

O-171-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2368347
IN THE NAME OF TOM PARKER LTD
FOR REGISTRATION OF THE TRADE MARK PARKAIR
AS A SERIES OF THREE MARKS IN CLASSES 7, 10, 17 AND 35**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 93383
IN THE NAME OF PARKER INTANGIBLES LLC**

Trade Marks Act 1994

**IN THE MATTER OF trade mark application No. 2368347
in the name of Tom Parker Ltd
for registration of the trade mark PARKAIR
as a series of three marks in Classes 7, 10, 17 and 35**

And

**IN THE MATTER OF opposition thereto
under No. 93383 in the name of Parker Intangibles LLC**

BACKGROUND

1. On 16 July 2004, Tom Parker Ltd made an application to register the trade mark PARKAIR as a series of three marks in Classes 7, 10, 17 and 35 in respect of the following goods and services:

- Class 7** Pneumatic control valves; couplings for pneumatic apparatus; hydraulic control valves; hydraulic connectors; valves; parts and fittings for all the aforesaid goods.
- Class 10** Tubing and tubing connectors for medical use; parts and fittings for all the aforesaid goods.
- Class 17** Jointing for pneumatic apparatus; hydraulic hose (non-metallic); rubber valves; parts and fittings for all the aforesaid goods.
- Class 35** Advertising services; promoting the goods and services of others; business introductory services; the bringing together, for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase those goods and services, from a general merchandise retail outlet including a pneumatic, hydraulic, water and gas applications retail outlet, or from a general merchandising catalogue including a pneumatic, hydraulic, water and gas applications catalogue by mail order, or from a general merchandising Internet website including a pneumatic, hydraulic, water and gas applications Internet website, or by means of telecommunications; consultancy, information and advisory services, including helpline services relating to all the aforesaid services.

2. On 29 April 2005, Parker Intangibles LLC filed notice of opposition to the application, the grounds of opposition being in summary:

1. Under Section 5(2)(b) because the mark applied for is similar to the opponents' earlier trade marks, and is sought to be registered in respect of goods that are identical and/or similar to the goods covered by these earlier marks such that there exists a likelihood of confusion on the part of the public.

2. Under Section 5(3) because the mark applied for is similar, and its use in respect of all of the goods and services specified, would, without due cause, take unfair advantage of, or be detrimental to the opponents' earlier mark.

3. The applicants filed a counterstatement in which they put the opponents to strict proof of the use that they have made of their mark, and deny the grounds on which the opposition is based.

4. Both sides ask that an award of costs be made in their favour.

5. Both sides filed evidence in these proceedings, which insofar as it is relevant I have summarised below. The matter came to be heard on 15 November 2007, when the applicants were represented by Mr. Tim Ludbrook of Counsel, instructed by Bison River Limited. The opponents were represented by Mr Alastair Rawlence, their trade mark attorneys.

Opponents' evidence

6. This consists of a Witness Statement dated 7 November 2006, from Thomas A. Piraino, Vice President and Secretary of Parker Intangibles LLC, the opponents in these proceedings. This Statement consists of a combination of evidence of fact, and submissions on the substance of the proceedings. Where facts are presented these have been summarized. I have noted the submissions but will not include them in the summary of the evidence.

7. Mr Piraino refers to the application in suit, details of which are provided in Tab 1. A copy of the Notice of Opposition and Statement of Grounds are shown as Tab 2. Mr Piraino says that the opponents are part of the Parker Hannifin Group of companies (Parker), the world's leading diversified manufacturer of motion and control technologies and systems. A list of companies within the Parker group is shown as Tab 3. Mr Piraino says that his company has been trading under the PARKER name for over 60 years, and operates 263 plants in 46 countries. He says that the company trades in various markets including industrial machinery, aviation, car care and engines. Further information about Parker's activities, including a copy of its annual report is at Tab 4.

8. Mr Piraino states that Parker's annual turnover (financial years from July 1 to June 30) for the years 2005 to 2006 exceeded US \$9 billion. The total annual sales by Parker in each of the financial years are as follows:

Year	Sales
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2002 - 2003	US \$ 6,311,693
2003 - 2004	US \$ 6,998,761
2004 - 2005	US \$ 8,215,095

9. Mr Piraino says that a full list of products sold under the PARKER brand is shown as Tab 5, listing these as falling into the following groups:

pneumatics - i.e. mostly pumps, valves, cylinders and other components for air and other gas pressure,

automation - i.e. mostly electric motors and other devices used in factory automation;

filtrating - mostly filters for removing contaminants from pneumatic (air) systems and from other gas and liquid fluids; fluid connectors - mostly hoses (also called tubing) and fittings (also called couplings) that connect pneumatic and other fluid components mostly for industrial applications but also for some medical applications;

hydraulics - mostly pumps, valves, cylinders and other components for hydraulic oil, water and other liquid pressure.

