

O-196-09

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND
THE TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 881731
IN THE NAME OF WKK NEDERLAND BV AND APPLICATION TO EXTEND
PROTECTION IN THE UK TO THE TRADE MARK**

HTI

IN CLASS 17

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 71412
BY HELLERMANN TYTON GMBH**

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THE TRADE MARKS ACT 1994**

**IN THE MATTER OF International Registration No. M 881731
in the name of WKK Nederland BV and application to extend protection in
the UK to the mark**

HTI in Class 17

and

**IN THE MATTER OF Opposition thereto under No. 71412
by Hellermann Tyton GmbH**

BACKGROUND

1) On 11th May 2006 the UK was notified by WIPO of international registration 881731 (having a registration date of 9th January 2006 and a priority date of 19th July 2005), in respect of which it had been designated under the relevant provisions of the Madrid Protocol (hereafter the "Protocol"). The relevant trade mark (hereafter "the designation") is as follows:

HTI

2) The designation stands in the name of WKK Nederland BV of Polluxstraat 1, NL-5047 RA Tilburg, Netherlands (hereafter "WKK") and covers the following goods:

Class 17

Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal; shrink sleeve

3) The designation was accepted and advertised for opposition purposes on 21st July 2006. On 20th October 2006 Hellermann Tyton GmbH (hereafter "Hellermann") of Großer Moorweg 45, 25436 Tornesch, Germany filed notice of opposition. The opposition was based solely on the provisions of section 5(2)(b) of the Trade Marks Act 1994 (hereafter "the Act"). Hellermann relied on their Community Trade Mark (hereafter "CTM") 3935781, the details of which are as follows:

HT

Filing and registration dates:

16th July 2004 and 16th April 2007 respectively

Specification:

Class 06:

Ironmongery, small items of metal hardware (except hinged bands), clips and binders of metal, seals.

Class 07:

Motor-driven tools and machines for electroassembly and packaging technology, in particular for fastening, bundling, connecting, separating, insulating, stripping, fitting with nozzles and covers, or for marking cables, cable joints and hoses.

Class 08:

Hand-operated tools; implements (hand-operated) for electroassembly and packaging technology, in particular for fastening, bundling, connecting, separating, insulating, stripping, fitting with nozzles and covers, marking, filling or sealing.

Class 09:

Electronic locks, electronic closing and access-monitoring apparatus.

Class 16:

Labels and signboards, included in class 16, hand labelling appliances, printed matter, printing apparatus.

Class 17:

Goods of rubber, gutta-percha, gum and plastics in extruded form for use in manufacture; bands, clips, nozzles, covers and seals of rubber, gum or plastic, in particular for fastening, bundling, enveloping or connecting cables, cable joints, pipes or hoses; packing, stopping and insulating materials, flexible pipes, not of metal

Class 20:

Goods of plastic, included in class 20, in particular bands (except hinged bands), clips, nozzles, covers and seals.

4) Hellermann say the respective marks are confusingly similar and that the goods covered in the designation are, in the case of class 17, identical to those covered by their mark. Alternatively, they are similar to Hellermann's goods. The designation should accordingly be refused under section 5(2)(b) of the Act. WKK responded by denying that the respective marks are similar, arguing that with two or three letter marks there is bound to be the possibility of a likelihood of closer

similarity than in a fuller length word, and that two letter marks should not debar the proprietor of a more distinctive three letter mark from registration. They also note that application had been made to WIPO to restrict the specification by a limitation, and that the consequence of this limitation (in respect of the UK only) was to render the goods in class 17 no longer similar to those in Hellermann's specification.

5) On 21st February 2008, the UK was notified by WIPO of the limitation referred to above. The specification of the international registration in respect of the UK was to read as follows:

Class 17

Shrink sleeve

6) In light of the limitation, Hellermann were asked in February 2008 whether they wished to continue with the opposition, and on 13th March 2008 they confirmed that they did wish to proceed. Following this, the matter proceeded to evidence rounds with both sides filing evidence and Hellermann filing evidence in reply. Both parties seek an award of costs and neither party wished to be heard, but both filed written submissions in lieu of a hearing. The evidence is summarised below.

Hellermann's evidence.

