

O-283-15

TRADE MARKS ACT 1994

IN THE MATTER OF

**INTERNATIONAL REGISTRATION NO. 1151539
IN THE NAME OF VAILLANT GMBH
TO REGISTER:**

AIRMASTER

IN CLASSES 7, 9 & 11

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 401377 BY AIRMASTER A/S**

BACKGROUND

1. On 15 September 2012 (claiming an International Convention priority date of 1 June 2012 from an earlier filing in Germany), Vaillant GmbH (“the applicant”) requested protection in the United Kingdom of the International Registration (“IR”) of the trade mark shown on the cover page of this decision. The United Kingdom Trade Marks Registry (“TMR”) considered the request satisfied the requirements for protection and particulars of the IR were published on 20 September 2013 for the following goods:

Class 7 - Parts for combined heat and power installations, namely combustion engines and generators; motors and engines (except for land vehicles); combustion engines for combined heat and power installations.

Class 9 - Equipment and systems for electricity generation, namely fuel cells; physical, electric and electronic instruments for measurement as far as included in this class, especially for heating, cooking, cooling, drying, ventilating and water supply apparatus, especially continuous flow water heaters, thermal storage water heaters, combined central heating and domestic water heaters, heating boilers, burners and thermal storage apparatus; apparatus and instruments for conducting, switching, transforming, accumulating or controlling of electricity; inverters; fuel cells for use in combined heat and power plants.

Class 11 - Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and water supply purposes; solar heating systems, heating boilers and burners; parts for building combined heat and power plants, namely heat pumps, fuel cell heating appliances.

2. The designation of the IR is opposed by Airmaster A/S (“the opponent”) under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition, which is directed against all of the goods in the IR, is based upon all the goods and services (shown below) in the following Community Trade Mark (“CTM”) registration:

CTM no. 9698986 for the trade mark: **AIRMASTER** which was applied for on 31 January 2011 and which completed its registration process on 18 May 2012:

Class 11 - Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, all aforementioned goods with the exception of hairdryers and other apparatus and instruments especially destined to hairdressers' saloons.

Class 37 - Building construction; Repair; Installation services.

Class 42 - Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software.

3. Having stated that the competing trade marks are identical, the opponent adds:

“Insofar as the specification of goods of the opposed application relates to: “apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and water supply purposes” it is identical to those goods which appear in class 11 of the opponent’s earlier trade mark registration.

Insofar as the specification of goods of the opposed application relates to other goods, these are similar to the goods and services covered by the opponent’s earlier trade mark registration.

The goods will be sold to the same consumers and through the same trade channels.”

4. The applicant filed a counterstatement in which, inter alia, it explained that the CTM upon which the opposition is based was the subject of cancellation proceedings before The Office for Harmonisation in the Internal Market (“OHIM”). It asked for these proceedings to be suspended until such time as OHIM issued its decision. Having noted that the opposition was directed against all the goods in its IR, the applicant concluded that as the opponent’s CTM was not protected in classes 7 and 9, the opposition should be rejected for (at least) those classes. The applicant stated:

“There is also no overlapping in class 11 concerning trademark IR 1151539 goods “solar heating, central heating boiler and burner, apparatus and plant for production electricity, namely fuel cells; fuel cells for use in combined heat and power plants; heat regenerators for combined heat and power plants, heat pumps, fuel cell heating appliances”. These goods are offered at totally different trade channels to another public. Especially the services of opposer’s mark are offered at totally different places to totally different consumers. Opponent’s [CTM] has low distinctiveness because mark is defined by 2 words that are common and have descriptive character for the goods and services of [the CTM]. So opponent’s mark may (if it is not cancelled by OHIM) only have protection for identity but not for products alike or goods totally different like fuel cells, heat pumps and solar heating. As a consequence there is no risk for confusion and opposition has to be rejected.”

5. The proceedings were suspended pending the issue of OHIM’s decision. In its decision, dated 4 August 2014 (no. 8386 C - Invalidity), OHIM rejected the applicant’s request to cancel the opponent’s CTM; this decision was not appealed. These proceedings were therefore brought out of suspension.

6. Although neither party filed evidence, both parties filed written submissions during the course of the evidence rounds and both filed written submissions in lieu of attendance at a hearing. I will keep all of these submissions in mind and refer to them, as necessary, later in this decision.

DECISION

7. The opposition is based upon sections 5(1) and 5(2)(a) of the Act which read as follows:

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

(b)...

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, 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.”

9. 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. As this trade mark had not completed its registration process more than 5 years before the publication date of the IR in suit, it is not (despite the applicant’s request in its counterstatement) subject to proof of use, as per section 6A of the Act. The opponent is entitled, as a consequence, to rely upon all of the goods and services for which its earlier trade mark stands registered.

