

O-457-16

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 102 905 ESSENTA FOR
GOODS AND SERVICES IN CLASSES 01, 02, 03, 05, 06, 07, 08, 09, 11, 16, 17,
19, 20, 21, 22 AND 24 IN THE NAME OF FORTIS MERCHANTS LIMITED

AND IN THE MATTER OF OPPOSITION THERETO BY ESSENTRA PLC

Background and pleadings

1. Fortis Merchants Limited (the applicant) applied to register the trade mark No 3 102 905 ESSENTA in the UK on 08/04/2015. It was accepted and published in the Trade Marks Journal on 19/06/2015 in respect of the following goods:

Class 01:

Adhesives and sealants for tradesmen to use for fixing pieces of timber to other substrates; waterproofing chemicals and compositions for use on houses, flat roofs, building chemicals namely additives for cement and mortar used in the building industry; cleaning chemicals namely turps and white spirit; screen fillers; flushing chemicals and additives, water treatments, solder and fluxes, inhibitors.

Class 02:

Paint and woodcare products.

Class 03:

Sandpapers and scouring products; limescale removers.

Class 05:

Disinfectants.

Class 06:

Security items namely locks, padlocks; hardware namely screws, nails, door handles, hinges, gate furniture, chains; metal ladders; windows with metal surrounds or fittings; lintels of metal.

Class 07:

Electric handtools; electric drills; shower pumps; waste disposal units.

Class 08:

Hand tools and hand operated implements; saws, plaster trowels, drills, hammers, screwdrivers.

Class 09:

Safety clothing and footwear; electrical plumbing controls namely thermostats, timers, parts and fittings.

Class 11:

Plumbing fittings namely kitchen and bathroom plumbing; bathroom products namely sanitaryware, baths, taps, showers, shower trays, shower screens, bath screens, toilet seats, metallic kitchen sinks and taps; radiators; boilers, cylinders; immersion heaters; kitchen appliances namely ovens double, single, gas, electric, range cookers; fridges, freezers, dishwashers, washing machines, tumble dryers, warming drawers, steam ovens, domestic kettles, toasters, coffee machines, microwaves.

Class 16:

Adhesives for household use, decorating accessories, paint brushes and paint rollers.

Class 17:

Insulating fillers; expansion joint fillers; adhesive and masking tapes; glasswool insulation for use in lofts, sealants; polyurethane insulation for floors and walls; jointing compounds, leak sealers, polystyrene insulation.

Class 19:

Concrete and natural stone paving slabs; wooden fencing and gates; wooden flooring; vinyl flooring; plastic drainage products including soil, rain water plumbing fittings guttering; roof felt and other roofing building products, lintels of concrete; roof tiles; glass windows, tiles; wooden doors; roof windows with wood surrounds; bricks, plastic drainage-waste-soil-rainwater pipes, damp proof membranes; building products namely floor levelling powder compounds.

Class 20:

Furniture and fittings for bathrooms, toilets and kitchens; wooden ladders; bathroom cabinets, bathroom mirrors, wooden bathroom furniture; kitchen worktops made of wood, kitchen cabinets made of wood.

Class 21:

Household or kitchen utensils and containers; combs and sponges; brushes (except paintbrushes); brush-making materials; articles for cleaning purposes; steel wool; soap dish holders, toilet roll holders; toothpaste and toothbrush holders, towel rails; plastic buckets.

Class 22:

Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks for transporting bulk materials; padding and stuffing materials which are not made of rubber or plastics; raw fibrous textile materials.

Class 24:

Dustsheets.

