

O/0125/23

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3652902
BY SHENZHEN PUREMATE TECHNOLOGY CO., LTD
TO REGISTER THE TRADE MARK:**



IN CLASS 11

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 428252
BY BERGER & KRAFT MEDICAL SP. Z O. O.**

Background and pleadings

1. On 8 June 2021, **Shenzhen Puremate Technology Co., Ltd** (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under trade mark number **3652902** (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 20 August 2021. Registration is sought for “disinfectant dispensers for toilets” in class 11.¹

2. On 17 November 2021, **Berger & Kraft Medical Sp. z o. o.** (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods of the application. The opponent relies upon its comparable UK trade mark number **918240116**,² **NPure** (“the earlier mark”) to support its claim. The earlier mark was filed on 14 May 2020 and became registered on 5 September 2020 in respect of the following goods, all of which are relied upon for the purpose of this opposition:

Class 11: Disinfectant apparatus; Sterilization, disinfection and decontamination equipment.

3. Given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. However, as it has not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

¹ As a result of decision number BL O/936/22, issued on 27 October 2022, the applicant’s specification within class 11 has been limited. My decision will take into account only the remaining goods of the application.

² On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UKIPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number **18240116** being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and the original EUTM filing date remains.

4. In its notice of opposition, the opponent essentially argues that the respective marks are similar and that the goods are either identical or similar, giving rise to a likelihood of confusion.

5. The applicant filed a counterstatement, within which it accepts some similarity between the parties' goods. The applicant also accepts some level of similarity between the marks, however denied this is enough to cause "a high risk of confusion"³ for the average consumer.

6. The opponent is professionally represented by Martin R Chinnery, whereas the applicant is professionally represented by Paweł Wowra. Both parties were given the option of an oral hearing, though neither asked to be heard on this matter. Neither party elected to file evidence or written submissions in lieu of a hearing; as such, I only have the notice of opposition and counterstatement available for me to consider. Whilst I do not intend to summarise these, I have taken them into consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

Decision

Section 5(2)(b)

8. Sections 5(2)(b) and 5A of the Act read as follows:

"5(2) A trade mark shall not be registered if because-

[...]

³ Applicant's counterstatement, paragraph 16

(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”.

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

9. I am guided by the following principles which 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:

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

10. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*,⁴ the General Council ("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".

11. The goods to be compared are those outlined in paragraphs 1 and 2 of this decision.

12. As noted above, the applicant has conceded that the parties' goods are similar. However, as "disinfectant dispensers for toilets" are a particular type of apparatus for dispensing disinfectant, this term would be encompassed by the opponent's broader term "disinfectant apparatus". Accordingly, I find that the goods are *Merici* identical.

The average consumer and the nature of the purchasing act

13. 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.

⁴ Case T-133/05

14. 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. (as he then was) 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.”

15. Due to the nature of the goods at issue in these proceedings, it is necessary to identify two groups of relevant consumers, namely, business users, such as those in the hospitality sector, and the general public.

16. In respect of the general public, the cost of the goods will range in price but, overall, they are likely to be fairly inexpensive. The frequency with which the goods are purchased will range from fairly regularly (in respect of, for example, disposable disinfectant apparatus) to more occasionally (for permanent apparatus that is refillable). The consumer’s thought process is likely to vary depending on the cost and permanency of the goods, but overall, it is likely to be more casual than careful. When selecting the goods, the general public will consider factors such as volume, quality and cost. It is my view that, overall, the general public will demonstrate a below average level of attention during the purchasing process. The goods are typically available from physical retail outlets, online product listings or catalogues. The purchasing process for these goods is likely to be dominated by visual considerations. However, I do not discount that there may be an aural component to the selection of these goods in the form of, for example, word of mouth recommendations, or discussions with sellers before purchasing.

17. For business users, the cost of the goods will be fairly inexpensive individually, however, businesses are likely to purchase these goods in large quantities to satisfy

their continuous demands, resulting in an overall moderate cost. The frequency with which they are purchased is likely to range depending on whether the goods are permanent or disposable. Business users will have the same considerations as members of the general public detailed above as well as the responsibility of choosing reliable goods for the operation of their business. However, that said, the selection of goods is unlikely to be of the utmost importance to business users. As a result, the purchasing process is likely to be more casual than careful. Consequently, business users are likely to pay an average level of attention during the purchasing process. The goods are typically available from wholesalers or their online equivalents, trade events, trade catalogues or sales representatives. The purchasing process for these goods is likely to be dominated by visual considerations. However, I do not discount aural considerations entirely as it is possible that the purchasing of these goods would involve oral discussions with sales representatives.

Distinctive character of the earlier mark

18. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. 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 *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).”

19. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, the more distinctive the earlier mark, the greater the likelihood of confusion.

20. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

21. The earlier mark is in word-only format and consists of the word “NPure”. The word “NPure” is not found in the dictionary, and instead will be viewed as an invented word. Nevertheless, consumers will identify the word “pure” within the earlier mark which is defined as “clean and free from harmful substances”.⁵ In the context of the goods, it will be seen as alluding to the intended purpose of the goods, i.e. to produce pure/clean environments. Accordingly, I consider that the earlier mark as a whole possesses a medium degree of inherent distinctive character.

Comparison of the marks

22. It is clear from *Sabel BV v. Puma AG*⁶ 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

⁵ <https://dictionary.cambridge.org/dictionary/english/pure>



⁶ Case C-251/95, paragraph 23

trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] 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.”

23. It would therefore be wrong to artificially dissect the trade 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 they create.

24. The respective trade marks are shown below:

Earlier mark	Contested mark
	

Overall impressions

25. The earlier mark is in word-only format and consists of the word “NPure”. The word is presented in standardised font and there are no other components to the mark. The overall impression of the mark resides in the word in its totality.

