

O-256-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2478786
BY LG CHEM, LTD**

TO REGISTER THE TRADE MARK:

SEPARODE

IN CLASS 9

AND

**THE OPPOSITION THERETO
UNDER NO 97505
BY EVONIK DEGUSSA GMBH**

Trade Marks Act 1994

**In the matter of application no 2478786
by LG Chem, Ltd
to register the trade mark:
SEPARODE
in class 9
and the opposition thereto
under no 97505
by Evonik Degussa GmbH**

1) On 4 February 2008 LG Chem, Ltd (LG) applied to register the trade mark **SEPARODE**. The application was published for opposition purposes on 28 March 2008 with the following specification:

electrodes; batteries; capacitors; fuel cells; battery separator membranes for use in batteries, capacitors and fuel cells; separator plates for use in electric storage batteries, lithium batteries, capacitors and fuel cells.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 30 June 2008 Evonik Degussa GmbH (Evonik) filed an opposition to the registration of the trade mark. Evonik bases its opposition on section 5(2)(b) of the Trade Marks Act 1994 (the Act). According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

The earlier trade mark upon which Evonik relies is **SEPARION**. The trade mark is the subject of international registration no 887647, its date of designation in the United Kingdom is 23 March 2006. It was granted protection in the United Kingdom on 9 December 2006, there being no opposition subsequent to the publication of the registration on 8 September 2006. The trade mark is protected for a number of goods in seven classes, however, Evonik identifies the following specific goods of its registration as being identical or similar to the goods of LG's application:

apparatus and instruments for the supply, distribution, transformation, accumulation, regulation or control of electric current.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. Evonik considers that the respective trade marks are similar and that the identified goods are identical or similar.

3) LG filed a counterstatement in which it denies that the respective trade marks are similar. It requires that Evonik establishes that the respective goods are similar or identical.

4) Both parties filed evidence and submissions, neither side requested a hearing.

5) LG has filed a copy of a decision of the Institut National de la Propriété Industrielle (INPI) in relation to an opposition brought by Evonik against the registration of SEPARODE in France. The opposition is based on the same international registration as in this case. LG considers that this decision is persuasive, I cannot see that a decision of INPI can be persuasive; I assume that LG uses this term in its legal meaning. In the non-legal sense I do not find it persuasive. Both parties have made submissions in relation to this decision. I am seised with the matter before me in this jurisdiction and the evidence filed, I cannot see that debating the merits or otherwise of a decision of INPI is of assistance; indeed, it is a red herring. I will say no more about the decision of INPI¹. LG also refers to state of the register evidence. State of the register evidence does not tell one what is happening in the marketplace; it does not show that the relevant, average consumer is used to distinguishing between a variety of trade marks which share a common element². I will say no more about the state of the register evidence.

Comparison of goods

6) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade³”. Words should be given their natural meaning within the context in which they are

¹ I note the comment of Mr Geoffrey Hobbs QC, sitting as the appointed person, in BL O/201/04:

“Finally, it must be appreciated that all assertions of inconsistency between acceptances and refusals within a national Registry and all assertions of inconsistency between acceptances and refusals in different registries are, by their very nature, question-begging as to the correctness of each of the various acceptances and refusals that are brought into contention.”

² See *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04* and *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 re state of the register evidence.

³ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

used, they cannot be given an unnaturally narrow meaning⁴. Consideration should be given as to how the average consumer would view the goods or services⁵. The class of the goods and services in which they are placed is relevant in determining the nature of the goods⁶. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary⁷. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed⁸.

7) The evidence of Evonik included definitions of various terms in both specifications, some of those terms, such as supply, are so commonplace I do not see any need for reproduction of the definitions. I have rehearsed some of the definitions for those terms which are not quite so commonplace or where it is helpful to do so in the context of the issues before me. The definitions of the terms involved in the specification allow for the comparison within the parameters of the case law to be made. This is especially the case as a number of the terms

⁴ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

⁵ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

⁶ *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

⁷ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

⁸ He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(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;
- (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.”

in the specification of the application are encompassed by the portmanteau terms of the earlier application, making the respective goods identical (see below). Evonik has fulfilled its task in putting forward evidence in relation to the claim of identity or similarity of the goods.