2. Essentra Plc (the opponent) oppose the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier European Union (formerly Community) trade marks No 1 147 0069 and No 118 791 37. The former earlier trade mark was subject to a notice of voluntary surrender in respect of its specification of goods. Further, the opponent compiled a table indicating which of the earlier goods of both marks it considered to be either identical or similar to those contained within the later trade mark applied for. This decision will focus upon the exact earlier goods identified by the opponent and will widen the comparison to be made only if is necessary to do so. On this basis, the following goods are relied upon in this opposition:

Class 01:

Adhesives for industrial purposes. cement-waterproofing chemicals; cement preservatives; acetates [chemicals]; alginates for industrial purposes; ammonia for industrial purposes; cellulose esters for industrial purposes; cellulose ethers for industrial purposes; cement [metallurgy]; cement preservatives, except paints and oils; concrete-aeration chemicals; condensation preventing chemicals; damp proofing chemicals, except paints, for masonry; alcohol; radiator flushing chemicals; waterpurifying chemicals; watersoftening preparations; ammonia for industrial purposes; soldering chemicals / welding chemicals; soldering fluxes; solvents for varnishes.

Class 02:

Paints; pigments; wood preservatives; varnishes; wood stains; wood mordants; anticorrosive bands; anti-corrosive preparations; anti-fouling paints; anti-rust greases; anti-rust oils; anti-rust preparations; creosote for wood preservation; distempers; dyes; enamels [varnishes]; oils for the preservation of wood / preservative oils for wood; wood coatings [paints]; turpentine [thinner for paints].

Class 03:

Caustics for industrial purposes.

Class 05:

Disinfectants.

Class 06:

locks of metal, other than electric; padlocks; screws; nails; door handles of metal; hinges of metal; gates of metal; fittings of metal for furniture; fittings of metal for building; building or furniture fittings of nickel-silver; chains of metal; ladders of metal; windows of metal; lintels of metal.

Class 07:

Hand-held tools, other than hand-operated; machine tools; electric arc cutting apparatus; electric arc welding apparatus; electric hammers; electric hand drills; electric welding apparatus; pumps [machines]; pumps [parts of machines, engines or motors]; garbage [waste] disposals / garbage disposals / waste disposals / waste disposers [machines].

Class 08:

Hand tools, hand-operated; garden tools, hand-operated; saws [hand tools]; trowels; hand drills, hand-operated; hammers [hand tools]; screwdrivers.

Class 09:

Clothing for protection against accidents, irradiation and fire; clothing for protection against fire / garments for protection against fire; gloves for protection against

accidents; shoes for protection against accidents; boiler control instruments; control panels [electricity]; thermostats; time recording apparatus; time switches, automatic.

Class 11:

Bath installations / bath plumbing fixtures; bath tubs; water taps; sanitary apparatus and installations; urinals [sanitary fixtures]; sinks; wash-hand basins [parts of sanitary installations] / wash-hand bowls [parts of sanitary installations]; water conduits installations; water distribution installations; water filtering apparatus; water flushing installations / flushing apparatus; washing machines; dishwashers; toilet bowls; toilet seats; toilets [water-closets]; radiators [heating]; radiators, electric; boilers, other than parts of machines; immersion heaters; drying apparatus; drying apparatus and installations; air driers [dryers] / air driers / air dryers; heating apparatus; heating installations; ovens, other than for laboratory use; hot air ovens; kitchen ranges [ovens]; microwave ovens; kettles [electric]; coffee machines, electric; coffee percolators, electric; coffee roasters; toasters; refrigerating apparatus and machines; refrigerating appliances and installations; refrigerating cabinets; refrigerators; freezers.

Class 16:

Adhesives for stationery or household purposes; glue for stationery or household purposes / pastes for stationery or household purposes; paintbrushes; house painters' rollers.

Class 17:

Insulators; expansion joint fillers / fillers for expansion joints; adhesive tapes, other than stationery and not for medical or household purposes; glass wool for insulation; sealant compounds for joints; fiberglass fabrics for insulation; fibreglass for insulation; draught excluder strips / weather stripping; duct tapes; insulating hands / insulating tapes; mineral 'wool [insulator]; packing

[cushioning, stuffing] materials of rubber or plastics; padding materials of rubber or plastics / stuffing of rubber or plastic; paper for electrical capacitors; sealant compounds for joints; chemical compositions for repairing leaks; foils of metal for insulating / metal foil for insulation.

