

O-155-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2647692
BY ZILMET UK LIMITED
TO REGISTER THE TRADE MARK
SOLAR PRO
IN CLASS 11
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 400308 BY
ALTECNIC LIMITED**

BACKGROUND

1) On 4 January 2013 Zilmet UK Ltd (hereinafter the applicant) applied to register the trade mark SOLAR PRO in respect of the following goods in Class 11: Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components; expansion tanks for heating systems; expansion vessels; heating components; valves, thermostatic mixing valves; radiator valves; shower valves; taps; mixer taps; chilled water installations and apparatus; central heating installations and apparatus; pressurisation units for maintaining the pressure within water systems; solar collectors; solar heating panels; solar powered heating apparatus and installations; parts and fittings for all the aforesaid goods.

2) The application was examined and accepted, and subsequently published for opposition purposes on 22 February 2013 in Trade Marks Journal No. 6980.

3) On 22 May 2013 Altecnic Ltd (hereinafter the opponent) filed a notice of opposition. The grounds of the opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Date of application / registration	Class	Specification relied upon
SOLARMIX SOLAR MIX A series of two marks	2481269	01.03.08 25.07.08	11	Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components; heating components; valves, thermostatic mixing valves; radiator valves; shower valves; taps; mixer taps; chilled water installations and apparatus; central heating installations and apparatus; pressurisation units for maintaining the pressure within water systems; solar collectors; solar heating panels; solar powered heating apparatus and installations; parts and fittings for all the aforesaid goods.

b) The opponent contends that the mark in suit is confusingly similar to its registered trade mark as they both contain the distinctive and dominant element SOLAR, and that the goods are identical except for the words “expansion tanks for heating systems; expansion vessels” and these are identical or similar to the other goods listed. The marks in suit therefore offend against Section 5(2)(b) of the Act.

4) On 14 June 2013 the applicant filed a counterstatement denying all the grounds. They contend that the word “SOLAR” is very non-distinctive for the goods of the two

parties. They state that it will be understood to denote products usable in or relating to solar powered installations or arrangements.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 31 March 2014 when the opponent was represented by Mr Sales of Messrs Swindell & Pearson; the applicant was represented by Mr Taylor also of Messrs Swindell & Pearson.

APPLICANT'S EVIDENCE

6) The applicant filed a witness statement, dated 19 September 2013, by Stuart Michael Gizzi a Director of the applicant company, a position he has held since July 2012. He states that he has been involved in the heating and plumbing component field since 1978. He states that he is aware of a number of trade marks used in the heating and plumbing field that are prefixed with the word SOLAR. He states that it is unsurprising that this indicates that the component or equipment are solar powered or are usable in solar powered installations. By way of example he provides a list of marks used by another company of which he is also a director. He states that the following marks are used in the UK on heating and plumbing components, SOLAR EVENT, SOLARFILL, SOLARVERT, SOLAR LOGIC, SOLARSAFE, SOLARSEAL and SOLAR ECLIPSE. With the exception of the last mark he provides, at exhibits SG1&2 examples of use of the marks mentioned.

OPPONENT'S EVIDENCE IN REPLY

7) The opponent filed a witness statement, dated 4 December 2013, by Kieron Peter Mark Taylor, the opponent's Trade Mark Attorney. He provides details from Companies House which show that Mr Gizzi is a director of Zilmet UK Ltd, Intatec Ltd, Intaco Ltd and Inta Eco Ltd, all of which have the same address. He provides a copy of the IPO Register which he states shows that a licence does not exist between Inta Eco Ltd and Intaco Ltd as suggested by Mr Gizzi, but instead between Intaco Ltd and Intatec Ltd. However, the register reflects assignments not licences. Mr Taylor suggests that all these companies are economically linked as confirmed by the websites of the four companies listed.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The only ground of opposition is based on section 5(2)(b) of the Act which reads:

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.”

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

11) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. Given the interplay between the date that the opponent’s mark was registered and the date that the applicant’s mark was published The Trade Marks (Proof of Use, etc) Regulations 2004 do not come into play.

12) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & 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* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

13) The specifications of both parties are as follows:

Applicant's specification	Opponent's specification
Class 11: Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components; expansion tanks for heating systems; expansion vessels;	Class 11: Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components;

heating components; valves, thermostatic mixing valves; radiator valves; shower valves; taps; mixer taps; chilled water installations and apparatus; central heating installations and apparatus; pressurisation units for maintaining the pressure within water systems; solar collectors; solar heating panels; solar powered heating apparatus and installations; parts and fittings for all the aforesaid goods.	heating components; valves, thermostatic mixing valves; radiator valves; shower valves; taps; mixer taps; chilled water installations and apparatus; central heating installations and apparatus; pressurisation units for maintaining the pressure within water systems; solar collectors; solar heating panels; solar powered heating apparatus and installations; parts and fittings for all the aforesaid goods.
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The average consumer and the nature of the purchasing process

14) I must now determine the average consumer for the goods of the parties. To my mind the goods of both parties would be aimed at the general public which would include businesses. Clearly, if one is looking to purchase, broadly speaking, plumbing and central heating equipment then you will ensure that it is compatible with whatever you currently have, or if a new system is suitable for your needs and the property in which it is being installed. To my mind, this will involve the purchaser in potentially carrying out research before making a carefully considered choice. It is likely that the choice will be made by reference to a catalogue (paper or digital) although it is certainly possible that the goods will be discussed with the sales person in the retail outlet or over the phone. To my mind, whilst aural considerations must not be overlooked, word of mouth recommendations etc, it is the visual aspect of the competing trade marks that will dominate the selection process.

Comparison of goods

15) In comparing the goods I take into account the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

“29 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 Vedial 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).”

16) The specifications of both parties are shown at paragraph 13 above. Clearly, with the exception of the words “expansion tanks for heating systems; expansion vessels” contained within the applicant’s specification, the wording of both specifications are identical. In my opinion, such tanks or vessels would be covered by the general specifications such as “Apparatus and installations for heating, water circulation, chilled water installations and apparatus; central heating installations and apparatus; heating components.” As such the goods of both parties must be regarded as being identical.

Comparison of trade marks

17) The trade marks to be compared are as follows:

Applicant’s mark	Opponent’s mark
Solar Pro	Solar Mix / Solarmix A series of two marks

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

Distinctiveness of earlier marks and dominant components of both parties marks

19) The applicant contends that there are a number of “Solar” marks in use in Class 11. The opponent disputes this view claiming that the only use is by companies associated with the applicant and even this is limited, with little actual use being shown in evidence. This is usually termed state of the register evidence. In *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 28 Jacob J. said:

“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. *MADAME* Trade Mark [1966] RPC 541 and the same must be true under the 1994 Act.”

20) In *Digipos Store Solutions v Digit International* [2008] RPC 24 Mr Alexander Q.C acting as a Deputy Judge of the High Court commented:

“63 That was said in the context of a case where absolute grounds were relied on as the basis for refusing registration. However, in the present case, this material is not relied on in support of an argument that a mark which shares characteristics

with those already registered should, for that reason, also be registered: the register is not relied on for its precedent value, in my judgment, rightly so. The register is not in this case deployed to show actual use of the marks recorded there either: for that purpose too, it would be of limited, if any, evidential value. Instead, the register is relied upon to show that, as a matter of fact, a significant number of traders have expressed the intention of using (and *may* be using) the prefix DIGI- as part of a mark in relation to class 9 goods which (one is invited to infer, in the absence of detailed specifications) involve a digital or computer-related element. It does not seem to me to be illegitimate, as a matter of principle, to deploy material of this kind for that limited purpose and, for that purpose, it is of some value as part of a larger body of material.”

21) However, in *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04* the General Court (GC) stated:

“68. As regards the search of the Cedalex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

22) This was a view re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06.* In *Digipos* Mr Alexander was not referred to the judgment of the GC in *GfK AG*. I also note that in his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are relative grounds cases; clearly the GC considered that the principle of not giving weight to state-of-the-register evidence also applies in cases involving relative grounds issues. I accept that unlike the *GfK* case mentioned above, the applicant has provided limited evidence that the marks are in use, although the level of that use, when it began, and the exact nature of goods and services offered under each mark is not determined. There is also no detail as to whether any of the businesses mentioned are in any way connected to the parties in this case.

23) I take into account the comments in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06* where the GC said:

“71 In addition, the weak distinctive character of an element of a compound mark does not necessarily imply that that element cannot constitute a dominant element since – because, in particular, of its position in the sign or its size – it may make an impression on consumers and be remembered by them (judgment of 16 May 2007 in Case T-491/04 *Merant v OHIM – Focus Magazine Verlag (FOCUS)*, not published in the ECR, paragraph 49). It should be added that, as regards the earlier marks, in so far as they comprise a single verbal element, the argument that that word has become common is not relevant for the purposes of the comparison of the signs at issue (see,

to that effect, *Limoncello della Costiera Amalfitana shaker*, cited in paragraph 44 above, paragraph 37).

