

O-161-11

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND
THE TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 982726
IN THE NAME OF UDO VOLLBRACHT IN RESPECT OF THE TRADE MARK**

D A B O T E X

IN CLASS 17

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 71979
BY CHESTERFIELD HOLDINGS LTD**

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND
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**IN THE MATTER OF International registration no. 982726
in the name of Udo Vollbracht in respect of the trade mark**

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**IN THE MATTER OF Opposition thereto under No. 71979
by Chesterfield Holdings Ltd**

BACKGROUND AND PLEADINGS

1. On 27th November 2008 the UK was notified by WIPO of international registration 982726 (having an international registration date of 30th May 2008), in respect of which it had been designated under the relevant provisions of the Madrid Protocol. The international registration is as above.
2. The designation stands in the name of Udo Vollbracht of Ecksteinsloh 24, 42279 Wuppertal, Germany and it is registered for the following goods in the UK:

Class 17:

Roof liquid sealing compound for construction consisting of natural rubber and bitumen that becomes a durable elastic geomembrane after drying.

3. The designation was accepted and advertised in the Trade Mark Journal for opposition purposes on 6th March 2009. On 3rd June 2009, Chesterfield Holdings Ltd of Foxwood Way, Sheepbridge, Chesterfield, Derbyshire S41 9RX (hereafter "Chesterfield") filed notice of opposition. Chesterfield has based its opposition on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (hereafter "the Act"). Under section 5(2)(b) and 5(3) they rely on one earlier mark as follows:

Mark, filing and registration dates	Goods relied upon
UK 1532458 DEBOTEK Filed on: 13 th April 1993 Registered on: 11 th February 1994	Class 19: Roofing felt; all included in Class 19

4. Chesterfield's pleaded case under section 5(2)(b) states that, when pronounced the respective marks sound incredibly similar with the same number of syllables, commencing with the same letter and having the identical central part, 'BOTE'. Visually, the marks are similar given the number of identical elements and given that neither mark has any particular stylisation or logo. Conceptually, neither mark has any particular meaning in the English language and on this basis, consumers cannot differentiate between the respective marks by reference to concept. As far as the goods are concerned, Chesterfield say that, although they are in different classes the goods of the international registration are a direct alternative to the goods covered by the earlier mark. Overall, there is a likelihood of confusion between the respective marks.
5. Under section 5(3), Chesterfield say they have been using their mark in the UK since 1993 and have built up a significant reputation and goodwill as a consequence. They say they are a leading manufacturer of bituminous membranes in the UK and sells their products throughout the UK and Southern Ireland. The owner of the international registration will gain an unfair advantage by use of its mark, such that members of the public may order its product believing it to be an alternative product of the opponent. In addition, the opponent will suffer damage and detriment should the products of the international registration holder be inferior to their own product.
6. Under section 5(4)(a), Chesterfield say, given the similarity between the respective marks already mentioned, use by the international registration holder would amount to passing off of the goodwill and reputation enjoyed by the opponent.
7. Mr Vollbracht filed a counterstatement denying the grounds of opposition but not putting Chesterfield to proof of its use of the earlier mark. Specifically, Mr Vollbracht said there was no likelihood of confusion between the two 'expressions' forming the respective marks. He also said that in terms of the specifications no confusion can arise as, as far as he knows, there is no other

roof sealing compound on a bitumen basis that does not need any undercoat, is insensitive to frost and is waterproof immediately after application. He also notes that the respective marks are also in different classes of the Nice Classification; his being in Class 19 and the earlier mark being in Class 17.

8. Evidence has been filed by both parties, the salient facts of which I shall summarise below. Neither party asked to be heard and so this decision is based only on the papers filed and after a careful assessment of those papers. Both parties request costs.

