

**BL O/0241/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NUMBER 3561792  
BY DANIEL DENNIS THOMAS PAYNE  
TO REGISTER THE TRADE MARK:**

**tansons**

**IN CLASSES 11 AND 16**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 424525  
BY TANSUN LIMITED**

## Background and Pleadings

1. On 29 November 2020, Daniel Dennis Thomas Payne (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision, under number 3561792 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 19 February 2021, in respect of goods in Classes 11 and 16.<sup>1</sup>

2. On 19 May 2021, Tansun Limited (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Within its Form TM7, the opponent indicated that the opposition is directed against all the goods in the application.

3. The opponent relies upon the following United Kingdom Trade Mark (“UKTM”) and European Union Trade Mark (“EUTM”):

(i) UKTM no. 3243847 (series of two) for the trade marks ‘TANSUN’ and ‘Tansun’ which was applied for on 14 July 2017, and which was entered in the register on 06 October 2017, in respect of goods and services in Classes 3, 11 and 35. For the purpose of these proceedings, the opponent relies upon some of the goods in Class 3 and all of the goods and services in Classes 11 and 35.<sup>2</sup>

(ii) EUTM no. 018193905 for the trade mark ‘TANSUN’ which was applied for on 07 February 2020, and which was entered in the register on 25 September 2020, in respect of goods and services in Classes 3, 9, 11, 21, 35, 37 and 42. For the purpose of these proceedings, the opponent relies upon some of the goods in Class 3 and all of the goods and services in Classes 11, 35, 37 and 42.<sup>3</sup>

4. The opponent essentially claims that due to the high similarity between the marks and the respective goods and services, there is a likelihood of confusion. In its

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<sup>1</sup> These will be listed in the goods and services comparison.

<sup>2</sup> These will be listed in the goods and services comparison.

<sup>3</sup> These will be listed in the goods and services comparison.

counterstatement, the applicant denies that consumers will be confused on the basis that the respective marks and the goods and services at issue are not sufficiently similar.

5. Given the respective filing dates, the opponent's marks are earlier marks, in accordance with section 6 of the Act. However, as they had not been registered for five years or more at the filing date of the application, they are not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier marks are registered without having to establish genuine use.

6. The opponent is represented by Forresters IP LLP, whereas the applicant represents itself. Only the opponent filed evidence. Both parties were given the option of an oral hearing but neither requested to be heard on this matter. Only the opponent chose to file written submissions in lieu. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

## **PRELIMINARY ISSUES**

8. A number of points have been raised by the applicant in its counterstatement. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

- The applicant states that its products do not utilise the same technologies as the opponent's products.

9. Differences between the goods and services currently provided by the parties, such as particular characteristics of the goods and services at issue, including any technologies utilised, are irrelevant, except to the extent that those differences are apparent from each party's specification. Since the opponent's earlier mark is not subject to proof of use, it is entitled to protection in relation to all the goods and services for which it is registered. It is the goods and services relied upon by the opponent and the goods applied for by the applicant that I will be comparing later in this decision. The assessment I must make between the goods and services is a notional and objective assessment, rather than a subjective one.

- The applicant refers to the parties having different customer bases, namely the opponent sells its goods direct to businesses, whereas the applicant sells its goods via an online marketplace.

10. Marketing strategies, including the targeting of specific consumers, are temporary and may change over time. As such, it is not appropriate to take that factor into account in my assessment. However, I will make an assessment, later in this decision, as to who the average consumer could be for the goods and services at issue.

11. Having dealt with the necessary submissions made by the applicant, I go on now to consider the opponent's evidence.

## **EVIDENCE**

12. The opponent filed evidence in the form of two witness statements:

- I. Witness statement of Mr Piara Singh Rana dated 18 March 2022, and its corresponding 18 exhibits (PSR1-PSR18). Mr Piara Singh Rana is the Director of Tansun Limited (opponent), a position he has held since 18 March 2022. His statement is made from his personal knowledge or the records of his company and is duly authorised to speak on the company's (opponent's) behalf.

II. Witness statement of Ms Janette Hamer dated 18 March 2022, and its corresponding 19 exhibits (JCH1-JCH19). Ms Janette Hamer is a Chartered Trade Mark Attorney and Partner at Forresters IP LLP, a position which she has held since April 2018. Her statement is made from her own knowledge and belief, as well as her own research, and on the basis that her firm is appointed as representative for the opponent.

13. Mr Piara Singh Rana states that the purpose of the evidence is to support the opponent's claim to an enhanced distinctive character through use.

14. The evidence and submissions will be referred to where necessary throughout this decision.

## **DECISION**

### **Section 5(2)(b)**

15. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

[...]

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

16. I am guided by the following principles which are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of goods and services**

17. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

18. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

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

19. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

20. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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."

21. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Meric')*, the 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 für 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".

22. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10), Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

23. The competing goods and services are as follows:

#### Applicant's goods

##### Class 11

Radiator valves; Radiator valves [thermostatic]; Apparatus for controlling temperature in central heating radiators [valves]; Automatic temperature regulators [valves] for central heating radiators; Control valves (Thermostatic -) for central heating radiators; Temperature control apparatus [valves] for central heating radiators; Temperature control valves [parts of central heating radiators]; Temperature controllers [valves] for central heating radiators; Temperature controlling apparatus [valves] for central heating radiators; Temperature limiters [valves] for central heating radiators; Temperature limiters for central heating radiators [thermostatic valves] incorporating bi-metallic discs; Temperature limiters

