

O-173-14

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO 2621086  
IN THE NAME OF BLACK MOUNTAIN INSULATION LIMITED  
IN RESPECT OF TRADE MARK:

**ThermalFlex**

AND

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY THEREOF  
UNDER NO 500011 BY THERMAFLEX ISOLATIE B.V.

## BACKGROUND

1. Trade mark No. 2621086 shown above stands registered in the name of Black Mountain Insulation Limited (the proprietor). It completed its registration procedure on 1 February 2013. It is registered for the following goods in class 17:

Semi-rigid and wood fibre thermal insulation materials for use in insulating loft space, timber floors, internal partitioning walls and external timber frame walls.

2. On 25 March 2013, Thermaflex Isolatie B.V. (the applicant) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and (b) and section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), which state:

"47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

And:

"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.

...

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade..."

3. The applicant relies upon the Community trade mark 332791 for the mark THERMAFLEX. The mark was registered on 3 June 1999 for goods in classes 11, 16 and 17.

4. If the applicant cannot succeed in respect of its goods in class 17, it is in no better position with its goods in classes 11 and 16. I will make the necessary comparison based on the applicant's class 17 goods recorded as follows:

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.

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. The applicant's mark is an earlier mark, which is, in principle, subject to proof of use because, at the date of the application for invalidity, its marks had been registered for five years.<sup>1</sup> However, at section 5 of its counter statement the applicant has answered “NO” when asked if it requires the opponent to provide proof of use. Therefore I need consider it no further. The opponent is entitled to rely on all of the goods contained in its specification.

7. On 7 June 2013, the proprietor filed a counter statement in which it denies the grounds of invalidation.

8. The applicant filed written submissions in lieu of a hearing and neither party elected to be heard.

### **Section 5(2)(b) case law**

9. 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 Court of Justice of the European Union (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 &*

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<sup>1</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

## **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 act

10. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

11. In its statement of grounds the proprietor submits:

*“Our product ThermalFlex is a natural fibre insulation designed for timber frame walls, lofts and suspended timber floors. [The applicant’s] products [are] man-made and are designed to insulate pipes, liquid cooling systems, duct work, tanks, valves and air conditioning systems. There is not a single application in which our product ThermalFlex could be used as a replacement for [the applicant’s] products...”*

12. In *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05* the GC stated:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors – whether carried out or not – which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

13. In making a finding with regard to the average consumer of the goods at issue, I must consider the specifications as registered. These will include highly specialised products of the type described by the proprietor, but will also include goods sold in builders’ merchants and DIY stores. Consequently, I must conclude that the average consumer may be a member of the general public or a professional such as a building contractor or engineer.

14. In this regard, I bear in mind the comments in *Adelphoi Limited v DC Comics (a general partnership)*<sup>2</sup>, when Professor Ruth Annand (sitting as the Appointed Person) stated:

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<sup>2</sup> *BL O/440/13*

“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).”

15. The nature of the purchase is likely to be primarily visual, the average consumer encountering the goods and trade marks on the internet, in a catalogue or product literature, through advertising or at the point of purchase such as in store. I do not rule out aural considerations as it is likely that enquiries may be made or advice sought, prior to or during the purchase of such products. The degree of attention paid is likely to vary according to the cost and complexity of the goods being purchased but, taking into account the nature of the goods, the average consumer will pay at least a medium degree of attention.

### Comparison of goods

16. The goods to be compared are as follows:

The applicant's goods	The registered proprietor's goods
<p><b>Class 17</b> 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><b>Class 17</b> Semi-rigid and wood fibre thermal insulation materials for use in insulating loft space, timber floors, internal partitioning walls and external timber frame walls.</p>

17. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

*“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”*

18. The proprietor's goods are included within the broad term 'insulating materials' in the applicant's specification. Consequently, in accordance with *Meric*, I find the parties' goods to be identical.

## Comparison of marks

19. The marks to be compared are as follows:

The applicant's mark	The proprietor's mark
THERMAFLEX	ThermalFlex

20. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>3</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

21. The applicant's mark consists of the single word 'THERMAFLEX' in block capitals. No part of the word is stylised or emphasised in any way. Consequently, the distinctiveness lies in the mark as a whole.

