

O-065-04

DECISION OF THE TRADE MARKS REGISTRY

TRADE MARKS ACT 1994

APPLICANT: OMEGA WATER HEATING LIMITED

APPLICATION N^o. 2233678

AND

OPPONENT: S.A. SPA MONOPOLE

OPPOSITION N^o. 52478

CLASS 11

SPA

BACKGROUND

1. The mark is SPA. It was applied for on 24th May 2000 by Omega Water Heating Limited, 4 First Avenue, Bluebridge Industrial Estate, Halstead, Essex, CO9 2EX Great Britain in respect of:

Class 11: Apparatus for heating water; water heaters and boilers; central heating apparatus; gas burners; flues; coils; gas boilers, burners and condensers; heat exchangers and accumulators; storage water heating apparatus; direct and indirectly heated water storage apparatus; instantaneous water heating apparatus; water heating apparatus; thermostatic valves; thermostats for use with water heating apparatus; water heating apparatus control systems; expansion vessels for water heating apparatus; parts and fittings for all the aforesaid goods.

2. Registration of the mark is opposed by S.A. Spa Monopole, Compagnie Fermiere de Spa under numerous grounds, namely: ss. 1(1), 3(1)(b), 3(1)(c), 3(1)(d), 3(3)(b), 3(4), 5(2)(b), 5(3) & 5(4)(a). The trade marks on which the opponent relies are listed in the Annexes to this decision.
3. A Counterstatement was provided by the applicant denying the grounds asserted. Both parties ask for costs to be awarded in their favour.

HEARING

4. Neither party requested a hearing, though each provided written submissions.

EVIDENCE

5. The opponent encloses two Declarations, both by their Managing Director, Marc du Bois. The first contains relevant evidence which I summarise below, and the second being in reply to the applicant's one Witness Statement, provided by Andrew R. C. Marshall, their Director. I have chosen not to summarise the latter two documents in detail: Mr. Marshall's Statement contains little material evidence that advances the applicant's case. And Mr. du Bois's second Declaration is a largely unnecessary repudiation of the latter. I do refer to one piece of material evidence cited by Mr. Marshall, and Mr. du Bois's response to it. Relevant submissions I consider in the body of the decision.
6. Mr. du Bois states the Spa Monopole is the owner of the trade mark SPA which has been used continuously in the United Kingdom in respect of mineral water since at least 1971. He says that SPA mineral waters have been exported to the United Kingdom for hundreds of years. The opponent has had the exclusive right to extract and commercially exploit the mineral waters produced from springs around the Belgium town of Spa, which it (and its predecessors) have done since the 17th century. In Mr. du Bois's view, the SPA trade mark is extremely well known in relation to mineral waters, and 'It is undoubtedly a "Well known" trade mark as envisaged by Article 6 bis of the Paris Convention.'
7. Examples of how the mark has been used are shown in Exhibit SPA 1, which encloses various specimen labels: mark No. 140673 appears to be the most commonly used form of the opponent's sign.

8. The 'annual values' of 'the said goods sold by Spa Monopole in the United Kingdom for the period 1973 to 2001 (inclusive)' are provided as follows:

| Year | Bottles | £ |
|------|------------|----------------------|
| 1973 | 39,840 | 13,900 |
| 1974 | 49,020 | 17,200 |
| 1975 | 24,420 | 8,500 |
| 1976 | 24,000 | 3,800 |
| 1977 | 26,400 | 7,500 |
| 1978 | 1,440 | 500 |
| 1979 | 212,064 | 23,200 |
| 1980 | 858,768 | 96,628 |
| 1981 | 1,872,168 | 243,294 |
| 1982 | 2,794,000 | 296,263 |
| 1983 | 3,167,388 | 453,218 |
| 1984 | 2,741,676 | 409,340 |
| 1985 | 2,511,384 | 364,948 |
| 1986 | 2,571,468 | 423,037 |
| 1987 | 4,350,984 | 806,779 |
| 1988 | 6,911,256 | 1,346,842 |
| 1989 | 13,956,072 | 3,109,569 |
| 1990 | 15,133,656 | 3,588,238 |
| 1991 | 14,608,860 | 3,475,821 |
| 1992 | 16,124,281 | 3,711,000 |
| 1993 | 16,943,132 | 4,004,000 |
| 1994 | 13,740,911 | 3,355,000 |
| 1995 | 14,010,903 | 3,355,000 |
| 1996 | 10,722,685 | 2,546,000 |
| 1997 | 13,986,024 | 3,079,000 |
| 1998 | 10,263,424 | 2,381,000 |
| 1999 | 12,188,815 | 2,728,000 |
| 2000 | 14,847,350 | 2,892,000 |
| 2001 | 15,288,400 | 3,000,000 (estimate) |

