

O-206-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3021525 BY
SOFTHEADS LIMITED**

TO REGISTER THE TRADE MARK:

COOL TECH

IN CLASS 20

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000071 BY
HEALTH BEDS LIMITED**

BACKGROUND

1. On 11 September 2013, Softheads Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 22 November 2013, for the following goods in class 20:

Furniture, beds, mattresses, headboards.

2. The application is opposed by Health Beds Limited (“the opponent”) under the fast track opposition procedure. The opposition, which is directed against all of the goods in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the opponent relies upon all of the goods in the following trade mark registration:

UK no. 2534230 for the mark: **COOLTEX** which was applied for on 14 December 2009 and for which the registration process was completed on 26 March 2010:

Class 20 - Beds, parts and fittings for beds.

3. The applicant filed a counter statement in which the basis of the opposition is denied. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

4. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

5. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. A hearing was neither requested nor considered necessary. Both parties filed written submissions, which I will refer to as necessary, below.

DECISION

6. The opposition is based upon section 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.”

7. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. Given the interplay between the date on which the application was published and the date on which the opponent’s earlier trade mark completed its registration process, the earlier trade mark is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

9. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the

chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing process

10. 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 its submissions, the applicant states:

“8. The average consumer of the goods at issue will be a member of the general public. The nature of the purchase is likely to be from a website,

catalogue or from a retail store selling furniture, beds mattresses, headboards and other parts and fittings will be primarily visual purchases.”

11. I agree with the applicant’s submissions both in terms of the average consumer and the manner in which the goods are likely to be selected. While the cost of the goods at issue can vary considerably, as such goods are likely to be relatively infrequent purchases, and as the average consumer will need to consider a range of factors, such as style, colour, size, price and compatibility with existing items of furniture before making a selection, a somewhat higher than normal level of attention is, in my experience, likely to be paid to the selection of the goods at issue.

Comparison of goods

12. The competing goods are as follows:

Opponent’s goods	Applicant’s goods
Class 20 - Beds, parts and fittings for beds.	Class 20 - Furniture, beds, mattresses, headboards.

13. In its submissions, the applicant accepts that:

“3. The goods in question are identical and similar...”

14. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the General Court stated:

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

15. As the terms “beds”, “mattresses” and “headboards” in the applicant’s specification are an alternative way of describing the goods in the opponent’s specification, the competing goods are identical. In addition, as the term “furniture” in the applicant’s specification, would include (at least) “beds” in the opponent’s specification, the competing goods are, on the principles outlined in *Merica*, also identical.

Comparison of marks

16. The competing marks are as follows:

Opponent's mark	Applicant's mark
COOLTEX	COOL TECH

17. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

18. In its submissions, the opponent states:

“(i) The applicant’s mark COOL TECH is visually similar to the opponent’s mark COOL TEX because they both consist of two syllables; the first syllable COOL is identical and shared by both marks while the second syllable is similar...

(ii) The mark COOL TECH is also phonetically very similar to the mark COOLTEX because both marks consist of two syllables, the first syllable COOL being identical and the second syllable would be pronounced almost identically.”

19. In its submissions, the applicant states:

“11. The opponent’s mark consists of the single word COOLTEX. Whilst presented as a single word, no part of which is stylised or emphasised in any way, it naturally breaks down into two component words. The word COOL is descriptive of the nature of, or a characteristic of, the goods at issue i.e. that the products allow a user of the goods to maintain a cool temperature and subsequently is a non-distinctive element for the goods. The word TEX, a commonly used abbreviation for “technology” is, again, descriptive of the goods i.e. that the goods take advantage of technology or technology is an important element of the manufacturing process.”

20. In relation to the visual, aural and conceptual position, in its submissions, the applicant states:

“13. The only visual similarity between the marks is that they both begin with the same word COOL. The opponent’s mark is shown as one word and the applicant’s mark consists of two separate words. The applicant’s mark consists of 8 characters whereas the opponent’s mark consists of 7 characters.

14. The marks will be pronounced similarly whereby the opponent's mark will be pronounced as the plural to the applicant's mark.