for central heating radiators [thermostatic valves] incorporating expansion rods; Temperature regulators [thermostatic valves] for central heating radiators; Temperature responsive control apparatus [thermostatic valves] for central heating radiators; Temperature sensing apparatus [thermostatic valves] for central heating radiators; Temperature sensitive switches [thermostatic valves] for central heating radiators; Temperature sensors [thermostatic valves] for central heating radiators; Thermal controls [valves] for central heating radiators; Valves as part of radiators; radiators; Automatic temperature regulators [valves] for central heating radiators; Central heating apparatus; Central heating radiators; Control devices [thermostatic valves] for heating installations; Control units [thermostatic valves] for heating installations; Control valves (Thermostatic -) for central heating radiators; Domestic radiators; Flat radiators for central heating installations; Radiator caps; Radiator heaters; Radiator valves; Radiator valves [thermostatic];Radiators; Radiators, electric; Radiators for central heating installations; Radiators for central heating systems; Radiators [for industrial air-conditioning purposes];Radiators [heating];Temperature control apparatus [valves] for central heating radiators; Temperature control valves [parts of central heating installations]; Temperature control valves [parts of central heating radiators]; Temperature controllers [valves] for central heating radiators; Temperature controlling apparatus [valves] for central heating radiators; Temperature limiters for central heating radiators [thermostatic valves] incorporating bi-metallic discs; Temperature limiters for central heating radiators [thermostatic valves] incorporating expansion rods; Temperature limiters [valves] for central heating radiators; Temperature regulators [thermostatic valves] for central heating radiators; Temperature responsive control apparatus [thermostatic].

Class 16 Adhesive packaging tapes; Adhesive tape cutters being stationery; Adhesive tape dispensers for household or stationery use; Adhesive tape dispensers [office requisites]; Adhesive tape dispensing machines [office requisites];Adhesive tape for stationery purposes; Adhesive tapes for stationery or household purposes; Adhesive tapes for stationery purposes; Adhesives for stationery; Adhesives for stationery and household use; Adhesives for stationery or household purposes; Adhesives for stationery or household use; Adhesives for stationery purposes; Adhesives [glues] for stationery or household purposes; Automatic adhesive tape

dispensers for office use; Bookbinding tape; Brown paper for wrapping; Dispensers (Adhesive tape -) [office requisites]; Double sided adhesive tapes for household use; Double sided adhesive tapes for stationery use; Double-sided adhesive tapes for household use; Gummed cloth for stationery purposes; Gummed paper; Gummed tape [stationery]; Gums [adhesives] for stationery or household purposes; Holders for adhesive tapes; Paper carton sealing tape; Sealing tape for stationery use; Self-adhesive tapes for stationery and household purposes; Self-adhesive tapes for stationery or household purposes; Self-adhesive tapes for stationery use; Sticky tape; Tapes (adhesive -) [stationery].

### Opponent's goods and services

UK00003243847

Class 3   Cosmetic preparations; Cosmetics; Cosmetics and cosmetic preparations; Skin care preparations; Hair care preparations; Hair cosmetics; Nail care preparations.

Class 11   Air conditioners; Air circulation apparatus; Air cleansing apparatus; Air conditioning installations; Air cooling apparatus; Air curtains; Air dehumidifiers; Air dryers; Air purifying apparatus; Air sterilisers; Air treatment equipment; Apparatus for cooking; Apparatus for drying; Apparatus for heating; Heating apparatus; Heating apparatus and installations; Heating apparatus for foodstuffs; Heating cushions [pads], non-electric, not for medical purposes; Heating elements; Heating installations; Heating, ventilating, and air conditioning and purification equipment (ambient); Humidifiers; HVAC systems (heating, ventilation and air conditioning); Dehumidifiers; Electric radiant heating apparatus; Electric space heaters; Electrically operated devices used in drying; Electrically powered fans for ventilation purposes; Electrically-operated devices used in cooling; Electrically-operated machines used in drying; Convector heaters; Barbecues; Hair drying apparatus; Halogen heaters; Halogen lamps; Hand dryers; Heat generating apparatus; Heaters; LED light machines; Lighting; Induction heaters; Infrared heating panels; Infrared lamps; Infrared radiators; Installations for heating; Ventilating apparatus; Radiant heaters; Radiant space heaters ;Radiators; Saunas; Solaria being suntanning apparatus, not

for medical purposes; Solaria, other than for medical purposes; Space heaters; Steam baths, saunas and spas; Sun lamps; Sun tanning appliances; Tanning apparatus [sun beds]; Tanning lamps; Ultra-violet apparatus for tanning the face; Ultra-violet apparatus for tanning the whole body; Ultra-violet sun ray lamps for cosmetic purposes; Ultra-violet sunbeds for cosmetic purposes; Electric dehydrators; Light tubes being parts of insect killing apparatus; Control devices [thermostatic valves] for heating installations; Electric fans; Electric fans with evaporative cooling devices.

Class 35 Retail and wholesale services related to sale of HVAC systems & apparatus, heating apparatus and appliances, wireless receivers, remote controls for controlling electronic products, water treatment apparatus and appliances, water storage and dispensing equipment, air treatment apparatus and appliances, mounting brackets for electric appliances, air dryers, hand dryers, electric fans, electric devices for attracting and killing Insects, lamps and lighting; Retail and wholesale services related to sale of HVAC systems & apparatus, heating apparatus and appliances, wireless receivers, remote controls for controlling electronic products, water treatment apparatus and appliances, water storage and dispensing equipment, air treatment apparatus and appliances, mounting brackets for electric appliances, air dryers, hand dryers, electric fans, electric devices for attracting and killing Insects, lamps and lighting provided via a catalogue; Retail and wholesale services related to sale of HVAC systems & apparatus, heating apparatus and appliances, wireless receivers, remote controls for controlling electronic products, water treatment apparatus and appliances, water storage and dispensing equipment, air treatment apparatus and appliances, mounting brackets for electric appliances, air dryers, hand dryers, electric fans, electric devices for attracting and killing Insects, lamps and lighting provided via the internet; Retail and wholesale services related to sale of catering equipment, catering related equipment, catering products, catering implements, catering tools, kitchen utensils, cutlery, hand tools for use in relation to catering and food preparation, clothing and apparel connected with catering, uv fly traps, barbeques, catering apparatus and catering appliances; Retail and wholesale services relating to sale of cosmetics and beauty products, beauty treatment products, hair products, beauty supplies, beauty related accessories, hair removal products, beauty salon furniture, beauty implements, beauty salon furniture,