22. The proprietor's mark consists of the word 'ThermalFlex'. The letters 'T' and 'F' are in capitals with the remaining letters in lower case. No part of the word is stylised in any way. The distinctiveness lies in the mark as a whole.

## Visual similarities

25. The applicant submits:

*"11. Each of the marks is a word only mark. The first six letters of the marks are identical...The final four letters are also identical. The marks differ only by the inclusion of an additional 'l' in the middle of the Registered Proprietor's mark. Visually, the presence of the additional letter is not immediately apparent because it is next to the upright portion of the 'F'. The marks are highly visually similar."*

26. The applicant also draws my attention to the fact that the beginnings of words are more important. The general rule, that the average consumer tends to place most importance on the start of a word<sup>4</sup>, is exactly that - a general rule, to which an exception can be made depending on the circumstances of the case.<sup>5</sup> In this case there are pertinent similarities at the beginning and the end of the respective marks.

27. In its counter statement the proprietor states that the extra letter and the capitalised 'F' increase distinction in its mark.

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<sup>3</sup> *Sabel v Puma AG, para.23*

<sup>4</sup> *Les Editions Albert Rene v OHIM, Case T-336/03*

<sup>5</sup> *Castellani SpA v OHIM, T-149/06 ans Spa Monopole, Campagnie Fermiere de Spa SA/NV v OHIM, T-438/07*

28. In considering the presentation of the marks at issue I am mindful of the decision in *Sadas*<sup>6</sup>, which was applied by the Court of First Instance (now the General Court) in *Peek & Cloppenburg v OHIM*,<sup>7</sup> where the earlier mark was the plain word mark. It stated,

"27...the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue. ... since the early mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for."

29. In this case, normal and fair use of the applicant's mark would include use of the mark in normal scripts, including upper and/or lower case letters which would reduce the apparent visual difference between the marks when the applicant's mark is considered in block capitals.

30. The only difference between the parties' marks is the presence of the letter 'l' in the middle of the proprietor's mark. Taking all of these factors into account, I find the degree of visual similarity to be very high.

### **Aural similarities**

31. The applicant submits:

*"12. The marks each consist of three syllables. The first and third syllables are identical and accordingly are pronounced identically. The middle syllables are respectively 'a' and 'al'. In each case by the ordinary rules of English pronunciation, the 'a' would be short and neutral as it is in 'apostle' and because of its proximity to another consonant (F) the 'l' sound would be 'swallowed' and not clearly enunciated. Overall, the marks are highly phonetically similar."*

32. Both marks contain three syllables. The applicant's mark will be pronounced THER (as in THIRD), MA (as in the end of the word OPTIMA) and FLEX (as in FLEXIBLE). The proprietor's mark has the same first and third syllables, the only difference being the central MAL (as in the end of the word ANIMAL). The aural difference created by the presence of the letter 'l' in the proprietor's mark is minimal. Taking all of these factors into account, there is a high degree of aural similarity between the marks.

### **Conceptual similarities**

33. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>8</sup> The assessment must be made from the point of view of the average consumer.

34. The applicant submits:

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<sup>6</sup> *Sadas v OHIM*, T-346/04

<sup>7</sup> T-386/07

<sup>8</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.



*“13. Neither of the marks has a clear conceptual meaning as a whole. In each case the element ‘therma/thermal’ alludes to temperature and the element ‘flex’ could be seen as alluding to flexibility. Although a strict conceptual comparison cannot be made, any conceptual meaning which can be inferred from the marks is identical.”*

35. In making a finding on this point I have considered the comments of the General Court in *Ontex NV v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 353/04 in relation to evocative effects, when it said:

“91. This evocative effect is independent of whether or not the word mark EURON designates a characteristic of the goods for which registration of the earlier mark was made, since that fact does not influence the ability of the relevant public to make an association between that word mark and the words ‘euro’ and ‘Europe’ (see, by way of analogy, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54). In the same way, the evocative force of the earlier mark cannot be altered by the fact that it is supposedly ‘made up’. Even a made-up word may carry conceptual weight.”