10. Mr Piraino says that the opponents are Parker's intellectual property holding company, with companies within the group being licensed by them to use the PARKER trade marks. Details of the Parker trade mark registrations and applications owned by the opponents throughout the world are shown as Tab 6 and Tab 7. Mr Piraino lists the registered trade marks having effect in the UK, exhibiting full details at Tab 8 and Tab 9.

11. Mr Piraino refers to Tab 10, which consists of the home page from the Tom Parker Ltd website. This refers to the company as having been established in 1972, becoming one of Britain's largest distributors of quick connect couplings for pneumatic, hydraulic, water and gas applications, with branches in Basingstoke and Preston. Extracts from the Tom Parker Ltd current catalogue giving examples of its use of PARKAIR are shown as Tab 11. In addition to distributing parts manufactured by third parties, Tom Parker Ltd also manufactures its own products under the PARKAIR brand. The extract from the applicant's website, tom-parker.co.uk shown at Tab 12 lists the goods sold under the PARKAIR brand, showing these to include couplings, valves, pipe fittings, fittings of iron, brass and steel, tubing, hose made of various materials, clips, clamps, pressure gauges, washers and hydraulic adaptors.

12. Mr Piraino says that his company has been using its PARKER brand in the UK for over twenty years and has owned a UK trade mark registration for PARKER since 1962. Tab 13 consists of a print showing the "P" device used by the opponents, Mr Piraino asserting that there are similarities between this and the "P" used by the applicants in their PARKAIR product list shown at Tab 10. As Tab 14 he exhibits copies of the Parker Hannifin International annual reports dating from 1966 to 2005 which refers to Parker's presence within the UK.

13. Mr Piraino goes on to give details of the “approximate” UK turnover under its PARKER brand made by his company’s UK subsidiary and trading company, Parker Hannifin Limited.(PHL) in the years 2001 to 2006:

Year Ending	UK Turnover
2001	US \$155.5 million
2002	US \$175.0 million
2003	US \$208.04 million
2004	US \$204.01 million
2005	US \$254.5 million
2006	US \$264.0 million

14. To illustrate the ways in which the PARKER brand has been used in the UK by PHL, Mr Piraino exhibits the following:

At Tab 15 is a copy of Parker's Annual Report for fiscal year ending June 2004. Approximately 75,000 are said to have been sent to all Parker locations, shareholders, security analysts, colleges and schools who requested them, foreign inventors and an executive list (which is confidential),

Screen shots from Parker's website at parker.com (Tab 16). Mr Piraino says that Parker's website provides UK customers with information about PARKER-branded products and services, and has been used extensively by Parker since at least December 1996. Details of other PARKER domain names owned by Parker are at Tab 17. Details of the number of visitors to Parker's websites is shown at Tab 18, but it is not possible to say how many originate from the UK.

At Tab 19 is a copy of Parker Directory of Products and Services dating from 2004.

Tab 20 Consists of a collection of catalogues (not all in English) dating from 2002 through to May 2004, Mr Piraino making particular reference to the details relating to the hydraulic and pneumatic components sold by Parker.

15. Mr Piraino states that PHL has spent US\$ 2.4 million on advertising and promotional activities under the PARKER brand during the last five years, but does not say how much of this relates to the UK. He goes on to say that during the financial year ending 2004, the year in which the application was filed, Parker's UK had a turnover under its PARKER brand of \$204.01 million.

16. Mr Piraino goes on to exhibit examples of the materials used in advertising campaigns involving the PARKER name since 1987, which are shown at Tab 21. This includes:

Product bulletins dating from 1987 onwards showing the “P” Parker logo and listing, amongst others, UK distributors as being on the distribution list,

Press releases dating from August 1995 and July 1998, announcing PARKER Pneumatic’s new products,

Brochures dating from 1997 relating to products for the truck industry, containing a list of European Sales Offices, including one in the UK,

Product sheets/flyers headed “The Parker Partnership” and “Partner with Parker...” showing a UK contact, or in the latter case a UK telephone number for contact. None can be dated,

Advertising project pack for 2005, that includes a schedule showing proposed advertisements in various publications

17. Mr Piraino says that Parker has also undertaken European road shows to promote the PARKER brand since 2000, photographs of which are shown at Tab 22. The stand has the “P” Parker logo clearly displayed. This part of the exhibit also includes a pack relating to the PARKER Roadshow activities in 2005.