manicure and pedicure products, single use disposable beauty related items, skincare, male grooming products, male grooming tools, salon wear, beauty related hygiene products, beauty aids and beauty apparatus and equipment; Retail and wholesale services related to the sale of cosmetics and beauty products, beauty treatment products, single use disposable beauty related items, hair products, beauty related implements, beauty apparatus and equipment, beauty products, hair removal products, beauty salon furniture, skincare, salon wear, male grooming products, male grooming tools, beauty related hygiene products, manicure and pedicure products, tools for use in relation to beauty treatments provided via the internet; Retail and wholesale services related to the sale of cosmetics and beauty products, beauty treatment products, single use disposable beauty related items, hair products, male grooming products, male grooming tools, beauty related implements, beauty apparatus and equipment, beauty products, hair removal products, beauty salon furniture, skincare, beauty related hygiene products, manicure and pedicure tools and products, tools for use in beauty treatments all provided via a catalogue; Retail and wholesale services in relation to beauty products; Commercial information and advisory services for consumers in the field of beauty products; Online retail store services relating to cosmetic and beauty products; retail services in relation to beauty supplies; Retail services in relation to toiletries; Retail and wholesale services in relation to sun tanning appliances; Provision of advice in relation to the operation of franchised establishments.

### EUTM 018193905

Class 3      Cosmetics; toiletries; hair care preparations; nail care preparations.

Class 11     Heating apparatus and installations; heaters; electric heaters; heating bars; heating panels; panel heaters; radiant heat panels; infrared heaters; infrared panels; infrared heating panels; electric infrared heating panels; indoor heaters; outdoor heaters; space heaters; storage heaters; industrial heaters; commercial heaters; domestic heaters; room heaters; ceiling heaters; air heaters; Low-glare heaters; No-glare heaters; portable heaters; mobile heaters; quartz heaters; ceramic heaters; sunshade heaters; parasol heaters; awning heaters; radiant heaters; radiators; burners, boilers and heaters; convection heaters; convector heaters;

immersion heaters; fan heaters; gas heaters; induction heaters; quartz electric shortwave infrared heaters; temperature controllers apparatus [valves] for heaters; sun tanning appliances; tanning beds, booths, lamps; sunbeds; commercial sunbeds; domestic sunbeds; ultra-violet sunbeds for cosmetic purposes; LED sunbeds for cosmetic purposes; infrared sunbeds for cosmetic purposes; standing tanning booths; vertical sunbeds; light therapy units; sunbeds and tanning units used for light therapy treatment; UV tubes for sunbeds; standing tanning boots and sunbeds incorporating changing area; sunlamps; ultra-violet apparatus for tanning; lighting tubes; ultra-violet lighting tubes for sun tanning apparatus; vitamin-D lamps; collagen lamps; infrared lamps; temperature controllers apparatus [valves] for sunbeds; lighting; domestic lighting; commercial lighting; outdoor lighting; electric lighting; lighting apparatus, equipment and installations; filters for lighting appliances; LED, ultra-violet and infrared lighting apparatus, installations and appliances; combined lighting and ultraviolet apparatus; full spectrum light sources; LED light machines; LED light strips; LED lights; grow lights; plant-grow lights; hand dryers; air purifiers; industrial air purifiers; air purifiers for household use; electric air purifiers; filters for air purifiers; commercial catering fryers; barbecues; barbecue apparatus; barbecue smokers; barbecue cooking apparatus; ceramic briquettes for barbecue grills; lava rocks for barbecue grills; parts and fittings for all the aforesaid.

Class 35 Retail services, online retail services and wholesale services in relation to cosmetics, cosmetic sun-tanning preparations, artificial tanning preparations, sun-tanning creams, oils, gels, milks and lotions, cosmetic tanning preparations, self-tanning preparations, sun bronzers, after-sun lotions, sun-care lotions, skin cream, moisturizers, sun cream, sun block, essential oils; retail services, online retail services and wholesale services in relation to toiletries, cleaning preparations, cleaning preparations and sanitisers for sun tanning appliances and equipment, wipes for sanitary and cosmetic purposes, perfumery, fragrances cosmetic impregnated tissues and wipes, cleaning preparations impregnated with perfumes, hair care preparations, nail care preparations; retail services, online retail services and wholesale services in relation to electronic control circuits for electric heaters, electronic control circuits for electric lighting, switches for operating heating and lighting apparatus, switches for operating sunbeds, automatic time switches for heating and lighting apparatus, automatic time switches for operating sunbeds; retail

services, online retail services and wholesale services in relation to temperature controllers, temperature controlling apparatus and equipment, temperature gauges, control and remote control apparatus for lighting and heating equipment; retail services, online retail services and wholesale services in relation to batteries for lighting and heating equipment, light dimmers, lighting and heating control software, lighting and heating control software for use in commercial and industrial facilities, programmable controls for lighting and heating apparatus and instruments, light-emitting diodes (LED), LED displays, LED drivers, LED position sensors, parts and fittings for all the aforesaid; retail services, online retail services and wholesale services in relation to heating apparatus and installations, heaters, electric heaters, heating bars, heating panels, panel heaters, radiant heat panels, infrared heaters; retail services, online retail services and wholesale services in relation to infrared panels, infrared heating panels, electric infrared heating panels, indoor heaters, outdoor heaters, space heaters, storage heaters, industrial heaters, commercial heaters, domestic heaters, room heaters, ceiling heaters, air heaters, Low-glare heaters, No-glare heaters, portable heaters, mobile heaters, quartz heaters, ceramic heaters, sunshade heaters, parasol heaters, awning heaters, radiant heaters; retail services, online retail services and wholesale services in relation to radiators, burners, boilers and heaters, convection heaters, convector heaters, immersion heaters, fan heaters, gas heaters, induction heaters, quartz electric shortwave infrared heaters; retail services, online retail services and wholesale services in relation to temperature controllers apparatus [valves] for heaters, sun tanning appliances, tanning beds, booths, lamps, sunbeds, commercial sunbeds, domestic sunbeds, ultra-violet sunbeds for cosmetic purposes, LED sunbeds for cosmetic purposes, infrared sunbeds for cosmetic purposes, standing tanning booths, vertical sunbeds; retail services, online retail services and wholesale services in relation to light therapy units, sunbeds and tanning units used for light therapy treatment, UV tubes for sunbeds, standing tanning boots and sunbeds incorporating changing area, sunlamps, ultra-violet apparatus for tanning, lighting tubes, ultra-violet lighting tubes for sun tanning apparatus, vitamin-D lamps, collagen lamps, infrared lamps, temperature controllers apparatus [valves] for sunbeds; retail services, online retail services and wholesale services in relation to lighting, domestic lighting, commercial lighting, outdoor lighting, electric lighting, lighting apparatus, equipment and installations, filters for lighting appliances, LED, ultra-violet and infrared lighting