36. In my view, both of the parties’ marks will be seen as invented words. However, both have a natural break between the first part of the mark, i.e. ‘THERMA’ and ‘Thermal’, and the second part of the mark, namely the word ‘Flex’. In the case of the proprietor’s mark this is due to its being a combination of two known words, both of which have been emphasised in that the first letter is capitalised. In the applicant’s case, the word FLEX is visible within the mark and will provide a break from the ‘THERMA’ part of the mark. Both ‘THERMA’ and ‘Thermal’ allude to heat and both marks contain the word ‘flex’, which may be considered to mean flexible. Whether the average consumer reaches these conclusions or simply sees the marks as invented words, the situation will be the same for both marks.

### **Distinctive character of the earlier mark**

37. I must now assess the distinctive character of the opponent’s earlier trade marks. The distinctive character of a trade 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 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 for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

38. No evidence has been filed and I have only the inherent characteristics of the trade mark to consider. The applicant’s mark is the word ‘THERMAFLEX’. I have already concluded that this may allude to heat and flexibility, but is not a known word and does not describe the goods at issue. I find it to have a medium degree of inherent distinctive character.

## Likelihood of confusion

39. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>9</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

40. In its counter statement the proprietor states:

*“Since launching ThermalFlex in June 2012, we have never had any confusion with another product, brand or company including that of the complainant which supports our view that the two brands are completely different. It also suggests that our trademark does not threaten to cause any misperceptions in the market.”*

41. On the issue of reliance on the absence of confusion in the marketplace, TPN9 4/2009 states:

“6. Parties are also reminded that claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.

42. In *Compass Publishing BV v Compass Logistics Ltd [2004] RPC 41* Laddie J held:

“22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s.10(2)<sup>10</sup>. So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full

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<sup>9</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*, paragraph 27

<sup>10</sup> 10 (2) *A person infringes a registered trade mark if he uses in the course of trade a sign where because – (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.*

width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.

23. This is of significance in this case because, as noted above, there is no suggestion that there has been any confusion in the market place between the activities of the Defendant under the sign "COMPASS LOGISTICS" and the Claimant, or any other member of the Compass Group, under the mark "COMPASS". Mr Wyand relies on this as being a good indication that there is no likelihood of confusion. But in my view Mr Purvis is right when he argues that the question of infringement has to be answered by assessing the likelihood of confusion were the Claimant to use the mark "COMPASS" in a normal way in respect of all services covered by the registration, including for business consultancy services in the field of logistics, that is to say the same specialist field the Defendant operates in."

43. In *Rousselon Freres et Cie v Horwood Homewares Limited*<sup>11</sup> Warren J commented:

"99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says...")"

44. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

45. In the absence of any evidence to the contrary and in accordance with the case law identified above, I need consider this point no further.

46. I have found the marks to have a high degree of visual similarity and to be aurally similar to a very high degree. Conceptually, if an impression is conveyed to the average consumer it will be the same for both marks. I have found the earlier mark to have a medium level of inherent distinctive character and have found the proprietor's goods to be identical to those of the applicant. I have identified the average consumer, namely a member of the general public or a trade professional and have concluded that the purchase will be primarily visual, though I do not discount an aural element where the consumer seeks assistance in store prior to purchase. The level of attention paid to the purchase will vary but will always be at least reasonable to the extent that the average consumer will ensure the goods are right for the work being undertaken.

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<sup>11</sup> [2008] EWHC 881 (Ch)

47. Taking all of these factors into account, the similarity of the marks is such that in the context of goods which are identical there will, in my view, be a likelihood of confusion because the marks will be mistaken for one another.

### **Conclusion**

48. As a consequence of my decision above, the applicant's request to invalidate the registered proprietor's registration has succeeded under section 5(2)(b) of the Act and under the provisions of 47(6) of the Act. The registration is deemed never to have been made.

### **Costs**

49. Thermaflex Isolatie B.V. has been successful and is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. I have taken into account that no hearing has taken place and award costs on the following basis:

Preparing a statement and considering the other side's statement: £ 300

Written submissions: £ 400

Official fee: £ 200

**Total: £ 900**

50. I order Black Mountain Insulation Limited to pay Thermaflex Isolatie B.V. the sum of £900. 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 16th day of April 2014**

**Ms AI Skilton  
For the Registrar,  
the Comptroller General**