

O-071-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2487620
BY ASAHI KASEI CONSTRUCTION MATERIALS CORPORATION
TO REGISTER THE TRADE MARK NEOMA IN CLASS 17**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 98023 BY NMC-SOCIÉTÈ ANONYME**

BACKGROUND

1. On 15 May 2008, Asahi Kasei Construction Materials Corporation (Asahi) applied to register NEOMA as a trade mark for the following goods in class 17:

“Plastic semi-worked products.”

This application was examined, accepted and subsequently published for opposition purposes on 4 July 2008 in Trade Marks Journal No.6742.

2. On 6 October 2008, NMC Société Anonyme (NMC) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). In their Statement of Grounds NMC indicate that the opposition is based upon the following trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods
NOMA	Community Trade Mark 3487626	30.10.2003	28.05.2009	Although registered in classes 11, 17, 19 and 20, NMC only rely on the following goods in class 17: Gutta-percha, gum elastic, balata and substitutes and goods made from these materials and not included in other classes; sheets, plates and rods of plastics (semi-finished products); Packing, stopping and insulating materials; asbestos, mica and goods made therefrom; flexible pipes, not of metal.

3. On 29 December 2008, Asahi filed a counterstatement in which the ground of opposition is denied.

4. On 31 December 2008, Asahi filed a Form TM21 amending their specification of goods. The amendment was published on 13 March 2009 in Trade Marks Journal No. 6777 and read:

“Plastic semi-worked products, namely heat insulating materials made of phenol resins in the form of boards, plates, panels, tapes, strips, pipes, tubes, sheets, sponges, films, rods, bars, blocks, pellets, foils, foams and fibres for further manufacturing.”

I note that in a letter to the Intellectual Property Office dated 10 March 2009, NMC stated that notwithstanding the above amendment they wanted their opposition to continue.

5. Only Asahi filed evidence; both parties seek an award of costs. While neither party asked to be heard, Asahi filed written submissions; I will refer to these submissions as necessary below. After a careful consideration of all the material before me, I give this decision.

EVIDENCE

Asahi's evidence

6. This consists of a witness statement, dated 7 August 2009, by Angela Thornton-Jackson a trade mark attorney at D Young & Co, Asahi's professional representatives in these proceedings. Attached to Ms Thornton-Jackson's statement are three exhibits. Exhibit ACTJ1 consists of extracts from the Concise Oxford Dictionary (tenth edition), the Oxford Popular Dictionary & Thesaurus and the Concise Oxford Dictionary of Current English (fifth edition). The purpose of filing these dictionary extracts is, says Ms Thornton-Jackson:

“as evidence of our contention that NEO is recognised in the English language as denoting something which is new.”

I note that all of the extracts list NEO as meaning, *inter alia*, new.

7. Exhibit ACTJ2 consists of three brochures. Ms Thornton-Jackson explains that although the NEOMA trade mark has not yet been used by Asahi in the United Kingdom the brochures have been submitted:

“to demonstrate the way in which the trade mark NEOMA is intended for use by [Asahi] in this jurisdiction.”

8. Ms Thornton-Jackson explains that exhibit ACTJ3 consists of extracts taken from NMC's website:

“showing their use of the trade mark NOMA in the format NOMA WOOD, NOMA FOAM and NOMA STYL.”

9. That concludes my summary of the evidence filed.

DECISION

10. The opposition is based solely upon section 5(2)(b) of the Act which reads as follows:

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

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

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

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. NMC is relying on the registered trade mark shown in paragraph 2 above, which has an application date of 30 October 2003 i.e. prior to that of the application for registration which has an application date of 15 May 2008; as such, it qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 4 July 2008 and the registration procedure for NMC’s earlier trade mark was completed on 28 May 2009. As a result, NMC’s earlier trade mark is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

13. The European Court of Justice (ECJ) has provided guidance in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & 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* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, 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 v. Puma AG*, paragraph 23;
- (e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (h) 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 BV v. Puma AG*, paragraph 24;
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (j) 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 CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;
- (k) 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 Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing process

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. Neither party has commented on whom they consider the average consumer for the respective goods to be, or how the goods are likely to be selected.

