

O/0331/23

THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,677,896 IN THE NAME OF WAN JOU LIN AND GREAT INS COMPANY LIMITED

AND IN THE MATTER OF THE OPPOSITION UNDER NO 429,368 IN THE NAME OF GENERAL ECOLOGY, INC

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF SARAH WALLACE (O/943/22) DATED 31 OCTOBER 2022

DECISION

Introduction

1. This is an appeal from the decision of Ms Sarah Wallace, for the Registrar, dated 31 October 2022 (O/943/22). General Ecology, Inc unsuccessfully opposed the application of Wan Jou Lin and Great Ins Company Limited to register trade mark (No 3,677,896) under section 5(2)(b) of the Trade Marks Act 1994. General Ecology appeals.
2. Wan Jou Lin and Great Ins Company Limited applied to register the following mark:



3. The application was for the following goods in Class 11:
Drinking water filters; Drinking water (Filters for -);Filters for drinking water; Apparatus for filtering drinking water; Water filters; Water filtering installations; Water filtering units; Water purification filters; Water filtering apparatus; Filters for water purifiers; Apparatus for water filtering; Apparatus for filtering water; Domestic water filtering units; Household tap-water filters; Water filters for household purposes; Electric water purification filters for household purposes; Filter apparatus for water supply installations; Filters for use with apparatus for water supply; Faucet filters; Water filtering apparatus for domestic use.
4. General Ecology opposed this application based on its earlier word mark NATURE PURE (No 900,122,143), which is registered in Classes 7, 11 and 37:

Class 7: Filtering machines; washing machines; and dishwashing machines; and parts and fittings for all the aforesaid goods.

Class 11: Water purifying machines, water treatment machines, water conditioning machines and water softening machines; water supply apparatus and installations; sanitary apparatus and installations; refrigerating apparatus; air purifying apparatus and instruments; water treatment apparatus and installations; water conditioning apparatus and installations; water softening apparatus and installations; water purification apparatus and installations; water sterilisers; liquid, gas and air filters; and parts and fittings for all the aforesaid goods.

Class 37: Installation, maintenance and repair services relating to water purifying, treatment, conditioning and softening machines, apparatus and installations; filtering machines, installations and apparatus, plumbing services.

Standard of appeal

5. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that he or she has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch) at [24]. When considering this appeal, and applying these principles, it is important to remember the high bar set.

The Hearing Officer's uncontested findings

6. The Hearing Officer made a number of findings which are not in issue in this appeal. She found the goods covered by the two marks to be identical (or as an alternative, highly similar): Decision, [17]. She went on to find there were two relevant publics: the general public and professional trade users: Decision, [20]. The marks were found to be visual similar to a medium degree (Decision, [32]), aurally similar to between a medium and high degree (Decision, [33]) and that there was a high degree of conceptual similarity (Decision, [34]). She also found that the purchasing process for the general public and for trade users would involve an average degree of attention and would be dominated by visual considerations, but there would be word of mouth recommendations: Decision, [21] and [22].

Grounds of appeal

7. The Appellant appeals the Hearing Officer's decision on two grounds. The first challenge is to the finding by the Hearing Officer that the earlier mark had a low degree of distinctiveness. The second challenge is to the way in which the Hearing Officer took account of the low distinctiveness of the word mark, NATURE PURE, in her application of the likelihood of confusion test.

First ground: incorrect finding on distinctiveness

8. I will first consider the challenge to the Hearing Officer's assessment of the distinctiveness of the earlier mark. She set out her findings in Decision, [26] (footnotes omitted):

The earlier mark is in a word-only format and consists of the words "NATURE PURE". The word "PURE" is defined as "clean and free from harmful substances". In the context of the

goods, it will be seen as strongly alluding to the intended purpose of the goods, i.e. to produce pure/clean water. The word “NATURE” has a dictionary definition meaning “all the animals, plants, rocks, etc. in the world and all the features, forces, and processes that happen or exist independently of people, such as the weather, the sea, mountains, the production of young animals or plants, and growth”. Nature brings to mind natural rivers and streams and is therefore somewhat allusive of the goods producing natural unspoilt water. Therefore, in my opinion, the distinctiveness of the mark lies in both words in roughly equal measure, however the word “NATURE” is slightly more distinct as its allusive meaning is less direct than that of the word “PURE”. However, both word elements, whether alone or in combination, will be lowly distinctive. Accordingly, overall, I consider that the earlier mark possesses a low degree of inherent distinctive character.

9. This is a reasonable and thoughtful exploration of this matter. It is also the Hearing Officer making a value judgment and therefore is something that cannot be challenged on appeal unless it is perverse. In my view there were no good reasons put forward by the Appellant as to why it should be disturbed and so I reject the first ground of appeal.

