

O-086-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2590270  
IN THE NAME OF INTACO LIMITED

AND

OPPOSITION THERETO UNDER NO 102933  
BY ALTECNIC LIMITED

## Background

1. Application no 2590270 has a filing date of 4 August 2011, stands in the name of Intaco Limited (“the applicant”) and seeks registration of the trade mark INTASOL in respect of the following goods:

### Class 11

Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components; heating components; valves, thermostatic mixing valves; radiator valves; shower valves; taps; mixer taps; chilled water installations and apparatus; central heating installations and apparatus; pressurisation units for maintaining the pressure within water systems; solar collectors; solar heating panels; solar powered heating apparatus and installations; parts and fittings for all the aforesaid goods.

2. Following publication of the application in the *Trade Marks Journal* on 4 November 2011, notice of opposition was filed by Altecnic Limited (“the opponent”). The opposition is founded on grounds under sections 5(2)(a) and (b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. In respect of the objections under sections 5(2) and (3) of the Act, the opponent relies on the following registration insofar as it is registered for the following goods:

Mark	Dates	Specification of goods relied upon
2270699 INTABALL	Filing date: 22 May 2001  Date of entry in the register: 2 November 2001	Apparatus and installations for heating, water circulation, water supply and sanitary purposes in the form of valves; plumbing fixtures, fittings and components in the form of valves; valves, thermostatic mixing valves; radiator valves.

4. In respect of the objections under section 5(4)(a) of the Act, the opponent bases its claims on the following:

Mark	Date of first use	Use claimed in respect of
INTABALL	Use since at least 2001 in Staffordshire	Apparatus and installations for heating, water circulation, water supply and sanitary purposes in the form of valves; plumbing fixtures in the form of valves, fittings and components in the form of valves; valves for use in water circulation; radiator valves; thermostatic valves, thermostatic mixing valves; radiator valves
INTA	Use since at least 1997 in Staffordshire	As above

5. The applicant filed a counterstatement in which it denies each of the claims made and puts the opponent to proof of its use of the marks relied upon.

6. Both parties filed evidence and written submissions and the matter came before me for a hearing on 11 February 2014. Mr Robert Sales of Swindell & Pearson Ltd represented the applicant whilst Mr Kieron Taylor of the same firm, represented the opponent.

### **The evidence**

7. Witness statements were filed by Mr Alan Stephen Sherwin for the opponent and Cynthia Kathleen Fisher on behalf of the applicant. Written submissions in lieu of evidence in reply were also filed by the opponent. Given the contents of this material, I do not intend to summarise it here but will refer to it as necessary later in this decision.

### **Preliminary issues**

8. In setting out the content of his witness statement, Mr Sherwin states that it:

“deals with my company’s use of the trade mark INTABALL.”

9. At the hearing, I indicated to the parties that in view of this statement and the fact that there is no evidence provided in relation to any use of the mark INTA, the claim made under section 5(4)(a) of the Act on the basis of this latter mark could not hope to succeed. Mr Taylor accepted this. The objection based on this ground is dismissed.

10. Mr Taylor also accepted that the objection brought under section 5(2)(a) of the Act would be dismissed as the respective marks are clearly not identical.

### **The objection under section 5(2)(b) of the Act**

11. I turn then to the ground of opposition based on 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.”

12. 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.”

13. The opponent relies under this ground on its trade mark no 2270699. This is an earlier trade mark within the meaning of section 6(1) of the Act. The applicant has requested the opponent prove use of its mark and, given the interplay between the date of registration of this earlier mark and the date the application was published, the provisions of section 6A of the Act are relevant.

14. Section 6A of the Act reads:

“(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

15. Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of the application for registration i.e. 5 November 2006 to 4 November 2011.

17. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

18. Having considered the evidence filed I must, if satisfied that it shows genuine use, determine a fair specification for that use which I will then take into account when making the comparison of the respective marks. In determining a fair specification I take into account the approach set out by Mr Richard Arnold Q.C. (as he was then) acting as the Appointed Person in O/262/06 (*NIRVANA*) where he said:

“58. I derive the following propositions from the case law reviewed above:

(1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].”

