

O-092-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2338998
BY OKA DIRECT LIMITED
TO REGISTER A TRADE MARK IN CLASSES 2, 4, 8, 11,
14, 16, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 35 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 92226
By HOKOCHEMIE GMBH**

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**IN THE MATTER OF Opposition thereto under No. 92226
by Hokochemie GmbH**

BACKGROUND

1. On 28th July 2003, OKA Direct Limited applied to register the following trade mark:

OKA

Registration was sought in Classes 2, 4, 8, 11, 14, 16, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 35 and 42.

2. The application was subsequently published in the Trade Mark Journal and on 24th December 2003 Hokochemie GmbH filed a notice of Opposition in respect of the goods in Class 2, these being:

Paints, varnishes, lacquers; dyestuffs; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

3. In summary, the ground pleaded was:

Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier trade mark owned by the opponent which covers identical goods in Class 2 and there exists a likelihood of confusion on the part of the public.

Registration No.	Mark	Date Registration Effective	Specification of goods
International Registration No. 701295		31 July 1998	Paints, varnishes, lacquers; preservatives against rust and deterioration of wood; dyes, mordants; unprocessed natural resins; metals in foil and powder form for painters, decorators, printers and artists; chemical additives for paint, varnishes, lacquers, preservatives against rust and deterioration of wood, dyes and mordants.

4. The applicant filed a counterstatement denying the ground of opposition. It admits that the respective goods are identical or similar except for chemical additives for paints, varnishes, lacquers, preservatives against rust and deterioration of wood, dyes and mordants: the similarity of these latter goods to the goods listed in the application is not admitted. The applicant denies that the trade marks are similar.

5. Both sides filed evidence and have asked for an award of costs in their favour. The parties were content for a decision to be taken without recourse to a hearing. The applicant also filed written submissions.

Opponent's evidence

6. The opponent's evidence consists of a statutory declaration by Dr Wolfgang Munk, dated 29 April 2004.

7. Dr Munk is the managing director of Hokochemie and he explains that the company carries out its business in relation to a wide range of chemicals and other products and services directly and indirectly related thereto. He states that the OKO + device trade mark has been in continuous use on goods exported from the UK since March 1998 and is also used for services imported into the UK. Reference is made to the fact that evidence of use was filed in a separate opposition action. However, that evidence has not been adopted into these proceedings and is not, therefore, before me.

8. Dr Munk's statutory declaration and supporting exhibits are largely composed of correspondence between the opponent and the applicant, which took place in the months prior to the launch of this opposition action. Dr Munk states that the correspondence implies a tacit admission on the part of the applicant that the marks are similar.

Applicant's evidence

9. This consists of two witness statements; one by Ian Bartlett, dated 26 July 2004 and one by Annabel Astor, dated 29 July 2004.

Witness statement of Ian Bartlett

10. Ian Bartlett is a partner in Beck Greener, a firm of patent and trade mark attorneys, and is the applicant's representative in these proceedings.

In his witness statement, Mr Bartlett rejects any suggestion that the applicant has admitted similarity between the marks at issue.

11. Mr Bartlett also says that the opponent's mark is inaccurately referred to by the opponent as "OKO + Device" and states that it should properly be referred to as HOKO and device, consistent, he says, with the opponent's company name (Hokochemie). To support this argument, there are a number of exhibits attached to Mr Bartlett's witness statement:

- (i) Exhibit IB1 Tab 1, showing the opponent's mark on the International Register as HOKO.
- (ii) Exhibit IB1 Tab 2, which is a page from the opponent's website, showing the opponent referring to its mark as "HOKO".
- (iii) Exhibits IB1 Tab 3 and Tab 4, which are copies of the UK examination report of the opponent's mark and the opponent's correspondence with the Registrar, showing the opponent's varying characterisation of the mark as "OKO + Device" and also "HOKO".

12. Mr Bartlett also states that the opponent's exclusive interest is in the provision of specialist agricultural chemicals and that there is no evidence that the opponent has any goodwill or reputation in the UK in relation to the goods in Class 2.

