

TRADE MARKS ACT 1994

AND THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 702821
AND THE REQUEST BY JOWAT LOBERS UND FRANK GMBH & CO KG
TO PROTECT A TRADE MARK IN CLASSES 1 AND 7**

AND

**IN THE MATTER OF OPPOSITION No 70144 THERETO
BY NORTON COMPANY**

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BACKGROUND

1. On 2 October 1998 Jowat Lobers und Frank GmbH & Co. KG applied to protect the mark Jowatherm in the United Kingdom in Classes 1 and 17 under the provisions of the Madrid Protocol on the basis of registration in Germany, for the following specification of goods:

Class 1:

"Hot-melt adhesives for technical use."

Class 17:

"Adhesive bands and adhesive foils for technical use."

2. The application numbered 702821 was published for opposition purposes in the Trade Marks Journal and on 27 July 1999 Norton Company filed Notice of Opposition. In summary, the grounds are:

1. The opponents are the registered proprietors of UK Trade Mark Registration No. 1095449 for NOVATHERM, covering goods in Class 17.
2. International Registration No. 702821 for JOWATHERM should be refused under the provisions of Section 5(2)(b) of the Trade Marks Act 1994 on the grounds that the marks are similar and the applicants' mark is to be protected for goods similar to those of the opponents. Therefore, there exists a likelihood of confusion on the part of the public including the likelihood of association.
3. The opponents and owner of the International Registration are both German companies. In the German language the letter "w" is pronounced "v". Therefore the marks are phonetically similar, being pronounced JOVATHERM

and NOVATHERM so that there is, effectively, only one letter difference when spoken.

4. The opponents have a reputation in the earlier mark in the UK and submit that use of the applicants' mark on goods not similar to those covered by the opponents' registration would take unfair advantage or be detrimental to the distinctive character or the repute of the earlier mark. Therefore, refusal of protection of the applicants' mark in the UK is requested under Section 5(3) of the Trade Marks Act 1994.
5. The applicants' mark should be refused under the provisions of Section 5(4)(a) of the Trade Marks Act 1994.

3. The applicants filed a counterstatement denying all grounds.

4. Both sides seek an award of costs.

5. Both sides have filed evidence and agreed that the matter can be decided from the papers. Both sides were provided with the opportunity to file written submissions. Only the opponents provided submissions and recognised that no evidence was filed regarding the opponents' reputation. Therefore, the matter will be decided on Section 5(2)(b) alone. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

OPPONENTS' EVIDENCE

6. This consists of a statutory declaration dated 1 June 2000 by Teresa Anne Bucks, a registered Trade Mark Attorney and partner of Boulton Wade Tennant, the opponents' trade mark attorneys. I should mention that this consists primarily of submissions rather than evidence in the strictest sense.

7. Exhibit TAB1 consists of a certified copy of the opponents' earlier rights, UK Trade Mark Registration 1095449 for the mark NOVATHERM in respect of the following Class 17 goods:

"Plastics in solid form adapted for melting by heat to form seals."

Ms Bucks compares the above specification to that of the applicants and says they are identical and/or similar in that the goods covered by the opponents' specification perform the function of providing a bond between two components and providing a seal between those two components. Ms Bucks goes on to say - "Therefore the issue to be decided in the Opposition is whether use of the trade marks JOWATHERM and NOVATHERM on identical goods would be likely to cause confusion."

8. Ms Bucks then refers to the Sabel v Puma case (c-251/95-ECJ), to which I will refer more fully later in this decision, and goes on to say:

"In this case the trade marks NOVATHERM and JOWATHERM are both phonetically

and visually extremely similar. Seven out of nine letters of the JOWATHERM trade mark are identical to the Earlier Registration and are positioned at identical positions in the words. In addition, the third letters of each trade mark (being a "v" in one and a "w" in the other) are phonetically very similar. Both the vowels in the prefix element of the marks are identical (-O-A), and it is these vowels which create the distinctive sound of the prefixes. Therefore, the overall pronunciation of the prefixes in both trade marks is likely to be extremely similar, and this, taken in conjunction with the identical suffix THERM, means that both trade marks are extremely similar both phonetically and visually. In my experience as a trade mark practitioner, the trade mark NOVATHERM and JOWATHERM are likely to be confused by members of the public."

