

O-142-15

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NO. 3040044
BY CONSTRUCTION MATERIALS ONLINE LIMITED
TO REGISTER THE TRADE MARK**



IN CLASS 35

AND

**THE OPPOSITION THERETO UNDER NO. 402382
BY SIG TRADING LIMITED**

Background and pleadings

1. Construction Materials Online Limited (“the applicant”) applied for the trade mark shown below on 30 January 2014, for a range of retail services relating to drainage goods, and safety clothing and equipment, in class 35:



2. The application was published on 28 March 2014. It was subsequently opposed by SIG Trading Limited (“the opponent”) on the basis that there is a likelihood of confusion, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent’s earlier trade mark (number 2506755, for a series of four marks) shown below, which is registered for various goods and retail services in classes 6, 19 and 35, all relating to drainage:



3. The opponent’s mark has an earlier filing date of 20 January 2009 and it was registered on 15 May 2009. As the mark had not been registered for five years or more at the date on which the applicant’s mark was published, the opponent is not required to make a statement that it has used its mark on all, or any, of the goods and services for which it is registered¹. As a consequence, the opponent can rely upon all of its registered goods and services.

4. Whilst admitting that, with some exceptions, the parties’ goods and services are identical or similar, the applicant denies that the marks are similar. The applicant denies that there is a likelihood of confusion between the marks.

5. Both sides filed evidence and written submissions and the matter came to be heard by me via video conference on 23 March 2015. Ms Katy Adams, of Groom Wilkes & Wright LLP, represented the opponent. Mr Carl Steele, of Ashfords LLP, represented the applicant.

¹ Section 6A of the Act refers.

Evidence

6. The applicant's evidence comes from Daniel Cahill, who is a trade marks paralegal at the applicant's firm of trade mark attorneys. Mr Cahill conducted an internet search on 13 November 2014 for businesses offering the same services as the applicant and which start with, or incorporate, the words drainage or drain in their trade names, trade marks or trading styles. The results are exhibited as DC1. The purpose of the evidence is to show that average UK consumers are used to several businesses using such words, sometimes with devices of pipes, and that consumers easily differentiate between them:

The logo for 'DRAINAGE SALES' features the word 'DRAINAGE' in a bold, blue, sans-serif font. The letter 'I' in 'DRAINAGE' is replaced by a stylized orange pipe with a vertical section on top. Below 'DRAINAGE', the word 'SALES' is written in a bold, orange, sans-serif font.The logo for 'DRAINAGE online.co.uk' consists of the word 'DRAINAGE' in a white, bold, sans-serif font on a dark blue rectangular background. Below the text is a white graphic of a teardrop shape. Underneath the teardrop, the text 'online.co.uk' is written in a smaller, white, sans-serif font.The logo for 'UK DRAINAGE DIRECT' features a dark blue horizontal bar. On the left is a white icon of a pipe with a circular joint. To the right of the icon, the words 'UK DRAINAGE DIRECT' are written in a large, white, bold, sans-serif font. Below this, the tagline 'The Drainage Products You Need at the Prices You Want' is written in a smaller, white, sans-serif font.The logo for 'Drainstore.com' features the text 'Drainstore.com' in a bold, black, sans-serif font. A black line representing a pipe starts above the 'e' in 'store', goes right, then curves down and ends in a small blue teardrop shape.

7. The opponent's evidence comes from Ms Katy Adams (from the opponent's firm of trade mark attorneys). Ms Adam's evidence was filed in reply to Mr Cahill's witness statement. She also conducted an internet search (on 12 January 2015) for the words "DRAINAGE WAREHOUSE", and exhibits a screen shot of the results page, which places the opponent, with the words Drainage Warehouse, as the first result.

Decision

8. Section 5(2)(b) of the Act states that:

“(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.”

9. 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.

