

O-180-15

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION
NO 2656102 IN THE NAME OF GUTTERCLEAR UK LIMITED
OF THE TRADE MARK



AND AN APPLICATION FOR CANCELLATION THEREOF
UNDER 500205 BY ENVIROTECNIC LTD

1. The trade mark shown on the front cover of this decision is registered under no 2656102, stands in the name of Gutterclear UK Limited (“the registered proprietor”), has a filing date of 13 March 2013 and was entered on the register on 28 June 2013. It stands registered in Class 37 for:

Commercial, industrial & residential cleaning services. Cleaning equipment rental services.

2. On 4 November 2013, an application to declare the registration invalid was filed by Envirotecnic Ltd (“the applicant”). The application is made under the provisions of section 47 of the Trade Marks Act 1994 (“the Act”), founded on an objection on two grounds:

- Under section 5(2)(b) of the Act on the basis that the applicant has an earlier Community trade mark (“CTM”) no 8475221 which is a similar mark and for similar goods and there is a likelihood of confusion between the respective marks. CTM 8475221 stands in the name of the applicant company, was applied for on 6 August 2009 and was entered in the register on 21 January 2010;
- Under section 3(6) of the Act on the basis that the registered proprietor’s registration was applied for in bad faith.

3. The registered proprietor filed a counterstatement denying each of the grounds of objection.

4. I pause here to record that the CTM relied on by the applicant was originally recorded in the name of another company, the sole director and owner of which is the same as that of the applicant. It was claimed by the applicant that it used the CTM under a licence from the original CTM holder, a fact that was not accepted by the registered proprietor. Given that the CTM now stands in the name of the applicant, it is entitled to rely on it in these proceedings in its own right. For this reason, I do not intend to refer to any evidence or submissions which refer to the originally recorded holder of the CTM or any disputed licence.

5. Both parties filed evidence and, as neither sought to be heard, I give this decision after a careful review of all the papers.

6. Section 47 of the Act states:

“(1)The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2)The registration of a trade mark may be declared invalid on the ground-

a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

The objection under section 5(2)(b)

7. Section 5(2)(b) of the Act states:

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

8. An earlier trade mark is defined in section 6 of the Act. It states:

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

(a) a registered trade mark, international trade mark (UK), 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,

(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), (ba) a registered trade mark or international trade mark (UK) which-

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) ...”

9. It is clear from the above, that the dates to be taken into account are the dates of application i.e. the filing dates of the respective registrations. As can be seen from the details set out above, the applicant’s CTM has a filing date which predates that of the registered proprietor’s mark. It is an earlier trade mark. The applicant is not required to show that it has made use of its mark but is entitled to rely on it for all of the goods for which it is protected. This is because section 47(2A) of the Act does not require an applicant to prove use of an earlier mark where the registration procedure for that mark was completed within the period of five years ending with the date of the application for the declaration of invalidation, as is the case here.

10. Whilst the applicant has completed the relevant part of its statement of grounds under section 5(2)(b), that statement makes reference to an unnamed third party’s use of a domain name, that company’s manner of trading and subsequent actions all of which are irrelevant to the objection under this ground. The statement also refers to the registered proprietor and states:

“David Dixon of GutterClearUK Ltd was contacted about the improper use of the name Gutter Clear in March 2013...When we initially contacted Mr Dixon he said that the directors of the company were looking ‘at other options’ ie they were considering other names to use to avoid any confusion with the GutterClear name or infringement of the trademark.”

11. For the sake of completeness, I set out what the registered proprietor states in its counterstatement regarding the objection under this ground:

“He applies for the invalidation under this section by claiming the mark is similar. The only similarity is the actual words “Gutter” and “Clear” both words are customarily in the current language of bona fide businesses and an established practise of the trade, notwithstanding keywords use extensively by internet search engines.

If he is relying on identical or similar goods and services in his claim for invalidation, then we must submit the earlier community trade markcannot be confused with our mark...”

12. Neither parties’ statements were prepared by trade mark professionals, however, both make reference to the matter of “confusion”. I proceed on the basis that the applicant claims the registered proprietor’s mark falls foul of section 5(2)(b) of the Act whereas the registered proprietor denies this.

