

O-284-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2652505
IN THE NAME OF DCC ENERGY LTD

AND

OPPOSITION THERETO UNDER NO 400411
BY CERTUSS DAMPFAUTOMATEN GmbH & CO KG

Background

1. Application no 2652505 seeks registration of the trade mark CERTAS ENERGY. It has a filing date of 15 February 2013 and stands in the name of DCC Energy Limited (“the applicant”). Following an amendment of the specification, it seeks registration for a range of goods and services in classes 1, 4, 6, 9, 35 and 37 of the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

2. Following publication in *The Trade Marks Journal* on 15 March 2013, notice of opposition was filed by Certuss Dampfautomaten GmbH & Co. KG (“the opponent”). The opposition is founded on a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“The Act”) relying on the following Community trade mark (“CTM”) and International (“IR”) registrations:

Mark	Dates	Specification
CTM 10632421 CERTUSS	Filing date: 10 February 2012 Date of entry in register: 28 June 2012	Class 9 Weighing, measuring, signalling, electrical display, electrical control, electrical monitoring and checking (supervision) apparatus and instruments for steam installations, including as systems Class 11 Automatic steam machines; Installations for processing water for automatic steam machines and for supplying automatic steam machines
IR designating the EU 911328 CERTUSS	Filing date: 22 November 2006 Date Protection granted: 8 April 2008	Class 11 Steam generators and their parts

3. The applicant filed a counterstatement denying the grounds of opposition. Only the applicant filed evidence. It takes the form of a witness statement of Mr Peter David Madden who is the Heating Services Manager of the Team Energy Division of Certas Energy UK Ltd, part of the same group of companies as the applicant on whose behalf he is authorised to give evidence. I shall refer to this evidence later in this decision.

4. The matter came before me for a hearing on 3 June 2014. The applicant was represented by Mr Simon Malynicz of Counsel instructed by Wilson Gunn. Although represented during the pendency of these proceedings, the opponent did not attend and was not represented at the hearing nor were written submissions filed in lieu of attendance.

Decision

5. The opposition is based on a ground under section 5(2)(b) of the Act which states:

“5(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, or

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

6. 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) or 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.”

7. In these proceedings, the opponent is relying on the trade marks as set out in paragraph 2 above. Each of them is an earlier mark under the above provisions but neither is subject to the proof of use provisions and so the opponent is entitled to rely on them for all goods for which they are registered.

8. The test for determining whether there is a likelihood of confusion is well established. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd - BL O/330/10* (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs Q.C., expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

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; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal*

Market (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 great 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

9. In essence, the test under section 5(2)(b) is whether there are similarities in marks and goods or services which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods or services, the category of goods or services in question and how they are marketed.

The comparison of the respective goods and services

10. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, the General Court said:

“...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...”

11. As to similarity, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28, Jacob J gave advice as to how it should be assessed. He identified the following factors to be taken into account:

- (a) The respective uses of the respective goods and services;
- (b) The respective users of the respective goods and services;
- (c) The physical nature of the goods or services;
- (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 the goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

12. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the CJEU stated:

“23. In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

13. In relation to what constitutes complementary goods and services, the following comments of the General Court in *Boston Scientific Ltd v OHIM* Case T-325/06 are relevant:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM –Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM –Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM –Bolaños Sabri (PiraÑam diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

14. Also of relevance in determining whether goods and/or services are complementary are the comments of the appointed person Mr Daniel Alexander Q.C. in *Sandra Amalia Mary Elliott and LRC Products Limited* (BL O-255-13).

15. Finally, in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J stated:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

16. In its notice of opposition, the opponent claims that each of the respective goods and services are “the same or similar” but gives no basis as to how it has reached this conclusion. In a letter dated 19 March 2014, it had changed its position somewhat and submitted that: “Many of the goods and services covered by the application and the opponent’s marks relate to the generation of energy” but did not specify to which goods it referred. Considering the breadth and nature of the respective goods and services, I considered this to be wholly inadequate and a letter was sent to the opponent requiring it to file detailed submissions as to why it considered each of the respective goods and services to be the same or similar taking into account the factors set out above. As its response is the only submission I have with any detail, I set it out here in full.

“The Opponent’s products can be used for a variety of purposes including heating up machines, devices, solids, gas and liquids to a precise temperature. Although the Opponent’s goods are related to steam installations they are fuelled with gas or oil and can be equipped with combined burners. More information can be found regarding the Opponent’s products on their website www.certuss.de.

Class 37 of the application is limited so as not to include the installation, repair, maintenance, restoration etc. of steam installations, generators etc. However, it still covers the installation, repair, maintenance, restoration etc. of other heating (sic) apparatus, installations as well as related products, These have the same intended purpose as the client’s products, they just use a different fuel, e.g. oil, gas. They would have the same uses and users and would be competing products.

Class 35 of the application relates to the retailing of various fuels as well as parts and fittings for heat installations and heating apparatus, heat pumps, heat exchangers etc. This is then qualified by none relating to the sale of steam generators or instruments or parts for steam generators. However, fuels, heating installations/generators, etc. have the same intended purpose as the Opponent’s goods, i.e. converting energy and would have the same uses and users. The applicants services relate to the sale of similar goods to those covered by the Opponent’s marks.

