

O-084-15

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3022388  
BY  
SIG TRADING LIMITED**

**TO REGISTER THE TRADE MARK**



**IN CLASSES 6, 19 AND 37**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 401455  
BY  
ALDI GMBH & CO KG**

## BACKGROUND

1. On 17 September 2013, SIG Trading Limited (the applicant) applied to register the above trade mark in classes 6, 19 and 37 of the Nice Classification system<sup>1</sup> as follows:

### **Class 6**

Common metals and their alloys; metal building materials; reinforcing bars of metal for use in masonry; reinforcement materials (metal -) for construction; reinforcing materials, of metal, for concrete; metal casting forms for concrete; forms (metallic -) for concrete; concrete (shuttering, of metal for -); metallic shuttering for concrete; beams of common metal for formwork systems; formwork of metal; steel reinforcement for use in the construction of concrete floors; metallic building materials; anchors; steel and steel masonry supports; boards of metal for use in building and construction; metal fixings for use in the building and construction industry; metal reinforcement materials for building; air vents of metal for buildings; metal roof vents; venting ducts of metal; roofing membranes of metal; metal screed supports; metal flooring screeds; wire and wire mesh for reinforcing concrete.

### **Class 19**

Building materials (non-metallic); construction materials, not of metal; building materials of concrete reinforced with plastics and glass fibres; forms (non-metallic -) for concrete; clay forms for concrete; shuttering, not of metal, for concrete; concrete; reinforced concrete; reinforcement rods, not of metal; structural reinforcement (non-metallic -) for construction purposes; reinforcing materials, not of metal, for building; non-metallic mouldings; non-metallic building materials; structural reinforcement (non-metallic-) for construction purposes; expansion joints of non-metallic materials for use in building; small items of non metallic hardware used in building and construction; industrial concrete for use in civil engineering works; concrete forms; concrete columns; concrete ground beams; screeds; flooring screeds; screed supports; crack inducers and void formers for use in forming concrete.

### **Class 37**

Building construction; masonry services; construction of civil engineering structures by forming concrete; erection of climbing formworks; erection of sliding formworks; erection of reinforced concrete structures utilising sliding and climbing formworks; grout reinforcement for bridges, dams, foundations, gas platforms, oil platforms, mines and tunnels; repair of concrete and concrete structures; construction of civil engineering structures by laying, pouring and forming concrete; erection of reinforced concrete structures utilising sliding and climbing formworks, application of screeds.

2. The application was published on 18 October 2013, following which ALDI GmbH & Co KG (the opponent) filed notice of opposition against the application.

3. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon Community Trade Mark (CTM) registration no 10609287 which stands as follows:

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<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

Mark details and relevant dates	Goods relied upon
<p><b>CTM:</b></p> <p><b>ALDI</b></p> <p><b>Filed:</b> 2 February 2012</p> <p><b>Entered in the register:</b> Class 5 currently opposed at OHIM</p>	<p><b>Class 1</b> Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; Unprocessed artificial resins, unprocessed plastics; Manures; Fire extinguishing compositions; Tempering and soldering preparations; Chemical substances for preserving foodstuffs; Tanning substances; Adhesives used in industry.</p> <p><b>Class 2</b> Paints, varnishes, lacquers; Preservatives against rust and against deterioration of wood; Colorants; Mordants; Raw natural resins; Metals in foil and powder form for painters, decorators, printers and artists.</p> <p><b>Class 5 (OPPOSED AT OHIM)</b> Pharmaceutical and veterinary preparations; Sanitary preparations for medical purposes; Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for humans and animals; Plasters, materials for dressings; Material for stopping teeth, dental wax; Disinfectants; Preparations for destroying vermin; Fungicides, herbicides.</p> <p><b>Class 6</b> Common metals and their alloys; Metal building materials; Transportable buildings of metal; Materials of metal for railway tracks; Non-electric cables and wires of common metal; Ironmongery, small items of metal hardware; Pipes and tubes of metal; Safes; Goods of common metal not included in other classes; Ores.</p> <p><b>Class 8</b> Hand tools and implements (hand-operated); Cutlery; Side arms; Razors.</p> <p><b>Class 10</b> Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; Orthopedic articles; Suture materials.</p> <p><b>Class 11</b> Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.</p> <p><b>Class 12</b> Vehicles; Apparatus for locomotion by land, air or water.</p>

**Class 13**

Firearms; Ammunition and projectiles; Explosives; Fireworks.