9. Also provided is advertising expenditure:

| Year | £ |
|------|---------------|
| 1978 | 30,000 |
| 1979 | 100,000 |
| 1980 | 150,000 |
| 1981 | 170,000 |
| 1982 | Not available |
| 1983 | Not available |
| 1984 | Not available |
| 1985 | Not available |
| 1986 | Not available |
| 1987 | Not available |
| 1988 | 48000 |
| 1989 | 84000 |

| | |
|------|--------------------|
| 1990 | 119000 |
| 1991 | 88000 |
| 1992 | 397,000 |
| 1993 | 123,000 |
| 1994 | 168,000 |
| 1995 | 100,000 |
| 1996 | 77,000 |
| 1997 | 243,000 |
| 1998 | 456,000 |
| 1999 | 598,000 |
| 2000 | 513,000 |
| 2001 | 500,000 (estimate) |

LAW

10. The relevant sections of the Act are:

“1.-(1) In this Act a ‘trade mark’ means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

....

3.-(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(3) A trade mark shall not be registered if it is –

- (a), or
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

....

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

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

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

(3) A trade mark which-

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

DECISION

Preliminary point: the opponent’s written submissions

11. As stated above, both parties have filed written submissions in these proceedings. There was, however, what I would describe as a “skirmish” between the parties in relation to whether or not I should consider the opponent’s submissions as part of my decision. In the Trade Mark Registry’s letter to both parties dated 7th May 2003 I indicated that I was content to issue a substantive decision on the case based on the papers on file rather than with recourse to a

hearing. I allowed a period up until 18th June 2003 for the parties to file any written submissions or alternatively up until 7th June 2003 for either party to request a hearing.

12. The opponent did not file their submissions by the 18th June deadline, instead filing a Form TM9 requesting additional time in which to do so. They explained that they did not know until after 7th June 2003 whether the applicant was intending to request a hearing, as a consequence, their submissions had not been prepared prior to this date. This was compounded by the fact that their representative was then away from the office on business and on holiday. The applicant objected to this extension of time as they felt that the reasons did not justify grant of the additional time.
13. The predicament that the opponent faced – as to whether preparation of written submissions should be conducted whilst the applicant was still able to request a hearing – is not a novel one. The same time periods are allocated in every case where the Registrar is prepared to make a decision without recourse to a hearing. I have yet to experience any other case where this has presented difficulties. Therefore, I would say that the opponent, particularly with the advance knowledge that their representative was planning business and holiday trips, should ideally have started to prepare the submissions even before the deadline for requesting a hearing had expired. Doing so would have enabled the submissions to be timeously filed. However, the fact remains that they did not. Their submissions were in fact filed a short time after on 10th July 2003.
14. Nevertheless, despite the applicant's reservations, my decision is to allow the opponent's submissions to be taken into account. Refusing to do so would, I feel, be a disproportionate action, taking everything into consideration. Although the time periods set by the Registrar should be adhered to as much as possible, it should be remembered that this case is proceeding without recourse to a hearing and, as such, there is a certain imperative to permit exposure of each party's best case in the preparation of a decision, particularly where it were to be unfavourable. Even on the facts of the extension, I do not feel able to overly criticise the opponent. They clearly felt that this was a case that may well have proceeded to a hearing (even if they did not request one) and, if the applicant had requested an opportunity to be heard, then they would also have attended rather than file written submissions. However, I should say that the applicant should not be unduly worried over the allowance of the extension because, as I observe later in this decision, neither parties' submissions were particularly helpful to me in determining this case. I, therefore, do not feel that anything much rests on this point, beyond venial point scoring.

Opposition under ss. 1(1), 3(1)(b), 3(1)(c) and 3(1)(d)

15. The opponent seeks to rely on the above grounds of opposition. However, as the applicant points out in their written submissions – correctly in my view – the opponent has directed no evidence to these grounds. The basis of the opponent's objection is based on the geographical significance of the word "Spa" (a location in Belgium) and, further, that it is a generic word that describes a whirlpool type or aerated bath.
16. I can, on the basis of judicial notice, take note that Spa is a geographical location (Collins English Dictionary shows it as having a population of 9504 in 1970), and I may also note that 'spa' is further defined as 'a mineral spring considered to have health-giving properties; a place or resort with such a spring; a commercial establishment offering health and beauty treatment.' I do not believe that I can go beyond this. The issue in relation to these absolute grounds of

objection is whether the word 'spa', in relation to the class of goods applied for (essentially heating apparatus) would, or would not, be seen as an indicator of origin.

