

O-112-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2568358  
BY BDL INTERIORS LIMITED TO REGISTER THE TRADE MARK**

A handwritten signature in black ink, appearing to read "Ben de Jij". The signature is written in a cursive, flowing style with a small dot at the end of the final stroke.

**IN CLASSES 11, 19, 20, 21 AND 24**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NOS 102907  
BY PINMILL B.V.**

## **BACKGROUND AND PLEADINGS**

1) On 6 January 2011, BDL Marketing applied under the Trade Marks Act 1994 ("the Act") for registration of the following mark:



2) The application is in respect of the following goods and services:

### **Class 11**

*Apparatus for lighting, heating, drying, ventilating, water supply and sanitary purposes; bathroom furniture; bathroom fixtures; bathroom fittings; bathroom installations; basins; sinks; bathroom suites; baths; toilets; heated towel rails; radiators; sanitary ware; taps; lavatory pans; shower pans; parts and fittings for all the aforementioned goods*

### **Class 19**

*Building materials (non-metallic); tiles; bathroom tiles; kitchen tiles; floor tiles; glass tiles; shower screens; parts and fittings for all the aforementioned goods.*

### **Class 20**

*Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; kitchen furniture; bathroom furniture; kitchen cabinets; bathroom cabinets; bathroom shelves; kitchen shelves; vanity units; mirror tiles; parts and fittings for all the aforementioned goods*

### **Class 21**

*Household or kitchen utensils (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; un-worked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; towel rails; parts and fittings for all the aforementioned goods.*

**Class 24**

*Textiles and textile goods; towels; face towels; face cloths; bath towels; hand towels.*

3) The application was subsequently assigned to BDL Interiors Limited (“the applicant”).

4) The application was published in the Trade Marks Journal on 21 October 2011 and on 19 January 2012, Pinmill B.V. (“the opponent”) filed notice of opposition to the application. The single ground of opposition is that the application offends under Section 5(2)(b) of the Act because consumers will be confused between the applicant’s marks and a mark in the name of the opponent, the relevant details of which are reproduced below. In making this claim, the opponent notes the prominence of the word BEN in both marks and the fact that they are in a similar script-type font. Further, it claims that the respective goods are either identical or similar.

Mark details	List of goods and services
<p>Community Trade Mark (“CTM”) 4688751</p>  <p>Filing date: 17 October 2005</p> <p>Registration date: 8 January 2007</p>	<p><b>Class 11:</b> <i>Bath installations, bathtubs, bath tubs for sitz baths, bath linings, heaters for baths; apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and water supply purposes.</i></p> <p><b>Class 19:</b> <i>Non-metallic tiles, including floor and bathroom tiles.</i></p> <p><b>Class 20:</b> <i>Bathroom furniture.</i></p> <p><b>Class 35:</b> <i>Advertising; business management; business administration; office functions; purchase and sale of bathroom installations, baths, bath tubs for sitz baths, bath linings, heaters for baths, apparatus for lighting, heating, steam generating, cooking, cooling, drying, ventilating and water supply purposes, non-metallic tiles, including floor and bathroom tiles and bathroom furniture.</i></p> <p><b>Class 36:</b> <i>Insurance; financial affairs; leasing (financing) bathrooms.</i></p> <p><b>Class 37:</b> <i>Construction, design, installation, maintenance and repair of bathrooms.</i></p> <p><b>Class 39:</b> <i>Transport; packaging and storage of goods, in particular bathrooms.</i></p>

4) The mark relied upon by the opponent qualifies as an earlier mark under Section 6 of the Act by virtue of being registered and having a date of filing earlier than that of the contested application. The application was published on

21 October 2011 and the registration procedure for the earlier mark was completed on 8 January 2007. This is within the period of five years ending with the date of publication of the contested mark and consequently is not subject to the proof of use provisions set out in Section 6A of the Act. The consequence of this is that the opponent is entitled to rely on the full list of goods and services in its registration.

5) The applicant subsequently filed a counterstatement admitting that its Class 11 and Class 19 goods are identical or similar. With the exception of *bathroom furniture*, it denies the opponent's claim that its goods in Classes 20, 21 and 24 are similar. It denies all other claims. Further, or as an alternative, it claims concurrent use as it has been using its mark since at least 2004 and is not aware of any cases of confusion.