**Class 14**

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; Jewellery, precious stones; Horological and chronometric instruments.

**Class 15**

Musical instruments.

**Class 17**

Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; Plastics in extruded form for use in manufacture; Packing, stopping and insulating materials; Flexible pipes, not of metal.

**Class 18**

Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas and parasols; Walking sticks; Whips, harness and saddlery.

**Class 19**

Building materials (non-metallic); Non-metallic rigid pipes for building; Asphalt, pitch and bitumen; Non-metallic transportable buildings; Monuments, not of metal.

**Class 20**

Furniture, mirrors, picture frames; Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

**Class 21**

Household or kitchen utensils and containers; Combs and sponges; Brushes (except paint brushes); Brush-making materials; Articles for cleaning purposes; Steelwool; Unworked or semi-worked glass (except glass used in building); Glassware, porcelain and earthenware not included in other classes.

**Class 22**

Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); Padding and stuffing materials (except of rubber or plastics); Raw fibrous textile materials.

**Class 23**

	<p>Yarns and threads, for textile use.</p> <p><b>Class 26</b> Lace and embroidery, ribbons and braid; Buttons, hooks and eyes, pins and needles; Artificial flowers.</p> <p><b>Class 27</b> Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; Wall hangings (non-textile).</p> <p><b>Class 37</b> Building construction; Repair; Installation services.</p> <p><b>Class 44</b> Medical services; Veterinary services; Hygienic and beauty care for human beings or animals; Agriculture, horticulture and forestry services.</p> <p><b>Class 45</b> Legal services; Security services for the protection of property and individuals; Personal and social services rendered by others to meet the needs of individuals.</p>
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4. The opponent's earlier mark was opposed at OHIM<sup>2</sup> and is currently awaiting an appeal decision. Consequently, the mark is not registered and any decision to uphold the opposition is provisional.

5. The applicant filed a counterstatement on 20 March 2014. It denies the grounds on which the opposition is based.

6. The applicant filed written submissions in the period allowed for the filing of evidence. The opponent filed evidence and written submissions in lieu of attendance at the hearing. A hearing took place before me on 15 January 2015, by video conference. The opponent did not attend. The applicant was represented by Mr Dominic Murphy for Withers and Rogers LLP.

## EVIDENCE

### Opponent's evidence

7. The opponent's evidence consists of a witness statement by Oliver Pollhammer, the Managing Director of ALDI Einkauf GmbH & Co oHG (since 2011) and "prokurist" of Aldi GmbH & Co KGa (since 2013). Mr Pollhammer's statement is dated 28 July 2014 and is accompanied by 8 exhibits.

8. At paragraph 7 of his witness statement Mr Pollhammer states:

*"...there is no doubt that the Opponent's mark ALDI possesses an enhanced*

<sup>2</sup> Office for Harmonisation in the Internal Market.

*level of distinctiveness acquired by its intensive geographically widespread use in the United Kingdom. The Opponent...and its affiliated companies are discount supermarkets which operate throughout Europe and the Opponent's trade mark is permitted to be used in the United Kingdom by Aldi Stores Limited, a company incorporated in the United Kingdom under company number 02321869."*

9. The exhibits attached to Mr Pollhammer's statement all relate to the opponent's supermarket business and its reputation in this regard. An assessment of distinctive character must be made with reference to the goods and services relied upon by the opponent. In this case those goods and services are entirely unrelated to supermarkets and their related services.

10. Consequently, there is no need to summarise this evidence or consider it further and I shall say no more about it.

11. Both parties filed written submissions which I will refer to as necessary below. I give this decision following a review of all of the material before me.

## **DECISION**

12. Section 5(2)(b) reads as follows:

"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."