7) Julius Edward Benedick Stobbs has provided a witness statement dated 2nd June 2008. He is a trade mark attorney and partner of the firm representing Hellermann. Exhibit JEBS2 is a copy of the entry from Wikipedia, the well known user-generated, on line encyclopedia, relating to the term "heat shrinkable sleeve" (or commonly "shrink sleeve"). The article explains that such a sleeve is a corrosive protective coating for pipelines in the form of a wraparound or tubular sleeve applied in the field. The first heat shrinkable sleeves were developed 35 years ago when polyethylene pipeline coatings started to replace bitumenous or tape coatings. The article then explains the technology behind the sleeves.

8) Exhibit JEBS3 is a copy from the website belonging to a company – Shrink Sleeve Ltd which provides electrical, mechanical and decorative "heat shrink tubing" for use in a variety of applications. Shrink Sleeve Ltd describe their products as "flexible or semi-rigid, thick or thin wall, with or without adhesive inner lining, flame retarded or non-flame retarded, various ranges of shrink sleeve that offers excellent electrical insulator and high performance for all packing applications". Shrink Sleeve Ltd's products are invariably described as "tubing" on their website and show a range of products having different properties as mentioned above.

9) A further page from Wikipedia is exhibited also at JEBS2, this time covering the term “heat shrink tubing”. This explains that such tubing, referred to as “heat shrink” is used to insulate wires, connections and joints and terminals in electrical engineering. It can also be used to repair wires, bundle wires together and to protect wires or small parts from minor abrasion. It is manufactured from thermoplastic material such as polyolefin, fluoropolymer (eg FEP, PTFE or Kynar), PVC or other material. Heat shrink is placed over the connection to be protected and then heated, causing it to contract and as a result providing a snug and protective coat. A further application, explained in the article, is tamper evident seals used on bottles.

10) Also at exhibit JEBS2 is a copy of a page from the catalogue appearing on WKK’s own website showing that their own HTI branded products are offered under the heading “heat shrinkable tubing” rather than “shrink sleeves” suggesting, says Mr Stobbs, that WKK are fully aware that their own product is denoted by the term “tubing” rather than “sleeve”. The page shows use of the letters “HTI” in association with various numbers, eg HTI -201x, HTI-300x, HTI-55x, all coming under the main heading “Heatshrinkable tubing” and subsidiary heading “End caps and cable breakouts”. Mr Stobbs says that the web page shown as exhibits JEBS2 and JEBS3 clarify the nature of the goods applied for in the designation.

11) Finally, at exhibit JEBS4, there are the results of a GOOGLE® search on the words “shrink sleeve”. Also we have various pages from four of the websites located in the search. The first of these three is Shrink Sleeve Ltd whose pages have already been exhibited at JEBS3. The second is a company called CCL LABEL (“CCL”) who provide decorative sleeves for packaging products in a wide variety of market sectors such as food, beers, soft drinks and household products. These are described as “heat shrink sleeves” on their website. The types of sleeves illustrated are used for marketing purposes to show the identity of the product within the, eg spray bottle or other container and thus have printed matter on them. The third comes from a firm called GRAHAM ENGINEERING (ESSEX) LTD (“GRAHAM”) who are also engaged in the field of body decorative sleeves or tamper evident applications, however, unlike CCL, they seem to manufacture the sleeving systems themselves and self adhesive labelling machines required to produce the sleeves. Finally, there is a firm called KARLVILLE which, like GRAHAM, fabricates the machinery necessary to produce the sleeves. Mr Stobbs says that this evidence shows use of the term “shrink sleeves” in connection with the packaging industry, in addition to, the electrical industry as evidenced in JEBS2 and JEBS3.

12) I will say a little more in due course about what I understand to be the purpose behind Mr Stobbs’s evidence, but for the time being it suffices to note that items known as ‘shrink sleeves’ have a variety of applications ranging from pipelines, through to electrical tubing and decorative sleeves used for packaging.

WKK's evidence

13) Josef Kouwenberg provides a witness statement dated 23rd September 2009. He is a director of WKK. Much of his statement takes the form of submission rather than evidence of fact which may assist in the evaluation process. However, he notes that the buyers of his products are well informed educated specialists who will notice at first sight that the products do not originate from the same source, further that it is common in the relevant trade to use capital letters to designate products and that differences in a short succession of letters will be evident.

14) Exhibit JK1 is a GOOGLE® search on the letters "HTI" which shows that no hits relate to Hellermann's company or products.