Comparison of goods and services

10. The parties' specifications are shown in the table below:

Earlier mark	Application
<p>Class 6: <i>Metallic drainage boards, channels, courses, installations, plates, pipes and profiles; metallic drainage systems and apparatus; metallic drainage products for use in building and road construction, metallic rain water drainage apparatus; parts and fittings for all the aforesaid goods.</i></p> <p>Class 19: <i>Non-metallic drainage boards, channels, courses, installations, plates, pipes and profiles; non-metallic drainage systems and apparatus; non-metallic drainage products for use in building and construction, non-metallic rain water drainage apparatus; parts and fittings for all the aforesaid goods.</i></p> <p>Class 35: <i>Retail services connected with the sale of drainage products and systems; retail services connected with</i></p>	<p>Class 35: <i>The bringing together, for the benefit of others, of a variety of goods, namely drainage pipes of metal and non-metal, drainage channels of metal and non-metal, drain gullies of metal and non-metal, drain covers of metal and non metal, drains of metal and non metal, drainage courses of metal and non-metal, inspection chambers of metal and non-metal, ducting installations (non-electric) of metal and non-metal, guttering of metal and non-metal, sewer pipes of metal and non-metal, water pipes of metal and non-metal, soil vents of metal and non-metal, gas pipes of metal and non-metal, manhole covers of metal and non-metal, sluices of metal and non-metal, floor drains of metal and non-metal, rainwater drainage apparatus, drainage installations (non-metallic), non-metallic pipes for roof drainage</i></p>

the sale of goods from an Internet website all relating to drainage products and systems; retail services connected with the sale of goods from a catalogue by mail order all relating to drainage products and systems; retail services connected with the sale of goods by means of telecommunications all relating to drainage products and systems; advisory, consultancy and information services relating to all the aforesaid.

installations, drainage plates of metal, drain traps of metal and non-metal, protective work clothing and eyewear, safety equipment, enabling customers to conveniently view and purchase those goods by means of telecommunications or from an internet website; retail services in connection with drainage pipes of metal and non-metal, drainage channels of metal and non-metal, drain gullies of metal and non-metal, drain covers of metal and non metal, drains of metal and non metal, drainage courses of metal and non-metal, inspection chambers of metal and non-metal, ducting installations (non-electric) of metal and non-metal, guttering of metal and non-metal, sewer pipes of metal and non-metal, water pipes of metal and non-metal, soil vents of metal and non-metal, gas pipes of metal and non-metal, manhole covers of metal and non-metal, sluices of metal and non-metal, floor drains of metal and non-metal, rainwater drainage apparatus, drainage installations (non-metallic), non-metallic pipes for roof drainage installations, drainage plates of metal, drain traps of metal and non-metal, protective work clothing and eyewear and safety equipment.

11. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

12. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“Treat”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

13. 'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

"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..."

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, sitting as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

"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."

Whilst on the other hand:

".....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.

14. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... 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."

15. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"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 meanings attributable to the rather general phrase.”

16. The applicant accepts that the parties’ goods and services are similar or identical, with the exception of the following in its specification, for which the applicant claims there is no similarity:

The bringing together, for the benefit of others, of a variety of goods, namely gas pipes of metal and non-metal, protective work clothing and eyewear, safety equipment.

Retail services in connection with gas pipes of metal and non-metal, protective work clothing and eyewear and safety equipment.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-33/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

With the exception of the applicant’s *the bringing together, for the benefit of others, of a variety of goods, namely gas pipes of metal and non-metal, protective work clothing and eyewear, safety equipment; retail services in connection with gas pipes of metal and non-metal, protective work clothing and eyewear and safety equipment*, the parties’ services are clearly identical, as admitted by the applicant.

18. The opponent maintains that it has cover for pipes in classes 6 and 19 and that the retail of gas pipes is similar to its pipes in classes 6 and 19. The opponent does not have cover for pipes at large: its specification is constructed so that pipes are qualified by the words “Metallic drainage...” (class 6) and “Non-metallic drainage...” (class 19). The comparison is therefore between the opponent’s metallic and non-metallic drainage pipes and the applicant’s bringing together/retailing of metal and non metal gas pipes.

19. The opponent also claims that the retail of protective clothing, eyewear and safety equipment would be considered similar because the average consumer would expect to wear such goods whilst using goods in classes 6 and 19, and would look to purchase protective clothing, eyewear and safety equipment in the same place as the class 6 and 19 goods.