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

13. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

#### **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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will 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**

14. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word

'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

15. On pages 4 and 5 of its submissions filed in lieu of attendance at the hearing, the opponent submits<sup>3</sup>:

*"the relevant goods and services at issue" may range from products used in large-scale construction and engineering projects but also encompass goods and services regarding repair work and refurbishment of individual buildings, including extension work to buildings and the construction of annexes, conservatories, garages, etc.*

*Regarding services in class 37, in the Explanatory Note to the WIPO's Nice Classification Guide, which appears as Exhibit OPI in the Witness Statement of Mr Oliver Pollhammer, which states as follows:*

*"Class 37 includes mainly services rendered by contractors or subcontractors in the construction or making of permanent buildings, as well as services rendered by persons or organizations engaged in the restoration of objects to their original condition or in their preservation without altering their physical or chemical properties"*

*It is therefore clear from the word mainly in the above quoted passage from the Nice description that construction and building services in class 37 are not limited to large-scale construction and engineering projects, and so may include small-scale projects including repairs and upgrading projects too.*

*The Applicant states in the counterstatement that "the goods and services claimed in classes 6, 19 and 37 are all used in or related to large scale and expensive building projects, either in relation to buildings, bridges or other large structures, that need detailed planning permission and take months or years to complete".*

*The Applicant also states that "the average consumer would be a highly educated and/or experienced professional in the building industry and they would pay a high level of attention to their purchase, due to its price, highly technological character and importance to the project as a whole."*

*However, the Opponent submits that the average consumer is not so easily or neatly categorised as suggested by the Applicant, since the relevant goods and services are not limited solely to professionals involved at the planning stage of large constructions projects. On the contrary, since the goods covered by the Applicant's specifications for Classes 06 and 19 are broad, on a fair reading it is clear that the goods and services would not be confined to the trade and to professionals, but would also encompass non-trade and non-professional users such as engineers, builders, traders, jobbers, builders undertaking repair work, refurbishment, extensions to a building, annexes, conservatories, garage, etc. and also Do It Yourself enthusiasts."*

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<sup>3</sup> Dated 7 January 2015



16. The applicant submits, in its skeleton argument:

*“3. The goods and services claimed in classes 6, 19 and 37 are all used in or related to large scale and expensive building projects, either in relation to buildings, bridges or other large structures that need detailed planning permission and take months or years to complete. Therefore, the average consumer in question would be a highly educated and/or experienced professional in the building industry and they would pay a high level of attention to their purchase, due to its price, highly technological character and importance to the project as a whole.”*

17. At the hearing Mr Murphy submitted that the goods at issue are used for large scale building projects, not by DIY purchasers and that they need an enormous amount of planning. He maintained goods such as concrete and forming concrete are highly technical with a high price attached and accordingly require numerous safety considerations to be taken into account. Consequently, in his view, these are highly considered purchases.

18. 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).”*

19. In making a finding with regard to the average consumer of the goods and services at issue, I must consider the specification as it appears on the register. The specification includes a range of building and construction materials and services, many of which are goods of the type described by the applicant, including, inter alia, concrete columns and grout reinforcement for bridges and dams. Clearly the average consumer for these goods will be a professional such as a building contractor or civil engineer. However, the specification also includes, inter alia, metal building materials and small items of non-metallic hardware used in building which will include goods of the type commonly sold in builders’ merchants and DIY stores. Accordingly, the average consumer for these goods may be a member of the general public or a professional such as a building contractor or civil engineer. The same applies with regard to the services which may include hiring a contractor to build a conservatory, which could be purchased by a member of the general

public or the building of a motorway bridge, which will be commissioned by a professional purchaser.

20. 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 level of attention paid will vary according to the nature of the goods, in this case, being at least reasonable, even where the consumer purchases small items of non-metallic hardware, which must be, inter alia, the correct size and shape and be suitable for the relevant task. Clearly, where the purchase relates to expensive civil engineering projects the level of attention will be higher.

### Comparison of goods/services

21. The opponent is relying on an earlier mark which stands registered in respect of 23 classes of goods and services. Three of these classes are the same as those for which the applicant seeks registration. I will consider these three classes first before moving on to consider the remainder of the opponent's specification if it becomes necessary.

