

O-159-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2606795  
BY KARTELL UK LIMITED  
TO REGISTER THE TRADE MARK**



**IN CLASS 11**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER No. 103314 BY  
KUNZE FOLIEN GMBH**

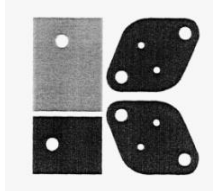
## BACKGROUND

1) On 12 January 2012 Kartell UK Ltd (hereinafter the applicant) applied to register the mark on the previous page in respect of the following goods in Class 11: Installations and apparatus, all for heating and drying; heating radiators; central heating radiators; heating installations; central heating installations and apparatus all for heating boilers; installations and apparatus for air conditioning; parts and fittings for all the aforesaid goods; all included in class 11.

2) The application was examined and accepted, and subsequently published for opposition purposes on 10 February 2012 in Trade Marks Journal No.6926.

3) On 11 May 2012, Kunze Folien GmbH (the opponent), filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the registered proprietor of the following trade marks:

Mark	Number	Date of filing and registration date	Class	Relevant Specification
	CTM 877944	15.07.1998 / 06.10.1999	11	Heating and cooling apparatus; electric and non-electric cooling apparatus, cool elements and heat sinks, Peltier elements, heat conducting and heat insulating component parts, in particular for use in electrotechnical, electric or electronic apparatus, instruments or components, data processing equipment and computers.
CRAYOTHERM	CTM 9206641	28.06.2010 / 03.02.2011	11	Apparatus and installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; electric and non-electric cooling apparatus, cool elements and heat sinks, Peltier elements, heat conducting and heat insulating component parts, in particular for use in electrotechnical, electric or electronic apparatus, instruments or components, data processing equipment and computers.

b) The opponent contends that it is an internationally recognised leading provider of customised heat management and thermal management solutions and has been since 1985. It contends that the goods applied for are similar to those for which its marks are registered. It also contends that the word “THERM” in the trade mark applied for will be perceived and/or recognised by the relevant consumer as a “non SI unit of heat energy given that the goods in question are

heating and/or cooling apparatus". Further, it claims that the distinctive element of the mark applied for is the letter "K" which is similar or identical to the opponent's mark CTM 877944 above, which combined with the goods being identical, creates a likelihood of confusion. It contends that the mark in suit offends against Section 5(2)(b).

c) The opponent also contends that the mark applied for is phonetically similar to its mark CTM 9206641 as the mark in suit will be pronounced "K-O Therm" identical or similar to the opponent's mark and for identical goods. It contends that the mark in suit offends against Section 5(2)(b).

4) On 17 July 2012, the applicant filed a counterstatement which accepted that the goods of the two parties were identical but basically denied the opponent's contentions. The applicant contended that the word "therm" would not be seen as a measurement of heat or energy but as a reference to the word "thermal". It does accept that as such the dominant element of its mark is the letter "K" and "dot".

5) Neither side filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 10 April 2013. At the hearing, the applicant was represented by Mr Onslow of Counsel instructed by Messrs Macrae & Co LLP; The opponent was represented by Mr Hall of Counsel instructed by Messrs i.p.21 Ltd.

## **DECISION**

6) The only ground of opposition is under Section 5(2)(b) of the Act which reads:

"5.-(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."

7) An "earlier trade mark" is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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."

8) The opponent is relying upon its trade marks shown in paragraph 3 above. The mark in suit was applied for on 12 January 2012 and so the opponent's marks are clearly earlier trade marks. Given the interplay between the dates of both sides' marks the issue of proof of use under Section 6A of the Act does not arise.

9) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *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 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; 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;

(e) 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

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

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

(i) 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;

(j) 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.

10) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. 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 different elements taking into account the degree of similarity in the goods, the category of goods in question, how they are marketed, who the relevant consumer is and the nature of the purchasing act. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods in their specifications.