Further the Opponent’s installations are fuelled by gas or oil.

The goods and services covered by the opponent’s marks and the application all relate to the generation of energy. The applicant’s specification only excludes services related to steam installations, generators etc. but it still covers services related to installations heated by gas, oil or other fuels. Such installations/generators are used for the same purpose as the Opponent’s goods (generating energy) and would have the same uses and users. The Applicant’s services in classes 35 and 37 and (sic) therefore similar to the Opponent’s goods.”

17. The above submissions are still somewhat limited and unhelpful not least because they do not specifically refer to each of the respective goods and services for which registration is applied. Whilst the opponent has referred me to its website, I have not accessed it. If it had wanted to put extracts from it before me, it should have filed them in evidence, not least so that the applicant could have seen them and commented on or otherwise challenged that evidence.

18. In his skeleton argument, Mr Malynicz referred me to the decision of Geoffrey Hobbs Q.C. sitting as the appointed person in *De’Longhi Spa (The Penguin)* BL O-144-05 as justification for his submission that where the goods and services at issue are not general consumer items such as chocolate bars or clothing but rather are those of a more technical or specialist nature and outwith the knowledge of those not in that area of trade, then the burden is on the opponent to show, on the basis of evidence, that there is similarity or identity.

19. In his witness statement filed on behalf of the applicant, Mr Madden submits that there is no similarity between the respective goods. He states the products sold by the opponent are highly technical and specialised machines and installations to generate steam, specialist components for those machines and installations which process water to feed automatic steam machines. He exhibits extracts from the opponent's websites at PDM1, PDM2 and PDM3 to show what goods it sells and submits that the goods are such as will be used by organisations and businesses requiring a large and constant supply of steam. In contrast, he states, the applicant's goods are mainly used "in relation to monitoring fuel levels in storage tanks".

20. I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where it said:

"67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed."

21. I also bear in mind the findings of the same court in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

"71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59)."

22. The effect of these decisions is that, in essence, I have to make my comparison not on the basis of what the parties may already do or intend to do in the future or what might appear on particular websites. Rather, I must consider matters on a notional basis taking into account the specifications of goods and services as registered or applied for by the respective parties.

23. Given the breadth of the applicant's specification, where appropriate, and for the purposes of comparison, I will group related goods or services together in accordance with the decision in *Separode Trade Mark* BL O-399-10:

"The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

24. I note that the opposition is directed at the application only insofar as it seeks registration of goods and services in classes 9, 35 and 37. With this in mind and for ease of reference, the goods and services to be compared are as follows:

Opponent's goods	Applicant's goods and services
<p>CTM 10632421</p> <p>Class 9</p> <p>Weighing, measuring, signalling, electrical display, electrical control, electrical monitoring and checking (supervision) apparatus and instruments for steam installations, including as systems</p> <p>Class 11</p> <p>Automatic steam machines; Installations for processing water for automatic steam machines and for supplying automatic steam machines</p> <p>Intl 911328</p> <p>Class 11</p> <p>Steam Generators and their parts</p>	<p>Class 9</p> <p>Apparatus for recording, transmission or reproduction of sound or images; transmitters and receivers; remote monitoring apparatus and systems; wireless monitoring equipment; recording equipment; electric monitoring apparatus and equipment; sensors; fluid level sensors, indicators and monitoring units; oil level sensors, indicators and monitoring units; gauges; fuel gauges; oil gauges; pressure gauges; all of the aforesaid goods being for use in monitoring fuel levels in storage tanks; electric or electronic security apparatus and instruments; security systems; security control apparatus; security alarms; locking apparatus, instruments and devices; anti-theft locking apparatus and devices; computer controlled locks; digitally controlled locks; electric, electronic or electromagnetic locks and locking installations; electric, electronic or electromagnetic lock switches and controllers; electric, electronic or electromagnetic security devices and apparatus; electronic keypad controlled mechanisms; alarm signalling transmitters and receivers; security surveillance apparatus; security warning apparatus; cameras and security monitoring systems; CCTV cameras and systems; security lights; energy control devices, none being for steam installations; fire extinguishing apparatus; protective clothing, footwear and headgear; parts and fittings for all of the aforesaid goods.</p> <p>Class 35</p> <p>Retail services and online retail services all connected with the sale of fuels, fuels for heating purposes, fuels for cooking, fuel oils, heating oils, gas oil, chemical additives for fuels, chemical additives for fuels for heating purposes, chemical additives for fuels for cooking, chemical additives for fuel oils, chemical additives for heating oils, chemical additives for gas oil, adhesives, chemical sealing compounds, sealing compounds for stopping leakage from oil tanks, chemical compositions for the control of fuel spillages, desiccants, tanks, storage tanks and parts and fittings therefor, containers for the storage and</p>