22. In the absence of any evidence from either party regarding the nature of the goods and services to be compared, the following assessment is made from my own understanding.

23. The goods/services I initially compare are:

Opponent's goods and services	Applicant's goods and services
<p><b>Class 6</b> - Common metals and their alloys; Metal building materials; Transportable buildings of metal; Materials of metal for railway tracks; Non-electric cables and wires of common metal; Ironmongery, small items of metal hardware; Pipes and tubes of metal; Safes; Goods of common metal not included in other classes; Ores.</p> <p><b>Class 19</b> - Building materials (non-metallic); Non-metallic rigid pipes for building; Asphalt, pitch and bitumen; Non-metallic transportable buildings; Monuments, not of metal.</p>	<p><b>Class 6</b> - Common metals and their alloys; metal building materials; reinforcing bars of metal for use in masonry; reinforcement materials (metal -) for construction; reinforcing materials, of metal, for concrete; metal casting forms for concrete; forms (metallic -) for concrete; concrete (shuttering, of metal for -); metallic shuttering for concrete; beams of common metal for formwork systems; formwork of metal; steel reinforcement for use in the construction of concrete floors; metallic building materials; anchors; steel and steel masonry supports; boards of metal for use in building and construction; metal fixings for use in the building and construction industry; metal reinforcement materials for building; air vents of metal for buildings; metal roof vents; venting ducts of metal; roofing membranes of metal; metal screed supports; metal flooring screeds; wire and wire mesh for reinforcing concrete.</p> <p><b>Class 19</b> - Building materials (non-metallic); construction materials, not of metal; building materials of concrete reinforced with plastics and glass fibres; forms (non-metallic -) for concrete; clay forms for concrete; shuttering, not of metal, for concrete; concrete; reinforced concrete; reinforcement rods, not of metal; structural reinforcement (non-metallic -) for construction purposes; reinforcing materials, not of metal, for</p>

<p><b>Class 37</b> - Building construction; Repair; Installation services.</p>	<p>building; non-metallic mouldings; non-metallic building materials; structural reinforcement (non-metallic-) for construction purposes; expansion joints of non-metallic materials for use in building; small items of non metallic hardware used in building and construction; industrial concrete for use in civil engineering works; concrete forms; concrete columns; concrete ground beams; screeds; flooring screeds; screed supports; crack inducers and void formers for use in forming concrete.</p> <p><b>Class 37</b> - Building construction; masonry services; construction of civil engineering structures by forming concrete; erection of climbing formworks; erection of sliding formworks; erection of reinforced concrete structures utilising sliding and climbing formworks; grout reinforcement for bridges, dams, foundations, gas platforms, oil platforms, mines and tunnels; repair of concrete and concrete structures; construction of civil engineering structures by laying, pouring and forming concrete; erection of reinforced concrete structures utilising sliding and climbing formworks, application of screeds.</p>
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24. In comparing the goods and services, 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.”*

25. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*<sup>4</sup>(hereafter Treat) for assessing similarity between goods and services:

- (a) the respective *uses* of the respective goods or services;
- (b) the respective *users* of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

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<sup>4</sup>[1996] R.P.C. 281

26. The comments of Daniel Alexander, sitting as the Appointed Person, in *LOVE*<sup>5</sup>, which dealt with similarity of goods but by analogy is relevant to similarity of services, are also to be borne in mind:

“18... the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

27. And at paragraph 20 where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

28. Where appropriate I will, for the purposes of comparison, group related goods and services together in accordance with the decision in *Separode Trade Mark*<sup>6</sup>:

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

29. When considering the parties services I am mindful of the decision in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, in which Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meaning attributable to the rather general phrase.”

30. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

“In construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

31. I will also bear in mind Floyd, J’s statement in *YouView TV Ltd v Total Ltd*:<sup>7</sup>

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<sup>5</sup> *BL O/255/13*

<sup>6</sup> *BL O-399-10*

"...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

32. And *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* in which the GC explained when goods were complementary:

"82 It is true that goods are complementary if 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 those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48)."