19. The opponent’s evidence takes the form of a witness statement by Mr Alan Stephen Sherwin who states he has been the Managing Director of the opponent company since August 2009 having been with the firm for 8 years before that date. His statement was challenged by the applicant and later corrected in written submissions to note that he took up the post of Managing Director in 2010. Mr Sherwin states that his company is a supplier of plumbing and heating components and has used the mark INTABALL since July 2002 throughout the UK. The goods are said to have been sold to plumbing and heating distributors and to original equipment manufacturers across the UK. Mr Sherwin states the mark has been used on the following:

- Ball valves with a blue butterfly handle
- Ball valves with a red butterfly handle
- Lever ball valves with a blue handle
- Lever ball valves with a red handle
- Combi ball valves with and without drain ports
- Lever operated ball valves for gas

20. Mr Sherwin gives the following details of turnover under the mark:

Year	Turnover
2006	£2,403,602
2007	£2,541,783
2008	£2,297,162
2009	£1,804,805
2010	£1,906,351
2011	£2,304,301
2012	£2,273,219

21. Mr Sherwin does not provide a breakdown of marketing costs under the mark but states:

“...as the INTABALL brand is not a new brand and has not just been launched and is I think well known in the industry and well liked by our direct customers and our ultimate consumers, the amount spent would be lower than a brand that we have just launched. That said I would state that the share of the marketing allotted to INTABALL would need to equate to about £5000, £10,000 per annum and this would have been the case by and large in the period from 2005 to the present.”

22. For the applicant, Mr Sales submitted that he took this to mean there was a yearly marketing expenditure of somewhere between £5,000 and £10,000. Whilst this is not an unreasonable interpretation, Mr Sherwin was not called for cross examination nor challenged on this evidence in any other way and I am unable to be sure what he might have meant by his statement. I do not think it is material to the issues before me as I note that he has not provided any details or materials to show where, how or when any marketing may have taken place.

23. At AS001, Mr Sherwin exhibits a copy of a price list published by the opponent. Consisting of 52 pages, the price list shows intaball MX valves (page 33), intaball lever ball valves (pages 41 and 42), intaball ball valves (page 43) and intaball lever operated ball valves for gas (page 46). The price list is dated February 2012, and therefore dates from after the relevant date in these proceedings, however, Mr Sherwin states that:

“Whilst our previous catalogue was not identical to that contained within **Exhibit AS001**, my company’s brochure as at the date of publication of [the application] was not that different ...as it related to the **INTABALL** trade mark and any relevant differences between the documents were subtle.”

24. At AS0002, Mr Sherwin exhibits extracts taken from the opponent’s website which show them to have been printed on 24 May 2013 and which Mr Sherwin states was again, if anything, only very subtly different to how it appeared at the date of filing of the application. The pages show lever ball valves, lever operated ball valves



for gas, combi ball valves and butterfly handle ball valves offered under the intaball mark.

25. At AS003, Mr Sherwin exhibits copies of photographs which he states have been taken from his company's website and enlarged to show use of the mark "as it has been for a number of years and date from before the publication date of [the application]." The five pages each show a lever ball valve. On the lever is the word intaball in a slightly stylised form with 'inta' and 'ball' presented in differing colours.

26. At AS004, Mr Sherwin exhibits extracts taken from the internet archive, WayBackMachine, consisting of some 14 pages. At page 2, dated 18 May 2004 to 1 July 2004, are shown INTABALL full bore lever ball valves. At page 3, dated 19 May 2004 to 28 December 2004, are shown Intaball combi valves. At page 4, dated 19 May 2004 to 27 December 2004, are shown INTABALL full bore lever ball valves. At pages 6 to 8, dated 29 September 2006 to 2 December 2009, are shown IntaBall Lever ball valves, Ball valves and Combi-combination Isolation and Filter Valves. Pages 9 to 11 and 12 to 14 appear to be duplicates of pages 6 to 8.

27. Exhibit AS005 is a copy of the opponent's price list dated January 2010. Pages 28 to 30, 38 and 39 show lever operated ball valves for gas, ball valves, combi ball valves and lever ball valves all offered for sale under the mark "intaball".