Sections 5(1) and 5(2)(a) – case law

10. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

11. The trade marks to be compared are as follows:

AIRMASTER (the opponent’s trade mark)

and:

AIRMASTER (the application).

12. Both trade marks consist of the well known English language words AIR and MASTER presented in upper case and conjoined. Although the applicant’s trade mark is presented in bold in a slightly stylised font, applying the guidance in *Sadas*, the competing trade marks must be regarded as identical.

Comparison of goods and services

13. The competing goods and services are as follows:

Opponent’s goods and services	Applicant’s goods
Class 11 - Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, all aforementioned goods with the exception of hairdryers and other apparatus and instruments especially destined to hairdressers' saloons. Class 37 - Building construction; Repair; Installation services. Class 42 - Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software.	Class 7 - Parts for combined heat and power installations, namely combustion engines and generators; motors and engines (except for land vehicles); combustion engines for combined heat and power installations. Class 9 - Equipment and systems for electricity generation, namely fuel cells; physical, electric and electronic instruments for measurement as far as included in this class, especially for heating, cooking, cooling, drying, ventilating and water supply apparatus, especially continuous flow water heaters, thermal storage water heaters, combined central heating and domestic water heaters, heating boilers, burners and thermal storage apparatus; apparatus and instruments for conducting, switching, transforming, accumulating or controlling of electricity;

	<p>inverters; fuel cells for use in combined heat and power plants.</p> <p>Class 11 - Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and water supply purposes; solar heating systems, heating boilers and burners; parts for building combined heat and power plants, namely heat pumps, fuel cell heating appliances.</p>
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14. The applicant uses the word “namely” in all of its specifications, and the word “especially” is used in its specification in class 9 and in the exclusion in the opponent’s specification in class 11. The word “namely” must be approached, as indicated in the TMR’s classification guidance on the basis shown below:

“Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.

The use of the word “especially” has no such limiting effect.

15. In the judgment of the 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. (as he then was) 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, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. As to how words in specifications should be construed, in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) 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. (as he then was) 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 *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court ("GC") 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)."

20. In relation to complementary goods and services, in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the 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”.

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.”

21. As will be seen in the passages I reproduce below, in its submissions, the opponent places no reliance on its services in classes 37 and 42. Given the nature of the opponent’s submissions, I begin by reminding myself of the comments of the GC in *Les Éditions Albert René v OHIM*, Case T-336/03 in which it stated:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

For the sake of convenience, I will deal with the matter on a class-by-class basis.

Class 7

22. In its submissions, the opponent states:

“Turning to the goods in Class 7 of the Applicant’s trade mark, these are identical or highly similar to the goods in Class 11 of the Opponent’s earlier trade mark.

The opposed application covers “*parts for combined heat and power installations, namely combustion engines*” and “*combustion engines for combined heat and power installations*” in Class 7. The purpose of these goods is to generate heat and they are therefore identical to apparatus for heating purposes in Class 11 of the Opponents earlier trade mark registration. If they are not identical, they are similar.

The goods “*parts for combined heat and power installations, namely generators*”, are highly similar to apparatus for heating purposes in Class 11 of the Opponent’s earlier trade mark registration. This is because the generators are specifically for use in heat installations which is identical to apparatus for heating purposes. The goods are complementary and would be bought and used by the same consumer...

Further, motors and engines (except for land vehicles) are similar to the goods of Class 11 of the Opponent’s earlier trade mark registration. The Office is referred to the OHIM decision dated 19 January 2009 on Opposition No. B1111063 which found that:

“As regards the goods “Pumps (machines), in particular pumps for heating installations and water supply (except pumps for medical purposes); **motors and engines, in particular electric motors (except for land vehicles)**; spare parts for pumps, motors and engines, included in Class 7, but not including pumps, motors or engines for land vehicles not spare parts for any of such goods in Class 7” and the goods of Class 9 “Regulating and control apparatus, included in Class 9; electrotechnical apparatus and instruments (included in Class 9)”, the relevant goods may have the same purpose and use, namely bring part of a pump or motor. This applies, in particular, to the apparatus for sanitary, water supply and air conditioning purpose covered by the earlier mark. All those apparatus may have pumps. These goods are also complementary given that manufacture entails the use of both body parts and mechanical components. In addition, the goods in question are aimed at the same public, namely specific consumers in the area of pumps, motors, engines and parts thereof. Furthermore, they will be sold in the same shop so that the distribution channels are identical. Therefore, the goods are similar.”

23. As I mentioned above, the use of the word “namely” in the applicant’s specification means that it must be interpreted as reading:

“Combustion engines and generators being parts for combined heat and power installations; motors and engines (except for land vehicles); combustion engines for combined heat and power installations.”

