

O/310/20

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3365471 BY
VECTA SAFES (UK) LIMITED
TO REGISTER:**



AS A TRADE MARK IN CLASSES 6 & 9

AND


**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 416133 BY
VEKA AG**

BACKGROUND AND PLEADINGS


1. Vecta Safes (UK) Limited (“the applicant”) applied to register the mark shown on the front page of this decision in the United Kingdom on 8 January 2019. The application was accepted and published on 25 January 2019 in respect of goods in Classes 6 and 9, as shown in the table in paragraph 29.

2. On 25 April 2019, the application was opposed by Veka AG (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns all goods in the application.

3. The opponent is relying upon the following earlier trade marks:

Mark	Goods and Services Relied Upon
<p>UKTM¹ 1462208 (“the 208 mark”)</p> <p>VEKA</p> <p>Filing date: 23 April 1991</p> <p>Registration date: 22 May 1992</p> <p>Priority date: 15 December 1990</p>	<p><u>Class 17</u></p> <p><i>Plastics products in the forms of profiles and seals; profiles made of elastic material; moulded parts, plates and foils; all included in Class 17.</i></p> <p><u>Class 19</u></p> <p><i>Plastics products in the forms of profiles and seals; profiles made of elastic material; moulded parts, plates and foils; Windows, doors, roller blinds, venetian blinds, roof coverings, coverings, partitions and wall panelling; all included in Class 19.</i></p>
<p>UKTM 1192424 (“the 424 mark”)</p>  <p>Filing date: 18 March 1983</p> <p>Registration date: 18 March 1983</p>	<p><u>Class 19</u></p> <p><i>Building materials, windows and roller shutters.</i></p>

¹ UK Trade Mark.

Mark	Goods and Services Relied Upon
<p>EUTM² 4689361 (“the 361 mark”)</p> <p>VEKA</p> <p>Filing date: 18 October 2005</p> <p>Registration date: 3 September 2007</p> <p>Seniority from UKTM 1462207.</p> <p>Seniority date: 15 December 1990</p>	<p><u>Class 1</u></p> <p><i>Plastic mixtures.</i></p> <p><u>Class 17</u></p> <p><i>Plastic products in the form of profiles, shaped seals for the aforesaid products, shaped parts (semi-finished).</i></p> <p><u>Class 19</u></p> <p><i>Building materials, windows, roller blinds and doors of plastic, plastic window systems, plastic door systems and plastic roller blind systems, folding shutters, roofs, covers and wall coverings of plastic, profiles, seals and plates of plastic, all the aforesaid goods for building; fences, railings, balustrades, floorboards and partitions of plastic, and connectors and fittings therefor, included in Class 19.</i></p> <p><u>Class 37</u></p> <p><i>Assembly and installation of windows, doors, roller blinds, folding shutters, roofs, fences, covers and wall coverings for building; providing information material and support for the aforesaid activities, and for the processing of plastic plates for building.</i></p>
<p>EUTM 4690483 (“the 483 mark”)</p> 	<p><u>Class 1</u></p> <p><i>Plastic mixtures.</i></p> <p><u>Class 17</u></p> <p><i>Plastic products in the form of profiles, shaped seals for the aforesaid products, shaped parts (semi-finished goods), plates.</i></p>

² European Union Trade Mark.

Mark	Goods and Services Relied Upon
<p>Filing date: 18 October 2005 Registration date: 20 September 2006 Seniority from UKTM 1192424 Seniority date: 18 March 1983</p>	<p><u>Class 19</u> <i>Building materials, windows, roller blinds and doors of plastic, plastic window systems, plastic door systems and plastic roller blind systems, folding shutters, roofs, covers and wall coverings of plastic, profiles, seals and plates of plastic, all the aforesaid goods for building; fences, railings, balustrades, floorboards and partitions of plastic, and connectors and fittings therefor, included in Class 19.</i></p> <p><u>Class 37</u> <i>Assembly and installation of windows, doors, roller blinds, folding shutters, roofs, fences, covers and wall coverings for buildings; providing information material and support for the aforesaid activities, and for the processing of plastic plates for building.</i></p>
<p>EUTM 14970123 (“the 123 mark”)</p> <div data-bbox="215 1384 657 1563" data-label="Image"> </div> <p>Colours claimed: Blue, white, black. Filing date: 30 December 2015 Registration date: 30 May 2016</p>	<p><u>Class 17</u> <i>Plastic products in the form of profiles, shaped seals for the aforesaid products, shaped parts (semi-finished goods), plates.</i></p> <p><u>Class 19</u> <i>Building materials, windows, roller blinds and doors of plastic, plastic window systems, plastic door systems and plastic roller blind systems, folding shutters, roofs, covers and wall coverings of plastic, profiles, seals and plates of plastic, all the aforesaid goods for building; fences, railings, balustrades, floorboards and partitions of plastic, and connectors and fittings therefor, included in Class 19.</i></p>

4. The opponent claims that the marks are visually and aurally highly similar and that the contested goods are identical, similar and/or complementary to the opponent's goods and services, leading to a likelihood of confusion on the part of the public. Therefore, registration of the contested mark should be refused under section 5(2)(b) of the Act.
5. The applicant filed a defence and counterstatement denying the claims and putting the opponent to proof of use of the first four marks for the goods and services relied upon.
6. Both parties filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
7. The opponent filed written submissions on 21 October 2019 and the applicant filed written submissions on 9 January 2020. I will not summarise these but shall refer to them where appropriate in my decision.
8. Neither side requested a hearing and so this decision has been taken following a careful consideration of the papers.
9. In these proceedings, the opponent is represented by Marks & Clerk LLP and the applicant by Primas Law Limited.