15) Exhibit JK2 comprises the results of another GOOGLE® search, this time conducted by an associate of Mr Kouwenberg in Germany. This associate advises Mr Kouwenberg that "HT" refers to high-temperature polymer and thus Hellermann's mark lacks distinctive capability. The exhibit shows that the search was made in respect of the words "HT high temperature polymer".

16) Exhibit JK3 is a search conducted by WKK's counsel in the Netherlands of the UK and Community Trade Mark Registers showing that at least 17 trade marks in class 17 incorporate the letters "HT".

17) He says that use of the mark HTI has been made in the UK since 2005 and there have not been any instances of confusion. Exhibit JK4 is evidence of that use and shows dealings (messages) usually between Mr Kouwenberg and a firm called EASE Ltd (Euro-Asia Super Electricals) ("EASE") which is based in the UK represented by a Lyn Dai. These communications date back to 2001 and show that at least from that date, EASE were supplying Mr Kouwenberg with "HTI" branded electrical tubing. EASE's catalogue dating from 2001 shows various tubing described as "heat shrinkable tubings" having different properties, but it would seem, only electrical application. The various "HTI" designations are derived from EASE's Catalogue Codes.

18) Finally, he says of Mr Stobbs's exhibit JEBS2 that Wikipedia is an amendable (by anyone) online encyclopedia which has in fact been amended in relation to those entries exhibited at JEBS2 on 2nd September 2007 and 8th March 2008, after the date of filing the oppositions on 19th October 2006.

Hellermann's evidence in reply

19) This is again provide by a witness statement, dated 2nd March 2009, by Julius Stobbs. He says in response to the claim that "HT" means "high temperature" (Exhibit JK2 of WKK's evidence) that, firstly, the search having been conducted by an associate in Germany cannot have any significance when the subject

proceedings are UK based. To further refute this he says that Exhibit JEBS5 shows a printouts from the websites www.acronymfinder.com and www.acronymsthefreedictionary.com which show that the letters “HT” can refer to the phrase “high temperature” amongst a variety of other meanings, but not “high temperature polymer”. Also comprising part of exhibit JEBS5 are GOOGLE® search results on the phrase “high temperature polymer” which, says Mr Stobbs, ought to have been the words used by WKK to establish that “HT” is an acronym for “high temperature polymer”. Mr Stobbs’s states that the result of his search is that the letters “HT” are not used as an acronym for “high temperature polymer”.

20) Mr Stobbs comments also on Exhibit JK4 of Mr Kouwenberg. This exhibit comprises communications between EASE and Josef Kouwenberg, being fax messages dated 3rd May 2001 and 7th August 2001. Mr Stobbs says that the fax from EASE shows two types of tubing being referred to, the “UK type” and the “Standard Type”. He notes that the “HTI” designation is only used against the UK Type tubing, whereas the designation “HTS” is used against the Standard Type. The “I” element in “HTI” can thus be explained as meaning an “imperial” measurement, the common denominator being “HT”. Thus, for example, in EASE Code “HTI 1.2”, the 1.2 would refer to millimetres, which would then be converted to tubing for 0.1 (inch) applications. This point can be best illustrated by reference to one of the faxes in Exhibit JK4 as below:

Actn: Mr. Rob Jansma
From: Lya Del
Your Ref: your visit to our stand
Our Ref: G20010503WKK
Fax: 0044 13 5712525
Page: 1
To: WKK
Tel: 13 5712171
Date: 03 MAY 2001

E A S E Ltd
Thermo-Airtec Superior Shrinkable Sleeves
E A S E Ltd Tel: 0044 (0) 13 5712171
50 Roper Close Fax: 0044 (0) 13 5712525
London, UK Email: info@easeltd.co.uk
SW6 6JG http://www.easeltd.co.uk

FAX MESSAGE:

Dear Mr. Rob Jansma,
 Thank you very much for visiting our stand. It was my great pleasure in meeting you during the Hannover Fair and I hope that you have had a fruitful and enjoyable trip.
 From our conversation, you expressed your interest in our range of heat shrinkable tubing. I am pleased to offer you our very competitive prices, which are listed below.