Second ground: likelihood of confusion and low level of distinctiveness

10. As a starting position for the second ground of appeal, it is the case that in relation to a registered trade mark, “it is necessary to acknowledge a certain degree of distinctiveness”: *C-196/11 Formula One*, EU:C:2012:314, [47]. In other words, every registered trade mark must be treated as having at least the minimum degree of distinctiveness necessary to obtain registration.
11. In addition, when considering marks with a low level of distinctiveness, the Court of Justice stated in *C-235/05 L’Oreal SA v OHIM* [2006] ECR I-57 at [45]:

The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.
12. The effect of this was explained further in *C-171/06 T.I.M.E. ART v OHIM* [2007] ECR I-41, [41] where the Court of Justice went on to indicate that giving undue weight to a mark’s low level of distinctiveness would be inconsistent with the global appreciation test, which is central to the comparison of marks. In short, it is clear that even where a mark has a weak distinctive character, there may be a likelihood of confusion by reason of the similarity between the marks and the goods and services covered by those marks.
13. Domestically, there is a series of cases dealing with marks which have a low level of distinctiveness. The usual starting point is *Whyte & Mackay v Origin Wine* [2015] EWHC 1271 (Ch), [2015] FSR 33. This was an appeal from an opposition where the

word mark JURA ORIGIN was applied for, and the “best” earlier mark used to oppose it was the word mark ORIGIN.

14. In his analysis Arnold J considered the fact that the ORIGIN element of the marks had a low level of distinctiveness and, in particular, he stated at [44]:

...if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.

15. Arnold J was also dubious about the correctness of the suggestion in R 1462/2012-G *Lifestyle Supplies VoF v Ultimate Nutrition Inc* [2014] ETMR 27 at [59]-[62] that where the shared elements in two marks have a low level of distinctiveness it will not normally give rise to any likelihood of confusion (*Whyte & Mackay*, [44]).

16. On the facts of that case, Arnold J held that the mark ORIGIN had the minimum degree of distinctive character for it to be validly registered, that the word ORIGIN in the later mark was identical to the word in the earlier mark (but did not play an independent distinctive role), and that JURA was the distinctive part of the mark. Critically, there was also a low degree of similarity between the goods (indeed, it would have been open to the court to find that wine and spirits were not similar at all: T-430/07 *Bodegas Montebello*, EU: T:2009:127). In any event, Arnold J found there was no likelihood of confusion (*Whyte & Mackay*, [46] and [47]).

17. Critically, in that case, the additional element in the later mark – the word JURA - was much more distinctive than the common element (ORIGIN).

18. I now turn to *Nicoventures Holdings v The London Vape Company* [2017] EWHC 3393 (Ch). This case involved the following two figurative marks:



19. Birss J drew on the reasoning from *Whyte & Mackay* and then added the following at [27]:

...If the only similarity between two marks arises from common elements which have low distinctiveness (alone and as a combination) then that tends to weigh against a finding of likelihood of confusion. Such a situation does not preclude a finding of likelihood of confusion but it is a relevant factor and in an appropriate case it may be decisive.

20. In these marks, Birss J held that the words VAPE and CO were individually both descriptive and non-distinctive, and likewise the combination is descriptive and non-distinctive: *Nicoventures*, [34]. He went on to say, “Although the stylised aspects of each mark are not very remarkable, the fact remains that these aspects are entirely different.”: *Nicoventures*, [36].

