

O-116-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2273267  
BY PILKINGTON PLC  
TO REGISTER A TRADE MARK IN CLASSES 9, 19 AND 21**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 91270  
BY OPTIROC GROUP AB**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2273267  
by Pilkington Plc to register a trade mark in Classes 9, 19 and 21**

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**IN THE MATTER OF Opposition thereto under No. 91270  
by Optiroc Group AB**

### **BACKGROUND**

1. On 21 June 2001 Pilkington Plc applied to register the trade mark OPTITEC in Classes 9, 19 and 21 of the register for the following specifications of goods:

**Class 09:**

Glass for screens in electrical and electronic devices; coated anti reflective glass for screens in electrical and electronic devices; coated anti reflective glass for screens for visual display units, personal computers, laptop computers, televisions, liquid crystal display panels and solar panels.

**Class 19:**

Glass, toughened glass, laminated glass, coated glass, radiation shielding glass; windows; articles made wholly or principally of glass; panels and screens made wholly or principally of glass; doors; porches; conservatories; multiple glazing units; structural glazing units; structural glass assemblies; parts and fittings for all the aforesaid goods; all the aforesaid goods for building purposes.

**Class 21:**

Glass; unworked or semi-worked glass; unworked or semi-worked glass sheets provided with an anti-reflective coating; articles made wholly or principally of glass.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 28 November 2002 Optiroc Group AB filed a Notice of opposition, the grounds being under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier registered trade marks owned by the opponent which covers identical and similar goods in Class 19 and there is a likelihood of confusion on the part of the public:

Registration No.	Mark	Date Registration Effective	Specification of goods
UK No. 2024722	OPTIROC	22 June 1995	<p><b>Class 19:</b> Building and construction materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal; concrete; building stone; cement coatings (fireproof); cement slabs, cement posts; refractory materials; floors and floor products (not of metal); clinker stone; construction materials, not of metal; bricks (building and construction); putty, putty compound; surfacings, not of metal, for buildings; coatings (building materials); calcareous sandstone and sandstone (building material).</p> <p><b>Class 37:</b> Building construction; installation, repair and maintenance services, all relating to building and construction; glazing services; paving (floor); information services relating to building construction.</p>
European Community No. 1716042		14 June 2000	<p><b>Class 02:</b> Putty, also in form of powder.</p> <p><b>Class 19:</b> Building materials (not of metal); bricks; lime; calcareous stone; mortar for building; grout; concrete; adhesives for mortar; plaster; putty and compositions for levelling walls and floors; cement based walls and floors and wall and floor products; cement coatings, cement</p>

			<p>slabs; floors, flooring and floor tiles, not of metal; wall claddings and wall tiles, not of metal.</p> <p><b>Class 37:</b> Construction of buildings; repair and maintenance and installation services for construction of buildings; flooring and installation services; rental of construction equipment for mixing mortar, plaster, cement, concrete, putty and compositions for levelling walls and floors.</p>
International No. 696379	<b>OPTIROC</b>	9 June 1998	<p><b>Class 19:</b> Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.</p> <p><b>Class 37:</b> Construction of fascades, paving, flooring, roofing, ceilings, internal and external walls, chimneys, fireplaces, arches and lintels; installation and repair of fascades, paving, flooring, roofing, ceilings, internal and external walls, chimneys, fireplaces, arches, lintels, insulation, concrete and masonry blocks, floor screeds, internal and external rendering, tile adhesives and grout, lightweight aggregates; road repair services.</p> <p><b>Class 40:</b> Mechanical or chemical processing or transformation of mineral based building materials; water purification.</p>

4. The opposition is directed against Class 19 of the application only.
5. The applicant filed a counterstatement denying the grounds of opposition. While the applicant admits that the Class 19 goods in each of the opponent's registrations cover the Class 19 goods of the mark in suit, the applicant contends that the marks of the applicant and opponent are different visually, phonetically and conceptually and that there is no likelihood of confusion on the part of the public.
6. The applicant filed evidence and both sides asked for an award of costs in their favour. Both parties were content for a decision to be taken without recourse to a hearing. Neither party forwarded written submissions for the hearing officer's attention.

### **Applicant's evidence**

7. This consists of a statutory declaration by John McKenna dated 16 September 2003.
8. Mr McKenna is the Company Secretary of Pilkington Plc, the applicant company.
9. Mr McKenna states that the UK Trade Marks Register has 44 registrations and pending applications in Class 19 with the prefix OPTI, 13 of which belong to his company or a subsidiary of his company. Exhibit JM1 to Mr McKenna's declaration is a printout of the Trade Marks Registry's online database which details the OPTI marks mentioned above. Mr McKenna goes on to submit that his company and/or at least one of its subsidiaries has been using OPTI prefixed marks in the UK in relation to glass products in Class 19 since at least 1997. No examples of such use are provided.
10. This completes my summary of the evidence filed and I turn now to the decision.