20. The issue of similarity between retail services and goods was considered by the GC in *Oakley, Inc v OHIM*, Case T-116/06. The court’s judgment in this cancellation action dealt with the similarity between goods and a retail services specification which was both unrestricted and restricted in scope. The conflict was between an earlier mark which was registered for goods in classes 18 and 25 and a later mark

which had been registered for “Retail and wholesale services, including on-line retail store services; retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets’. The Court said:

“49 Contrary to what is claimed by the applicant, the fact that the retail services are provided at the same sales points as the goods is a relevant criterion for the purposes of the examination of the similarity between the services and goods concerned. In that regard, it should be pointed out that the Court has held, in paragraph 23 of Canon, paragraph 16 above, that, in assessing the similarity of the goods and services in question, all the relevant factors characterising the relationship between the goods or services should be taken into account. It stated that those factors include their nature, purpose, method of use, and whether they are in competition with each other or are complementary, meaning that it did not in any way regard those factors are the only ones which may be taken into account, their enumeration being merely illustrative. The Court of First Instance therefore concluded from this that other factors relevant to the characterisation of the relationship which may exist between the goods or services in question may also be taken into account, such as the channels of distribution of the goods concerned (Case T-443/05 *El Corte Inglés v OHIM– Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR II-0000, paragraph 37; see also, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 65, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; and Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PUVIAL)* [2007] ECR II-757, paragraph 95).

50 Furthermore, contrary to the applicant’s assertion, which is moreover unsubstantiated, that, as the majority of the goods are sold in supermarkets, consumers do not attach too much importance to the point of sale when making up their mind whether goods share a common origin, it must be held that, as contended by OHIM, the manufacturers of the goods in question often have their own sales outlets for their goods or resort to distribution agreements which authorise the provider of the retail services to use the same mark as that affixed to the goods sold.

51 It was therefore correct, in paragraph 22 of the contested decision, to take into account, when comparing the goods and the services covered by the trade marks in dispute, the fact that those goods and services are generally sold in the same sales outlets (see, in that regard, *SISSI ROSSI*, paragraph 49 above, paragraph 68, and *PiraÑAM diseño original Juan Bolaños*, paragraph 49 above, paragraph 37).

...

54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As

the Court held in paragraph 34 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.

55 Furthermore, the relationship between the goods covered by the earlier trade mark and the services provided in connection with retail trade in respect of goods identical to those covered by the earlier trade mark is also characterised by the fact that those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.

56 It follows that, because the services provided in connection with retail trade, which concern, as in the present case, goods identical to those covered by the earlier mark, are closely connected to those goods, the relationship between those services and those goods is complementary within the meaning of paragraphs 54 and 55 above. Those services cannot therefore be regarded, as the applicant claims, as being auxiliary or ancillary to the goods in question.

...

62 It follows from all of the foregoing that the Board of Appeal was right to consider that services consisting of ‘retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets’, and ‘retail and wholesale services, including on-line retail store services’, are similar to the goods covered by the earlier trade mark.”

21. In *Major League Baseball Properties, Inc v Giant UK Limited* (“*Giant*”), BL O/264/14, Ms Anna Carboni, sitting as the Appointed Person, considered *Oakley* in the context of a case involving the comparison of the retailing of bicycles against clothes. She said:

“30. Mr Onslow submitted that these paragraphs were predicated on identity between the goods of the earlier mark and the goods covered by the retail services of the later mark and that paragraph 49, in particular, is *obiter* and wrong, or is limited to cases of identical goods. While it is true that this was the scenario facing the General Court, there is nothing in the *Oakley* decision that persuades me that it is wrong to consider the channels of distribution and sales outlets through which the relevant goods and services are provided in the absence of identity. Indeed, the authorities cited in paragraph 49 of *Oakley* do not all involve identity. Further, as Mr Gymer pointed out, and as set out in *Oakley* itself, the CJEU in *Canon* and subsequent cases has made it clear that, in assessing the similarity of the goods and services in question, all the relevant factors characterising the relationship between the goods or services should be taken into account.

31. Having said this, in the modern age of retail stores, particularly on-line retailers, that sell almost anything one can envisage wanting to buy, trade mark tribunals have to be careful not to give undue weight to the existence of an overlap in the channels of distribution and sales outlets, particularly in the absence of any specific evidence on the point.

...

33. I accept Mr Gymer's submissions and the hearing officer's finding of a potential overlap between the retail outlets for clothing covered by the Earlier Mark (particularly a sub-set comprising clothing for cycling) and those through which retail services for bicycles and bicycle accessories are provided, and I reject Mr Onslow's submission that this overlap is irrelevant. However, I consider that this is only a weak indicator of overall similarity in the light of the obvious differences between goods and retail services highlighted above.