17. No evidence has been filed to show that the word 'spa' has a generic meaning – as a type of bath or anything else. In particular, there is nothing demonstrating any relationship to categories of heating apparatus for which the applicant has sought protection under the name. Without any evidence to assist the tribunal on these matters there is little I can take from mere assertions in the submissions provided.
18. Of course, there is also the objection raised on geographical grounds by the opponent in that the word Spa is associated with the Belgium town of that name, famous for its spring waters, leading to an objection under s. 3(1)(c) in that the mark is descriptive and liable to be used as a designation of geographical origin, not as a mark of trade. The relevant judgement here is that of the European Court of Justice (ECJ) in *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v Boots und Segelzubehör Walter Huber, Franz Attenberger* (Joined Cases C-108/97 and C-109/97) [1999] ETMR 585. It is clear from this judgement that article 3(1)(c) of the Directive (section 3(1)(c) of the Trade Marks Act 1994) applies where:
 - the name at issue designates a place which, in the minds of the relevant public, is already associated with the goods/services listed in the application; and
 - there is no current association, but the name is liable to be used in the future by undertakings as an indication of the geographical origin of the goods/services concerned.

Further, in assessing whether the name is liable to be used as a designation of the geographical origin of the goods or services, the Registrar must consider the degree of familiarity amongst the relevant class of persons with the geographical name in question, the characteristics of the place designated by that name, and the nature of the goods or services concerned.

19. With a location with a relatively small population, particular as in this case where the location is overseas, I feel that it is incumbent on the opponent to supply evidence to show that despite its small size the word Spa would be seen as a geographical indicator for the goods in question – that is, not only for spa waters (the evidence on this is absent), but also for heating apparatus. No such evidence has been filed. The sort of material indicated in *Windsurfing* is absent.
20. I might add, here, that I do not say that SPA is a strong mark – there is a clear allusion to water in the name – but nothing has been provided by the opponent that instructs me to find that it is so weak as to fall foul of the criteria set by these sections of the Act.
21. Against this background, I do not feel it necessary to make any further detailed findings under these grounds of opposition: they are hereby dismissed.

Opposition under ss. 3(3)(b) and 3(4)

22. These objections can be quickly dismissed. The s. 3(3)(b) objection fails on the same basis as those on the last section: there is no evidence to show that the public would be misled into believing that that heating apparatus would come from the town of Spa, or that its application on such products means they must be suitable for spa bath installations, and nothing else. As

for s. 3(4) – that use of the name is a false trade description – for the same reason, the objection here fails also.

Opposition under s. 5(2)(b)

23. The opponent's case under this ground is based on four earlier marks that stand not in the opponent's proprietorship, but in that of four different third parties. Relying on another parties marks is acceptable. There is no requirement in the Act or Rules for an opponent to have a *locus standi*.
24. I also note that the opponent cites both their own marks (annex 1) as well, under s. 5(2)(b). I consider these also.
25. In application of this section, I am mindful of the following decisions of the European Court of Justice (ECJ) on this provision (equivalent to Article 4(1)(b) of Directive 89/104/EEC) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:
 - (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel*, paragraph 22;
 - (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV*, paragraph 23, 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; *Lloyd*, paragraph 27;
 - (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV*, paragraph 23;
 - (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV*, paragraph 23;
 - (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*; *Canon*, paragraph 17;
 - (f) 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; *Sabel*, paragraph 24;
 - (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of s. 5(2); *Sabel*, paragraph 26;
 - (h) further, 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; *Marca Mode*, paragraph 41;

- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.; *Canon*, paragraph 29.

26. Neither parties written submissions were particularly helpful in assisting me in determining the likelihood of confusion in this case. The opponent states that the earlier marks contain the word SPA as a prominent feature and that the goods are the same or similar. They argue that it would be wrong to grant the applicant a monopoly in the mark SPA having regard to the legitimate interests of other traders to use and to register trade marks that contain the word 'spa' (as a descriptive term) for such goods. They also say that if the mark was registered it is likely to cause other companies concern as to whether they were entitled to use and to register such marks without infringing the rights of the applicant. The opponent makes no submissions on the similarities between the marks and their goods and services and whether there would be a likelihood of confusion.

27. As for as the marks that lie in the applicant's ownership, of these they state (in their written submissions):

“So far as the opponents own statutory rights are concerned, these marks have been used extensively throughout the United Kingdom for many years and, indeed, the mark SPA has been used in the United Kingdom for hundreds of years. As a consequence, in addition to the trade mark registrations set out in the notice of opposition, their trade mark SPA constitutes an 'earlier trade mark' by virtue of Section 6(1)(c) i.e. the trade mark SPA is a well known trade mark as envisaged by Article 6bis of the Paris Convention.

Although, as mentioned above, the trade marks of the opponent have not been used or registered for the same goods in respect of which application No. 2233678 has been applied, there is still an association between the goods of interest to the opponent and those covered by the subject application. The connection is 'water'.

The primary activity of the opponents is the production and sale of mineral waters and other soft drinks. It is quite common, especially in offices, for water, including mineral waters, to be provided to staff by the utilisation of water dispensers. Different sorts of dispensers may be utilised. Some may be free standing, whereas others may be wall mounted, for example. The goods in respect of which the applicants have actually used their mark have the appearance of water dispensers and, indeed, the goods are water dispensers to the extent that they dispense hot water.