28. At AS007 Mr Sherwin exhibits 6 invoices. Whilst they all list the sales of various fittings, only the invoice at page 3, dated 10 July 2008 makes any reference to the mark. It shows the sale of 100 "¾ F/F INTABALL- NO DRAIN PORT". The code number of this item shows it to correspond with the intaball combi ball valve shown at page 46 of exhibit AS0001.

29. Mr Sherwin states his view that the "INTABALL products are the market leader and we have a significant market share" but he provides no indication of how he has reached this view nor has he provided any evidence to support such a claim. Indeed I note he also states that he does not "know what our market share in the UK [is] ...as such figures are not easy to come by".

30. There are a number of gaps in the evidence, however, when taken as a whole I am satisfied that it shows use of the mark as required by section 6A of the Act. Whilst Mr Sherwin has provided some details of turnover under the mark, I am unable to ascertain the volume of sales that would represent: I note from exhibit AS0006, for example, that various items sold under the mark have been offered for sale from a low of £5.63 to a high of £67.75. Even if this information were to have been provided, there is no evidence to show the size of the relevant market or the opponent's place within it though, given the number of properties, whether domestic or commercial, in the UK which have heating or other systems on which such goods would be used, the market is likely to be of immense size. I have no evidence from the trade or third parties nor do I have any evidence in the form of advertising or publicity material.

31. In its notice of opposition, the opponent has claimed to have used the mark in respect of:

“Apparatus and installations for heating, water circulation, water supply and sanitary purposes in the form of valves; plumbing fixtures in the form of valves, fittings and components in the form of valves; vales for us in water circulation; radiator valves; thermostatic valves, thermostatic mixing valves; radiator valves”.

In his written submissions and at the hearing, Mr Taylor’s position was slightly different. He submitted that genuine use had been shown in relation to goods for which a fair specification would be “Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components; valves, thermostatic mixing valves; radiator valves and central heating installations and apparatus”. He referred me to a number of decisions including *Animal Trade Mark* [2004] FSR 19 and *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 in which the court and appointed persons had considered how such a decision should be reached. He also referred me to the decision of the General Court (‘GC’) in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)* case T-133/05 and Jacob J’s comments in *Avnet* [1998] FSR 16. As I indicated to Mr Taylor, his reliance on these latter two cases appeared to me to be conflating the question of what constitutes a fair specification as regards the use made of the earlier mark with tests for determining whether respective goods are similar or identical.

32. Whilst I accept, and as the price lists which form the opponent’s evidence at AS001 and AS005 show, the opponent’s goods are products which are intended for use in plumbing and heating installations, this does not mean that genuine use has been shown on this wider category of goods nor that a fair specification of the use made should extend to cover all of the goods as set out by Mr Taylor in his submissions. As Ms Fisher states in her witness statement on behalf of the applicant, “the mark INTABALL appears to only have been used on ball valves” which accords with Mr Sherwin’s own statement in his evidence as set out above at paragraph 19. Ball valves is a category of goods which will accord with the perceptions of the average consumer for the goods concerned. Taking all matters into account, I consider that a fair specification for the use shown, and the one I shall take into account in my comparison, is:

Ball valves for use in plumbing and heating.

33. In considering the objection under section 5(2)(b) and the likelihood of confusion between the respective marks, I take into account the guidance from the settled case law provided by the CJEU 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 Q.C., 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.

### **Comparison of the respective goods**

34. Taking into account my findings regarding the use shown to have been made of the earlier mark, the goods to be compared are:

Opponent	Applicant
Ball valves for use in plumbing and heating	Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components; heating components; valves, thermostatic mixing valves; radiator valves; shower valves; taps; mixer taps; chilled water installations and apparatus; central heating installations and apparatus; pressurisation units for maintaining the pressure within water systems; solar collectors; solar heating panels; solar powered heating apparatus and installations; parts and fittings for all the aforesaid goods

35. Earlier in this decision I referred to the case of *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*. The court commented that:

“...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...”

I also note the findings in Case T-420/03 – *El Corte Inglés v OHIM- Abril Sanchez and Ricote Sauger* (Boomerang TV) where the General Court (GC) commented:

“96.....Goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T14169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gomez Frias* (euroMASTER), not published in the ECR, paragraph 35).”