74 Third, as regards the applicant's claim that the earlier marks have weak distinctive character, it should be held that accepting that the earlier mark has a weak distinctive character does not prevent the finding in the present case that there is a likelihood of confusion. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion (see, by analogy, *Canon*, cited in paragraph 32 above, paragraph 24), it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see judgment of 12 November 2008 in Case T-210/05 *Nalocobar v OHIM – Limiñana y Botella (Limoncello di Capri)*, not published in the ECR, paragraph 51 and the case-law cited).

75 In addition, granting excessive importance to the fact that the earlier mark has only a weak distinctive character would have the effect that the factor of the similarity of the marks would be disregarded in favour of the factor based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the signs at issue. Such a result would not, however, be consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94 (see *Limoncello di Capri*, cited in paragraph 74 above, paragraph 52 and the case-law cited)."

24) The opponent contended:

"12. Further on this point the goods of the opposed application and the goods of the earlier registration are identical and they cover a very broad range of goods in relation to plumbing and central heating. The Applicant's goods are not defined as being for solar powered installations, they are plumbing goods in the round, and therefore it would be wrong to run a defence that states that SOLAR is 100% descriptive of solar power and therefore there is no likelihood of confusion because the opposed goods cover just about all forms of plumbing and central heating article that can be conceived of, and the application as it stands must be considered as it stands and on that basis the descriptiveness or otherwise of SOLAR should not be taken into account on a specification that covers for example, lever valves or boilers or y pattern strainers or valves for radiators, or expansion vessels.

13. Even if the opposed application was amended to describe goods relating to solar power, apart from a very few specialised goods which are only found in the solar power market, all of the other goods of the application even if they would be used as part of a central heating system that had a sun based heating component would be the same goods as would be found in a common or garden central

heating system, by which we mean a lever valve that would be used in a common or garden central heating system would be the same lever valve that would be used in a central heating system that has a sun based component, and this means that descriptiveness or other wise of SOLAR does not provide any defence under S. 5(2).”

25) Whilst I accept that the goods of the two parties are not limited to solar powered systems I think it is inevitable that the average consumer will be aware of solar powered units used to heat water for central heating and/or use in showers etc. This will lead the average consumer to view either parties’ mark as an indication that the goods are suitable for solar powered systems and potentially unsuitable for non-solar powered systems. Thus I do not believe that the word “Solar” in either mark is the dominant or distinctive element. The opponent’s mark consists of two words “SOLAR” and “MIX”. Although the second mark in the series has the words conjoined it is my view that the average consumer will, because they are both well known English words, view the conjoined mark as two words. Whilst no evidence has been presented in respect of the meanings of the word “mix” or “pro” it is my view that these words are well known. It is also my opinion that the average consumer will be aware that the word “mix” has a meaning in general plumbing terms where it refers to hot and cold water being mixed to create a suitable temperature and items such as “mixer taps” and “mixer valves” are commonly referred to within the industry. The distinctiveness of either word is low, it does however appear to have a meaning arising from the mark in totality that it enables solar power to be integrated or mixed with normal systems. Overall I believe that the mark is of low inherent distinctiveness for the goods in Class 11. The same arguments regarding the term “solar” hold true of the mark in suit. This leaves the second element of the mark in suit “Pro” which alludes to it being of professional standard or perhaps being used by professionals. Again individually both words are descriptive, but in totality have a meaning which suggests that the goods are for use on solar systems by professional or are parts for solar systems of professional standard. Again the mark is of low inherent distinctiveness for the goods in Class 11.

Visual / Aural and Conceptual similarity

26) Clearly both marks share the first element “Solar”. However, given that this is highly descriptive for the goods in question its role in identifying the provider of the goods will be minor to non-existent, being viewed much in the same way as the word “electric” or “gas” i.e. a source of power. Clearly, the second elements of both marks “Mix” and “Pro” are very different visually, aurally and conceptually. The identity of the initial part of the mark which lacks distinctiveness means that the marks have a very low degree of similarity.

Likelihood of confusion

27) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. The evidence does not show that the opponent has an enhanced reputation for its

goods and that the mark is of low inherent distinctiveness. The goods are clearly identical, but the marks have a very low level of similarity. The average consumer would easily distinguish between the two, and as such there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2)(b) fails.**

COSTS

28) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering the evidence of the other side	£400
Preparing for and attending a hearing	£600
TOTAL	£1,200

29) I order Altecnic Ltd to pay Zilmet UK Ltd the sum of £1,200. This sum 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 9th day of April 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**