2:1 Heat Shrinkable Tubing Prices (Thin Wall, Black Colour)

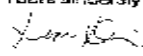
| UK TYPE | | STANDARD TYPE | |
|---------------|---------|---------------|---------|
| BASE CODE | PRICE | BASE CODE | PRICE |
| HTS-SIZE (MM) | USD / M | HTS-SIZE (MM) | USD / M |
| HT1-1.2 | 0.073 | HTS-1 | 0.073 |
| HT1-1.6 | 0.079 | HTS-1.5 | 0.079 |
| HT1-2.4 | 0.083 | HTS-2 | 0.083 |
| HT1-3.2 | 0.093 | HTS-2.5 | 0.088 |
| HT1-4.8 | 0.111 | HTS-3 | 0.090 |
| HT1-6.4 | 0.128 | HTS-3.5 | 0.098 |
| HT1-9.6 | 0.158 | HTS-5 | 0.117 |
| HT1-12.8 | 0.186 | HTS-6 | 0.124 |
| HT1-16.0 | 0.380 | HTS-7 | 0.136 |
| HT1-19.2 | 0.571 | HTS-8 | 0.144 |
| HT1-25.4 | 0.799 | HTS-9 | 0.151 |
| HT1-32.0 | 1.367 | HTS-10 | 0.160 |
| HT1-36.1 | 1.987 | HTS-11 | 0.170 |
| HT1-50.8 | 3.251 | HTS-12 | 0.186 |
| HT1-76.2 | 3.889 | | |
| HT1-101.6 | 4.839 | | |

Note: (a) Bigger sizes are available upon request; (b) 10% extra for coloured ones; (c) Medium or thick wall and adhesive ones are also available.

Remarks:
 PRICE TERM: EX-LONDON
 MINIMUM ORDER VALUE: USD 5000
 PAYMENT TERM: T/T OR L/C
 LEAD TIME: 5-7 WEEKS

This offer is valid for 30 days.

I trust that our price is to your satisfaction and I am waiting for your further valued instructions

Yours sincerely

 Lya Del (Ms)

21) Exhibit JEBS6 is filed in direct response to comments made by Josef Kouwenberg in relation to the reliability of Wikipedia as an evidential source. It comprises GOOGLE® searches on the terms “heat shrinkable sleeve” and “shrink sleeve”, showing the variety of UK websites which can be accessed using those terms. These show applications in the packaging, as well as cabling and tubing industries. Amongst the printouts is a website at www.viscose.co.uk being found by searching on the term “shrink sleeve”. This website site shows use in relation to packaging for food and drink for safety (being tamper proof) and promotional/decorational purposes. The nature of these products is plainly not the same as WKK’s, which are termed in use (by WKK themselves) as “heat shrinkable tubing”.

22) Exhibit JEBS7 shows a further GOOGLE® search on “heat shrink tubing” and “heat shrink” which shows use in respect only of cables (as covering, or other

application), or wire protection applications. Finally, exhibit JEBS8 is the results of a final GOOGLE® search on “heat shrinkable tubing” revealing the website www.seipusa.com, belonging to the international company, Sumitomo Electric, ‘world leaders’ in heat shrinkable technology and having a range of application in, eg the automotive, aerospace, communications and electronics industries. Mr Stobbs says that the exhibits JEBS5 – 8 are intended to clarify both the nature and range of goods covered by the subject application (designation, as I have termed it) and also the actual goods upon which the opposed trade mark is used.

DECISION

Section 5(2) (b)

23) The opposition is founded upon section 5(2) (b) of the Act. This 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.”

24) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“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,

25) Hellermann’s CTM registration has a filing date of 16th July 2004, whereas the priority date of WKK’s designation is 19th July 2005. Hellermann’s CTM is therefore clearly an earlier trade mark in accordance with section 6 above. Moreover, having been registered on 16th April 2007, it is not subject to proof of use requirements.

26) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (“ECJ”) 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] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 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 (LIMONCELLO). 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 trade 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*

The average consumer

27) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, para 23), it is important that I assess who the average consumer is for the goods at issue, and whether there is anything about the nature of transactions under the respective marks that may lead me to conclude that the average consumer is other than someone “deemed to be reasonably well informed and reasonably circumspect and observant” (see authority (b) in para 16 above).

28) I have no doubt that the average consumer for WKK’s goods will be a specialist trade consumer rather than the general public; Mr Kouwenberg refers to “well informed, educated specialists”. Of the traded goods, he also says it is “customary for such goods to consist of capital letters as is common for other technical goods”. Having considered the evidence, including especially the website pages of www.alibaba.com and www.seipusa.com, which have both been put in evidence by Mr Stobbs, as well as the evidence of Mr Kouwenberg in his dealings with EASE, I agree that manufacturers use short combinations of capital letters and numbers to designate their goods. Sometimes the designations are generic (such as a standard or known abbreviations), but at other times there is no clear discernable meaning and one assumes that at those times, such designations are capable of trade mark function. Given the need for technical precision in this field it is common practice to use catalogue or model numbers to designate particular properties. I see no objective reason why such designations may not also serve a trade mark function in addition to, or alongside, that of being a catalogue or model number.

