

O-089-11

IN THE MATTER OF AN APPLICATION FOR REGISTRATION
OF A TRADE MARK UNDER NO. 2427319A
IN THE NAME OF ALAN NUNN, MARY NUNN,
RICHARD NUNN, DANIEL NUNN AND ALEX NUNN
T/A ALANSONS INDUSTRIAL SUPPLIES (A PARTNERSHIP)

AND

OPPOSITION THERETO UNDER NO. 96707 BY EVONIK DEGUSSA GmbH

Background

1. Application 2427319A is for the mark ARO-SEAL and has a filing date of 15 July 2006. It stands in the name of Alan Nunn, Mary Nunn, Richard Nunn, Daniel Nunn and Alex Nunn t/a Alansons Industrial Supplies (a partnership) (hereafter “Alansons”).

2. The specification of goods for which registration was sought has been subject to an amendment and now stands as follows:

Adhesives and sealants based on hybrid polymers as ready to use products; but not including divided silicic acid (fumed silica)

3. Notice of opposition to the registration was filed by Evonik Degussa GmbH (hereafter “Evonik”). There is a single ground of opposition, brought under section 5(2)(b) of the Act. Evonik relies on the following Community trade mark:

No.	Mark	Goods	Dates:
615757	AEROSIL	<i>Finely separated silicic acid for use as filling materials for rubber and rubber substitute materials, chemicals for thickening liquids for oils and gel type fatty substances, chemicals for thickening liquids for acids and stripping pastes, chemicals for thickening liquids for paints and lacquers, chemicals for thickening liquids for cosmetic and pharmaceutical preparations, including water for toothpaste, and for making alcoholic and non-alcoholic beverages, finely separated silicic acid for preventing the formation of lumps and for aiding pourability.</i>	Application date: 20.8.1997 Registration date: 14.6.1999

4. Evonik claims that it has used its mark in respect of “finely divided silicic acid (fumed silica) and chemicals for thickening”.

5. Alansons filed a counterstatement in which, essentially, it denied the claims made and put Evonik to proof of its use of its mark.

6. Both parties filed evidence and the matter came before me for hearing on 16 February 2011. Alansons was represented by Ms Kara Bearfield of Potts, Kerr & Co, its trade mark attorneys. Evonik was similarly represented by Mr Peter Charlton of Elkington & Fife LLP.

Evidence

7. Evidence was filed by Susanne Reinhart, who has been Director of Strategic Marketing for Evonik for three years and by Alan Chater Nunn, senior partner with Alansons, which he has been part of since 1975.

Evonik's evidence

8. Ms Reinhart states that her company's AEROSIL product has been sold in the UK since at least 1952 and gives the following details of sales made in the UK under the mark:

Year	Amount	Value (euro)
2002	1.15m kg	8.4m
2003	1.05m kg	7.2m
2004	0.95m kg	7.2m
2005	0.90m kg	8.2m
2006	0.85m kg	6.3m

9. Ms Reinhart goes on to give the following details of sales within this period which were specifically for use in the adhesives and sealants industry:

Year	Amount	Value (euro)
2002	156,000 kg	1.1m
2003	183,000 kg	1.1m
2004	176,000 kg	1.0m
2005	168,000 kg	1.1m
2006	124,000 kg	0.8m

10. Ms Reinhart states that advertising expenditure for each of the years 2001-2006 was approximately 2000 euros. Advertising is said to have taken place in trade magazines such as Adhesives and Sealants Industry, Chemical & Engineering News and Paint & Coatings Industry, all of which were available in the UK, though none of the advertisements have been provided.

11. Ms Reinhart attaches a number of exhibits to her witness statement, as follows:

SR1: This is a brochure, dated July 2004, which Ms Reinhart says describes the AEROSIL product. The exhibit consists of a 16 page brochure. The title page bears the mark AEROSIL and company name Degussa (described as "a leading specialty chemicals company" (page 7)), along with the words "more than just a powder". The brochure explains that "...we succeeded in producing the first ultrafine-particle fumed silica...and the brand known as AEROSIL[®] was born" (page 3). The brochure further explains that "as a raw material [it] has a direct influence on viscosity and creates a high degree of transparency" (page 9) and that the powder "improves flow behaviour, increases the temperature stability of lipsticks, reduces caking in dry shampoo, bonds odorants, [and] improves absorptive capacity" (page 3). It explains that it is used "for the creation, modification and characterization of surface effects. AEROSIL[®] is used, for example, in the earthquake-proof foundations of buildings, in silicone sealants for bathtubs, for the production of yachts, in insulation materials for ceramic cooking surfaces or in paints and coatings, which, without AEROSIL[®], would be difficult to process".