8) The relevant definitions follow along with my findings based upon the definitions.

Electrode -

a conductor, not necessarily metallic, through which a current enters or leaves a non-metallic medium, as an electrolytic cell, arc generator, vacuum tube, or gaseous discharge tube;

a collector or emitter of electric charge or of electric charge carriers, as in a semiconducting device;

the ends of the wires or conductors, leading from source of electricity, and terminating in the medium traversed by the current.

Electrodes facilitate the entry and exit of an electric current, they are a means for the supply of electricity to a medium and so will be included in the term *apparatus and instruments for the supply of electric current* and so *electrodes* are identical to the goods of Evonik's registration.

Battery –

a combination of two or more cells electrically connected to work together to produce electric energy;

a single cell, such as a dry cell, that produces an electric current.

Batteries supply electricity and so *batteries* in LG's specification will be included in the term *apparatus and instruments for the supply of electric current* and so *batteries* are identical to the goods of Evonik's registration.

Capacitor –

a device for accumulating and holding a charge of electricity, consisting of two equally charged conducting surfaces having opposite signs and separated by a dielectric;

an electric circuit element used to store charge temporarily, consisting of two metallic plates separated and insulated from each other by a dielectric. Also called condenser;

an electrical device characterised by its capacity to store an electric charge;

a device used in electrical circuits. The capacitor stores an electrical charge for short periods of time, and then returns it to the circuit.

Capacitors accumulate power and so capacitors in LG's specification will be included in the term *apparatus and instruments for the accumulation of electric current* and so capacitors are identical to the goods of Evonik's registration.

Fuel cell –

a device that produces a continuous electric current directly from the oxidation of a fuel, as that of hydrogen by oxygen;

an electrochemical cell in which the energy of a reaction between a fuel, such as liquid hydrogen, and an oxidant, such as liquid oxygen, is converted directly and continuously into electrical energy.

Fuel cells supply electricity and so fuel cells in LG's specification will be included in the term *apparatus and instruments for the supply of electric current* and so fuel cells are identical to the goods of Evonik's registration.

Separator –

a device that prevents metal contact between plates of opposite charge in a storage battery.

Membrane –

a thin sheet of natural or synthetic material that is permeable to substances in solution.

Transform –

to increase or decrease (the voltage and current characteristics of an alternating-current circuit) as by means of a transformer;

to decrease (the voltage and current characteristics of a direct current circuit) as by means of a transformer;

to subject to the action of a transformer.

Accumulation –

accumulation of energy or power, the storing by means of weights lifted or masses put in motion, electricity stored.

Electric current –

a flow of electricity through a conductor

9) *Battery separator membranes and separator plates*, taking into account the definitions supplied, are devices that prevent metal contact between plates of opposite charge. In the context of this case, as per the specification, they are parts of batteries (including electric storage batteries and lithium batteries), capacitors and fuel cells. A normal understanding of apparatus and instruments will be that it refers to complete products rather than parts of products, so I do not consider that Evonik's specification encompasses *battery separator membranes and separator plates*, so the respective goods are not identical. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* the Court of First Instance (CFI) stated:

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

As found above, Evonik's specification will include batteries (at large), capacitors and fuel cells. The goods under consideration are indispensable to batteries (at large), capacitors and fuel cells, the former goods exist only to perform part of the latter goods. The respective goods are mutually dependent and, consequently, are complementary to a high degree. In considering the issue of similarity I bear in mind the findings of the CFI in *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03*:

“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.”

The position was reiterated by the CFI in *Promat GmbH v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle) (HABM)* Case T-71/08:

“33 Auch wenn, wie die Klägerin in der mündlichen Verhandlung ausgeführt hat, Mineralfasern und Werg denselben Ursprung haben können, genügt dies nicht, um die Ähnlichkeit der betreffenden Waren festzustellen. Die bloße Tatsache, dass ein Produkt als Einzelteil, Zubehör oder Komponente einer anderen Ware verwendet wird, reicht nicht als Beweis dafür aus, dass die diese Komponenten enthaltenden Endprodukte einander ähnlich sind (Urteil des Gerichts vom 27. Oktober 2005, Éditions Albert René/HABM – Orange [MOBILIX], T-336/03, Slg. 2005, II-4667, Randnr. 61).”

