

O-365-15

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NO. 3043975
BY SOLAR INSTALL (UK) LTD
TO REGISTER THE TRADE MARK**



IN CLASS 11

AND

**THE OPPOSITION THERETO UNDER NO. 402742
BY ZEHNDER GROUP PARTICIPATIONS**

Background and pleadings

1. Solar Install (UK) Ltd (“the applicant”) applied for the trade mark shown below on 25 February 2014 for ‘electric radiant heating apparatus’, in Class 11.
2. The application was published on 23 May 2014. It was subsequently opposed by Zehnder Group Participations (“the opponent”) on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon all the goods of its earlier international registration which was protected in the UK on 28 January 2010 (the request for protection was made on 1 July 2009), as follows:

IRED

Class 9: Programming devices for heating apparatus.

Class 11: Heating apparatus and installations; electric radiators; radiators fired by solid, liquid or gaseous fuels; central heating radiators; taps for pipes for heating apparatus and installations.

3. The opponent claims that there is a likelihood of confusion under section 5(2)(b) of the Act because the marks are similar and the goods identical.
4. The applicant denies the grounds on the basis that the marks are not similar. It also requested that the opponent prove that it has made genuine use of its mark. There is no statutory requirement that the opponent prove it has made genuine use of its mark because it had not been protected in the UK for five years or more on the date of publication of the opposed application (section 6A of the Act refers).
5. The opponent is professionally represented, whilst the applicant represents itself. The opponent filed submissions and evidence and the applicant filed submissions. The parties were asked if they wished to be heard or for a decision to be made from the papers. Neither chose to be heard. The opponent filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by both parties.

Opponent’s evidence

6. This comes from Elaine Deyes, who is a trade mark attorney at Dehns, the opponent’s professional representatives in these proceedings. This consists of two exhibits which show the identity of the applicant and how the applicant is using its mark, and a third exhibit which is a list of 700 trade mark decisions by the Registrar, the Appointed Persons, the Intellectual Property Enterprise Court and the High Court, in which trade marks were held to be similar. It is unnecessary for the purposes of this decision to summarise the evidence.

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

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

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

The principles

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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 and services

9. The applicant has not denied the opponent's claim that the parties' goods are identical. The comparison between the parties' goods must be made between the goods as registered in the earlier mark and as applied for by the applicant, not on the basis of what goods are actually sold under the mark at the present time. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-33/05, the General Court ("GC") stated that:

"29. In addition, 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".

10. Consequently, the applicant's goods, electric radiant heating apparatus, are wholly encompassed by the opponent's 'heating apparatus and installations'. They are, therefore, identical.

Average consumer

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

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

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

13. The goods of both parties could be bought by the general public, but also by businesses. For the most part, heating apparatus is relatively expensive and will be bought infrequently, which means that it is likely to be purchased with an above average degree of care and attention to detail to ensure e.g. compatibility, value for money, durability and functionality etc. The perception of the marks during the selection process will be primarily visual, on the basis of e.g. advertisements, company literature and websites, but I do not ignore the possibility of oral use of the marks during the purchasing process, such as in technical discussions.

Comparison of marks

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

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

It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

15. The respective marks are:

Opponent	Applicant
	

16. The opponent's mark consists of a single invented word, so this comprises its dominant and distinctive element and gives the mark its overall impression. The applicant's mark is more complex. The applicant submits that the i is the dominant element of its mark, and I agree: the letter i is the most prominent element because of its size and position, relative to the other components of the mark. Despite the size of the globe, the eye is drawn to the central white letter components, i.red. Although the globe will not be ignored, it is i.red which dominates the overall impression of the applicant's mark.

17. The marks are visually moderately similar because they both include the letters IRED/i.red. I put it no higher than moderately similar because of the visual differences created by the prominent, curved i against the globe, which looks like a shiny ball. The marks are aurally identical. They will both be pronounced I-RED; particularly the applicant's mark, with the full-stop giving a degree of separation so that the i will be pronounced as the letter's name, rather than a short I (as in 'intent'). The applicant submits that the opponent's mark will be said as 'ered'; I think this unlikely.