EVIDENCE

Opponent's evidence

10. The opponent's evidence comes from Rebecca Campbell, Chartered Trade Mark Attorney and Associate at Marks & Clerk LLP, the opponent's representative. Her witness statement is dated 13 November 2019 and is a vehicle for filing print outs from trade mark registers showing details of the earlier marks and evidence directed towards showing use of the marks. I briefly summarise that evidence below:

- A print out from the website of Stevenswood, a supplier of windows and doors. It describes the opponent as “the UK’s largest windows and door systems manufacturer” and shows the products available. The only date is the date of printing: 21 October 2019;
- Entries from Wikipedia and Bloomberg on the opponent, both printed on 21 October 2019;
- Print outs from the opponent’s website (vekauk.com) retrieved via the Wayback Machine. They date from 24 October 2015 to 19 January 2019, provide corporate messages and show the marks in a variety of forms;
- Print outs from Twitter which show that as of the date of printing (21 October 2019) the UK arm of the opponent had 4,796 followers. The oldest tweet appears to be dated 13 December 2018;
- An undated brochure containing information on the opponent’s doors, windows and conservatories;
- An article from *Building Products* dated 1 November 2018 which states that a firm called Listers is using the Veka flush window system to make its own range of sash windows;
- Product details from the opponent’s own website, all printed on 17 October 2019;
- A print out from the website of S&S Plastics, which states that it supplies ancillary components compatible with the opponent’s 70mm profile. The only date is the date of printing: 17 October 2019;
- A print out from www.door-stop.co.uk showing a door using a Veka profile. This was printed on 17 October 2019;
- A blank order and enquiry form for Veka products from Stevenswood;
- A screenshot from the opponent’s Czech website. It has not been translated;
- A consumer question from 2016 about the differences between profiles from Veka and those from other companies. It is from a German website, but a translation has been provided;
- What appears to be a German-language magazine produced by the opponent and dated February 2011. It has not been translated;

- Extracts from a product catalogue produced by Aikon Distribution. It describes the opponent as “one of the world’s largest manufacturers of PVC window profiles” and the “strongest window brand in the world”. It is undated.
- A screen shot from the website www.vetrex.co.uk dated 21 February 2016 and retrieved via the WayBack Machine. It describes features of the opponent’s products.
- A discussion from the website diynot.com headed “Veka, eurocell or linear (HL plastics) – which brand UPVC?”, starting in June 2014.
- Contact details for the opponent’s companies in the Czech Republic and Germany, taken from veka.cz and veka.de

Applicant’s evidence

11. The applicant’s evidence comes from Daniel Thomas, partner of Primas Freeman Fisher Ltd, which trades as Primas Law, and is the applicant’s representative. His witness statement, annexed to which are images of safes and security boxes produced by the applicant and an article from *Locksmiths Journal* posted on 2 August 2019 promoting the Vecta Personal Safe, is dated 9 January 2020. I need say nothing further about the applicant’s evidence here.

Preliminary issue

12. The opponent has provided some of its evidence in foreign languages without any translation. In *Pollini*, BL O/146/02, Professor Ruth Annand, sitting as the Appointed Person, said:

“It seems to me that exhibits in a foreign language ought to be treated in the same way as the statutory declaration, affidavit or witness statement in conjunction with which they are used. Accordingly, where an exhibit is in a foreign language, a party seeking to rely on it in registry proceedings must provide a verified translation into English.”³

³ Paragraph 32.

The opponent is therefore unable to rely on the untranslated evidence.

DECISION

Proof of Use

13. Section 6A of the Act is as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section ‘the relevant period’ means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the ‘variant form’ differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

14. Section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15. All the marks the opponent is relying on are earlier marks under section 6(1)(a) of the Act.⁴ The 208, 424, 361 and 483 marks all completed their registration procedures before the start of the relevant period, and the applicant has put the opponent to proof of use of these marks for all the goods and services in respect of which they stand registered. The relevant period is 9 January 2014 to 8 January 2019.

16. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV*, [2018] EWHC 1608 (Ch):

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-698/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

⁴ “a registered trade mark, international trade mark (UK), European Union 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”.

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [132].

17. For the 208 and 424 marks, the opponent must show use in the UK. The 361 and 483 marks are EUTMs and so the EU is the relevant territory. In *Leno Marken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (CJEU) noted that:

“36. It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and

examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).

18. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J (as he then was) reviewed the case law since *Leno* and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant’s challenge to the Board of Appeal’s conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant’s argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had only been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that ‘genuine use in the Community will in general require use

in more than one Member State’ but ‘an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State’. On the basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon’s analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of use.”

19. The General Court (GC) restated its interpretation of *Leno* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of an EUTM. Consequently, in trade mark opposition and cancellation proceedings, the Registrar continues to entertain the possibility that use of an EUTM in an area corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

20. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment, I must consider all relevant factors, including the scale, frequency and nature of the use shown, the goods and services for which use has been shown and the nature of those goods and services and the market(s) for them, and the geographical extent of the use shown.

