identical then there will be some difference in their physical nature sufficient to account for their contrasting methods; using plasma versus a traditional blade, for example. There will be some similarity in the respective trade channels and there is a chance that the goods could occupy competitive roles, particularly if a user was seeking an outcome which each could accomplish. All things considered, I find the goods to be similar to at least a medium degree.

### **Log splitters (machines)**

27. To my knowledge, log splitters are machines which divide logs (by splitting) into smaller pieces. The same result could be achieved by the opponent's "cutters", at least those that are suitable for use with wood. The method of separation, however, at least as I understand it, is not the same, likely to be based upon sawing as opposed to splitting. There is likely to be some similarity in the goods' users and the goods may be subject to the same trade channels. Their contrasting methods are likely to limit the possibility for competition as the user will need either a cutter or a splitter (or perhaps both). On balance, I find the goods to be similar to a medium degree.

**Saw blades (parts of machines); saw blades for use with power tools; saw chains;**

28. When considering the above goods, I refer to the principles outlined in *Boston Scientific Ltd* regarding goods' complementarity. The opponent's earlier mark is registered for "power operated saws". The above goods are, fundamentally, essential component parts or accessories for saws. The competing goods are self-evidently indispensable for the use of one another, to the extent that the average consumer, who will be the same in both cases, is likely to assume that they originate from the same undertaking. One being an essential part or accessory for the other, their physical nature will certainly differ, though there will be a degree of similarity between the blade and a whole saw when sold together. The trade channels are identical and the goods are likely to be positioned in fairly close proximity in the relevant store. The goods are similar to a fairly high degree.

**Shredders (machines);**

29. In its written submissions, the opponent identifies a similarity between the above goods and "crushing machines", "mincing machines" and "waste disposal machines" from the earlier mark. Each of the above goods are essentially machines intended to dispose of or condense materials and, as such, serve a highly similar purpose. "Shredders" includes small domestic machines and much larger industrial machinery for use by businesses. There is some overlap in the users of the respective goods and the operation and nature will be similar to the extent that the material to be processed will have to be placed into the machine and there will be a way of collecting the material once it has been processed. There is also likely to be some overlap between the respective trade channels and some proximity in stores and on websites. I do not consider the goods to be competitive as each is likely to have bespoke limitations including materials catered for and the extent of disposal provided. With the above factors in mind, I find the goods to be similar to a medium degree.

**Nailing machines**

30. I consider the above alongside “electric hammers”, for which the opponent’s mark is registered. The goods share a highly similar purpose insofar as both are used to assist their user in inserting a nail into something, though they operate in notably different ways. There is likely to be a significant overlap in their respective users. To my knowledge, while there will be a degree of similarity in their physical nature, this will not be at a high level. The goods’ trade channels are often the same and it would not be unusual for there to be some proximity in their location in-store or online. As a consequence of their highly similar use, the goods are likely to be competitive at times. On balance, I find the goods to have at least a medium degree of similarity.

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

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

32. The average consumer for the goods at issue in these proceedings is likely to be either a member of the general public or a professional. In either case, the goods are most likely to be the subject of self-selection from catalogues, websites and traditional bricks and mortar retail outlets. This suggests that the selection of such goods will predominantly be made on a visual basis, though aural considerations cannot be ignored as, in my experience, it would not be unusual for advice to be sought by the purchaser or offered by a trader.

33. When selecting tools or machinery of the nature already specified, consumers may consider factors such as quality, longevity, compatibility and so on. The respective goods are available in a relatively broad range of prices but are rarely inexpensive and will be purchased fairly infrequently. As such, the purchase is unlikely to be impulsively made and will, instead, be subject to a reasonably considered selection process. Regardless of cost, the average consumer is likely to pay a slightly higher than average degree of attention (but certainly not of the highest level), necessary to determine the product's suitability for its intended purpose.

### **Comparison of trade marks**

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

35. It would be wrong, therefore, to artificially dissect the trade 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 they create. The trade marks to be compared are:

<b>Opponent's trade mark</b>	<b>Holder's trade mark</b>
EDISON	EDISONS

36. The opponent's mark comprises a single word, presented in plain block capital letters. It is in the totality of this word that the mark's distinctive character and overall impression lies.

37. The holder's mark comprises a single word presented in slightly elongated block capitals. It is the totality of this word that strongly dominates the overall impression of the mark and within which its distinctive character and overall impression lies. The mark's stylisation plays only a very small role.

### **Visual comparison**

38. The opponent's trade mark and the holder's registration consist of six and seven letters respectively. The six letters which represent the opponent's mark in its entirety are identical to the first six letters of the holder's mark which is rendered complete by the addition of a final letter 'S'. With the stylisation of the holder's mark doing little to distinguish, I find the competing marks to be visually similar to a very high degree.

### **Aural comparison**

39. The presence of (or absence of) the letter 'S' is all that separates the formation of the words within the respective marks from an aural perspective. As a result, there will be little aural distinction between the two. Both are likely to be articulated in a total of three syllables (namely 'ED-I-SUN' and 'ED-I-SUNS'), two of which are identical and the third of which is highly similar. On balance, the marks possess an extremely high degree of aural similarity.

