

O-154-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION Nos. 2313915A  
AND 2313915B BY APPLIED ENERGY PRODUCTS LIMITED  
TO REGISTER TRADE MARKS IN CLASS 11**

**AND**

**IN THE MATTER OF OPPOSITIONS THERETO UNDER  
Nos. 92306 and 92307  
BY HANS GROHE AG**

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**IN THE MATTER OF Oppositions thereto under  
Nos. 92306 and 92307  
by Hansgrohe AG**

**BACKGROUND**

1. On 23 October 2002 Applied Energy Products Limited (hereafter AEP) applied to register the following marks:

ACTIVE (No. 2313915A)

 ACTIVE (No. 2313915B)

In each case AEP specified the following goods in Class 11:

“Showers; electric showers; electric instantaneous and pumped electric showers; power showers; mixer showers; instant showers; parts and fittings for all the aforesaid goods.”

2. On 13 February 2004 Hansgrohe AG (hereafter Hansgrohe) filed notice of opposition to these applications. Hansgrohe is the proprietor of UK trade mark registration No. 1557326, AKTIVA which has a filing date of 23 December 1993 and an international priority date of 15 July 1993 (and is, therefore, an earlier trade mark). It is registered in respect of:

“Apparatus for the supply of water; sanitary installations; mixing valves; manually and automatically operated regulating apparatus for the supply and draining of water; mixer-taps for wash-stands, bidets, washing tables, baths and for showers; shower cubicles; hand showers, shower heads, body showers and parts and fittings for showers; sanitary hoses, nozzles, shower holders; supply and discharge fittings, all for sanitary basins, wash-stands, washing-tables, bidets, bath tubs and for shower basins; siphons, supply and discharge pipes; lighting apparatus for use as sanitary fittings; parts and fittings for all the aforesaid goods; all included in Class 11.”

3. The opponent claims that the marks are “virtually identical” and that the specifications cover identical or similar goods such that there exists a likelihood of confusion. Refusal is sought under Section 5(2)(b) of the Act.
4. AEP filed a counterstatement denying the sole ground of opposition and offering a number of submissions on the respective marks.
5. Both sides ask for an award of costs in their favour.
6. Neither side has asked to be heard. Written submissions have been received from W. P. Thompson & Co on behalf of the opponent.

## **EVIDENCE**

7. Both sides have filed evidence. Hansgrohe’s professional representative in this matter has filed details of the registration relied on. AEP’s professional representatives has filed dictionary extracts intended to show that words beginning with AK are visually unusual whereas words beginning with AC are not and also to show that –ive is a recognised adjectival suffix whereas –iva is not.

## **DECISION**

8. It will be apparent from the above that the issues in these two actions are substantially the same, and this is reflected in the grounds and evidence. The exception to the generality of this point is the stylisation of the presentation of the mark in the case of No. 2313915B. I will deal with this by way of separate comment below but, in other respects, I regard the two cases as being susceptible to a single decision albeit that they have not been formally consolidated. The parties retain their right to appeal against the outcome of either or both of the cases as they see fit.

9. The sole ground of opposition is under Section 5(2)(b). The relevant part of the statute reads:

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

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

10. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

11. In essence, the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of identity/similarity in the goods and how they are marketed. I must compare the marks in issue having regard to the distinctive character of each and assuming normal and fair use of the marks across the full range of the goods within their respective specifications.

12. The specifications of the applied for marks commence with the general term showers and go on to itemise various specific types of showers. Hansgrohe's earlier trade mark contains both the broad terms "apparatus for the supply of water; sanitary installations" and a number of more specific terms that clearly overlap with the AEP's goods, most notably "hand showers, shower heads, body showers". Both parties' specifications also cover parts and fittings for such goods. I conclude that the specifications encompass identical and/or closely similar goods.