26. The contested mark is a figurative mark and encompasses the word “upure”, which, with the exception of the letter “r”, appears in black standardised typeface in lowercase. The letter “r” however, has an extended ear (the small stroke that extends outwards from the stem in a lowercase r) which arches over part of the neighbouring letter “e”. There is a split between the stem and the ear of the letter “r” which gives the ear the appearance of a water droplet. The overall impression of the mark lies predominantly in the word “upure” with the stylisation contributing but playing a much lesser role.

Visual comparison

27. The competing marks are visually similar as they both contain a single word comprising five letters, with the final four letters of the word being identical and forming the word “pure”. I do not consider the distinction in letter case between the earlier mark and the contested mark to be a point of significant difference between them. This is because the registration of word-only marks provides protection for the word itself, irrespective of whether it is presented in upper or lower case. However, the first letter of the respective first words vary; the earlier mark beginning with the letter “u”, whereas that of the contested mark starts with the letter “N”. The marks also differ as the contested mark is a figurative mark with a stylised letter “r” as described above. Taking into account the overall impressions, I find that the competing marks are visually similar to a medium degree.

Aural comparison

28. The Opponent’s mark will be articulated as “EN-PURE”; while the applicant’s mark will be pronounced as “YOU-PURE”. Both marks comprise two syllables, the final syllables being identical. The only aural difference between the competing marks resides in the respective first syllables. Consequently, I find the marks to be aurally similar to between a medium and high degree.

Conceptual comparison

29. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁷ In the contested mark, the word “upure” will be perceived

⁷ *Ruiz Picasso v OHIM* [2006] E.T.M.R 29.

by the average consumer as an invented word, though one which conveys the concept of purity and cleanliness. This is also true of the earlier mark “NPure”. Part of the stylised letter “r” in the applicant’s mark will likely be perceived as a droplet, but this does not materially add anything to the conceptual message of the mark. Therefore, both marks will be understood as conveying the idea of purity and cleanliness. In relation to the letters at the beginning of the respective marks, they give no real concept over and above their existence as letters in the English alphabet. Bearing in mind my assessment of the overall impressions, I find that the competing marks are conceptually highly similar, if not identical.

Likelihood of confusion

30. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be aware of the fact 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 that they have retained in their mind.

31. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

32. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. (as he then was), as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no

process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

33. These examples are not exhaustive but provide helpful focus.

34. I have found that the applicant’s goods are identical. I have found that the average consumer of the goods will be either the general public who will pay a below average level of attention, or business users who will pay an average level of attention. I have

found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impression of the contested mark lies predominantly in the word “upure”, whilst the overall impression of the earlier mark resides in the word “NPure” in its entirety. I have found that the earlier mark and the contested mark are visually similar to a medium degree, aurally similar to between a medium and high degree, and conceptually similar to a high degree, if not identical. I have also found that the earlier mark possesses a medium degree of inherent distinctive character.

35. I acknowledge that there are differences between the marks. The respective marks begin with different letters, i.e. “u” for the contested mark and “N” for the earlier mark. Furthermore, the earlier mark is a word-only mark whereas the contested mark is a figurative mark with the letter “r” having a fragmented appearance as described above. However, the marks are identical in length, both consisting of five letters, with the same four last letters i.e. “Pure”. The letters within each of the marks, (with the exception of the letter “r” in the applicant’s mark) appear in black, standardised font. Any difference in case between the marks, as discussed above, I do not consider to be significant, as registration of word-only marks provides protection for the word itself, irrespective of whether it is presented in upper or lower case. Equally, in my opinion, the slight stylisation of the letter “r” in the contested mark will be misremembered. Aurally, the last syllable of the competing marks is identical. Furthermore, both marks convey the notion of cleanliness and purity. I bear in mind the comments of Mr James Mellor Q.C. (as he was then), sitting as the appointed person in *Robert Bosch GmbH v Bosco Brands Limited*,⁸ where he said, “there are no special tests which apply to ‘short’ marks [...] In reality, the tribunal simply has to apply the well-established propositions for assessing the visual, aural and conceptual similarities.” Taking into account the overall levels of similarity between the marks, the aforementioned differences are likely to be insufficient to distinguish the marks from one another, even allowing for the fact that consumers attention is usually directed towards the beginning of the mark.⁹ In my judgement, taking into consideration imperfect recollection, it is highly likely that consumers, paying no more than an average level of attention during the purchasing process, would misremember the marks for one another, and fail to recall the

⁸ BL O/301/20, paragraph 43

⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

differences; especially as the letters at the beginning of the respective marks have no meaning, is it likely that consumers would fail to recall which letter prefaced the word “pure”. Furthermore, although the common element is allusive, and on its own, not particularly distinctive, this is not a bar to confusion.¹⁰ Overall, taking into consideration the similarities and the identity of the goods, I find that there is a likelihood of direct confusion.

Conclusion

36. The opposition under section 5(2)(b) of the Act has been successful. Subject to any appeal against my decision, the application will be refused.

Costs

37. The opposition has been successful, and the opponent is, therefore, entitled to a contribution towards its costs based upon the scale published in Annex A of Tribunal Practice Notice 2 of 2016. Applying this guidance, I award the opponent the sum of **£300**, which is calculated as follows:

Official fee:	£100
Preparing the notice of opposition and considering the applicant’s counterstatement:	£200
Total:	£300

38. Accordingly, I hereby order Shenzhen Puremate Technology Co., Ltd to pay Berger & Kraft Medical Sp. z o. o. the sum of **£300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of February 2023

Sarah Wallace

¹⁰ *L’Oréal SA v OHIM*, Case C-235/05 P

For the Registrar