### **The applicant's goods in class 6**

33. Both parties' specifications include the terms, 'common metals and their alloys, and 'metal building materials'. These are clearly identical. I also find 'metallic building materials' in the application to be identical to 'metal building materials' in the opponent's specification, since it is simply an alternate form of words.

34. At the hearing Mr Murphy stated that there was some similarity between, reinforcing bars of metal for use in masonry; reinforcement materials (metal -) for construction; steel reinforcement for use in the construction of concrete floors; anchors; steel and steel masonry supports; boards of metal for use in building and construction; metal fixings for use in the building and construction industry and the goods in the opponent's specification. Since all of these goods are building materials and are made of metal, I find these goods to be identical to the opponent's metal building materials.

35. The remaining goods in class 6 of the application are:

'reinforcing materials, of metal, for concrete; metal casting forms for concrete; forms (metallic -) for concrete; concrete (shuttering, of metal for -); metallic shuttering for concrete; beams of common metal for formwork systems; formwork of metal; metal reinforcement materials for building; air vents of metal for buildings; metal roof vents; venting ducts of metal; roofing membranes of

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<sup>7</sup> [2012] EWHC 3158 (Ch) at [12]

metal; metal screed supports; metal flooring screeds; wire and wire mesh for reinforcing concrete’.

36. Mr Murphy stated that these are not similar to the opponent’s goods. It is my understanding that these goods are used for shaping and reinforcing concrete, for example, metallic shuttering for concrete; or they are goods which are used within the structure of a building, such as roofing membranes of metal. Consequently, these are all goods which fall within the ambit of the opponent’s ‘metal building materials and are identical.

### **The applicant’s goods in class 19**

37. ‘Building materials (non-metallic)’ are included within both sides’ specifications and are clearly identical goods.

38. At the hearing Mr Murphy accepted there was some similarity between the opponent’s specification and the following goods:

‘construction materials, not of metal; building materials of concrete reinforced with plastics and glass fibres; concrete; reinforced concrete; non-metallic building materials; industrial concrete for use in civil engineering works’.

39. Since all of these goods can be considered non-metallic building materials I find them to be not just similar, but in fact identical to the opponent’s goods.

40. The same is true of the remaining goods, namely, ‘forms (non-metallic -) for concrete; clay forms for concrete; shuttering, not of metal, for concrete; reinforcement rods, not of metal; structural reinforcement (non-metallic -) for construction purposes; reinforcing materials, not of metal, for building; non-metallic mouldings; structural reinforcement (non-metallic-) for construction purposes; expansion joints of non-metallic materials for use in building; small items of non metallic hardware used in building and construction; concrete forms; concrete columns; concrete ground beams; screeds; flooring screeds; screed supports; crack inducers and void formers for use in forming concrete’, which Mr Murphy stated were not similar to the opponent’s goods. It is my understanding that these are all non-metallic building materials of varying types and are, therefore, identical to the opponent’s ‘building materials (non-metallic)’.

### **The applicant’s services in class 37**

41. Mr Murphy stated at the hearing that with the exception of ‘building construction’ and ‘repair of concrete and concrete structures’, there is no similarity between the applicant’s services and those contained in the specification of the opponent’s earlier registration which stands registered for building construction, repair and installation services at large.

42. The terms identified by Mr Murphy as similar are identical services to those of the opponent. The remaining services are either building construction services or in the case of ‘masonry services’ and ‘grout reinforcement for bridges, dams, foundations, gas platforms, oil platforms, mines and tunnels’ may be services used for construction or repair. Consequently, all of these services are identical to those of the opponent.

43. Having found the applicant's goods and services to be identical to the opponent's goods and services in the same classes, I will not go on to consider the remainder of the opponent's specification which cannot advance the opponent's position.


### Comparison of marks

44. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

45. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

46. The marks to be compared are as follows:

Opponent's mark	Applicant's mark
ALDI	

47. The opponent's mark consists of a single element, the word ALDI with no form of stylisation and presented in block capitals. Consequently, the overall impression is based solely on this word.