The appearance of such products are very similar to dispensers that might be used for mineral water, such that customers might easily mistake one product for the other. At the very least, they would be given cause to pause and stop and think as to the true nature of the product and we would again refer to the principles established in the case of *Hack* (1940) 58 RPC.”

I return to these observations under 'similarity of goods' below.

28. The applicant's submissions are as lacking in assistance as the opponent's. All that they say is

that during the *ex officio* examination of the application, two of the earlier marks relied on by the opponent were raised as citations; the two citations were then waived following a restriction of the specification and the apparent strength of argument made by the applicant's representative. The applicant says that the other two marks are even further removed from the application. I should say now that as an independent tribunal I must consider the matters afresh. The fact that two of the earlier marks may have been waived upon a restriction of the specification has no bearing on my decision. I must make a comparison of the respective marks and their goods and determine whether there exists a likelihood of confusion.

Similarity of goods

29. I am mindful of the following passage in *Canon*, where the ECJ stated:

“23. In assessing the similarity of the goods or services concerned, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

This list is not exhaustive, and to it I add the respective uses of the goods (*British Sugar Plc v. James Robertson & Sons Ltd* (the *Treat* case) [1996] R.P.C. 281, at 298, point (a)).

30. The goods sought by the applicant can essentially be categorised as central heating and water heating apparatus and various parts and fittings of these goods.

31. In terms of the submission on behalf of the opponent above (paragraph 17) in relation to their own earlier marks, I have no hesitation in finding that there will be no likelihood of confusion: the goods are just too far apart. In the case of *Harding v. Smilecare Limited* [2002] F.S.R. 37, P. W. Smith Q.C. (sitting as a Deputy Judge of the High Court) stated:

“... for an action under section 10(2)(b) [equivalent to s. 5(2)(b)] to succeed there is a threshold which has to be crossed namely that the goods or services are identical with or similar to those for which the trade mark is registered.”

There is a simply a point at which goods or services become so dissimilar that confusion is unlikely, no matter the identity shared by the marks in issue. As the Appointed Person stated in *RALEIGH INTERNATIONAL Trade Mark* [2001] R.P.C. 11, paragraph 21:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks.”

Bottled drinking water and heating apparatus are very different. On the logic of the opponent's submissions a Pressurized Light Water Nuclear Reactor, which uses water *inter alia* as a coolant, would also be similar to their goods. I have not considered the remainder of the goods specified with the opponent's marks, as these are even further away in similarity.

32. Although the four earlier marks all cover goods in Class 11, each mark does so in relation to a distinct area. I will therefore give my assessment on the similarity of the goods with a detailed reference to each.

Registration No. 1133430

33. For ease of reference, the two specifications under comparison are detailed below:

| Applicant's specification | Earlier mark's specification |
|--|---|
| Apparatus for heating water; water heaters and boilers; central heating apparatus; gas burners; flues; coils; gas boilers, burners and condensers; heat exchangers and accumulators; storage water heating apparatus; direct and indirectly heated water storage apparatus; instantaneous water heating apparatus; water heating apparatus; thermostatic valves; thermostats for use with water heating apparatus; water heating apparatus control systems; expansion vessels for water heating apparatus; parts and fittings for all the aforesaid goods. | Water taps and stopcocks, all included in Class 11; installations of water conduits, installations for distributing and for cooling water; parts and fittings included in Class 11 for all the aforesaid goods. |

34. The applicant's specification, in broad terms, covers central heating apparatus, specifically listing parts and fittings for central heating apparatus, and a general term covering parts and fittings for the aforesaid.
35. A superficial assessment of the two specifications might lead one to observe that water taps and stopcocks are fairly common items used in a relation to a variety of plumbing installations, and therefore are likely to be utilised as parts and fittings in central heating apparatus. However, the applicant's goods appear to me to be of a rather specific nature: in summary they are all water heating devices of a fair degree of complexity, and they are very specific.
36. Having regard to the criteria used to assess the similarity between goods and services outlined above (*Canon* and *Treat*), I do not see how water taps and stopcocks could be regarded as similar to central heating apparatus at large or to any of the specifically listed parts and fittings such as water heaters, boilers etc. This is particularly so when taking the overall context of the applicant's specification into account, i.e. central heating apparatus, which by its very nature, is a quite distinct and specialised set of goods. This also applies to the general term "parts and fittings for all the aforesaid goods": these relate to the goods I have determined to be different to water taps and stopcocks.
37. Much the same observations apply in respect of the term "installations for water conduits". I understand (from Collins English Dictionary) that a conduit is a pipe or channel for carrying fluid. As such, I can see nothing in the applicant's specification to clash with this term either.
38. As for "installations for distributing and cooling water", these must be considered as different

as well. Though it could be argued that central heating apparatus carries out its function by distributing heated water around a system, I consider that I must look to the primary function of the two sets of goods and that I should not decontextualise them by giving the respective terms greater meaning. One item is utilised for central heating purposes the other, I would guess, is used for the movement of cold water around pipework for unspecified purposes. The two purposes and uses are quite distinct. The fact that both items may be fitted by a plumber does not necessarily make them similar. In respect of installations for cooling water, I see nothing in the applicant's specification that would clash with this term. In essence it carries out the opposite function to the applicant's goods and on the face of it has no real relationship. The goods are not similar.