apparatus, installations and appliances, combined lighting and ultraviolet apparatus, full spectrum light sources, LED light machines, LED light strips, LED lights, grow lights, plant-grow lights; retail services, online retail services and wholesale services in relation to hand dryers, air purifiers, industrial air purifiers, air purifiers for household use, electric air purifiers, filters for air purifiers, commercial catering fryers, barbecues, barbecue apparatus, barbecue smokers, barbecue cooking apparatus, ceramic briquettes for barbecue grills, lava rocks for barbecue grills, parts and fittings for all the aforesaid; retail services, online retail services and wholesale services in relation to insect traps (electric and non-electric), electric apparatus for attracting and killing insects, cooking utensils for barbecue use, cleaning brushes for barbecue use, parts and fittings for the aforesaid; information, consultancy and advisory services relating to the aforesaid.

Class 37 Heating contractor services; heating equipment installation services; installation of sunbeds and sun tanning apparatus; installation of lighting apparatus; repair, servicing and maintenance of heating apparatus; repair, servicing and maintenance of lighting apparatus; repair, servicing and maintenance of sunbeds and sun tanning apparatus; disposal services relating to heating, lighting and sun tanning apparatus; information, consultancy and advisory services relating to the aforesaid.

Class 42 Design, technical design and development of heating appliances and installations; Design, technical design and development of lighting appliances and installations; Design, technical design and development of sun tanning appliances and installations; information, consultancy and advisory services relating to the aforesaid.

24. With regard to the similarity of the goods and services, in its counterstatement the applicant states the following:

“There is little to no likeness between the products sold by me and the products sold by the opponent. I do not sell a single product that the opponent also sells, or products that utilise the same technology, and have no intention of doing so.”



25. With regard to the similarity of the goods and services, the opponent states the following:<sup>4</sup>

“The class 11 goods covered by the marks in question are partly identical and partly similar.

The class 11 goods covered by the Application are also similar to the heating related services covered by classes 35, 37 and 42 of the Earlier Registrations as these goods complement the services provided.

*Cosmetic preparations, nail care preparations, hair care preparations* as covered by the Earlier Registrations also include *cosmetic adhesives and glue including face or body adhesives and tapes, nail glue and hair bonding materials*. Exhibits JCH6-JCH8 show that these adhesive [sic] and glues have the same characteristics as household adhesives and adhesive tapes. The Opponent submits that they are average household products and therefore, will have the same consumer circles.

In view of this, the class 16 goods are covered by the Application are similar to the class 3 goods as covered by the Earlier Registrations. The Opponent’s evidence also shows that the goods are being sold through the same distribution channels.

As a results [sic], it is submitted that the goods in classes 11 and 16 as covered by the Application are partly identical and partly similar to the goods and services of the Earlier Registrations on which the opposition is based.”

### **Class 11 of the contested application**

#### Radiators

26. The above contested goods appear in both earlier specifications, therefore these goods are identical.

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<sup>4</sup> Written submissions in lieu.

Central heating radiators; Domestic radiators; Flat radiators for central heating installations; Radiator heaters; Radiators, electric; Radiators for central heating installations; Radiators for central heating systems; Radiators [for industrial air-conditioning purposes]; Radiators [heating]

27. The above contested terms are included in the broad term *radiators*, contained in both earlier specifications and therefore the goods are considered identical in line with the principle set out in *Meric*.

#### Central heating apparatus

28. Central heating is a heating system used in buildings and comprises heated air or water that travels around a building through pipes and radiators. *Central heating apparatus* will include *radiators* present in both of the opponent's earlier specifications. As such, I find that the above contested broad term overlaps with the opponent's *radiators*, and consequently, the competing goods are identical based on the *Meric* principle.

#### Control devices [thermostatic valves] for heating installations

29. The above contested goods are also present in the opponent's earlier specification (UK00003243847), therefore these goods are identical.

Radiator valves; Radiator valves [thermostatic]; Apparatus for controlling temperature in central heating radiators [valves]; Automatic temperature regulators [valves] for central heating radiators; Control valves (Thermostatic -) for central heating radiators; Temperature control apparatus [valves] for central heating radiators; Temperature control valves [parts of central heating radiators]; Temperature controllers [valves] for central heating radiators; Temperature controlling apparatus [valves] for central heating radiators; Temperature limiters [valves] for central heating radiators; Temperature limiters for central heating radiators [thermostatic valves] incorporating bi-metallic discs; Temperature limiters for central heating radiators [thermostatic valves] incorporating expansion rods; Temperature regulators [thermostatic valves] for central heating radiators;

Temperature responsive control apparatus [thermostatic valves] for central heating radiators; Temperature sensing apparatus [thermostatic valves] for central heating radiators; Temperature sensitive switches [thermostatic valves] for central heating radiators; Temperature sensors [thermostatic valves] for central heating radiators; Thermal controls [valves] for central heating radiators; Valves as part of radiators; radiators; Automatic temperature regulators [valves] for central heating radiators; Control units [thermostatic valves] for heating installations; Control valves (Thermostatic -) for central heating radiators; Radiator valves; Radiator valves [thermostatic]; Temperature control apparatus [valves] for central heating radiators; Temperature control valves [parts of central heating installations]; Temperature control valves [parts of central heating radiators]; Temperature controllers [valves] for central heating radiators; Temperature controlling apparatus [valves] for central heating radiators; Temperature limiters for central heating radiators [thermostatic valves] incorporating bi-metallic discs; Temperature limiters for central heating radiators [thermostatic valves] incorporating expansion rods; Temperature limiters [valves] for central heating radiators; Temperature regulators [thermostatic valves] for central heating radiators; Temperature responsive control apparatus [thermostatic]

30. The above contested goods are all various types of valves for heating apparatus. The function of such valves is to, amongst other things, regulate and control temperature. Accordingly, I find that the above contested goods overlap with the opponent's *control devices [thermostatic valves] for heating installations* (UK00003243847) and are therefore identical based on the *Meric* principle.