21. I turn now to the evidence before me. In *Awareness Limited v Plymouth City Council (PLYMOUTH LIFE CENTRE)*, Case BL O/236/13, Mr Daniel Alexander QC, sitting as the Appointed Person, made the following comments on the sufficiency of evidence:

“The burden lies on the registered proprietor to prove use ... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”⁵

22. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd (CATWALK)*, Case BL O/404/13, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the

⁵ Paragraph 22.

age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not '*show*' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

23. Earlier in this decision, I have referred to examples of statements made about the position of the opponent in the market for doors and windows. These statements have all been made by the opponent itself or by its suppliers and are uncorroborated by any financial information on sales volumes or size of the said market. They are also at such a level of generality as to be inconclusive about where any sales have taken place. It seems to me that it would not have been difficult for the opponent to produce some financial information. However, there is no witness statement from the opponent itself. To my mind, the evidence shows that the opponent produces profiles for doors and windows, but it does not tell me whether the use of the marks amounts to real commercial exploitation. Consequently, I am unable to find that the opponent has shown genuine use of any of the earlier marks. However, it is still able to rely on the 123 mark which completed its registration process during the relevant period and so is not subject to the requirement to prove use.

Section 5(2)(b)

24. Section 5(2)(b) of the Act states that:

“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.”

25. Section 5A of the Act is as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

26. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the CJEU 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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

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

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

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

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

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

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

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

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

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

Comparison of goods

27. When comparing the goods, all relevant factors should be taken into account, per *Canon*:

“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 complementary.”⁶

28. Guidance was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)*, [1996] RPC 281. At [296], he identified the following relevant factors:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

⁶ Paragraph 23.

(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

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

29. The goods to be compared are shown in the table below:

Opponent's Goods	Contested Goods
<p><u>Class 17</u> Plastic products in the form of profiles, shaped seals for the aforesaid products, shaped parts (semi-finished goods), plates.</p> <p><u>Class 19</u> Building materials, windows, roller blinds and doors of plastic, plastic window systems, plastic door systems and plastic roller blind systems, folding shutters, roofs, covers and wall coverings of plastic, profiles, seals and plates of plastic, all the aforesaid goods for building; fences, railings, balustrades, floorboards and partitions of plastic, and connectors and fittings therefor, included in Class 19.</p>	<p><u>Class 6</u> Adjusters, casement window adjusters; bolts, deadbolts, door bolts, chain bolts, hinge bolts, panic bolts, patio bolts, stay bolts, window bolts, handle bolts, hook bolts, latch bolts, press bolts, swing bolts, foot bolts and roller bolts; brackets; nuts; Door and window catches; transom catches, catches for cupboards, catches for showcases and catches for fanlights; padbars; chains; door chains and security chains; mechanical door closers; mechanical door coordinators comprising door closers, door stops and door releases; door closer rods and shoes; valves; metal washers; spacers of metal; safes, front doors for safes; door holders; door holder/stops; door holder/release/stops; door fittings; door knockers; door furniture; non-electric door bells; door cases; door frames; door openers; door panels; door scrapers; cables; plugs; metal clamps; door pulls; draw pulls; drawer pulls; door sets; door stops; escutcheon sets; mechanical floor closer/coordinator; mechanical exit devices; mullions and mullions stabilizers; fasts, fasteners, chain door fasteners [sic], casement fasteners and sash fasteners; hasps; handles, lockable window handles, door handles (pull type), door handles (lever type), patio door handles, handle sets; hinges, checking floor hinges; hooks, coat hooks; keys, key holders, key rings, key blanks, keying systems, metal keying kits, keyhole covers; knobs;</p>

Opponent's Goods	Contested Goods
	<p><i>knob sets and shutter knobs; latches, casement latches, ring latches, rim latches, mortice latches, upright latches, combination locker latch sets and night latches, combination knocker and latch sets; combined door knockers and letter boxes and stillages; latch retainers; letter boxes; locks, bike locks, bathroom locks, cam locks, cabinet locks, checklocks, combination locks, cylinder locks, door locks, hookbolt locks, furniture locks, mortice locks, multi-lever mortice locks, multi-point locks, nightlatch locks, rim locks, multi-lever rim locks, pump cylinder rim locks, locks for safes, gate locks, patio door locks, sliding door locks, sashlocks, screw locks, stile locks, spring locks, staylocks, swingbolt locks, locks for metal doors, locks for rolling shutters, locks for up-and-over doors, utility locks, window locks; padlocks, pin tumbler padlocks, steel padlocks, padlocks with chains, rolling shutter padlocks, special application padlocks, visual packed padlocks, armored padlocks and deadlocks; locksets; lock cases; lock bodies; cylinder locks; lock mechanisms; metal mounting cases; plugs; pivots and pivot sets; plates, locking plates, letter plates, cover plates, mounting plates, escutcheon plates and striking plates; rings; shackles; staples; screws; springs; spindles; shims; door thumbturns; arm caps; articles for use by locksmiths in the repair and preparation of locks and keys; and parts and fittings included in Class 6 for all the aforesaid goods.</i></p> <p><u><i>Class 9</i></u> <i>Electrical and electronic security or alarm apparatus; annunciator panels; detector switches and relays for actuating an alarm; pivots modified to allow for passage of electrical wiring; sirens; audible and silent alarms and indicators; electrically or electronically operated burglar alarm apparatus and instruments; battery chargers; access control apparatus; electrically controlled locks; electronically operated door closers; electric control apparatus for doors; electronic door locks; electrically controlled door locks activated by keycards; computer controlled apparatus for coding keycards; combined electronically controlled door holder/closer; electronic door control and monitoring</i></p>