39. Before moving to the next mark, I want to make the following observations. I have given the words in these specifications their obvious meanings, as is in keeping with the case law (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267), where it is stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor."

40. If there exists technical information that might have altered this meaning, then it was the responsibility of the opponent to bring this to my attention. In this context, I make no apology for quoting at length from one of my own earlier decisions on this point (BL O-395-03; paragraph 23):

"The following passage from *Canon* was also brought to my attention:

"22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered."

This extract stresses the importance of establishing similarity between goods and services even where a finding of confusion is loaded in the favour of an earlier mark, i.e., where it is highly distinctive; it is, effectively, a confirmation of the principle in *Harding* and *RALEIGH* that a threshold requirement of similarity must be met. Though the extract mentions only marks of a 'highly distinctive character' and goods that are similar, I believe that the principle enunciated is of more general application. Proof of similarity is required. Nevertheless, the quantity (and quality) of that must be proportional to need. I do not believe that the ECJ is suggesting that material evidence be produced in every case to establish similarity between goods and services: where the denotation of the latter is quotidian, common sense, in my view, will suffice. Words must be presumed to retain their usual meanings (see *Beautimatic, supra*) and evidence is needed to overturn this presumption. In cases where the 'usual meaning' is called into question, a dictionary definition can help, and the class in which an item is listed is also informative (*Reliance*).

If Ms. Himsworth was arguing that if a party opposing an application on the basis of earlier marks does not, in every case, furnish proof of similarity or identity between the items specified with his registrations and those of the application, he has failed to meet the burden placed on him, then I believe this is wrong. However, where the similarity of the goods is uncertain, more detailed evidence will usually be required – as with ‘terms of art’ – and the absence of such definitional material is at the contending parties own risk. I note the following very pertinent comment, from the Appointed Person, in the case *DIGEO*, cited above:

“24. I agree that ignorance of meaning is not the same thing as absence of meaning, but that simply invites the question how meaning or its absence should be determined. In the context of claims for trade mark protection, the guiding principle is that the decision taker must have regard to ‘the presumed expectations of an average consumer who is reasonably well-informed and reasonably observant and circumspect’ as anticipated by the Judgment of the ECJ in Case C-210/96 Gut *Springenheide GmbH* [1998] ECR I-4657, paragraphs 27 to 37. It is clearly not right to impute unusual knowledge or experience to the average consumer. Also, as famously affirmed by Ludwig Wittgenstein in his later work *Philosophical Investigations* (1953) at paragraph 43: ‘For a large class of cases - though not for all - in which we use the word ‘meaning’ it can be defined thus: the meaning of a word is its use in the language’.”

“In that state of affairs the hearing officer had to make the best assessment he could by drawing upon his general knowledge and experience. Although it can be a ‘*task of some nicety*’ to decide how far a court or tribunal may act upon its own knowledge (see *Phipson on Evidence* 15th Edition, 2000 paras. 2-08 to 2-10)..” (*DIGEO*, paragraph 28).

If the average consumer of the goods in question has extensive expertise, then it is the responsibility of the opponent to provide evidence of the same. Hearings officers cannot be expected to make bricks out of straw. The parties will need to rely on my ability, in the place of the average consumer, to impute a meaning to the terms used – and where I consider this necessitated extrinsic matter which has not been provided, then – as Ms. Himsworth contended – the opponent has failed to meet the burden of proof prescribed by *Canon*, and it is their case that must suffer.”

41. For ease of reference, the two specifications under comparison are detailed below:

| Applicant's specification | Earlier mark's specification |
|--|--|
| Apparatus for heating water; water heaters and boilers; central heating apparatus; gas burners; flues; coils; gas boilers, burners and condensers; heat exchangers and accumulators; storage water heating apparatus; direct and indirectly heated water storage apparatus; instantaneous water heating apparatus; water heating apparatus; thermostatic valves; thermostats for use with water heating apparatus; water heating apparatus control systems; expansion vessels for water heating apparatus; parts and fittings for all the aforesaid goods. | Tubs incorporating nozzles for the supply of water jets for the purpose of massage, baths and shower-baths, all being parts of water supply or sanitary installations; parts and fittings included in Class 11 for all the aforesaid goods. CANCELLED IN RESPECT OF any such goods being taps and mixers (valves). |

42. The goods covered by the earlier mark are essentially bath tubs incorporating water jets together with their parts and fittings. In terms of comparison with the applicant's goods, I do not see that there is any similarity having regard to the uses and nature of the goods. A bath tub is a distinct product (particularly as this product has incorporated water jets) when compared to products such as central heating apparatus, water heaters and boilers etc.

