

**O-294-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3198271  
BY SPECIALIST BUILDING PRODUCTS LIMITED  
TO REGISTER THE TRADE MARK:**

**OPTIMA**

**IN CLASS 19**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 409239 BY UNLIMITED PERSPECTIVE SA**

## **Background and pleadings**

1. On 23 November 2016, an application was filed to register the trade mark **OPTIMA**. The trade mark was assigned after filing and now stands in the name of Specialist Building Products Limited (“the applicant”). The specification has also been subject to amendment after filing and now reads as follows:

Class 19: Extruded plastic profiles being parts for assembly into external doors, windows and conservatories.

2. The application was published for opposition purposes on 10 February 2017. A notice of opposition was filed on 9 May 2017 by Unlimited Perspective SA (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application.

3. The opponent relies upon its UK trade mark number 3119826 for the following trade mark:

**OPTIMAH!**

The opponent’s trade mark has a filing date of 28 July 2015 and was entered in the Register on 14 October 2016. The mark is registered for the following goods and services, all of which are relied upon:

Class 6: Metal building materials, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods included in this class; door knobs and locks; none of the aforementioned goods being for use in offices.

Class 19: Building materials, non-metallic, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods not included in other

classes; façade claddings; none of the aforementioned goods being for use in offices.

Class 37 Building construction; building repair services; installation and repair of windows, doors, skylights, blinds, shutters, fittings and components for these goods; none of the aforementioned services being provided in offices.

4. Given its date of filing, the opponent's trade mark qualifies as an earlier trade mark under the provisions in s. 6(1) of the Act. As the earlier mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions contained in s. 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified, without demonstrating that the mark has been used.

5. The opponent claims that the marks are visually, aurally and conceptually similar or identical and that the goods and services are identical or similar. There is, it asserts, a likelihood of confusion, including a likelihood of association.

6. The applicant filed a counterstatement in which it accepts that there is a low level of similarity between the marks but denies that the goods applied for are identical to the earlier registration. It puts the opponent to proof of any similarity between the goods. It denies that there is a likelihood of confusion.

7. Both parties filed evidence. A hearing took place before me on 2 May 2018, by telephone conference, at which the applicant was represented by Thomas St Quintin of counsel, instructed by Appleyard Lees IP LLP. The opponent chose not to attend the hearing but filed written submissions in lieu, which I will bear in mind. The opponent has been represented throughout by Boulton Wade Tennant.

## **Evidence**

### Opponent's evidence

8. The opponent's evidence, filed in response to the applicant's evidence, consists of the witness statement of Diogo Oliveira Almeida Alves de Matos, the Director-General of the opponent. There is one accompanying exhibit (DAM1), which consists of prints from [www.profine-group.com](http://www.profine-group.com), said to be "an established international organisation" unconnected to the opponent. It is not itself dated but appears to have been printed on 14 February 2018. Various products are discussed, including "PVC-U profiles for windows and doors".

### Applicant's evidence

9. This consists of the witness statement of Martin Althorpe, the applicant's Technical Director.

10. Mr Althorpe provides in his statement the definition of "optima" from the "online Oxford Dictionary". It is, he states, the plural of "optimum" which is, in turn, defined as "most conducive to a favourable outcome; best" (adjective) or "the most favourable situation or level for growth, reproduction or success" (noun).

11. Mr Althorpe also explains that the applicant sells its products to other businesses, typically window manufacturers, who make up the finished window, which is then sold under another brand to house builders or homeowners. He says the business consumer of his company's products "would measure the window and decide what length of extrusion they need [...] order the extrusion from us and then mitre and weld the extrusion into a window for delivery to the client". The applicant's products are, he says, typically ordered from order pads.

12. That concludes my summary of the evidence, insofar as I consider it necessary.

## Decision

13. The opposition is based upon s. 5(2)(b) of the Act, which reads as follows:

“5. – [...]

(2) A trade mark shall not be registered if because – [...]

(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”.

14. 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 are:

(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**

15. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, 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”.

16. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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 respectively 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. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“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 fur 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”.

18. Registration is sought for “extruded plastic profiles being parts for assembly into external doors, windows and conservatories”. The parties, sensibly in my view, focused on the earlier specification in class 19 for “building materials, non-metallic, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods not included in other classes; none of the aforementioned goods being for use in offices”. The opponent submits that these goods are identical. It states:

“Mr Martin Althorpe [...] states that the Applicant’s goods are welded into windows, which are then sold to consumers (paragraph 4). The Opponent submits, therefore, that on the Applicant’s own evidence, plastic profiles for windows are clearly fittings or components for non-metallic windows.



The Opponent further submits that an extruded plastic profile being a part **for assembly into** a door or conservatory must also be a fitting or component for a door or conservatory since, as described in the Applicant's specification, they are assembled into such goods" [original emphasis].

19. Mr St Quintin submitted that the goods are not similar or, in the alternative, similar only to a low degree. He submitted that the nature of the goods is only similar to the extent that both are solid parts and that the overlap in users does not engage overall similarity. The uses and channels of trade are claimed to be different and the goods are said not to be complementary. Mr St Quintin argues that the applied-for goods are:

"in effect, the raw materials that a manufacturer of windows will cut and fix together to form a plastic window. [...] Conversely, the  *fittings and components for [non-metallic windows and doors]* of the Earlier Mark are fittings (which are manufactured items, such as handles and the like) or are components (which in this context is a synonym for a fitting)".<sup>1</sup>

20. He elaborated on this point at the hearing, submitting that "component" suggests a complete item, such as a handle or a mechanism for opening the door, not a part such as an extruded plastic profile. I am not persuaded by this argument. The *Collins* dictionary provides the following definition of "component": "The components of something are the parts that it is made of".<sup>2</sup> That accords with my own understanding that a "component" is the same as a "part". I note the limitation in the earlier specification, namely "none of the aforementioned goods being for use in offices". Neither party has made reference to this limitation. For reasons which will become apparent, it is not necessary for me to decide whether it is compliant with the principle in *POSTKANTOOR* (Case C-363/99). The applied-for specification is unlimited and therefore includes all types of extruded plastic profile, irrespective of its specific purpose (i.e. for use in offices or not). The applicant's specification is, therefore, identical to

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<sup>1</sup> Skeleton argument, §28.

<sup>2</sup> <https://www.collinsdictionary.com/dictionary/english/component> [accessed 2 May 2018]

“building materials, non-metallic, namely fittings and components for these goods not included in other classes; none of the aforementioned goods being for use in offices”, on the principle outlined in *Meric*. If the limitation were valid, there would still be a high degree of similarity between those goods in the applied-for specification which are for use in offices and those of the earlier specification. Whilst the goods may differ in their specific intended place of use, their more general purpose (providing protection for window and door frames and/or an aesthetic function to the same) would remain identical. They would share nature, users, channels of trade, method of use and, potentially, both a complementary and a competitive relationship.

21. I have not overlooked the evidence of Mr Althorpe regarding the way in which his company’s products reach the market. However, the assessment must be made on the notional use of, in this case, both trade marks, not the specific way in which either trade mark has been, or is intended to be, used.<sup>3</sup> Unless the differences between the goods are evident from the specification, they are not relevant.

22. Given my finding that the goods in class 19 are identical, the opponent’s position would not be any better were I to consider the similarity of its remaining goods and services to the applied-for specification. I decline to do so.

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

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

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<sup>3</sup> On the notional assessment of the earlier specification, see *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22], *Roger Maier v ASOS* [2015] EWCA Civ 220 at [78] and [84]; regarding the applied-for specification, see *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (CJEU), Case C-533/06 at [66].

“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”.

24. Given my findings, above, the relevant average consumer is the consumer of the identical goods in class 19.

25. The opponent has not commented on the identity of the average consumer of the relevant goods. Mr St Quintin submitted that the average consumer will be a manufacturer of plastic windows, as explained in Mr Althorpe’s evidence. He submitted that the consumer is likely to make a careful assessment of the goods, as it may offer, for example, long-term warranties, and that the level of attention paid to the purchase will be high.