These judgments do not, however, state that a component cannot be similar to a finished product in which it appears; the matter is one that must be considered on the basis of the particular facts of the case.

10) The goods under consideration are not linked on a very general level, they are linked on a very specific level, the goods of the application could not be used in a multitude of other products, as screws or nails could be. Their sole purpose is to be parts of batteries, capacitors and fuel cells, goods which Evonik's registration encompasses. Consequently, the complementary nature of the respective goods creates a very close connection; this is not the sort of strained claim to similarity rejected by the CFI in *Assembled Investments (Proprietary) Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-105/05 (the judgment of the CFI was confirmed by the ECJ in Case C-398/07 P). The goods of LG will be used to help effect the purpose of the goods of Evonik and so there is a degree of similarity in relation to their respective purposes. The goods under consideration will go to the manufacturers of batteries rather than to the purchasers of batteries and so the users are not likely to be the same. I cannot see that the separators have the same nature or method of use as the goods of Evonik's registration. They are not fungible and so are not in competition. Despite the number of differences between the separators and the goods of the earlier registration, within the parameters of the case law, **I consider that the degree of complementarity is such that *battery separator membranes for use in batteries, capacitors and fuel cells; separator plates for use in electric storage batteries, lithium batteries, capacitors and fuel cells* are similar to a significant degree to the goods of the earlier registration.**

Average consumer, nature of purchasing decision and standard for likelihood of confusion

11) Batteries of the application will cover every type and form of battery. They include small domestic batteries. There will be batteries that are bought by specialists but I have to consider the specification in the round and in all of its

ramifications. LG refers to the highly specialised nature of the goods but I cannot see how this claim can apply to batteries at large, which are covered by the specification. Batteries can be of very low cost, they can be bought on the spur of the moment; especially when a battery in a device needs replacing. Batteries are bought by the public at large and the public of all ages. The purchasing decision in many circumstances will not be careful and educated. Consequently, in relation to *batteries* of the specification the effects of imperfect recollection are increased.

12) The other goods of the specification of the application will be bought by industrial undertakings rather than the public at large and by specialists within the industrial undertakings. Their nature means that the purchase of the goods will be the result of a careful and educated decision. The potential effects of imperfect recollection will be limited; the nature of the products is such that the purchaser will make every effort to make sure that there is no mistake in the purchase.

Comparison of trade marks

13) The trade marks to be compared are:

Evonik's trade mark

LG's trade mark

SEPARION

SEPARODE

The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details⁹. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components¹⁰. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant¹¹. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public¹².

⁹ *Sabel BV v Puma AG* [1998] RPC 199.

¹⁰ *Sabel BV v Puma AG* [1998] RPC 199.

¹¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

¹² *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

14) Evonik argues that both trade marks commence with the common prefix SEPAR (sic) and that the trade marks only differ in relation to the final three letters. A search for 'separ-' is exhibited, there are no results. Evonik submits that -ODE is a common suffix in words relating to electrical apparatus, for example in the words electrode, anode and cathode. In its evidence Evonik exhibits definitions for -ODE. It is defined as a suffix of nouns, it appears in loan words from Greek, in which language it means like. It is also described as a combining form meaning way and road and that it is used in the formation of compound words such as anode and electrode. Material is exhibited in relation to the meaning of anode and cathode. An anode is the electrode or terminal by which current enters an electrolytic cell, voltaic cell or battery, it is the negative terminal of a voltaic cell or battery, it is the positive terminal or element of an electron tube or electrolytic cell. A cathode is the electrode or terminal by which current leaves an electrolytic cell, voltaic cell or battery, the positive terminal of a voltaic cell or battery, the negative terminal, electrode, or element of an electron tube or electrolytic cell, it is a negatively charged electrode that is the source of electrons entering an electrical device. Evonik argues that the suffix -ION is also descriptive in relation to electrical apparatus. Evidence is exhibited in relation to ION. Ion is defined as an electrically charged atom or group of atoms formed by the loss or gain of one or more electrons, as a cation (positive ion) which is created by electron loss and is attracted to the cathode in electrolysis, or as an anion (negative ion) which is created by an electron gain and is attracted to the anode. It is also defined as one of the electrically charged particles formed in a gas by electric discharge, or the like. In relation to its meaning in physics, the term was introduced by Faraday.