48. The applicant's mark comprises a heavily stylised number of letters, which clearly begin with the capital letter 'A'. It is shown in blue with the colour gradually darkening to the right of the mark, the whole of which is outlined in grey. With regard to the overall impression of its mark the applicant suggests a number of possibilities:

*“...the Applicant's Mark is so figurative and stylised with the various letters being merged so heavily and seamlessly that it could be interpreted as either AUTI-, AUI-, AUN ALN—, AUNI-. or ALTI-*

*... the use of a hyphen at the end of a free-standing word is unheard of in accepted English language. As such the hyphen at the end of the Applicant's Mark immediately attracts the eye of the average consumer and forms a*

*dominant and highly distinctive part of the Applicant's Mark due to its highly unusual position at the complete end of one word rather than in the middle of two words."*

49. The opponent accepts that there are a number of interpretations but concludes that following scrutiny of the mark it would be seen as ALTI-. It says:

*"(i)...the Opponent concedes the Applicant's statement that the stylisation of the Applicant's mark renders it open to a variety of interpretations. However, that said, the Opponent submits that this would only be temporary and after any initial uncertainty as to its pronunciation, the average consumer would penetrate the letters behind their stylised merged appearance and interpret the Applicant's mark correctly as ALTI-.*

*...*

*(iii) Regarding the metallic edging and coloured shading on the Applicant's mark, the Opponent maintains that these elements are not sufficient either in themselves or in combination with the word ALTI- to overcome the overriding impression created by the dominant and distinctive element of the Applicant's mark, which is the word ALTI-, which is confusingly similar to the Opponent's mark ALDI.*

50. I accept that there are numerous ways in which the applicant's mark may be interpreted. The joining of letters in the mark is not negligible and nor is the dash to the right of the mark. Even though the 'A' is clearly visible, the joining of 'L' to 'T' creates a striking shape which is certainly noticeable within the mark as a whole. The gradual blue shading and grey outline is unlikely to be given any trade mark significance, if it is noticed at all. The presentation of the mark results in a degree of effort being required in order to 'decode' it. In my view, some average consumers will see the word as 'ALTI', the stylisation of which contributes equally in terms of relative weight in the overall impression of the mark.

### **Visual similarities**

51. The opponent submits:

*"(i) Regarding the respective marks themselves, the Opponent's mark ALDI is visually and phonetically very similar to the Applicant's mark ALTI-, since both consist of four letters and only differ in their third letters, namely 'D' and 'T' respectively.*

*(ii) The Opponent also duly notes the presence of the hyphen at the end of the Applicant's mark. However, the Opponent disagrees that the presence of the hyphen in the Applicant's mark ALTI- constitutes such a departure from proper and accepted grammatical usage that it forms a dominant and highly distinctive part of the Applicant's mark. The Opponent submits that in any case, such fine points of grammar would be lost on the average consumer.*

*In any event, the Opponent submits that the presence of the hyphen at the end of the Applicant's mark ALTI- in no way detracts from the overall visual and phonetic/aural similarities between the Opponent's mark ALDI and the Applicant's mark ALTI-."*



52. The applicant states that the comparison to be made is between its stylised mark and the opponent's word mark ALDI and not simply the plain words ALTI- v ALTI. It points to the shading and 'metallic' edging around the mark as well as the fact that the marks are short so that small differences have a more significant impact than is the case with longer marks. It also submits:

*"If the Applicant's Mark is interpreted as ALTI- the marks are still visually dissimilar, as...the Applicant's Mark is so highly stylised with the letters being merged so heavily that it takes on a character of its own above and beyond the mere letters that comprise it...the presence of the hyphen turns the mark as a whole into an unpartnered prefix. When used a hyphen is always used to link two words together, a hyphen is never used at the end of one word without a word immediately following it, unless in the form of a list where multiple prefixes are used.*

*...the marks must be regarded as a whole. The sum of the intractable merging of the letters, the hyphen, the overall prefix nature of the mark, the metallic surround, the shading across the mark and the very short length of both marks, all together make the marks visually dissimilar overall when regarded as a whole."*

53. Any visual similarity between the marks rests in the fact that each begins with the letter 'A'. The high point of visual similarity occurs where the applicant's mark is seen as 'ALTI'. In these circumstances the marks are both four letter marks with three letters in common, namely the first two, 'AL' and the last letter 'I', though the presentation of these letters is very different.