36. I consider the following of the applicant’s goods to be identical to the opponent’s goods on the basis outlined in *Merica*:

Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components; heating components; valves, thermostatic mixing valves; radiator valves; shower valves; chilled water installations and apparatus; central heating installations and apparatus; pressurisation units for maintaining the pressure within water systems; solar powered heating apparatus and installations; parts and fittings for all the aforesaid goods

37. *Taps* and *mixer taps* are, like ball valves, goods that are used by e.g. plumbers to regulate the flow in a water supply albeit that they do so in different ways and one is not a substitute for the other but both could be used as part of the same system. The respective goods will be supplied through the same trade channels and each will be used by the same users (i.e. plumbers or heating engineers). The respective goods are similar to a low degree.

38. That leaves *solar collectors; solar heating panels and parts and fittings for these goods*. These are goods which, as their names suggest, are used as part of a heating system to harness solar energy. Whilst solar heating panels, solar collectors and ball valves may all be part of the same heating system, the specific uses and natures of each differ and there is no evidence that one is indispensable or important for the use of the other such that the average consumer will think that they come from the same undertaking. The respective goods are dissimilar.

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

39. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and then to determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

40. Whilst it is likely that most of the goods will be bought by professionals such as plumbers and heating engineers, many will also be bought by e.g. those members of the general public who are competent DIYers. As to the level of attention these different purchasers will pay, I note that in *Adelphoi Limited v DC Comics (a general partnership)* BL O/440/13, Professor Annand, sitting as the appointed person stated:

“21. As for the services, e.g., broadcasting, whilst I agree with Mr. Malynicz that the average consumer would include business consumers or professionals as well as the general public, the likelihood of confusion must be assessed in relation to the part of the public whose attention is lower (see e.g., Case T-448/11, *Golden Balls Ltd v. OHIM*, 16 September 2013, para. 26), although in any event, the Hearing Officer relied on an average consumer (reasonably well informed and reasonably circumspect and observant) paying an average level of attention (para. 41).”

As the respective goods range from e.g. a complete central heating system to a small replacement part, they will vary widely in price. Because of the need to ensure a part is of an appropriate fit and function within a more complex system and compatible with it or because of the need to ensure the complete system is appropriate to the location and purpose for which it is being installed, all of the goods are such as are likely to be subject to a purchasing process involving some, though not necessarily the highest, degree of care whether bought by a professional or a member of the general public. The goods are such as are sold in specialist stores such as plumbers merchants though some may also be sold in more general DIY or hardware stores, whether on line or on the high street and thus the visual aspects of the marks are likely to come into play. That is not to say the aural aspects can be ignored as it is possible that some businesses will create a job list and place orders with suppliers over the telephone for direct delivery to a specific location for its installation.

## Comparison of the respective marks

41. For ease of reference, the marks to be compared are as follows:

Earlier mark	Applicant's mark
INTABALL	INTASOL

42. Both marks are presented in plain block capitals and as single words. Mr Sales accepted that both marks start with the same four letters in the same order but submitted that as the remainders of each mark were so different and were well known or dictionary words, the respective marks were different.

43. Whilst the earlier mark is presented as a single word, as the goods at issue are ball valves, the word naturally breaks down into its two component parts: the dominant and distinctive prefix INTA and the non-distinctive suffix BALL. The applicant's mark is also presented as a single word. The goods for which registration is applied include goods for use in solar heating systems for which the SOL suffix, a dictionary word meaning sun, is also non-distinctive.

44. Each of the respective marks begins with the same four letters INTA and ends with the letter L. They differ as to their remaining letters. When considered as wholes, there is a reasonable degree of visual and aural similarity between the respective marks. From the conceptual perspective, despite the earlier mark including the word BALL, no particular image is brought to mind. The same is true of the applicant's mark.