	<p>transportation of fuels, fuels for heating purposes, fuels for cooking, fuel oils, heating oils and gas oil, security containers, security closures, locking oil tank caps, locks for oil tanks, security devices, security fittings, locks, lock systems, locking installations, locking apparatus and instruments, locking devices, keys, key blanks, key rings, key chains, electric or electronic security apparatus and instruments and parts and fittings therefor, security systems, security control apparatus, security alarms, anti-theft locking apparatus and devices, computer controlled locks, digitally controlled locks, electric, electronic or electromagnetic locks and locking installations, electric, electronic or electromagnetic lock switches and controllers, electric, electronic or electromagnetic security devices and apparatus, electronic keypad controlled mechanisms, apparatus for recording, transmission or reproduction of sound or images, transmitters and receivers, alarm signalling transmitters and receivers, remote monitoring apparatus and systems, remote monitoring apparatus and systems, wireless monitoring equipment, security surveillance apparatus, security warning apparatus, cameras and security monitoring systems, CCTV cameras and systems, recording equipment, security lights, electric monitoring apparatus and equipment, sensors, fluid level sensors, indicators and monitoring units, oil level sensors, indicators and monitoring units, gauges, fuel gauges, oil gauges, temperature gauges, thermometers, pressure gauges, energy control devices, energy generating apparatus and equipment, fire extinguishing apparatus, protective clothing, footwear and headgear, parts and fittings for security systems, heating apparatus and parts and fittings therefor, heating installations and parts and fittings therefor, heating systems and parts and fittings therefor, heaters, heat pumps and parts and fittings therefor; thermal storage apparatus for heating and parts and fittings therefor; heating oil apparatus and parts and fittings therefor, heating oil installations and parts and fittings therefor, heating oil systems and parts and fittings therefor, gas oil apparatus and parts and fittings therefor, gas oil installations and parts and fittings therefor, gas oil systems and parts and fittings therefor, oil-fired heaters and parts and fittings therefor, oil burners and parts and fittings therefor, boilers and parts and fittings therefor, oil-fired boilers and parts and fittings therefor, cooking apparatus and parts and fittings therefor, cooking installations and parts and fittings therefor, cookers and parts and fittings therefor, range cookers and parts and fittings therefor, actuators, air intake apparatus, automatic air vents, baffles, blast tubes, burner gaskets, burner seals, burner diaphragms, burner supply tubes, burners, capacitors, valves, check valves, isolation valves, condensate pumps, high tension connectors, control boxes, tubes, copper tubes, copper fittings, couplings, drive couplings, diverter valves, electrodes, fans, fibre rope, filling loops, filters, elements, bowls, fire-valves, flue-stats, switches, flow switches, pipes, fuel inlet pipes, steel tubes, fuses, gate valves, hydraulic rams, igniters, leads, inhibitors, insulation, mixer valves, motors, motorised valves, nipples, nozzles, oil controlvalves, oil lifters, oil lines, oil hoses, oil pumps, photocells, flanges, lead, plate heat exchangers, pressure vessels, pressure relief valves, heating and hot water programmers, time programmers, timers, pump valves, pump nuts, rotors, seals, sight gauges, sight glass, sight tubes, solenoid coils, solenoid leads,</p>
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solenoid stems, solenoid valves, synchron motors, tank caps, tank nuts, tank vents, tank boss, terminal guards, thermostats, transformers, pumps, vaporisers, water pumps, water jackets, wicks; none of the aforesaid services being connected with the sale of steam generators or connected with the sale of apparatus, instruments or parts for steam generators; provision of space on web sites for advertising goods and services; information, advisory and consultancy services in relation to all of the aforesaid.

Class 37

Repair; installation services; maintenance services; installation, maintenance, servicing, repair, refurbishment, restoration and cleaning of heating apparatus, heating installations, heating systems, heaters, heat pumps, thermal storage apparatus, heating oil apparatus, installations and systems, gas oil apparatus, installations and systems, oil-fired heaters, oil burners, boilers, oil-fired boilers, tanks, cooking apparatus, cooking installations, cookers and range cookers, tanks, storage tanks, containers for the storage and transportation of fuels, fuels for heating purposes, fuels for cooking, fuel oils, heating oils and gas oil, security containers, security closures, locking oil tank caps, security devices, security fittings, locks, lock systems, locking installations, locking apparatus and instruments, locking devices, electric or electronic security apparatus and instruments and parts and fittings therefor, security systems, security control apparatus, security alarms, anti-theft locking apparatus and devices, computer controlled locks, digitally controlled locks, electric, electronic or electromagnetic locks and locking installations, electric, electronic or electromagnetic lock switches and controllers, electric, electronic or electromagnetic security devices and apparatus, electronic keypad controlled mechanisms, apparatus for recording, transmission or reproduction of sound or images, transmitters and receivers; alarm signalling transmitters and receivers, remote monitoring apparatus and systems, remote monitoring apparatus and systems, wireless monitoring equipment, security surveillance apparatus, security warning apparatus, cameras and security monitoring systems, CCTV cameras and systems, recording equipment, security lights, electric monitoring apparatus and equipment, sensors, fluid level sensors, indicators and monitoring units, oil level sensors, indicators and monitoring units, gauges, fuel gauges, oil gauges, temperature gauges, thermometers, pressure gauges, energy control devices, energy generating apparatus and equipment, actuators, air intake apparatus, automatic air vents, baffles, blast tubes, burner gaskets, burner seals, burner diaphragms, burner supply tubes, burners, capacitors, valves, check valves, isolation valves, condensate pumps, high tension connectors, control boxes, tubes, copper tubes, copper fittings, couplings, drive couplings, diverter valves, electrodes, fans, fibre rope, filling loops, filters, elements, bowls, fire-valves, flue-stats, switches, flow switches, pipes, fuel inlet pipes, steel tubes, fuses, gate valves, hydraulic rams, igniters, leads, inhibitors, insulation, mixer valves, motors, motorised valves, nipples, nozzles, oil control valves, oil lifters, oil lines, oil hoses, oil pumps, photocells, flanges, lead, plate heat exchangers, pressure vessels, pressure relief valves, heating and hot water