Class 19:

Concrete; stone; asphalt paving; concrete building elements; fences, not of metal; floor tiles, not of metal; floors, not of metal; tile floorings, not of metal; tiles, not of metal, for building; wooden floor boards; roof coverings, not of metal; roof flashing, not of metal; roof gutters, not of metal; roofing shingles; roofing slates; roofing tiles, not of metal; roofing, not of metal; lintels, not of metal; plate glass [windows], for building; windows, not of metal; bricks; drain pipes, not of metal; gutter pipes, not of metal; water pipes not of metal; floor tiles, not of metal; floors, not of metal; felt for building; door panels, not of metal; doors, not of metal.

Class 20:

Furniture; furniture fittings, not of metal; mirrors [looking glasses]; cupboards; door bolts, not of metal; door fasteners, not of metal; door fittings, not of metal; door handles, not of metal; door knockers, not of metal; door stops, not of metal or rubber; doors for furniture; towel dispensers, fixed, not of metal / towel dispensers, not of metal, fixed; towel stands [furniture]; and-held mirrors [toilet mirrors]; curtain hooks; curtain rails; curtain rings; curtain rods; curtain rollers; curtain tie-backs; indoor window blinds [shades] [furniture] / indoor window shades (furniture).

Class 21:

Cutlery; nut crackers; oyster openers; fleshing knives; meat choppers; sharpening steels [Class 8]; towel dispensers, fixed, not of metal / towel dispensers, not of metal, fixed; towel stands [furniture]; furniture fittings,

not of metal [in Class 20]; acetylene cleaning apparatus; cleaning appliances utilizing steam; dust removing installations for cleaning purposes; electric; machines and apparatus for cleaning [Class 7].

Class 21 (EU 118 791 37):

Non-impregnated cosmetic applicator sponges and swabs.

Class 22:

Ropes; string; nets; tents; awnings of synthetic materials; awnings of textile; tarpaulins; sails; bags [sacks]; padding materials, not of rubber, plastics; raw fibrous textile.

Class 24:

Sheets.

3. The opponent argues that the respective goods are identical or similar and that the marks are similar.
4. The applicant filed a counterstatement denying the claims made.
5. A Hearing took place on 14th September 2016, with the opponent represented by Mr Holah of Bird and Bird LLP; Mr Lee Tiffin, appeared in person on behalf of the applicant.

DECISION

Section 5(2)(b)

6. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods

7. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

8. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;

- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

Class 01:

9. The earlier goods are: Adhesives for industrial purposes. This is a wide term encompassing any manner of particular adhesive products used in industry. The later goods are adhesives and sealants for tradesmen to use for fixing pieces of timber to other substrates. They clearly fall within the ambit of the earlier term and so are identical.
10. The earlier goods are: cement-waterproofing chemicals; The later goods are: waterproofing chemicals and compositions for use on houses, flat roofs, building chemicals namely additives for cement and mortar used in the building industry. The earlier term "cement- waterproofing chemical" clearly encompass the later goods. They are identical.
11. The earlier goods are: turpentine [thinner for paints] [in class 2]; alcohol; radiator flushing chemicals; waterpurifying chemicals; watersoftening preparations; ammonia for industrial purposes; soldering chemicals / welding chemicals; soldering fluxes; solvents for varnishes.
12. The later goods are: cleaning chemicals namely turps and white spirit; screen fillers; flushing chemicals and additives, water treatments, solder and fluxes, inhibitors. In respect of cleaning chemicals namely turps and white spirit; screen fillers; flushing chemicals and additives, water treatments, they are clearly within the ambit of the earlier terms. The same applies to inhibitors which is a type of liquid used to maintain the performance of a central heating

system. Finally, the earlier term soldering fluxes is clearly identical to the later solder and fluxes (albeit expressed slightly differently).

