O-459-16

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO 3125808

BY DUNDEE OVEN CLEANERS LIMITED

TO REGISTER THE TRADE MARK

IN CLASS 03

AND

OPPOSITION THERETO (UNDER NO. 405541)

BY

THE OVEN GLEAM TEAM LTD

BACKGROUND

1) On 07 September 2015, Dundee Oven Cleaners Limited ('the applicant') applied to register the following trade mark for the goods listed below:

Class 03: Oven Cleaners.

2) The application was published on 25 September 2015 in the Trade Marks Journal and notice of opposition was subsequently filed by The Oven Gleam Team Ltd ('the opponent').

3) The opponent claims that the application offends under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act').[1] It relies upon the UK Trade Mark ('UKTM') shown in the table below:

UKTM details	Goods and services relied upon
UKTM No: 2567421 **OVEN GLEAMERS** **OVENGLEAMERS** (Series of 2 marks)	**Class 03:** Cleaning, washing, wiping, polishing, scouring, and abrasive preparations; bleaching preparations; detergents; soaps; disposable wipes impregnated with chemicals or compounds for household use; oven cleaners and oven cleaning

[1] Other grounds pleaded under sections 3 and 5(3) of the Act were struck out for want of any supporting evidence.

Filing date: 17 December 2010 **Date of entry in the register: 01 April 2011**	preparations. **Class 37:** Oven and barbecue cleaning services; services for the cleaning of hobs, grills and extractor hoods; kitchen cleaning services; rental of oven cleaning apparatus; advisory, consultancy and information services relating to all of the aforesaid services.

4) The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act and, as it had not been registered for five years or more before the publication date of the applicant's mark, it is not subject to the proof of use requirements, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

5) The applicant filed a counterstatement in which it briefly denies the ground of opposition.

6) Neither party filed evidence. Only the applicant filed written submissions. Neither party requested to be heard. I now make this decision on the basis of the papers before me.

DECISION

7) Section 5(2)(b) of the Act states:

> **"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."

8) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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

9) Although the opponent relies upon goods in class 03 and services in class 37 (as shown in the table above), I will base my assessment solely on the goods given that they clearly represent the opponent's strongest case; if the opponent does not succeed on that basis neither would it succeed on the basis of the services. The goods to be compared are:

Opponent's goods	Applicant's goods
Class 03: Cleaning, washing, wiping,	**Class 03:** Oven cleaners.

polishing, scouring, and abrasive preparations; bleaching preparations; detergents; soaps; disposable wipes impregnated with chemicals or compounds for household use; oven cleaners and oven cleaning preparations. (my emphasis)	

10) Both parties' specifications cover 'oven cleaners' which are self-evidently identical.

Average consumer and the purchasing process

11) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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."

12) The average consumer for oven cleaners is the general public. They will be selected off the shelf from supermarkets and other retail premises and so the purchase will be primarily visual. However, the potential for oral use of the mark will not be ignored given that the goods may, for example, be ordered over the telephone. The consumer may take into account factors such as the product's

suitability for purpose, promised results or potential hazardous effects. However, bearing in mind that the goods are, generally speaking, inexpensive and may be purchased reasonably frequently, I would nevertheless expect a low degree of attention to be paid during the purchase.

Comparison of marks

13) 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."

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

14) There is no material difference between the opponent's two earlier marks (which have been registered as a 'series'). For the sake of convenience, I will make my comparison on the basis of the first mark, 'OVEN GLEAMERS' only. Accordingly, the marks to be compared are:

Opponent's marks	Applicant's mark
OVEN GLEAMERS	

15) The opponent's mark consists of the words 'OVEN GLEAMERS' presented in plain block capitals. The two words combine to form a unit with neither materially dominating the other.

16) The applicant's mark readily breaks down into three elements: the first is the phrase 'DUNDEE OVEN CLEANERS', the second is the image of a sparkling clean oven with something reminiscent of a smiley face and the third is the words 'DOMESTIC & COMMERCIAL'. None of the elements, of themselves, are particularly distinctive, if at all. The distinctiveness of the mark lies in the combination of the three elements and the manner in which they are presented. Nevertheless, given the relative prominence of the words 'DUNDEE OVEN CLEANERS' to the other elements, and given that this is the element by which the consumer is likely to refer to the mark, it is those words which have the greatest weight in the overall impression. The image of the oven has slightly less weight and the words 'DOMESTIC & COMMERCIAL' very little weight.

