

**TRADE MARKS ACT 1938 (AS AMENDED) AND  
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1543979  
IN THE NAME OF LAUER MEMBRAN WASSERTECHNIK  
TO REGISTER A TRADE MARK IN CLASS 11**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No 42319  
BY THE BSS GROUP PLC**

## **TRADE MARKS ACT 1938**

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in the name of Lauer Membran Wassertechnik  
to register a Trade Mark in Class 11**

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**IN THE MATTER OF Opposition thereto under No 42319  
by The BSS Group PLC**

### **BACKGROUND**

1. On 5 August 1993 Lauer Membran Wassertechnik, a German company, applied to register the trade mark AQUABOSS in respect of the following:-

Water filter elements; apparatus for water purification and conditioning; parts and fittings for all the aforesaid goods; all included in Class 11.

2. On 18 April 1995 the BSS Group PLC filed notice of opposition to this application for registration. The grounds, initially, were extensive but, prior to the Hearing, these were narrowed to a single ground based upon Section 11. The opponent claimed to have a very substantial reputation in the trade mark BOSS as a result of its extensive and lengthy use in relation to goods which are the same or similar to those covered by the application for registration. Thus, use by the applicant of their trade mark in respect of the goods covered by the application would be likely to deceive or cause confusion.

3. Both parties filed evidence in these proceedings and the matter came to be heard on 6 February 2001 when the applicant for registration was represented by Ms Fiona Clark of Counsel, instructed by Frank B Dehn their Trade Mark Attorneys and the opponents by Mr David Young of Her Majesty's Counsel instructed by Marks & Clerk, their Trade Mark Attorneys.

4. By the time this matter came to be heard, the old Act had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the Trade Marks Act 1938 however, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the provisions of the old law, unless otherwise indicated.

## DECISION

5. The only ground of opposition being pursued by the opponent is that under Section 11 of the Act which states:

"11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

6. The established test for grounds of opposition based upon Section 11 is set down in Smith Hayden & Co Ltd's application (1936 63) RPC 101 as adapted by Lord Upjohn in the BALI trade mark case (1996) RPC 496. Adapted to the matter in hand, the relevant test may be expressed as follows:

Having regard to the user of the trade mark BOSS is the tribunal satisfied that the mark applied for, AQUABOSS, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

7. Considering the matter I also take account of the guidance set down by Parker J in Pianotist Companies application (1906) 23 RPC 777 at line 26 et seq, which reads as follows:

"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

8. First of all I consider whether or not the goods sold under the opponent's trade mark are the same or of the same description as those to be provided under the applicant's trade mark. In that respect I have regard to the matters set out by Romer J. in Jellinek (1946) 63 RPC 59. These are:-

- (a) the nature and composition of the goods;
- (b) the respective uses of the articles;
- (c) the trade channels through which the commodities are respectively bought and sold.

9. At paragraph three of his Statutory Declaration dated 26 February 1997, Mr Alan Milne, the Group Finance Director of the opponent stated that his company's product range consisted of the following:-

Metal tubes and fittings, pipeline plastics, valves, steam and air traps, heat exchange equipment, pumps and plumping equipment, instruments and meters, strainers and filters, heat omitters, heating and air conditioning controls, chimney and flue systems, jointing compounds, plumbers' supplies and tools inter alia in the industrial field and boilers, radiators, pumps, cylinders, heating controls, plastic pipes and fittings, copper tubes and fittings, sanitaryware, gas fires etc. aimed at the domestic market in particular via plumbers and heating installers.

10. The specification of goods covered by the application is as follows:-

Water filter elements; apparatus for water purification and conditioning; parts and fittings for all the aforesaid goods; all included in Class 11.

11. There were submissions from Ms Clark to the effect that the goods covered by her clients application for registration were so far removed from those sold by the opponents that they were neither the same nor goods of the same description. She based this upon the fact that her clients, as stated in a Declaration of 23 October 1997 by Mr Hans Gunter Lauer, Director and owner of the applicant company, were in the business of "marketing, distribution, sale and maintenance of water purification technology, in particular reverse osmosis facilities, water purifiers and softners, dialysis units and the like". The applicant's brochures attached to that Declaration support the submission that the applicants' goods are focussed on that particular sector of the market. For example, there is a brochure which has reference to "dialysis technology". Thus, prima facie, there is substance in Ms Clarks' submission. However, as Mr Young rightly pointed out I have to take account of notional and fair use of the applicant's trade mark across the full breadth of the specification of the application and compare that with the actual use of the opponent's trade mark. In that respect, I note that the applicant's specification is not limited in terms of the supply of water purification equipment in the way suggested by Ms Clark. My comparison must be based accordingly.

12. In my view, the strainers and filters sold by the opponent could be the same goods or goods of the same description as the water filter elements or apparatus for water purification and conditioning contained in the applicant's specification. In addition, the parts and fittings for the applicant's goods could include a number of the items sold by the opponent ie. metal tubes and fittings, pumps etc. Therefore, the nature and composition of the goods and the respective uses of the articles could be said to be the same. Also, given the breadth of the applicant's specification, I see no reason why the respective goods could not be sold through the same trade channels. Specialist water supply equipment outlets (for, say, the trade) or D.I.Y. stores for the public at large.