Class 02:

13. The earlier goods are: Paints; pigments; wood preservatives; varnishes; wood stains; wood mordants; creosote for wood preservation; distempers; dyes; enamels [varnishes]; oils for the preservation of wood / preservative oils for wood; wood coatings [paints]. The later goods, paint and woodcare products are self-evidently identical.

Class 03:

14. The earlier goods are caustics for industrial purposes. Caustics remove, for example, paints or build up of other matter such as limestone. The later goods, sandpapers and scouring products; limescale removers aim to perform the same or a highly similar function. They are highly similar.

Class 05:

15. Disinfectants appear in each specification. They are identical.

Class 06:

16. The earlier goods: locks of metal, other than electric; padlocks are clearly identical to the later security items namely locks, padlocks.

17. The earlier screws; nails; door handles of metal; hinges of metal; gates of metal; fittings of metal for furniture; fittings of metal for building; building or furniture fittings of nickel-silver; chains of metal are clearly identical to the following later terms: hardware namely screws, nails, door handles, hinges, gate furniture, chains.

18. The earlier ladders of metal; windows of metal; lintels of metal are clearly identical to the later metal ladders; windows with metal surrounds or fittings; lintels of metal.

Class 07:

19. The earlier Hand-held tools, other than hand-operated; machine tools; electric arc cutting apparatus; electric arc welding apparatus; electric hammers; electric hand drills; electric welding apparatus are clearly identical to the later electric handtools; electric drills.

20. The earlier pumps [machines]; garbage [waste] disposals / garbage disposals / waste disposals / waste disposers [machines] are clearly identical to the later shower pumps; waste disposal units.

Class 08:

21. The earlier hand tools, hand-operated; garden tools, hand-operated; saws [hand tools]; trowels; hand drills, hand-operated; hammers [hand tools]; screwdrivers are clearly identical to the later hand tools and hand operated implements; saws, plaster trowels, drills, hammers, screwdrivers.

Class 09:

22. The earlier clothing for protection against accidents, irradiation and fire; clothing for protection against fire / garments for protection against fire; gloves for protection against accidents; shoes for protection against accidents are identical and similar to the later safety clothing and footwear.

23. The earlier boiler control instruments; control panels [electricity]; thermostats; time recording apparatus; time switches, automatic are clearly identical to the later electrical plumbing controls namely thermostats, timers, parts and fittings. In the case of the later parts and fittings, they are considered to be highly similar to the earlier terms.

Class 11:

24. The earlier goods are bath installations / bath plumbing fixtures; bath tubs; water taps; sanitary apparatus and installations; urinals [sanitary fixtures]; sinks; wash-hand basins [parts of sanitary installations] / wash-hand bowls [parts of sanitary installations]; water conduits installations; water distribution installations; water filtering apparatus; water flushing installations / flushing apparatus; washing machines; dishwashers; toilet bowls; toilet seats; toilets [water-closets]. These are identical to the later plumbing fittings, namely kitchen and bathroom plumbing; bathroom products namely sanitary ware, baths, taps, showers, shower trays, shower screens, bath screens, toilet seats, metallic kitchen sinks and taps; dishwashers, washing machines.
25. The earlier goods are radiators [heating]; radiators, electric; boilers, other than parts of machines; immersion heaters; drying apparatus; drying apparatus and installations; air driers [dryers] / air driers / air dryers; heating apparatus; heating installations. These are identical to the later radiators; boilers, cylinders; immersion heaters; tumble dryers, warming drawers.
26. The earlier goods are ovens, other than for laboratory use; hot air ovens; kitchen ranges [ovens]; microwave ovens; kettles [electric]; coffee machines, electric; coffee percolators, electric; coffee roasters; toasters and are identical to the later kitchen appliances namely ovens double, single, gas, electric, range cookers; steam ovens; domestic kettles, toasters, coffee machines, microwaves.
27. The earlier goods refrigerating apparatus and machines; refrigerating appliances and installations; refrigerating cabinets; refrigerators; freezers are identical to the later fridges, freezers.

