

O/399/19

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003297423 AND NO.
UK00003297418

TO REGISTER THE FOLLOWING TRADE MARKS:



(SERIES OF 2)

AND

RECYCOOLA

RECYCOOLA

(SERIES OF 2)

IN CLASSES 11, 16, 17, 20, 21 AND 39

BY JASON ANDREW HARRIS

AND IN THE MATTER OF OPPOSITIONS THERETO
UNDER NO. 413009 AND 413010 BY RECYCOLD HOLDING B.V.

BACKGROUND AND PLEADINGS

1. On 16 March 2018, Jason Andrew Harris (“the applicant”) applied to register the trade marks shown on the cover page of this decision in the UK. The applications were published for opposition purposes on 6 April 2018. Registration is sought for the following goods and services:

Class 11 Heating apparatus; apparatus for heating; appliances for heating; freezing installations; apparatus for freezing; deep freezing apparatus; air freezing apparatus; deep freezing installations; cooling installations for deep freezing; combination apparatus for cooling and freezing; refrigerating and freezing equipment; refrigerated units; refrigerated food counters; refrigerated shipping containers; combined cooking stoves and gas containers; food and beverage cooking, heating, cooling and treatment equipment; cooking utensils, electric; industrial cooking installations.

Class 16 Paper; paperboard; industrial paper; paper stock; lining paper; cardboard; cardboard boxes; cardboard badges; cardboard packaging; cardboard cartons; cardboard labels; packing cardboard; cardboard containers; boxes of cardboard; cardboard shipping containers; industrial paper and cardboard; airtight packaging of cardboard; boxes of cardboard or paper; containers of cardboard for packaging; boxes of paper or cardboard; bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; shipping labels; packaging containers of card; packing containers of cardboard; packaging containers of paper; plastic wrap.

Class 17 Insulating materials; electrical insulating materials; plastics insulating materials; thermal insulating materials; insulating materials made of plastics; insulating materials for insulation against heat; insulating materials for insulation against light; insulating foils; insulating mats; insulating matting; insulating adhesives; insulating sheets; insulating

boards; insulating material; insulating materials made of polyethylene foam; molded foam for packing; packing foam in sheet form; low-density polyurethane foam for packing; molded foam insulated container packing for commercial transportation; packing materials; packing material; plastic materials in the form of chips for use as packing.

Class 20 Containers, and closures and holders therefor, non-metallic; flexible containers of plastics for the storage of liquids; flexible containers of plastics for the transport of liquids; containers, not of metal, for storage or transport; transport containers (non-metallic -); carrying containers (non-metallic -); plastics closures for containers; packaging containers of plastic; packing containers of plastic material; closures for containers, non-metallic; transparent food containers for commercial packaging use; closures, not of metal, for containers; receptacles of plastic for storing goods for transportation; plastic trays for foodstuff packaging; plastic boxes; non-metal lock boxes; boxes for storage purposes [plastic]; storing boxes, not of metal; stacking boxes of compressed fibre; containers for transport, not of metal; containers (non-metallic -) for transport purposes; non-metallic transportable exhibition stands [other than structures]; plastic trays [containers] used in food packaging; protective containers of non-metallic materials for packing goods; plastic stoppers for industrial packaging containers; plastic boxes for packing.

Class 21 Portable coolers; portable beverage coolers; non-electric portable coolers.

Class 39 Transportation; transportation of goods; transportation services; transportation of food; services for transportation; packaging articles for transportation; transportation of goods by road; transportation and storage of goods; transportation and delivery of goods; inspection of goods for transportation; shipping; shipping services; shipping of goods; packaging of food; packaging services; packaging of products; packaging of goods; packaging and storage of goods; packing and packaging services; storage; refrigerated storage; storage information;

storage of food; food storage services; storage of liquids; storage of containers; storage of packages; refrigerated storage of goods; storage services for goods; transport and storage of goods; storage and delivery of goods; arranging the storage of goods.

2. The applications are opposed by Recycold Holding B.V. (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade marks for the purpose of its oppositions:

RECYCOLD

(EUTM no. 16177032)

Filing date 16 December 2016; Registration date 16 June 2017

(“the First Earlier Mark”)



(EUTM no. 16177099)

Filing date 16 December 2016; Registration date 27 June 2017

(“the Second Earlier Mark”)

3. The opponent relies on all goods and services for which the earlier marks are registered, as set out in paragraph **16** below. The opponent submits that the parties’ respective goods and services are identical or similar and that the marks are similar.

4. The applicant filed counterstatements denying the claims made.

5. On 18 September 2018, the Tribunal wrote to the parties to confirm that the proceedings would be consolidated in accordance with rule 62(1)(g) of the Trade Marks Rules 2008.

6. The opponent is represented by Maguire Boss and the applicant is represented by Trade Mark Wizards. The opponent filed evidence in chief in the form of the witness statement of David Tate dated 6 November 2018. The applicant filed evidence in the form of the witness statement of Oliver Oguz dated 7 January 2019. The opponent filed evidence in reply in the form of the second witness statement of David Tate dated 7 March 2019. No hearing was requested, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

The Opponent's Evidence in Chief

7. As noted above, the opponent's evidence in chief consists of the first witness statement of David Tate, which is accompanied by 14 exhibits. Mr Tate is the opponent's trade mark attorney. I have read Mr Tate's evidence and, whilst I do not propose to summarise it in full, I have taken it all into consideration in reaching my decision. However, I note, in particular, the following points:

a. Brochures from Campingaz, a camping and caravanning supplies company, and a business called Dometic show that they both provide cooking apparatus and stoves, portable coolers, freezer packs, lighting products, BBQ and gas appliances¹.

b. Print outs of the Go Outdoors website dated 30 October 2018 list a variety of products under the heading "What are the different cooling options?", specifically coolbags, passive coolboxes, powered coolboxes and fridges².