	<p>programmers, time programmers, timers, pump valves, pump nuts, rotors, seals, sight gauges, sight glass, sight tubes, solenoid coils, solenoid leads, solenoid stems, solenoid valves, synchron motors, tank caps, tank nuts, tank vents, tank boss, terminal guards, thermostats, transformers, pumps, vaporisers, water pumps, water jackets, wicks; none of the aforesaid services being connected with the installation, maintenance, repair, refurbishment, restoration and cleaning of steam installations, steam generators, automatic steam machines, installations for supply/processing water to such machines, or apparatus and instruments for such machines; information, advisory and consultancy services in relation to all of the aforesaid.</p>
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25. Whilst they are subject to the limitation to they are for use in monitoring fuel levels in storage tanks, the applicant's *Apparatus for recording, transmission or reproduction of sound or images* are goods which, self evidently, record, transmit or reproduce sound or images. The opponent's earlier IR includes *steam generators* which, given the differing uses, users, natures and channels of trade, I find to be dissimilar to these goods. The opponent's mark also includes *parts* of steam generators as are proper to class 11. I have no evidence to show what such parts might be or how they may be similar to the applicant's aforementioned goods. Absent any such evidence, I cannot see any meaningful way in which these respective goods are similar either. As for the opponent's CTM, and for the same reasons, I find there is no similarity between the goods covered by the specification in class 11 and those of the applicant. The CTM also covers goods in class 9 and includes *signalling and electrical display apparatus and instruments*. Whilst the applicant's goods may use a *signal* and may *display* an image, given the comments made in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Anr* [2000] FSR 267 that words appearing in a specification should be given their natural meaning and again, absent any evidence to the contrary, I am unconvinced that there is any similarity between the applicant's goods and those of the opponent. For the same reasons, I can find no meaningful similarity between any of the opponent's goods and the applicant's *transmitters and receivers; or recording equipment*. The same is true of the applicant's *parts and fittings* for these goods.

26. *Sensors; fluid level sensors, indicators and monitoring units; oil level sensors, indicators and monitoring units; gauges; fuel gauges; oil gauges; pressure gauges* are goods which are likely to form parts of e.g. plant or equipment, however, I am not aware, and have no evidence, that such goods, which are limited to being for use in monitoring fuel levels in storage tanks, are parts as are covered by the opponent's IR specification or similar to them. Neither am I aware, nor do I have any evidence, of any similarity with the other goods covered by either the IR or the CTM. Absent such evidence, I find there is no similarity between these goods or their parts and fittings and the goods covered by the opponent's earlier marks.

27. The applicant's *electric or electronic security apparatus and instruments; security systems; security control apparatus; security alarms; locking apparatus, instruments and devices; anti-theft locking apparatus and devices; computer controlled locks; digitally controlled locks; electric, electronic or electromagnetic locks and locking*

installations; electric, electronic or electromagnetic lock switches and controllers; electric, electronic or electromagnetic security devices and apparatus; electronic keypad controlled mechanisms; alarm signalling transmitters and receivers; security surveillance apparatus; security warning apparatus; cameras and security monitoring systems; CCTV cameras and systems; security lights; are each goods which will be used by those who wish to keep something secure whether by allowing it to be kept under observation, under lock and key or in some way fixed or secure. I do not consider these goods, nor their parts and fittings, to be similar to any of the opponent's goods. Their users, uses, nature and channels of trade differ.

28. I do not consider the applicant's *fire extinguishing apparatus* to be similar in any way to any of the opponent's goods. Their users, uses, nature and channels of trade all differ. Similarly, the applicant's *protective clothing, footwear and headgear* have no similarity with the opponent's goods. The same is true in respect of *parts and fittings* for all of these goods.

29. The application and the opponent's CTM include *electric monitoring apparatus and equipment* and *electrical monitoring apparatus and instruments* respectively. Whilst, on the face of it, these would appear to be (at least) highly similar goods, the applicant's goods are limited to use in monitoring fuel levels in storage tanks and the opponent's goods are for steam installations, including as systems. The respective users will therefore differ and, whilst the nature of the respective goods may overlap to some extent, the specific uses of each differ. I have no evidence of any commonality of trade channels. Any similarity between these respective goods is low. For the same reasons *remote monitoring apparatus and systems;* and *wireless monitoring equipment,* I find to be of low similarity to the opponent's *electrical monitoring apparatus and instruments.* The same is true in respect of the applicant's *parts and fittings* for these goods.