24. The “combustion engines and generators being parts for combined heat and power installations” are indicated as being for the same purpose as the combustion engines in the final phrase in the specification. As it is broader in scope, the “motors and engines (except for land vehicles)” in the applicant’s specification would, in my view, encompass all of the other goods in the applicant’s specification. All of the above goods are either specified for being for use in (at least) “heat installations” or would include goods for such a purpose. Whilst keeping the comments in *Les Éditions Albert René* in mind, if one compares the applicant’s goods with (at least) the “apparatus for heating” in the opponent’s specification in class 11 in the context of the likely overlap in their respective nature, users, intended purpose, method of use, trade channels, as well as the likely complementary relationship that exists, there is, in my view, at least a reasonable degree of similarity between them.

Class 9

25. In its submissions, the opponent states:

“The above [OHIM] decision is also applicable to the comparison of goods in Class 9 of the opposed application.

The terms “physical, electric and electronic instruments for measurement as far as included in this class, especially for heating, cooking, cooling, drying, ventilating and water supply apparatus, especially continuous flow water heaters, thermal storage water heaters, combined central heating and domestic water heaters, heating boilers, burners and thermal storage apparatus” are all parts of apparatus for heating and cooking purposes which are covered in Class 11 of the Opponent’s earlier trade mark registration. Therefore, the goods are similar. Further, the goods in Class 9 covered by the opposed application are complementary to those in Class 11 of the earlier trade mark. The goods are therefore likely to be sold together through the same trade channels...

The remaining goods in Class 9, namely “Equipment and systems for electricity generation, namely fuel cells, apparatus and instruments for conducting, switching, transforming, accumulating or controlling of electricity; inverters; fuel cells for use in combined heat and power plants” are similar to the goods of Class 11 of the earlier application (sic) because these goods in Class 9 are part of the goods in Class 11. They are therefore complementary. Specifically, the measurement instruments in Class 9 of the opposed application are indicated as being especially for the apparatus included in Class 11 of the Opponent’s earlier Application (sic). Whilst the use of the term ‘especially’ is not limiting, it serves to indicate that the measurement instruments are complementary to the various pieces of apparatus covered by the earlier trade mark. They are used by the same consumer, manufactured by the same undertaking and sold through the same channels. As such, the goods are similar...”

26. Once again the use of the word “namely” means that the applicant’s specification must be interpreted thus:

Fuel cells for electricity generation; physical, electric and electronic instruments for measurement as far as included in this class, especially for heating, cooking, cooling, drying, ventilating and water supply apparatus, especially continuous flow water heaters, thermal storage water heaters, combined central heating and domestic water heaters, heating boilers, burners and thermal storage apparatus; apparatus and instruments for conducting, switching, transforming, accumulating or controlling of electricity; inverters; fuel cells for use in combined heat and power plants.”

27. The applicant’s “electric and electronic instruments for measurement...for heating, cooking, cooling, drying, ventilating and water supply apparatus, especially continuous flow water heaters, thermal storage water heaters, combined central heating and domestic water heaters, heating boilers, burners and thermal storage apparatus”, as the opponent suggests, are all likely to be either parts of the opponent’s goods for the same purposes in class 11 or used in conjunction with them; as a consequence, they are, in my view, complementary. For the same reasons, there is also, in my view, a complementary relationship between the remaining goods in the applicant’s specification i.e. “fuel cells for electricity generation”, “apparatus and instruments for conducting, switching, transforming, accumulating or controlling of electricity”, “inverters” and “fuel cells for use in combined heat and power plants” and at least “apparatus for heating” in the opponent’s specification in class 11 which again, notwithstanding the decision in *Les Éditions Albert René*, results, in my view, in at least a reasonable degree of similarity between them.

28. I will return to the degree of similarity between the applicant’s goods in classes 7 and 9 and the opponent’s goods in class 11 when I consider the likelihood of confusion.

Class 11

29. Having identified those goods in the IR which it considers to be identical to its goods in this class, in its submissions, the opponent states:

“The remaining goods in Class 11 of the opposed application, namely “*solar heating systems, heating boilers and burners; parts for building combined heat and power plants, namely heat pumps, fuel cell heating appliances*” are identical to “*Apparatus for...heating...purposes*” in Class 11 of the Opponent’s trade mark, This is because they are all apparatus for heating purposes and therefore fall within the broad term “*apparatus for heating purposes*”.

If such goods are not identical, they are similar. They are complementary to apparatus for heating purposes as they have the same function....”

30. As both parties' specifications in this class include "apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and water supply purposes", these goods are literally identical (the exclusion in the opponent's specification does not affect this analysis). In addition, given the manner in which the word "namely" must be approached, all of the goods which remain in the applicant's specification i.e. "solar heating systems", "heating boilers and burners", "heat pumps being parts of combined, heat and power plants" and "fuel cell heating appliances" would, in my view, be encompassed by the term "apparatus for heating" appearing in the opponent's specification in this class; the competing goods are, therefore, identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing decision

31. 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 *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."