¹ Exhibit DT7 and Exhibit DT10

² Exhibit DT8

c. Print outs from a selection of businesses show fridges, freezers and coolboxes being sold through the same outlets³.

d. A print out from the website for Cargo LLC dated 30 October 2018 states “Since 2012, ‘Cargo’ LLC provides services of whole and collected cargo transportation by land, by air and on the sea. ‘Cargo’ LLC also provides customs mediation (brokerage) service, cargo insurance, as well as financing mediation via up-to-date banking tools of external trade.⁴”

e. A print out from the website Global Forwarding lists sea freight, air freight, warehousing and distribution, logistics and supply and customs brokerage as services that it provides⁵.

f. A brochure for Buzz Catering Suppliers shows that storage boxes and kitchen utensils are both available for purchase⁶.

The Applicant’s Evidence

8. As noted above, the applicant’s evidence consists of the witness statement of Mr Oliver Oguz, which is accompanied by 9 exhibits. Mr Oguz is a Chartered Trade Mark Attorney and Director of Trade Mark Wizards, the applicant’s representatives.

9. Mr Oguz provides evidence about various companies who all use the prefix RECY or RECYC in reference to goods that are ‘recyclable’ or services that relate to ‘recycling’⁷. Mr Oguz has also provided dictionary definitions for the words ‘recycled’ and ‘cold’ but, as the meaning of these words does not appear to be contentious, I do not propose to reproduce those definitions here.

³ Exhibit DT9

⁴ Exhibit DT12

⁵ Exhibit DT12

⁶ Exhibit DT14

⁷ Exhibits JAH1 to JAH7

10. The applicant's evidence was accompanied by written submissions dated 7 January 2019. The applicant also filed written submissions in lieu of a hearing. Whilst I do not propose to summarise these here, I have taken them all into consideration and will refer to them where necessary below.

The Opponent's Evidence in Reply

11. As noted above, the opponent's evidence in reply consists of the second witness statement of Mr Tate, which is accompanied by 5 exhibits. Mr Tate's witness statement is intended to respond to points raised about the other companies referred to in Mr Oguz's witness statement which use the prefix RECY or RECYC in their trade names. I note Mr Tate's evidence and, whilst I do not propose to summarise that evidence here, I have taken it into consideration. I have also considered the submissions that accompanied Mr Tate's submissions and the opponent's written submissions in lieu of a hearing and will refer to them below where appropriate.

DECISION

12. Section 5(2)(b) of the Act states as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

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

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

13. 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.”

14. The trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions. As these trade marks had not completed their registration processes more than 5 years before the publication date for the applications in issue in these proceedings, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

15. The following principles are gleaned from the decisions of the EU courts in *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.

(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 greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

16. The competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
<p><u>Class 16</u></p> <p>Paper, cardboard; Printed matter; Adhesives for stationery or household purposes; Plastic materials for packaging (not included in other classes); Cardboard and paper material for packaging; Boxes of cardboard or paper; Packaging boxes; Paper bags and sacks; Plastic sacks, bags and film for packaging; Bubble packs (Plastic -) for wrapping or packaging; Cling film; Carrier bags; Rubbish bags; Craft paper; Gift wrap, gift wrap paper, gift boxes and gift bags; Paper tapes; Envelopes [stationery]; Packing list envelopes; Labels and tags not of textile; Label clips; Self-adhesive tapes, tape and glue for</p>	<p><u>Class 11</u></p> <p>Heating apparatus; apparatus for heating; appliances for heating; freezing installations; apparatus for freezing; deep freezing apparatus; air freezing apparatus; deep freezing installations; cooling installations for deep freezing; combination apparatus for cooling and freezing; refrigerating and freezing equipment; refrigerated units; refrigerated food counters; refrigerated shipping containers; combined cooking stoves and gas containers; food and beverage cooking, heating, cooling and treatment equipment; cooking utensils, electric; industrial cooking installations.</p>

stationery use; Parts for the aforesaid goods, included in this class.

Class 17

Plastics in extruded form for use in manufacture; Insulating, packing, stopping materials; Insulating materials for insulation against heat; Insulating paper; Rubber packaging; Packing (cushioning, stuffing) materials; Packing tape; Parts for the aforesaid goods included in this class.

Class 21

Household or kitchen utensils and containers; Portable cool boxes, non-electric; Non-electric cool boxes; Isothermic bags; Parts for the aforesaid goods, included in this class.

Class 35

Advertising; Business management; Business administration; Office functions; Publication of advertising texts; Distribution of advertising material; Promotional activities; Advertising; Provision of commercial information; Business organisation, business economic and business administration consultancy; Marketing services; Market canvassing, market research and market analysis; Business mediation in the purchase and sale, import and export,

Class 16

Paper; paperboard; industrial paper; paper stock; lining paper; cardboard; cardboard boxes; cardboard badges; cardboard packaging; cardboard cartons; cardboard labels; packing cardboard; cardboard containers; boxes of cardboard; cardboard shipping containers; industrial paper and cardboard; airtight packaging of cardboard; boxes of cardboard or paper; containers of cardboard for packaging; boxes of paper or cardboard; bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; shipping labels; packaging containers of card; packing containers of cardboard; packaging containers of paper; plastic wrap.