Applicants’ evidence

18. This consists of a Witness Statement dated 28 February 2007, from Tim Parker, the Financial Director of Tom Parker Limited (TPL) a position that he has held since 1987. Mr Parker says that he is authorised to make this witness statement on behalf of TPL, and that save and to the extent that he has indicated otherwise, the facts and matters referred to are within his own knowledge. He confirms that the TPL records that he refers to have been maintained in the ordinary course of business and that he has full access to them.

19. Mr Parker’s Statement consists of references to his own evidence in support of his case, mixed with submissions on the opponents’ evidence and the substantive issues. Where evidence of fact is provided I have summarised it below, but otherwise will take all of the contents of the statement into account in my determination of this case.

20. Mr Parker says that his company was formed on 29 August 1972, being initially incorporated as Tom Parker (Hydraulics & Pneumatics) Limited, changing its name to Tom Parker Limited on 10 December 1993. He further says that TPL has made continuous use of the trade mark PARKAIR in the UK since 1972, in relation to the goods and services covered by the application. He notes that this has been concurrent with the use by Parker Intangibles LLC (PIL).

21. Mr Parker goes on to refer to Exhibit TP1/1a, which consists of a print of the marks that are the subject of the application. Mr Parker goes on to refer to a trade mark search conducted by Bison River Limited, who act for TPL, to find live trade marks that contain or comprise the surname PARKER, the results of which are shown as Exhibits TP1/lb and TP1/lc. Mr Parker asserts that PARKER is a commonly occurring name, which as can be seen from Exhibit TP1/1d, was first recorded in the Domesday Book records in 1086.

22. Exhibit TP1/3b consists of a Year planner for 1989 that contains the device of a letter P, the space in the upper portion being formed by an arrow, placed above the company name Tom Parker Limited. The name PARKAIR is used in relation to “balancers”. The exhibit

also shows the opponents' trade mark and a reference to the applicants selling compression fittings from the Parker Hannifin range.

23. Mr Parker goes on to refer to his company's commercial association with Parker Hannifin, and the trade marks owned by PIL, stating that for a number of years, but primarily between 1987 and 1999, his company actually sold products under the PIL Marks. He says that his company was the Parker Hannifin (PH) distributor for the North West of England, dealing with their Fluid Connectors division, and that during this time his company was using the trade mark PARKAIR. Exhibit TP1/6a consists of a sheet showing the composite P PARKAIR logo with the words "FLUID POWER". Exhibit TP1/6b to TP1/61n consists of extracts taken from some of the applicants' brochures from this period. These Exhibits consist of catalogues for Tom Parker (Hydraulics & Pneumatics) Ltd, endorsed as dating from "Pre 88" through to "April 2005. The "Pre 88" and some later catalogues mention PARKAIR "recoil nylon pig tails". The brochure dating from August 2002 refers to the PARKAIR AND HYDRAULICS 2002 – 2003 CATALOGUE, listing fluid power products such as valves, hoses, hose connectors, tubing, etc.

24. Mr Parker states although the distribution agreement with PH was terminated in 1999, his company still sells that company's products. He says that as can be seen from Exhibit TP1/4a to TP1/4e, his company used to advertise and sell PARKER products alongside PARKAIR products, the artwork for these advertisements and his company's catalogues having been approved by PH. Exhibits TP1/4a to TP1/4e consist of letters dating from the period 31 January 1997 to 23 July 1998, from Parker Fluid Connectors to Mr Tom Parker of Tom Parker Pneumatics, setting out terms for their becoming a distributor of Parker fluid connectors. There is a an unsigned Distributorship Agreement, although not mentioning Tom Parker.

25. Mr Parker goes on to recount the development of his company's business, stating that in 1996 they bought G & R Hydraulics Pneumatics, the aim being to increase their local presence in Basingstoke. Mr Parker says that this company is a wholly owned division of TPL and now trades as Tom Parker Ltd. He goes on to give details of his company's nationwide sales, support and quality control team. Mr Parker outlines his company's Quality Management protocols and regimes deployed, going on to refer to Exhibit TP15a, which consists of a copy of a Certificate of Registration showing them to have been registered since 23 October 1991 to date. Exhibit TP1/5b consists of an excerpt taken from british-accreditation.co.uk that explains ISO 9000.