54. There are a number of obvious differences between the marks such as the addition of a hyphen at the end of the applicants mark, the conjoining of letters and the fact that the third letters are different, being 'D' in the opponent's mark and 'T' in the applicant's.

55. With regard to the differences in colour and typeface, it is clear from cases such as *Sadas*<sup>8</sup> and *Peek & Cloppenburg v OHIM*<sup>9</sup> that normal and fair use of a word trade mark includes use in a range of fonts and cases. However, the applicant's mark, even when drained of colour possesses a considerable degree of stylisation which results in the average consumer needing to give it some consideration in order to arrive at the letters ALTI- and goes beyond the presentation of a word in a standard typeface.

56. Taking all of these factors into account the marks are visually similar to a low degree.

### **Aural similarities**

57. The opponent states the following:

"(iv) On conducting an aural comparison of the Opponent's and Applicant's marks, the letters 'D' in ALDI and the letter 'T' in ALTI- are both known phonetically as 'alveolar stops'. These are consonantal sounds made with the tongue contacting the alveolar ridge located behind the teeth, and held tightly to block the passage of air.

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<sup>8</sup> *Sadas SA v OHIM, T-346/04*

<sup>9</sup> *T-386/07*

Therefore, from an aural/phonetic perspective, the letter 'T' in the Applicant's mark ALTI- may be easily mispronounced or misheard as the letter 'D' in the Opponent's mark ALDI."

58. The applicant submits:

"7. On an aural level both marks are very short with only two syllables, so that even if the mark was interpreted as ALTI- the obvious difference between the "D" and the supposed "T" in the marks would be noticeable to the average consumer, making the marks only weakly aurally similar at best."

59. Both marks begin with the letter 'A' and are short marks. Where the applicant's mark is seen as ALTI, it will be pronounced 'AL-TEA', this is aurally highly similar to the opponent's earlier mark 'AL-DEE'.

### **Conceptual similarities**

60. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>10</sup> The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.<sup>11</sup>

61. In respect of this comparison the opponent submits:

*"(v) When making a conceptual comparison of the marks, as confirmed in the Witness Statement of Mr Oliver Pollhammer, the mark ALDI has no conceptual meaning..."*

*The Opponent accepts that the Applicant's mark ALTI- has a conceptual meaning to indicate height, as set out in some examples mentioned in the Applicant's submissions, such as ALTIMETER and ALTITUDE. However, the Opponent submits that the prefix ALTI- only ever assumes this conceptual meaning when used in combination with another word, as indicated by the hyphen attached to the end of the word.*

*The Opponent disagrees with the Applicant's assertion that the prefix ALTI- is so well known by the average consumer that he would immediately think of an unpartnered prefix that brings to mind the concept of height or altitude.*

*On the contrary, the Opponent submits that since the Applicant's mark ALTI- has no conceptual meaning unless used in combination with another word, which it clearly is not in the Applicant's mark. Therefore, the Applicant's mark loses any conceptual significance it might have when used alone, albeit with a hyphen, when considered by the average consumer of the relevant goods and services."*

62. The applicant comments in submissions and at the hearing that the opponent concedes the word ALTI- is used as a prefix to indicate height or altitude. It submits:

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<sup>10</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.

<sup>11</sup> See the comments of Anna Carboni, sitting as the Appointed Person in *Cherokee*, BL O-048-08, paragraphs 36 and 37.