29) My conclusion is that the average (specialist) consumer will be alert to small differences in designations used, whether they are being used in a trade mark or descriptive capacity. Given the nature of the products and the technical and safety aspects involved, he or she will have to be. I think it also likely, given the evidence of Mr Kouwenberg in relation to his dealings with EASE, that the nature of the transactions involved may tend to be bulk orders (eg Exhibit JK4 showing a minimum order value of USD 5000 (on a small value product, USD 0.073) stated in the fax dated 3rd May 2001). Further, that such orders are placed not on a whim but based on prior knowledge as to what exactly is required, previous dealings and possibly personal contact. When these factors are put together I am left to conclude that the average consumer in relation to WKK's products will be astute in their purchasing and alert to small differences in the way products are designated.

30) In relation to Hellermann's products, I believe that some of these also will be the subject of a specialised trade which may well overlap with WKK's (notional if not actual) consumer base. Hellermann's goods are however broader in scope than WKKs and it is entirely possible that some may be sold directly to the public. Without deciding which is which, as I have no evidence on the point, it is sufficient to say there will be overlap as far as the identities of the average consumer for both parties' goods will be concerned.

Comparison of goods

31) Hellermann say in their Form TM7 that it is only the goods of Class 17 which they consider to be identical or similar to those of WKK. The table below reminds us of the respective specifications for comparison:

| WKK's goods | Hellermann's goods |
|-------------------------------|--|
| Class 17 Shrink Sleeve | Class 17 Goods of rubber, gutta-percha, gum and plastics in extruded form for use in manufacture; bands, clips, nozzles, covers and seals of rubber, gum or plastic, in particular for fastening, bundling, enveloping or connecting cables, cable joints, pipes or hoses; packing, stopping and insulating materials, flexible pipes, not of metal |

32) In assessing the similarity of goods or services, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors

relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at para 23 of the Judgment:

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

33) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson (monBeBé)*).

34) It is worthwhile mentioning a further case of the European Court of First Instance (“CFI”) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:

“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).”

35) Finally, there are three cases on the way that specifications ought to be interpreted which should be borne in mind. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd (“Thomson”)* [2003] RPC 32, at para 31, Aldous LJ, says

“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.”

Although this was in the context of arriving at a fair specification consequent to an attack of revocation on the grounds of non-use, the principle that it is the public and circumstances of the relevant trade that should underpin consideration as to the terms used in a specification nonetheless holds good. Secondly, there is the case of *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd (“Beautimatic”)* [2000] FSR 267, in which the principle of giving words their ordinary (rather than an unnaturally narrow) meaning was

enshrined. The third case is that of *Avnet Incorporated v Isoact Ltd* (“Avnet”) [1998] FSR 16 where Jacob J (as he then was) says:

“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.”

Although his comments relate to specifications for services the same principle applies also to goods. In summary, the *Beautimatic* and *Avnet* cases urge an approach that is neither unnaturally narrow nor overly wide, whilst the *Thomson* case stresses that the exercise is not one of lexical analysis in a vacuum but by reference to how the average consumer may perceive matters in the relevant trade.

36) There is much discussion in the evidence and submissions as to what exactly a “shrink sleeve” is, and in particular whether what WKK actually trade in can properly be described as such, or whether it is known by the term “heat shrinkable tubing”. I confess to not being certain exactly what the purpose of this evidence is and where the line of argument is intended to take me. Given the various possible applications of a “shrink sleeve”, from oil pipes through to decorative promotional packaging, is it being suggested that the specification is unduly vague? Is it intended to show that the limitation does not have the desired effect of detaching (making dissimilar, or at least less similar) from Hellermann’s goods; or is Mr Stobbs intending to cast some sort of wider shadow over WKK’s motives? I do not know, but will confine myself to simply observing that there can be no rule requiring an applicant for a trade mark to describe their product or service, when used in trade, in exactly the same terms as those used in their trade mark application. Nor do I see that the products actually being sold by WKK are incapable of being described as “shrink sleeves”. The dictionary meaning of “sleeve” is, inter alia, a “tube fitted externally over two cylindrical parts in order to join them”, or alternatively, a “liner” (see The Collins English Dictionary). “Sleeve” and “tube” or “tubing” are synonyms and could equally be used as apt descriptions for WKK’s products. In the same way, “shrink” and “heat shrinkable” have the same meaning as far as WKK’s products are concerned; the capacity of the sleeve to shrink is only through the application of heat.