At page 5, the brochure explains that the product "improves the application properties of paints. First and foremost, it serves as rheology control, thereby

allowing perfect application in modern painting lines. In pigmented paints [it] prevents reagglomeration and pigment settling, thereby ensuring perfect and reproducible color perception". The product is said to "control [-] mechanical and rheological properties and ensures that the cell structure in foamed systems is even" (page 7). It is used as a "product enhancer for a wide variety of industries" and "optimizes" such products as e.g. airbags, silicone sealing compounds, toothpastes, golf balls, plastic bags, photocopier toners, shoe soles, marine paints and adhesives amongst others (page 11). It is also used in the manufacture of electronic components where it "planarizes the layered structures of electronic components in the nanometer area, [and] enables high removal rates and aids high selectivity" (page 13). In relation to its use on wind turbines it is said to have a "thixotropic effect.... on the film of resin of the outer skin of propeller shells [which] ensure the uniform and weatherproof surface of the gel coat, as well as cavity free seams" (page 15).

SR2 is described as a technical leaflet. It consists of 20 pages. The title page is headed Evonik Industries and Product Overview. The leaflet explains that AEROSIL is a fumed silica which has a particle nature and is used in a wide range of applications. It comes in a variety of grades supplied either in a multi-layer 10-20kg polyethylene coated bag or in bulk containers or silos and should be "stored in closed containers under dry conditions, protected from volatile substances and processed within one or two years of manufacture" (page 17). As hydrophilic fumed silica it is said to allow for "optimum adjustment of rheology during processing, thickening of non-polar liquids, free flow of foodstuffs and industrial powders and rheology control of greases and lubricants"(page 6).

SR3 consists of pages taken from Evonik's website relating to Aerosil's use in adhesives and sealants. It explains how the fumed silica, which comes in a number of grades, not only "improve[s] the rheological and mechanical properties, but also act as anti-settling agents, and improve the storage stability and processability of adhesives and sealants" (page 1).

In relation to the adhesives industry it explains that "an important use [is as] "a thixotropic agent in special adhesives for the construction of wind turbines... [as it] prevents the sagging of the adhesive on sloping or vertical walls during processing" (page 5).

SR4 consists of some 9 invoices showing sales of various bags of AEROSIL to a number of companies with addresses in the UK including what I take from their names, to be chemical and paint manufacturers. The invoices date from the earliest of 17 August 2004 to the latest of 8 January 2007.

SR5 is a letter addressed to a Mr Colin Cherry of Evonik Materials from Mr Steve Brown, technical director of Adshead Ratcliffe. The letter is dated 25 March 2010. Whilst it appears, from its content, to have been solicited for these proceedings, I note that Mr Brown indicates "that the Aerosil range of products and the use of a Trade Mark associated with the range is widely known throughout the sealants industry" though he does not specify which particular trade mark he associates with the range or the source of his opinion

as to its recognition within the industry. I also note his opinion that "...the brand name Aerosil is synonymous for us with fumed silica...".

SR6 is a print from Adshhead Ratcliffe's website.

Alanson's evidence

12. Mr Nunn gives evidence that Alansons began selling adhesives and sealants under the mark ARO-SEAL in the summer of 2004 before applying for registration of a trade mark in 2006. He states that the mark has been used in connection with "the supply of goods to fulfil a requirement in the window and door industries". The goods are "finished products ready for use in a range of bonding and sealing applications further down the supply chain, mainly by organisations engaged in construction, products assembly and engineering".

13. At ACN5, Mr Nunn exhibits a copy of an advertisement which appeared in the trade publication Glass and Glazing in 2006. It shows a cassette of adhesive bearing the mark. At ACN6 Mr Nunn exhibits samples of literature sheets and sales quotations for goods supplied under the mark.

14. At ACN7 and ACN8, Mr Nunn exhibits two letters which also appear to have been solicited from customers and for these proceedings.

15. That completes my summary of the evidence to the extent I consider it necessary.

Decision

16. The single ground of opposition is founded on section 5(2)(b) of the Act which states:

"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."