*“9. In the event that the Applicant’s Mark is interpreted to be ALTI- it has a clear and specific meaning, as ALTI- is used as a prefix in many words to indicate height, as it derives from the Latin word ALTI- which is the combining form indicating height or altitude. Hence it’s use in many well-known words, including ALTIMETER, ALTITUDE, ALTITUDE SICKNESS and ALTIPLANO. The meaning of ALTI- is also conceded by the Opponents in their submissions, where they state that “...the word ALTI- is used as a prefix to indicate height or altitude...”*

*10. Shortened versions of words are commonly interpreted to mean the longer versions of the word, for instance, ECO- is interpreted as ECOLOGICAL and ECONOMICAL, MULTI is interpreted to meaning more than one and “multiple” and PAN- is interpreted to mean ‘all inclusive’. Just as the word ALTI- is interpreted to mean “height” or “altitude” or at least bring them to mind.*

*12. ALTI- has a direct and clear meaning of height and altitude in its own right, as a prefix derived from the Latin word ALTI- which is a combining form used in the formation of compound words. Furthermore, given that the average consumer in this case is a highly educated and/or experienced professional in the building industry paying a high level of attention, they would be very familiar with working in dimensions and measurements and therefore be immediately familiar with the meaning of ALIT- which would bring to mind height and altitude, Therefore, when regarded as a whole, the Applicant’s Mark is a highly unusual unpartnered prefix that immediately brings to mind height and altitude. Therefore, there is a clear conceptual difference between the marks, where the Opponent’s Mark brings to mind either nothing or budget supermarket services, and the Applicant’s mark is a highly unusual unpartnered prefix that clearly and specifically brings to mind height and altitude.”*

63. The average consumer of the goods and services at issue will include specialist purchasers of the type identified by the applicant, but will also include (for certain of the goods and services) members of the public undertaking DIY projects. With regard to the applicant’s comments concerning the status of ALTI- as a prefix, in the absence of evidence to the contrary, I am not able to conclude that ALTI- is a word commonly used in isolation or to represent a longer word, as is the case with the applicant’s example, ECO. Whilst I am aware that it is used to indicate height, as part of a longer word, I am unable to conclude that the average consumer would be aware of such a meaning.

64. The opponent’s mark has no conceptual meaning being an invented word. The applicant’s mark may not be seen as ALTI- at all so for them there is neither conceptual similarity nor dissimilarity. Even for those that see the word ALTI-, my finding that this will not be perceived as a reference to the word altitude means that, likewise, the marks are conceptually neutral.

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

65. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify its goods 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.

66. As I have concluded above, the opponent's mark will be seen as an invented word by the average consumer. Consequently, it is neither descriptive nor elusive of the goods and services at issue and enjoys a high level of inherent distinctive character. The evidence filed by the opponent only refers to its reputation with regard to supermarkets and accordingly is not relevant for an assessment of enhanced distinctive character for the goods and services the subject of these proceedings.

### **Likelihood of confusion**

67. 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>12</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.

68. I have found the parties' marks to be visually similar to a low degree, aurally similar to a high degree and conceptually neutral. I have found the earlier mark to have a high degree of inherent distinctive character for the opponent's goods and services. I have identified the average consumer, namely a professional or a member of the general public and have concluded that the degree of attention paid is likely to be at least reasonable. I have found the parties' goods and services to be identical.

69. Taking all of these factors into account, the applicant's mark in its totality is visually striking in a way that is not common to the earlier mark. The differences between the parties' respective marks are such that, even where the goods are identical, demand a reasonable level of attention to be paid and the earlier mark has a high level of inherent distinctive character; the marks in their totality are sufficiently different that there is no likelihood of direct confusion (where one mark is mistaken for the other) or indirect (where the average consumer believes the respective goods originate from the same or a linked undertaking).

70. I find this to be the case even where the average consumer sees the applicant's mark as ALTI-. The differences in spelling between ALTI- and ALDI, coupled with the highly stylised nature of the mark applied for means that there is no likelihood of confusion.

### **CONCLUSION**

**71. The opposition fails under section 5(2)(b) of the act.**

### **COSTS**

72. The opposition having failed, the applicant is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement	£300
Considering and commenting on the other sides' evidence	£300

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<sup>12</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

Preparation and filing of written submissions	£200
Preparation for and attendance at a hearing	£500
Total:	£1300

73. I order Aldi GmbH & Co KG to pay SIG Trading Limited the sum of £1300. 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 20th day of February 2015**

**Ms Al Skilton  
For the Registrar,  
The Comptroller-General**