15. In her witness statement Ms Thornton-Jackson explains that the information provided in her exhibit ACTJ2 demonstrates how Asahi intend to use their NEOMA trade mark in the United Kingdom. Given the now limited specification mentioned in paragraph 4 above, and while I accept that marketing strategies are subject to change, it is, I think, permissible for Asahi's current literature to guide me on both the nature of the average consumer for Asahi's goods and the process likely to be undertaken by them when selecting such goods. I note that page 6 of brochure No. 1 reads, *inter alia*:

"Inviting creativity and skill of architect and constructor, for freedom and innovation in design and implementation

Thin, light, fire-resistant, durable, ecological high-performance insulation that..

...facilitates broad and intricate designs

...enables faster, more efficient installation

...reduces processing and installation time

...lowers initial and long-term costs

...heightens owner confidence and satisfaction."

16. From the information provided in exhibit ACTJ2, it appears that Asahi's insulation products can be used in a range of applications. Examples are provided in the context of use in relation to, for example, exterior fireproof spanwalls, inner or outer non-combustible steel ceilings or walls, waterproof layers in steel roofs, concrete-placement installation, steel roof decks, airline gallery carts, train cabins, refrigerated trucks, clean rooms, cold-storage rooms, floor heating, doors and cold-carry containers. While it is possible that some of these goods could be utilised in a domestic setting by a member of the public, given the references in Asahi's evidence to "architects", "constructor" and "industrial applications", it appears to me that the more likely average consumer of Asahi's goods will be professionals such as architects, designers, builders etc.

17. I have no submissions on how Asahi's goods are likely to be selected by the average consumer in the course of trade. That said, the existence of the brochure mentioned above indicates that selection of the goods will consist (to some extent at least) of a visual act having encountered the trade mark in brochures of the type exhibited. Other visual indications are likely to appear on, for example, websites, in trade publications and at the premises of retailers of the goods. Whilst visual considerations will be one means by which the goods are selected, it is possible that orders may also be placed by telephone. Equally, the goods may be requested over the

counter at, for example, a trade supplier. As such, aural considerations may also play a part in the selection process.

18. I have no information or submissions on the potential cost of Asahi's goods. However, given the nature of the goods shown in the brochure at exhibit ACTJ2 and their various commercial applications, it appears that when the goods are selected for a particular project their cost is likely to be not insignificant. The nature of the average consumer, what is likely to be the not insignificant cost involved and the importance of selecting the most appropriate product for the job in hand, all suggest to me that the average consumer will pay a high level of attention to the selection of Asahi's goods.

19. As NMC's earlier trade mark includes the phrase "insulating materials" at large, the average consumer of those goods appearing in NMC's specification may be the same as those of Asahi, and where they are, the average consumer is likely to display the same traits when selecting the goods.

Comparison of goods

20. The goods to be compared are as follows:

Asahi's goods	NMC's goods
Plastic semi-worked products, namely heat insulating materials made of phenol resins in the form of boards, plates, panels, tapes, strips, pipes, tubes, sheets, sponges, films, rods, bars, blocks, pellets, foils, foams and fibres for further manufacturing	Gutta-percha, gum elastic, balata and substitutes and goods made from these materials and not included in other classes; sheets, plates and rods of plastics (semi-finished products); Packing, stopping and insulating materials; asbestos, mica and goods made therefrom; flexible pipes, not of metal.

21. In their written submissions Asahi say:

"Essentially therefore [Asahi's] goods are heat insulating materials made of phenol resins in various forms. Insofar as [NMC's] mark covers insulating materials, it is accepted that these would be considered similar goods to the heat insulating materials claimed by [Asahi]."