13. The factors to be considered under this ground have been the subject of a large number of cases before the Courts. In determining whether there is a likelihood of confusion between the respective parties’ marks, I look to certain principles which are gleaned from the following decisions of the EU courts: *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen*

Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles are:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the respective goods and services

14. For ease of reference, the goods and services to be compared are as follows:

Registered proprietor's services	Applicant's goods
Class 37 Commercial, industrial & residential cleaning services. Cleaning equipment rental services.	Class 19 Non-metal rain gutter filters in the nature of foam insets for maintaining gutters and downspouts.

15. Again, previous decisions issued by the Courts set out the factors to be taken into account when assessing the similarity of the goods and services. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated, at paragraph 23 of its judgment, that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

16. The relevant factors identified by Jacob J. in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods and services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert

sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

18. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

19. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

20. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

21. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

22. The specification of goods of the applicant's earlier mark is, essentially, gutter filters made of foam. Gutter filters are goods used by property owners and are intended to prevent gutters becoming blocked and so allow free draining. Such goods are available through e.g. hardware or do-it-yourself stores, whether on the high street or online. The registered proprietor's registration is for cleaning services and services for the rental of cleaning equipment. Cleaning services are used by members of the general public and/or businesses who wish to have something or somewhere cleaned, whether by renting suitable equipment to be able to do it themselves or getting someone else to do it for them. They are services which are widely available. In the case of cleaning services they may be provided through general or specialist cleaning companies whereas the rental services are additionally available through hire stores and, I am aware from my own knowledge, from stores such as dry cleaners and supermarkets. The services have not been limited and so will include services for (the rental of equipment for) the cleaning of guttering. In relation to these latter services, they will be used by property owners to remove a build up of debris in guttering so as to allow free draining. The applicant's goods are not similar to the registered proprietor's rental services or to the majority of its cleaning services. In respect of the registered proprietor's services which are for cleaning guttering, however, their users overlap with the applicant's goods and their ultimate purpose, to allow free draining of guttering are the same, however, their natures differ and one is not indispensable or important for the use of the other nor is there any meaningful competition between them. I have no evidence to show that there is any overlap in their channels of trade. To the extent there is any similarity between the applicant's goods and the registered proprietor's services as they refer to cleaning gutters, that similarity is extremely low.

The average consumer and the nature of the purchasing process

23. 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*.

24. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"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."

25. As indicated above, cleaning services and the rental of cleaning equipment are services which may be bought by businesses or by the general public. Cleaning services may be highly specialised e.g. the deep cleaning of a hospital theatre or commercial kitchen or may be more general e.g. the cleaning of domestic carpets or


windows. The purchasing process is equally wide, with the more specialised cleaning services likely to be purchased following e.g. pre-contract negotiation setting out the standards and timescale to be met whereas the more general are likely to be made with an eye to convenience. Even for the more general services such as gutter cleaning services, at least an average degree of care in their purchase is likely to be taken to ensure they meet the purchaser's needs in terms of what work is to be done, when and by whom and at what cost. Rental services are also likely to be purchased with at least an average degree of care so as to ensure the customer rents the correct equipment and knows what ancillary materials he might need to purchase to suit the job which he intends to carry out and which are compatible with that equipment. The applicant's goods are likely to be bought by self-selection from a display in store or online and again, will involve an average degree of care to ensure they are suitable for and fit his particular guttering and to establish how they are fitted. The respective goods and services are unlikely to be a purchase made on a daily basis but they are widely available and likely to come to the purchaser's attention in ways that mean the visual considerations are of most relevance though I do not discount the fact that aural considerations come into play given that they may be subject of recommendations from others.

Comparison of the respective marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

27. It would be wrong, therefore, artificially to dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. For ease of reference, the marks to be compared are:

Registered proprietor's mark	Applicant's mark
	Gutter-Clear

28. The applicant's mark consists of the hyphenated words Gutter-Clear in title case, no part of which is highlighted in any way. Both words are in everyday use and have well-known meanings and each plays an equal role in the mark. It has no dominant

elements and its distinctiveness rests in the whole. The registered proprietor's mark is made up of a device (in green) of a leaf with raindrops on it followed by the word GUTTERCLEARUK presented in capitals letters in ordinary type face. Whilst presented as a single word, it naturally breaks down in the well-known component words and abbreviation GUTTER, CLEAR and UK, more so because each is presented in a different colour (black, blue, grey). Beneath the words is a partial reflection of them suggesting that the words and abbreviation themselves are standing in water. Whilst the leaf device will not be overlooked, it is the words GUTTERCLEARUK which form the dominant part of the mark both because of the proportion of the mark they form and because of the general principle that "words speak louder than devices".

