

O-046-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 1063868  
AND THE REQUEST BY SPHEROS GMBH  
TO PROTECT THE TRADE MARK  
REVO  
IN CLASSES 11, 37, 41 & 42  
AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER No. 72315 BY  
EAE ELETRIK ASANSOR ENDUSTRISI INSAAT  
SANAYI VE TICARET ANONIM SIKETI**

## BACKGROUND

1) On 30 July 2010, Spheros GmbH (hereinafter the applicant) on the basis of its international registration based upon its registration held in Germany, requested protection in the United Kingdom of the trade mark:

Revo

2) Protection was sought for the following goods:

In Class 11: Air conditioning systems, namely integrated or roof top air conditioners; air conditioners and structural parts thereof, namely condensers, evaporators and electric fans, air filters and filter mats; valves, especially thermostat valves, suction stopcocks and slide valves, all these systems, devices, components and valves for air conditioning units for omnibuses and track vehicles; heating installations for vehicles and parts thereof, namely silencers for heated air, radiators, heaters with electric axial fans, axial and radial side wall heaters, roof channel heaters, engine independent vehicle heaters, pre-heaters and supplementary heaters operated with gas, in particular with gasoline or diesel fuel as source of energy, all these systems, devices and components for omnibuses and track vehicles.

In Class 37: Maintenance, servicing and repair and installation of air conditioning systems and heaters for omnibuses and track vehicles.

In Class 41: Training of installation and service staff in the field of air conditioners and heating devices for omnibuses and track vehicles.

In Class 42: Technical project studies relating to heaters and air conditioning systems for omnibuses and track vehicles (included in this class).

3) The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published on 17 June 2011 in accordance with Article 10.

4) On 17 August 2011 Eae Elektrik Asansor Endustrisi Insaat Sanayi Ve Ticaret Anonim Sirketi (hereinafter the opponent) filed notice of opposition to the conferring of protection on this international registration. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following international registration designating the UK/EU:

| Mark        | Number   | Date of designation in UK /International registration date | Class | Specification   |
|-------------|----------|--|-------|---|
| <b>Revo</b> | M1001379 | 27.03.2009 /<br>27.03.2009                                 | 11    | Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes. |

b) The opponent contends that the mark in suit is identical similar to its mark. It also contends that the goods and services of the two parties are identical or similar. The mark in suit therefore offends against Section 5(1), 5(2)(a) and 5(2)(b) of the Act.

5) On 28 May 2012, the applicant filed a counterstatement denying all the grounds but did not put the opponent to proof of use.

6) Neither side filed evidence, but both seek costs. Neither side wished to be heard in the matter. Only the applicant provided written submissions.

## DECISION

7) The opposition is based on sections 5(1), 5(2)(a) and 5(2)(b) which read as follows:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the earlier trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

8) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking

account (where appropriate) of the priorities claimed in respect of the trade marks.”

9) The opponent is relying upon its trade mark listed in paragraph 4 above which is clearly an earlier trade mark. The opponent was not put to strict proof of use by the applicant as, given the play between the dates of both parties’ marks, its mark is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

10) When considering the issue under Section 5(1) I shall take into account the decision of the Court of Justice of the European Union (CJEU) in the *LTJ Diffusion S.A. v Sadas Vertbaudet S.A.* (case C-291/00) [2003] FSR 34 where at paragraphs 49-54 they stated:

“49. On the other hand, Article 5(1)(a) of the directive does not require evidence of such a likelihood in order to afford absolute protection in the case of identity of the sign and the trade mark and of the goods or services.

50. The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Article 5(1)(a) of the directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the directive.

51. There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52. However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26).

53. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by the average consumer.

54. In those circumstances, the answer to the question referred must be that Article 5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

11) When considering the issues under Section 5(2)(a) & (b) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

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

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Distinctive character of the opponent's earlier trade mark**

12) The opponent has provided no evidence and as such cannot show that it has a significant reputation in the mark at paragraph 4 above. However, I regard the opponent's mark as having a high degree of inherent distinctiveness for the goods for which it is registered.

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

13) I must now determine the average consumer for the goods and services of the parties. The opponent has a specification for "Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes". This is a broad specification of goods which will be sold to professionals as well as members of the general public. By contrast the applicant's goods and services all are limited to omnibuses and track vehicles. Clearly the applicant's goods and services will not be purchased by members of the public but by professionals working on, broadly, buses and trains. Such individuals are likely to be highly attentive as technical specifications of goods will be paramount and similarly when choosing services they will be very wary about purchasing in services given the possibility of being open to public liability lawsuits. Any consumer for such services would want to be certain of the technical abilities of those entrusted with any work on buses or trains.

