

O-168-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2506668  
IN THE NAME OF SEDDONS (PLANT & ENGINEERS) LTD

AND

OPPOSITION THERETO UNDER NO. 99332 BY LF, LLC

## Background

1. Application No. 2506668 stands in the name of Seddons (Plant & Engineers) Ltd (“Seddons”) and has a filing date of 19 January 2009. Registration is sought for the following mark:



in respect of the following goods:

Class 7

Pressure washers, generators, vibrating pokers and poker drive units; all being engine powered.

2. Notice of opposition to the application was filed by LF, LLC (“LF”). There is a single ground of opposition under section 5(2)(b) of the Act. LF relies on its earlier International Trade Mark registration No 914198.

3. Seddons filed a counterstatement denying the grounds of opposition. Only Seddons filed evidence in these proceedings. This takes the form of a witness statement by Alison Jennifer Brooks, who is the “house solicitor” for the company however as it consists entirely of submission I do not intend to summarise it though I do take it into account. For its part, LF filed written submissions dated 22 February 2010 and 15 April 2010. The two sets of submission differ only in that the latter set refers to the former. Again, I take these into account in reaching my decision.

### **The objection under section 5(2)(b)**

4. Section 5(2) 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.

5. The mark relied on by LF is an earlier mark by virtue of section 6 of the Act. It does not have a registration date which is more than five years before the date of publication of the application. That being the case, section 6A of the Act is not relevant and LF is not required to prove its use of its marks.

6. 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*;
- (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*, paragraph 26;

- (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*, paragraph 41;
- (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*, paragraph 29;
- (k) 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*;
- (l) 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*.

### Comparison of goods

7. At question 1 of the Form TM7, LF indicates that it is relying on its earlier mark in respect of all of the wide range of goods for which it is protected in classes 7 and 8. In the statement of grounds attached to the form, however, it states that it relies, in particular, on the following:

- The identity of the goods in Class 7 of the Application and the Earlier Mark, in particular, the identical coverage of “*pressure washers*” and “*generators*” that are covered by both specification in Class 7
- The similarity of other goods in Class of the Application with those in Classes 7 and 8 of the Earlier Mark. In particular, the similarity between *vibrating pokers and poker drive units; all being engine powered*” of the Application and “*electrical generators*”, “*air compressors*”, “*power tools*” “*pumps for purging drains*” “*masonry hand tools*”; “*paint and mud mixers*”; “*sewer rods*” and “*plumbing snakes*” of the Earlier Mark

8. As regards its claim to similarity of goods, I note that LF does not have protection for *power tools* at large. Rather, its specification covers “*power tools, namely, saws, routers, drills, grinders, sanders, planers and accessories therefor...*” (my emphasis). The goods to be compared are therefore those named power tools. Similarly, LF’s earlier mark is registered in respect of *masonry hand tools namely, mud pans made of aluminum, stainless steel and plastic, aluminum hawks, brick and convex jointers, cement edgers, brick tongs, corner tools, drywall and joint knives, hand sanders, pole sanders, floats, wire twisters, paint and mud mixers, circle cutters, utility saws,*

*wood line blocks, sanding blocks* (again, my emphasis) and the comparison will be made on the basis of these named goods.

9. Subject to the above paragraph, I intend to consider the opposition based on the particularised goods named by LF in its statement of grounds as if the action fails in respect of these goods then it is unlikely LF will be in any stronger position in relation to the remaining goods of its registration. The goods relied onto be compared are, therefore, as follows:

<b>Seddons' goods</b>	<b>LF's goods</b>
<p>Class 7 Pressure washers, generators, vibrating pokers and poker drive units; all being engine powered</p>	<p>Class 7 Electric generators; air compressors; pressure washers, power tools namely, saws, routers, drills, grinders, sanders, planers and accessories therefor, pumps for purging drains</p> <p>Class 8 Masonry hand tools namely, mud pans made of aluminum, stainless steel and plastic, aluminum hawks, brick and convex jointers, cement edgers, brick tongs, corner tools, drywall and joint knives, hand sanders, pole sanders, floats, wire twisters, paint and mud mixers, circle cutters, utility saws, wood line blocks, sanding blocks , sewer rods, plumbing snakes</p>

10. As *pressure washers* is a term which appears in both parties' specifications of goods, these goods are clearly identical. Bearing in mind the comments in *Gérard Meric v OHIM*, Case T-133/05 at paragraph 29, where it was established that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category within the later mark and vice versa, I find that *generators* are identical goods to *Electric generators*.