### **DECISION**

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

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

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

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

12. An earlier right is defined in Section 6, 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 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,”

13. I take into account the guidance provided by the European Court of Justice (ECJ) 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 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 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) 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;
- (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) 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) 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.

14. 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. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned above. 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 different elements taking into account the degree of similarity of the goods, the category of goods in question and how they are marketed. As I have no evidence to demonstrate use of the respective marks in the UK in relation to the relevant goods I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods covered within the respective specifications.

15. Turning first to a consideration of the respective goods covered by the Class 19 specification within the application and the Class 19 specification of the opponent's earlier registrations, it is obvious that they encompass identical and similar goods. This point was sensibly conceded by the applicant in its counterstatement – see paragraph 5 of this decision.

16. I now go on to a comparison of the marks in suit with the opponent's earlier registrations. In the evidence the applicant has drawn attention to the state of the UK trade marks register in relation to marks prefixed with the letters OPTI. I am not assisted by such evidence and I am guided on this point by the following comments of Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

“Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

17. My decision involves a comparison of the applicant's and opponent's particular marks and must be made on its own merits. I would only add that it is apparent that the opponent does not possess a de facto monopoly in the prefix OPTI.

18. I now go on to compare the mark in suit (OPTITEC) with the opponent's earlier trade marks, which comprise or contain the word OPTIROC. Both marks comprise an invented word, share the first four letters “OPTI” and their final letter, the letter C. Furthermore, both marks consist

of seven letters. The suffix to the applicant's mark is "TEC" and the suffix within the opponent's mark is "ROC". I would add that the opponent's earlier OPTIROC marks are in their totality highly distinctive and are deserving of a good penumbra of protection.

19. The respective marks must be compared as a whole and by reference to overall impression but, as recognized in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and prominence of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

20. While the applicant has submitted evidence relating to the 'state of the register' in relation to trade marks containing the prefix "OPTI", this does not demonstrate that "OPTI" is meaningful or descriptive in relation to the relevant goods. However, as mentioned earlier in this decision, it is apparent that the opponent does not possess a monopoly in the prefix and there is no evidence to show that the prefix OPTI is associated wholly with the opponent.

21. I turn to a visual comparison of the respective marks. Both marks share the first four letters and their final letter and comprise seven letters in totality. While the prefix (OPTI) is identical, the respective suffixes (TEC and ROC) differ. As mentioned earlier, my decision on similarity must be governed by overall impression and notwithstanding the common prefix, the terminations ie. remainder of the marks, are conspicuously different and I do not believe that these differences would be readily ignored or marginalised in use. On balance, it seems to me that in their totality the marks look different and would be distinguished visually in use.

22. In relation to aural use I consider the opponent's case to be of similar weight. Both marks share the same beginning and it is widely accepted in relation to the spoken use of trade marks that customers have a propensity to slur the endings of words. However, I believe this to be of limited impact in the present case as the terminations of the respective marks, TEC and ROC, would sound noticeably different and serve to distinguish the marks in aural use.

23. Next, I turn to a conceptual comparison of the marks. Both marks comprise invented words and share the same prefix, OPTI. However, OPTI has no obvious meaning in relation to the goods and although it may allude to optical, the respective suffixes TEC and ROC could equally allude to different concepts e.g. TEC to "technical" and ROC to "rock". In totality I do not believe that the respective marks share conceptual similarity.

24. In assessing the degree of similarity between the respective marks and whether it is likely to give rise to a likelihood of confusion I must also consider the goods at issue, the average customer for the goods and make allowance of imperfect recollection.

25. While I have no evidence before me on the point, it seems to me that the customer for the goods would include the trade (in particular the building and glazing trades) and also the public, in particular those members of the public with an aptitude for or interest in "do it yourself". While the goods covered could range widely in price from tens of pounds to thousands of pounds, it seems to me that the goods at issue are usually chosen with some care and

consideration e.g. as to measurement, fitness for purpose and/or appearance. In my view the average customer for the goods is likely to be reasonably careful in making his or her purchase.

## **CONCLUSION**

26. On a global appreciation, taking into account all the relevant factors, including identity of goods in the specification of the respective marks, and after allowing for an appropriate level of defective recollection, I do not believe the average customer for the goods is likely to confuse the applicant's mark OPTITEC with the opponent's OPTIROC marks given the differences in the marks when they are viewed in their totalities. The opposition under Section 5(2)(b) of the Act fails.

## **COSTS**

27. The applicant is entitled to a contribution towards costs and I therefore order the opponent to pay the applicant the sum of £750 which takes into account the fact that no hearing took place on this case and that the opponent did not file evidence. 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 27<sup>th</sup> day of April 2004**

**JOHN MacGILLIVRAY  
For the Registrar  
the Comptroller-General**