26. Mr Parkers provides extracts from the applicants' company accounts in relation to turnover for the financial years ending 30th April.

1998	£ 5,513,576
1999	£ 4,765,490
2000	£ 4,626,171
2001	£ 5,620,162
2002	£ 5,057,567
2003	5,450,505
2004	£ 5,330,243
2005	5,469,525
2006	5,459,972

27. Mr Parker also gives advertising expenditure (exclusive of VAT) by year

	2004	2005	2006
Advertising gifts/pens diaries etc	3454	9370	4260
Exhibitions/advert agencies/magazines	30577	36706	32140
TPL/Parkair Brochures	26215	24404	63038
Total	60246	70480	99438

28. Mr Parker says that the PARKAIR mark is promoted by TPL, with goods being packaged and labeled as shown in Exhibits TP1/6a to TP1/6n and TP1/8a to TP1/8c. He goes on to say that TPL creates and distributes its own catalogues, Exhibits 6b, 6c, 6d in TP1 and exhibits 1 to 5 in TP2 being put forward as “typical examples” of such documents. These Exhibits show use of PARKAIR, both on its own, in conjunction with a letter P having the upper void formed by an “arrow”, or other descriptive matter such as “Fluids” and “Recoil Nylon”. In addition, Mr Parker says that TPL attends and exhibits at various exhibitions, Exhibits 8a and 8b in TP1 being various examples of this activity. These show the name PARKAIR in similar formats as described in the previous exhibits.

29. Mr Parker says that since 1997, TFL has maintained the website www.tomparker.co.uk. Exhibits 7a and 7h in TP1 consist of extracts from the: historical Internet database WAYBACKMACHINE and extracts from the current TFL website. These refer to TPL having been established in 1972 and to being “one of Britain’s largest distributors of quick connect couplings for pneumatic, hydraulic, water and gas applications”, the goods listed under the PARKAIR product range. Mr Parker states that TPL's products are promoted via the Internet, through other media, and by a variety of third parties, examples of this being shown as Exhibit 9a, 9b, 9c and 9d in TP1. Whilst most of these cannot be dated, or at least not dated as relating to a period prior to the relevant date, one example from Fluid Power Limited refers to the availability of the “Parkair 2004/5 catalogue”.

30. The remainder of Mr Parker’s Statement consists of submissions on the evidence provided by Thomas Piraino. Of particular interest is paragraph 34 which relates to Parker Hannifin Limited, being PIL's UK subsidiary. Mr Parker mentions that as can be seen from Exhibit 10 of TP1, an extract from the Register of Companies, Parker Hannifin Limited had been incorporated on 20 June 2003, stating that the figures provided for sales of unspecified goods and services from 2001 cannot be correct.

31. In relation to paragraph 38 of Mr Piraino’s Statement, Mr Parker notes that the schedule at tab 21 relates to “proposed” advertisements. He says that press releases are very often not published, and given that the examples have not been substantiated with actual published articles, he asserts that that is the case here. He refers to Exhibits 11 a and 11b to TP1, which consists of an extract taken from PHL’s website, showing its address to be in the USA.

32. Mr Parker refers to the draft agreement that PIL sent to his Company in 1998, a copy of which is shown as Exhibit 4b of TP1.

33. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

34. In his Skeleton Argument, Mr Rawlence, the opponent's representative stated that the ground under Section 5(3) was not to be argued. He confirmed that the opposition was therefore to be considered on the basis of the ground under Section 5(2)(b) alone.

35. Turning first to the ground under Section 5(2)(b). That Section 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.”

36. An earlier trade mark is defined in Section 6 of the Act 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 or international trade mark (EC) 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.”

37. In my consideration of a likelihood of confusion or deception 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] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [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) in determining whether similarity between the goods or services covered by 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*,
- (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 and Adidas Benelux BV*,
- (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*.

38. The opponents rely on four earlier UK trade marks and one earlier Community Trade Mark, details of which are shown as an annex to this decision.