43. Much the same comments I have already made in relation to parts and fittings can be said here. Though, the parts and fittings of the earlier mark could, theoretically, be common to the parts and fittings of the applicant's goods, I have no information before me to say what sort of goods would constitute parts and fittings of either. Neither parties' written submissions help, here – in particular, the opponent's, with whom the onus effectively rests, has failed to provide any evidence to assist. I do not, therefore, feel able to make a leap of faith and say that any of the parts and fittings would be common. The primary goods of each specification are distinct and I consider that their respective parts and fittings should be considered in the context of these distinct products. I therefore find no similarity between the goods of this earlier mark and the application in suit.

44. Again, the two specifications are:

| Applicant's specification | Earlier mark's specification |
|--|---|
| Apparatus for heating water; water heaters and boilers; central heating apparatus; gas burners; flues; coils; gas boilers, burners and condensers; heat exchangers and accumulators; storage water heating apparatus; direct and indirectly heated water storage apparatus; instantaneous water heating apparatus; water heating apparatus; thermostatic valves; thermostats for use with water heating apparatus; water heating apparatus control systems; expansion vessels for water heating apparatus; parts and fittings for all the aforesaid goods. | Installations and apparatus, all for water supply or sanitary purposes; baths, shower baths, wash hand basins and bidets; all for use with the aforesaid installations; parts and fittings for all the aforesaid goods; all included in Class 11. |

45. The earlier mark's specification includes "baths, shower baths, wash hand basins and bidets" and parts and fittings for these goods. Given my comments in relation to the marks already considered, I do not believe these goods to be similar to anything contained in the applicant's specification. This leaves "installations and apparatus, all for water supply or sanitary purposes" and parts and fittings for these goods.
46. Installations and apparatus for sanitary purposes are products such as baths, toilets etc. Again, the uses and nature of these goods are quite distinct from the applicant's goods and as such I do not regard them as similar.
47. As for installations and apparatus for water supply, these would cover e.g. goods for distributing water to and from sanitary apparatus. Therefore, the same observations I have made in respect of the term "apparatus for distributing water" in respect of earlier mark 1133430 also applies here. I also make the same observations in relation to these goods parts and fittings as I have made in respect of earlier mark 1190132. In conclusion, I do not consider any of these goods to be similar to those of the applicant.

48. The two specifications are:

| Applicant's specification | Earlier mark's specification |
|--|--|
| Apparatus for heating water; water heaters and boilers; central heating apparatus; gas burners; flues; coils; gas boilers, burners and condensers; heat exchangers and accumulators; storage water heating apparatus; direct and indirectly heated water storage apparatus; instantaneous water heating apparatus; water heating apparatus; thermostatic valves; thermostats for use with water heating apparatus; water heating apparatus control systems; expansion vessels for water heating apparatus; parts and fittings for all the aforesaid goods. | Apparatus and installations for conditioning, deodorising, purifying, fragrancng and sterilising air; air freshening apparatus; electrical units for dispensing fragrances into air, or circulating air; all included in Class 11. |

49. It appears to me that the goods of this earlier mark are quite distinct from those of the applicant. The air conditioning etc. items serve a quite different purpose to the goods of the applicant. The uses and nature differ. I do not consider the goods to be either competitive or complimentary. Given the specialist nature of these distinct products I would even suggest that the end users also differ. The earlier mark does not cover parts and fittings of the products, so there is not even a possible overlap with the parts and fittings of the application. Taking all this into account, I conclude that there is no similarity of goods between the two marks specifications.

Likelihood of confusion

50. I have found none of the goods in the earlier specifications to be similar to those in the application. There is, therefore, no likelihood of confusion and the opposition under this section fails.

OPPOSITION UNDER S. 5(3)

51. In applying the law I note the following cases including *General Motors Corp. v Yplon SA (Chevy)* 1999 ETMR 950 and 2000 RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited* 2000 FSR 767 (*Typhoon*), *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42 and *C.A. Sheimer (M) Sdn Bh's TM Application (Visa)* 2000 RPC 484. I also note the recent decision in *Davidoff & Cie SA v Gofkid Ltd* [2003] F.S.R. 28. It follows from these cases:

a) 'Reputation' for the purposes of S. 5(3) means that the earlier trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (paragraph 26 of the ECJ's judgment in *Chevy*);

b) Protection is available where the respective goods or services are, and are not, similar (*Davidoff*, paragraph 30);

- c) The provision is not intended to give marks ‘an unduly extensive protection’ there must be actual detriment or unfair advantage (not merely risks) which must be substantiated to the satisfaction of the national court or tribunal (paragraph 43 of the Advocate General’s Opinion in *Chevy* and paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J in the *Typhoon* case);
- e) The stronger the earlier mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it (paragraph 30 of the ECJ’s judgment in the *Chevy* case);
- f) Confusion as to the trade source of the goods or services offered for sale under the later mark is not a necessary condition before there can be detriment, but is one form of detriment (paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- g) Detriment can take the form of either making the earlier mark less attractive (tarnishing) or less distinctive - blurring (paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- h) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in *Visa* at page 505, lines 10-17).