9. Ms Bucks says that as the applicants are a German company the first element of their mark "Jowat" will be pronounced "Jovat". Therefore, Ms Bucks goes on to say that consumers will identify the products in question in a similar manner ie. that JOWATHERM would be pronounced JOVATHERM which would bring it closer to NOVATHERM. Exhibit TAB2 is a declaration executed by Dr Walter Maiwald, a German Patent Attorney, concerning the pronunciation of the words in the German language. Exhibit TAB3 provides an extract from the Langenscheidts New Concise German Dictionary to further support the German pronunciation of the marks at issue.

10. Ms Bucks further says that account should be taken of the fact that the marks are for use on technical products and that industrial application of sealants and adhesives relies upon specific uses for particular products so that it is vital that products can be easily differentiated. Ms Bucks points out that the consequences of using the wrong sealant or adhesive can be extreme and that confusion would have more serious consequences than in relation to some other products.

11. Ms Bucks again refers to the Sabel v Puma case which, she says, makes clear that when considering the likelihood of confusion, the overall idea underlying each mark should be considered. As JOWA has no meaning, Ms Bucks says there are no different meanings to help remove the applicants' mark further from the opponents' mark. Therefore, taking all the above factors into account there is likely to be confusion between the marks and the application should be refused.

APPLICANTS' EVIDENCE

12. This consists of a witness statement dated 25 August 2000 by Mr Paul Anthony Thomson, a Registered Trade Mark Attorney and partner of Potts, Kerr & Co, the applicants' representative for the defence of their International Registration in the UK. Again, this consists primarily of submissions rather than evidence.

13. Mr Thomson says that the issue to be decided is whether use of the respective marks on or in relation to similar goods would be likely to cause confusion within the context of Section 5(2) of the Trade Marks Act 1994. It was further argued that as the opponents' goods are sealants while the applicants' goods are adhesives, the goods are not identical as stated by Ms Bucks. Exhibit PAT1 shows an extract from B & Q's website. Mr Thomson says that this

clearly lists sealants and adhesives separately and argues that because "an adhesive and a sealant are used for completely different purposes, clearly substantiates that the goods of the respective marks are not identical as alleged."

14. Mr Thomson also refers to the Sabel v Puma case extract quoted by Ms Bucks, in particular the reference to recognition of the trade mark on the market, and points out that the opponents have a national right and the UK Trade Marks Act covers the UK. Therefore the appropriate market to be considered is the UK market and whether JOWATHERM and NOVATHERM would be deemed phonetically, visually or conceptually similar to one another by the ultimate consumer within the UK market.

15. Comparing the marks phonetically, Mr Thomson argues that in the UK "JOWA-" would be pronounced "J-OUR" and not "JOVA-" as alleged by Ms Bucks because of reference to the German language. Exhibit PAT2 provides an extract from The New Collins Concise English Dictionary which provides proper pronunciation of the word "JOWL", being the closest word Mr Thomson could find to "JOWA", which is invented and has no meaning.

16. Mr Thomson further argues that it is well established practice that on comparing marks within the context of Section 5(2) it is the beginnings of marks or the first part of word marks, which is the most important, especially in light of a tendency in ordinary speech to slur the endings of words. The prefixes "JOWA-" and "NOVA-" are clearly distinguishable from one another, Mr Thomson says, so that their inclusion renders "JOWATHERM" and "NOVATHERM" phonetically dissimilar.

17. Mr Thomson refers to the visual differences - the different consonants - and argues their alignment is altered if one types one word below the other.

18. The marks are also compared conceptually by Mr Thomson who says that the marks differ because NOVATHERM is a combination of two known words, "NOVA" and "THERM" while the applicants' mark JOWATHERM is a combination of an invented word "JOWA" with "THERM". Exhibit PAT3 provides entries from The New Collins Concise English Dictionary for "NOVA" and "THERM". In view of these meanings, he says, when used in relation to the opponents' products, namely plastics in solid form adapted for melting by heat to form seals, the opponents' mark is suggestive of a product which glows when heated, distinguishing the marks conceptually.