37) This leads to the question, applying the *Meric* case, whether “shrink sleeves” are included in a broader category of goods for which Hellermann has protection. The most obvious broader category would be: “bands, covers and seals of rubber, gum or plastic, in particular for fastening, bundling, enveloping or connecting cables, cable joints, pipes or hoses.” This category would include the “shrink sleeves” of WKK’s registration, which I know from the evidence are intended to be of application in the electrical field for joining, protecting and bundling, e.g. cables. It is also noted in this regard that the material from which WKK’s sleeves are made is polyolefin (Exhibit JK4), which is a thermoplastic according to Wikipedia (Exhibit JEBS2). Whilst there are times when one should be sceptical of user-generated material such as Wikipedia, there is no suggestion that on the

simple factual question whether polyolefin is a plastic (and thus within the terms Hellermann's specification), that Wikipedia is unreliable. Applying the *Meric* case, and the other cases that I have cited, it must be held therefore that the respective goods are identical.

Comparison of marks

38) The respective marks are as below:

| WKK's mark | Hellermann's mark |
|------------|-------------------|
| HTI | HT |

39) Visually, the marks share the same two letters at the beginning. WKK's mark however has an additional letter 'I' at the end. The attorney for Hellermann says, without quoting authority, that the beginning part of a mark is recognised to be the most important. That would of course depend on the nature of the marks being compared, and it is understandable that if the respective marks comprise, eg invented words, emphasis may be placed on the beginnings of those words. However I am not dealing with invented words here, but what would most likely be seen as unpronounceable abbreviations. The word 'unpronounceable' is intended to distinguish an abbreviation from an acronym, which comprises a pronounceable set of initial letters or parts of words, eg UNESCO (United Nations Educational, Scientific and Cultural Organisation). In contrast, the attorney for WKK says the letter 'I' extends the 'HT' element by 50% and will clearly be noticed by consumers. She also says that two letter marks are 'notoriously weak' and even small differences will be noticed. I will return to this question later, but for the time being I conclude that visually, as the marks share two letters in the same order, they have a reasonable degree of similarity.

40) In terms of an aural comparison, consistent with my view that both marks will be seen as unpronounceable abbreviations, it is inevitable that all the letters of which they comprise will, individually and separately, be enunciated. In that regard it cannot be ignored that the 'I' element will be present in the one but not the other and will duly lengthen pronunciation of the 'HTI' mark. Taking account of the differences and similarities I conclude that, aurally, the marks share only a reasonably low level of similarity.

41) In conceptual terms my starting point is as before, that the respective marks will both be seen as unpronounceable abbreviations. In this regard, I am not persuaded by the evidence and submissions by WKK to the effect that the letters 'HT' will possibly be seen as the descriptive term 'high temperature' or 'high temperature polymer', or their submission that the letters will be seen as the initial letters of Hellermann Tyson. Both are unsubstantiated assertions; the mere presence of the letters 'HT' as meaning 'high temperature' on an internet acronym site (www.acronymfinder.com), along with 20 other meanings of the letters, is of no help at all in deciding if the letters will convey descriptive meaning to the average consumer - in the particular and technical context of either parties' goods. Similarly,

in the absence of the words “Hellermann Tyson” in the earlier mark, there is no obvious or proven reason why the consumer would make such a linkage between the letters ‘HT’ and Hellermann Tyson. Likewise I am not persuaded by Hellermann’s attorney that the letter ‘I’ in WKK’s mark will be taken to denote the word ‘imperial’ (ie the UK type of tubing), in contrast to ‘HTS’, being the Standard type of tubing as shown in the copy fax which I have referred to in para 20 above. There is no clear reason why the consumer would be led to that conclusion, given especially that the preceded letters ‘HT’ carry no obviously descriptive meaning. I conclude that neither mark has an obvious concept behind it and therefore I must conclude that there is neither conceptual similarity nor dissimilarity.