15. The marks have the same conceptual meaning..."

21. The competing marks are shown above. They consist of 7 letters presented as a single word (the opponent's mark) and eight letters presented as two four letter words (the applicant's mark). In my view, neither parties' marks have any dominant elements, the distinctiveness of each mark lying in its totality. Although the marks are presented differently, the fact that they are only one letter different in length and the first six letters of each mark are identical, results, in my view, in a high degree of visual similarity between them. On the applicant's own analysis, the competing marks are aurally similar differing only to the extent that the opponent's mark will be pronounced as the plural of the applicant's mark (they are, in my view, aurally similar to a high degree) and conceptually identical. Considered overall, the competing marks are, in my view, similar to a high degree.

Distinctive character of the opponent's earlier trade mark

22. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings – *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

23. As these are fast track opposition proceedings in which neither party has sought leave to file evidence, I have only the inherent characteristics of the opponent's mark to consider. In its submissions, the applicant states:

"18. The inherent distinctiveness of the opponent's earlier mark is extremely low because it is wholly descriptive of the characteristic and intended purpose of the goods..."

24. Whilst I accept that the word COOL may be used to indicate a characteristic of some of the goods at issue, when it is conjoined with the word TEX (which the applicant states is a commonly used abbreviation for the word technology), the resulting whole cannot, in my view, be said to lack any distinctive character (were that to be the case, the applicant's mark would, of course, also lack distinctiveness on the same basis). In my view, the opponent's mark is possessed of (at least) the minimum degree of distinctiveness necessary to justify *prima facie* acceptance.

Likelihood of confusion

25. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind

26. I begin by reminding myself that the applicant accepts that the competing goods are identical or similar and that the competing marks are phonetically similar and conceptually identical. Earlier in this decision, I concluded that: (i) the competing goods are identical, (ii) the average consumer of the goods at issue is a member of the general public who will select the goods by predominately visual means and who is likely to pay a somewhat higher than normal level of attention when doing so, (iii) the competing marks are similar to a high degree, and (iv) the opponent's earlier mark is possessed of (at least) the minimum degree of distinctiveness required to justify prima facie acceptance. In reaching a conclusion, I also note the applicant's following submissions, in which it states:

"2. The applicant contends that the differences between the marks are sufficient enough to allow consumers to clearly define the two trade marks and which will, subsequently, avoid any potential confusion for the relevant public."

"15. The marks have the same conceptual meaning but that is not to say that the conceptual similarities will give rise to a likelihood of confusion. As stated in ENERCAP [BL- O/295/98], conceptual similarity is relevant but it must be a conceptual similarity which is likely to cause confusion."

"19...However, as the GC held in *Meda Pharma GmbH & Co. KG, c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI) les affaires jointes T-492/09 et T-147/10*, where goods are identical it is not essential, in order to exclude the likelihood of confusion, that there is a large difference between the trade marks being compared. This is the case whether the earlier trade mark has limited distinctiveness.

20. It is well established (*Sabel v Puma*) that the more distinctive the earlier trade mark, the greater the likelihood of confusion will be. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millet LJ commented upon the logical corollary of this proposition:

"The more distinctive the earlier mark, the greater will be the likelihood of confusion. The converse, of course, follows. The more descriptive and the less distinctive the major feature of the mark, the less the likelihood of confusion."

27. Whilst I understand and accept the principles outlined above, in reaching a conclusion, I must, given my conclusions above, compare the competing marks as wholes. I must also remember that in Case C-196/11 P, *Formula One Licensing BV v*

OHIM, Global Sports Media Ltd, the CJEU made it clear that is not permissible for me to regard the opponent's earlier mark as having no distinctive character.

28. I bear all of the above in mind, and remind myself once again of the relatively low degree of distinctive character the earlier mark possesses and the above average degree of care the average consumer will display when selecting the goods at issue. Having done so, I have concluded that the combination of the identity in the goods and the high degree of similarity between the competing marks, points to a likelihood of direct confusion i.e. the average consumer is likely to mistake one trade mark for the other.

Conclusion

29. The opposition based upon section 5(2)(b) of the Act to all of the goods in the application succeeds in full and, subject to any successful appeal, the application will be refused.

Costs

30. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but making no award to the opponent in respect of its written submissions (which simply repeated comments contained in its notice of opposition), I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Opposition fee:	£100
Total:	£300

31. I order Softheads Limited to pay to Health Beds Limited the sum of **£300**. This sum is 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 9th day of May 2014

C J BOWEN
For the Registrar
The Comptroller-General