11. This leaves *vibrating pokers and poker drive units; all being engine powered* to be considered.

12. In carrying out the comparison I will take into account *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281. This identified the following as elements to be considered: their uses, their users, their natures, the trade channels through which they reach the market, where the items are to be found and whether they are in competition with each other. I must also consider the issue of whether the goods and services are complementary. In Case T-420/03 – *El Corte Ingles v OHIM- Abril Sanchez and Ricote Sauger* (Boomerang TV) the Court of First Instance commented at paragraph 96:

“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 of 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 T14 169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gomez Frias* (euroMASTER), not published in the ECR, paragraph 35).”

13. A *vibrating poker* is an implement which is put into newly poured concrete. The poker’s vibrations encourage the removal of air from the concrete with the result that the concrete has fewer air pockets, is compacted and thus its structural integrity is improved. The poker may be attached to and driven by a *poker drive unit* which generates the power to make the poker vibrate at a given frequency. These are items of specialised equipment used by those in the construction trade when pouring e.g. footings or formwork and are sold by specialised construction industry or general tool suppliers.

14. An *electric generator* is a device which produced electrical energy by converting mechanical energy into electrical energy. An *air compressor* converts a power source into kinetic energy. Like a *poker drive unit*, both electric generators and air compressors generate power which may be used to provide power to a tool. In its submissions, LF says that as each of these goods is a tool or machine used both in the construction industry as well as by those carrying out DIY and are sold through the same channels, they are similar goods. LF also submit that these are goods in competition with each other. Whilst I accept that all of the respective goods may power a particular tool, I have no evidence that electric generators and air compressors are able to power a vibrating poker and there is nothing before me which goes any way to indicating that these goods can be used as alternatives. Absent evidence to the contrary, I do not consider *electric generators* and *air compressors* to be similar goods to *poker drive units*.

15. As regards LF’s reliance on *power tools namely, saws, routers, drills, grinders, sanders, planers and accessories therefor* these are all tools which are for cutting, shaping, boring holes in or surfacing etc. materials, such as wood. Whilst they may also be used by those in the construction industries and be supplied through general tool suppliers, they are not complementary to the goods applied for and their uses differ to the extent that I do not consider them to be similar to *vibrating pokers* or *poker drive units*. Similarly, as regards *masonry hand tools namely, mud pans made of aluminum, stainless steel and plastic, aluminum hawks, brick and convex jointers, cement edgers, brick tongs, corner tools, drywall and joint knives, hand sanders, pole sanders, floats, wire twisters, paint and mud mixers, circle cutters, utility saws, wood line blocks, sanding blocks*, none of these are complementary goods and the uses differ to such an extent that I do not consider them to be similar to *vibrating pokers* or *poker drive units*.

16. This leaves *pumps for purging drains, sewer rods and plumbing snakes*. All of these goods are used by plumbers and technicians such as maintenance engineers to clean, unblock and drain pipework and drainage systems. They are dissimilar goods to *vibrating pokers* and *poker drive units*.

17. In summary, I find pressure washers and generators as applied for to be identical to pressure washers and electric generators of the earlier mark. All other goods I find to be dissimilar.

**The relevant consumer and the purchasing act**

18. Pressure washers are used for high power cleaning of e.g. a property’s external surfaces or vehicles and thus may be bought by individual property or car owners or by professionals in the cleaning trade. They may be bought from a variety of suppliers, such as DIY, motor factors or builders’ merchants including their online equivalent. Generators may be used by an individual, e.g. to be used in situations where the domestic power supply is unavailable or its use is inappropriate. They are goods which are most likely to be bought by professionals such as builders or certain engineers though I do not rule out the possibility of them being used by e.g. an individual homeowner or hobbyist. All of the goods are such as would be bought on an infrequent basis with a good deal of consideration being given to their purchase in view of their likely cost and to ensure fitness for purpose. In my view the level of attention being paid to the goods indicates that the visual aspects of the marks will be of greatest effect however that does not mean that the other aspects would be ignored.

**Comparison of marks**

19. For ease of reference I set out below the respective marks:

Seddon’s application	LF’s earlier mark
	TASK FORCE

Seddon’s application is made up of several elements: there is the word TASKMAN within a rectangular border, with the word TASK in red and the word MAN in grey (which serves to separate the words from each other) both on a black background. Next to these words is a device of the upper body and head of a man with his arms crossed, on a square grey background. The man is wearing what looks to me to be a hardhat and a shirt with the sleeves rolled up. The left side of the figure appears to be in shadow as the right side shows the hat to be coloured red and the shirt, grey. LF’s mark consists of the words TASK and FORCE.