Class 17

Insulating materials; electrical insulating materials; plastics insulating materials; thermal insulating materials; insulating materials made of plastics; insulating materials for insulation against heat; insulating materials for insulation against light; insulating foils; insulating mats; insulating matting; insulating adhesives; insulating sheets; insulating boards; insulating material; insulating materials made of polyethylene foam; molded foam for packing; packing foam in sheet

and wholesaling and retailing of packaging materials and components of packaging; Business mediation in the purchase and sale, import and export, and wholesaling and retailing of paper, cardboard, printed matter, adhesives for stationery or household purposes, plastic materials for packaging, wrapping materials made of paper and cardboard, boxes of cardboard or paper, boxes for packaging, paper sacks and bags, plastic sacks, bags and film for packaging, bubble packs for wrapping or packaging, cling film and parts for the aforesaid goods; Business mediation in the purchase and sale, import and export, and wholesaling and retailing of carrier bags, garbage bags, craft paper, gift wrap, gift wrap paper, gift boxes and gift bags, paper tapes, envelopes, packing list envelopes, labels, label clips, adhesive bands, tape and glue for stationery use and parts for the aforesaid goods; Business mediation in the purchase and sale, import and export, and wholesaling and retailing of plastics in extruded form for use in manufacture, packing, stopping and insulating materials, insulating materials for insulation against heat, insulating paper, packaging of rubber, packing (cushioning, stuffing) materials, packing tapes and parts for the aforesaid goods;

form; low-density polyurethane foam for packing; molded foam insulated container packing for commercial transportation; packing materials; packing material; plastic materials in the form of chips for use as packing.

Class 20

Containers, and closures and holders therefor, non-metallic; flexible containers of plastics for the storage of liquids; flexible containers of plastics for the transport of liquids; containers, not of metal, for storage or transport; transport containers (non-metallic -); carrying containers (non-metallic -); plastics closures for containers; packaging containers of plastic; packing containers of plastic material; closures for containers, non-metallic; transparent food containers for commercial packaging use; closures, not of metal, for containers; receptacles of plastic for storing goods for transportation; plastic trays for foodstuff packaging; plastic boxes; non-metal lock boxes; boxes for storage purposes [plastic]; storing boxes, not of metal; stacking boxes of compressed fibre; containers for transport, not of metal; containers (non-metallic -) for transport purposes; non-metallic transportable exhibition stands [other than structures]; plastic trays

<p>Business mediation in the purchase and sale, import and export, and wholesaling and retailing of household or kitchen utensils and containers, portable cool boxes, coldboxes, isothermic bags and parts for the aforesaid goods; Organisation of events for commercial and advertising purposes; Compilation and management of data files; Consultancy and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the Internet.</p>	<p>[containers] used in food packaging; protective containers of non-metallic materials for packing goods; plastic stoppers for industrial packaging containers; plastic boxes for packing.</p> <p><u>Class 21</u> Portable coolers; portable beverage coolers; non-electric portable coolers.</p> <p><u>Class 39</u> Transportation; transportation of goods; transportation services; transportation of food; services for transportation; packaging articles for transportation; transportation of goods by road; transportation and storage of goods; transportation and delivery of goods; inspection of goods for transportation; shipping; shipping services; shipping of goods; packaging of food; packaging services; packaging of products; packaging of goods; packaging and storage of goods; packing and packaging services; storage; refrigerated storage; storage information; storage of food; food storage services; storage of liquids; storage of containers; storage of packages; refrigerated storage of goods; storage services for goods; transport and storage of goods; storage and delivery of goods; arranging the storage of goods.</p>
--	---

17. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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.”

18. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are 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.

19. 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.”

20. 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.”

21. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) 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.”

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. 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 the responsibility for those goods lies with the same undertaking.”

24. 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.”

Class 11

25. In its Notice of Opposition, the opponent states as follows with regard to the applicant's class 11 goods:

“11. The Applicant's goods in Class 11 are similar to the Opponent's goods in Class 21, with the Applicant's Class 11 cooling, freezing and refrigerating products being particularly similar to the Opponent's Class 21 cool boxes, and the Applicant's Class 11 heating and cooking apparatus being similar to the Opponent's Class 21 kitchen utensils and containers, the latter which would cover, inert [(sic)] alia, non-electrically heated hotpots and other cooking utensils and containers. The respective goods coincide in nature, distribution channels, relevant public and producers.”

26. “Freezing installations”, “apparatus for freezing”, “deep freezing apparatus”, “air freezing apparatus”, “deep freezing installations” and “cooling installations for deep freezing” in the applicant's specification are all terms which cover different types of freezer equipment. The opponent claims that these goods are similar to its “Portable cool boxes, non-electric” and “non-electric cool boxes”. I accept that the purpose of these goods overlap in that they are all intended to reduce the temperature of their contents. However, the applicant's goods are all intended to reduce their contents to a much lower temperature than the opponent's goods. Their users may overlap. Freezer units purchased by the general public are most likely to be purchased from stores specialising in household utility products, whereas cool boxes are more likely to be purchased from travel specialists such as the camping retailers shown in the opponent's evidence. I do not, therefore, consider that there will be a significant overlap in trade channels, although I accept there may be some. The method of use is likely to be similar. I consider these goods to be similar to a medium degree.

27. “Combination apparatus for cooling and freezing”, “refrigerating and freezing equipment” and “refrigerated units” in the applicant’s specification are more similar in use to the opponent’s “Portable cool boxes, non-electric” and “non-electric cool boxes” because they will all cover goods which are intended to cool rather than freeze. There will be overlap in user and uses. I also consider that there will be a degree of overlap in trade channels to the extent that travel businesses may sell both cooler boxes and portable refrigerator units as set out in the opponent’s evidence. I consider these goods to be similar to at least a medium degree.