### **The average consumer and the nature of the purchasing process**


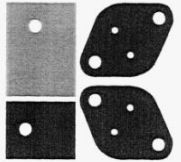
11) As the case law in paragraph 9 above indicates I must determine the average consumer for the goods of the parties. I must then determine the manner in which these goods are likely to be selected by the said average consumer. Both parties' goods broadly speaking consist of heating and cooling systems. These could vary from stand alone plug in units which would be purchased by an individual to complex industrial systems designed for offices or factories and installed by specialists. Therefore, the average purchaser would be the whole of society (general public, businesses & heating and cooling trades-people). They could therefore vary enormously in their intended purpose and price. Clearly, the amount of attention paid by the average consumer would vary considerably, but even at the cheaper end the average consumer will pay a reasonable amount of attention to the selection as it has to perform the intended function and may need to be integrated into an existing system. Selection would vary from being mainly visual for stand-alone units such as a fire/heater which are likely to be purchased via the internet or from a catalogue without expert advice to face to face meetings with experts in the case of complex installations.

**Comparison of goods**

12) The parties agree that the specifications of the mark in suit and those of the opponent are identical.

**Comparison of the trade marks**

13) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Trade Mark	Opponent's Trade Marks
	<p data-bbox="792 638 899 667">877944</p> 
	<p data-bbox="792 869 915 898">9206641</p> <p data-bbox="792 905 1019 934">CRAYOTHERM</p>

14) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes 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 elements.**

15) The opponent contended that the applicant had not contested its claim to have reputation in its marks. However, a simple claim such as the one made in the statement of grounds without any corroboration is not enough for the opponent to benefit from enhanced reputation. The applicant accepted in its counterstatement that the dominant element in its mark is the letter “K” and “dot”, although it pointed out that the word “THERM” would not be ignored by the average consumer but “it would play a lesser role in distinguishing the applicant’s mark than the “K dot” part of the mark”. This was based on the applicant’s acknowledgement that the word “therm” is at least partially descriptive of the goods in the case, whether by reference to a unit of energy or by its use as a suffix or root of words such as “thermal”, “thermometer” and “thermostat”. The opponent agrees with the initial point but believes that because of its descriptive nature the word “therm” will be ignored by the average consumer. The opponent also contends that the average consumer may take what the applicant refers to as a “dot” to be the letter “o”, and the mark could be referred to as “K-O-THERM”. To my mind, whilst the mark in suit

has an element (THERM) that is partially descriptive, I cannot ignore the totality of the marks and must compare them as wholes.

16) I shall first compare the mark in suit with the opponent's mark 877944

### **Visual comparison**

17) Although the letter "K" of the mark in suit is shown in red, there is no colour claim and so therefore I must consider the marks as they appear in black and white (SPEC SAVERS 2011 FSR1). The mark in suit clearly has the letter "K" and the word "THERM" in it. The fact that the background is black and the lettering is in red/ white respectively will not, in my opinion, be seen as particularly significant by the average consumer. The issue of how the average consumer will view the mark between the letter "K" and the word "THERM" has exercised both parties. The opponent contends that it will be seen as a dot in this comparison but as a letter "O" when compared to the opponent's other mark. I do not accept the contention that it will be seen as a letter "O" at all as its size and shape are inconsistent with the average consumer forming this impression. It is, in my view, far more likely to be seen as a "dot" or possibly even a hole drilled in the sign. The opponent's mark clearly consists of four engineering plates, complete with holes, which have been placed to form a heavily stylised letter "K". It is instructive to note that the applicant refers to the opponent's mark in these terms and never questions whether it will be seen as a letter "K". Clearly there are points of similarity in that both marks have a letter "K" in them. The applicant contended that the letter "K" emerges from the sign because of the juxtapositioning of the plates. The applicant further contended that a single letter is not in and of itself distinctive. Whilst I accept that the plates are cleverly positioned there is no doubt that the mark would be perceived as a letter "K", albeit a stylised version. As the opponent's mark is registered it must be considered to be distinctive. The letter "K" is the first element of the mark in suit and the only element in the opponent's mark, albeit very stylised and created by a device element. Equally clearly there are differences in that the mark in suit also has a "dot" and the word "THERM" in it. Given the descriptive nature of the word "THERM" which is accepted by the applicant, I believe that the visual similarities outweigh the differences.

### **Aural comparison**

18) To my mind the mark in suit is most likely to be referred to as "K-Therm". I do not believe that the average consumer will verbalise the "dot" element and it will certainly not be referred to as "K-O-Therm". Again there are similarities and differences.