42) The existence of a reasonable degree of visual similarity and a reasonably low degree of aural similarity, combined with the fact that no conceptual comparison can be made, results in the respective marks being similar only to a reasonably low level or degree.

Likelihood of confusion

Distinctive character of the earlier mark

43) Before proceeding to a global assessment I need to assess the distinctive character of the earlier mark. The more distinctive it is, in trade mark terms, the greater will be the possibility of likelihood of confusion. Attorneys for WKK say the earlier mark is ‘weak’ by virtue of the fact that two letter marks are “notoriously weak and that small differences between such marks, such as the addition of one letter, will exclude the possibly of risk of confusion.” They also refer, as I have said, to the possible descriptive meaning attaching to ‘HT’ and finally, in evidence, there is reference made to the number of marks on the UK and Community registers containing the letters ‘HT’ in class 17.

44) As with all ‘rules of thumb’ I think there are dangers in characterising such marks as being inherently ‘weak’. Such marks are not necessarily ‘weak’ in the sense of being descriptive or semi-descriptive; as I have already found this has not been established in respect of either mark. But Hellermann’s mark is nonetheless ‘minimal’, comprising in a given order, only two letters, together, making what to the average consumer would see as an unpronounceable abbreviation. This has the consequence that the ‘footprint’ of the earlier mark, or what has been called its ‘penumbra of protection’, will be correspondingly minimal. As the impact of the earlier mark on the consumer is restricted to two letters in a given order, forming what I have assumed will be seen as an unpronounceable abbreviation (not even an acronym), the potential effect of adding a third letter is considerable, especially where that consumer may be a trade specialist. It is of course possible to conceive circumstances where the letters forming the respective marks are not necessarily of equal ‘standing’ in relation to the goods or services applied for, or of circumstances where, through use, an earlier mark may be possessed of enhanced distinctive character, even though it is ‘minimal’. However, neither are shown to be the case here. I thus

regard the 'l' letter in the later mark as having no less 'impact' than the preceding 'H' and 'T' letters, in relation to the goods specified, and moreover there is no evidence from Hellermann of their own use in the UK which would give rise to an enhanced distinctive character. As I have said, I prefer in this case not to characterise the distinctive character of the earlier mark as inherently 'weak' on some notional scale, but simply to conclude that its 'footprint', that is to say, its penumbra of protection, in relation to other marks is minimal.

Possible parallel trading

45) I should finally mention that Mr Kouwenberg says in para 13 of his witness statement that WKK has sold goods under their HTI mark "since 2005", with no instances of confusion. Millet LJ in the Court of Appeal case in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, says:

"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."

In any event it is not clear exactly when WKK's use started and without further and better details of the precise nature of this 'co-existence' I am not inclined to regard it as a factor in the global assessment. Likewise the reference to other marks on the UK and Community registers which contain the letters 'HT'. This is 'state of the register' evidence of the sort that has been condemned as irrelevant for the purposes of considering a mark for registration (see eg *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281), on the basis that it does not reflect the circumstances of the market place, nor does it explain the registrar's rationale for the acceptance of such marks. Ms Deas, in her submissions on behalf of Hellermann, in any event notes that those marks highlighted invariably have other distinctive matter which renders them unsuitable as comparisons. For the benefit of any doubt therefore, these are not factors which I am including in my overall assessment.

Conclusions

46) Bringing my conclusions together, noting in particular, the specialist nature of the average consumer and the likely nature of the transactions involved, together with my visual, aural and conceptual comparison of the respective marks, I conclude that there is no likelihood of confusion. I have factored in imperfect recollection and also taken into account both the possibility of direct (mark against mark) and indirect (belief that goods sold under the respective marks emanate from the same source) confusion. The opposition to the application under section 5(2)(b) fails in its entirety.

Costs

47) WKK is successful and is entitled to a contribution towards its costs. I take account of the fact that the decision has been reached without a hearing taking place. In the circumstances I award WKK the sum of £1,200 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Considering Notice of Opposition and statement - £ 200
2. Preparing and filing counterstatement - £300
3. Filing evidence and considering evidence of HT – £500
4. Filing written submissions - £200

Total £1,200

48) I order Hellermann Tyton GmbH to pay WKK Nederland BV the sum of £1,200. The sum should 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 10th day of July 2009

**Edward Smith
For the Registrar,
the Comptroller-General**