29. Despite the presence of the hyphen, as the word element of the registered proprietor's mark begins with the same two words which make up the applicant's mark, there are clear visual and aural similarities between them. The presence of the leaf device and abbreviation UK lead to clear visual differences between them. Whilst the leaf device has no effect aurally, the abbreviation UK does add an aural difference. The words Gutter Clear (whether hyphenated or otherwise separated or not) are in everyday language and will bring to mind something intended to assist in making or keeping gutturing clear of something else. The non-distinctive abbreviation UK brings to mind either a UK based company or a company which operates throughout the UK. The leaf device brings to mind either a service to clear gutters of (amongst other things) leaves or may bring to mind an ecologically sound service. Whilst there are conceptual similarities between them, there are also clear conceptual differences between the respective marks.

The distinctiveness of the earlier mark

30. 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)."

31. The applicant has filed evidence in the form of two witness statements dated 10 July 2014 and 17 January 2015 from David Davies. Mr Davies states he is the sole owner of both the applicant company and another company in whose name the application for registration of the earlier mark was originally made and granted. As I indicated earlier, this led to some dispute between the parties both before and in the early stages of these proceedings, however, as the earlier mark now stands in the name of the applicant, there is no need for me to review the evidence regarding the question of whether the applicant had the necessary authority to use the mark. The majority of the rest of Mr Davies' witness statements concern the registration and ownership of various website addresses and company names but I do not intend to refer to it. This is because domain names and company names are subject to their own legal registration regimes and any registration under those regimes give rights which are separate from any granted by registration under the Trade Marks Act and are not therefore relevant to the consideration I have to make under section 5(2)(b) of the Trade Marks Act.

32. In respect of the applicant's trade mark and the products sold under it, Mr Davies states that development of the product began in 2009 with the product itself being launched in 2012. I note, in passing, that this conflicts to some degree with the content of his exhibit 4 whereby he produces an email he sent to the registered proprietor on 12 March 2013. In this exhibit he refers to "our GutterClear product, which we are about to launch nationally" having "tested out products in January 2008 and prototypes had been supplied under the name GutterClear soon after that".

33. Mr Davies states that his goods are offered for sale through the retailers Screwfix and B&Q. At exhibit 6, he provides what appears to be an extract from the Screwfix website. The text on the page notes that the product shown is intended for fitting "above the roofing tile or between the tile and felt. It can even be fitted into the gutter, provided an eaves tray is in place" to prevent blockages in gutters. It shows a roll of what is described as Gutter-Clear Mesh 5m x 110mm sold, at £10.99, with 14 spring clips for its fitting. It is not clear to me that this is a non-metal rain gutter filter *in the nature of a foam insert* as is specified in the earlier registration, however, nothing rests on this because the page is undated and so does not assist the applicant in establishing what the position was at the relevant date. Also included within this exhibit are copies of two photographs which are said to have been taken at an unidentified B & Q store which show a point of sale display within the building materials part of a store. The display shows the words GUTTER CLEAR presented vertically, one letter above the other without hyphenation and notes that the product (which I cannot see on the photograph) "prevents blocked gutters". Again, the page is undated.

34. Mr Davies provides no detail to show that any sales have been made of the goods covered by the registration at any time. There is no evidence of e.g any turnover or volume of sales made under the earlier mark, invoices or other similar records, any advertising or promotional expenditure nor is there any evidence from customers or the trade. Absent such evidence, the applicant has not shown that its mark has accrued any enhanced distinctive character through its use. In my view the words Gutter-Clear have a very low level of inherent distinctiveness for goods which are intended, as Mr Davies' evidence shows, to keep gutters clear.

Likelihood of confusion

35. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I also have to factor in the distinctive character of the earlier mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, 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 on the imperfect picture of them he has retained in mind.

36. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

37. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

38. Earlier in this decision I found:

- To the extent that the services of the registered proprietor are for (equipment for) cleaning guttering, any similarity with the applicant’s goods is extremely low. For all other services, there is no similarity;
- The average consumer of the goods and services is a member of the general public who will purchase them with at least an average degree of care;
- Whilst there are some visual, aural and conceptual similarities between the respective marks, there are also clear visual, aural and conceptual differences between them;
- The distinctiveness of the earlier trade mark rests in its whole. It is a mark of very low inherent distinctiveness which has not been shown to have been enhanced through its use.

39. Taking all matters into account and making a global comparison as I am required to do, I find that there is no likelihood of either direct confusion (where one mark is mistaken for the other) or indirect confusion (where the average consumer will assume that the registered proprietor’s goods are those of the applicant or some undertaking economically linked to them). I consider the differences between the marks outweigh the similarities and the (at best) extremely low degree of similarity between the respective goods and services and degree of care taken over the purchase of them are more than sufficient to preclude such a likelihood, even considering imperfect recollection. The objection based on section 5(2)(b) of the Act fails.

The objection under section 3(6) of the Act

40. Section 3(6) of the Act states:

“3 (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

41. The applicant puts its case in the following terms:

“There is clear evidence that the trademark was registered in bad faith. Mr Dixon did not make any attempt to file a trademark until after he was contacted about the infringement of the Gutter-Clear trademark. When he was contacted in March 2013, he acted in bad faith by saying that he was investigating other names to change it to, whilst at the same time he had filed a trademark application for a logo using the name GutterClearUK. He pretended that he was going to change the name so that no objection would be filed by Envirotecnic Ltd.

A further demonstration of bad faith is the fact that GutterClearUK Ltd did not file a trademark application for the name GutterClearUK because (sic) they knew that as a name registration it would not have been allowed as it was too similar to the existing name Gutter-Clear (and for a similar purpose), which had previously been registered. They instead filed a trademark application as a logo in order (sic) 'cheat' the system to get his logo registered."

42. The registered proprietor's counterstatement was filed by Mr Dixon, who is described on the form as Director of the registered proprietor. The registered proprietor alleges the applicant's objection is:

"born out of malice with intent, having bullied the previous company owners and continues to bully anyone with any part of the name Gutter or Clear in their trading name. He has already failed to take our domain, web name from us and will continue to pursue others should his application be granted."

It continues:

"Prior to setting up our trading company in 2010 we carried out extensive and through (sic) due diligence to ensure our services, proposed market and trading name would be well received by our customers. At the time we found several similar named companies registered and operating in our field, including other websites, none were concerned as to our potential competition when contacted.

We did however see a European registered community trade mark for [the earlier CTM]. Upon further investigation of the mark we found no such company or trading name within UK or Europe or indeed any website. A domain search returned a generic registrants advertising place nothing related to Mr Davies, Envirotecnic Limited, Gutter-Clear or otherwise. We were unable to confirm the validity of [the CTM's earlier holder].

Taking legal advice we were informed of trademark law and felt it should not be of concern.

[The registered proprietor] is a legitimate UK registered company. The company purchased its own web domains www.gutterclear.co.uk and www.gutterclear.eu All were available and purchased without any complaint or opposition.

In November 2012, [the registered proprietor] made the decision to seek a trademark registration. It quickly became apparent the generic dictionary terms such as Gutter, Clear & UK where (sic) not in themselves trade mark able. Our online application with the IPO office dated 21st December 2012 subsequently lapsed pending further legal advice.

In March 2013 we were in the process of preparing a second IPO application to register our company's legitimate image [logo] (GutterclearUK). When somewhat surprised, Mr Davies called claiming to be the owner of a name "Gutterclear" and informing us; in no uncertain terms, we should stop using

our company name, Gutterclear UK Limited otherwise he will be sued! He followed this up with an email and various copies of correspondence showing his approach to a previous owner of the web domain. He also included early correspondence from the trademark agent for Envirotech Malta, Revomark.

We immediately took a dislike to Mr Davies's approach and advised formally the company had no intention to infringe his trademark but we would be seeking further legal counsel.

Our own application was certainly not a result of Mr Davies's approach but a legitimate attempt to protect or (sic) own image (GutterclearUK) in class 37 Commercial & residential cleaning services and not as Mr Davies's (sic) states to "Cheat the System".