39. The opponent's earlier marks are for the word PARKER, both in plain font and in a stylized version as follows:



40. In my view the stylization does not take away from the fact that this is the word PARKER, and I shall write my decision on this basis, taking into account any impact and

relevance of the stylization. However, in respect of the consideration of whether the opponent's earlier marks and the mark in suit are similar, I believe it must follow that if there is a finding that the words PARKER and PARKAIR without any other matter are not similar, it must follow that the stylized version of the opponent's earlier marks cannot be either.

41. The decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan's Manufacturing (UK) Ltd*, [2005] EWHC 1303 indicated that the circumstances in which the relevant goods (and I believe it must follow, also services), and the trade marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. That said, the matter must be considered by applying an assessment of all relevant factors.

42. The products covered by the application, both in the goods classes and those encompassed by the retail services, are of a reasonably specialized type for particular applications. These would most likely be purchased by a consumer more knowledgeable and informed than for less technical items. It also seems likely that in making the purchase the consumer will be more observant and circumspect to ensure the correct size, type, etc is obtained. The remaining services, namely, "advertising and promoting the goods and services of others" and the "business introductory services" are also fairly specialised, at least insofar as they are not generally purchased by the public at large. The purchase of such services will also be a careful and considered act.

43. It is clear from the evidence that products of the type covered by the respective marks are available for selection from catalogues and the Internet where the visual impact of the marks will be of most importance. It is, of course possible that a consumer with the requisite knowledge would simply telephone, or call to an outlet and ask for the goods. In such circumstances the similarity in sound will come into play. But bearing in mind the need for precision in the product obtained there would seem to be less likelihood of there being confusion over the name.

44. The marks applied for are the word PARKAIR as a series of three, two are in upper-case and show the word in black and in pink. The remaining mark consists of the word PARKAIR in lower case.

45. In a visual comparison it is self-evident the words PARKER and PARKAIR are not identical. What is also clear is that they have the element "PARK" in common and both terminate with the letter "R", so if only to this extent there must be a degree of similarity in appearance. However, the question is not whether there is similarity in the elements of the marks, but whether the marks as a whole are similar. That the similarity is essentially in the first part of the respective marks (generally accepted as being of most significance in a comparison) gives it a greater impact on the eye than otherwise would be the case. Added to the fact that the difference is in the letters that form the terminal syllable, and arguably lost within the body of the mark could easily lead to the view that these marks are visually similar. It is, however relevant to consider the impression that the respective words convey to the consumer as I believe this will influence what they see when encountering the words.

46. As can be seen from Exhibit TP1/1d, the word PARKER has for some considerable time been in use as a surname in the UK, a usage that I consider will be well known to the relevant

public. To my mind this is what the consumer of the relevant goods will see when the word is used in connection with the goods for which the opponents have it registered. There is no dominant, distinctive element within this mark.

47. The applicants have stated the source of the inspiration for their mark to be an absorption of a characteristic of the relevant goods and services, namely “air”, as in air hoses and air hose connectors, into the applicant’s name PARKER. In other words, it is an adaptation of the word PARKER to allude to some aspect of the goods and services. That may well be the case, but when used in connection with goods for which registration is sought there is no reason to suppose that the consumer will know this. It is just as likely, if not more so that they see PARKAIR as the conjunction of the two ordinary English words “PARK” and “AIR”. If there is a dominant, distinctive element in this mark it is probably the word PARK, if only because it is the first element, and “AIR” is clearly capable of being recognized as a reference to a characteristic of the goods and services. So whilst the marks PARKER and PARKAIR may have similarities in their visual characters, the mark have different impact on the eye.

48. Extending these considerations to the question of whether there is any conceptual similarity, if the consumer knows the connection with PARKER they may see the mark as a clever play on that name. Alternatively, because the AIR element of the applicant’s mark has descriptive connotations for the goods, whereas PARK does not, it is just as possible that the relevant consumer will see the mark as PARK – air products. As a whole I would say that the words PARKER and PARKAIR will say something different to the consumer of the relevant goods and services.

49. The respective marks are probably closest in their sound. Being composed of the same letters in the same sequence, the first element “PARK” will sound identical. It is possible for different suffixes to change the sound of an identical prefix, but that is not the case here. The terminal letter is identical so the question is whether the different use of consonants alters the sound of the mark as a whole. Taken in isolation, the letters “AI” in combination create a different sound to the letter “E”, but of course the letters either side will influence the sound and significance. That the mark applied for is a portmanteau word created by combining two ordinary words which can still be discerned within the whole, makes it more likely that the consumer will make more effort to pronounce both PARK and AIR, but this has to be balanced against the fact that the end of words tend to be enunciated with less clarity. The letter K has a strong sound whereas the letter R is much softer, making it more likely that the termination will fade, and lessen the distinction between the elements.