6) Both sides also filed written submissions that I will keep in mind but not summarise. The applicant also filed evidence. Both sides ask for an award of costs. Neither side requested to be heard and I make my decision after a thorough review of the papers.

### **Applicant's Evidence**

7) This takes the form of two witness statements. The first is by Benedetto de Lisi, director of the opponent company. Mr de Lisi explains that his Ben de Lisi designer collection started in around 1982 in respect of ladies clothing and that he started expanding the brand into interior design in 2001 and in 2004 he licensed the name to Abacus Direct Limited ("Abacus") for use on sanitary and bathroom wear.

8) Use of the mark changed to his signature in around 2006 when he began work "on a very large home range" for *Debenhams* department stores. He states that this range was branded with his signature in 2008 and it has been used on an ongoing basis since then. In addition to a clothing range, Mr de Lisi states that he licences the use of his name to *Debenhams* in respect of towels, bedding, bathroom products, home wear accessories, pictures, prints, ornaments and other goods not covered by his application.

9) At Exhibit BDL1, Mr de Lisi provides undated copies of photographs of goods sold by *Debenhams* and bearing the contested mark ("the signature mark"). The goods shown are a face cloth, what appears to be a decorative "clapper board" and mugs. At Exhibit BDL2 are extracts from *debenhams.com*, obtained from the web archive "waybackmachine". The first of these is dated 30 November 2009 and illustrates a canvas print, bed linen sets, a mug, a cushion, vases, a tea light holder, a crockery set, as well as a couple of unidentifiable goods. All are identified by the mark "Ben de Lisi" in ordinary typeface, but the signature mark is not shown. The second is dated 28 February 2010 and illustrates cushions, a beach towel, fleece throws, a cutlery set, mugs, and picture frames all identified

as being “Ben de Lisi” but the signature mark is not shown. The third and fourth are dated 7 September 2010 and 14 October 2010 and illustrate a variety of the same goods as the first two printouts and, in addition, wine glasses, a glass tumbler, a tea towel, a pair of oven gloves and a storage jar. Again, they are identified by the mark “Ben de Lisi” in ordinary typeface.

10) Mr de Lisi states that, for the year 2010/11, total retail sales were above £33 million of which £6.1 million relates to home accessories. He also provides figures for the two subsequent years that show a gradual increase in turnover.

11) Mr de Lisi is not aware of any confusion with regard to the use of his name.

12) The second witness statement is by Stephen Bradbury, Chairman and Director of Abacus. He describes how he approached Mr de Lisi in around 2004 with regard to using his name in respect of Abacus’ specialist ranges of bathroom furniture, sanitary wear, baths, towel rails and accessories. The licence was granted and Abacus used the name from that date. He explains that the word version of the mark was replaced by the signature version in 2008 and has been used since then.

13) Mr Bradbury provides copies of “various brochures” at Exhibit SB1. The exhibit has a cover sheet identifying the content as the “Ben de Lisi Hands and Faces Catalogue 2006”. This predates Abacus’ use of the signature mark at issue in these proceedings and no use is shown of this mark. Exhibit SB2 is a single page print from Abacus’ website that provides information about Mr de Lisi. The signature mark does not appear.

14) Mr Bradbury provides turnover figures relating to its Ben de Lisi branded goods. The figures provided between 2004 and 2007 cannot relate to the use of the signature version of the mark (as Mr Bradbury has stated that it was not used until 2008) but in respect of the years 2008 to 2011, turnover reduced from about £730,000 a year to about £260,000 a year. Further, he states that, to date, about £200,000 has been spent on promoting the brand and an additional £80,000 on launch costs.

15) Mr Bradbury states that there has been no confusion between the use of Abacus’ brand and any other.

## **DECISION**

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

16) Section 5(2)(b) reads:

“(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.”

17) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) 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; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

### **Comparison of goods**

18) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* (“*Canon*”) the CJEU stated at paragraph 23:

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

19) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited* (“*TREAT*”) [1996] RPC 281).

