

O-416-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2585447
BY DUNCRYNE LTD
TO REGISTER econic & ECONIC
AS A SERIES OF 2 TRADE MARKS**

IN CLASSES 17, 19, 20 & 37

AND:

**OPPOSITION THERETO UNDER NO. 102696
BY EVONIK INDUSTRIES AG**

BACKGROUND

1. On 21 June 2011, Duncryne Ltd (“DL”) applied to register the trade marks shown on the cover page of this decision. The application was accepted and published for opposition purposes on 26 August 2011 for the following goods and services:

Class 17: Materials, compositions, mastics and resins; all for sealing, gap filling or insulating; sealants, sealing strips, fire-retardant seals and fire retardant sealing strips; adhesives; insulating adhesives.

Class 19: Buildings materials; tiles; building panels, boards and tiles; fire retardant building boards, panels and tiles; materials, compositions, mastics and resins; all for sealing, gap filling, joint filling or insulating, fire retardant sealants, fire retardant strips, fire seals and fire sealing strips; all being building materials.

Class 20: Furniture, mirrors, picture frames.

Class 37: Building construction; repair and maintenance of buildings; information, advisory and consultancy services of all of the aforesaid services.

2. On 24 November 2011, Evonik Industries AG (“EI”) filed a notice of opposition directed at all of the goods and services in DL’s application. However, in its written submissions dated 21 September 2012, EI withdrew its opposition in relation to the goods in class 20. In these proceedings EI relies upon a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). EI relies upon the following trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods and services relied upon
EVONIK	E918426	2.10.2006	NA	<p>17 - Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.</p> <p>19 - Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; scaffolding, not of metal; tiles and paving slabs, not of metal; artificial stones; coatings (building materials); non-metallic pipework; caverns or containers of concrete.</p> <p>37 - Building construction; installation services other than for hoisting, pumps and pumping/conveying; plant construction in the fields of cleanroom, air-conditioning, energy, heat and/or environment technology; demolition; damp-proofing; roofing; insulating work; electric installation; facade cleaning; fireplace construction; tile laying; floor laying; dehumidification of buildings; scaffolding;</p>

				glazing; structural and civil engineering; plastering and tiling; road building, tunnelling; water engineering; industrial building; installation and fitting of lighting equipment, lightning protectors, earthing installations, radio and communications devices, heating, ventilating and air-conditioning installations, refrigerating apparatus, machine installations, sanitary installations; insulation; plumbing and gas and water installation; painting, lacquering and wallpapering; parquet floor laying; pipeline laying; cleaning of buildings, chimneys, drains, motor vehicles and textiles; repairs to buildings; repair or maintenance of electrical engineering goods, mechanical engineering goods, chemical installations, thermo technical installations, burners, precision engineering goods, healthcare apparatus, heating, air-conditioning, cooling and ventilating apparatus, motor vehicles, aircraft, ships, mechanical apparatus and devices for medical and orthopaedic purposes, photographic, projection and cinematographic apparatus, data technology systems, irrigation devices, power supply systems and gas supply systems, clothing, bicycles, rubber goods, upholstery, shoes and clocks; ship building; chimney construction; blasting; stucco, plastering and rough casting; laying of land and sea cables; rental of machinery, tools and equipment for building; destroying vermin and weed killing (except for agricultural purposes); washing of laundry; carpentry and timber engineering and construction of wooden buildings; building and construction consultancy.
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3. While both parties filed evidence i.e. the witness statements of Mr Peter Charlton dated 5 April 2012 (for EI) and Mr Ken Forrest dated 1 June 2012 (for DL), as neither of these statements relate to the substantive issues in these proceedings there is no need for me to record their contents here. While neither of the parties asked to be heard, both filed submissions in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

DECISION

4. Section 5(2)(b) of the Act reads as follows:

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

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

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

5. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

6. In these proceedings, EI is relying upon the trade mark shown in paragraph 2 above, which has an application date prior to that of the application for registration. However, as this trade mark is still pending it does not qualify as an earlier trade mark at this stage. Consequently, if I find for EI my decision will be provisional pending the registration of EI’s application.