50. I take the view that the marks PARKER and PARKAIR are not visually or conceptually similar. They are closer when considered from an aural perspective, although in my view it is arguable whether they are sufficiently so to be considered similar. However, even if I were to consider PARKER and PARKAIR to have a similar sound, this does not inevitably lead to the conclusion that the marks are similar; in my view they are not.

51. The opponents say that they have been trading under the PARKER name for over 60 years, since 1962 in respect of the UK, and operate in 46 countries trading in markets such as industrial machinery, aviation, car care and engines. The turnover for the financial year from 1 July 2005 to June 30 2006 is stated to have exceeded US \$9 billion, with annual sales in the financial years 2002 to 2003 through to 2004 to 2005 being of the order of US\$6 billion to

over US\$8 billion. This is said to have been derived from sales of pneumatics (pumps, valves, cylinders and other components for air and other gas pressure), automation (electric motors and other devices used in factory automation), filtrating (filters for removing contaminants from pneumatic (air) systems and from other gas and liquid fluids), fluid connectors (hoses, tubing and fittings such as couplings) that connect pneumatic and other fluid components for industrial applications and some medical applications, and hydraulics (pumps, valves, cylinders and other components for hydraulic oil, water and other liquid pressure).

52. Mr Piraino gives details of the “approximate” UK turnover under its PARKER brand made by his company’s UK subsidiary and trading company, (PHL) in the years 2001 to 2006, which range from US \$155.5 million in 2001, rising almost year on to US \$264 million in 2006. He does not say how, or what basis he approximates the sales to the UK, or why exact figures cannot be provided, and unlike the global figure, he does not say what goods generated this income. Mr Piraino further states that PHL has spent US\$ 2.4 million on advertising and promotional activities under the PARKER brand during the last five years, but does not say how much of this relates to the UK. Supported by the exhibits showing how the mark has been used these figures should be taken as “illustrative” of a trade that is of sufficient scale to have generated a strong reputation in the PARKER name, in relation to a range of goods corresponding to those stated for the trade as a whole. There is no suggestion that PARKER is a less than distinctive mark for the goods in question. Given my findings in relation to the use that the opponents have made of the name, I believe it must follow that this adds to the distinctive character of the PARKER name in relation to the goods stated.

53. The applicants, Tom Parker Ltd are stated to have been formed on 29 August 1972 as Tom Parker (Hydraulics & Pneumatics) Limited, changing its name to Tom Parker Limited on 10 December 1993. Mr Parkers states that they have made continuous use of the trade mark PARKAIR, initially in respect of “quick-connect couplings, hydraulic and pneumatic hose and related fittings” primarily in relation to the automotive industry, but also newspaper machinery manufacturing. This constitutes some, but not all of the goods and services covered by the application. Mr Parker says that further products were added, but apart from a comment referring to a move away from the “hydraulic and pneumatic image” and the addition of “couplings for medical applications” he does not give specifics. The details of the TPL website exhibited by Mr Piraino refers to a range of goods stated to be sold under the PARKAIR name, but this does not assist in determining whether, from when or to what extent they may have done so.

54. Mr Parker notes that his company’s use has been concurrent with the use by PIL, and even involved a commercial relationship with them. Whilst the evidence does not show use from the company’s beginnings, Exhibit TP1/3b, which consists of a Year planner for 1989 shows the device of a letter P, the space in the upper portion being formed by an arrow, placed above the company name Tom Parker Limited. The name PARKAIR is used in relation to “balancers”.