20) I also bear in mind the following guidance of the General Court (“the GC”) in *Gérard Meric v OHIM*, T-133/05:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

21) Finally, in terms of understanding what a "complementary" relationship consists of, I note 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 where it was stated:

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, th that effect, Case T-169/03 *Segio 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 *EI Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseno original Juan Bolanos)* [2007] ECR I-0000, paragraph 48)."

22) For ease of reference, the respective goods and services are:

<b>Opponent's goods and services</b>	<b>Applicant's goods</b>
<p><b>Class 11:</b> <i>Bath installations, bathtubs, bath tubs for sitz baths, bath linings, heaters for baths; apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and water supply purposes.</i></p>	<p><b>Class 11:</b> <i>Apparatus for lighting, heating, drying, ventilating, water supply and sanitary purposes; bathroom furniture; bathroom fixtures; bathroom fittings; bathroom installations; basins; sinks; bathroom suites; baths; toilets; heated towel rails; radiators; sanitary ware; taps; lavatory pans; shower pans; parts and fittings for all the aforementioned goods</i></p>

<p><b>Class 19:</b> <i>Non-metallic tiles, including floor and bathroom tiles.</i></p> <p><b>Class 20:</b> <i>Bathroom furniture.</i></p> <p><b>Class 35:</b> <i>Advertising; business management; business administration; office functions; purchase and sale of bathroom installations, baths, bath tubs for sitz baths, bath linings, heaters for baths, apparatus for lighting, heating, steam generating, cooking, cooling, drying, ventilating and water supply purposes, non-metallic tiles, including floor and bathroom tiles and bathroom furniture.</i></p> <p><b>Class 36:</b> <i>Insurance; financial affairs; leasing (financing) bathrooms.</i></p> <p><b>Class 37:</b> <i>Construction, design, installation, maintenance and repair of bathrooms.</i></p> <p><b>Class 39:</b> <i>Transport; packaging and storage of goods, in particular bathrooms.</i></p>	<p><b>Class 19:</b> <i>Building materials (non-metallic); tiles; bathroom tiles; kitchen tiles; floor tiles; glass tiles; shower screens; parts and fittings for all the aforementioned goods.</i></p> <p><b>Class 20:</b> <i>Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; kitchen furniture; bathroom furniture; kitchen cabinets; bathroom cabinets; bathroom shelves; kitchen shelves; vanity units; mirror tiles; parts and fittings for all the aforementioned goods</i></p> <p><b>Class 21:</b> <i>Household or kitchen utensils (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; un-worked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes; towel rails; parts and fittings for all the aforementioned goods.</i></p> <p><b>Class 24:</b> <i>Textiles and textile goods; towels; face towels; face cloths; bath towels; hand towels.</i></p>
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Class 11

23) The applicant admits that its Class 11 goods are similar. I would go further and say that, when applying the principles provided by the GC in *Meric*, the respective goods are identical.

Class 19

24) As with Class 11, the applicant concedes that the respective goods are similar. This is clearly not the case in respect of all of the applicant's goods, for example, *shower screens* have no equivalent in the opponent's specification and are arguably not similar to its *non-metallic tiles*. The applicant's specification also includes the broad term *building materials* that, whilst it covers *non-metallic tiles*, it will also include many goods that are not similar to such tiles.

Class 20

25) The opponent's specification consists of the single term *bathroom furniture* and is self-evidently covered by the applicant's term *Furniture* and, applying the guidance in *Meric*, these terms are considered to be identical. The applicant's specification also contains the identical term *bathroom furniture*. Further, the

following terms listed in the applicant's specification also include goods that are specifically designed/intended for bathrooms and, consequently, will also be covered by the term *bathroom furniture*:

*goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; bathroom cabinets; vanity units; parts and fittings for all the aforementioned goods*

26) In respect of *mirrors*, they may be specifically designed to be suitable for bathrooms or to match a range of bathroom furniture. Consequently, some types of mirrors are closely related goods to *bathroom furniture* and I find that these goods share a reasonable level of similarity. The term also includes *mirrors* that may be specifically adapted for use in living spaces other than bathrooms, for example, they may be designed to appeal to the consumer for use in a lounge, hall or dining room, or for use in non-domestic environments other than bathrooms. Such mirrors have only a low level of similarity to *bathroom furniture*. In respect of *mirror tiles; parts and fittings for [mirror tiles]*, these goods are self-evidently highly similar to the opponent's *non-metallic tiles* listed in its Class 19 specification. They share the same nature, intended purpose, methods of use and trade channels. In respect of *bathroom shelves*, such goods are not furniture, but may nonetheless, be designed to accompany a range of furniture and, consequently, may share a reasonable degree of similarity with *bathroom furniture*.