22. This is a sensible concession, although it does not, in my view, go far enough. The use of the term "namely" in a trade mark specification is dealt with in paragraph 5.2.27 of the Trade Marks Registry's Classification work manual which reads:

"Note that specifications including "namely" should be interpreted as only covering the named goods . Thus, in the above "dairy products namely cheese and butter" would only be interpreted as meaning "cheese and butter" and not "dairy products" at large. This is consistent with the definitions provided in Collins

English Dictionary which states "namely" to mean "that is to say" and the Cambridge International Dictionary of English which states "which is or are".

23. Thus Asahi's specification is in effect limited to:

"Heat insulating materials made of phenol resins in the form of boards, plates, panels, tapes, strips, pipes, tubes, sheets, sponges, films, rods, bars, blocks, pellets, foils, foams and fibres for further manufacturing."

24. In their written submissions Asahi say:

"Samples of use of [Asahi's] mark NEOMA...showing use of NEOMA predominantly in the format NEOMA Foam in relation to insulating products. [NMC's] website shows their use of NOMA in the format NOMAWOOD, Nomastyl and Nomafoam. However, Nomafoam is used for packaging products, industrial products and sports and leisure products – not as insulating materials. As such the goods have different purpose, are neither competitive nor complementary and would reach their ultimate consumer through different distribution channels. Accordingly, the actual manner of use by the parties supports our contention that there would be no likelihood of confusion between the respective trade marks."

25. This point can be disposed of fairly briefly. As I mentioned above, NMC's earlier trade mark is not subject to the Proof of Use provisions. As such, NMC are entitled to rely on the full width of the specification for which their earlier trade mark is registered; how they are currently using their trade mark and in relation to which goods, is, for present purposes, irrelevant.

26. While Asahi's goods are made of phenol resins and are supplied in different forms, they are clearly all heat insulating materials. "Heat insulating materials" is a sub-category of the broader term "insulating materials" which appears in NMC's registration. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05, at paragraph 29 the General Court said:

"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 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 Vedral 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."

27. Applying the conclusion reached in the second part of that quotation to these

proceedings i.e. where Asahi's goods are included in a more general category in NMC's registration, I conclude that the respective goods at issue in these proceedings are identical. As none of NMC's other goods in class 17 can put them in any better position, I see no reason to consider these other goods any further.

Comparison of trade marks

28. For the sake of convenience, the trade marks to be compared are as follows:

Asahi's trade mark	NMC's trade mark
NEOMA	NOMA

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

Visual similarity

30. Asahi's trade mark consists of the five letter word NEOMA presented in upper case, whereas NMC's trade mark consists of the four letter word NOMA also presented in upper case. As both trade marks consists of single words presented in upper case, there are, in my view, no distinctive or dominant elements.

31. In their written submissions Asahi say:

“With short word letter marks such as these, an extra letter can have a significant visual impact on the overall visual presentation of the trade mark. Such is the case in the present instance where NEOMA appears as a longer word than NOMA and would be readily appreciated by the consumer from the visual perspective. The first two letters of [Asahi's] trade mark are NE rather than NO. It is now well established that it is the first part of marks which assume most prominence visually and such an initial difference and overall difference in impression of length between the respective trade marks is in our submission sufficient to counteract any similarities coinciding in the ends OMA of each trade mark.”

32. Consisting as they do of four and five letter words respectively, and as the only difference between them is the letter E appearing as the second letter in Asahi's trade

mark, and notwithstanding Asahi's submissions above, still results, in my view, in a high degree of visual similarity between the respective trade marks.

Aural similarity

33. In their written submissions Asahi say:

“[NMC's] trade mark is the word mark NOMA consisting of two syllables NO-MA. In contrast [Asahi's] mark is a three syllable word NEOMA (NE-O-MA). The different number of syllables between the respective trade marks creates a different rhythm and intonation beginning with the different prefixes NE and NO of the respective trade marks. As such, we submit that the trade marks are not similar from an aural point of view.”

34. I agree with Asahi that the respective trade marks consist of two and three syllable words. They are most likely to be pronounced as NO MA (where MA is pronounced in the same way as the abbreviation for mother), and NE O MA (where the letters NE are likely to be pronounced in the same manner as the word knee), and MA in the manner indicated above i.e. KNEE O MA. In my view, these possible pronunciations are likely to create a reasonably high degree of aural similarity between the respective trade marks.