#### Radiator caps

31. Broadly speaking, the contested goods are components for radiators. *Radiator caps* are used to cap radiator valves. Some types of *radiator caps* provide a purely decorative function, whilst other types control the water supply to a radiator, for example, in order to turn the water supply on or off, required when removing or re-installing a radiator. The opponent's *control devices [thermostatic valves] for heating installations* (UK00003243847) are also components for radiators, used to control the flow of water to a radiator, for example, in order to change the temperature of a

room. Whilst the primary purpose of the goods at issue is not the same, there are clearly points of similarity between these goods. Accordingly, I find that the goods at issue belong to the same homogeneous market sector and are likely to be found under the same category online and in the same or adjacent aisles in physical stores. Furthermore, the goods will target the same relevant consumer and share the same distribution channels, which will result in the consumer seeing a connection between the goods and believe that the responsibility for both lies with the same undertaking. Consequently, I find that the goods are similar to a high degree.

### **Class 16 of the contested application**

Adhesive packaging tapes; Adhesive tape for stationery purposes; Adhesive tapes for stationery or household purposes; Adhesive tapes for stationery purposes; Adhesives for stationery; Adhesives for stationery and household use; Adhesives for stationery or household purposes; Adhesives for stationery or household use; Adhesives for stationery purposes; Adhesives [glues] for stationery or household purposes; Bookbinding tape; Double sided adhesive tapes for household use; Double sided adhesive tapes for stationery use; Double-sided adhesive tapes for household use; Gummed cloth for stationery purposes; Gummed paper; Gummed tape [stationery];Gums [adhesives] for stationery or household purposes; Paper carton sealing tape; Sealing tape for stationery use; Self-adhesive tapes for stationery and household purposes; Self-adhesive tapes for stationery or household purposes; Self-adhesive tapes for stationery use; Sticky tape; Tapes (adhesive -) [stationery]

32. In its submissions the opponent states that its *cosmetics; toiletries; hair care preparations; nail care preparations* in Class 3 cover goods such as *adhesives for cosmetic purposes and use; glue for strengthening nails; hair piece bonding glue; adhesive for affixing false eyelashes and hair pieces; double eyelid tapes*, and on this basis the opponent submits that such *adhesives, glues and tapes* are similar to the contested Class 16 *adhesive, glues and tape* goods as they have the same nature, purpose, method of use and can have the same producers.

33. However, I am unable to agree with the opponent's viewpoint. Whilst it is acknowledged that various forms of *adhesives, glues* and *tapes* appear in both Classes 3 and 16, it has to be put forward that the primary purpose of these goods is completely different. The contested *adhesives, glues* and *tapes* in Class 16 are solely for stationery, household and office purposes, whereas the *adhesives, glues* and *tapes* in Class 3, as referred to by the opponent, are specifically for cosmetic purposes. For example, *adhesives, glues* and *tapes* used in relation to cosmetic products are specifically designed to be safe for use on the skin and body. These differing groups of *adhesives, glues* and *tapes* are not interchangeable and belong to completely different sectors. For example, adhesives used to affix false eyelashes and hair pieces into place, would not also be used as household or stationery adhesives used to stick together, paper and card, etc., and likewise, household and stationery adhesives would not be used to affix false eyelashes and hair pieces, etc., into place.

34. Accordingly, despite the goods at issue all being various types of *adhesives, glues* and *tapes*, which can all be used to stick items together, etc., I find this to be a very general overlap and I do not consider it sufficient for a finding of similarity. While I note that consumers purchasing the opponent's cosmetic *adhesives, glues* and *tapes* may, for example, also be interested in purchasing the contested *adhesives, glues* and *tapes* since all of them can be used in the same home environment, this factor is not sufficient to find the competing goods similar to each other, keeping in mind the core purpose of the goods. Moreover, I find that the goods at issue will satisfy different consumer needs, will ordinarily originate from different providers and will move through different trade channels. Furthermore, the goods are neither in competition nor are they complementary. The fact that both sets of goods may be found in supermarkets, etc., is not determinative since these stores usually sell a vast range of totally different goods. It is highly unlikely that these goods would be found in the same location or aisle. The fact that a person may buy adhesives for eyelashes, and also adhesives for household or stationery use does not result in similarity between the goods. Furthermore, the nature and method of use of the goods at issue also differs greatly. Accordingly, I find that the contested Class 16 goods listed above are dissimilar to all the opponent's goods in Class 3. The same conclusion also applies to the opponent's remaining goods and services

contained in both of its earlier marks, namely in Classes 3, 11, 35, 37 and 42, on the basis that they share no direct similarities with the above contested goods.

Adhesive tape cutters being stationery; Adhesive tape dispensers for household or stationery use; Adhesive tape dispensers [office requisites]; Adhesive tape dispensing machines [office requisites]; Automatic adhesive tape dispensers for office use; Dispensers (Adhesive tape -) [office requisites]; Holders for adhesive tapes; Brown paper for wrapping

35. Following on from my previous comment regarding the contested *adhesives*, *glues* and *tapes* in Class 16, contrary to the opponent's view, I find that its goods in Classes 3, 11, 35, 37 and 42 contained in both earlier marks are even further away from the remaining contested Class 16 goods listed above. As such, I see no reasonable basis for a finding of similarity between the contested goods and the opponent's goods and services, and the opponent's submissions have not convinced me otherwise. Accordingly, I find the above contested Class 16 goods to be dissimilar to all the opponent's goods and services in Classes 3, 11, 35, 37 and 42, contained in the earlier marks.