13. Turning now to the respective trade marks. The applicant's trade mark consists of the word AQUABOSS and the opponent's trade mark the word BOSS. It seems to me that the prefix AQUA in relation to the goods concerned is not a particularly distinctive element (AQUA of course being Latin for water). That being so, it seems to me that the focus in

respect of the applicant's trade mark would be on the suffix BOSS because that is the element around which all of the distinctive character is centred. In reaching this view I take into account the comments made by Sir Wilfred Green M.R. in *Saville Perfumery Ltd v June Perfect Ltd and FW Woolworth & Co Ltd* (1941) 58 RPC 147 at page 162 line 2 et seq:-

"..... traders who have to deal with a very large number of marks used in the trade in which they are interested, do not, in practice, and indeed cannot be expected to, carry in their heads the details of any particular mark, while the class of customer among the public which buys the goods does not interest itself in such details. In such cases the mark comes to be remembered by some feature in it which strikes the eyes and fixes itself in the recollection. Such a feature is referred to sometimes as the distinguishing feature, sometimes as the essential feature, of the mark."

"Now the question of resemblance and the likelihood of deception are to be considered by reference not only to the whole mark, but also to its distinguishing or essential features, if any."

14. In this case, we are dealing with ordinary industrial and domestic plumbing items, some of which are relatively inexpensive. I am thinking here of the parts and fittings as well as the specific plastic piping. In those circumstances it seems to me that the comments made by Sir Wilfred Green are particularly apt in this case because the relevant public could be both traders and ordinary members of the public; they will be many and various and most will only keep the distinctive element of a trade mark in their minds.

15. Before concluding matters I must, of course, be satisfied that the opponent has used the trade mark on the goods claimed. In that respect, though much of the evidence by both sides post dated the date of application in this case, I also take into account the fact that the opponent has used both BOSS and BSS trade marks on the goods as pointed out by Ms Clark. But I am satisfied that the opponent has used the trade mark BOSS on the range of goods claimed. In that respect I take particular account of the evidence of Mr Milne in his Statutory Declaration. The points I note in particular are:-

"The opponent company was founded in the United Kingdom in 1899 as the British Steam Specialities, and subsequently changed its name to the BSS Group PLC:-

The opponents trading divisions have approximately 109 branches throughout the United Kingdom - the opponent's two principal trade marks are BOSS and BSS. Use of BOSS commenced in 1924 and turnover of goods under the BOSS trade mark in the year 1992/93 amounted to some £7million, through the opponents own retail outlets.

Approximately £118K was spent advertising the trade marks BSS and BOSS in the period 1995 to 1996. Though after the material date I note that this amount is considered by Mr Milne to be typical of the amount spent in previous years - the opponent commenced use of the trade marks BSS and BOSS in relation to filters and strainers for industrial use in approximately 1980."

16. With all of that in mind I am satisfied that the opponent has used the trade mark on the goods claimed. I have also reached the view that the goods covered by the application for registration can be regarded either the same or of the same description as the opponent's goods. And for the reasons set out earlier I believe that the respective trade marks are similar because the applicants' trade mark would be remembered as a BOSS trade mark, the non-distinctive prefix being discounted. Therefore the applicant's AQUABOSS trade mark would be regarded by the relevant public as confusingly similar to the opponents BOSS trade mark. In all of the circumstances, if the applicant sought to use their trade mark in respect of the goods covered by their application for registration then there will be confusion in the minds of the public which will lead to confusion in the goods. Thus, the ground of opposition under Section 11 succeeds.

17. However, that does not end the matter. In the course of her submissions Ms Clark indicated that the applicant, depending upon my finding might be prepared to limit their specification in order to avoid refusal. I am grateful to Ms Clark for this, because I believe that there is scope for limiting the applicants' specification of goods in such a way that use of the applicant's trade mark will not be confused with that of the opponent.

18. It is clear from the applicant's evidence that they consider their goods to be for use in a specialist market. I note that at paragraph 5 of Mr Lauers' Statutory Declaration he states:-

The goods upon which the Trade Mark has been used are as follows:

RO-systems (Reverse Osmosis)  
softeners  
UV-disinfection apparatus  
electrodialysis apparatus  
other water treatment apparatus (e.g. ozone apparatus)  
spare parts (e.g. membranes)

19. If the applicant was to limit their application for registration to those particular goods then, given their specialist nature, compared to the routine domestic and industrial nature of the opponents goods, then I think the respective trade marks could live together in the market place. In reaching that view I have considered Mr Young's submissions to the effect that the respective trade marks might nevertheless be used alongside each other in, say, specialist plant rooms or hospital environments, such that confusion and deception may occur. It may well be that the respective trade marks, in those circumstances, will be used at the same location but it seems to me that the respective goods would still be provided to separate and distinct markets therefore, in my view no confusion is likely to occur.

20. In summary, the opponents have succeeded in respect of their opposition based upon Section 11 of the Act. However, if the applicant limits the specification to the precise goods upon which they state they use or intend to use the trade mark then the objection based upon Section 11 can be waived. Therefore, if they submit a Form TM21 within one month of the expiry of the appeal period limiting the specification of goods to the following:-

Reverse Osmosis equipment; water softening apparatus; Ultraviolet-disinfection apparatus; electrolysis apparatus; ozone apparatus and membranes; parts and fittings for all the aforesaid goods. all included in Class 11

the application may proceed to registration.

21. If a Form TM21 is not filed and the specification is not so limited then the application will be refused in total.

22. As the opponents have succeeded in this case I order the applicant to pay to them the sum of £850 as a contribution towards their costs. I see no reason for any reduction in this sum in the event that the specification of goods is amended and the application proceeds.

This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 4<sup>TH</sup> day of May 2001**

**M KNIGHT  
For the Registrar  
the Comptroller-General**