### **Conceptual comparison**

19) The applicant accepts that the "THERM" element of its mark is partially descriptive, and, given that the goods are concerned with heating and/or cooling, it will simply serve to emphasise the nature of the goods. The main conceptual image is therefore the letter "K" which, as far as I am aware has no meaning for such goods.

20) When comparing the marks overall I take into account Case T-6/01 *Matratzen Concord GmbH v OHIM* where the GC stated:

“A complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.”

21) The applicant contends:

“9. The issue therefore is what is the significance to the consumer of the fact that the letter "K" appears prominently in both marks.

10. It is difficult to think of any trademarks in which the distinguishing function is performed by a single letter. It is possible to think of marks in which that function is performed, or partially performed, by pairs of letters by reason of overwhelming use: AA, EE, GE etc. There are of course examples of well known 2 letter acronyms which have acquired distinct secondary meanings, albeit not trademark meaning, such as EU, US. It is possible to think of marks where a single letter forms a prominent part of a composite mark e.g. "SPECIAL K" for cereals, by reason of overwhelming use.

11. Where, as here, a single letter features prominently in the mark, its primary "meaning" to the average consumer, is as a reference to the initial letter of the company name. Thus both the Opponent's and the Applicant's decision to feature the letter "K" prominently in their respective marks fits in with the average user's expectations; if the letter to which prominence is given were not the initial letter of the company name, the consumer might think the choice of letter to be presented and embellished in the device mark to be somewhat eccentric – and perhaps explicable on other grounds of which he or she is unaware.

12. It follows that the use of the letter "K" prominently in both the Opponent's and Applicant's marks accords with the average consumer's expectations that he or she is seeing, in each case, a different embellishment of the first letter of the company name i.e. is indeed seeing the primary "meaning" of the letter "K" when raised to prominence within a device mark. The consumer's eye inevitably turns to examine the detail of the embellishments in the mark, in addition to the letter.

13. For these reasons, the average consumer would not disregard the manner in which the "K" is stylised in each case, and would be bound to take into account the different graphical representations of each - he or she would be bound to take into



account the very distinctive form of 877944 as formed from engineering parts in the one case, and, the juxtaposition of the K with a prominent "dot" and subsequent THERM suffix in the other."

22) I do not accept the contention that the average consumer will view the letter "K" in both marks as a reference to the name of the company name as, broadly speaking, most consumers will be oblivious to the company name, partly because they can and do frequently change, but also as they often do not feature prominently but can only be found in the small print. The main feature that the average consumer looks for is the brand that he is aware of, either having purchased it before or via advertising or recommendation. I accept that the average consumer will not fixate on the dominant feature to the exclusion of all else. They will perceive the marks as wholes, although they rarely have the opportunity of a side by side comparison, and I have to take into account the issue of imperfect recollection. Overall I believe that the similarities in the marks outweigh the differences.

#### LIKELIHOOD OF CONFUSION

23) When determining whether there is a likelihood of confusion I have to take a number of factors into consideration. There 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 services and vice versa. I must consider whether the opponent's trade mark has a distinctive nature, the average consumer for the goods, the nature of the purchasing process and the issue of imperfect recollection. I must also take into account that these goods may be chosen with only a modicum of care. In the instant case the opponent's mark has a degree of inherent distinctiveness. It has not shown that its mark has any enhanced distinctiveness. The similarities between the trade marks are such that when used on identical goods there is a likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) succeeds.

24) This finding negates the need for me to compare the mark in suit with the opponent's other mark (CTM 9206641) although had I carried out such a comparison I would have undoubtedly found that the marks are so dissimilar that there is no likelihood of confusion or association despite the marks being used on identical goods.

#### CONCLUSION

25) The opposition has succeeded.

#### COSTS

26) The opponent has been successful and it is therefore entitled to a contribution towards its costs. I have taken into account that no evidence was filed in this case and that the applicant accepted in its counterstatement that the goods were identical. Therefore the issues discussed at the hearing were solely in relation to the marks.

Preparing a statement and considering the other side's statement	£300
Preparing for and attending a hearing	£300
TOTAL	£600

27) I order Kartell UK Limited to pay Kunze Folien GmbH the sum of £600. This sum 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 17th day of April 2013**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**