Section 5(2)(b) – case law

7. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing process

8. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services and then to determine the

manner in which these goods and services will be selected by the average consumer in the course of trade. In its submissions EI said:

“4.3 The goods and services in classes 17, 19 and 37 include ordinary consumer products and services offered to the public, as well as specialised products and services. It is clear that the relevant public includes the general public and so a low to normal level of attentiveness to the marks should be assumed.”

9. In its submissions DL said:

“21...However, we contend that the goods and services of the respective parties are highly specialised and are not “fast moving” consumer goods and as such, the average well-informed, reasonably circumspect consumer of the goods and services of the respective parties will be highly technical and pay greater attention to the goods and services being purchased...”

10. The goods and services at issue in these proceedings are, broadly speaking, building products and building construction and building repair and maintenance services. These are goods and services which will be selected by both members of the general public and by professionals such as building contractors, architects and engineers.

11. As to the manner in which the average consumer of the goods and services will encounter the parties' trade marks, in the absence of any evidence to assist me, I consider this is most likely to be in traditional retail settings such as builder's merchants, home improvement stores, supermarkets etc., on the pages of websites and in, inter alia, advertisements, articles and product literature. As to the manner in which the goods and services are likely to be selected, my own experience tells me that this is most likely to consist of a visual act having encountered the trade marks in the settings indicated above. However, as many of the goods and services at issue may engage technical considerations which need to be confirmed before they are purchased, aural considerations (where the average consumer seeks guidance) will also come into play. As to the degree of care and attention the average consumer will display when selecting the goods and services at issue, this is likely to vary depending on the cost, size and complexity of the goods being selected or the service being sought and the importance of ensuring that the goods and services meet appropriate standards. Overall, I think that a member of the general public will, given that they are unlikely to be selecting the goods and services on a regular basis, pay at least a reasonable level of attention when selecting even relatively inexpensive goods and services of the sort at issue in these proceedings and that this level of attention will increase as the cost and complexity of the goods and services increases. As to the professional users I have identified above, although they are likely to be much more familiar with the goods and services at issue, as they may, for example, be purchasing goods on a commercial scale for use in a range of different projects and environments and for a range of different clients, I think that they are likely to pay a relatively high degree of attention to their selection.

Comparison of goods and services

12. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC said:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

13. In its submissions DL said:

“20. We contend that [DL’s goods in class 17] may be regarded to be similar to some of the goods [in EI’s application in class 17] but we contend that they are not identical.

21. We admit that there is some identity between [DL’s goods and services in classes 19 and 37] and the goods and services covered by [EI’s trade mark]...”

Class 17

14. DL’s goods in class 17 are as follows:

Materials, compositions, mastics and resins; all for sealing, gap filling or insulating; sealants, sealing strips, fire-retardant seals and fire retardant sealing strips; adhesives; insulating adhesives.

15. In its submissions reproduced above, DL admits that its goods in class 17 should be regarded as similar to some (unidentified) goods in EI’s application in class 17. In its submissions EI says:

“Regarding class 17, it appears that the goods of the later mark are all covered by the general term “packing, stopping and insulating materials” of the earlier mark. Although the latter mark recites “adhesives”, “adhesives at large are not in class 17 and so we believe this term must be interpreted to mean “insulating adhesives” which are clearly identical goods...”

16. Having considered the parties’ submissions, and bearing in mind the court’s views in *Gérard Meric*, I am inclined to agree with EI that all of DL’s goods in class 17 would be encompassed by the phrase EI has identified above. However, even if the goods are

not identical (keeping in mind DL's concession above), they are, in my view, similar to a high degree.