36. Similarity of goods and services is essential for a finding of a likelihood of confusion.<sup>5</sup> As a consequence, the opposition fails with respect of the following goods:

Class 16 Adhesive packaging tapes; Adhesive tape cutters being stationery; Adhesive tape dispensers for household or stationery use; Adhesive tape dispensers [office requisites]; Adhesive tape dispensing machines [office requisites]; Adhesive tape for stationery purposes; Adhesive tapes for stationery or household purposes; Adhesive tapes for stationery purposes; Adhesives for stationery; Adhesives for stationery and household use; Adhesives for stationery or household purposes; Adhesives for stationery or household use; Adhesives for stationery purposes; Adhesives [glues] for stationery or household purposes; Automatic adhesive tape

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<sup>5</sup> *Waterford Wedgwood plc v OHIM*, Case C-398/07 P, CJEU

dispensers for office use; Bookbinding tape; Brown paper for wrapping; Dispensers (Adhesive tape -) [office requisites]; Double sided adhesive tapes for household use; Double sided adhesive tapes for stationery use; Double-sided adhesive tapes for household use; Gummed cloth for stationery purposes; Gummed paper; Gummed tape [stationery]; Gums [adhesives] for stationery or household purposes; Holders for adhesive tapes; Paper carton sealing tape; Sealing tape for stationery use; Self-adhesive tapes for stationery and household purposes; Self-adhesive tapes for stationery or household purposes; Self-adhesive tapes for stationery use; Sticky tape; Tapes (adhesive -) [stationery].

### **The average consumer and the nature of the purchasing act**

37. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

38. 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.”

39. The average consumer of the goods at issue is likely to include members of the general public as well as business and professional users. The goods will mainly be available via retailers, being both general retailers and more specialist ones, and their online or catalogue equivalents. At the retailers' physical premises, the goods

will be displayed on shelves and in cabinets. A similar process will apply when the goods are selected online or via catalogues, in that a consumer will select them after seeing an image, on, for example, a webpage or in a catalogue. In my view, the visual component will dominate all methods of sale, although I do not discount an aural component playing a part given that orders may be placed by telephone or that word-of-mouth recommendations and advice may be received from sales assistants. Given the goods at issue, the price and frequency of purchase will vary depending on their nature and type. In this regard, when selecting the goods, the average consumer is likely to pay at least a medium degree of attention.

### **Comparison of the marks**

40. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

42. The opponent relies on two earlier marks, namely UKTM no. 3243847 for the trade marks ‘TANSUN’ and ‘Tansun’ (series of two), and EUTM no. 018193905 for the trade mark ‘TANSUN’. Clearly the marks are the same. Accordingly, as I have found the goods in the opponent’s first mark (UK00003243847), to share a greater



degree of similarity with the contested goods, I will carry out a single comparison using the applicant's UK mark only.

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

Opponent's mark (series of 2)	Applicant's mark
<p style="text-align: center;">TANSUN</p> <p style="text-align: center;">Tansun</p>	<p style="text-align: center;">tansons</p>

44. With regard to the similarity of the marks, in its counterstatement, the applicant states:

“My logo is not remotely similar to the opponent's logo. There is nothing about the ‘feel’ of my brand that is in any way similar to the opponent's. I cannot see that there is any case for arguing that my application is, in any way, detrimental to the opponent's trademark(s) or operation of their business.”

45. With regard to the similarity of the marks, the opponent states:<sup>6</sup>

“On a visual level the marks are highly similar due to their identical beginnings; They share identical letters as the first, second, third, fourth and sixth letters; Capital or small letters of “U/u” and “O/o” look similar.

Orally, the marks would be referred to as:

Earlier Registrations	Application
/tæɪn/sʌn/	/tæɪn/sʌns/

It is submitted that orally there is a high degree of similarity, almost identity, between the marks.

Conceptually, none of the marks has a meaning.

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<sup>6</sup> Written submissions in lieu

Overall, and on the basis of the above comments, it is submitted that there is a high degree of similarity between the marks.”

### **Overall impression**

46. The opponent’s marks (series of two) comprise the word ‘TANSUN’ presented in capital letters, and the word ‘Tansun’ presented in standard sentence case, with a capital first letter, and lower-case letters following. There is no stylisation present in the marks. There are no other elements that contribute to the overall impression of the marks which lies in the words themselves.

47. The applicant’s mark comprises the word ‘tansons’ presented in lower-case letters with no additional stylisation. There are no other elements that contribute to the overall impression of the mark which lies in the word itself.

### **Visual comparison**

48. Visually the marks coincide insofar as they identically share the same first four letters and sixth letter, namely ‘TANS\_N / Tans\_n / tans\_n\_’. However, the marks differ in that the opponent’s marks contain the letter ‘U/u’ in the fifth position of the mark whereas the fifth letter in the contested mark is the letter ‘o’. In addition, there is a letter ‘s’ present at the end of the contested mark which is not replicated in the opponent’s mark. The fact that the marks at issue identically share the same first four letters is an important point of coincidence, being where consumers tend to focus<sup>7</sup> as this position is generally considered to have more impact due to consumers in the UK reading from left to right. In making my visual comparison of the marks, I bear in mind that notional and fair use of the marks would include use in both upper and lower case,<sup>8</sup> so letter case is irrelevant to the comparison. Overall, I find that the marks are visually similar to a high degree.

### **Aural comparison**

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<sup>7</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>8</sup> *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17

49. The opponent's marks consist of two syllables, namely 'TAN-SUN / Tan-sun'. These syllables will be pronounced as the dictionary words 'tan' and 'sun' combined. The applicant's mark also consists of two syllables, namely 'tan-sons', which will be pronounced as the dictionary words 'tan' and 'sons' combined. The marks at issue consist of two syllables the first of which is identical and the pronunciation of the second syllables 'sun' and 'sons' is near identical. Accordingly, I find that the marks are aurally similar to a high degree.

### **Conceptual comparison**

50. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

51. Conceptually, the average consumer is likely to perceive the opponent's marks and the contested mark as meaningless invented words. Therefore, the marks are conceptually neutral.