Class 16:

28. The earlier adhesives for stationery or household purposes; glue for stationery or household purposes / pastes for stationery or household purposes; paintbrushes; house painters' rollers are identical to the later adhesives for household use, decorating accessories; paint brushes and paint rollers.

Class 17:

29. The earlier insulators; expansion joint fillers / fillers for expansion joints; adhesive tapes, other than stationery and not for medical or household purposes; glass wool for insulation; sealant compounds for joints; chemical compositions for repairing leaks; sealant compounds for joints; are identical to the later insulating fillers; expansion joint fillers; adhesive and masking tapes; glasswool insulation for use in lofts, sealants.

30. The earlier terms are fiberglass fabrics for insulation; fiberglass for insulation; metal foil for insulation. The later terms are polyurethane insulation for floors and walls; polystyrene insulation. Although they may differ in exact nature, they are all similar in purpose: to insulate. They are considered to be similar.

Class 19:

31. The earlier goods are: Concrete; stone; asphalt paving; concrete building elements; fences, not of metal; floor tiles, not of metal; floors, not of metal; tile floorings, not of metal; tiles, not of metal, for building; wooden floor boards; roof coverings, not of metal; roof flashing, not of metal; roof gutters, not of metal; roofing shingles; roofing slates; roofing tiles, not of metal; roofing, not of metal; lintels, not of metal; plate glass [windows], for building; windows, not of metal; bricks; drain pipes, not of metal; gutter pipes, not of metal; water pipes not of metal; floor tiles, not of metal; floors, not of metal; felt for building; door panels, not of metal; doors, not of metal.

32. The later goods are: Concrete and natural stone paving slabs; wooden fencing and gates; wooden flooring; vinyl flooring; plastic drainage products including soil, rain water plumbing fittings guttering; roof felt and other roofing building products, lintels of concrete; roof tiles; glass windows, tiles; wooden doors; roof windows with wood surrounds; bricks, plastic drainage waste-soil-rainwater pipes, damp proof membranes; building products namely floor levelling powder compounds. They are identical.

Class 20:

33. The earlier goods are: Furniture; furniture fittings, not of metal; mirrors [looking glasses]; cupboards; door bolts, not of metal; door fasteners, not of metal; door fittings, not of metal; door handles, not of metal; door knockers, not of metal; door stops, not of metal or rubber; doors for furniture; towel dispensers, fixed, not of metal / towel dispensers, not of metal, fixed; towel stands [furniture]; and-held mirrors [toilet mirrors]; curtain hooks; curtain rails; curtain rings; curtain rods; curtain rollers; curtain tie-backs; indoor window blinds [shades] [furniture] / indoor window shades (furniture). The later goods are: furniture and fittings for bathrooms, toilets and kitchens; wooden ladders; bathroom cabinets, bathroom mirrors, wooden bathroom furniture; kitchen worktops made of wood, kitchen cabinets made of wood. They are identical.

Class 21:

34. The earlier goods are: cutlery; nut crackers; oyster openers; fleshing knives; meat choppers; sharpening steels [Class 8]; towel dispensers, fixed, not of metal / towel dispensers, not of metal, fixed; towel stands [furniture]; furniture fittings, not of metal [in Class 20]; acetylene cleaning apparatus; cleaning appliances utilizing steam; dust removing installations for cleaning purposes; electric; machines and apparatus for cleaning [Class 7]. The following later goods are considered to be clearly identical: household or kitchen utensils; towel rails.

35. The later goods: soap dish holders, toilet roll holders; toothpaste and toothbrush holders are likely to be sold alongside bathroom furniture and can be selected aesthetically as accessories. They are considered to be similar.
36. The later goods are articles for cleaning purposes; steel wool; plastic buckets; sponges. The earlier goods include cleaning apparatus and appliances which have the same purpose and function: to clean items and/or to be used during the action of cleaning. They are similar.
37. The later brushes (except paint brushes) will likely include those used in cooking and baking. They are highly likely to use identical trade channels with many of the earlier goods. They are similar, albeit to a low degree. The same applies to the later household or kitchen containers.
38. The later brush making materials will include replacement brush heads etc. They are also likely to use identical trade channels as many of the earlier goods. They are similar to a low degree.
39. The later combs include items which are used on human hair and aim to improve its overall appearance. The same applies to the earlier non-impregnated cosmetic applicator sponges which are used to apply make up products. These items are also likely to be sold alongside one another. They are considered to be similar.