28. “Refrigerated food counters” in the applicant’s specification are likely to be used by businesses rather than members of the general public, whereas the opponent’s cool boxes are more likely to be used by members of the general public. Whilst the uses overlap in that the goods are all intended to cool their contents, the specific uses differ as the applicant’s goods are intended for use on an industrial scale and the opponent’s goods are intended for use in travel on a small scale. The nature of the goods differs. There will be no overlap in trade channels and the goods are neither in competition nor complementary. I consider there to be only a low degree of similarity between the goods. I can see no further point of similarity which would put the opponent in a stronger position.

29. There may be overlap in user between “refrigerated shipping containers” in the applicant’s specification and the opponent’s packaging materials in class 16. There will be overlap in use, in that both are intended to ensure secure transportation of their contents, but the applicant’s goods have the added purpose of ensuring that goods are kept cool during transit. Whilst I accept that there may be a small degree of overlap in trade channels, the applicant’s goods are more likely to be specialist and therefore more likely to be sold by specialist suppliers, whereas the proprietor’s goods are more general products. I consider there to be a low degree of similarity between these goods. I can see no further point of similarity which would put the opponent in a stronger position.

30. In my view, the term “household or kitchen utensils” in the opponent’s specification is unlikely to cover goods such as cooking apparatus. Rather, this is more likely to

refer to pots and pans which are used in combination with heating apparatus. However, I recognise from the opponent's evidence that "heating apparatus", "apparatus for heating", "appliances for heating" and "combined cooking stoves and gas containers" in the applicant's specification would cover camping stoves and other similar goods. To this extent, there will be overlap in trade channels with "household or kitchen utensils and containers", "Portable cool boxes, non-electric" and "non-electric cool boxes" in the opponent's specification. There will also be overlap in user. However, the uses, nature and method of use of the goods will differ. I do not consider them to be in competition or complementary. I consider the goods to be similar to no more than a low degree. I can see no further point of similarity which would put the opponent in a stronger position.

31. The overlap that does exist between these goods does not apply to the applicant's "industrial cooking installations". There will be no overlap in trade channels between these goods and the users will be different. I consider these goods to be dissimilar.

32. "Portable cool boxes, non-electric" and "non-electric cool boxes" in the opponent's specification will be highly similar to "Food and beverage [...] cooling [...] equipment" in the applicant's specification. These goods will overlap in user, uses, trade channels, method of use and nature. I consider these goods to be highly similar. However, "food and beverage cooking, heating [...] and treatment equipment" in the applicant's specification cannot be said to share the same degree of similarity. In my view, these will share no more than a low degree of similarity for the same reasons set out in paragraph **30** above.

33. "Cooking utensils, electric" in the applicant's specification and "household or kitchen utensils and containers" in the opponent's specification will overlap in use, user and trade channels. They may also overlap in nature and method of use. I consider these goods to be highly similar.

Class 16

34. "Paper" and "cardboard" appear in both the opponent's specification and the applicant's specification and are self-evidently identical.

35. “Industrial paper”, “paper stock” and “lining paper” in the applicant’s specification all fall within the broader category of “paper” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

36. “Cardboard boxes”, “cardboard packaging”, “cardboard cartons”, “packing cardboard”, “cardboard containers”, “boxes of cardboard”, “cardboard shipping containers”, “airtight packaging of cardboard”, “boxes of cardboard or paper”, “containers of cardboard for packaging”, “boxes of paper or cardboard”, “packing containers of cardboard” and “packaging containers of paper” in the applicant’s specification all fall within the broader category of “cardboard and paper material for packaging” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

37. I understand “paperboard” in the applicant’s specification to be a type of paper which is thicker than usual; similar to card. This will fall within the broader category of “paper, cardboard” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

38. “Industrial paper and cardboard” in the applicant’s specification will fall within the broader category of “Paper, cardboard” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

39. The Cambridge English Dictionary defines “card” as “(a piece of) thick stiff paper⁸”. I therefore consider that “packaging containers of card” in the applicant’s specification will fall within the broader category of “cardboard and paper material for packaging” in the opponent’s specification. These good can, therefore, be considered identical on the principle outlined in *Meric*.

40. “Cardboard badges”, “cardboard labels” and “shipping labels” in the applicant’s specification all fall within the broader category of “Labels and tags not of textile” in the

⁸ <https://dictionary.cambridge.org/dictionary/english/card>

opponent's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

41. "Boxes of cardboard or paper" in the opponent's specification can be used for the storage of any number of materials. They are also articles that can be used for packaging purposes. "Paper bags and sacks" and "envelopes [stationery]" in the opponent's specification are articles and bags that can be used for packaging and wrapping different materials. These are, consequently, all goods which can fall within the broader category of "bags and articles for packaging, wrapping and storage of paper, cardboard or plastics" in the applicant's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

42. "Plastic wrap" in the applicant's specification will fall within the broader categories of "Plastic materials for packaging (not included in other classes)" and "plastic sacks, bags and film for packaging" in the opponent's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

Class 17

43. "Insulating materials for insulation against heat" appears in both the opponent's and applicant's specification. These goods are self-evidently identical.