...

44. I reject Mr Onslow's suggestion that complementarity can only be found where there is identity of goods with the subject goods of retail services, and only in those circumstances can the relevant goods and retail services be found to be similar. In my view, it must be a question of fact to be assessed in each case, as the Courts have done in countless cases, including the General Court in *Oakley* itself.

...

54. So far as complementarity is concerned, the hearing officer did not find this to exist between clothing and retail services for bicycles and bicycle accessories. So the only feature of similarity that he found was "the potentially common retail environment". Here, I go back to my earlier comments about the need for care when considering overlaps in distribution channels and sales outlets, due to the possibility of finding all sorts of otherwise quite different products and services being provided in one place. When it is possible to find products and services together, it is worth delving a bit deeper and considering, for example, whether they are usually purchased together or whether one is needed for the use of the other. In this case, as Mr Onslow submitted, the purchase of cycle clothing is not indispensable or important to the purchase of a bicycle; their purchase is optional. While of course clothing is generally necessary to be worn when bicycling, it is not necessary to buy clothes at the same time or through the same outlets as the bicycle, and in any event the same could be said for virtually any other activity. The connection between the two is therefore at a very general level.

55. In my assessment, the fact that cycle clothing covered by the Earlier Mark might be offered through the same outlet as retail services for bicycles and bicycle accessories, whether specialist or more general outlets, cannot be

enough to reach an overall finding of similarity in circumstances where the other *Canon* factors point quite strongly in the other direction (in the case of nature, purpose and method of use) or are absent (in the case of competitiveness or complementarity). While the requirement of similarity of goods/services – just like that of similarity of marks – is not a high one, the bar must not be set at an unduly low level.”

22. In *Tony Van Gulck v Wasabi Frog Ltd* (“*Miss Boo*”), BL O/391/14, Mr Geoffrey Hobbs, sitting as the Appointed Person, cautioned that “selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35”. The objective of retail services, as set out in *Oakley*, “includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction” and “those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.”

23. The opponent bases its claim of similarity between its class 6 and 19 goods and the applicant’s retail services for protective work clothing, eyewear and safety equipment upon shared channels of trade; i.e. that the average consumer would expect to find the goods which are the subject of the retail service in the same place as the class 6 and 19 goods. Yet, applying *Oakley*, *Giant* and *Miss Boo*, it is difficult to see how there can be any similarity between activity carried out by the retailer to encourage the sale of protective work clothing, eyewear and safety equipment, and drainage goods in classes 6 and 19. They do not share nature, intended purpose or method of use, and neither is indispensable for the other. Nor are they in competition. It is possible that an outlet offering the specified retail services might sell drainage goods. However, the opponent’s argument does not really get off the ground: in *Giant*, an overlap in trade channels was considered to be only a weak indicator of similarity when all other points of the *Canon* test pointed the other way, as they do in this case. I find that there is no similarity between the applicant’s *the bringing together, for the benefit of others, of a variety of goods, namely protective work clothing and eyewear, safety equipment; retail services in connection with protective work clothing and eyewear and safety equipment*, and any of the opponent’s goods in classes 6 and 19, which is the basis of its claim of similarity as set out in the skeleton argument and at the hearing. For the avoidance of doubt, since the original pleadings relied upon all the opponent’s goods and services, I also find that there is no similarity between the applicant’s services listed in the preceding sentence and the opponent’s services.

24. This leaves the opponent’s claim that its metallic drainage pipes in class 6 and its non-metallic drainage pipes in class 19 are similar to the applicant’s services for *the bringing together, for the benefit of others, of a variety of goods, namely gas pipes of metal and non-metal; retail services in connection with gas pipes of metal and non-metal*. This is how the opponent characterised its perception of similarity in its skeleton argument and at the hearing, although the original pleadings relied upon all of the opponent’s goods and services. The opponent’s argument boils down to ‘pipes are pipes’, whether for gas or drainage. It is correct that drainage pipes and gas pipes share nature, at a general level, for they are both pipes. However, similarity stops there. They do not share the same purpose or method of use. In

fact, they are likely to be quite different in terms of technical specification, since one is for carrying water and the other a highly flammable substance. This means that they are not complementary, are not in competition, and the channels of trade will be different. With all the *Canon* factors pointing away from similarity, with the possible exception of nature, the differences are amplified when one considers that the comparison is between drainage pipes and retail of gas pipes. Here there is no shared nature. I find that there is no similarity between the opponent's drainage pipes in classes 6 and 19, and the applicant's services. I also find no similarity in relation to the parties' retail services (for drainage goods versus for gas pipes), for the reasons set out above; although the opponent's case, when it came to its skeleton and at the hearing, appeared to centre upon a comparison between the applicant's services and the opponent's drainage pipes, not its services.