43. After giving some details of the trade mark examination process, the statement continues:

"Since, trying hard to placate Mr Davies we have explained it is not illegal, for one company or other to have similar or the same name. Nor that his gutter product advertised on his hastily established web site and sold through Screwfix is not the same product trademarked as Gutter-Clear, a filter in the nature of foam insert but a generic gutter mesh freely available in most shops including the 99p shop. He claims to have patented his design in 2011 but a simple search found nothing. Notwithstanding this, there is a company in the US with a similar foam gutter filter named www.gutterclear365.com they also have a registered trademark!

We have spoken with a number of gutter clear name holders some of which can be seen from a simple web search who have, at best been irritated by Mr Davies's approach. Each of who have said they are willing to present evidence of his harassment if so required."

It concludes:

"The completion of this section does not refer to any goods or services in the registrations as required but merely bemoans our approach and interpretation of trademark law. He cannot simply claim bad faith, where we sought to avoid any perceived conflict by using the IPO's Right Start Examination service. It's his mark that lacks suitability for the reasons detailed in this submission."

44. The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT*

WEEKLY Trade Mark [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

45. In *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07, the CJEU stated that:

"46.....the fact that a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that that sign enjoys some degree of legal protection is one of the factors relevant to the determination of whether the applicant was acting in bad faith".

47. In such a case, the applicant's sole aim in taking advantage of the rights conferred by a Community trade mark might be to compete unfairly with a competitor who is using the sign which, because of characteristics of its own, has by that time obtained some degree of legal protection.

48. That said, it cannot be excluded that even in such circumstances, and in particular when several producers were using, on the market, identical or similar signs for identical or similar products capable of being confused with the sign for which registration is sought, the applicant's registration of the sign may be in pursuit of a legitimate objective.

49. That may in particular be the case.....where the applicant knows, when filing the application for registration, that a third party, who is a newcomer in the market, is trying to take advantage of that sign by copying its presentation, and the applicant seeks to register the sign with a view to preventing use of that presentation.

50. Moreover.....the nature of the mark applied for may also be relevant to determining whether the applicant is acting in bad faith. In a case where the sign for which registration is sought consists of the entire shape and presentation of a product, the fact that the applicant is acting in bad faith might more readily be established where the competitor's freedom to choose the shape of a product and its presentation is restricted by technical or commercial factors, so that the trade mark proprietor is able to prevent his competitors not merely from using an identical or similar sign, but also from marketing comparable products.

51. Furthermore, in order to determine whether the applicant is acting on bad faith, consideration may be given to the extent of the reputation enjoyed by the sign at the time when the application for registration as a Community trade mark is filed.

52. The extent of that reputation might justify the applicant's interest in ensuring wider legal protection for his sign."

46. Mr Davies's evidence at exhibit 4 shows, and it is not disputed, that on 12 March 2013 he sent an email to the registered proprietor advising them of his company's CTM. That email contains the following:

"It is an infringement of our trademark protection for you to use the name GutterClear and would request that you change your company name, to avoid confusion in the market place for our GutterClear product, which we are about to launch nationally. It is also an offence to place TM logo next to a name if it is not registered. You must have been aware when you started trading that the domain names were not available and therefore there was likely to be a company using this name. It was also the case that a trademark search would have shown our registration of the name."

47. It is clear that the registered proprietor entered into correspondence with Mr Davies as a result of his email. That correspondence, at Exhibits 3 and 4, is largely in the form of holding replies by email and indicates that the matter has been passed to the registered proprietor's management team (email 13 March 2013) and trade mark advisor (email 27 March 2013). A formal response was sent in letter form on 12 April 2013. The letter contains the following:

"As you know we have sought the advice of our legal advisors and in turn a trade mark specialist. We have to advise we are actively seeking ways we can avoid any assumed infringement on our part and will continue to do so. We are further investigating and reviewing all similar names as you suggested.

That said, it is not the intention of [the registered proprietor] or its officers to pass off as you, nor your company or your proposed gutter product. We are not planning to manufacture or counterfeit any product you have designed or produced. Your trademark is not a company name but a product which you have registered under class 19. This mark; although similar in name, does not look the same and any public confusion would be small. We are a services company and you a design manufacturer.