30. The applicant's "*energy control devices*" is a somewhat vague term but self-evidently they are devices which in some way control energy, whether in terms of its output or in some other way. The opponent's CTM in class 9 includes *electrical control apparatus and instruments* which would include such goods for the control of energy. Again, on the face of it, the respective goods would appear to be (at least) highly similar, however, the opponent's goods are *for steam installations* whilst the applicant's goods are subject to the exclusion "none being for steam installations" Given the exclusion, the users of the respective goods will differ although the nature of the respective goods and their uses may overlap to some extent. I have no evidence of any commonality of trade channels. Taking all things into account, I find these respective goods and their parts and fittings to be of low similarity.

31. I go on to consider the applicant's services in class 35 all of which are retail services. In making the comparison, I take note that in *Oakley, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06 the Court of First Instance (now General Court) stated there was a complementary relationship between the retail of goods and the goods themselves. It said:

"54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the

goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau-und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

32. Insofar as *Retail services and online retail services all connected with the sale of fuels, fuels for heating purposes, fuels for cooking, fuel oils, heating oils, gas oil, chemical additives for fuels, chemical additives for fuels for heating purposes, chemical additives for fuels for cooking, chemical additives for fuel oils, chemical additives for heating oils, chemical additives for gas oil, fuels for heating purposes, fuels for cooking, fuel oils, heating oils and gas oil* are concerned, the opponent submits that they are similar because both have the same purpose of converting energy and would have the same (unspecified) users and uses. In my view the applicant’s services provide the user with the means to power a piece of equipment or machinery in order for that equipment etc. to function effectively but that does not make the retail service in respect of the fuel or additive similar to the equipment which requires such a fuel in order for it to function. I do not consider these retail services to be similar to the opponent’s goods as the uses, users, nature and purpose of the two differ as do the channels of trade and they are not complementary. The same is true in relation to the applicant’s *information, advisory and consultancy services* in relation to these services.

33. *Retail services and online retail services all connected with the sale of adhesives, chemical sealing compounds, sealing compounds for stopping leakage from oil tanks, chemical compositions for the control of fuel spillages, desiccants, tanks, storage tanks and parts and fittings therefor, containers for the storage and transportation of fuels, heating oil installations and parts and fittings therefor, heating oil apparatus and parts and fittings therefore; heating oil systems and parts and fittings therefor, gas oil apparatus and parts and fittings therefor, gas oil installations and parts and fittings therefor, gas oil systems and parts and fittings therefor, security containers, security closures, locking oil tank caps, locks for oil tanks, security devices, security fittings, locks, lock systems, locking installations, locking apparatus and instruments, locking devices, keys, key blanks, key rings, key chains, electric or electronic security apparatus and instruments and parts and fittings therefor, security systems, security control apparatus, security alarms, anti-theft locking apparatus and devices, computer controlled locks, digitally controlled locks, electric, electronic or electromagnetic locks and locking installations, electric, electronic or electromagnetic lock switches and controllers, electric, electronic or electromagnetic security devices and apparatus, electronic keypad controlled mechanisms, apparatus for recording, transmission or reproduction of sound or images, transmitters and receivers, alarm signalling transmitters and receivers, security surveillance apparatus, security warning apparatus, cameras and security monitoring systems, CCTV cameras and systems, recording equipment, security lights, sensors, fluid level sensors, indicators and monitoring units, oil level sensors, indicators and monitoring units, gauges, fuel gauges, oil gauges, temperature*

gauges, thermometers, pressure gauges, fire extinguishing apparatus, protective clothing, footwear and headgear, parts and fittings for security systems; cooking apparatus and parts and fittings therefor, cooking installations and parts and fittings therefor; cookers and parts and fittings therefor, range cookers and parts and fittings therefor; provision of space on web sites for advertising goods and services; information, advisory and consultancy services in relation to all of the aforesaid, I find to be not similar to the opponent's goods. Absent evidence to the contrary, I find the users, uses, nature and trade channels all differ and they are not complementary.