17) Visually, there is clearly similarity between 'OVEN GLEAMERS' and the words 'OVEN CLEANERS' in the applicant's mark. However, given that all other aspects of the applicant's mark are absent from the opponent's mark, I find there to be a low degree of visual similarity when considering the marks overall.

18) From an aural perspective, I would expect the applicant's mark to be referred to solely by the element 'DUNDEE OVEN CLEANERS'. There is a medium degree of similarity between those words and 'OVEN GLEAMERS'.

19) The concept brought to mind by the opponent's mark is of something which cleans ovens to make them gleam (i.e. shine brightly). The main conceptual hook for the consumer in the applicant's mark will come from the non-distinctive, yet prominent, phrase 'DUNDEE OVEN CLEANERS', the meaning of which is self-explanatory. As the general concept of cleaning is common to both marks, there is a good degree of conceptual similarity. However, that this is not a distinctive concept for the goods at issue is something which I will need to bear in mind.

Distinctive character of the earlier mark

20) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 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 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
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> 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)."

As there is no evidence of use before me, I can only take into account the inherent qualities of the opponent's mark. Clearly, the concept portrayed by the mark (of cleaning ovens to make them gleam) is not a particularly distinctive one in relation to the relevant goods. Bearing this in mind, together with the lack of any stylisation or the presence of any other elements which may have served to elevate the mark's distinctiveness, I find that it has a low degree of distinctive character.

Likelihood of confusion

21) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V).*

22) I have found that the marks are aurally similar to a medium degree and visually similar to a low degree; of those two factors, the latter factor is the more important given that the goods are likely to be purchased mainly by the eye. Further, although I have found there to be a good degree of conceptual similarity, this is not a point which assists the opponent given the obvious relevance of that shared concept to the goods at issue. There is also the factor of the earlier mark having only a low degree of distinctive character weighing against the opponent. Bearing all of these factors in mind, I have no hesitation in concluding that there is no likelihood of confusion despite the identity of the goods and the low degree of attention that will likely be paid during the purchase.

23) In reaching this conclusion, I have not overlooked the opponent's arguments in its notice of opposition to the effect that the applicant's mark could be confused with a local Oven Gleamers company i.e. 'DUNDEE OVEN GLEAMERS'. This point does not assist the opponent. The mark before me is 'OVEN GLEAMERS'; it is not 'DUNDEE OVEN GLEAMERS'. I am not able to take into account any matter which forms no part of the marks before me. See, for instance, *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, where Floyd L.J. stated:

> "46. Mr Silverleaf submitted that, in the light of this guidance, the proposition stated by Jacob LJ in *L'Oreal* can no longer be regarded as representing the law. He starts by recognising that acquired distinctiveness of a trade mark has long been required to be taken into account when considering the likelihood of confusion. He goes on to submit that *Specsavers* in the CJEU has made it clear that the acquired distinctiveness to which regard may properly be had included not only matter appearing on the register, but also matter which could only be discerned by use. The colour, on which reliance could be placed in *Specsavers,* was matter extraneous to the mark as it appeared on the register. It followed that if something appears routinely and uniformly in immediate association with the mark when used by the proprietor, it should be taken into account as part of the relevant context.
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> 47. I am unable to accept these submissions. The CJEU's ruling does not go far enough for Mr Silverleaf's purposes. The matter not discernible from the register in *Specsavers* was the colour in which a mark registered in black and white was used. It is true that in one sense the colour in which a mark is used can be described as "extraneous matter", given that the mark is registered in black and white. But at [37] of its judgment the court speaks of colour as affecting "*how the average consumer of the goods at issue perceives <u>that trade mark</u>*" and in [38] of "*the use which has been made of <u>it</u>* [i.e. the trade mark] *in that colour or combination of colours*". By contrast Mr Silverleaf's submission asks us to take into account matter which has been routinely and uniformly used "*in association with the mark*". Nothing in the court's ruling requires one to go that far. The matters on which Mr Silverleaf wishes to rely

are not matters which affect the average consumer's perception of the mark itself."

24) **The opposition fails.**

COSTS

25) As the applicant has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 4/2007, but keeping in mind that the applicant has not incurred the expense of legal representation, I award the applicant £100 for considering the notice of opposition and preparing a counterstatement.

26) I order The Oven Gleam Team Ltd to pay Dundee Oven Cleaners Limited the sum of **£100**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

.**Dated this 30th day of September 2016**

Beverley Hedley
For the Registrar,
the Comptroller-General