### **Comparison of trade marks**

14) The trade marks to be compared are as follows:

| Applicant's mark | Opponent's mark |
|------------------|-----------------|
| Revo             | Revo            |

15) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

### **Distinctive and dominant components**

16) In my opinion, there are no dominant or distinctive elements in either party's trade marks. The distinctiveness lies in their totality, which in the case of the opponent's mark is, as far as I am aware (and there is no evidence or submissions to the contrary), distinctive for the goods for which it is registered

17) Whilst there are very slight stylistic differences in the fonts used the marks are clearly identical. I note that the applicant does not contest this in its submissions.

### **Comparison of goods and services**

18) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods reach the market;
- e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be found on the same or different shelves;
- f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

19) In *Gerard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM-Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the earlier trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM-Petit Liberto (Fifties)*[2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

20) The question of complementary goods/services has been considered by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the CFI stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057 ; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757 , paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000 , paragraph 48).”

21) For ease of reference the competing goods and services are reproduced below:

| Applicant's goods and services   | Opponent's goods   |
|--|--|
| In Class 11: Air conditioning systems, namely integrated or roof top air conditioners; air conditioners and structural parts thereof, namely condensers, evaporators and electric fans, air filters and filter mats; valves, especially thermostat valves, suction stopcocks and slide valves, all these systems, devices, components and valves for air conditioning units for omnibuses and track vehicles; heating installations for vehicles and parts thereof, namely silencers for heated air, radiators, heaters with electric axial fans, axial and radial side wall heaters, roof channel heaters, engine independent vehicle heaters, pre-heaters and supplementary heaters operated with gas, in particular with gasoline or diesel fuel as source of energy, all these systems, devices and components for omnibuses and track vehicles. | In Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes. |
| In Class 37: Maintenance, servicing and repair and installation of air conditioning systems and heaters for omnibuses and track vehicles.  |  |

|  |  |
|--|--|
| In Class 41: Training of installation and service staff in the field of air conditioners and heating devices for omnibuses and track vehicles.     |  |
| In Class 42: Technical project studies relating to heaters and air conditioning systems for omnibuses and track vehicles (included in this class). |  |

22) It is accepted case law that goods and services in different classes cannot be regarded as identical. I shall first compare the goods of both parties in Class 11. The applicant's specification can be said to be services associated with of heating and air conditioning systems for omnibuses and track vehicles and associated parts thereof. The opponent's specification includes heating, refrigeration, drying and ventilation. To my mind these terms encompass the whole of the applicant's specification. The applicant submitted that its goods were highly specialised, however as the opponent's specification is not restricted it would cover parts for omnibuses and track vehicles. **The goods in Class 11 must be regarded as identical.**

23) I now turn to consider the applicant's services in Class 37, 41 and 42 which basically cover the maintenance, servicing and repair of air conditioning and heating for omnibuses and track vehicles, training staff how to install and service such systems and also technical project studies relating to such systems. No evidence has been put forward regarding the marketplace to show whether or not manufacturers of such heating and air conditioning systems for omnibuses and tracked vehicles also provide maintenance, training and technical study services. All of these are highly specialised services which would require highly skilled and qualified technicians. Also any company offering such services would require to be certified by various governmental bodies as well as trade organisations. Despite this the services must be regarded as complimentary to the provision of goods as the services cannot exist without the services and the average consumer would be expected to offer such services. **In my opinion, the applicant's services in Classes 37, 41 & 42 are similar to the opponent's goods in Class 11 as they are complimentary.**

### **Likelihood of confusion**

24) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services and vice versa. Clearly the marks are identical, however my finding that the services in classes 37, 41 and 42 are not identical but only similar/complementary to the opponent's goods in class 11 means that there is a likelihood of consumers being confused into believing that the services provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (a) therefore fails in relation to the services in classes 37, 41 and 42. However, the opposition under Section 5(2)(b) succeeds.**

## CONCLUSION

25) The opponent has succeeded under Section 5(1) with regard to the applicant's goods in Class 11 but has failed under this ground in relation to the applicant's services in Classes 37, 41 and 42. However, it succeeds with regard to the applicant's services in Classes 37, 41 & 42 under the ground of opposition under Section 5(2)(b).

## COSTS

26) As the opponent has been successful it is entitled to a contribution towards its costs.

|  |             |
|--|-------------|
| Preparing a statement and considering the other side's statement | £200        |
| Expenses   | £200        |
| <b>TOTAL</b>   | <b>£400</b> |

70) I order Spheros GmbH to pay Eae Elektrik Asansor Endustrisi Insaat Sanayi Ve Ticaret Anonim Sirketi the sum of £400. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 30<sup>th</sup> day of January 2013**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**