26. The goods at issue are components used in manufacturing windows, doors and conservatories. They may also be available as spare parts or for repairs. The goods do not strike me as the type of product which is typically bought by the general public: whilst a DIY enthusiast may purchase and fit windows in their own property, it is more likely that they would purchase ready-made windows than that they would purchase the profiles and glass separately to make their own windows. The average consumer is, therefore, more likely to be a business user, whether a manufacturer of windows or, potentially, a tradesperson such as a window fitter or repairer.

27. The goods may be purchased from a bricks-and-mortar shop, though, given their specific application, it is more likely that they would be purchased from a specialist outlet than from a general store such as a builder’s merchant. They may also be purchased through catalogues or online. These purchases involve primarily visual

considerations. However, as there is the potential for the goods to be ordered by telephone, or perhaps over the counter, without visual inspection of the goods, I also take into account that there may be an important aural element to the purchase.

28. When purchasing the goods at issue, the consumer will be attentive to a number of factors, such as size, style and quality. A tradesperson or manufacturer is also likely to be particularly attentive to considerations such as compatibility with other components, and there may be larger quantities or repeat contracts at issue. The average consumer is likely to pay a reasonably high, though not the very highest, degree of attention to the purchase.

### **Comparison of trade marks**

29. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.


30. 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”.

31. 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 trade

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

32. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark
	OPTIMA

33. The opponent submits that the marks are visually highly similar, and aurally and conceptually identical (or, in the alternative, highly similar). It stresses the importance of the initial part of a trade mark “since it catches the consumer’s attention first”. It accepts the definitions of “optimum” provided by the applicant (i.e. “most conducive to a favourable outcome; best”, or “the most favourable situation or level for growth, reproduction, or success”) and submits that the average consumer will perceive the earlier mark “as a play on the word OPTIMA since OPTIMA is wholly contained within the mark and is easily recognisable therein”.

34. Mr St Quintin submitted that “[the] striking and dominant feature of the Earlier Mark is the final section: “**AH!**””. Among other factors, he points to the different colour, the fact that it is presented in a bold font, that “ah” is a recognisable word and that “the remainder of the Earlier Mark, is just a part of the familiar word “optimum” or “optimal” and is low in distinctive character.<sup>4</sup>

35. The earlier mark is a stylised representation of the word “OPTIMAH”, followed by an exclamation mark. The letters “OPTIM” are presented in capital letters in an unremarkable black typeface. The letters “AH”, along with the exclamation mark, are also presented in capitals but in a bold font, in red. The left hand upright of the letter “H”

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<sup>4</sup> Skeleton argument, §15.

extends higher than the other letters. The overall impression of the mark is dominated by the word “OPTIMAH”. I do not agree with the applicant that the element “AH!” is dominant. Although its bold typeface and distinct colour have a separating effect, the shorter length and position at the end of the mark of “AH!” mean that, whilst it makes a contribution to the overall impression it is to a lesser extent than the word “OPTIMAH” as a whole. The slight stylisation of the letter “H” is unlikely to be noticed and plays a much weaker role.

36. The application consists of the word “OPTIMA”. There are no other elements to contribute to the overall impression, which is contained in the word.

37. There is some visual similarity as the six letters of the application are the same as the first six letters of the earlier mark. There is also a visual difference because of the extra letter “H” and the exclamation mark at the end of the earlier mark, as well as because of the separation of “AH!” in the earlier mark through the use of colour. In relation to the colour aspect, I note that Kitchin LJ stated in *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96]:

“A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours”.<sup>5</sup>

38. This means that the applicant’s mark would be registered in respect of all colours and could be used in any colour, including the red used by the opponent. However, notional use would not extend to contrived colour splits, such as putting the first part of the mark in one colour and the rest in another. Bearing in mind my assessment of the overall impression, the marks are visually similar to a reasonably high degree.