### **Conceptual comparison**

40. In its written submissions, the opponent states the following:

*"1. ...The average consumer will see the applicant's mark as merely the possessive or plural version of the Opponent's mark. They are accordingly conceptually identical".*

41. The holder, in contrast, submits:

*“16. From a conceptual point of view, the word sign EDISON is internationally recognised by the relevant public to be the name of the famous inventor and pioneer in the energy sector, Thomas Edison. There was only one Edison. Edison never appeared in the plurality. Edison is particularly renowned for inventing the lightbulb, as well as a system for electric distribution. The word sign EDISONS, however, may be understood as being a common surname by the relevant public... The signs mean, evoke, and represent different conceptual meanings and are therefore not similar from the conceptual point of view.*

*17. ...The allusion to electrically powered goods being related to the specific inventor of the electric lightbulb results in a very particular semantic content of the earlier mark. The relevant public is therefore capable of immediately grasping the meaning of the EDISON mark. That one of the marks has such a meaning is sufficient to counteract, to a large extent, the visual and aural similarities between the two marks (T-292/01 Phillips-Van Heusen v OHIM).*

*18. It is therefore submitted that the marks are conceptually dissimilar, to the extent that any purported visual and aural similarities are counteracted.”*

42. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

43. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

*“36...By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care*

has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a Native American tribe. This is a matter that can easily be established from an encyclopedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

44. Similarly in this case, I am aware that Thomas Edison was an inventor. However, in the absence of any evidence from the parties to the contrary, I am not able to take judicial notice of the fact that the average consumer for the goods at issue would know this. Instead, I find it more likely that 'EDISON' will be viewed purely as a name, without any specific connotation or additional conceptual indication. In this case, I agree with the opponent's conclusion that the addition of an S (in the holder's mark) will be viewed as EDISON in its plural or possessive form, indicative of an entity (or entities) or person (or persons) known as EDISON.

45. In the event that the average consumer *does* immediately bring to mind Thomas Edison, the same reasoning will apply. If 'EDISON' is enough to evoke this concept, 'EDISONS' is likely to do the same, the addition and position of the 'S' having little impact on the word's conceptual significance. In either case, the competing marks will both be seen as the same name in the singular, plural or possessive form. Regardless

of whether the average consumer attaches a specific individual to the name itself, it will do so (or not do so) consistently across both marks. I find they are conceptually similar to a high degree.

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

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

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

47. I note the holder’s submission regarding the distinctive character of the opponent’s mark and the level of protection it should be awarded as a consequence. It states:

“32. ...*The EDISON mark is not distinctive, as the relevant consumer would naturally associate the mark with goods and services related to energy, given the fame of the name, Edison. As such, the mark should be afforded a lesser degree of protection than for a mark with a highly distinctive character.*”

48. Without evidence to aid my assessment of the distinctive character of the opponent’s earlier trade mark, I have only its inherent characteristics to consider. It is widely accepted that words which are invented possess the highest degree of distinctive character, whilst words which are suggestive or allusive of the goods and/or services relied upon may possess a lower level. To my mind, ‘EDISON’ will simply be seen as a name, which to some consumers will bring Thomas Edison to mind and for

others it will not. In either case, this is a normal trade mark possessed of a medium degree of inherent distinctive character.

### **Likelihood of confusion**

49. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them retained in its mind.

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

51. Earlier in this decision I reached the following conclusions:

- I have found some of the competing goods to be identical. Where this is not the case, the degrees of similarity range from medium to fairly high;
- The average consumer is a member of the general public or a professional tradesperson who will select the goods predominantly by visual means. I do not, though, discount an aural element;
- A slightly higher than average degree of attention will be paid to the selection of the goods to the extent necessary to determine, for example, compatibility, quality and so on;
- The competing trade marks are visually, aurally and conceptually similar to a high degree;

- The opponent’s trade mark possesses a medium degree of inherent distinctive character.

52. Keeping in mind each of the above findings, I have no hesitation in concluding that direct confusion is likely to arise in relation to goods which are identical or highly similar. Even when considering a likelihood of confusion based on less similar goods, “log splitters” and “cutters”, for example, the marks’ similarity, together with the nature of the goods and their relationship to one another, in my view, will still result in confusion as to their economic origin. It follows that confusion will exist in respect of each of the remaining goods (which I have found to have the same or a higher degree of similarity). Indeed, it is worth saying that even had the goods been similar to only a low degree, I would likely have come to the same conclusion.

### **Overall conclusion**

**53. The opposition has been successful and, subject to any successful appeal, the application will be refused.**

### **Costs**

54. As the opponent has been successful, it is entitled to a contribution toward its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and reviewing the counterstatement:	£200
Written submissions:	£200
Official fee:	£100
<b>Total:</b>	<b>£500</b>

**55. I order MILLS INTERNATIONAL TRADING PTY LTD to pay Edison S.p.A the sum of £500. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 4<sup>th</sup> day of September 2018**

**Laura Stephens  
For the Registrar**