21. In other words, the distinctiveness of the two marks was entirely in the stylisation and in this respect the two marks were very different. Accordingly, he found there to be no likelihood of confusion between the two marks (at [37]).
22. In *Whyte & Mackay*, the word mark ORIGIN had to be treated as distinctive in accordance with the rule from *Formula One*. Whereas in *Nicoventures*, the words VAPE or CO could be treated as descriptive (and not distinctive) because the necessary distinctiveness for *Formula One* purposes could come from the stylisation.
23. Accordingly, I think *Whyte & Mackay* goes much further than *Nicoventure*. I read the former case as holding that where the first mark is of low distinctiveness overall, and it is replicated (even wholly replicated) in a second mark, this suggests against a likelihood of confusion *provided* there is at least one element in the second mark which is sufficiently more distinctive than the element consisting of the first mark. This view also seems to me to be consistent with the extract from the *L'Oreal* judgment above.
24. More recently, in *Planeart LLC v Photobox Ltd* [2020] EWHC 713 (Ch), [2020] FSR 26, Daniel Alexander QC, sitting as a deputy High Court judge, stated at [29]:
- These cases show that there is no hard rule that use of a descriptive term cannot lead to a finding that there is confusion but they also show that such a case is harder to establish. It also has the impact of somewhat downgrading the significance of conceptual similarity in the evaluation of the likelihood of confusion at least in so far as the mark is descriptive of the goods and services in question.
25. This conclusion was built upon by Nicholas Caddick QC, sitting as a deputy High Court judge, in *Match Group, LLC V Muzmatch Ltd* [2022] EWHC 941 (IPEC) at [91]:
- the fact that a claimant's mark and a defendant's sign share a common element that is descriptive may make it more difficult to conclude that there is a likelihood of confusion, but it does not make it impossible. Moreover, it seems to me that a finding of a likelihood of confusion may well be appropriate where the average consumer recognises that that common element, whilst capable of being used descriptively, is in fact being used distinctively as a badge of origin. The issue is highly fact sensitive and has to be assessed globally, taking into account all relevant factors, including the context in which the signs have been used.
26. I agree with this statement of the law, but I think it would be helpful once more to put it in the context of *Formula One*. A mark which is of low distinctiveness overall is still seen as a badge of origin; so the mark ORIGIN in *Whyte & Mackay* must be treated as a badge of origin. But when that badge of origin is combined with other *more* distinctive elements in a second mark, the origin function of the first mark *may* fade into the background in the wider context of the second mark. Thus, the question is really whether other elements of the second mark cause the element coming from the first mark to fade sufficiently.
27. This reasoning is consistent with what was said by Philip Harris, sitting as the Appointed Person, in *Purity Well Group* (O/115/22) at [80]:
- The point about weak distinctiveness is that consumers will be less likely, depending on context, to jump to the conclusion the term is functioning in a distinctive, origin indicative way. I consider that to be the case here. The overall differences outweigh the similarity, which is entirely due to the weak components.

28. Turning to the instant case, in relation to the NATURAL PURE words in the mark applied for, the Hearing Officer found as follows at [31]:

The contested mark is a figurative mark and encompasses the words “Natural Pure” in standardised blue font. Above these words is a figurative element, which, in context of the mark as a whole, will be perceived as a blue water droplet with a stylised green leaf positioned inside. Below the words “Natural Pure”, are the words “NATURAL PURE DRINKING WATER”, in small font. Together, these words will be considered a strapline for the product, informing the customer that the goods are for producing natural, pure drinking water. Therefore, they will have little trade mark significance and play a minimal role in the overall impression. The words “Natural Pure” and the figurative element dominate the overall impression in roughly equal measure, but the words “Natural Pure” will have slightly more impact as consumers’ eyes are naturally drawn to elements of marks that can be read.

29. Accordingly, there are two equally dominant elements of the later mark: the words NATURAL PURE, and the water drop and leaf combination. Both of these elements are of low distinctiveness. This contrasts to *Whyte & Mackay* (and cases like T-102/14 *Deutsche Post v OHIM*, EU:T:2015:279) where the shared element of low distinctiveness faded behind a much more distinctive element; in the instant case, it stands equal to it. Furthermore, in contrast to *Whyte*, the goods in this case are identical (or at least highly similar) rather than of low similarity.

30. I therefore take the view that the Hearing Officer fell into error in her assessment of the likelihood of confusion by giving undue weight to the fact that the earlier mark had a very low level of distinctiveness.

31. In light of the Hearing Officer’s factual findings set out in paragraph 6, which are not disputed, I must reconsider the likelihood of confusion.

32. When the correct weight is given to the low distinctiveness of the mark, NATURE PURE, it is my view that a consumer paying only an average degree of attention could easily mistake the words NATURAL PURE in the contested mark for the earlier mark NATURE PURE. This is particularly the case when one takes into account imperfect recollection and word of mouth recommendations. Indeed, it must be remembered that the scope of protection of the mark NATURE PURE extends to any typeface and font: *DREAMERS CLUB* [2019] RPC 505, [11] and [12]. The earlier word mark could therefore be used in exactly the same typeface and font as that used for NATURAL PURE. I also note that the consumer has more regard to the beginning of words: T-183/02 *El Corte SA v OHIM* [2004] ECR II-965, [83]. But in this case one can go further and say that the second word being identical, combined with the small difference between the endings of the first word (E and AL), means that this difference could easily go unnoticed or be discounted by the consumer.

33. In contrast to the Hearing Officer, I do not believe the addition of the water drop and leaf (or indeed the tag line Natural Pure Drinking Water), even though they would be noticed by the relevant public, would be sufficient to dispel any confusion as to origin.

34. Accordingly, I take the view that there would be a likelihood of confusion between the two marks.

Conclusion

35. I therefore uphold the appeal. The opposition under section 5(2)(b) is successful and the application should be refused in its entirety.

36. I award the Appellant £2,000 as a contribution to its costs on appeal and below. This is to be paid by the Respondent with 14 days of the date of this decision.

PHILLIP JOHNSON
THE APPOINTED PERSON
2 April 2023

Representation

Steve Waine (of Murgitroyd & Co) for the Appellant

Shuhao Chang appeared for the Respondent as a litigant in person