13. The average consumer for these sorts of goods is likely to be or include the general public. Builders and tradesmen in the field may also be involved in selecting and installing such goods. The latter groups are likely to be more knowledgeable and experienced about the range of products available and the associated brand names. For ordinary members of the public the purchase of showers and parts and fittings is likely to be an occasional rather than a regular process.

14. The earlier trade mark relied upon by Hansgrohe is the word AKTIVA. The distinctive character of the mark is a factor to be taken into account (*Sabel v Puma*, paragraph 23). As the applicant has pointed out the case details for the mark indicate that it consists of a German word meaning "financial assets". That point may be apparent to German speakers but not, I would think, to the majority of people in this country who either do not speak German or whose command of the language does not extend to a word that may not be met or required on an everyday basis. Nevertheless, it is reasonable to suppose that there may not be uniform recognition of, or reaction to, the mark. For one group it may be recognised as a foreign language word, for the other it is more likely to be seen as a purely invented word. In neither case does the word have any apparent significance in relation to the goods at issue. I regard it as having a high degree of distinctive character. As no evidence of use has been provided no issue arises as to whether there has been any further enhancement of that distinctive character in the circumstances contemplated in *Sabel v Puma* at paragraph 24.

15. Turning to the applied for marks, in the case of No. 2313915A it is the word ACTIVE (in plain block capitals) which appears to be distinctive in relation to the goods. In the case of 2313915B the mark would, in my view, be clearly seen and referred to as ACTIVE but I must not lose sight of the presentational aspects of the mark in terms of the slightly less usual font and, more importantly, the extended curve of the letter C which gives the mark a certain visual flourish. It has been suggested (paragraph 5 of the written submissions) that this latter feature serves to make this mark even more similar to Hansgrohe's mark because the stylised C might be interpreted as a K. I find this improbable. Overall, it seems to me that the degree of stylisation is not particularly remarkable and is unlikely to make or break either side's chance of success. If the mark ACTIVE is found to conflict with AKTIVA then the degree of stylisation present in the second mark is unlikely to save it. By the same token if the

opponent does not succeed against the mark ACTIVE it is unlikely to fare any better against the stylised version of that word.

16. I go on to consider the visual, aural and conceptual similarities of the marks. Both marks contain six letters with four of them in common and in the same positions. The differences lie in the second and last letters. The applicant has reminded me that small differences can be telling in relatively short words. In this case the difference it makes is between a common dictionary word (ACTIVE) and what for most people will be a meaningless/invented word. I accept too that words commencing with AK- and/or ending in -VA are relatively uncommon. These are not insignificant visual differences in the context of the marks as wholes.

17. Nevertheless, the opponent's written submissions suggest that the level of spelling accuracy is so low that the letters K and C are used interchangeably. I think it unlikely that a common word such as ACTIVE would be misspelt as AKTIVA, or that circumstances are likely to arise where transcription problems of this order will occur.

18. Aurally, the marks are somewhat closer as the (hard) C and K sounds will be indistinguishable in speech. The final letter of ACTIVE is not articulated. The final letter of AKTIVA will be and turns it into a three syllable as opposed to a two syllable word. It has been said in the past that the beginnings of words tend to be the most important and that there is a tendency to slur the termination of words (see *TRIPCASTROID* 42 RPC 264 at page 279). Each case must, however, be considered on its merits. I see no reason why the final A of AKTIVA would be dropped or slurred.

19. There is one other point to mention. The stress on ACTIVE is on the first syllable. Because AKTIVA will be seen either as a German word or, more likely, an invented word it is less certain where the average consumer would place the stress. In dealing with this decision I have found myself placing the stress on the second syllable and giving it a long vowel sound as in Geneva. I cannot, of course, say for certain whether my own approach to the word is likely to be typical of consumers at large. In short there is rather greater aural than visual similarity but due allowance must be made for the effect of the final A of AKTIVA and its effect on stress and the pronunciation of the I.

20. Conceptually, the balance swings in the applicant's favour because ACTIVE is a well known dictionary word and AKTIVA is not (or, to the extent that it is a German word it appears to have a completely different meaning to the English word 'active').