44. "Insulating materials", "electrical insulating materials", "plastics insulating materials", "thermal insulating materials", "insulating materials made of plastics", "insulating materials for insulation against light", "insulating foils", "insulating mats", "insulating matting", "insulating adhesives", "insulating sheets", "insulating boards", "insulating material", "insulating materials made of polyethylene foam", "molded foam for packing", "packing foam in sheet form", "low-density polyurethane foam for packing", "molded foam insulated container packing for commercial transportation", "packing materials", "packing material", "plastic materials in the form of chips for use as packing" in the applicant's specification all fall within the broader category of "Insulating, packing, stopping materials" in the opponent's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

Class 20

45. “Containers, and closures and holders therefor, non-metallic”, “flexible containers of plastics for the storage of liquids”, “plastic boxes”, “non-metal lock boxes”, “boxes for storage purposes [plastic]”, “storing boxes, not of metal” and “stacking boxes of compressed fibre” in the applicant’s specification are all different types of storage boxes. “Boxes of cardboard or paper” in the applicant’s specification can also be used for storage purposes. There may be some difference in nature of the goods, but their purpose and users are likely to overlap. Their methods of use will also be the same. There may be some overlap in trade channels, although I recognise that the opponent’s goods are more likely to be sold in stationery shops whereas the applicant’s goods are more likely to be sold in homeware shops. I consider the goods to be similar to at least a medium degree.

46. “Flexible containers of plastics for the transport of liquids”, “containers, not of metal, for storage or transport”, “transport containers (non-metallic -)”, “carrying containers (non-metallic -)”, “plastics closures for containers”, “packaging containers of plastic”, “packing containers of plastic material”, “closures for containers, non-metallic”, “transparent food containers for commercial packaging use”, “closures, not of metal, for containers”, “receptacles of plastic for storing goods for transportation”, “plastic trays for foodstuff packaging”, “containers for transport, not of metal”, “containers (non-metallic -) for transport purposes”, “plastic trays [containers] used in food packaging”, “protective containers of non-metallic materials for packing goods” and “plastic boxes for packing” in the applicant’s specification are all goods used to package goods for transport purposes. There will, therefore, be overlap in user, purpose and method of use with “Packaging boxes” in the opponent’s specification. The goods are all likely to be available through outlets which sell packaging materials. There may be a degree of competition between them. I consider the goods to be highly similar.

47. The packaging materials in class 16 of the opponent’s specification are not exclusively for use by the domestic market. These goods will also cover industrial packaging products. In this sense there will be overlap in user and trade channels with

“plastic stoppers for industrial packaging containers” in the applicant’s specification. There may be a degree of complementarity. However, the nature and method of use of the goods is likely to differ. I consider these goods to be similar to a medium degree.

48. That leaves “non-metallic transportable exhibition stands [other than structures]” in the applicant’s specification. I can see no point of overlap in user, uses, method of use, trade channels or nature with the opponent’s goods. I can see no point of competition or complementarity. In the absence of any submissions to assist me, I consider these goods to be dissimilar to the opponent’s goods.

Class 21

49. “Non-electric portable coolers” in the applicant’s specification and “Portable cool boxes, non-electric” in the opponent’s specification are self-evidently identical.

50. “Portable cool boxes, non-electric” in the opponent’s specification falls within the broader category of “Portable coolers” in the applicant’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

51. “Portable beverage coolers” in the applicant’s specification falls within the broader category of “portable cool boxes, non-electric” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

Class 39

52. In its Notice of Opposition, the opponent states as follows with regard to the applicant’s class 39 services:

“14. The Applicant’s Class 39 services are similar to the Opponent’s services in Class 35, with the Applicant’s transportation and delivery services being particularly similar to the Opponent’s business mediation in the import and export of goods. The respective services coincide in distribution channels, relevant public and producers.

15. The Applicant's Class 39 packing, packaging, storage and refrigeration services are similar to the Opponent's packing, packaging, storage and cooling goods in Classes 16, 17 & 21. The respective goods and services are complimentary, and coincide in distribution channels, relevant public and producers."

53. The opponent has provided examples in its evidence of businesses which offer both mediation or brokerage services for import/export purposes and transportation services. To this extent, I accept that there will be overlap in user and trade channels between the opponent's "Business mediation in the purchase and sale, import and export, and wholesaling and retailing of packaging materials and components of packaging" (and its other business mediation services) and "Transportation", "transportation of goods", "transportation services", "transportation of food", "services for transportation", "transportation of goods by road", "transportation and delivery of goods", "inspection of goods for transportation", "shipping", "shipping services" and "shipping of goods" in the applicant's specification. However, the uses and nature of the service are different. The methods of use of the services will differ. I do not consider the services to be complementary within the meaning of the case law and I do not consider the services to be in competition. I consider the services to be similar to a medium degree.

54. I accept that part of the transportation process involves storage of the goods being transported. To this extent, there will be the same overlap in trade channels and user between the opponent's "Business mediation in the purchase and sale, import and export, and wholesaling and retailing of packaging materials and components of packaging" (and its other business mediation services) and "transportation and storage of goods", "storage", "refrigerated storage", "storage information", "storage of food", "food storage services", "storage of liquids", "storage of containers", "storage of packages", "refrigerated storage of goods", "storage services for goods", "transport and storage of goods", "storage and delivery of goods" and "arranging the storage of goods" in the applicant's specification as identified in paragraph **53** above. I consider the services to be similar to a medium degree.

55. “Packaging articles for transportation”, “packaging of food”, “packaging services”, “packaging of products”, “packaging of goods”, “packaging and storage of goods” and “packing and packaging services” in the applicant’s specification will cover a broad range of packaging services such as industrial packaging for businesses and domestic packaging for the general public (such as home removal businesses). In my view, it is likely that providers of such services are likely to also provide the equipment needed to package the goods. There will, therefore, be a degree of overlap in trade channels and users between the services and the opponent’s class 16 packaging goods. There may also be a degree of complementarity. However, the goods and services differ in nature, method of use and uses. I consider the goods and services to be similar to a medium degree.

56. As some degree of similarity between the goods and services is required for there to be a likelihood of confusion⁹, the opposition must fail in respect of the following goods in the applicant’s specification:

Class 11 Industrial cooking installations.