Opponent's Goods	Contested Goods
	<p><i>panels; electrical automatic door operators; electromagnetic door holders; electromagnetic floor closers; electromagnetic door releases; electromagnetic locks; alarms (not for vehicles); alarm locks; push button locks; electromechanical door holders; electromechanical door holder/releases; electromechanical door holder/closers; electromechanical door latches; key operated controls; card-operated locks; key pads, keypad-operated locks; solenoid-operated locks; electromechanical exit devices; electronically controlled door opening devices; automatic activating devices for opening doors; electronically controlled door closing devices; fire control systems comprising annunciator panels, detector switches and relays; keycard controlled electronic security systems comprising alarm and control modules; interface electronics and computer hardware and computer software for controlling electronic security alarm systems; locks operated by internal computer; identification devices; code or keycard activated electric or magnetic locks; infra-red or magnetic contact detectors; infra-red keys; magnetic cards; magnetic card readers; radio-frequency door closers and door controls; transformers; infra-red decoder transformers and electronic transformers; electric decoders; radar scanning apparatus; light-operated apparatus; security systems and apparatuses; scanners; microprocessor controlled door locks activated by encoded cards; smoke detectors; motion detectors; transmitters; electrical wires; cabling; electric-release strikes; infra-red receivers; switching devices (electric); visual and audible annunciators; batteries; electric power supplies, door viewers; and parts and fittings included in Class 9 for all the aforesaid goods.</i></p>

30. The opponent submits that the contested goods are similar or identical to its goods.⁷ It notes that its Class 19 goods comprise non-metallic goods relating to

⁷ The opponent had submitted that the contested goods are similar or identical to its goods and services. However, the marks that covered services were all subject to the proof of use requirement, which I found had not been met.

buildings and construction, while the contested application seeks protection in relation to goods in Class 6, which covers metallic goods relating to buildings and construction, and that there is a degree of overlap between the specifications. It continues:

“Following *Canon*, the degree of similarity cannot be outweighed by the fact that the goods are dissimilar in one factor, e.g. where one good is metallic and the other is non-metallic. Both classes contain goods with identical purposes, relevant publics, producers and sales channels. They are also in many cases ... complementary or in competition.”⁸

31. On the other hand, the applicant submits that the goods are not similar, as they have different uses, different physical natures and are likely to be sold by different retailers.

32. While adopting either of these approaches would simplify the goods comparison, the variety of goods, particularly in the applicant’s specification, requires a more detailed approach, taking account of all relevant factors. Where it seems to me appropriate to do so I shall group goods together, in line with the comments of the Appointed Person Mr Geoffrey Hobbs QC 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.”⁹

33. I shall take account of the case law on complementarity which the CJEU stated in *Kurt Hesse v OHIM*, Case C-50/15 P, is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means

⁸ Paragraph 24.

⁹ Paragraph 5.

“... 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.”¹⁰

34. The purpose of examining whether there is a complementary relationship between the goods is to assess whether the relevant public is liable to believe that responsibility for the goods lies with the same undertaking or with economically connected undertakings. Mr Daniel Alexander QC, sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings Limited (LUV/LOVE)*, BL O-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”¹¹

and

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”¹²

35. I also bear in mind the decision of the GC in *Gérard Meric v OHIM*, Case T-133/05, where the court said:

“... the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.¹³

¹⁰ Paragraph 82.

¹¹ Paragraph 18.

¹² Paragraph 20.

¹³ Paragraph 29.

The opponent's goods

36. The opponent's goods are all used during construction or manufacturing processes. Their users are therefore companies or individuals involved in these trades, or, in the case of the Class 19 goods, the general public making home improvements. They will be sold through specialist retailers. In some cases, the specification states that the goods are made of plastic; elsewhere the terms are broader, namely "building materials" in Class 19 and "plates" in Class 17. It is settled case-law that words used in specifications should be given their ordinary and natural meanings: see *YouView Ltd v Total Ltd* [2012] EWHC 3158 (Ch). I also recall that the Nice Classification is an administrative tool. However, in *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)* [2018] EWHC 3608 (Ch), the late Mr Justice Carr considered whether it was appropriate to take the class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods and/or services shown in the evidence. After considering the judgments of the High Court in the *Omega 1*¹⁴ and *Omega 2*¹⁵ cases, the judge stated that in his (provisional) view, the class number should be taken into account where the meaning of the disputed term is not otherwise sufficiently clear and precise. In particular the judge stated that where "the words chosen may be vague or could refer to goods or services in numerous classes, the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services".¹⁶ The same principle is applicable to opposition proceedings.

37. The headings for Classes 17 and 19 are as follows:

"Unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials; plastics and resins in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, tubes and hoses, not of metal."

¹⁴ [2010] EWHC 1211 (Ch)

¹⁵ [2012] EWHC 3440 (Ch)

¹⁶ Paragraph 94.

“Materials, not of metal, for building and construction; rigid pipes, not of metal, for building, asphalt, pitch, tar and bitumen; transportable buildings, not of metal; monuments, not of metal.”

38. Where the terms in the opponent’s specification are vague or may refer to goods in numerous classes, I shall keep these headings in mind as I make my comparison.

The applicant’s Class 6 goods

39. The applicant’s specifications for both Class 6 and Class 9 include *parts and fittings* for the goods listed therein. I shall consider the goods discussed below to include the relevant parts and fittings.

40. The applicant’s *adjusters, casement window adjusters, window catches, transom catches, catches for fanlights, casement fasteners, sash fasteners, handles, lockable window handles* and *casement latches* are all fittings that are used to allow a window to be opened, closed or to remain in that position. In my view, the relevant public would expect these fittings to be the responsibility of the same undertaking as the opponent’s *windows* or *plastic window systems*. Consequently, I find them to be complementary and similar to a high degree.