Opponent's evidence

9. This takes the form of a witness statement dated 18th August 2010 by Rachel Elizabeth Nicholls, a trade mark attorney with Marks & Clerk LLP, acting for the opponent. She says the materials exhibited to her witness statement have been forwarded by Chesterfield and obtained from their records.
10. She says Chesterfield has been using the mark, DEBOTEK, in respect of a range of roofing membranes used for new-build, flat roofing purposes, and also for the repair and maintenance industry in the repair of existing flat roofing structures, since 1993. The opponent is unable to provide client lists or market share information given the commercially sensitive nature of that information. However, the opponent "confirms that annual turnover of products under the DEBOTEK trade mark amounts to approximately 40% of the opponent's turnover, equating to approximately £4 million per annum."
11. Exhibit REN1 comprises sample guarantee documents, demonstrating use of the mark DEBOTEK back to the year 2000. There are two sample guarantees, the first giving a job completion date of 2nd October 2000, and the second of 5th May 2004. The documents show the respective 'site addresses', the first being in Berkshire and the second in Huddersfield. Different distributors and roofing contractors are also named. The word DEBOTEK (the TEK element being italicised) is in bold at the top of both guarantees. There is a heading, "Description and Quantities of Debotec Products used", under which is listed, on the first guarantee : "Debotec Debovent, Debotec Laser Torch Plain x 2 layers (protected by mineral chippings) and Debotec Laser Torch Mineral (trims only)". On the later guarantee, the product descriptions are "Debotec Debovent, Debotec Laser Gold Underlay, and Debotec Laser Gold Charcoal".
12. Ms Nicholls says the opponent undertakes a variety of promotional activities under the DEBOTEK mark in the UK, and exhibit REN2 comprises a sample advertising leaflet dated 19th November 2004, the date appearing in small lettering at the top. The leaflet shows a variety of roofing products, the word DEBOTEK appearing on products under the heading, "FLAT ROOF WATERPROOFING TORCH ON APPLICATION". Other products listed are

UNDERTILE PRODUCTS and FLAT ROOF WATERPROOFING ROLL ANDPOUR APPLICATION but the latter product is not sold under the DEBOTEC mark. The leaflet is headed 'CHESTERFELT GROUP'. At the bottom it is said that guarantees for 10, 12,15 and 30 years are available for CHESTERFLEX, CHESTERMERIC and DEBOTEC products. Other marks used on the leaflet bearing the 'DEBO' prefix are DEBOFLEX and DEBOVENT.

13. Exhibit REN3 comprises a pack of advertising material showing the product range of the 'CHESTERFELT GROUP'. The Group started in 1978 and provides a range of flat or pitched roof products. The DEBOTEC range comprises what are described as 'TORCH-ON' products. There is a specific (undated) DEBOTEC pamphlet, describing the range as being "offered in a traditional three layer built up system using universal venting/perforated layers, glass fibre base sheets intermediate followed by final capping layers." The leaflet contains instructions on laying the roof, and as I understand it, typically, a venting layer is normally laid, followed by an underlay and finally, the cap sheet is added.
14. Depending on the particular application and specification, different materials may be used. So, for example, the DEBOTEC CHESTERTORCH Standard Range comprises a glass fibre underlay and polyester reinforcements (capping sheet). There are then, a range of premium or higher performance systems described, utilising eg modified bitumens or strengthened glass fibre and/or reinforced polyester. DEBOTEC LASER TORCH, for example, is described as using a range of membranes using "SBS type bitumens offering lower melt characteristics for faster applications". The word DEBOTEC is used in relation the whole range of TORCH-ON products, along with other marks such as DEBOFLEX, TOPGUARD, LASER TORCH and LASER GOLD, and DEBOVENT. In summary, the mark DEBOTEC is used to describe a range of TORCH-ON roofing felt products, which are typically laid as a series of membranes constructed from, eg glass fibre, bitumen and polyester.
15. Ms Nicholls submits that the respective specifications cover identical or very similar products as the opponent produces bitumen-based roofing materials, resistant to rain and structural movement. The respective products serve the same function, would be used by an identical user and would be in direct competition with each other. The remainder of Ms Nicholl's evidence is also in the form of submission and with which I shall deal in due course.

Applicant's evidence

16. This takes the form of a witness statement dated 22nd October 2010 by Udo Vollbracht. English is not Mr Vollbracht's native language and he explains

that he has been assisted in the preparation of his witness statement by Alan Hall of Concept Language Services, based in Wuppertal, Germany.

17. He says firstly, that the goods of the respective specifications are not similar by virtue of the fact that they do not appear in the same Nice Class. Moreover, his specification is for a liquid compound, whereas Chesterfield's is for a roll-on product.
18. The remainder of his evidence is critique of the evidence from Ms Nicholls. In particular he says that the DEBOTEC mark, in actual use, presents as a two word mark 'DEBO' and 'TEC', given the use of different colours and italicisation. He also says the evidence of use is not compelling as the dates referred to are outside the relevant period and/or the evidence does not show uninterrupted usage and/or does not otherwise discharge the burden of proof on the earlier rights holder to *prove* use; that is to say that unsubstantiated assertions that products sold under the earlier mark have generated a turnover of 'approximately £4 million' are insufficient to discharge the burden on the opponent.

Opponent's evidence in reply.