Class 19

17. DL's goods in class 19 are as follows:

Buildings materials; tiles; building panels, boards and tiles; fire retardant building boards, panels and tiles; materials, compositions, mastics and resins; all for sealing, gap filling, joint filling or insulating, fire retardant sealants, fire retardant strips, fire seals and fire sealing strips; all being building materials.

18. As EI's application in class 19 includes the phrase "Building materials (non-metallic)" the competing goods are identical.

Class 37

19. DL's services in class 37 are as follows:

Building construction; repair and maintenance of buildings; information, advisory and consultancy services of all of the aforesaid services.

20. As EI's application in class 37 includes the phrases "Building construction", "repairs to buildings" and "building and construction consultancy", the competing services are identical.

Comparison of trade marks

21. The trade marks to be compared are as follows:

DL's trade marks	EI's trade mark
Econic/ECONIC	EVONIK

22. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

23. As both parties trade marks consist of plain words presented in either upper case (EI) or upper and lower case (DL's series of 2 trade marks) and as no part of either

parties' trade marks are highlighted or emphasised in any way, there are no dominant elements, the distinctiveness of each trade mark lies in its totality. In comparing the competing trade marks, I, like EI, see no distinction between DL's trade marks presented in either upper or lower case. While in their submissions the parties agree that as the competing trade marks consist of invented words they can be neither conceptually similar nor conceptually dissimilar, both parties provided detailed submissions on the degree of visual and aural similarity between the competing trade marks. While I do not intend to detail these submissions here, I will keep them in mind and refer to them if necessary below.

Visual similarity

24. Both trade marks consist of 6 letters. The first letter is the same as are the letters O-N-I- which appear in the same order as the third to fifth letters of the competing trade marks. The trade marks differ in as much as EI's trade mark has the letters V and K as the second and sixth letters, whereas DL's trade mark has the letters C in the same positions. In its submissions, EI characterised the degree of visual similarity between the competing trade marks as "medium to high". That, I think, is a realistic approach, although, in my view, the degree of visual similarity is more accurately pitched at the high end of the spectrum.

Aural similarity

25. EI says that the competing trade marks comprise three syllables i.e. "EH-VON-ICK" as opposed to "EH-KON-ICK" characterising the degree of aural similarity once again as medium to high. DL submits that the competing trade marks have two syllables (in my view they have three) and would be pronounced as EVE-ONIK and ECK-ONIC arguing that the differences in the first syllable renders the trade marks phonetically distinguishable in totality. Irrespective of which parties' approach I adopt, leads me to conclude that the degree of aural similarity between the competing trade marks is once again high rather than medium.

Distinctive character of EI's earlier trade mark

26. I must now assess the distinctive character of EI's trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which it has been applied for and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade 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 trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As DL accepts that EI's trade mark consists of an invented word, it is a trade mark possessed of the highest degree of inherent distinctive character.

Likelihood of confusion

27. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of EI's trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

28. I have concluded that the competing goods and services are either identical or highly similar, that the competing trade marks are visually and aurally highly similar and conceptually neutral and that EI's trade mark enjoys the highest degree of inherent distinctive character. In those circumstances, the likelihood of direct confusion (i.e. where one trade mark is mistaken for the other) is, in my view, inescapable irrespective of the degree of sophistication of the average consumer or the degree of care the average consumer may take when selecting the goods and services. EI's opposition (subject to my comments below) will succeed.

Conclusion and further action

29. Subject to successful registration of EI's trade mark in respect of relevant goods and services, its opposition will succeed in relation to DL's goods and services in classes 17, 19 and 37. Consequently, I cannot give a final decision in relation to these proceedings until EI's EVONIK trade mark is finally determined.

30. I direct that EI advise me within one month of the final determination of its EVONIK trade mark of the outcome of the application. On receipt of this information I will issue a supplementary decision giving a full determination of the opposition proceedings and making an award of costs.

Dated this 23rd day of October 2012

**C J BOWEN
For the Registrar
The Comptroller-General**