41. To my mind, the same reasoning applies to the applicant’s *Door catches, door pulls, door handles (pull type), door handles (lever type), patio door handles, handle sets, hinges, knobs, knob sets and shutter knobs, latches, ring latches, rim latches, mortice latches, upright latches, combination knocker and latch sets, latch retainers, pivots and pivot sets* and *striking plates*. These are all items that enable the opponent’s doors or shutters to be opened or closed. I find these also to be similar to the opponent’s *doors of plastic* and *folding shutters* to a high degree.

42. The applicant’s *Catches for cupboards, catches for showcases, draw pulls, drawer pulls* are all used with items of furniture. I find them to be dissimilar to the opponent’s goods.

43. The applicant's *bolts, deadbolts, door bolts, chain bolts, hinge bolts, panic bolts, patio bolts, stay bolts, window bolts, handle bolts, hook bolts, latch bolts, press bolts, swing bolts, foot bolts and roller bolts, padbars, chains, door chains and security chains, door releases, chain door fasteners [sic], hasps, combination locker latch sets and night latches, locks, bathroom locks, combination locks, cylinder locks, door locks, hookbolt locks, mortice locks, multi-lever mortice locks, multi-point locks, nightlatch locks, rim locks, multi-lever rim locks, pump cylinder rim locks, patio door locks, sliding door locks, sashlocks, screw locks, stile locks, springlocks, staylocks, swingbolt locks, locks for up-and-over doors, utility locks, window locks, deadlocks, locksets, lock cases, lock bodies, cylinder locks and door thumbturns* are all locks that can be fixed to the opponent's *windows or doors of plastic* to secure the building in which the windows or doors have been fitted. To my mind, these goods are complementary. They are used together and the average consumer would expect them to be sold by the same or related undertakings. It would be common for the doors or windows to be supplied with locks. I find that these goods are similar to a medium degree.

44. On the other hand, *locks for metal doors* would not be used with the opponent's doors, which are made from plastic. They are not complementary to the opponent's goods, neither are they in competition. Their nature is dissimilar: the opponent's goods are made from plastic, while the applicant's are made from metal. Their purposes are different and the goods will be supplied through different trade channels. I find *locks for metal doors and armored padlocks and deadlocks* to be dissimilar to the opponent's goods.

45. The applicant's *bike locks, cam locks, cabinet locks, checklocks, drawer locks, furniture locks, locks for safes, gate locks, locks for rolling shutters and rolling shutter padlocks* are all locks that are used to secure items other than windows, doors or folding shutters. These include furniture, bicycles and safes. Their users and trade channels are different, and I find that they are neither in competition nor complementary. To my mind, these goods are dissimilar to the opponent's goods.

46. *Padlocks, pin tumbler padlocks, steel padlocks, padlocks with chains, special application padlocks, visual packed padlocks and armored padlocks* may all be used with the opponent's doors but can have other uses too. The trade channels are

different from those of the opponent's goods and the average consumer would not expect them to be the responsibility of the same undertaking just because they can be used together. I also find them to be dissimilar.

47. *Brackets, nuts, valves, metal washers, spacers of metal, cables, plugs, metal clamps, fasts, fasteners, locking plates, cover plates, mounting plates, rings, shackles, staples, screws, springs, spindles, shims and arm caps* are all items of ironmongery that would be used in construction projects to fasten or support parts. They have the same users as the opponent's *building materials* and are likely to be sold through the same trade channels. They are not in competition and there is a degree of complementarity. I find them to be similar to a medium degree to *building materials*.

48. *Mechanical door closers, mechanical door coordinators comprising door closers, door closer rods and shoes, door holders, door holders/stops, door holder/release/stops, door openers, mechanical floor closer/coordinator, mechanical exit devices and checking floor hinges* are devices that open or close doors in a controlled way or allow them to remain open. There will be some overlap in trade channels as the average consumer may purchase them with new door sets or may obtain them from specialist suppliers. There will be some complementarity. I find these goods to be similar to a medium degree to *doors of plastic* and *plastic door systems*.

49. The applicant's *safes* are used to secure property against theft. They tend to be made from metal and would be sold through different trade channels from those used for the opponent's goods. They are not in competition or complementary. I find them to be dissimilar to the opponent's goods. On the same basis, I find that *front doors for safes* (which, of course, are parts for those goods) are also dissimilar to the opponent's goods. *Metal mounting cases* are used to fix items such as safes to walls. I also find that they are dissimilar.

50. The applicant's *Door fittings, door knockers, door furniture, non-electric door bells, door scrapers, door stops, escutcheon sets, keyhole covers, combined door knockers and letter boxes and stillages, letter boxes, plates, letter plates and escutcheon plates* are all fittings that may be used with a door, although they are not essential to its basic operation. They share the same users and there will be an overlap in trade channels,

as businesses that sell doors are likely also to sell door furniture and fittings. There is also a degree of complementarity. Consequently, I find these goods to be similar to a medium degree to the opponent's *doors of plastic*.

51. *Hooks* and *coat hooks* will also have overlapping trade channels with *doors of plastic*, as they will be sold by retailers selling DIY or home improvement products. Hooks may be attached to the door, or to a wall. I consider there to be a degree of complementarity, although this may be at a fairly low level. I find there to be a low degree of similarity between these goods.

52. The applicant's *Door cases*, *door frames*, *door panels* and *door sets* are, in my view, clear terms and may be given their ordinary and natural meaning without using the heading for Class 6.¹⁷ They are all parts that make up the opponent's (*Plastic*) *door systems*. Consequently, I find them to be identical under the *Meric* principle.