55. The exhibit also shows the opponent’s trade mark, referring to the applicants as selling compression fittings from the PH range. Exhibits TP1/4a to TP1/4e also show that the applicants used to advertise and sell PARKER products alongside their PARKAIR products. This seems to have come about through the applicants having had a commercial association with

PH for a number of years, primarily between 1987 and 1999, including as distributor for the North West of England dealing with the PH Fluid Connectors division. Exhibits TP1/4a to TP1/4e consist of letters dating from the period 31 January 1997 to 23 July 1998, from Parker Fluid Connectors to Mr Tom Parker of Tom Parker Pneumatics setting out terms for their becoming a distributor of Parker fluid connectors. There is an unsigned Distributorship Agreement, although not mentioning Tom Parker. During this relationship the applicants had been using and selling products using the trade mark PARKAIR. Mr Parker states although the distribution agreement with PH was terminated in 1999, his company still sells their products

56. Exhibit TP1/6a consists of a sheet showing the composite P PARKAIR logo with the words “FLUID POWER”. Exhibit TP1/6b to TP1/61n consists of extracts taken from some of the applicants’ brochures from this period. These Exhibits consist of catalogues for Tom Parker (Hydraulics & Pneumatics) Ltd, endorsed as dating from “Pre 88” through to “April 2005. The “Pre 88” and some later catalogues mention PARKAIR “recoil nylon pig tails”. The brochure dating from August 2002 refers to the PARKAIR AND HYDRAULICS 2002 – 2003 CATALOGUE listing fluid power products such as valves, hoses, hose connectors, tubing, etc. Mr Parker says that the artwork for these advertisements and his company’s catalogues had been approved by PH.

57. This evidence taken in conjunction with the turnover of around £5 million per annum for a number of years, and the advertising expenditure stated by Mr Parker indicate that the applicants have made use of the PARKAIR mark on a scale likely to have created an impact on the minds of the consumer of couplings for pneumatic, hydraulic, water and gas applications (see Exhibits 7a and 7h). It also shows that the respective parties have not just been using PARKER and PARKAIR side by side; the marks have been used in a trade emanating from a single source. In his submissions Mr Rawlence makes various comments on the extent to which the evidence showed use. Whilst I accept that there may be gaps in the facts provided by the applicants, if these were to be challenged it should have been done earlier, either by evidence or cross-examination. (see *Extreme Trade Mark* (BL O/161/07)). That aside, I am mindful that concurrent use is not, of itself sufficient to avoid a finding of a likelihood of confusion, but is a fact that can be taken into account in the assessment of a likelihood of confusion.

58. In relation to the goods of Class 7 and Class 17, I consider there to be identical goods involved. In Class 7 the application covers “Pneumatic control valves, couplings for pneumatic apparatus, hydraulic control valves, hydraulic connectors, valves, and parts and fittings for such goods. Two of the opponent’s earlier marks cover “valves” at large, and parts and fittings for such goods which would notionally encompass all of these goods

59. Class 17 of the application covers “Jointing for pneumatic apparatus, hydraulic hose (non-metallic), rubber valves, and parts and fittings for such goods. The opponent’s earlier marks covers “jointings”, non-metallic couplings and fittings for pipes, tubes and hose”, which in my view encompasses the full range of goods in this class of the application.

60. Insofar as Class 35 of the application notionally covers the retailing of the goods for which the opponent’s earlier mark is registered, this service is similar to the goods of the opponent’s earlier mark. The remainder of the services are not similar.

61. Class 10 of the application covers goods for medical use. Although similar in description to goods for which the opponents have registered their mark, being in Class 10 means that they are specialized, and in my view sufficiently far removed to be regarded as dissimilar.

62. So the conclusion I reach is that there is identity or similarity in respect of the goods in all but Class 10 of the application, and also in respect of the services involving the retailing of such goods. There is nothing in the wording of any of these specifications that would move the marks apart because of specialism, intended use, etc, so I must infer that the respective goods and services notionally follow the same channels of trade, from manufacturer to wholesaler/retailer, and are provided to the same end consumer.

63. Balancing all of the factors and adopting the global approach advocated. I take the view that whilst use of the marks applied for in respect of the goods and services for registration is sought may bring to mind the opponent's mark PARKER, and more so given the reputation that it enjoys, that is not sufficient for there to be a finding of a likelihood of confusion (*Sabel BV v Puma AG and Marca Mode CV v Adidas AG*). The question is whether the association between the marks will lead the consumer to believe that the respective goods and services come from the same or some linked undertakings; there has to be a likelihood of confusion. (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*) Even taking into account the possibility of imperfect recollection, I do not consider there to be such a likelihood and the opposition under Section 5(2)(b) is accordingly dismissed. I make this judgment without taking regard of the impact of the concurrent use of the respective marks. If this is factored in this can only serve to emphasise that in the reality of the market the consumer of the relevant goods and services does not appear to have been confused as to their origins. Whilst it is possible that there is undiscovered confusion, it is telling that the opponents have been content to allow the two marks to be used side by side without any apparent concern in this respect.