21. The importance of conceptual dissimilarity was considered by the Court of First Instance in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made.

That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning – to counteract to a large extent the visual and aural similarities between the two marks.”

22. Likelihood of confusion is a matter of global appreciation taking all relevant factors into account (*Sabel v Puma*, paragraph 22). A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods (*Canon v MGM*, paragraph 17). The goods in question here are either identical or closely similar. I also consider that, because the goods will for most people be occasional purchases only, the opponent is right to say that particular allowance must be made for the effects of imperfect recollection. That said, the purchase of a shower is a significant item of expenditure and care is likely to be taken in the selection process. I would expect visual considerations to play a key part either by inspection of the actual goods or by viewing them in a catalogue. That much is confirmed by the opponent in paragraphs 8 and 9 respectively of the (separate) sets of submissions. Those submissions go on to say that “[T]he trade mark will be used to identify the particular model wanted by the consumer, so there is a high level of potential for inaccurate transcribing of the trade marks or mis-remembering of the trade marks”. I do not understand why the use of marks in the course of trade on packaging or on display material should result in inaccurate transcription or why the averagely attentive etc consumer should mis-remember marks to the point where an invented word and a common dictionary word are confused.

23. In my view the visual and conceptual differences between the marks outweigh and have greater impact than the points of similarity (including aural similarity).

24. I have, nevertheless, hesitated about the outcome for two reasons. Firstly, both parties specifications cover parts and fittings. Such items (or at least replacement ones) are more likely to be requested orally to match whatever make of shower is installed. That brings aural considerations rather more into play. The second point is that I am unwilling to rule out the possibility that some consumers may make an association between the marks thinking perhaps that AKTIVA is a foreign language version of ACTIVE or vice versa.

25. So far as the first point is concerned it seems to me that if a replacement part is to be ordered then a fair amount of information is likely to be required. It will almost certainly not be enough to identify the shower by brand. There are many different types of showers (as to which see the respective specifications). It would, therefore, be necessary to specify brand, type, model and part. Thus the nature of the enquiry/ordering process is likely to make confusion highly unlikely.

26. As to the second point, it is well established that mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2) (*Sabel v Puma*, paragraph 26). However, if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the Section (*Canon v MGM*, paragraph 29). The question is, therefore, what the nature of any association would be in this case.

27. There is no evidence one way or the other on likely consumer reaction to the marks. I bear in mind that the average consumer, in addition to having the qualities set out in the *Lloyd Schuhfabrik* case (see paragraph 27 of that judgement), is said not to analyse marks. Whether and to what extent consumers will make any association between the marks in issue here is not clear. It would be speculation on my part to suggest that some consumers, having spotted certain similarities, would go a step further and assume that goods offered under the mark ACTIVE (or the stylised version thereof) emanated from the same trade source as AKTIVA goods or a related undertaking of the proprietor of the AKTIVA mark. I cannot go as far as ruling out the possibility that this might happen but on the material before me I am unable to say that there is a likelihood of confusion by association. The test is in terms of likelihood not possibilities. The opposition fails under Section 5(2)(b).

## **COSTS**

28. The applicant is entitled to an award of costs. My attention has been drawn to exchanges of correspondence (commencing with a letter from Marks & Clerk dated 31 March 2004) between the parties and the Registry arising from certain deficiencies that the applicant claimed existed in the opponent's statement of case. It appears to have arisen because the opponent's attorneys had made a number of errors in referring to the marks though I note that WP Thompson's letter of 6 April 2004 dealing with the point claims it was a typographical error. The matter was dealt with expeditiously and bearing in mind issues of proportionality should not have involved the applicant in unnecessary costs. I do not propose to penalise the opponent for the lapse. In recognition of the applicant's success in the actions I order the opponent to pay the applicant the sum of £700. This is a combined award covering the two actions and recognises that the grounds and evidence are in substance the same. 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 10<sup>th</sup> day of June 2005**

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