Average consumer

25. 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*.

26. Mr Steele submitted that the average consumer is a legal construct, not a real person. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

27. The average consumer will be both members of the public and the trade (e.g. plumbers, builders and road engineers). Some of the goods will be more expensive and require more careful attention to purchase than others. For example, replacing manhole covers or sluices is likely to be the result of a considered public sector procurement exercise, whereas the attention paid to the purchase of a downpipe or a piece of guttering will be the subject of less scrutiny. However, it is important to note that, in addition to goods in classes 6 and 19, both parties have cover for retail services. These should not be conflated with the goods themselves. Although the goods may be subject to scrutiny, I consider that the selection of a retail service for the goods will come under less scrutiny than the goods themselves.

28. The evidence shows that the goods and services are typically the subject of a visual purchase via websites, but there is obvious potential for online sales to be mirrored by sales from physical retail premises too. Although primarily, therefore, a visual purchase, I do not ignore the possibility of oral use of the marks during the

purchasing process, such as those in trade giving instructions to staff to make purchases for use during a construction project.

Comparison of marks

29. 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 Court of Justice of the European Union 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.”

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.

30. The respective marks are:

Opponent	Applicant
	

31. Both marks are complex, consisting of a number of elements, both words and devices, with colour, and of various levels of shading. Given the size and emboldening of the word Drainage in the opponent’s mark in comparison to the smaller words ‘The’ and ‘Warehouse’, and the extension from the right of the pipe device over the second half of the word Drainage, the overall impression of the opponent’s mark is dominated by the word Drainage and the pipe device. The rectangle in the third and fourth marks in the series will, if noticed at all, assume a subordinate background role. The word ‘Drainage’ in the applicant’s mark is both coloured and bolder than the word ‘Superstore’. Further, the pipe device covers the second half of the word Drainage, drawing the eye to this part of the mark. The overall impression of the applicant’s mark is also dominated by the word Drainage and a pipe device extending over half of the word, from the right.

32. There are visual differences between the marks in the arrangement of the descriptive/non-distinctive words 'The', 'Warehouse' and 'Superstore'. The pipes are also different. Having said that, the pipes in both parties' marks extend over the second half of the word Drainage and both use the dot over the letter 'i' to form a water droplet. This makes for a level of visual similarity which I put at medium. In the case of the first mark in the series, in which the word Drainage appears in blue, as it does in the application, the level of visual similarity is increased, though not to a great extent.

33. The pipes will not form part of the aural perception of the marks, so the comparison is between The Drainage Warehouse and Drainage Superstore. The aural similarity between the marks is also at a medium level.

34. There is a high level of conceptual similarity between the marks. They both share the identical meaning of a warehouse or superstore for drainage products and both incorporate a pipe from the right which has turned the dot over the letter 'i' into a water droplet.

Distinctive character of the earlier marks

35. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*² the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

36. There is no evidence to show that the opponent's mark can claim an enhanced level of distinctiveness. The descriptive phrase “The Drainage Warehouse” does not give the mark distinctive character (nor does the opponent claim as such) for drainage goods and services. The distinctive character of the earlier mark lies in the combination of the elements of which it is composed; that is to say, the arbitrary

² Case C-342/97.

arrangement of the pipe extending over the word Drainage, so that the dot of the ‘i’ forms a water droplet falling from the mouth of the pipe. Despite this, given the descriptiveness of the words, the level of inherent distinctive character is low to average.