18. The applicant submits that the concept of its mark is an infrared heater. There is no evidence that i.red, or ired, are shortened forms of infrared, nor is there any evidence that the average consumer would attach that meaning to the letters. The opponent's mark is an invented word with no concept. The applicant's mark is also invented, but additionally brings to mind the idea of 'red' because this component is smaller than the 'i', which, along with the full-stop gives it a degree of separation from the letter i. The concept of red is reinforced by the red globe or sphere (it is difficult to make out the continents), although the mark is not limited to the colour red, so could be used in any colour. (This also goes for the opponent's mark, which could be used in any colour, including red.)

Distinctive character of the earlier marks

19. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹ the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

20. The opponent has not filed any evidence that it is using its mark, so I only have to consider the position of distinctiveness from the inherent point of view. The mark is an invented word, with no meaning. Such words, as trade marks, are normally considered to be highly distinctive because they do not describe the goods or services offered and are memorable. The opponent’s mark falls into this category: it is highly distinctive.

Likelihood of confusion

21. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the parties’ goods are identical. I have also found that the opponent’s mark is highly distinctive. The applicant points out that the earlier mark is registered in block capitals, which is different to its own mark. Registering a trade mark in block capitals entitles the owner of the registration to use it in lower case as

¹ Case C-342/97.

well as capitals. Normal and fair use of the opponent's mark includes use as ired. This brings it close to the applicant's mark, i.red. The marks are aurally identical, although there are visual differences and a measure of conceptual difference. However, notwithstanding the differences, I consider that there is a likelihood of confusion within the meaning of section 5(2)(b) of the Act. This is because, although the average consumer is unlikely, directly, to mistake one mark for the other (after all, an above average degree of attention will be paid to the purchase) the similarities between the marks, for identical goods, will cause the average consumer to perceive the marks as emanating from commercially linked entities, or the same company, as being different versions of the mark. For example, devices of globes are commonly used to convey the idea of international trade, so the later mark could be perceived as conveying the global, or international, side of the IRED/ired brand. This type of confusion is sometimes called indirect confusion, which was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in case *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

22. The applicant submits that its company name, registered at Companies House, is I.Red Heating Ltd and that it fails to see why it can't use its company name as a mark. This is a common misconception, but trade mark and company name registration are two very different areas of law, as stated in the guidance on the websites of both Companies House and the Intellectual Property Office. Companies House guidance is that registrants should check to see if the chosen name may infringe a trade mark and that registering a company or partnership name or using a business name doesn't mean it's protected as a trade mark. IPO guidance includes that the company name may not qualify as a trade mark because it may already be registered in someone else's name.

23. The opposition succeeds under section 5(2)(b) of the Act.

Costs

24. The opponent has been successful and is entitled to a contribution (not compensation) towards its costs, in line with the scale of costs published in Tribunal Practice Notice 4/2007. There is no award for the evidence because it did not advance the opponent's case and put the unrepresented applicant to the cost of time spent reviewing the list of 700 trade mark decisions (it is clear from the applicant's submissions that it did review, at least, the list). The point of filing this evidence appears to be to show the unrepresented applicant the legal point that adding matter to an identical verbal element may not avoid a likelihood of confusion. This could have been shown more efficiently and economically, for example, by citing established jurisprudence, illustrated if necessary by one or two apposite decisions. Expecting an unrepresented applicant to review 700 decisions, or even to attempt to review some of them, is burdensome and disproportionate to what was necessary to decide the case, having regard to the issues. In addition to making no award for the evidence, I will reduce the costs awarded to the opponent by the rate of £20 per hour for a nominal 5-hour period spent reviewing its unnecessary evidence. The breakdown of costs is as follows:

Opposition fee	£100
Preparing a statement and considering the counterstatement	£200
Filing written submissions	£400
Less £100	-£100
Total	£600

25. I order Solar Install (UK) Ltd to pay Zehnder Group Participations the sum of £600 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 4th day of August 2015

**Judi Pike
For the Registrar,
the Comptroller-General**