Witness statement of Annabel Astor

13. Annabel Astor is the Managing Director of the applicant company, OKA Direct Limited.

14. Ms Astor explains that the applicant is in the interior design and furniture business and that the company distributed its first catalogue in March 1999 (Exhibit AA1 Tab 2) and its second one six months later, reaching 930,000 and nearly 200,000 people respectively. The company launch that year was publicised in the national press, and a list of the reports achieved is shown at Exhibit AA1, Tab 3.

15. The applicant has traded continuously since 1999, publishing a further twelve catalogues. It has five trading premises, located in Central London, Berkshire, Wiltshire, Surrey and Oxfordshire. There is also a website: Exhibit AA1, Tab 4 shows representative pages. Since 1999, the total turnover of the business to the relevant date amounts to more than £13 million. Advertising expenditure amounts to £3 million.

16. The applicant commenced use of OKA on paints in May 2002, with a turnover of £50,000 before the relevant date. Exhibits AA1, Tabs 5 and 6 support this claim.

17. Ms Astor also states that the opponent is not using its mark in relation to paint, having no intention of doing so, and that the applicant has filed to have the opponent's mark declared invalid in the UK. However, so far as I am aware, no request has been made to stay the current opposition pending the outcome of the invalidation action.

Opponent's evidence in reply

18. Dr Munk has made a second witness statement, dated 26 November 2004 in which he comments on the applicant's evidence. The main points are:

- (i) that the opponent's OKO + device and HOKO marks are distinct from the company name;
- (ii) invalidity proceedings are not relevant to this action;
- (iii) the allegation of non-use is pure speculation.

19. Dr Munk also makes a comparison of the marks in this witness statement.

Written submissions

20. The applicant's written submissions are attached to a letter dated 17 January 2005 from Beck Greener, the applicant's professional representatives in these proceedings.

21. The submissions are signed by Ian Bartlett who reiterates the points made in his witness statement that the opponent encourages the public to perceive its mark as HOKO and that, when seeking the consent of the proprietors of OKO marks which were cited against the opponent's (then) application for registration, the opponent characterised its mark as HOKO. He contends that this undermines the opponent's position in this opposition action.

22. Mr Bartlett also submits that the applicant considers the "H" device to be the distinctive feature of its mark, covering at least ten times the size of the wording.

23. Mr Bartlett states that there is no evidence that the opponent's mark has been used and therefore there is no evidence of enhanced distinctiveness acquired through reputation. However, Mr Bartlett says that the applicant's mark has been enhanced through extensive use.

24. The applicant submits that the marks are simply different. The opponent's mark is significantly stylised and the differing last letters of each mark serve to distinguish because the marks are so short.

25. That concludes my summary of the evidence and submissions. I now turn to the decision.

DECISION

Section 5(2)(b)

26. Section 5(2)(b) of the Act reads as follows:

“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.”

27. An earlier right is defined in Section 6 as follows:

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

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

27. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *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 BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*

- (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*;
- (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*;
- (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 Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (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*;
- (g) account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*;
- (h) 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*;
- (i) 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*;
- (j) 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*.

28. In essence, the test under section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. I must compare the mark applied for and the opponent's registration having regard to the distinctive character of each and assuming normal and fair use of the marks across the full range of the goods within their respective specifications.

Comparison of goods

29. The applicant accepts that, with the exception noted above, the goods are identical. I agree that the majority of the goods applied for are identical to those of the opponent's earlier trade mark. The remainder, dye stuffs and colorants, are closely similar.

Distinctive character of the respective marks

30. The applied for mark can be relatively easily dealt with. It consists of the word OKA. So far as I am aware it is an invented word and, as with most invented words, can be presumed to enjoy a relatively high degree of distinctive character.

31. It is rather more difficult to form a clear view as how the relevant public (which for the goods in question I take to include DIY householders, trade purchasers and industrial users) would perceive the opponent's earlier trade mark. In essence the issue is whether the device element would be perceived as a distinct and self-contained element within the totality of the mark or whether it would be taken to be a stylised letter H reading directly into the element OKO to form HOKO (again in stylised form). I do not find this an easy matter to resolve.

32. The applicant, understandably, points to the opponent's company name, and the ambivalent position that the opponent has adopted, to support its (that is the applicant's) view that it is a HOKO (stylised) mark. It may well be that consumers who are aware of the identity of the company behind the mark or have come across a reference to HOKO (of the kind illustrated in IB1 Tab 2) will interpret the mark in the light of that knowledge. But there can be no presumption that this will necessarily be the case and consumers are not generally credited with approaching trade marks in a spirit of enquiry. What, therefore, will be the reaction of the consumer who is exposed to the mark without the benefit of external prompts?