52. The opponent relies on its own earlier marks in relation to this ground of opposition. The earlier marks cover goods such as mineral water and other forms of beverage whereas the application for registration covers central heating and water heating apparatus. It takes little analysis for me to conclude that the respective goods are not similar and consequently the opponent succeeds under the first test of the case they have pleaded under S. 5(3). Furthermore, all of the opponent’s earlier marks consist either of the word SPA *solus* or the word SPA as a dominant element of the mark. I also conclude that the respective marks are identical or similar, and I move on to consider, therefore, whether the opponent possesses the required reputation.

Reputation

53. The turnover and advertising figures evidenced by the opponent clearly show that they have a trade in the mineral water market. Since 1989, the opponent has been selling between 10 million and 16 million bottles of water per annum, the values of these sales being between £3 and £4 million. However, I am not told what the total UK market is for such goods or what position or market share the opponent holds. There may be many major players in this market, I do not know. Is the opponent’s business small, large or average sized?. On their face, the turnover figures given could be argued as being high, but I am conscious from my own general knowledge that, over the last 10 years, the sale of bottled water has proliferated. Without being able to put these figures into context there is little I can take from them.

54. The opponent's evidence also refers to advertisement placed in publications circulated in the UK. However, I am not told the frequency of such advertisements. This information therefore tells me little as to the impact that such advertisements may have on the public. A list of the geographical spread of the opponent's principle customers has also been supplied; a reasonably wide geographical spread is shown. But again, without the contextualized information in respect of turnover etc all that this information tells me is that the opponent does trade with a reasonably wide geographical spread, but this does not necessarily equate to a *Chevy* type reputation required under this ground.
55. The evidence also details the opponent's attendance at a number of exhibitions. The test under s. 5(3) is one of "a significant part of the public". I do not feel that a significant part of the public will attend such exhibitions, so this evidence does not take the opponent any further forward. I am left with the view, having considered the opponent's evidence, that the required reputation has not been demonstrated. This ground of opposition is therefore dismissed.

OPPOSITION UNDER S. 5(4)

56. The final ground is under S. 5(4)(a). The common law tort of passing off is clearly set out by Geoffrey Hobbs QC, acting as the appointed person, in *Wild Child* [1998] 14 RPC, 455:

"A helpful summary of the element of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

'(a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the element of passing off in the form of this classical trinity has been referred to as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 is noted (with footnotes omitted) that:

‘To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely, the courts will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective field of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.’ ”

57. From the evidence before me I have little doubt that the opponent possessed a goodwill under the name SPA in respect of mineral water at the relevant date. But, as applied to this case, passing-off requires the consumer to be of the mistaken belief that the central heating apparatus provided by the applicant is in fact being offered under the control of the mineral water producing opponent. Whilst the similarity between the marks clearly helps the opponent, the dissimilarity between the goods does not.
58. Though a ‘common field of activity’ (*McCulloch v May* [1947] 65 RPC 58) is no longer a requirement in passing off, clearly the similarity of the trade(s) in question is a factor which must be considered (*Annabel’s (Berkeley Square) Ltd. v Schock* [1972] RPC 838) when determining confusion in respect of passing off. – Consumers are more likely to assume a connection or be confused where trades are closely related or the same.
59. Against this, there is the case of *Lego System Aktielskab and Another v Lego M. Lemelstrich Limited* (FSR 1983 155), where the plaintiffs were manufacturers of the famous building bricks

and succeeded in a passing-off action against an old established Israeli company which manufactured irrigation equipment, including garden sprays and sprinklers constructed wholly or substantially of brightly coloured plastic material. But here there was at least a tenuous link between the products insofar as both sets of goods were made from similar materials. There is no such contention here. Further, there was substantial evidence of likely confusion in that case. No such exists in this matter.

60. Thus, whilst it is well established in the law of passing off that there is no limitation in respect of the parties fields of activity, the goods in dispute are in such a distinct field of activity that I can not see how a misrepresentation will occur. Incumbent upon a failure to show misrepresentation is a failure to show that damage will result. The ground of opposition under S. 5(4) is dismissed

CONCLUSION

61. The opposition has failed.

COSTS

62. The opponent has failed and owes the applicant some pecuniary recognition as a consequence. The applicant requested that the costs award be inflated to account for what they called an attempt by a large company to assert a monopoly in a name that they could not justify. Though the opponent's case failed, I do not regard it as anything other than arguable. I therefore require the opponent to pay the applicant £1200, and no more, as is typical in relatively straightforward cases determined 'from the papers'. The payment of costs is 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 11th Day of March 2004.