15) Evonik argues that there is an intimate relationship between ions and electrodes which will be well understood by members of the relevant public. It claims that the conceptual pictures likely to be created by the suffixes -ODE and -ION are likely to be very similar. Evonik submits that because of their common prefix (sic) SEPAR- and short three letter suffixes, the respective trade marks are visually and phonetically similar. It states that this similarity is enhanced by the fact that the identical element is distinctive in itself and appears at the beginning of both trade marks. It also argues that the respective suffixes are suggestive of the goods and are closely connected in meaning, therefore, the trade marks are conceptually similar.

16) LG argues that the prefix (sic) SEPA is suggestive to the relevant public of separate which is descriptive and non-distinctive for the goods of the application and covered by the earlier registration. It claims that the suffixes -ODE and -ION clearly distinguish them, especially given the specialized field of activity within which the respective goods will be used. Due to the highly specialised nature of the goods the relevant public will be more circumspect when considering the products they wish to use and so likelihood of confusion will not arise. LG states that Evonik does not have exclusive rights to the use of the prefix (sic) SEPA -. LG submits that SEPAR is a clear abbreviation of separate

which directly describes the nature of the products sold by Evonik under its trade mark . A page from the website of Evonik relating to its SEPARION product is exhibited. The following appears on the page:

“Degussa offers the worldwide patented new generation of lithium-ion technology with clearly improved safety and abuse tolerance at the cell level. The core of this technology is Degussa’s SEPARION[®] separator, a ceramic composite. The ceramic nature of the SEPARION[®] separator delivers inherent thermal and chemical stability to the system. Independent testing has shown that lithium-ion batteries with the ceramic SEPARION[®] separator also pass the most critical overcharge and nail penetration tests, which frequently result in smoke or even fire when normal separators are used.....

..... Could lithium-ion batteries also be used to power hybrid vehicles?" This was the question the chemists at Degussa proposed. The objective: to combine the low energy consumption and superior performance of electric power systems with conventional combustion engines. A new kind of ceramic membrane developed by the Degussa company, called SEPARION[®], has proved successful here. As an important component of safe and powerful lithium-ion batteries for hybrid vehicles, it could smooth the path ahead for environmental cars.”

LG argues that no one party should be entitled to an exclusive right to the use of trade marks “prefixed” by SEPAR. LG submits that Evonik’s trade mark will be divided by the customer into SEPA – RODE not SEPAR – ODE. Any comparison should therefore be between the “prefixes” SEPA and the suffixes – RODE and –ION, which it claims are clearly distinguishable. LG submits that the respective trade marks are conceptually, phonetically and aurally different from each other.

17) Both parties work on the premise that the average consumer will set about dividing the respective trade marks and seeking meaning in their separate parts. Reference is made to the prefix at the beginning of the trade marks. SEPA or SEPAR are not prefixes as I understand the word. In *Collins English Dictionary* (5th Ed 2000) prefix is defined as:

n. 1. Grammar; an affix that precedes the stem to which it is attached, as for example un- in unhappy. Compare; suffix; 1; 2. something coming or placed before. vb. tr; 3. to put or place before. 4. Grammar; to add (a morpheme) as a prefix to the beginning of a word. prefixal; adj. 'prefixally; adv. prefixion; n. 'pre'flight; adj. pre'form; vb