17. In these proceedings, Evonik is relying on Community trade mark no. 615757 which, given the relevant dates set out in paragraph 3 above, qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 4 January 2008 and the earlier mark was registered on 14 June 1999. As the earlier mark completed its registration process more than five years before the publication date of the mark for which registration has been applied, the provisions of section 6A of The Trade Marks (Proof of Use, etc) Regulations 2004 are relevant. They state:

“6A (1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7)....”

18. Also of relevance is section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

19. Whilst, in its Notice of Opposition, Evonik indicated that it claimed use of the mark in respect of “finely divided silicic acid (fumed silica) and chemicals for thickening”, at the hearing Mr Charlton indicated that Evonik now relied on use of the mark in relation to “finely separated silicic acid for preventing the formation of lumps and for aiding pourability”, a term included within the specification of goods as registered. I go on to consider whether genuine use has been shown of the mark relied on by Evonik in respect of these latter goods. In doing so, I take into account that the relevant period is the five year period ending with the date of publication of Alanson’s application, i.e. 5 January 2003 to 4 January 2008.

20. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003]RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);

- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

21. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

“Pumfrey J in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use”.

22. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the “fair description” is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods—are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

23. Also of relevance are the comments of the Court of First Instance in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03 where it said:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

24. Ms Reinhart has provided (unchallenged) evidence that Evonik has sold its AEROSIL product in the UK since at least 1952. Turnover for 2002 to 2006, some of which is before the relevant period, shows sales of between 8.4m euro and 6.3m euro with around 1m euro of these sales each year made to the adhesives and sealants industry. Sample invoices, all from within the relevant period, show sales made under the mark to a number of companies in the UK. Advertising expenditure, in relation to trade press which was available in the UK, is given as some £2k per annum. On the basis of the evidence, I have no doubt that there has been genuine use of the mark relied on by Evonik within the relevant period.

25. The evidence shows that the use of the mark has been made on finely separated silicic acid, otherwise known as fumed silica, a raw material in powder form and which is used in the manufacturing process of other goods for e.g. its thixotropic and rheological properties. The evidence indicates that it ‘improves flow behaviour’ and ‘reduces caking’ (SR1, page 3) and that it ‘has a direct influence of viscosity’ (SR1, page 9). On the basis of the evidence filed I am satisfied that genuine use of the mark has been shown on “finely separated silicic acid for preventing the formation of lumps and for aiding pourability”. This is the specification solicited by Mr Charlton at the hearing and so is that which I will take into account when considering the objection under section 5(2)(b) of the Act.

The objection under section 5(2)(b)

26. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen 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) 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 v Metro-Goldwyn-Mayer Inc*, 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 BV v Puma Ag*, paragraph 24;
- (g) in determining whether similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer inc*; 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;
- (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 CV v Adidas AG*, 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 Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29;
- (j) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*;
- (k) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L Laudato & C. Sas v OHIM*.

27. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

The average consumer and the nature of the purchasing process

28. The goods of the earlier mark are finely separated silicic acid (fumed silica), a chemical in powder form. They are raw materials for use in preventing the formation of lumps or to aid pourability in the manufacture of other products. They are specialist, technical goods which are available in a number of “grades” and will be bought for specific, technical purposes appropriate to the particular industry in which they may be used. The average consumer of these goods is a business wishing to use it in the production of its own goods, either to facilitate that production or to enhance the finished product in some way. The purchasing process of these goods is not a casual one but instead is a relatively detailed one highly likely to involve a number of technical considerations, not least to ensure that it is suitable for use in the particular application process being undertaken. Whilst the goods may not be particularly high cost when considered on a ‘per kilo’ basis, they are goods which are bought in bulk and at a substantial cost, as can be seen in some of the invoices exhibited at SR4. The customer will take a high degree of care in their purchase.

29. Adhesives and sealants as ready to use products are goods which may be bought by professionals for specialist use but may also be bought by the general public e.g. for DIY use in the home. These are relatively inexpensive goods but ones which the purchaser will take some, though not necessarily the highest, degree of care in choosing to ensure it is suitable for its intended use.