Conceptual similarity

35. In their written submissions Asahi say:

“Conceptually, the first part of the NEOMA trade mark NEO will be perceived by the public as meaning “new”. Indeed, NEO is a recognisable prefix for “new” in the English language as shown by the attached dictionary entries to the witness statement of [Ms Thornton-Jackson]. In contrast [NMC's] mark has no meaning in any element. Consequently, the trade marks are also conceptually different.”

36. In reaching a conclusion on this point I have kept in mind the comments of the General Court in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01 [2004] ETMR 60 when they said:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent

the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

37. Both trade marks consist, in my view, of invented words. While I accept that the letters NEO are shown in the dictionaries provided as meaning, *inter alia*, new, given the presentation of Asahi’s trade mark (i.e. as one word in upper case), I see no reason why the average consumer would dissect the trade mark in the manner Asahi suggest and in so doing identify the letters NEO as a distinct element. They would, in my view, simply see the word as a meaningless integrated whole. As both trade marks consist of invented words, neither is likely to convey any conceptual message to the average consumer. As such, the respective trade marks are neither conceptually similar or dissonant.

Distinctive character of NMC’s trade mark

38. As NMC are not relying on any evidence of the use they may have made of their trade mark, and as Asahi point out in their written submissions, I have only the inherent characteristics of their trade mark to consider.

39. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought (or as in this case registered) and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

40. As I have already found that NMC’s trade mark consists of an invented word, I have no hesitation in concluding that it is a trade mark possessed of a high level of inherent distinctive character.

41. In reaching my conclusions I have not overlooked the decisions of other Hearing Officers mentioned by Asahi in their written submissions in respect of conflicts between: RELAY and REPLAY, AMICLAV and ACLAV and VELUX and VERSULAX and the points which came out of these decisions which they feel assist them in these proceedings. While I have considered the points raised in these cases, it is trite law that each case must be considered on its own merits; that is the approach I have adopted.

Likelihood of confusion

42. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of NMC's trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks but must instead rely upon the imperfect picture of them he has retained in his mind.

43. In summary, I have concluded that:

- (i) the respective goods at issue are identical;
- (ii) while the average consumer may be a member of the general public, it is more likely to be a business user such as an architect, designer, or builder;
- (iii) both visual and aural aspects of the comparison are likely to play a part in the selection process;
- (iv) the average consumer is likely to pay a high level of attention to the selection of the goods;
- (v) there is a high degree of visual similarity and a reasonably high degree of aural similarity between the respective trade marks;
- (vi) the respective trade marks are neither conceptually similar or dissonant;
- (vii) NMC's trade mark is possessed of a high level of inherent distinctive character.

44. I must now apply the global approach advocated to my findings to determine whether direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the goods would be assumed to come from economically linked undertakings) is likely to occur. Notwithstanding what is likely to be the considered nature of the purchasing process of the goods at issue and the traits of what (in the main) is likely to be a sophisticated average consumer, I have concluded that the combination of the identity in the goods, the high degree of visual similarity, the reasonably high degree of aural similarity and the absence of conceptual differences between the respective trade marks, when combined with the high level of inherent distinctive character NMC's trade mark possesses, is still likely to result in confusion. In this regard, while imperfect recollection is likely to be mitigated to some extent at least by the nature of the purchasing process and the sophisticated average consumer, it is

still, in my view, a relevant factor which is likely to result in the average consumer mistaking one trade mark for the other rather than assuming that NEOMA is a variant trade mark from an undertaking economically linked to NMC.

45. In summary, the opposition has been successful and the application should be refused.

Costs

46. As NMC have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to NMC on the following basis:

Preparing a statement and considering the other side's statement:	£200
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Official fee:	£200
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Total:	£400
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47. I order Asahi Kasei Construction Materials Corporation to pay to NMC Société-Anonyme the sum of £400. This sum 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 25 day of February 2010

C J BOWEN
For the Registrar
The Comptroller-General