What is referred to as a prefix is simply the start of the trade marks. Evonik adduced a search for words beginning with SEPAR with no hits, so not indicating that there is a profusion of such words. At one moment LG is arguing that the

trade marks will be divided into SEPA plus another element, at another moment that the SEPAR elements are descriptive of the products; if the SEPAR meaning is perceived this would seem to represent the division in the words that the average consumer would perceive; if he or she perceived any division. I can see no reason why the average consumer, whether that be the public at large or the specialist, would divide up the trade marks. They do not readily lend themselves to division, despite the comments of both sides. Even the philologist is unlikely to find an easy task in dividing the trade marks and even greater difficulty in defining a meaning from the words. LG refers to the use that Evonik makes of its trade mark; I am concerned with the specifications as applied for and registered and not just the goods upon which the earlier trade mark has been used, this not being a case where the earlier trade mark is subject to the proof of use provisions. Some of the goods of the application do serve a separating function but this still does not mean that the average consumer, who will be a specialist in relation to such goods, will seek meaning in the trade mark or find meaning in it. There is certainly nothing to suggest that the average consumer has been educated into seeing SEPAR or SEPA as indicating separation in relation to the respective goods. In the case of LG's trade mark what does the separation activity relate to? Ode as a word relates to verse not to a part or type of battery. It may be that battery technology uses technology to separate ions but I have no evidence to this effect; there is nothing that indicates this from the page from the website of Evonik that LG has exhibited. I consider that the trade marks, for both types of average consumer, in their entireties have no meaning. They may have been devised to reflect some aspect of the goods but this is not the same as them being perceived in such a fashion. In relation to conceptual meaning the case law demands that it is clear and obvious:

“the fact remains that that meaning must be clear, so that the relevant public are capable of grasping it immediately see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel(BASS)* [2003] ECR II-4335, paragraph 54).”¹³

In this case there is no obvious meaning. I do not consider that, even taking into account goods that separate, that the goods will have an “evocative effect”¹⁴.

18) LG submits that no one party can have exclusive rights to the use of SEPA at the beginning of a trade mark. No claim has been made to exclusive use of trade marks beginning with SEPA, so LG is tilting at a man of straw that it has constructed. I cannot see how this claim relates to whether trade marks are

¹³ *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-135/04). Also see *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 147/03.

¹⁴ See *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 353/04.

similar (and whether there is a likelihood of confusion)¹⁵. In this part of the decision the question before me is whether the respective trade marks are similar in their entireties, it is not to decide whether by finding similarity one is effectively granting an unfair monopoly (equally this is not a question in relation to a likelihood of confusion). Of course, in considering the matters before me I have to take into account the distinctive and dominant components of the trade marks.

19) As I have indicated above, I consider that both trade marks are invented words. I do not consider that any one part of the trade marks is dominant and distinctive, they are unlikely to be divided up, regardless of the submissions of the parties. The trade marks are distinctive in their entireties. It is often stated that the beginnings of words are more important in consideration of similarity than the endings¹⁶. I consider that in this case this rule of thumb applies, the endings of the two trade marks do not draw the average consumer away from the beginnings. Both trade marks start with SEPAR, which as far as the beginnings of the trade marks are concerned creates visual and phonetic identity. The endings of the trade marks both include the letter 'o' but in different positions. LG's trade mark ends in a single syllable while the trade mark of Evonik ends with two syllables. The spoken emphasis is likely fall on the first two syllables of LG's trade mark. In my view Evonik's trade mark is likely to be pronounced SEP

¹⁵ See by analogy the judgment of the CFI in *Koipe Corporación SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-363/04*:

"83 However, OHIM submits that a single competitor cannot exclusively appropriate to itself the representation of a woman. The question whether the elements which make up a trade mark may be freely used by other competitors does not form part of the examination of the distinctive character of the figurative elements of a trade mark (see, by way of analogy, Case C-329/02 P *SAT.1 v OHIM* [2004] ECR I-8317, paragraph 36). The only relevant issue in that examination is whether the sign examined is distinctive or not, a question which, as regards the seated woman, OHIM has already answered affirmatively."

and the judgment of the ECJ in *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-235/05 P*:

"45 The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

¹⁶ See for instance: *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03*.