34. As regards *retail services and online retail services all connected with the sale of actuators, air intake apparatus, automatic air vents, baffles, blast tubes, burner gaskets, burner seals, burner diaphragms, burner supply tubes, burners, capacitors, valves, check valves, isolation valves, condensate pumps, high tension connectors, control boxes, tubes, copper tubes, copper fittings, couplings, drive couplings, diverter valves, electrodes, fans, fibre rope, filling loops, filters, elements, bowls, fire-valves, flue-stats, switches, flow switches, pipes, fuel inlet pipes, steel tubes, fuses, gate valves, hydraulic rams, igniters, leads, inhibitors, insulation, mixer valves, motors, motorised valves, nipples, nozzles, oil controlvalves, oil lifters, oil lines, oil hoses, oil pumps, photocells, flanges, lead, plate heat exchangers, pressure vessels, pressure relief valves, heating and hot water programmers, time programmers, timers, pump valves, pump nuts, rotors, seals, sight gauges, sight glass, sight tubes, solenoid coils, solenoid leads, solenoid stems, solenoid valves, synchron motors, tank caps, tank nuts, tank vents, tank boss, terminal guards, thermostats, transformers, pumps, vaporisers, water pumps, water jackets, wicks; none of the aforesaid services being connected with the sale of steam generators or connected with the sale of apparatus, instruments or parts for steam generators; again I have no evidence and am not aware that the goods the subject of these services are parts of the goods covered by the opponent's specification and I therefore find there to be no similarity with them as the uses, users, nature and trade channels differ and they are not complementary. The same is true in relation to the applicant's information, advisory and consultancy services in relation to these services.*

35. On the basis of *Oakley*, I find the applicant's *retail services and online retail services all connected with the sale of remote monitoring apparatus and systems, wireless monitoring equipment, electric monitoring apparatus and equipment*, to be similar to *electrical monitoring apparatus* as appears in the opponent's CTM albeit, given the limitation, to a low degree. I find the applicant's *retail services and online retail services all connected with the sale of heating apparatus and parts and fittings therefor, heating installations and parts and fittings therefor, heating systems and parts and fittings therefor, heaters, heat pumps and parts and fittings therefor; thermal storage apparatus for heating and parts and fittings therefor; oil-fired heaters and parts and fittings therefor, oil burners and parts and fittings therefor, boilers and parts and fittings therefor, oil-fired boilers and parts and fittings therefor* to be similar to a low degree to the opponent's IR on the basis that the opponent's goods may be heating apparatus or parts thereof. I find the applicant's *retail services and online retail services all connected with the sale of energy control devices* to be similar to the opponent's *electrical control apparatus* in its CTM and the applicant's *retail services all connected with the sale of energy generating apparatus and equipment* to be similar to the opponent's IR and CTM in class 11, again, to a low degree. The

same is true in relation to the applicant's *information, advisory and consultancy services* in relation to these services.

36. That leaves the services as applied for in class 37. In respect of *installation, maintenance, servicing, repair, refurbishment, restoration and cleaning of heating oil apparatus, installations and systems, gas oil apparatus, installations and systems, oil burners, tanks, cooking apparatus, cooking installations, cookers and range cookers, tanks, storage tanks, containers for the storage and transportation of fuels, fuels for heating purposes, fuels for cooking, fuel oils, heating oils and gas oil; security containers, security closures, locking oil tank caps, security devices, security fittings, locks, lock systems, locking installations, locking apparatus and instruments, locking devices, electric or electronic security apparatus and instruments and parts and fittings therefor, security systems, security control apparatus, security alarms, anti-theft locking apparatus and devices, computer controlled locks, digitally controlled locks, electric, electronic or electromagnetic locks and locking installations, electric, electronic or electromagnetic lock switches and controllers, electric, electronic or electromagnetic security devices and apparatus, electronic keypad controlled mechanisms, apparatus for recording, transmission or reproduction of sound or images, transmitters and receivers; alarm signalling transmitters and receivers, security surveillance apparatus, security warning apparatus, cameras and security monitoring systems, CCTV cameras and systems, recording equipment, security lights; sensors, fluid level sensors, indicators and monitoring units, oil level sensors, indicators and monitoring units, gauges, fuel gauges, oil gauges, temperature gauges, thermometers, pressure gauges, actuators, air intake apparatus, automatic air vents, baffles, blast tubes, burner gaskets, burner seals, burner diaphragms, burner supply tubes, burners, capacitors, valves, check valves, isolation valves, condensate pumps, high tension connectors, control boxes, tubes, copper tubes, copper fittings, couplings, drive couplings, diverter valves, electrodes, fans, fibre rope, filling loops, filters, elements, bowls, fire-valves, flue-stats, switches, flow switches, pipes, fuel inlet pipes, steel tubes, fuses, gate valves, hydraulic rams, igniters, leads, inhibitors, insulation, mixer valves, motors, motorised valves, nipples, nozzles, oil control valves, oil lifters, oil lines, oil hoses, oil pumps, photocells, flanges, lead, plate heat exchangers, pressure vessels, pressure relief valves, heating and hot water programmers, time programmers, timers, pump valves, pump nuts, rotors, seals, sight gauges, sight glass, sight tubes, solenoid coils, solenoid leads, solenoid stems, solenoid valves, synchron motors, tank caps, tank nuts, tank vents, tank boss, terminal guards, thermostats, transformers, pumps, vaporisers, water pumps, water jackets, wicks; none of the aforesaid services being connected with the installation, maintenance, repair, refurbishment, restoration and cleaning of steam installations, steam generators, automatic steam machines, installations for supply/processing water to such machines, or apparatus and instruments for such machines; absent evidence to the contrary, I find them not to be similar to the opponent's goods. The uses, users, nature and channels of trade differ and they are not complementary. The same is true in respect of *information, advisory and consultancy services* in relation to these services.*