OPPONENTS' FURTHER WRITTEN SUBMISSIONS

19. These submissions are provided in a letter dated 26 March 2001 from Ms Bucks of Boulton Wade Tennant who says "We have not provided evidence of our client's reputation, and therefore we accept that the Opposition will be decided on the basis of Section 5(2)(b) alone."

20. In response to the Witness Statement by Mr Thomson, Ms Bucks refers firstly to his comments regarding whether the goods are the same or similar and comments that it should make little difference to considerations under Section 5(2)(b) of the Act. Ms Bucks refers to dictionary references for "seal" which include:

"A device or substance used to prevent the escape of gas etc, close an aperture, or act as a tight fastening, especially at a place where two surfaces meet."

(New Shorter English Dictionary)

This, Ms Bucks says, indicates that "seal" can be a tight fastening and is exactly what an adhesive is designed to do. Ms Bucks argues that the goods are, therefore, identical but even if not considered to be so "Mr Thomson does not deny the fact that the goods are similar to all the goods covered in the opposed UK designation. Again, Mr Thomson's statement that an adhesive and a sealant are used for completely different purposes cannot be the case considering the fact that a sealant can be used to act as a tight fastening, which is precisely the function of an adhesive."

21. Ms Bucks then refers to Mr Thomson's comments on the comparison of the marks. In particular, Ms Bucks refers to Mr Thomson's comments that the evidence regarding German pronunciation is irrelevant as the opposition relates to the UK and says that this is an over-simplification. Ms Bucks says that as the applicants' mark is owned by a German company, "It only stands to reason that the manufacturers would apply a German pronunciation through its trade channels." Furthermore, Ms Bucks says that "even to non-German speakers, many would be aware of the basis of German pronunciation if only from television."

22. Ms Bucks concludes by saying that Mr Thomson's points concerning the pronunciation in English are not valid as marks should be considered as a whole. It is pointed out by Ms Bucks that only two of the nine letters in each mark differ and that "V" and "W" are "extremely close in the English language."

DECISION

23. The only remaining ground is under Section 5(2)(b) of the Act which reads as follows:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

24. The term "earlier trade mark" is itself defined in Section 6 as follows:

6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities

claimed in respect of the trade marks,"

25. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the

meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

26. The applicants' and the opponents' specifications are set out below for ease of reference:

JOWATHERM (M 702821)

NOVATHERM (1095449)

CLASS 1:

"Hot melt adhesives for technical use"

CLASS 17:

"Adhesive bands and adhesive foils for technical use"

CLASS 17:

"Plastics in solid form adapted for Melting by heat to form seals".

27. The first matter I must consider is whether the above goods are identical or similar. It seems to me apparent that the goods are not identical. "Adhesives" and "seals" are, by definition, different from each other. An adhesive will stick two surfaces together while a seal will join two items together or make a join impervious. Furthermore, the opponents' goods are "plastics in solid form" and not "adhesives", "adhesive bands" or "adhesive foils". (I consider this in more detail later in this decision). However, I must also consider the degree, if any, of similarity between the goods in any global assessment of confusion.

28. The CANON case, *Canon KK v Metro-Goldwyn-Meyer Inc* (1999 RPC 117) refers to factors which determine the similarity of goods as set out in the TREAT case by Jacob J. (paragraph 23 of the judgement) which are:

- (a) The uses of the respective goods or services;
- (b) The users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The 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 in competition with each other; that enquiry 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 the services in the same or different sectors.

I now consider each point in turn.

29. Uses (Point a). As indicated above, the uses of adhesives and seals seem different. An adhesive would be used to make two surfaces adhere. A seal will merely join two or more items together perhaps making the joint impervious but will not necessarily physically stick them together. Nevertheless, it is clear that in some instances the difference could be small.

30. Users (Point b). I have no evidence as to who would use either the applicants' or the opponents' products. It seems likely that the opponents' goods could be "for technical use" as indicated in the applicants' specifications. There seems nothing to suggest the users could not be the general public involved in more advanced do-it-yourself work. Therefore, the users are likely to be the same.

31. Nature (Point c) The opponents' products are described as "Plastics in solid form adapted for melting by heat to form seals." It seems to me that the physical nature is different from the applicants' "hot melt adhesives" and especially "adhesive bands" and "adhesive foils". Goods intended for melting indicate that heat needs to be applied. In the absence of any additional information I consider it is possible that the goods in Class 1 of the application could include "plastics in solid form" which require heat to form "hot melt adhesives" but goods for sealing and goods for creating adhesion must be of different chemical composition.