52. Whilst I note that the opponent's marks and the contested mark are made up from two dictionary terms, namely 'TAN-SUN / Tan-sun / tan-sons', I consider it highly unlikely that the average consumer would break the marks down in this way. However, even allowing for that possibility, the marks would still, in my view, send meaningless concepts overall. This is because in the opponent's marks the word 'tan' does not naturally combine with the word 'sun', in that order, as these words would normally be combined as 'suntan' which has a known dictionary meaning, and insofar as the applicant's mark is concerned, the word 'tan' does not naturally combine with the word 'sons'. It follows that whether the respective marks are perceived as single words or whether they are broken down into two words, as a whole, the respective marks, remain meaningless and therefore conceptually neutral. I say this even bearing in mind the possible allusive nature of the opponent's earlier mark, when used in relation to tanning products.

## **Distinctive character of the earlier trade marks**

53. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

54. 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. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

55. With regard to the distinctiveness of the earlier mark, the opponent states:<sup>9</sup>

“For the last 35 years, my company has been at the forefront of infrared indoor and outdoor heater design and manufacturing. TANSUN has been used on the range of indoor and outdoor heaters since incorporation of the company in May 1986. The TANSUN ranges from domestic, commercial to industrial infrared heaters.

The TANSUN products are sold or installed by Tansun distributors in over 40 countries worldwide. TANSUN have a constant flow of installations ranging from bars and restaurants to churches, factories and warehouses. Examples of case studies and testimonials are included in Exhibit PSR2.

[...]

the TANSUN brand has been used for a long time and has built up a reputation for the relevant goods. Therefore, I believe that the TANSUN trade mark has acquired enhanced distinctiveness as a consequence of the use made by my company.”

56. I will begin by assessing the inherent distinctive character of the earlier marks (series of two), which consist solely of the word TANSUN / Tansun. The word is likely to be perceived as invented, however, bearing in mind that some of the opponent’s goods are tanning products, such as sunbeds, etc., whilst not descriptive, the mark may be perceived as allusive in relation to such goods. On this basis, I find that the mark has a medium degree of inherent distinctiveness.

57. Turning now to consider whether the distinctiveness of the earlier mark has been enhanced through use, I refer to the opponent’s evidence of use, which can be summarised as follows:

Summary of the witness statement and exhibits of Mr Piara Singh Rana, filed in support of a claim of enhanced distinctiveness:

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<sup>9</sup> Mr Piara Singh Rana’s witness statement

- Various screenshots taken from the internet archive site 'Wayback Machine' dated between 2005 to 2021, relating to websites 'www.tansun.com', 'www.tansun.co.uk' and 'www.tansunbeds.co.uk' as well as 'TANSUN LEISURE' and 'TANSUN LIMITED' websites. The numerous screenshots demonstrate the range of tanning products available under the 'TANSUN' trade mark.<sup>10</sup>
- Case studies and testimonials taken from the opponent's website 'www.tansun.com', dated between 2017 and 2018.<sup>11</sup>
- Printouts obtained from 'TANSUN LEISURE' magazines dated between 2018-2020, 2018-2019, illustrating use of the 'TANSUN' trade mark on tanning products and supplies.<sup>12</sup>
- Industry awards and ISO 9001 certification dated between 2017-2020.<sup>13</sup>

Summary of the witness statement and exhibits of Ms Janette Hamer filed in support of a claim of enhanced distinctiveness:

- Examples of the products sold by 'TANSUN' (opponent).<sup>14</sup>
- Examples of products offered on TANSUN'S UK websites.<sup>15</sup>
- Dictionary definitions for the terms: 'cosmetics', 'toiletry', 'repair', 'sticker', 'adhesive', 'tape', 'glue', 'heating apparatus', 'heater', 'radiator', 'valves' and 'thermostat'.<sup>16</sup>
- Screenshots showing use of TANSUN'S valves in the form of dimmers to control the output of heat, a gas.<sup>17</sup>

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<sup>10</sup> Exhibits PSR2-PSR6

<sup>11</sup> Exhibit PSR2

<sup>12</sup> Exhibits PSR3 and PSR6

<sup>13</sup> Exhibits PSR9 and PSR10

<sup>14</sup> Exhibit JCH1

<sup>15</sup> Exhibits JCH9 and JCH10

<sup>16</sup> Exhibits JCH2-JCH8, JCH11-JCH14, and JCH16

<sup>17</sup> Exhibit JCH15

- Screenshots showing sun tan beds utilising heat to function.<sup>18</sup>
- Screenshot showing that sun tan beds require ballasts.<sup>19</sup>
- Screenshots showing the purpose of an electrical ballast for controlling voltage of fluorescent lighting and regulating and electric current.<sup>20</sup>

58. Whilst it is clear from the opponent's evidence that the mark 'TANSUN' has been in use in the UK for a number of years in relation to tanning products and tanning supplies, I am of the view that the evidence before me is not sufficient for me to be persuaded that the earlier mark is known to consumers in the UK to such an extent that the mark's distinctive character has been enhanced above an average level. Turnover and marketing figures have not been submitted, nor have I been provided with the market share of any of the goods or services at issue. Accordingly, whilst I note the marketing material submitted along with the above stated screenshots from various websites, from the evidence presented before me, I find that the level of inherent distinctive character has not been enhanced through such use.

### **Likelihood of confusion**

59. 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. One such factor 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 necessary for me to keep in mind the distinctive character of the earlier trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

60. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where

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<sup>18</sup> Exhibit JCH17

<sup>19</sup> Exhibit JCH18

<sup>20</sup> Exhibit JCH19

the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

61. Earlier in the decision I concluded that the respective marks are visually and aurally similar to a high degree, and conceptually neutral. I have found the opponent's marks to be inherently distinctive to a medium degree but that the evidence does not show the distinctiveness has been enhanced through use. I concluded that the parties' goods vary from being identical to dissimilar. Furthermore, I have found that average consumers of the goods will include members of the general public as well as business and professional users. I have found that average consumers will pay at least a medium degree of attention when selecting the goods. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations.