As you say: you have communicated with and authorised a business in Gloucester, trading as Gutterclear, using the web domain www.gutterclear.org as they were prepared to identify themselves as not a related business to you, your company or product. There is no reason why we may not be prepared to do the same.

Whilst we undertook due diligence before forming this company we did not find any record of a patent or company name for Gutter-Clear or similar, We did find a web domain Gutter-Clear.co.uk which is not active and your company mark again not trading.”

48. The registered proprietor sent a further letter 20 June 2013. It contains the following:

“Firstly: We repeat it is not, nor ever has been the intention of Gutterclear UK Limited or its officers to copy or pass off as you, your company or your proposed gutter product. We are a services company and you a designer manufacturer. We are not planning to manufacture or counterfeit any product your have designed or produced. Your trademark is not a company name but a product name, which ideally should be patented. You have it registered under class 19. This mark; although similar in name, does not look the same and in our view any perceived public confusion would be minimal, if any at all, We will continue to express (if asked, no one has yet!) that we have no connection with your or your product.

We undertook due diligence before forming this company and apart from your gutter hyphen clear trademark we did not find any record of a patent or company name or similar. We did find a web domain Gutter-Clear.co.uk that is a blank advertising/holding page and as you say your company is not trading!

...

In conclusion it is our commercial and legal belief we do not infringe your mark and will therefore continue to use the name. “GutterclearUK” our company name.”

49. There is no doubt that the registered proprietor received correspondence from Mr Davies on 12 March 2013 formally notifying it of his company’s CTM and, the very next day, filed its own application for registration which is the subject of this decision. Whilst I understand why Mr Davies considers this indicated the application was made in bad faith, particularly in view of the fact that the registered proprietor

communicated with him and stated that “the company is looking at various options, one of which is changing the name” (email 17 April 2013), I do not consider this to be the case. Whilst the timing of the application might, of itself, raise doubts in his mind, there is no dispute that the registered proprietor had made an earlier application for registration, albeit without the device element, in December 2012, several months before it was contacted by Mr Davies.

50. As indicated earlier, the evidence shows there is a degree of confusion amongst the parties regarding the rights conferred by company names, domain names and trade mark registration and their interaction. It is accepted that the registered proprietor undertook “due diligence” checks which located a CTM of interest and made decisions as to the likely effects on its business as a result. Whether or not those decisions were legally sound is not a matter for me to decide but having been contacted by him, it obviously, I would say sensibly, thought it wise to seek further legal advice before responding substantively to Mr Davies’s letter. In the meantime, it filed an application for registration of a trade mark for services which, it later made very clear, it felt were very different to the goods Mr Davies stated he had been developing and intended soon to launch. In doing so, I consider that the registered proprietor did not act in bad faith in filing its trade mark application but instead, took a reasonable action that any business would take to preserve its position. The fact that the application it made comprised both a device and words, does not support a claim that it did so with the intention to “cheat the system”. The objection under section 3(6) of the Act fails.

Summary

51. The application for invalidation of the registration fails on each of the grounds on which it was brought.

Costs

52. The application having failed, the registered proprietor is entitled to an award of costs in its favour. I note that a Case Management Conference (“CMC”) took place at an early stage of proceedings, however, I make no award in respect of it. This is because, as I set out in my letter sent to the parties following the CMC, “I had called the CMC with the aim of assisting both parties as they are representing themselves and, given what had already been filed, appear to have limited knowledge of proceedings before the registrar.” The registered proprietor filed evidence and, whilst I acknowledge it would have taken time to prepare, I have not found it necessary to refer to in any detail as I consider it is not material to the issues to be determined. Neither party sought a substantive hearing, the decision being reached instead from a review of the written material before me.

53. The fact that the registered proprietor represented itself means that it is not entitled to an award of costs from the usual scale but rather is entitled to a proportion of it. The usual scale itself is not intended to recompense a successful party for the costs it will have expended but rather is intended to be a contribution towards those costs. I do not consider it necessary or proportionate to make further enquiries as to the costs to which the registered proprietor has been put. In all the circumstances, I

consider the sum of £500 to be a reasonable award to reflect the time and effort involved in defending the registration.

54. I order Envirotecnic Ltd to pay Gutterclear UK Ltd the sum of £500. 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 16th day of April 2015

**Ann Corbett
For the Registrar
The Comptroller-General**