53. *Mullions* are the parts of a door or window that separate panes of glass or panels and *mullion stabilizers* are small metal fittings that can improve the security of a panelled door and make it harder for it to be shaken open. The applicant has not specified whether the term *mullion* refers to a part of a door or a window, or either.

54. The users of mullions will be manufacturers of doors and windows and they will obtain those goods from specialist suppliers. The GC stated in *Les Éditions Albert René v OHIM*, Case T-366/03:

“... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”¹⁸

¹⁷ *Common metals and their alloys, ores; metal materials for building and construction; transportable buildings of metal; non-electric cables and wires of common metal; small items of metal hardware; metal containers for storage of transport; safes.*

¹⁸ Paragraph 61.

The windows and doors themselves would be bought by construction companies, builders or property owners, with the end-user being a member of the general public. The purpose of the mullions is structural. Nevertheless, in the case of windows at least, it seems to me that the average consumer might expect the same entity to be responsible for both mullions and the window as a whole. I find that they are complementary and similar to a medium degree.

55. I have no evidence to say whether *mullion stabilizers* might be used with the opponent's *doors of plastic*. The difference in nature and intended purpose lead me to find that they are not complementary. I find *mullion stabilizers* to be dissimilar to the opponent's goods.

56. The applicant's goods include *keys* and related articles. Keys are used in locks to secure property. Their users are members of the general public, who will also be the end-users of the opponent's goods. They are made from metal, but will be supplied with lockable doors. The average consumer would expect the same, or a connected undertaking, to be responsible both for the key and for the door it is to be used with. In my view they are complementary. I find that *keys* are similar to a high degree to the opponent's *doors of plastic* and *plastic door systems*. However, I find that there is no complementarity between the applicant's *doors* and *key holders, key rings, key blanks, keying systems, metal keying kits* and *articles for use by locksmiths for the repair and preparation of locks and keys*. Consequently, I find them to be dissimilar.

57. The applicant's *lock mechanisms* comprise the parts inside a lock that make it work. They would generally be made from metal. The users of these goods are manufacturers of locks or locksmiths who wish to replace parts and who would buy those parts from specialist suppliers. They are not in competition with the opponent's goods. I recall that I found complementarity between the opponent's *doors* and *windows* and some of the applicant's locks, but in my view this does not extend to the mechanisms. The average consumer would not expect a supplier of doors or windows also to provide lock mechanisms, except as part of a finished product. I find *lock mechanisms* to be dissimilar to the opponent's goods.

Class 9 goods

58. The applicant's *door viewers* are optical instruments consisting of lenses that are placed in a door and which enable someone on the inside to see who is on the other side of the door. It is self-evident that they will be used with the opponent's *doors of plastic* and they may be optional fittings in a new door. There is, in my view, a degree of complementarity. A hotel business, for example, acquiring new doors would expect the viewers and the doors to be the responsibility of the same or connected undertakings. I find the goods to be similar to a medium degree to the opponent's *doors of plastic*.

59. The remaining goods in this Class are electrical or electronic equipment, many of which have security purposes. This includes electronic locks, security systems and control apparatus. All these may be used with doors, but I remind myself of the comment of Mr Daniel Alexander QC in *LUV/LOVE* quoted in paragraph 34 above. The mere fact that the goods may be used together is not sufficient for a finding of similarity. They are different in nature and are unlikely to be sold through the same trade channels. The average consumer would, in my view, expect them to be produced by different undertakings. Consequently, I find that the remaining Class 9 goods are dissimilar to the opponent's goods.

Summary

60. For convenience, my findings of similarity are summarised in the table below:

<p><u>Identical</u></p> <p>Class 6: <i>Door cases, door frames, door panels, door sets.</i></p>
<p><u>Similar to a high degree</u></p> <p>Class 6: <i>Adjusters, casement window adjusters, door and window catches, transom catches, catches for fanlights, casement fasteners, sash fasteners, handles, hinges, keys, latches, casement latches, ring latches, rim latches, mortice latches, upright latches, combination knocker and latch sets, latch retainers, pivots and pivot sets, striking plates; parts and fittings included in Class 6 for all of the aforesaid goods.</i></p>

Similar to a medium degree

Class 6: Bolts, deadbolts, door bolts, chain bolts, hinge bolts, panic bolts, patio bolts, stay bolts, window bolts, handle bolts, hook bolts, latch bolts, press bolts, swing bolts, foot bolts and roller bolts, brackets, nuts, padbars, chains, door chains and security chains, mechanical door closers, mechanical door coordinators comprising door closers, door stops and door releases, door closer rods and shoes, valves, metal washers, spacers of metal, door holders, door holder/stops, door holder/release/stops, door fittings, door knockers, door furniture, non-electric door bells, door openers, door scrapers, cables, plugs, metal clamps, door pulls, door sets, escutcheon sets, mechanical floor closer/coordinator, mechanical exit devices, mullions, fasts, fasteners, chain door fasteners [sic], hasps, checking floor hinges, keyhole covers, knobs, knob sets and shutter knobs, combination locker latch sets and night latches, combined door knockers and letter boxes and stillages, letter boxes, locks, bathroom locks, hookbolt locks, mortice locks, multi-lever mortice locks, multi-point mortice locks, nightlatch locks, rim locks, multi-lever rim locks, pump cylinder rim locks, patio door locks, sliding door locks, sashlocks, screw locks, stile locks, springlocks, staylocks, swingbolt locks, locks for up-and-over doors, utility locks, window locks, deadlocks, locksets, lock cases, cylinder locks, plugs, plates, locking plates, letter plates, cover plates, mounting plates, escutcheon plates, rings, shackles, staples, screws, springs, spindles, shims, door thumbturns, arm caps; parts and fittings included in Class 6 for all of the aforesaid goods.