37. Despite the limitation to the applicant's services, I find its *Installation, maintenance, servicing, repair, refurbishment, restoration and cleaning of heating apparatus, heating installations, heating systems, heaters, heat pumps, thermal storage apparatus, oil-fired heaters, boilers, oil-fired boilers, energy control devices,*

energy generating apparatus and equipment; remote monitoring apparatus and systems, remote monitoring apparatus and systems, wireless monitoring equipment, electric monitoring apparatus and equipment and information, advisory and consultancy services in relation to all of the aforesaid to be similar, albeit to a low degree, to the goods of the opponent's IR and *automatic steam machines, electrical control apparatus and instruments for steam installations including as systems and electrical monitoring apparatus* as included in the opponent's CTM as they are complementary services.

38. As well as the specific repair etc. services in class 37, the application also seeks registration for *Repair; installation services; maintenance services* at large, subject to the limitation that none of them are *connected with the installation, maintenance, repair, refurbishment, restoration and cleaning of steam installations, steam generators, automatic steam machines, installations for supply/processing water to such machines, or apparatus and instruments for such machines* and information, advisory and consultancy services in relation to these services. In view of the limitation and in the absence of any evidence to the contrary, I find that there is no similarity between these services and the opponent's goods other than insofar as they include the specific services which I have already found to have a degree of similarity.

The average consumer and the nature of the purchasing process

39. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services and then to determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade.

40. In his witness statement, Mr Madden states:

“Due to the highly technical and specialised nature of [the opponent's] products, they are used and purchased by well-educated technical professionals [who will] exercise a high degree of attention in selecting such products, carefully studying the products' technical data in order to ensure that such an expensive and niche piece of equipment or component will be entirely suited to their specialist requirements. These are certainly products which would not be purchased by an average everyday consumer because they would neither have the requirement for such products nor would they have the technical expertise, experience and skills to operate them.” He goes on to submit that “the purchase of such items is likely to involve a large capital outlay, even for substantial businesses.”

41. Mr Madden's submissions appear to have been made in the context of the goods he says the opponent sells rather than the specification of goods for which the mark is registered, however, given that the specifications as registered are all for steam installations, systems and generators, I agree that whilst the goods could be bought by a member of the public, given their nature they are more likely to be bought or specified by a well informed or professional person working on behalf of an individual or organisation. Given their potential cost and their importance to a project the goods are unlikely to be bought without a good deal of care the purchaser having satisfied

himself (after reviewing relevant documentation and, where appropriate, seeking technical advice), that the goods are suitable for use in the project concerned. They are also likely to involve a degree of pre-contract negotiation if the system to be supplied is, effectively, a bespoke one.

42. Some of the goods covered by the application are limited to being for use in monitoring fuel levels in storage tanks. These are goods most likely to be used by professionals but could also be used by those members of the general public who have such storage tanks in a domestic setting (e.g. householders who have oil-fired central heating). Even if used by such members of the general public, such goods are more likely to be bought by professionals who will install them on behalf of the householder. In either case, they are goods which are likely to be subject to a very careful and considered purchasing process from specialist suppliers, given the importance of them to the proper containment and supply of the fuel. The remaining goods of the application (most of which are said not to be for steam installations) are, in general terms, intended either for security or protection. Such goods will vary in price depending on e.g. their complexity or level of protection given and may be bought by professionals or the general public but, given their purpose, they are also likely to be a very careful and considered purchase from specialist suppliers. The services covered by the application in classes 35 and 37 are retail services and e.g. repair, installation and maintenance services respectively. The users of these services will be either a professional or member of the general public depending on the object of those services and in line with my comments above in respect of the goods but again, are likely to be a very careful and considered purchase.

The comparison of the respective marks

43. Again, for ease of reference, the marks to be compared are as follows:

Opponent's earlier mark	Applicant's mark
CERTUSS	CERTAS ENERGY

44. The earlier mark consists of the word CERTUSS presented in plain block capitals. As no part of the word is highlighted or emphasised in any way, there are no distinctive and dominant elements: the distinctiveness of the mark rests in its totality. The mark applied for consists of the two words CERTAS and ENERGY. The word ENERGY is descriptive for goods or services used in the provision of energy and thus the word CERTAS is the dominant and distinctive element of the mark. In respect of goods and services used other than in the provision of energy, e.g. protective clothing, both words within the mark would be distinctive though the word CERTAS would have a degree of dominance due to its position within the mark.

45. Both marks begin with the same four letters in the same order, followed by a vowel and letter S (a double letter S in the opponent's mark). The different vowels and the doubling of the letter S leads to a degree of visual difference between them, however, there is still a reasonable degree of visual similarity between the respective

marks. From an aural perspective, and in the absence of anything but the very highest care in enunciation of the different vowels, unlikely in normal use, the respective marks are very highly similar. Neither the word CERTUSS or CERTAS has any meaning as far as I have been made aware and therefore the conceptual position is neutral.