32. Trade Channels (Point d). I have indicated above that the goods at issue could be for related purposes and for the do-it-yourself market. Therefore, it is likely that the goods could be sold through the same trade channels. It is also likely that the goods could be used for complementary purposes e.g. for plumbing or roofing. As such, specialist suppliers may well provide a range of products covering the goods at issue.

33. Supermarket Shelves (Point e). While I have found the goods are not physically the same or have the same purpose, I have indicated above that it seems likely to me that they are for related or complementary purposes. Therefore, it seems likely that the goods will be sold side-by-side in a D-I-Y Store or by suppliers of products for specialist purposes so that a particular job can be completed using a range of goods including adhesives and seals e.g. for plumbing purposes.

34. In Competition (Point f). As indicated above, given the different nature and uses of adhesives and seals I consider it unlikely that the goods are in competition with each other but are likely to be used alongside each other. I do not see how one could be used as an alternative for the other.

35. Taking the best view I can of the matter I consider similar goods are involved in that the respective goods are likely to be used together and for a similar purpose (although not an identical one) and by the same end user.

36. I now turn to a comparison of the marks. When doing so, it is well established that in order to assess the degree of similarity between them I must determine the degree of visual, aural and conceptual similarity, while keeping in mind the distinctive character of the earlier mark.

37. Turning first to a visual comparison I note that both are invented words of equal length, consist of three syllables, and end in THERM. However, in my view, the beginnings of each word differ significantly so that I consider the marks, on first impressions, to be visually very different.

38. Turning to aural comparisons I note the opponents' emphasis on the applicants' goods having a German producer. However, I do not consider this affects the matter one way or the other. I have to consider how the average consumer in the UK market is likely to pronounce the mark on first seeing it. In my view the mark JOWATHERM does not have an obvious Germanic "feel". Even if it did, the British public is notorious for mis-pronouncing such words. The household names VOLKSWAGEN and BRAUN spring to mind. From my own knowledge these well known German owned products are not pronounced in the correct German manner (VOLKS WAGGON and BRAUN respectively and not the more correct VOLKSVAHGEN and BROWN). With this in mind I consider it most unlikely that the UK public will pronounce the applicants' mark in the correct German way other than on rare occasions, even if they were aware of the German origin of the goods. Therefore, in oral use I consider the applicants' mark is likely to be pronounced in the way described by the applicants or, using my own comparison, JOWA to rhyme with TOWER. It is well established that beginnings of words tend to be emphasised and carry more weight. As such I consider the difference between JOWA and NOVA is sufficient to distinguish the marks aurally when compared as wholes.

39. Finally, I turn to conceptual similarity. Clearly, each mark ends in the known dictionary word "THERM". However, the applicants' mark begins with a meaningless word JOWA and the opponents' mark begins with another known dictionary word NOVA. Each mark, considered as a whole, is an invented word. However, the different beginnings of each mark convey quite a different idea. Therefore, I do not consider there is any conceptual similarity between the marks.

40. Having found that the marks are not visually, aurally or conceptually similar I consider confusion by the public is unlikely. The Act requires me to consider the likelihood of confusion, as opposed to the mere possibility of confusion. I assume that the "average consumer" is reasonably well informed and reasonably circumspect and observant and that he or she "normally perceives a mark as a whole and does not proceed to analyse its various details". I consider this is all the more so when the goods are of a technical nature such as those described in the specifications above. I consider the purchaser is likely to take particular care before buying products of this type, even if the goods were relatively low-cost. They may be comparatively rare purchases in the D-I-Y market. However, if they are for more technical use and bought on a more regular basis, the purchasers are likely to be more sophisticated and take greater care when buying such products. Therefore, any similarity which exists between the goods or aural use of the marks (if the German nature of the applicants' mark is identified) is likely to be more than offset by the care taken in purchasing such products. Therefore, the opposition fails under the only remaining ground, Section 5(2)(b).

41. The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30 day of April 2002

R A JONES
For the Registrar
the Comptroller-General