## The distinctiveness of the earlier mark

45. I must also assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the goods for which it is registered 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 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 undertakings – *Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

46. The opponent has filed evidence which shows turnover under the mark of around £2m per annum. Whilst this is not an insignificant figure, as I indicted earlier, no evidence has been provided which shows its position within the relevant market. Despite the claim that there has been (an uncertain) promotional spend under the mark, there is no evidence of any advertising or promotion under the mark having been undertaken nor are there any details of what, when and how any such activities may have taken place. There is no evidence from the trade nor from customers. The evidence does not show the earlier mark to have enhanced its distinctiveness, to any material extent, through its use or to have a reputation. It is a mark with an average level of inherent distinctive character.

## Likelihood of confusion

47. In determining whether there is a likelihood of confusion, a number of factors must 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 vice versa. I must also factor in the distinctive character of the earlier 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, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between the trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

48. In her witness statement, Ms Fisher states she was one of four co-founders of the opponent company and remained a director of it from its inception in 1987 until 2010. She is now a director of the applicant as well as other companies. She refers to a number of trade marks originally in the name of the opponent as well as others in the name of the applicant some of which have been subject to assignments. Mr Sales made a number of submissions which repeated claims made in Ms Fisher's evidence that the applicant is the proprietor of a number of other INTA prefixed trade marks. Mr Taylor pointed out that no details of the registration numbers or dates of these trade marks, nor the goods and/or services for which these may have been registered, have been provided. Even if these details had been supplied and it was established that they predated the mark relied on by the opponent in these proceedings, it would not have furthered the applicant's case as I have to make my comparison under this ground solely on the basis of the mark applied for by the applicant and the earlier mark relied on by the opponent. See *PepsiCo, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) T-269/02.

49. Earlier in this decision I found:

- with the exception of *solar collectors* and *solar heating panels*, which I have found to be dissimilar, the respective goods are either identical or of low similarity;
- the goods are such as will be purchased with some, though not the highest, degree of care;
- the respective marks have a reasonable degree of visual and aural similarity and are conceptually neutral ;
- the earlier mark is of average distinctive character which has not been shown to have been enhanced to any material degree through its use.

50. In order for a finding that there is a likelihood of confusion, there has to be some similarity in the respective goods. As I have found the applicant's *solar collectors* and *solar heating panels* to be dissimilar to the opponent's goods which are *ball valves for use in heating and plumbing*, it follows that there can be no likelihood of confusion. As for the goods which I have found to be similar or identical, and taking

all matters into account, I consider the differences in the marks are such that there will be no likelihood of direct confusion: i.e. where one mark is mistaken for the other. As both marks, however, start with the same four letters which make up the distinctive prefix INTA followed by a non-distinctive suffix Ball/Sol, I consider there is a likelihood of indirect confusion: i.e. that the average consumer will consider that the respective goods come from the same or an economically linked entity, even where I have found the respective goods to be of low similarity.

### **The objections under sections 5(3) and 5(4) of the Act**

51. In view of my findings under section 5(2)(b) of the Act, I do not propose to consider the matter further under these remaining grounds save to indicate that for a successful finding under section 5(3) it has to be shown that the earlier mark has a reputation. On the basis of the evidence filed, I have found it has no such reputation. As for the objection brought under section 5(4)(a) of the Act, I fail to see how the opponent can be in any better position than I have already assessed under section 5(2). This is because any goodwill the opponent has, has not been shown to extend beyond the goods which I took into account in my consideration under that ground. On that basis, the objections under these grounds would also fail.

### **Summary**

52. The opposition based on section 5(2)(b) of the Act succeeds in respect of all goods of the application with the exception of *solar collectors; solar heating panels and parts and fittings therefor*.

### **Costs**

53. The opposition has largely succeeded and the opponent is entitled to an award of costs in its favour. I take into account that whilst both parties filed evidence, it was not particularly complex or extensive. I also take note that a hearing took place. Bearing this in mind and taking account of the degree to which the opposition has succeeded, I make the award on the following basis:

For filing a statement and reviewing the other party's statement:	£300
Fee:	£200
For the preparation and review of evidence:	£200
For preparation and attendance at a hearing:	£300
<b>Total:</b>	<b>£1000</b>



54. I order Intaco Ltd to pay Altecnic Ltd the sum of £1000 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 26<sup>th</sup> February 2014**

**Ann Corbett  
For the Registrar  
The Comptroller-General**