**Dr W J Trott
Principal Hearing Officer
For the Registrar**

ANNEX 1

UK TRADE MARKS OWNED BY THE OPPONENT

| Mark | Number | Date of application | Goods/services |
|---|---------|---------------------|---|
| SPA | 678421 | 05.04.1949 | Class 32: Preparations in crystal form for making lemonade. |
| SPA | 801933 | 19.02.1960 | Class 32: Soda water, bitter lemon, dry ginger ale, cola, quinine tonic water, ginger beer, grapefruit crush, orange crush, lemonade, and drinks consisting of or containing mixtures of lime and lemon juice; all being non-alcoholic drinks for sale in the Counties of Glamorgan, Monmouth and Brecknock. |
| SPA REINE | 1079268 | 01.06.1977 | Class 32: Natural mineral waters for sale in England, Scotland, Northern Ireland and the counties of Clwyd and Gwynedd. |
| SPA | 1113217 | 25.04.1979 | Class 32: Soda water, bitter lemon, dry ginger ale, cola, quinine tonic water, ginger beer, grapefruit crush, orange crush, lemonade, drinks containing mixtures of lime and lemon juice, American ginger ale, lime juice cordial, blackcurrant flavour cordial, orange squash, peppermint cordial, all being non-alcoholic drinks for sale in the Counties of West Glamorgan, Mid Glamorgan, South-Glamorgan, and Gwent. |
|  | 1263376 | 25.03.1986 | Class 32: Natural mineral waters; fruit flavoured mineral waters; soft drinks made with spring and/or mineral waters; preparations in crystal form for making lemonade; all included in Class 32. |
|  | 1263377 | 25.03.1986 | Class 32: Natural mineral waters; fruit flavoured mineral waters; soft drinks made with spring and/or mineral waters; preparations in crystal form for making lemonade; all included in Class 32. |
|  | 1446726 | 08.11.1990 | Class 32: Natural mineral waters included in Class 32. |
| SPA | 1446727 | 08.11.1990 | Class 32: Natural mineral waters; fruit flavoured mineral waters; soft drinks made with spring and/or mineral waters; preparations in crystal form for making lemonade; all included in Class 32. |
|  | 1481846 | 05.11.1991 | Natural mineral waters; fruit flavoured mineral waters; soft drinks made with spring and/or mineral waters; preparations in crystal form for making lemonade; all included in Class 32. |

CTMs OWNED BY THE OPPONENT

| Mark | Number | Date of application | Goods/services |
|---|--------|---------------------|---|
|  | 140673 | 01.04.1996 | Class 32: Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages. |
|  | 470542 | 14.02.1997 | Class 32: Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages. |
| SPA | 140574 | 01.04.1996 | Class 32: Beers; fruit drinks and fruit juices, and other non-alcoholic drinks (except mineral and aerated waters); syrups and other preparations for making beverages. |

IR OWNED BY THE OPPONENT

| Mark | Number | Date of application | Goods/services |
|-------------|--------|---------------------|---|
| SPA TONIQUE | 725711 | 25.11.1999 | Class 32: Natural mineral waters; fruit flavoured mineral waters; soft drinks made with spring and/or mineral waters; preparations in crystal form for making lemonade; all included in Class 32. |

ANNEX 2

UK REGISTRATIONS OWNED BY OTHERS BUT CITED BY THE OPPONENT

| Mark | Number | Date of application | Goods/services |
|------------|---------|---------------------|--|
| SUPER SPA | 1133440 | 08.05.1980 | Water taps and stopcocks, all included in Class 11; installations of water conduits, installations for distributing and for cooling water; parts and fittings included in Class 11 for all the aforesaid goods. |
| SCANDI SPA | 1190132 | 08.02.1983 | Tubs incorporating nozzles for the supply of water jets for the purpose of massage, baths and shower-baths, all being parts of water supply or sanitary installations; parts and fittings included in Class 11 for all the aforesaid goods. CANCELLED IN RESPECT OF any such goods being taps and mixers (valves). |
| TURBO-SPA | 1396469 | 09.09.1989 | Installations and apparatus, all for water supply or sanitary purposes; baths, shower baths, wash hand basins and bidets; all for use with the aforesaid installations; parts and fittings for all the aforesaid goods; all included in Class 11. |
| AROMA-SPA | 1508431 | 31.07.1992 | Apparatus and installations for conditioning, deodorising, purifying, fragrancing and sterilising air; air freshening apparatus; electrical units for dispensing fragrances into air, or circulating air; all included in Class 11. |

I note that HYDRA-SPA, trade mark No. 1180498 lists goods in Class 11, not 32, as stated in the opponent's Statement of Case; further it is recorded as 'expired'. Trade mark number POOL-SPA/POOLSPA No. 2242195 is recorded as 'refused'.