Class 20 Non-metallic transportable exhibition stands [other than structures].

The average consumer and the nature of the purchasing act

57. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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

⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

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.”

58. I have no submissions from the opponent on the average consumer for the goods and services in issue or the nature of the purchasing process. In its written submissions in lieu, the applicant states:

“16. Given the nature of both the Earlier Goods and Services and the Opposed Goods and Services, it is submitted that the average consumer will be a member of the public or a commercial purchaser, paying an average to above average degree of attention to the goods and services. They are not particularly specialist but some of them may be quite expensive and the average consumer is likely to pay a higher degree attention when spending larger sums of money (i.e. for ‘industrial cooking installations’ as against ‘wrapping paper’).”

59. I agree with the applicant that the average consumer for the goods and services in issue will be a member of the general public or a business user. The price of the goods and services will vary substantially from very low (in the case of paper and packaging materials) to high (in the case of transportation and business mediation services). A number of factors are likely to be taken into account such as volume, efficiency and quality of materials and so I consider that at least a medium degree of attention will be paid during the purchasing process, although I recognise that a higher degree of attention will be paid for some of the goods and services.

60. The goods are more likely to be purchased by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. Visual considerations will dominate the selection process for the goods, although I do not discount that there will also be an aural component to the purchase of the goods given that advice may be sought from a sales assistant or orders may be placed by telephone.

61. The services may also be purchased from specialist bricks and mortar premises or their online equivalent. The purchasing process is likely to be dominated by visual considerations, as the average consumer is likely to select the services following inspection of the premises' frontage, on websites and in advertisements (such as flyers, posters or online adverts). However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services. In addition, for those services which are more niche (such as business mediation or specialist transportation services) I recognise that an intermediary may be involved, in which case, aural considerations may play more of a role in the purchasing process than for the other goods and services in issue.



Comparison of trade marks

62. 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 the trade marks, 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.”

63. It would be wrong, therefore, to artificially 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.

64. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade marks
<p style="text-align: center;">RECYCOLD (the First Earlier Mark)</p>  <p style="text-align: center;">(the Second Earlier Mark)</p>	 <p style="text-align: center;">(“the First Application”)</p> <p style="text-align: center;">RECYCOOLA RECYCOOLA</p> <p style="text-align: center;">(“the Second Application”)</p>

Overall Impression

The First Earlier Mark

65. The First Earlier Mark consists of the invented word RECYCOLD. There are no other elements to contribute to the overall impression which is contained in the word itself.

The Second Earlier Mark

66. The Second Earlier Mark consists of the invented word RECYCOLD and a device which combines an image of a snowflake and the recycling symbol. The device is larger than the wording, but the eye is naturally drawn to the element that can be read. I consider that the overall impression of the mark lies in the combination of these elements, with the word and the device playing an equal role.

The First Application

67. The marks in the First Application consist of the invented word RECYCOOLA in large upper-case lettering. In the first mark in the series, the letters RECY are presented in green and the letters COOLA are presented in blue. In the second mark there is a variation in shading between the letters. The words INSULATIVE PACKAGING SYSTEM are presented beneath in smaller text. The wording is preceded by a device which combines a snowflake and a leaf. The word RECYCOOLA plays the greater role in the overall impression due to its size compared to the other elements. The device plays a lesser role. The words INSULATIVE PACKAGING SYSTEM are likely to be seen as descriptive of the goods and services offered under the mark and so will be attributed little trade mark significance by the average consumer. It, therefore, has the least impact on the overall impression.

The Second Application

68. The marks in the Second Application consist of the invented word RECYCOOLA. The first mark in the series is a word only mark. Again, in the second mark in the series, there is a variation in shading between the letters RECY and COOLA. In the first mark in the series, the overall impression lies in the word RECYCOOLA itself, with no other elements to contribute to the overall impression. In the second mark in the series, the word itself plays the greater role in the overall impression, with the shading playing a lesser role.

Visual Comparison

The First Application and the First Earlier Mark

69. Visually, the First Earlier Mark and the First Application coincide in the presence of the first six letters RECYCO-. These letters are followed by LD in the First Earlier Mark and OLA in the First Application. The First Application can also be visually differentiated by the presence of the leaf/snowflake device and the words INSULATIVE PACKAGING SYSTEM, which have no counterpart in the First Earlier

Mark although, as noted above, these will play a lesser role in the overall impression of the mark. As the First Earlier Mark is a word only mark it can be used in any standard typeface and registration in black and white will cover use of the mark in different colours. However, I note that this does not mean it is appropriate to apply complex colour combinations to the First Earlier Mark. Overall, I consider the marks to be visually similar to no more than a medium degree.

The First Application and the Second Earlier Mark

70. Visually, the same points apply regarding the similarity between the words used in the marks as noted above. However, the Second Earlier Mark also contains a snowflake device (albeit a different one). I recognise that the First Application is registered in either black and white or a green and blue colour scheme, whereas the Second Earlier Mark is registered in a pale blue colour. Overall, I consider the marks to be visually similar to a higher than medium degree.

The Second Application and the First Earlier Mark

71. Visually, the Second Application and the First Earlier Mark, again, coincide in the presence of the same first six letters – RECYCO. The point of difference is the letters LD in the First Earlier Mark and OLA in the Second Application. Both are word only, with minimal stylisation being used in the second mark in the Second Application series. As a general rule, the beginnings of words tend to make more of an impact than the ends. Overall, I consider the marks to be visually similar to a medium to high degree.

The Second Application and the Second Earlier Mark

72. Visually, the same points apply regarding the wording used as mentioned above. The point of difference is the stylisation of the wording in the Second Earlier Mark and the presence of the snowflake device which has no counterpart in the Second Application. I consider the marks to be visually similar to no more than a medium degree.