Class 9: Door viewers.

Similar to a low degree

Class 6: Hooks, coat hooks.

61. I found the remaining goods to be dissimilar to the opponent's goods. For a section 5(2)(b) claim to succeed there must be some similarity between the goods and/or services. The opposition therefore fails in respect of the goods I found to be dissimilar.

Average consumer and the purchasing process

62. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”¹⁹

63. The average consumer of the goods at issue is an individual or business in the construction industry, or an individual making home improvements. They will purchase the goods from a specialist supplier, either from a catalogue or the internet, or perhaps a bricks-and-mortar shop or showroom. It follows that the visual element will be important in the decision, although I do not discount the aural element as word-of-mouth recommendations may play a part and goods may also be ordered by telephone. For the trade customers these are likely to be regular purchases, but will be less frequent for the homeowner. They range in price, but the quality will be important. In my view, the average consumer will be paying an average degree of attention for most of the goods. For more expensive purchases such as door or window systems, the average consumer will in my view be paying an above average degree of attention.

Comparison of marks

. It is clear from *SABEL* (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 CJEU stated in *Bimbo* that:



“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”²⁰

¹⁹ Paragraph 60.

²⁰ Paragraph 34.

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

66. The respective marks are shown below:

Earlier mark	Contested mark
	

67. The earlier mark consists of the word “VEKA” presented in blue capitals in a standard font on a white rectangular background. The rectangle is then shown in the middle of an equilateral blue diamond with borders of varying thickness in white and blue. It appears that this diamond has been superimposed on another of the same size. At the right of this device can be found the words “Das Qualitätsprofil” in black title case, again in a standard font, and below these words seven blue stars in a row. The opponent submits that the words will be interpreted as a laudatory statement, given their proximity to the stars. While I can accept that the stars are laudatory, it seems to me that the average consumer would identify that the words are in a foreign language (and possibly recognise this language as German) but would not necessarily understand what they mean. The consumer’s eye will pass quickly over them and be drawn to the device and the word contained therein. The word VEKA itself is the most distinctive element of the mark, but the shape and the German words also make a contribution to the overall impression of the mark.

68. The applicant submits that its mark

“... is comprised of the word ‘Vecta’ in a soft, rounded font and is encapsulated in a distinctive, opaque, oval background. It will therefore play an important role in the assessment of the visual similarity between the marks.”

In its counterstatement, the applicant also said:

“In circumstances where there is a figurative element to the competing marks emphasis should be placed on those figurative elements (*G-Star Raw Denim kft v OHIM*, Case T-309/08, 21 January 2010).”

In that particular case, though, the figurative elements were significantly more fanciful than they are here, as the initial letter of the contested mark included a stylised Chinese dragon head. Here, it is my view that an oval background is a banal shape that makes a negligible contribution to the overall impression of the mark. The dominant and distinctive element of the mark is the word “Vecta”.

Visual comparison

69. The contested mark consists of five letters in title case, while the dominant and distinctive element of the earlier mark consists of four letters in upper case, three of which are found in the contested mark in the same order. The opponent submits that the marks are visually highly similar. However, as I have already found, the overall impression of the earlier mark is not confined to the word “VEKA”. The German phrase, the use of the colour blue, and the diamond device also play a part. The marks are visually similar, to my mind, to a low degree.

Aural comparison

70. The opponent also submits that the marks are aurally similar to a high degree, based on the following analysis:

“The similarity is heightened by the identical onsets (the consonant sound V at the beginning of the first syllables VE/VEK) and identical nucleuses (the

vowel E in the middle of the first syllables VE/VEK). The second syllables also share the same coda or auslaut (the vowel A which follows the consonants [sic] K/T in the final syllables KA/TA). Due to these identical sounds and the brevity of the respective word elements, the overall impression will be of a very similar or even identical word when enounced by the relevant public.”

71. I agree with the opponent that the phrase “Das Qualitätsprofil” will not be pronounced and so the aural comparison is between “VEKA” and “VECTA”. The applicant submits that the marks are not aurally similar, as the contested mark will be pronounced “VEK-TA”, with a short E, and the earlier mark as “VEE-KA” or “VEY-KA”. It is not obvious how the earlier mark will be spoken by the average consumer, so it seems to me most likely that they will say it phonetically as “VEK-A”. Consequently, I find that the marks are aurally highly similar.

Conceptual comparison

72. The contested mark will be seen as an invented word, and the earlier mark will be understood to comprise an invented word on a decorative device with no conceptual content, accompanied by a phrase in a foreign language. It follows that neither mark has a readily understandable concept and the conceptual position is neutral.

Distinctiveness of the earlier mark

73. There is, as I have already noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark’s distinctive character in *Lloyd Schuhfabrik Meyer*:

“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 1989 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).”

74. Earlier in my decision, I found that the dominant and distinctive element of the mark was “VEKA” and that the average consumer would think that the word had been invented. It follows that the mark has a high level of inherent distinctiveness. The opponent makes no claim that the mark’s distinctiveness has been enhanced through use and I do not consider that the evidence filed would support such a claim.

Conclusions on likelihood of confusion

75. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 26 of this decision. Such a global assessment is not a mechanical exercise. I must keep in mind the average consumer of the goods and the nature of the purchasing process. I remind myself that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture they have kept in their mind: see *Lloyd Schuhfabrik Meyer*, paragraph 27.

76. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, gave helpful guidance on making a global assessment:

“81.2 ... in my view it is important to keep in mind the purpose of the whole exercise of a global assessment of a likelihood of confusion, whether direct or indirect. The CJEU has provided a structured approach which can be applied by tribunals across the EU, in order to promote a consistent and uniform approach. Yet the reason why the CJEU has stressed the importance of the ultimate global assessment is, in my view, because it is supposed to emulate what happens in the mind of the average consumer on encountering, for example, the later mark applied for with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.

81.3 Third, when a tribunal is considering whether a likelihood of confusion exists, it should recognise that there are four options:

81.3.1 The average consumer mistakes one mark for the other (direct confusion);

81.3.2 The average consumer makes a connection between the marks and assumes that the goods or services in question are from the same or economically linked undertakings (indirect confusion);

81.3.3 The various factors considered in the global assessment lead to the conclusion that, in the mind of the average consumer, the later mark merely calls to mind the earlier mark (mere association);

81.3.4 For completeness, the conclusion that the various factors result in the average consumer making no link at all between the marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods or services;

81.3.5 Accordingly, in most cases, it is not necessary to explicitly set out this fourth option, but I would regard it as a good discipline to set out the first three options, particularly in a case where a likelihood of indirect confusion is under consideration.”

77. The opponent notes that there is a greater likelihood of confusion where the earlier mark is highly distinctive and submits that this is the case here. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis QC, sitting as the Appointed Person, pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the mark that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

78. I recall that it is the word “VEKA” that is the dominant and highly distinctive element of the earlier mark. This has a clear counterpart in the “VECTA” of the contested mark. Although I found that the marks in question had only a low degree of visual similarity, I agree that the distinctiveness of the mark increases the likelihood of confusion, bearing in mind the imperfect recollection of the average consumer. The marks have no conceptual content to help the consumer distinguish between them, and the figurative elements play a small or negligible role in the overall impressions of the earlier and contested marks respectively. Aurally, they are highly similar. While I found that the visual element would be most important in the purchasing process, the aural aspect cannot be ignored. Where the goods are identical or similar, the average

consumer is likely to be directly confused, mistaking one mark for the other. I recall that I found the applicant's *hooks* and *coat hooks* to be similar to a low degree to the opponent's goods. Given the distinctiveness of the earlier mark, I consider that there would be a likelihood of direct confusion even for these goods.

79. In the event that I am wrong in making this finding, I shall consider whether indirect confusion is likely. It seems to me that it is unlikely. If the average consumer recognises that they are different marks, there is nothing to suggest that they would then assume that the undertakings were the same or connected. At the most, the later mark might call to mind the earlier mark. Consequently, I find there to be no likelihood of indirect confusion.

80. The opposition succeeds in respect of the goods that are listed in the table in paragraph 60 as identical or similar.

CONCLUSION

81. The opposition has been partially successful. The application by Vecta Safes (UK) Limited may proceed to registration in respect of the following goods that I have found to be dissimilar:

Class 6

Catches for cupboards, catches for showcases, safes, front doors for safes, draw pulls, drawer pulls, mullion stabilizers, key holders, key rings, key blanks, keying systems, metal keying kits, bike locks, cam locks, cabinet locks, checklocks, drawer locks, furniture locks, locks for safes, gate locks, locks for metal doors, locks for rolling shutters, padlocks, pin tumbler padlocks, steel padlocks, padlocks with chains, rolling shutter padlocks, special application padlocks, visual packed padlocks, armored padlocks, lock mechanisms, metal mounting cases, articles for use by locksmiths in the repair and preparation of locks and keys; parts and fittings included in Class 6 for all of the aforesaid goods.

Class 9

Electrical and electronic security or alarm apparatus, annunciator panels, detector switches and relays for activating an alarm, pivots modified to allow for the passage of electrical wiring, sirens, audible and silent alarms and indicators, electrically or electronically operated burglar alarm apparatus and instruments, battery chargers, access control apparatus, electronically controlled locks, electronically operated door closers, electric control apparatus for doors, electronic door locks, electrically controlled door locks activated by keycards, computer controlled apparatus for coding keycards, combined electronically controlled door holder/closer, electronic door control and monitoring panels, electrical automatic door operators, electromagnetic door holders, electromagnetic floor closers, electromagnetic door releases, electromagnetic locks, alarms (not for vehicles), alarm locks, push button locks, electromechanical door holders, electromechanical door latches, key operated controls, card-operated locks, keypads, keypad-operated locks, solenoid-operated locks, electromechanical exit devices, electronically controlled door closing devices, fire control systems comprising annunciator panels, detector switches and relays, keycard controlled electronic security systems comprising alarm and control modules, interface electronics and computer hardware and computer software for controlling electronic security alarm systems, locks operated by internal computer, identification devices, code or keycard activated electric or magnetic locks, infra-red or magnetic contact detectors, infra-red keys, magnetic cards, magnetic card readers, radio-frequency door closers and door controls, transformers, infra-red decoders, radar scanning apparatus, light-operated apparatus, security systems and apparatuses, scanners, microprocessor controlled door locks activated by encoded cards, smoke detectors, motion detectors, transmitters, electrical wires, cabling, electric-release strikes, infra-red receivers, switching devices (electric), visual and audible annunciators, batteries, electric power supplies, parts and fittings included in Class 9 for all the aforesaid goods.

COSTS

82. Both parties have had a roughly equal share of success in these proceedings. In the circumstances, I decline to make an award of costs.

Dated this 5th day of June 2020

Clare Boucher

For the Registrar,

Comptroller-General