39. Aurally, the application is likely to be pronounced “OP-TI-MA”. The stress is likely to fall on the first syllable. The earlier mark is likely to be pronounced as “OP-TI-MA” or

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<sup>5</sup> See also *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd and Specsavers Optical Superstores Ltd v Asda Stores Ltd and The Registrar Of Trade Marks (Intervening)* [2014] EWCA Civ 1294 at [5].

“OP-TI-MAH”. I have considered Mr St Quintin’s submission for the applicant that the stress in the earlier mark will fall on the final syllable. Whilst some average consumers may pronounce the mark in that way, I do not think it particularly likely. The majority of average consumers are likely to pronounce the words identically or, if the final syllable is slightly lengthened, in a highly similar fashion.

40. As far as the conceptual similarity is concerned, I think it unlikely that the average consumer will know that “optima” is the plural of “optimum”. The use of plural forms ending in “a” is not particularly common and the word “optima” as a noun does not strike me as something in frequent usage. The average consumer is likely to perceive the word as invented, albeit, because of the commonplace use of words such as “optimal”, suggestive of excellence. I consider that broadly the same applies to the earlier mark. Although the average consumer is likely to perceive the whole combination “OPTIMAH!” as being an invented word, the earlier mark is also likely to be seen as alluding to excellence. Mr St Quintin argued that the exclamation “AH!”, in the earlier mark, is used to express “sweet appreciation” of something which is cute. The exclamation may, in my view, be used to express various other things, such as pain, sympathy or relief and is, accordingly, rather vague. I consider that the marks are conceptually similar to a reasonably high degree.

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

41. The distinctive character of the earlier marks must be assessed, as the more distinctive the earlier marks, either inherently or through use, the greater the likelihood of confusion (*Sabel* at [24]). In *Lloyd Schuhfabrik*, 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-2779, 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)".

42. The opponent has not claimed that the earlier mark has an enhanced distinctive character through use and has filed no evidence in this regard. I therefore have only the inherent position to consider. The earlier mark consists of the word "OPTIMAH!" in a somewhat stylised form. Although the word itself is invented, I have indicated, above, that the mark is likely to be suggestive of excellence. I consider that the mark has an average degree of inherent distinctive character.

### **Likelihood of confusion**

43. The factors considered above have a degree of interdependency (*Canon* at [17]) and a global assessment of the competing factors must be made when determining whether there is a likelihood of confusion (*Sabel* at [22]). It is a matter of considering the various factors from the perspective of the average consumer and deciding whether they are likely to be confused. Confusion can be direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods



down to the responsible undertakings being the same or related). In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

44. I remind myself that the goods at issue are identical or highly similar. That is a point in the opponent's favour. Another point in the opponent's favour is that the marks are visually and conceptually similar to a reasonably high degree, and that they are either aurally identical or highly similar. In the applicant's favour is that the average consumer is likely to pay a reasonably high level of attention to the purchase, the consequence of which is that they are less likely to be confused. However, bearing in mind all of the competing factors, including the average level of the distinctive character of the earlier mark, I come to the view that the average consumer, operating under the concept of imperfect recollection, is likely to be directly confused. The reasonably high level of attention, even in the case of goods which are not identical but highly similar, is not sufficient to offset the similarities between the marks. There is a likelihood of confusion.

## **Conclusion**

45. The opposition has succeeded. Subject to appeal, the application will be refused.

## **Costs**

46. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. The evidence filed by both of the parties was very light (consisting of just a few pages), which is reflected in the award below. I award costs to the opponent on the following basis:

Official fee: £100

Preparing the notice of opposition and considering

the counterstatement:	£200
Filing evidence and considering the other party's evidence:	£200
Written submissions:	£300
<b>Total:</b>	<b>£800</b>

47. I order Specialist Building Products Limited to pay Unlimited Perspective SA the sum of **£800**. 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 15th day of May 2018**

**Heather Harrison**  
**For the Registrar**