Likelihood of confusion

37. A lesser degree of similarity between goods or services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). However, where there is no similarity between the goods or services, there can be no likelihood of confusion, as per *Canon*. The opposition therefore fails in respect of *the bringing together, for the benefit of others, of a variety of goods, namely gas pipes of metal and non-metal, protective work clothing and eyewear, safety equipment; retail services in connection with gas pipes of metal and non-metal, protective work clothing and eyewear and safety equipment.*

38. Deciding whether there is a likelihood of confusion is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). Apart from the applicant’s services for which I have found no likelihood of confusion, in paragraph 37, all the other services of the application are identical to the services of the earlier mark.

39. The applicant points out that the words in the earlier mark are non-distinctive and relies upon the decision of Mr Iain Purvis QC, sitting as the Appointed Person in *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, in which it is explained that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. Mr Purvis said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

40. Mr Steele urged me not to find a likelihood of confusion on the basis of the convergence of descriptive words in both marks. I agree that this would not be a sound basis upon which to do so, recalling the words of Jacob LJ in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40:

“83 Finally, although I agree with the judge's questioning of the Court's proposition of fact that “there is a greater likelihood of confusion with very distinctive marks” there is some truth with the opposite proposition. The Court in Lloyd said:

“23. In determining the distinctive character of a mark, and accordingly in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings.

24. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; ...”

84 The last sentence is an acknowledgement of a fact that has long been recognised: where a mark is largely descriptive “small differences may suffice” to avoid confusion (per Lord Simonds in *Office Cleaning Services v Westminster Window and General Cleaning* (1946) 63 R.P.C. 30 at p.43). This is not a proposition of law but one of fact and is inherent in the nature of the public perception of trade marks.

85 It is worth examining why that factual proposition is so—it is because where you have something largely descriptive the average consumer will recognise that to be so, expect others to use similar descriptive marks and thus be alert for detail which would differentiate one provider from another. Thus in the cited case “Office Cleaning Association” was sufficiently different from “Office Cleaning Services” to avoid passing off.”

41. One might say that The Drainage Warehouse and Drainage Superstore are not very far away from the Office Cleaning Association and Office Cleaning Services example. Mr Steele further submitted that neither should I find a likelihood of confusion on the basis that both marks contain pipe devices; the applicant's evidence showing third-party websites with various logos incorporating pipes is intended to show that consumers are used to seeing different undertakings in the drainage field using such devices. I have reproduced some of those logos from the evidence in paragraph 6 of this decision. They are all very different, as one might expect because there is ample scope for creating different arbitrary arrangements of words and pipe devices.

42. Whilst I appreciate where the applicant is coming from, I must keep in mind the whole mark comparison, because the average consumer perceives trade marks as

wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. Having put everything into the mix, I find that there is a likelihood of confusion. This is not simply on the basis of similar descriptive words, and is not simply on the basis of similar descriptive words and pipe devices. Rather, it is because, for the identical services which attract no higher than an average degree of attention during selection, there is high conceptual similarity and a very similar overall impression created by the words and the extension from the right of a pipe device which uses the dot of the letter 'i' as a water droplet emerging from the mouth of the pipe. This similar overall impression will be all the more similar in relation to the first mark in the series in which the word Drainage is in blue, as it is in the application. For this mark and for all the marks in the series the imperfect picture in the consumer's mind is likely to cause the parties' marks to be mistaken for each other once imperfectly recalled, the conceptual hook for both being the similar overall impression which they convey.

Outcome

43. The opposition partially succeeds:

(i) the application will be registered for *The bringing together, for the benefit of others, of a variety of goods, namely gas pipes of metal and non-metal, protective work clothing and eyewear, safety equipment; retail services in connection with gas pipes of metal and non-metal, protective work clothing and eyewear and safety equipment.*

(ii) the application will be refused for all other services.

Costs

44. The opponent has been partially successful and is entitled to an award of costs, according to the published scale in Tribunal Practice Notice 4/2007. There will be an offset, as a proportion of the applicant's specification, to take account of its failure to oppose successfully some of the services. The breakdown of the award is as follows:

Statutory opposition fee	£100
Filing the opposition and considering the counterstatement	£300
Filing evidence and submissions, and considering the applicant's evidence and submissions	£500
Attendance at hearing	£500
Offset:	- £50
Total	£1350

45. I order Construction Materials Online Limited to pay SIG Trading Limited the sum of £1350 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 2nd day of April 2015

**Judi Pike
For the Registrar,
the Comptroller-General**