20. Where marks employ a common element, competing considerations are likely to come into play in determining the proper outcome. In *10 Royal Berkshire Polo Club Trade Mark*, [2001] RPC 32, Mr Hobbs QC, sitting as the Appointed Person, said:

“31..... I am satisfied that the use of the word POLO as part of the applicant’s mark does not capture the distinctiveness of the opponent’s earlier trade marks [POLO]. I do not think that people exposed to the use of the applicant’s mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB. The

message of the mark comes from the words in combination and that is not something that I would expect people to overlook or ignore in the ordinary way of things.”

21. The weight of other matter and the context in which the common element occurred was sufficient in that case for the Appointed Person to hold that consumers’ attention would not focus on the element POLO to the point where the marks would be regarded as sharing a distinctive character.

22. In *Cardinal Place* Trade Mark, BL O/339/04, Mr Hobbs QC, again acting as the Appointed Person, had before him the mark CARDINAL (and small device) and CARDINAL PLACE. He held that:

“15. The perceptions and recollections triggered by the earlier mark are likely to have been ecclesiastical whereas the perceptions and recollections triggered by the Applicant’s mark are likely to have been locational as a result of the qualifying effect of the word **PLACE** upon the word **CARDINAL**. A qualifying effect of that kind can be quite powerful as indicated by the examples cited in argument on behalf of the Applicant: **SOMERSET** as compared with **SOMERSET HOUSE**; **COUNTY** as compared with **COUNTRY HALL**; **CANARY** as compared with **CANARY WHARF**.”

He posed the following question:

“17. So why should it be thought that the visual, aural and conceptual differences are sufficiently significant to render the marks distinguishable, but not sufficiently significant to enable them to be used concurrently without giving rise to a likelihood of confusion? This, to my mind, is the critical question. The answer to it depends upon how much or how little the word **PLACE** would be likely to contribute to the distinctive character of the mark **CARDINAL PLACE** taken as a whole.”

23. His conclusion was that the overall effect and impact of the combination CARDINAL PLACE was sufficiently different to the word CARDINAL on its own that the two marks could be used concurrently without giving rise to a likelihood of confusion.

24. In Case T-22/04 the Court of First Instance (CFI) annulled the decision of OHIM’s second Board of Appeal in a case involving the marks WESTLIFE and WEST. In its judgment the Court said:

“37. It must also be borne in mind that the Court of First Instance has already held that, on an initial analysis, where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar (*Case T-286/02 Oriental Kitchen v OHIM – Mou Dybfrost (KIAP MOU)* [2003] ECR II-0000, paragraph 39).

38. In this instance one of the two words which alone constitute the word mark applied for is actually identical in appearance to the sole word forming the earlier word mark. Aurally there is a degree of similarity, although the pronunciation of the word 'west' is not identical, at least as regards the whole of the relevant public. In this instance, the two words forming the Westlife mark mean something to the relevant public but they do not describe either the goods or services in question or their qualities and therefore do not have any particular connotation in relation to them.

39. Although the approach described at paragraph 37 above is not therefore directly applicable in this case, it must nonetheless be stated that the only visual difference between the two word marks at issue is that one of them contains a further element added to the first. Moreover, as stated above, there is a degree of similarity between the two marks in aural terms and, in particular, in conceptual terms.

40. It must therefore be held, in this case, that the fact that the Westlife trade mark consists exclusively of the earlier West trade marks to which another word, 'life' has been added, is an indication that the two trade marks are similar.”

25. The CFI went on to find that the relevant public might consider the mark applied for to be a variant of the earlier mark or at least that there was an economic link between the companies or undertakings marketing goods or services under the marks.

26. It is apparent from these contrasting outcomes that questions of this kind are not susceptible to any single or mechanistically applied solution. The test under Section 5(2) is, in essence, whether there are similarities in the trade 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 trade 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. I should, however, guard against dissecting the respective marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the chance to compare marks side by side but must instead rely on the imperfect picture he has of them in his mind.