27) Of the remaining terms, *picture frames* are not obviously or commonly designed for use in bathrooms, neither are they generally considered to be "furniture" and, therefore, they are unlikely to be covered by the term *bathroom furniture*. The opponent claims that similarity exists with its retail services in Class 35 because the goods are all capable of being sold in the same outlets. It is not uncommon for traders in the furniture/household goods field to provide such a wide range of goods and there may be some overlap of trade channel. However, applying the other criteria set out in *Canon* and *Treat*, there is little else by way of similarity. Hence, any similarity is on the low side.

28) In respect of the applicant's *kitchen furniture; kitchen cabinets*, these are all goods specifically designed/adapted for use in kitchens rather than bathrooms. Nevertheless, they are the same in nature, intended purpose and methods of use. Further, there may be overlap in trade channels, as discussed above. Consequently, although they will be used in different locations in the home, they share a moderately high level of similarity. Finally, in respect of the applicant's *kitchen shelves*, these are not normally described as furniture and because they are designed for use in kitchens, it is not obvious to me how they may be similar to furniture for use in a bathroom. Consequently, I find that these goods are not similar.

### Class 21

29) The applicant's *towel rails; parts and fittings for all the aforementioned goods*, may be suitable for bathrooms, either through design or functions and accordingly, they are closely related goods to *bathroom furniture* and may even be designed to accompany a given range of *bathroom furniture*. Therefore, I find that these goods share a moderate level of similarity.

30) All of the applicant's remaining goods are different in terms of nature, intended purpose and method of use. Neither is it obvious that the respective goods share trade channels. Again, the opponent argues that as these goods may be sold in the same outlets as its goods, they are similar to its retail services in Class 35. Whilst large retailers may well sell both groups of goods, it is not normal for them to be sold in close proximity to each other, being sold in different parts of the store. Consequently, I conclude that even if there is any similarity, it is only on the low side.

### Class 24

31) The applicant's Class 24 goods, namely *Textiles and textile goods; towels; face towels; face cloths; bath towels; hand towels*, whilst they may all be goods that can be used in a bathroom, that is the extent of any similarity. The respective goods differ in terms of nature, intended purpose and methods of use and they cannot be said to be complementary in the sense described in *Boston Scientific*. The opponent argues that as these goods may be sold in the same outlets as its goods, they are similar to its retail services in Class 35. Once again, I do not rule out that this may occur in larger retailers, but once again, for the same reasons mentioned in the previous paragraph, this will result in no more than a very low level of similarity.

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

32) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

33) The range of goods and services covered by the parties' specifications are wide and varied. At one end of the spectrum there is *steel wool* and *brushes* that are affordable and very utilitarian in nature and are bought with no more than an average level of attention. At the other end of the scale, bathroom suites are considerably more expensive and are chosen with function and aesthetics in mind. Consequently, the purchasing process is more highly considered with

features, dimensions and aesthetics being considered in brochures, by viewing showroom examples and by discussion with a salesman.

34) Most of the parties' goods could be bought equally by members of the public or tradesman, but this is unlikely to materially affect the degree of attention paid. As it has been pointed out on behalf of the applicant, the various categories of goods at issue are likely to have different average consumers. I agree. For example, the average consumer for *towels* is not the same average consumer for *bath installations*, however, I do recognise that these different average consumers are drawn from the general public.

**Comparison of marks**

35) For ease of reference, the respective marks are:

Opponent's mark	Applicant's mark
	

36) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). The opponent's mark consists of the name BEN appearing in handwritten script with the words "Badkamers & Sanitair" in small script underneath. The mark is overwhelmingly dominated by the name BEN and this is the mark's dominant and distinctive element.