Aural Similarity

The First Application and the First Earlier Mark

73. Aurally, the First Application will be pronounced REE-SIGH-COO-LAA. The First Earlier Mark will be pronounced REE-SIGH-COLD. The device in the First Application will, clearly, not be pronounced. It is unlikely that the words INSULATIVE PACKAGING SYSTEM will be pronounced in the First Application because, as noted above, they are more likely to be seen by the average consumer as descriptive of goods/services sold under the mark. If this is correct, then there will be a medium to high degree of aural similarity between the marks. If I am incorrect, and these words are pronounced, then there will be only a medium degree of aural similarity between the marks.

The First Application and the Second Earlier Mark

74. Again, the device in the Second Earlier Mark will clearly not be pronounced by the average consumer. The same points, therefore, apply to the aural comparison between these marks as noted above and I consider there to be a medium to high degree of aural similarity if the words INSULATIVE PACKAGING SYSTEM in the First Application are not pronounced and a medium degree of aural similarity if they are pronounced.

The Second Application and the First Earlier Mark

75. As noted above, the First Earlier Mark will be pronounced REE-SIGH-COLD. The Second Application will be pronounced REE-SIGH-COO-LAA. I consider there to be a medium to high degree of aural similarity between the marks.

The Second Application and the Second Earlier Mark

76. Again, the device in the Second Earlier Mark will clearly not be pronounced and so these marks will share a medium to high degree of aural similarity for the same reasons as stated above.

Conceptual Similarity

The First Application and the First Earlier Mark

77. The words RECYCOLD and RECYCOOLA in both marks will be recognised as including a reference to the ordinary dictionary word RECYCLE. This meaning is enhanced in the First Application by the presence of the leaf device, which suggests a connection with the environment. I consider that the second element of the First Earlier Mark – the word COLD - will be recognised as the ordinary dictionary word and given its ordinary meaning and COOLA, in the First Application, will be seen as a misspelling of the word 'cooler' or the word 'cool' with the letter 'a' added. The meaning conveyed by the marks will be seen as a reference to something which relates to recycling and has the effect of reducing temperature. A point of conceptual difference between the marks is the presence of the words INSULATIVE PACKAGING SYSTEM, although as noted above, these words will have a lesser impact on the overall impression. I consider the marks will be conceptually similar to a high degree.

The First Application and the Second Earlier Mark

78. The same points of conceptual similarity as conveyed by the wording applies to these marks. The Second Earlier Mark also contains a device which consists of a snowflake and recycling symbol. This further enhances the meaning conveyed by the words. I consider that the marks will be conceptually similar to a high degree

The Second Application and the First Earlier Mark

79. The same points of conceptual similarity as conveyed by the wording applies to these marks. I consider the marks to be conceptually similar to a high degree.

The Second Application and the Second Earlier Mark

80. The same points of conceptual similarity as conveyed by the wording applies to these marks. The device in the Second Earlier Mark enhances the meaning conveyed by the invented word. I consider the marks to be conceptually similar to a high degree.

Distinctive character of the earlier trade marks

81. 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-2779, 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).”

82. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

83. The opponent has filed no evidence to demonstrate that the distinctive character of its marks has been enhanced through use and, consequently, I have only the inherent position to consider. The word RECYCOLD is an invented word. However, as noted above, it will be identified as being a combination of the ordinary dictionary word RECYCLE and COLD. It will be allusive for those goods and services which involve cooling (such as fridges or freezers). For those goods, the First Earlier Mark will be inherently distinctive to only a medium degree. For all other goods, I consider the First Earlier Mark to be inherently distinctive to a higher than medium degree. I recognise that RECY- is a commonly used prefix for goods and services which relate to recycling. The presence of the device in the Second Earlier Mark adds to its distinctiveness. I consider the Second Earlier Mark will be distinctive to a higher than medium degree for those goods and services which relate to cooling and highly distinctive for all other goods and services.

Likelihood of confusion

84. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

85. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 direct and indirect confusion were described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

86. As I have found the Second Earlier Mark to share the higher degree of similarity with the First Application, I will begin by considering the likelihood of confusion on the basis of this mark. I have found the marks to be visually similar to a higher than medium degree and conceptually similar to a high degree. I have found the marks to be aurally similar to a medium to high degree if the words INSULATIVE PACKAGING SYSTEM are not pronounced or similar to a medium degree if they are pronounced. The Second Earlier Mark will be inherently distinctive to a higher than medium degree for those goods and services which relate to cooling and inherently distinctive to a high degree for all other goods.

87. As I have found the First Earlier Mark to share the higher degree of similarity with the Second Application, I will begin by considering the likelihood of confusion on the basis of this mark. I have found the marks to be visually and aurally similar to a medium to high degree, and conceptually similar to a high degree. For those goods and services which relating to cooling, the First Earlier Mark will be inherently distinctive to

a medium degree. For all other goods, it will be inherently distinctive to a higher than medium degree.

88. I have found the average consumer for the goods and services in issue to be a member of the general public or a business user who will select the goods and services by primarily visual means (although there will also be an aural component to the purchase of the goods and services). I recognise that for some services, an aural component may have a greater role to play in the purchasing process. At least a medium degree of attention will be paid during the purchasing process for the goods and services. I have found the parties' goods to range from identical to similar to only a low degree (except for those goods and services that I have found to be dissimilar).