The distinctiveness of the earlier mark

46. I must also assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

47. The two earlier marks relied upon are for the same word both presented in plain block capitals. The opponent has not filed any evidence of use of them and therefore I have only the inherent distinctiveness to consider. As an invented word, it has a high degree of inherent distinctive character.

The likelihood of confusion

48. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I also have to factor in the distinctive character of the earlier marks as the more distinctive they are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she has retained in mind.

49. Earlier in this decision I found:

- the respective marks have a reasonable degree of visual similarity, are aurally very highly similar but are conceptually neutral;
- the earlier marks have a high degree of inherent distinctive character not shown to have been enhanced through use;
- the following goods and services to be similar to a low degree to the opponent's goods:

Remote monitoring apparatus and systems; wireless monitoring equipment; electric monitoring apparatus and equipment; all of the aforesaid goods being for use in monitoring fuel levels in storage tanks; energy control devices none being for steam installations; parts and fittings for all of the aforesaid goods;

Retail services and online retail services all connected with the sale of remote monitoring apparatus and systems, wireless monitoring equipment, electric monitoring apparatus and equipment, energy control devices, energy generating apparatus and equipment, heating apparatus and parts and fittings therefor, heating installations and parts and fittings therefor, heating systems and parts and fittings therefor, heaters, heat pumps and parts and fittings therefor; thermal storage apparatus for heating and parts and fittings therefor; oil-fired heaters and parts and fittings therefor, oil burners and parts and fittings therefor, boilers and parts and fittings therefor, oil-fired boilers and parts and fittings therefor; none of the aforesaid services being connected with the sale of steam generators or connected with the sale of apparatus, instruments or parts for steam generators; information, advisory and consultancy services in relation to all of the aforesaid.

Installation, maintenance, servicing, repair, refurbishment, restoration and cleaning of heating apparatus, heating installations, heating systems, heaters, heat pumps, thermal storage apparatus, oil-fired heaters, boilers, oil-fired boilers, remote monitoring apparatus and systems, wireless monitoring equipment, electric monitoring apparatus and equipment, energy control devices, energy generating apparatus and equipment; none of the aforesaid services being connected with the installation, maintenance, repair, refurbishment, restoration and cleaning of steam installations, steam generators, automatic steam machines, installations for supply/processing water to such machines, or apparatus and instruments for such machines; information, advisory and consultancy services in relation to all of the aforesaid;

- all other goods and services I found to be not similar.

50. There can be no finding of a likelihood of confusion where the goods or services are found to be not similar. Consequently, the opposition against those goods and services set out above which I have found not to be similar, fails.

51. As per the decision in *React Trade Mark* [2000] RPC 285, the mere possibility of confusion is not sufficient for a positive finding under section 5(2)(b) of the Act; there has to be a likelihood of confusion. As indicated above, that is a multi-factorial assessment. In that regard, I note that in her decision in *Thornton & Ross Ltd's Application* BL O-175-14, Anna Carboni, sitting as an appointed person said:

“33. Further, it simply is not the case that, under section 5(2)(b) of the Act, similarity of marks plus similarity of goods (or services), with an average consumer who is reasonably observant and circumspect, equals success of opposition. The law is that, where there exists a likelihood of confusion *because of* the similarities between the particular marks in issue and the particular goods (or services), then the mark shall not be registered. This

requires an assessment which takes into account “all factors relevant to the circumstances of the case” (as explained in *Sabel v Puma* C-251/95 [1998] R.P.C. 199 at [22] and subsequent cases). To follow a path of automatism would be contrary to established law.”

52. Whilst I have found the remaining goods and services to be similar, to a low degree, to the goods covered by the opponent’s earlier marks and have found the respective marks to be visually similar to a reasonable degree and aurally very highly similar, the cases referred to above make it clear that the assessment requires me to consider other factors too. The goods and services I have found to be similar are specialist ones most likely to be bought by a professional and will be a very careful and considered purchase. Whilst I would hesitate to rule out entirely the possibility that a customer might be mistakenly drawn to the wrong mark, I do not see this as being a ‘likely’ occurrence but instead merely a ‘possible’ occurrence given the traits which the average consumer identified are likely to display when selecting the respective parties’ goods and services. That being the case, the opposition also fails in respect of these goods and services.

Summary

53. The opposition fails in its entirety.

Costs

54. The applicant having succeeded, it is entitled to an award of costs in its favour. In making the award I take note that the opponent filed no evidence and that it did not attend the hearing or make submissions in lieu of attendance. I also note that the opposition was brought against all of the goods and services of the application but that, when challenged to provide submissions on the similarity of those goods and services to the goods of the earlier marks, those submissions were brief and not particularly helpful, though would not have taken much effort to consider.

55. I make the award on the following basis:

For filing a statement and reviewing the other side’s statement:	£400
For preparing and filing evidence:	£500
For preparation and attendance at the hearing:	£1000
Total:	£1900

56. I order Certuss Dampfautomaten GmbH & Co KG to pay DCC Energy Limited the sum of £1900 as a contribution towards its costs. This sum is to be paid within

seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of June 2014

**Ann Corbett
For the Registrar
The Comptroller-General**