64. The opposition having failed the applicants are entitled to a contribution towards their costs. I therefore order that the opponent pay the applicants the sum of £3,250 towards their costs. 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 20th day of June 2008

**Mike Foley
for the Registrar
the Comptroller-General**

Case details for Trade Mark 841894

Mark: Parker

List of goods or services

Class 06: Couplings for metal tubes for pipes and for flexible hose, devices for connecting fuel supply hose to tanks, and manually operated valves; all being wholly or principally of common metal and for use in pipe line systems.

Case details for Trade Mark 867755

Mark: PARKER

List of goods or services

Class 07: Power operated valves (not being automatically operated) for use in pipe line systems.

Case details for Trade Mark 1165280

Mark:



List of goods or services

Class 07: Cylinders, valves

Case details for Trade Mark 2025600

Mark



List of goods or services

- Class 06: Hose, pipes and tubes of metal, couplings, fittings and clamps, all for metal tubes, for pipes and for flexible hose; devices for connecting metal tubes, pipes and flexible hose to tanks, nozzles, valves, motors and pumps, all being wholly or principally of common metal.
- Class 07: Machines for assembling fittings onto hose and tubing, machines for cutting and processing hose and couplings; air dryers for pneumatic systems; pumps, accumulators, injection nozzles, motors, valves, nozzles, flow dividers, flow regulators, pressure regulators, receivers, filters (for machines or engines), lubricators, regulators, cylinders, actuators, for fluid handling installations, hydraulic installations, pneumatic installations, fuel distribution installations, electro-mechanical installations of fluid devices; control mechanisms for machines, engines or motors; parts and fittings for all the aforesaid goods.
- Class 09: Electric or electronic sensors; electro-mechanical motor controllers and their components parts including electronic control devices; electric motors, electric stepper motors, electric linear actuators, electric rotary actuators, fuel pumps (self regulating), sensors, controls; electro-magnetic interference shielding devices; parts and fittings for all the aforesaid goods.
- Class 17: Electromagnetic interference shielding materials of plastics or rubber, o-rings, seals, electrically conductive seals, jointings, gaskets; non-metallic couplings and fittings, all for pipes, for tubes and for hose; tubing and hose, all of rubber or plastic.

Case details for Community Trade Mark E47290

Mark



List of goods or services

- Class 06: Common metals and their alloys, small items of metal hardware; goods of common metal not included in other classes; hoses, pipes and tubes of metal; couplings, fittings and clamps all for metal tubes, for pipes and for flexible hose; devices for connecting metal tubes, pipes and flexible hose to tanks, nozzles, valves, motors and pumps; all being wholly or principally of common metals; their parts and fittings comprised in this class.
- Class 07: Machines and machine tools; machines for assembling fittings onto hose and tubing, machines for cutting and processing hose and tubing; machine coupling and transmission components; air dryers for pneumatic systems; pumps, accumulators, injection nozzles, motors, valves, nozzles, flow dividers, flow regulators, pressure regulators, receivers, filters (for machines or engines), lubricators, regulators, cylinders, actuators, for fluid handling installations, hydraulic installations, pneumatic installations, fuel distribution installations, electro-mechanical installations or fluid devices; electric motors, electric stepper motors, electric linear actuators, electric rotary actuators; control mechanisms for machines, engines or motors; their parts and fittings comprised in this class.
- Class 09: Electric, measuring, signalling, checking (supervision) apparatus and instruments; electric or electronic sensors; electromechanical motion controllers and their component parts inclusive of the electronic control devices; fuel pumps (self-regulating), sensors, controls; electro-magnetic interference shielding devices; their parts and fittings comprised in this class; recorded computer programs.
- Class 11: Apparatus for heating, steam generating, refrigerating, drying, ventilating; valves, dryers, accumulators and filters for refrigerating, ventilating and air conditioning apparatus and installations; filters (parts of industrial installations), filter dryers; their parts and fittings comprised in this class
- Class 17: Plastics in extruded form for use in manufacture; packing, stopping

and insulating materials; electromagnetic interference shielding materials of plastics or rubber; O-rings, seals, electrically conductive seals, jointings, gaskets; non-metallic couplings and fittings all for pipe, for tubes and for hose; tubing and hose, all of rubber or of plastic; their parts and fittings comprised in this class.

Class 42: Technical consultation and design for motion control, fluid handling, hydraulic or pneumatic components and systems.