89. With regard to both applications, bearing in mind the principle of imperfect recollection and the degree of visual, aural and conceptual similarity between the marks, I consider that the average consumer is likely to mistakenly recall one mark for the other. In my view, the average consumer will recall the conceptual meaning of the marks and remember that they relate to recycling and cooling and will mistakenly identify one made-up word for the other. I consider this to be the case even where a higher degree of attention is paid during the purchasing process. In respect of the First Application, I consider that the average consumer is likely to recall that it is accompanied by a device which includes a snowflake design but, without the benefit of comparing both marks side by side, will not recall the precise design of the device. On encountering the device in the Second Earlier Mark, they are unlikely to identify the differences between the two. I consider there to be a likelihood of direct confusion in respect of both the First Application and the Second Application, for those goods and services which are similar to at least a medium degree.

90. Even if the differences between the devices used in the First Application and the Second Earlier Mark are identified by the average consumer, in my view, the conceptual hook will still apply and they will consider the different stylisation and devices used to be alternative variants used by the same, or economically linked undertakings. As to the Second Application and the First Earlier Mark, the average consumer is also likely to believe that these are also variant marks used by the same or linked undertakings. I therefore consider there to be a likelihood of indirect confusion

in respect of both the First Application and the Second Application for those goods and services which I have found to be similar to at least a medium degree.

FINAL REMARKS

91. For the avoidance of doubt, I consider that a likelihood of confusion would also exist in respect of the First Application and the First Earlier Mark and the Second Application and the Second Earlier Mark as the same conceptual hook will apply in respect of these marks.

CONCLUSION

91. The opposition is partially successful and the First Application and the Second Application are refused for the following goods and services:

Class 11 Freezing installations; apparatus for freezing; deep freezing apparatus; air freezing apparatus; deep freezing installations; cooling installations for deep freezing; combination apparatus for cooling and freezing; refrigerating and freezing equipment; refrigerated units; food and beverage cooling equipment; cooking utensils, electric.

Class 16 Paper; paperboard; industrial paper; paper stock; lining paper; cardboard; cardboard boxes; cardboard badges; cardboard packaging; cardboard cartons; cardboard labels; packing cardboard; cardboard containers; boxes of cardboard; cardboard shipping containers; industrial paper and cardboard; airtight packaging of cardboard; boxes of cardboard or paper; containers of cardboard for packaging; boxes of paper or cardboard; bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; shipping labels; packaging containers of card; packing containers of cardboard; packaging containers of paper; plastic wrap.

Class 17 Insulating materials; electrical insulating materials; plastics insulating materials; thermal insulating materials; insulating materials made of

plastics; insulating materials for insulation against heat; insulating materials for insulation against light; insulating foils; insulating mats; insulating matting; insulating adhesives; insulating sheets; insulating boards; insulating material; insulating materials made of polyethylene foam; molded foam for packing; packing foam in sheet form; low-density polyurethane foam for packing; molded foam insulated container packing for commercial transportation; packing materials; packing material; plastic materials in the form of chips for use as packing.

Class 20 Containers, and closures and holders therefor, non-metallic; flexible containers of plastics for the storage of liquids; flexible containers of plastics for the transport of liquids; containers, not of metal, for storage or transport; transport containers (non-metallic -); carrying containers (non-metallic -); plastics closures for containers; packaging containers of plastic; packing containers of plastic material; closures for containers, non-metallic; transparent food containers for commercial packaging use; closures, not of metal, for containers; receptacles of plastic for storing goods for transportation; plastic trays for foodstuff packaging; plastic boxes; non-metal lock boxes; boxes for storage purposes [plastic]; storing boxes, not of metal; stacking boxes of compressed fibre; containers for transport, not of metal; containers (non-metallic -) for transport purposes; plastic trays [containers] used in food packaging; protective containers of non-metallic materials for packing goods; plastic stoppers for industrial packaging containers; plastic boxes for packing.

Class 21 Portable coolers; portable beverage coolers; non-electric portable coolers.

Class 39 Transportation; transportation of goods; transportation services; transportation of food; services for transportation; packaging articles for transportation; transportation of goods by road; transportation and storage of goods; transportation and delivery of goods; inspection of goods for transportation; shipping; shipping services; shipping of goods; packaging of food; packaging services; packaging of products;

packaging of goods; packaging and storage of goods; packing and packaging services; storage; refrigerated storage; storage information; storage of food; food storage services; storage of liquids; storage of containers; storage of packages; refrigerated storage of goods; storage services for goods; transport and storage of goods; storage and delivery of goods; arranging the storage of goods.

92. The opposition has been unsuccessful in relation to the following goods for which the First Application and the Second Application will proceed to registration:

Class 11 Refrigerated food counters; Refrigerated shipping containers; Heating apparatus; apparatus for heating; appliances for heating; combined cooking stoves and gas containers; Industrial cooking installations; food and beverage cooking, heating and treatment equipment.

Class 20 Non-metallic transportable exhibition stands [other than structures].

COSTS

93. As the opponent has enjoyed the greater degree of success, it is entitled to a contribution towards its costs. I acknowledge the opponent's request for costs off the scale, but I am not satisfied that the applicant's actions justify any such award. I, therefore, will award costs based upon the scale published in Tribunal Practice Notice 2/2016. In approaching the award, I bear in mind that the two Notices of Opposition were largely identical in their content and that the two cases were consolidated upon receipt of the counterstatements (and prior to the opponent filing evidence). In the circumstances, I award the opponent the sum of **£1,200** calculated as follows:

Preparing statements and considering the applicant's statements	£200
Preparing evidence and evidence in reply and considering the applicant's evidence	£500

Preparing written submissions in lieu	£300
Official fee (x2)	£200
Total	£1,200

94. I therefore order Jason Andrew Harris to pay Recycold Holding B.V. the sum of £1,200. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 12th day of July 2019

S WILSON

For the Registrar