– AR - EE – ON, with the emphasis falling on the third syllable; this pronunciation further decreases the possibilities of conceptual connotations. There is, consequently, a reasonable degree of phonetic similarity. As indicated above these are invented words without either clear conceptual meaning or evocative effect. **Taking into account all of the above I find that overall the respective trade marks are similar to a reasonably high degree.**

Likelihood of conclusion

20) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa¹⁷. In this case certain of the goods are identical, the remainder are similar to a significant degree. So this aspect of the global appreciation is in favour of Evonik. I have decided that the trade marks are similar to a reasonably high degree, so strengthening Evonik's case. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion¹⁸. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public¹⁹. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings²⁰. As I have stated above, the earlier trade mark is an invented word. Unlike the parties I do not consider that either type of average consumer will find meaning in it, there is certainly no clear meaning. I find that the earlier trade mark enjoys a good deal of inherent distinctiveness. As both trade marks are invented words there is no conceptual hook for the memory of the consumer, which would help him or her to distinguish between them.

21) There are two types of average consumers and there are two types of goods. Batteries can be cheap goods bought by the public at large, increasing the likelihood of a consumer being prey to imperfect recollection. **In relation to batteries I find that there is a likelihood of confusion.**

¹⁷ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

¹⁸ *Sabel BV v Puma AG* [1998] RPC 199.

¹⁹ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

²⁰ *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

22) The other goods of the application are specialist goods which be bought by specialists with a good deal of care and attention. In *SHS Polar Sistemas Informáticos SL v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-79/07 the CFI stated:

“50 In the present case, the Board of Appeal observed, in paragraph 22 of the contested decision, that the goods at issue were extremely specialised, expensive and often developed over many years in collaboration with the end consumer. The consumers concerned, the staff of financial institutions responsible for the acquisition of such goods, will carry out a scrupulous examination of the products on the market and very probably contact the manufacturers. In the course of that selection process, those consumers will be aware not only of the characteristics of the goods, but also of the identity of the manufacturers and the marks on the market and will therefore be very attentive to even slight differences between those marks.”

I also bear in mind the findings of the CFI in *Apple Computer, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-328/05:

“58 As has been shown above, the relevant public, even if it is a specialist public, is aware of the goods’ essential characteristic, which pertains to their nature and their method of use, and considers them to be part of the same category of goods. The fact that the goods have different spheres of application is not sufficient for the relevant public to conclude, rightly or wrongly, that those differences prevent one undertaking from making or selling both types of goods at the same time. Therefore, the relevant public will naturally have the impression that the goods concerned may have the same commercial origin (see, to that effect, Case T-85/02 *Díaz v OHIM – Granjas Castelló (CASTILLO)* [2003] ECR II-4835, paragraph 33).

59 Accordingly, the fact that the relevant public is composed of persons whose level of attention may be considered high is not sufficient, given the fact that the signs at issue are almost identical and the similarity between the goods in question, to exclude the possibility that that public might believe that the goods and services concerned come from the same undertaking or, as the case may be, from economically-linked undertakings (GALZIN, paragraph 48 above, paragraph 80).”

In the above case the respective trade marks “were almost identical”, which is not the case here. There is matter which distinguishes between the two trade marks. There was also “cross-fertilization” between domestic and commercial use by relevant consumers, again something that does not occur here. For the “specialist” goods the primary means of consideration and purchase will be visual. In *New Look Ltd v Office for the Harmonization in the Internal Market*

(*Trade Marks and Designs*) Joined cases T-117/03 to T-119/03 and T-171/03 the CFI stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

I consider that owing to the nature of the purchasing process and the nature of the average consumer, the visual differences between the trade marks and the nature of the goods will counter the similarity between the trade marks, the identity or high degree of similarity of the goods and the inherent distinctiveness of the earlier trade mark and militate against confusion, including the possibility that the consumer would consider that the goods came from the same or an economically linked undertaking. These are goods that will be bought with the utmost care and consideration.

Outcome

23) The application is to be refused in respect of batteries but may proceed to registration for all other goods.

Costs

24) LG, for the most party having been successful, is entitled to a contribution towards its costs. The evidence of LG had no bearing upon the case and so I have made no award in respect of it. I have, however, made an award in respect of the arguments in support of the application, which were filed with the evidence. I award costs on the following basis:

Preparing a counter statement and considering the statement of Evonik:	£300
Arguments in support of the application:	£200
TOTAL	£500

I order Evonik Degussa GmbH to pay LG Chem, Ltd the sum of £500. 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 4th day of September 2009

**David Landau
For the Registrar
the Comptroller-General**