37) The applicant's mark consists of the full name BEN DI LISI appearing in handwritten script. The opponent cites case law to support its submission that the first part of the mark "is of prominent importance" and goes onto to infer that the BEN element of the applicant's mark is the dominant and distinctive element. I do not agree with such a conclusion. Whilst it is true that the first element of the mark will be the first element the UK consumer encounters (by virtue of reading from left to right), it is not particularly unusual. First names are not normally endowed with a high level of distinctive character. Certainly, the name BEN is not unusual and, in fact, is a common name in the UK. With many individuals sharing first names or surnames, the distinctive character of the applicant's mark resides in the combination of the two. In reaching this conclusion, I acknowledge that the surname present in the applicant's mark appears unusual and will have more distinctive character than a more common surname.

38) Turning to the visual comparison of the marks, the DE LISI element of the applicant's mark is absent in the opponent's mark and is an obvious point of

difference. Both marks share the element consisting of the first name BEN, but the opponent's mark features a capital "B" whereas the applicant's mark features a lower-case "B". There are some similarities in the handwritten style. The lower half of the letter "B" in both marks displays a looped link to the letter "E" and the letters "E" and "N" are similar in style. The opponent's mark also includes the words "Badkamers & Sanitair" that are subservient to the "Ben" component, both in terms of size and position. Taking all of these similarities and differences into account, I find that the respective marks share a low degree of visual similarity.

39) From an aural perspective, the applicant's mark consists of the four syllables BEN-DE-LI-SEE, whereas the opponent's mark consists of the single syllable BEN. I should say here, that it is my view that the words "Badkamers & Sanitair" will not be aurally expressed. Whilst the BEN syllable is shared in both marks, the additional three syllables present in the applicant's mark result in the aural similarity being no more than moderate.

40) Conceptually, the applicant's mark will be perceived as the handwritten full name of an individual male person. The opponent's mark will be perceived as a handwritten first name of an individual male person whose surname is unknown. These marks have no concept *per se* beyond being personal names. That said, the name "Ben" is used to designate any number of individuals, whereas the full name "Ben de Lisi" identifies one or only a very few individuals.

41) In summary, I have found that the respective marks share a low degree of visual similarity, no more than a moderate degree of aural similarity and that they have no concept, *per se*. This combines to give the marks a low to moderate level of similarity overall.

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

42) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

43) The opponent has provided no evidence of use and I, therefore, only have the inherent qualities to consider. In this respect, a common first name is not endowed with a particularly high level of distinctive character. The opponent's mark is presented in a handwritten form that is not unusual in any way and does not add, in any appreciable way, to the distinctive character of the mark. There is also the words "Badkamers & Sanitair" present, in a greatly subservient, to the BEN component. This element is close to being negligible when considering the mark as a whole. If this component is not negligible, its meaning will not be readily understood by the UK consumer, because it is in a foreign language. This

component is adds little, if nothing to the distinctive character of the mark. Taking all of this into account, I find that the opponent's mark is endowed with no more than a moderate level of distinctive character.

### ***Likelihood of confusion***

44) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

45) Both Mr de Lisi and Mr Bradbury state that they are not aware of any confusion in the marketplace. Firstly, this could be explained by the opponent not trading in the UK. Certainly there is no evidence before me to indicate that they are. Secondly, even if the opponent was using its mark in the UK, there is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little. See, for example, *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

46) In *Compass Publishing BV v Compass Logistics Ltd* Laddie J stated:

“22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark

uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

47) Consequently, I find that the alleged lack of confusion is not persuasive.

48) It is submitted on behalf of the opponent that the element “Badkamers & Sanitair” in its mark would not be seen as a distinguishing feature of its mark. I concur with this. The precise meaning of these words is not likely to be understood to the average UK consumer, but taking account of their position and relative size within the mark, these words may go unnoticed by the consumer. If they are noticed, the consumer is likely to assume that the words are descriptive in some way.