32. As the opponent is only relying upon its goods in class 11, it is only necessary for me to consider the average consumer for the goods in classes 7, 9 and 11. The average consumer of such goods is, in my view, either a member of the general public or a professional user such as a tradesperson. Although I have no submissions on the point, as the goods are, in my experience as a member of the general public, most likely to be selected from the shelves of a bricks and mortar retailer/wholesaler or from the pages of a website, visual considerations are likely to dominate the selection process. That said, as many of the goods at issue are of a technical nature, the seeking of advice from, for example, a sales consultant seems highly likely, which in turn will add an oral component to the selection process. As to the degree of care that will be taken, (i) as many of the goods at issue are of a technical nature, (ii) as their selection may be infrequent (particularly in the case of a member of the public) and (iii) as the cost of many of the goods at issue is likely to be not insignificant, I would expect both average consumer groups to pay at least an average degree of attention to their selection.

The opposition based upon section 5(1) of the Act

33. Having concluded that the competing trade marks are identical as are the competing goods in class 11, the cumulative provisions of section 5(1) of the Act are satisfied and the opposition to the application in class 11 succeeds accordingly.

The opposition based upon section 5(2)(a) of the Act

34. For an opposition to succeed under this section of the Act, not only must the competing trade marks be identical (which they are), but there must also be similarity in the competing goods and services. Having concluded that there is at least a reasonable degree of similarity between the opponent's goods in class 11 and the applicant's goods in classes 7 and 9, I must now go on and determine if there is a likelihood of confusion.

Distinctive character of the earlier trade mark

35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services 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 and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As the opponent has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In its submissions, the applicant states:

“...for some of the goods and services by the mark the term is descriptive and for some others it deceives the public to their nature. The word “master” means “controller, head, supervisor, leader”, etc. As a consequence [the opponent's earlier trade mark] has only low distinctiveness because mark is defined by 2 words that are common and have descriptive character for the goods and services of the [opponent's earlier trade mark].”

36. By its application to OHIM, the applicant sought to cancel the opponent's earlier trade mark on the basis that it contravened those provisions of the Community Trade Mark Regulation (“CTMR”) which equate to the provisions of sections 3(1)(b),(c) and (d) and section 3(3)(b) of the 1994 Trade Marks Act; OHIM rejected those arguments and no appeal against that decision was filed. In its decision, OHIM considered, inter alia, the applicant's arguments mentioned above. Although I agree with the conclusions reached by OHIM, in my view, as the opponent's trade mark consists of the simple conjoining of two well known English language words (the individual meanings of which will be well known to the average consumer in the United Kingdom), its earlier trade

mark is possessed of no more than an average degree of inherent distinctive character; I will return to this point below.

Likelihood of confusion – the opposition based upon section 5(2)(a) of the Act

37. 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 trade 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.

38. I have already concluded that the opponent's earlier trade mark is possessed of no more than an average degree of inherent distinctive character, however, even if I am wrong in that conclusion and, as the applicant argues, the opponent's earlier trade mark has only a low degree of inherent distinctive character, that would not matter. That is because in *Formula One Licensing BV v OHIM*, Case C-196/11P, the CJEU held that:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

39. In addition, even if it were the case that the opponent's trade mark has only a weak inherent distinctive character that does not preclude a likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“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.”

40. In its submissions, the opponent states:

“Therefore, even if the goods which are similar are only found to be weakly similar to those of the earlier trade mark, there is still a likelihood of confusion since the trade mark are identical.”

41. Even if, contrary to my primary conclusion, the average consumer pays the highest degree of attention during the selection process, the identity in the competing trade marks combined with the (at least) reasonable degree of similarity in the competing goods leads, inevitably in my view, to a likelihood of direct confusion i.e. one trade mark will be mistaken for the other. Bearing in mind the interdependency principle (in which a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the respective trade marks), I would (given the identity in the competing trade marks and the average degree of distinctiveness the opponent’s earlier trade mark possesses) have reached the same conclusion even if I had only found there to be the very lowest degree of similarity between the goods at issue.

Overall conclusion

42. The opposition based upon section 5(1) of the Act succeeds in relation to the goods in class 11 of the application and the opposition based upon section 5(2)(a) of the Act succeeds in relation to the goods in classes 7 and 9. Subject to any successful appeal, the designation of the IR will be refused in its entirety.

Costs

43. 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, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Written submissions:	£300
Opposition fee:	£100
Total:	£600

44. I order Vaillant GmbH to pay to Airmaster A/S the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of June 2015

C J BOWEN
For the Registrar
The Comptroller-General