Class 22:

40. The earlier goods are: ropes; string; nets; tents; awnings of synthetic materials; awnings of textile; tarpaulins; sails; bags [sacks] and are identical to the later ropes, string, nets, tents, awnings, tarpaulins, sails, sacks for transporting bulk materials.
41. The earlier goods are: padding materials, not of rubber, plastics; raw fibrous textile. The later goods are padding materials, not of rubber, plastics; raw fibrous textile. They are clearly identical.

Class 24:

42. The earlier trade mark covers “sheets” at large which clearly includes the later dustsheets. They are identical.

Comparison of marks

43. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

44. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

45. The respective trade marks are shown below:

ESSENTRA	ESSENTA
Earlier trade mark	Contested trade mark

46. Each of the marks is comprised of one element. It is noted that there is only one letter difference. They are considered to be highly similar both visually and aurally.

47. Conceptually, there was an indication at the hearing that each of the marks alluded to the word “ESSENTIAL”. Indeed the applicant argued that this was why it had chosen its mark. That said, neither of the marks is the word ESSENTIAL and it is considered that one would be hard pressed to absorb this meaning from the marks in contention here. As such, it is considered more likely that each would be viewed as an invented word and so, the conceptual impact is neutral.

Average consumer and the purchasing act

48. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

49. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

50. The average consumer is likely to be both the professional building trade and also public at large, bearing in mind DIY activities. Items can be purchased in a dedicated shop or online, with many being accessible by both the trade and the general public. A purchase may follow research or word of mouth and/or may be selected visually. Visual and aural considerations are therefore important. These are items that may be purchased frequently in the case of a trade customer or on a more ad hoc basis in the case of the general public. There will be a range of expense involved, for example, from furniture and boiler at one end of the spectrum and paintbrushes and sandpaper at the other. Irrespective of this, a customer will wish to ensure that the correct product is chosen on each occasion, whether it be due to its aesthetic or functional qualities. As such, it is concluded that at least a medium level of attention will be displayed during the purchasing process.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect,

judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

52. There is no claim from the opponent that its earlier trade mark has acquired a higher degree of distinctiveness as a result of the use made. As such, it must be assessed on a prima facie basis. ESSENTRA has no meaning in respect of the earlier goods. It is distinctive to an average degree.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

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

The principles

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

54. The goods have been found to be identical and/or similar. It is true that the level of attention displayed during the purchasing process is expected to be medium which can negate against the impact of imperfect recollection. However, the marks in question here are highly similar, visually and aurally with no conceptual gap enabling the relevant consumers to distinguish between them. It is considered highly likely that one mark will be mistaken for the other. As such, there is clearly a likelihood of direct confusion.

55. The opposition succeeds in its entirety.

Final Remarks

56. At the hearing, Mr Tiffin's main argument was that the opponent and applicant operated in different areas of the marketplace. As support for this argument, Mr Tiffin explained that his business is aimed at the professional "trade" customer, whereas the opponent's interest is in a very narrow product range. After hearing from Mr Holah, who rightly pointed out that, as the earlier trade mark is not subject to the proof of use provisions, the opposition must be considered across the entire range of goods for which the earlier trade mark is registered. I also explained to Mr Tiffin that the earlier trade mark must be assessed as against all the potential circumstances within which the earlier goods can be marketed. Further, that marketing strategies have potential to change over a period of time.

COSTS

57. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition and accompanying statement plus statutory fee - £400

TOTAL - £400

58. I therefore order Fortis Merchants Limited to pay Essentra Plc the sum of £400. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of September 2016

Louise White
For the Registrar,