27. In the *Medion* judgment the ECJ stated:

“29 In the context of consideration of the likelihood of confusion, 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. On the contrary, 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 one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark use by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

28. And, in *Shaker di Laudato (supra)* the ECJ stated:

“41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, 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. On the contrary, 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 (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42 As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

29. I also take note of the decision in *MIP Metro Group Intellectual Property GmbH & Co KG v OHIM* T-290/07 where the CFI stated:

“ For the purpose of the global assessment of the likelihood of confusion, the overall impression created by the two signs at issue must be considered (Case C-206/04 P *Mulhens V OHIM* [2006] ECR I-2717, paragraph 23, and Case C -234/06P *Il Ponte Finanziaria v OHIM* [2007] ECR I-7333, paragraph 37) and the signs’ aural, visual and conceptual similarities must be weighed up, taking into account factors such as, in particular, the nature of the goods or services, the way they are marketed and the public’s level of attention. In that regard, it should be pointed out that, although there will not necessarily always be a likelihood of confusion where two signs are found to be only

aurally similar, it is nevertheless conceivable that the marks' aural similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94. However, the conceptual, visual and aural similarities between the signs at issue and the assessment of any aural similarity is only one of the relevant factors for the purpose of that global assessment (Mulhens v OHIM paragraphs 21 and 23; see also, to that effect, Il Ponte as before paragraphs 35 and 37; and Joined cases T-117/03 to T-119/03 and T-171/03 New Look v OHIM –Naulover (NLSPORT, NLJEANS, NLACTIVE and NLCollection) [2004] ECR II-3471, paragraph 49.”

30. From a visual perspective, it is clear that the word TASK appears in both marks and to this extent there is some degree of similarity. That similarity is very low given that there are also clear visual differences between the marks in that Seddons' mark also has the common 3 letter word MAN within it whereas LF's mark contains the equally common 5 letter word FORCE. Seddons' mark also contains the device of a man and the differing colours of the different elements. From an aural perspective the first word in each mark is identical whereas the latter words are clearly different. I find there is a modest degree of similarity.

31. LF's mark consists exclusively of the words TASK FORCE which is a well known phrase which appears in the dictionary and brings to mind a group of people brought together to carry a specific task. Given that the words TASK FORCE form a well known phrase, these words hang together with neither word being dominant. TASK MAN is not, as far as I am aware, either a single word or a phrase with a dictionary meaning and whilst both words have a meaning, they combine to make a meaningful whole: a man who will carry out a given job-though the more usual would be “workman”. The device of the man wearing what appears to be a protective hard hat reinforces the use of the word MAN within the mark as a whole but I consider the dominant element of this mark to be the word(s) TASKMAN. To the extent that both marks bring to mind the carrying out of a task or job, there is some similarity from a conceptual viewpoint, though there are also differences in that one relates to a group of people whereas the other relates to a single person.

### **Distinctiveness of the earlier mark**

32. I also have to take into account the distinctive character of the earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the public. In her witness statement, Mrs Brooks on behalf of Seddons, submits that “the usage of the word TASK for machine and machine tools in Class 7 is extremely common” though she provides no evidence for this other than making an unsupported reference to the “large number of trade marks [which] have been registered alongside each other containing the word in combination with other elements”. For its part, LF submits that “the state of the register and whether or not other proprietors use similar or identical elements to those contained within either of the [marks] is not relevant”.

33. In my view the word TASK is an apt one to use when referring to a tool or piece of equipment for use in a particular activity however, when considering the mark as a whole, as I am required to do, it seems to me that the earlier mark has a reasonable degree of distinctive character. AS I have said above, the words TASK and MAN

have their own meanings which may be relevant to describe the purpose of the goods, but they hang together to create a different and allusive meaning. No evidence of any use of this mark has been filed and therefore I am unable to find that its distinctive character has been enhanced through use.

### **Likelihood of confusion**

34. In reaching a decision on whether there is a likelihood of confusion, I must make a global assessment based on all relevant factors. Having done so it seems to me that whilst there are some similarities between the respective trade marks, there are also significant differences and that those differences outweigh the similarities, even where identical goods are involved. That being the case I consider there is no likelihood of confusion and the opposition brought under the provisions of section 5(2)(b) fails in its entirety.

### **Costs**

35. The opposition has failed and Seddons is entitled to an award of costs in its favour. I take note that a single witness statement was filed (and which was, in fact, submission), that there was duplication of submission by LF and that no hearing took place. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4/2007. Using that TPN as a guide, I award costs on the following basis:

Preparing a statement and considering other side's statement:	£200
Preparing and reviewing written submissions:	£500
Total:	£700

36. I order LF, LLC to pay Seddons (Plant & Engineers) Ltd the sum of £700. 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 26 day of May 2010**

**Ann Corbett  
For the Registrar  
The Comptroller-General**