19. This takes the form of a further witness statement dated 24th November 2010 by Rachel Elizabeth Nicholls. Again this takes the form of critique of the evidence of Mr Vollbracht with which I shall deal in due course. She notes however that proof of use of the earlier had not been requested by the international registration holder and hence detailed evidence was not thought to be required. Insofar as Mr Vollbracht now seeks to criticise that evidence, his criticisms are irrelevant. Even if they were not considered to be irrelevant, she says the relevant period is, in fact, 4th March 2004 – 4th March 2009. Therefore, several pieces of evidence fall within that period. Moreover, advertising materials do constitute proof of use, contrary to Mr Vollbracht's assertions.

DECISION

Proof of use

20. Mr Vollbracht had not put Chesterfield to proof of its use of the earlier mark and therefore, strictly speaking, his subsequent criticisms of their evidence are not for me to consider. The fact that he did not put Chesterfield to such proof may also have resulted in them not going the same level of detail and persuasiveness than they may have otherwise done had they clearly, and at the outset, been put to such proof. That said, I will make a few *observations* on Chesterfield's evidence as regards proof of use in relation to the section 5(2) ground of opposition, both for the benefit of completeness and noting that Mr Vollbracht (and also Ms Nicholls) may be factually incorrect as regards certain claims, such as the relevant period for proof of use.

21. In giving my observations, I am not thereby arriving at a formal and detailed *finding* on the matter, such as I would have done had proof been requested, but in this case I can see benefit in making the following observations.

22. The Trade Marks (Proof of Use, etc) Regulations 2004 apply and read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services...”

23. With a registration date of 11th February 1994, it is clear that under Section 6(1) of the Act, Chesterfield’s mark is an earlier trade mark. Further, as it completed its registration procedure more than five years before the publication of the contested mark (being 6th March 2009), it is subject to the proof of use requirement set out in section 6A of the Act. In accordance with Section 6A of the Act above, the relevant 5 year period ends on 6th March 2009 and starts on 7th March 2004.
24. Given the relevant dates involved, both of the guarantees forming Exhibit REN 1, which is dated 5th May 2004, as well as Exhibit REN 2, which is dated 19th November 2004, clearly fall within the relevant period. The other exhibits, whilst not containing dates, are not to be dismissed or deemed inadmissible simply because they may be undated. Evidence needs to be assessed in the round, so to speak. Certain matters can be deduced, for example, the package of advertising materials comprising Exhibit REN 3 notes that the Chesterfelt Group was established in 1978 and in February 2003 it was awarded ISO 9001, so such advertising materials would, in all probability, have been published *after* 2003. Another leaflet in the package says the company has 30 years experience in roofing manufacture. So, again, on the balance of probability, the package comprising Exhibit REN 3 was published in or around 2008, within the relevant period. There is no question either, that such advertising materials are incapable of demonstrating genuine use and are as probative as, say, invoices or other material showing use on the *actual* products.
25. In short, the evidence needs to be considered, as I have said, ‘in the round’, taking account of what in particular is *said* in the witness statement as well as what may be exhibited. Whilst, normally, it is the case that parties set out more exact turnover figures and advertising spend, one cannot be too prescriptive and in this case, I can see no reason to doubt that approximate annual turnover of goods under the mark amounts to £4 million.
26. As to the question whether Chesterfield has used the mark as registered or an ‘acceptable variant’, I note Mr Vollbracht’s comments, but plainly Chesterfield uses the plain text version ‘DEBOTEC’ in their materials, as well as other versions which tend to visually split the two elements ‘DEBO’ and

'TEC', either by use, eg, of colour or italicisation. Even with the latter examples, the fact that such a difference(s) may be noticed by the average consumer for the products does not thereby mean, the alternative versions used by Chesterfield are not acceptable variants in accordance with Section 6A.¹ In my view, splitting the mark into two elements would not affect its overall identity as far as the consumer would be concerned. In any event I have noted also the usage made by Chesterfield of the single-word version DEBOTEK.

27. For all the above reasons, shortly stated, I would have accepted, in any event, that the evidence provided by Chesterfield, albeit provided by their attorney, would have amounted to proof of genuine use during the relevant period. In addition, in any analysis of 'fair specification' I would not have had cause to render their specification any narrower than it is by rephrasing the specification along the lines, eg, of "flat roofing felt" or "torch on roofing felt". "Roofing felt" in Class 19 appears to me to be a perfectly 'fair' way of describing the products sold under the mark DEBOTEK (see my evidence summary at para 14 above in particular). I need now to consider the substance of the section 5(2)(b) claim.

Section 5(2)(b)

28. Section 5(2)(b) of the Act reads:

5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

(a) or

(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.

29. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union ("CJEU") in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd*

¹ The relevant test for 'acceptable variant' use can be found in, eg para 34 of BL 0/262/06 (*NIRVANA*) a decision of the appointed person dated 18th September 2006.

Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). 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*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*,

(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*,

(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*,

(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.*,

(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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*



The average consumer and nature of the purchase

30. The average consumer for both parties' goods is likely to be trade-based. Both are concerned with roofing products, and whilst the more ambitious DIY member of the public may be tempted to try his or her hand at roofing, perhaps by way of small scale maintenance, in my view most people would be tempted to leave such a task to roofing contractors or general builders. As such, the general public or businesses that own the property being roofed or maintained may never come into contact with either parties' mark. That said, I note for example that Chesterfield give guarantees on their products and the mark DEBOTEK appears prominently on those guarantees.
31. Nevertheless, such exposure does not disturb my view that in the main, it is roofing contractors or general builders who will be the average consumer for both parties' products. There is therefore complete commonality as far as the question as to who the respective average consumers' for both parties' marks are concerned.
32. As far as the nature of the purchasing process is concerned, I am lacking evidence on this but I can assume that roofing contractors would be familiar with the properties and specifications of these products and, for them, they will be routine purchases. This is not to say they are selected and purchased

in any ‘casual’ fashion; far from it, the roofing contractor, as technical expert, will be familiar with the properties of the products and need to match them to the job in hand. I need to factor these observations into my overall assessment of likelihood of confusion.

Comparison of marks

33. The case law makes it clear that I must undertake a full comparison of both marks in their totalities, taking account of all differences and similarities. The comparison needs to focus on the visual, aural and conceptual identities of both marks. The respective marks to be compared are as follows:

Mr Vollbracht’s mark	Chesterfield’s mark
	

34. Visually, Mr Vollbracht’s mark presents as a single-word mark comprising seven letters, DABOTEX. Although there a slightly unusually large gap between the lettering, that is the extent of any stylisation. Chesterfield’s mark is also a single, seven letter word mark, , DEBOTEC. The first letter of both marks is the same, being a ‘D’. The middle series of letters ‘BOTE’ is also common to both marks. However, the marks differ in the second letters of both, one being an ‘A’ and the other an ‘E’ and also in the final letters, one being an ‘X’ and the other, a ‘C’. Taking the similarities and differences into account, I find that visually the marks are similar to a high degree.

35. Phonetically, Mr Vollbracht’s mark will, in all probability, be pronounced ‘DAB - O- TECKS’. An alternative version may be ‘DA-BOT-ECKS’ (with the ‘B’ and the ‘O’ pronounced as is ‘bottom’, rather than ‘bow’ as in the first version), but I think this less likely than the first version. Chesterfield’s mark will, in all probability, be pronounced ‘DEB –O-TECK’. A similar, alternative version may be used, ‘DE-BOT-ECK’, but likewise I think this less likely than the first version. In aural use, it is important that the first letter of both marks is the same and will be aurally significant. The respective second letters, ‘A’ and ‘E’ however, are both apt to be less aurally significant, and thereby capable of slurring. The endings of both marks are also likely to sound alike. Taking the similarities and dissimilarities into account I find that, phonetically, the marks are similar to a high degree.

36. When the authorities talk of conceptual similarity, it is meant ‘semantic’ conceptual similarity. I must also remember that I am viewing matters from

the perspective of the average consumer who is unlikely to be an expert linguist. Neither marks comprise known, dictionary words, or even invented words having a clear linguistic point of reference in relation to their usage on the relevant products. As such, neither mark can be said to possess a 'concept' and so, inevitably, I must find that there is neither conceptual similarity nor dissimilarity.

Overall assessment of marks

37. I need to bring these findings together in an overall assessment of the marks, taking into account distinctive and dominant characteristics as wholes. Neither marks are complex marks, having a number of different elements, some of which may be more distinctive and dominant than others. Both marks are single word marks. Taking all factors into account, I find that the parties' respective marks are, overall, similar to a high degree.

Comparison of the goods

38. In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the 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 end users and their method of use and whether they are in competition with each other or are complementary.'

39. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.
40. It is important to recognise that even though the factual evidence on similarity is non-existent, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the appointed person said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. He also stated that the tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public.

41. The respective goods to be compared are as follows:

Mr Vollbracht's goods	Chesterfield's goods
<p>Class 17:</p> <p>Roof liquid sealing compound for construction consisting of natural rubber and bitumen that becomes a durable elastic geomembrane after drying.</p>	<p>Class 19:</p> <p>Roofing felt; all included in Class 19</p>

42. If I understand Mr Vollbracht's argument correctly, it is that the respective goods are not similar, (a) by virtue of being in different classes of the Nice Classification system, and/or (b) that his specification plainly covers a product that is, eg brushed on as a liquid, and Chesterfield's specification covers a felt membrane product which is not in liquid form but rolled on to a suitable surface.