62. Given that the letters 'TANS\_N / Tans\_n / tans\_n\_' are identically present in the competing marks, I consider that the marks are likely to be mistakenly recalled or misremembered as each other when used on the goods at issue. I am of this view given that the degree of visual similarity is high and that the purchasing process is predominantly visual. Furthermore, I keep in mind that the beginnings of marks tend to make more of an impact than the ends. Accordingly, as the marks identically share the same beginnings and the only differences between the marks is that the opponent's marks contain the letter 'U/u' in the fifth position of the mark whereas the fifth letter in the contested mark is the letter 'o', and there is an additional letter 's' present at the end of the contested mark which is not replicated in the opponent's mark, it is my view that these differences will be easily overlooked by the average consumer. Furthermore, although the marks are not aurally identical, they are nevertheless aurally similar to a high degree. I also consider that, in the absence of a strong conceptual hook, the average consumer will not have a strong conceptual message to assist them in differentiating between the marks. Accordingly, I consider there to be a likelihood of direct confusion for those goods which I have found to be identical or similar to a high degree.



63. In the event that I am wrong about direct confusion, I will now go on to consider indirect confusion. I acknowledge that a finding of indirect confusion should not be made merely because the two marks share a common element. However, it is not sufficient that a mark merely calls to mind another mark:<sup>21</sup> this is mere association not indirect confusion.

64. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, as the Appointed Person, explained that:

“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.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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<sup>21</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

65. These examples are not exhaustive but provide helpful focus.

66. Further, in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

67. For a finding of indirect confusion, I would need to conclude that consumers will notice the common elements ‘TANS\_N / Tans\_n / tans\_n\_’ while at the same time recalling the differences between the marks and assume that the marks are from the same or related undertakings. However, to my mind, the stated differences between the letters in the marks, namely ‘TANSUN / Tansun’ versus ‘tansons’ are not a logical brand extension or sub-brand and, as such, I do not see a logical step which would induce consumers to be indirectly confused. Rather, I am of the view that the average consumer would put the presence of the common elements ‘TANS\_N / Tans\_n / tans\_n\_’ in the marks down to coincidence rather than economic connection. Accordingly, there is no likelihood of indirect confusion.

## **Conclusion**

68. The opposition under section 5(2)(b) has been partially successful. The application is refused for the following goods:

Class 11 Radiator valves; Radiator valves [thermostatic];Apparatus for controlling temperature in central heating radiators [valves]; Automatic temperature regulators [valves] for central heating radiators; Control valves (Thermostatic -) for central heating radiators; Temperature control apparatus [valves] for central heating radiators; Temperature control valves [parts of central heating radiators]; Temperature controllers [valves] for central heating radiators; Temperature controlling apparatus [valves] for central heating radiators; Temperature limiters [valves] for central heating radiators; Temperature limiters for central heating radiators [thermostatic valves] incorporating bi-metallic discs; Temperature limiters for central heating radiators [thermostatic valves] incorporating expansion rods; Temperature regulators [thermostatic valves] for central heating radiators; Temperature responsive control apparatus [thermostatic valves] for central heating radiators; Temperature sensing apparatus [thermostatic valves] for central heating radiators; Temperature sensitive switches [thermostatic valves] for central heating radiators; Temperature sensors [thermostatic valves] for central heating radiators; Thermal controls [valves] for central heating radiators; Valves as part of radiators; radiators; Automatic temperature regulators [valves] for central heating radiators; Central heating apparatus; Central heating radiators; Control devices [thermostatic valves] for heating installations; Control units [thermostatic valves] for heating installations; Control valves (Thermostatic -) for central heating radiators; Domestic radiators; Flat radiators for central heating installations; Radiator caps; Radiator heaters; Radiator valves; Radiator valves [thermostatic];Radiators; Radiators, electric; Radiators for central heating installations; Radiators for central heating systems; Radiators [for industrial air-conditioning purposes];Radiators [heating];Temperature control apparatus [valves] for central heating radiators; Temperature control valves [parts of central heating installations]; Temperature control valves [parts of central heating radiators]; Temperature controllers [valves] for central heating radiators; Temperature controlling apparatus [valves] for central heating radiators; Temperature limiters for central heating radiators [thermostatic valves] incorporating bi-metallic discs; Temperature limiters for central heating radiators [thermostatic valves] incorporating expansion rods; Temperature limiters [valves] for central heating radiators; Temperature regulators [thermostatic valves] for central heating radiators; Temperature responsive control apparatus [thermostatic].

69. The opposition fails under Section 5(2)(b) for the following goods which can proceed to registration:

Class 16 Adhesive packaging tapes; Adhesive tape cutters being stationery; Adhesive tape dispensers for household or stationery use; Adhesive tape dispensers [office requisites]; Adhesive tape dispensing machines [office requisites]; Adhesive tape for stationery purposes; Adhesive tapes for stationery or household purposes; Adhesive tapes for stationery purposes; Adhesives for stationery; Adhesives for stationery and household use; Adhesives for stationery or household purposes; Adhesives for stationery or household use; Adhesives for stationery purposes; Adhesives [glues] for stationery or household purposes; Automatic adhesive tape dispensers for office use; Bookbinding tape; Brown paper for wrapping; Dispensers (Adhesive tape -) [office requisites]; Double sided adhesive tapes for household use; Double sided adhesive tapes for stationery use; Double-sided adhesive tapes for household use; Gummed cloth for stationery purposes; Gummed paper; Gummed tape [stationery]; Gums [adhesives] for stationery or household purposes; Holders for adhesive tapes; Paper carton sealing tape; Sealing tape for stationery use; Self-adhesive tapes for stationery and household purposes; Self-adhesive tapes for stationery or household purposes; Self-adhesive tapes for stationery use; Sticky tape; Tapes (adhesive -) [stationery].

### **Costs**

70. On balance, I consider that both parties have achieved a relatively equal level of success in these proceedings. In the circumstances, I do not consider it appropriate to make a costs award in favour of either party. Therefore, I order both parties to bear their own costs in these proceedings.

**Dated this 6<sup>th</sup> day of March 2023**

**Sam Congreve  
For the Registrar**