33. The background device is considerably larger than the element OKO. The latter has the appearance of being superimposed over the right hand upright of the device. My own impression is that the contrast in size, style and presentation between the elements that make up the mark militates against seeing the device as a letter H and, as a consequence, the mark as a whole as HOKO (stylised). I come to that view with some hesitation because I am aware that it is not uncommon for the first letters of words to be presented in a different style and format from the remainder of the word particularly in an advertising context. My reason for doubting that this would happen here is the extreme difference in size and format between the component elements and the fact that the device cannot unequivocally be said to be a letter H. It is true that the underlining of OKO extends beyond that element and to the left in a way that might suggest the bar of a letter H but that seems to me to represent a process of analysis and dissection of the mark which is out of character with the presumed reaction of the average consumer. It would not have been my reaction to the mark approaching the matter without prior knowledge and on the basis that I was not aware that a question was being asked.

34. In summary, therefore whilst I accept that the opponent's earlier trade mark is capable of being seen in more than one way, my immediate reaction is that the elements coexist rather than coalesce. That being so, the device and word OKO each contribute to the character of the mark and each (and the mark as a whole) can legitimately claim a high degree of distinctive character.

Comparison of marks

35. I am required to consider the visual, aural and conceptual similarities bearing in mind the overall impression created by the marks and their distinctive and dominant components.

36. The device element of the opponent's earlier trade mark occupies a large part of the mark and is visually dominant but not, I would suggest, to the point that OKO becomes a negligible or entirely subordinate component. Given also the somewhat abstract and indeterminate nature of the device it seems likely that consumer attention will focus on the element OKO at least to the extent that it creates an identifiable reference point (by which I mean a word as distinct from an abstract device) within the mark albeit not one that has a discernible meaning.

37. The device element has no counterpart in the applied for mark. The opponent's objection focuses on the element OKO and the word OKA. The points of similarity are self-evident. Both words are made up of three letters with the first two being the same. They differ in the final vowel. Single letter differences in short words, may result in quite different visual impressions particularly where dictionary words are concerned. That is not the case here. The overall structure and appearance of OKO and OKA is quite similar particularly when allowance is made for the effect of imperfect recollection. Reverting to the necessary whole mark comparison I find that the device element in the earlier trade mark makes a significant contribution to the mark but does not displace the point of visual similarity. There is in overall terms a moderate degree of visual similarity.

38. The opponent's position is arguably stronger when it comes to aural comparison for the simple reason that the device does not readily lend itself to description/oral references. If that is the case then the respective marks are likely to be referred to by reference to the element OKO and OKA. It is usually held that vowel sounds are somewhat less distinct than consonants and that the final syllable of words are often slurred or at least, less clearly articulated. That is likely to be the case here aided by the fact that OK produces a strong and distinct first syllable.

39. As neither mark has a clear meaning, comparison of conceptual similarities and differences is unlikely to be a productive process. I regard conceptual considerations to be subordinate to visual and aural ones in marks of this kind.

Global assessment of likelihood of confusion

40. It is accepted that there is a large measure of identity between the two sets of goods. The remainder are also closely similar. The purchasers or prospective purchasers of those goods could include both the public at large and trade professionals etc. The goods are likely to be selected with some, but perhaps not the very highest degree of, care. The matter turns critically on the impact of the marks within the context of the global test. That in turn depends to an appreciable extent on the weight and significance that is likely to be attached to the device. I have come to the view that, whilst the device makes a significant visual impact and marks a point of differentiation, it is likely to be seen as an independent element that has been brought together with the element OKO to form a composite mark. I am not persuaded that the combination of elements creates a mark that is materially different to the sum of its parts or that the points of difference outweigh the similarity between the elements that give the opponent cause for concern. Making the best I can of the matter, and allowing for the fact that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, I find that there is a likelihood of confusion. The opposition succeeds under Section 5(2)(b).

COSTS

41. The opponent has been successful and is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1200. 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 7th day of April 2005

**M REYNOLDS
For the Registrar
the Comptroller-General**