43. As regards argument (a), Professor Ruth Annand, sitting as the Appointed Person, in a relatively recent case, *TAO ASIAN BISTRO* (BL O-004-11) had to deal with the same argument. In a lengthy analysis (paras 36-52), the Appointed Person, in essence, cautions against supplanting a full and proper analysis of similarity of goods or services, taking due account, eg of apposite dictionary definition, one's own experience, trade practices and the evidence itself, by an approach which *deems goods or services dissimilar* by virtue only of their appearance in different Nice Classes. This is not a trap I wish to fall into. Whilst the respective products fall in different Nice Classes, they are not thereby dissimilar. Both products are used in roofing, and in effect have the same intended purpose – to provide an effective, weather resistant and suitable roof covering. The same people are likely to access such products, being roofing contractors and/or general builders. It is likely also that such products will be available through the same trade channels, such as builders or roofing merchants.

44. Argument (b) deployed by Mr Vollbracht does not displace any of my comments above. The fact that his product has the physical property of a liquid and Chesterfield's has to be rolled or torched on in successive layers in the form of 'felt' does not disturb my comments on the relevant factors affecting similarity above. The relevant products may not have the same physical properties but their intended purpose is the same; they are alternatives and thus in competition.

45. That said, I am prepared to concede that the respective products are not, strictly speaking, 'identical', in the sense that one is plainly a 'roofing felt' and the other a 'sealing compound' for use on roofs. A felt is apt to be used to cover an entire roof, either as a new build or as a repair, whereas a 'compound' may conceivably be used in a more limited fashion, for example to render a particular area watertight. Nevertheless, as I have already said their intended purposes are the same; they are alternatives and thus in competition. On that basis, I do not find that the respective products are identical but they are nonetheless, highly similar, in light of my comments on all the relevant factors above in para 43.

Likelihood of confusion

46. Before proceeding to bring all my findings together in an overall global assessment I need to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness. In terms of its inherent distinctiveness, and as it is not a known dictionary word, or even derived from one, I regard Chesterfield's mark to be inherently highly distinctive.

47. I need to consider also whether this level of inherent distinctiveness can be said to be enhanced through use in the UK market. Plainly, use has been shown but it is hard from the evidence to assess what relative exposure to the UK market the mark has had. Chesterfield has not given evidence of its market share under the mark or its advertising spend, and on that basis, I am not inclined to find that the degree of inherent distinctiveness I have already found is enhanced through use.

48. To return to my express findings, I have found above that the respective marks are similar to a high degree and that the respective goods are also highly similar. I have also found the earlier mark to be highly distinctive and the identity of the respective average consumers to be common. I have also made observations that the purchasing process involves an above average level of attention.

49. I must also bear in mind I need to factor in the notion of 'imperfect recollection'. That is to say, consumers (including trade-based consumers) may rarely see marks in use side by side but, in real life, retain an imperfect picture of them. I think in this case, imperfect recollection does in particular come into focus as a factor. The real market experience is not in the form of a 'spot the difference' exercise, and I can easily imagine a scenario where these two marks are genuinely and mistakenly confused.

50. In this case, taking all factors into account, as well as imperfect recollection of course, I find that likelihood of confusion is made out in respect of all the goods.

51. The opposition therefore succeeds under section 5(2)(b) in relation to all the goods opposed.

52. Given the strength of the ground of opposition under section 5(2)(b), in the circumstances I do not find it necessary to consider the grounds of opposition under section 5(3) and/or section 5(4)(a). Had I done so, I would have struggled to find the required 'reputation' under section 5(3) based on the evidence, as well as find that the necessary damage or unfair advantage had occurred, or was likely to occur. Under section 5(4)(a), the case is really no stronger than that under section 5(2)(b) and for that reason I have not found any finding necessary.

Costs

53. Chesterfield Holdings Ltd has been totally successful in its opposition and accordingly it is entitled to a contribution towards its costs. I take account of the fact that the decision has been reached without a hearing. In the circumstances I award Chesterfield Holdings Ltd the sum of £800 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Filing fee for opposition - £200
2. Preparing a statement and considering counterstatement in both the opposition and the revocation - £300
3. Preparing evidence £300

Total £800

54. I order Udo Vollbracht to pay Chesterfield Holdings Ltd the sum of £800. The sum should 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 13 day of May 2011

**Edward Smith
For the Registrar,
the Comptroller-General**