Comparison of goods

30. The goods to be compared are:

Alansons' goods	Evonik's goods
Adhesives and sealants based on hybrid polymers as ready to use products; but not including finely divided silicic acid (fumed silica)	finely separated silicic acid for preventing the formation of lumps and for aiding pourability

31. In considering the similarity or otherwise of the respective goods, I take into account the comments of Jacob J in *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 280 (“*Treat*”), where he said (at 289):

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

He went on (at 295) to set out the following factors as being relevant to the question of similarity (insofar as relevant to goods), without reference to the classes in which they fell:

- (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-service consumer items, where in practice they are respectively found or likely to be found in supermarkets;
- (f) the extent to which the respective goods are competitive. This enquiry may take into account how those in trade classify goods, for instance whether market research companies put the goods in the same or different sectors.

32. In *Canon Kabushiki Kaisha v MGM Inc.* (referred to above), the ECJ stated the following:

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.

33. The goods for which registration is sought are ready-to-use adhesives and sealants. Mr Charlton indicated that he did not consider these goods to be identical to those of the earlier mark but submitted that as the goods of the earlier mark could form a component part of adhesives and sealants, they were similar goods. I referred the parties to the case of *Les Éditions Albert René V Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM) T-336/03*, where it was held:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

34. Ready to use adhesives and sealants are everyday products which are used by manufacturers, tradesmen, DIYers and members of the public. They are used to bond or stick e.g. one surface to another or to seal something e.g. to prevent ingress of air or moisture. Finely separated silicic acid for preventing the formation of lumps and for aiding pourability are raw materials which are used by manufacturers of other products, as the description indicates, to prevent lumps forming or to make something easier to pour. The high point of Evonik’s case is that its silicic acid can be used as a component in adhesives and sealants in which case the users of these goods will be manufacturers of adhesives and sealants. The natures and uses of the respective goods differ markedly. A ready-to-use adhesive or sealant self evidently is a finished product which the user simply picks up and uses to stick or seal. Finely separated silicic acid, on the other hand, is a raw material that needs to be processed (see exhibit SR2) and added to other ‘ingredients’ to improve or enhance either the production process of a finished product or the finished product itself . Adhesives and sealants are goods which are sold in a variety of ways, whether online or through a supermarket, DIY store, builders’ merchants or more specialist supplier whereas the goods of the earlier mark are supplied through specialist channels and, as the evidence shows, direct from the manufacturer and therefore the channels of trade also differ markedly. Given the different purposes of the respective goods, one is not a substitute for the other and therefore they are not in competition.

35. In *El Corte Ingles v OHIM Case T-420/03*, the CFI commented:

“96...goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

Whilst the goods of the earlier mark may form a component in some adhesives and sealants, there is no evidence that it forms a component of all such goods or that it is an indispensable or important component of them. I consider it unlikely that the average consumer of adhesives and sealants will know or be interested in what those goods are made from or how they are made. Instead, his purchase is likely to be made on the basis its suitability for purpose (e.g. an adhesive that is suitable for use on glass or a sealant suitable for external use). I do not consider the respective

goods to be complementary goods. Taking all relevant factors into account, I find the respective goods to be dissimilar.

36. In order for a positive finding under section 5(2)(b), there has to be some similarity of goods. As I have found the respective goods to be dissimilar, the ground of opposition under section 5(2)(b) fails.

37. Even if I had found the goods to have a degree of similarity, that similarity would be extremely low and, when taken with the visual, conceptualⁱ, and to a lesser extent, the aural differences between the two marks, it would not lead to a likelihood of either direct or indirect confusion, whatever the reputation of the earlier mark.

38. The opposition having failed, the application is free to proceed to registration.

Costs

39. Alansons having succeeded is entitled to an award of costs in its favour. I make the award on the following basis:

For reviewing the Notice of Opposition and filing a counterstatement	£300
For filing and reviewing evidence	£800
For preparation for and attending a hearing	£400
Total	£1500

40. I order Evonik Degussa GmbH to pay Alan Nunn, Mary Nunn, Richard Nunn, Daniel Nunn and Alex Nunn t/a Alansons Industrial Supplies, the sum of £1500 as a contribution towards its costs. 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 these proceedings if any appeal against my decision is unsuccessful.

Dated this 02 day of March 2011

Ann Corbett
For the Registrar
The Comptroller-General

ⁱ Whilst the letters ARO do not, as far as I am aware, have any meaning, the presence of the word SEAL in the mark ARO-SEAL will bring to mind something that seals. Whilst the earlier mark is presented as a single word, it naturally breaks down into the component parts AERO and SIL. The word AERO is a well known combining form meaning air. Whilst the letters SIL do not, again as far as I am aware, have any meaning, they are likely, given the goods, to bring to mind the word silica.