49) The main thrust of the opponent’s submissions is that the script used in both marks is very similar and that the word BEN is a recognisable name and the first element of both marks and as a consequence there is a real likelihood of confusion. It cites the following cases as supporting the contention that it is a commonly accepted principle that the beginning of the mark is of prominent importance when comparing marks: *Pfizer v Eurofood Link (UK)* [2001] FSR 3, *Jose Alejandro SL v OHIM - Anheuser-Busch (BUDMEN)* T-129/01 and *Medion*. It further points out that the addition of the family name DE LISI does not change the meaning of the first element. Whilst I accept that, in certain circumstances, the first element of a mark may have prominent importance, this is not a rule set down by the courts. Further, in the first two of these cases, the facts are markedly different to the current case. In the first, the court was commenting upon the likelihood of confusion between the marks VIAGRA and VIAGRENE. Both are invented words and not the names of individuals. In the second case, the court was considering the marks BUD and BUDMAN and found that the MAN element of the second mark was suggestive or descriptive (and, in effect, elevating the significance of the BUD element).

50) In the *Medion* case, the court commented as follows:

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive

even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

51) In the current case, the distinctive element of the earlier mark (being the stylised “BEN” component) is not reproduced in the applicant’s mark. Whilst both marks refer to the name BEN, and whilst there are similarities in style of presentation of this name, there are also noticeable differences such as use of a lower case “b” in the applicant’s mark and an upper case “B” in the earlier mark and the underlining of the letter “n” in the opponent’s mark. Consequently, it cannot be said that the applicant’s mark includes the whole of the distinctive component of the earlier mark. There are visual differences between these respective components. Therefore, I do not believe it is appropriate to apply the guidance from *Medion* to the circumstances of this case.

52) The first name “BEN” is common in the UK and consequently is endowed with no more than a moderate level of distinctive character resulting in it having a proportionately lesser capacity to distinguish one undertaking’s goods from another compared to signs with a higher level of distinctive character. It is my view that the hand-written presentation of the name does little by way of enhancing this level of distinctive character. It is presented in a normal, unremarkable hand-written form and the consumer is familiar with encountering hand-written names.

53) Further, where one mark comprises a common first name and the other mark consists of that common first name and an unusual (to the UK consumer) surname, the effect is to reduce the impact of the first name in the overall impression created by the composite mark. The consumer’s attention is likely to focus more upon the surname. The forename does, however, retain an independent distinctive character. Of course, as I have already discussed, the distinctive components of the respective marks in the current proceedings, are not just the forename BEN and the full name BEN DE LISI, but also include presentation in hand-written script. Whilst there are some similarities in this script, these are outweighed by the differences identified. Consequently, it is my view that such respective presentations do not support a finding of a likelihood of confusion.

54) This being the case, taking into account all the factors required in the global appreciation test, including that some identical goods are involved, that the

degree of distinctive character of the earlier mark is moderate and that there is only a low to moderate level of similarity between the marks, I find that there is no likelihood of confusion. In making this fact, I do not ignore the fact that the purchasing process is more highly considered than average. The first name BEN is common in the UK and, therefore, is *prima facie*, less likely than an a more unusual forename, to identify any one trader. This is especially so where the mark that it is compared with includes other distinctive matter such as the unusual surname, as in this current case. The visual and aural differences between the marks outweigh the similarities and, as such, enhance this finding.

55) Therefore, the consumer is not likely to assume that there is a connection between the goods and services provided under the opponent's mark and the goods provided under the applicant's mark. Consequently, the consumer is not likely to confuse one mark for the other (direct confusion) or believe that the respect goods and services originate from the same or linked undertaking (indirect confusion).

56) In summary, the opposition fails in its entirety.

## **COSTS**

57) The opposition having been failed, the applicant is entitled to a contribution towards its costs. In making the award, I take into account that the applicant filed evidence and that both sides filed written submissions in lieu of a hearing. I award costs on the following basis:

Considering Notice of Opposition and preparing statement in reply	£250
Preparing and filing evidence	£500
Preparing written submissions	£400
TOTAL	£1150

58) I order Pinmill B.V. to pay BDL Interiors Limited the sum of £1150. 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 this 11th day of March 2013**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**