

O-434-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2575820
BY THE ASCERTIVA GROUP LIMITED TO REGISTER THE FOLLOWING
TRADE MARK IN CLASSES 4, 7, 9, 11, 35, 37, 39, 40 & 42:**

PURAGEN

AND

OPPOSITION THERETO (NO 102644) BY HALYARD (M & I) LIMITED

The background and the pleadings

1) Ascertiva Group Limited (“Ascertiva”) applied for the trade mark PURAGEN on 19 March 2011. It was published in the Trade Marks Journal on 12 August 2011 in respect of:

Class 4: Electricity; electric energy; solar energy; biomass; fuels.

Class 7: Generators of electricity, including wind and photovoltaic generators; apparatus, machines and installations for power, electricity or heat generation; heat pumps; apparatus for rainwater harvesting and filtration machines; machines for generating energy from biomass combustibles; wind turbines for power generation; wind powered electricity generators; components of the aforesaid apparatus and systems for using, storing and transformation of primary energy; information, advice and consultation in relation to the aforesaid.

Class 9: Products and installations for the generation of electricity, in particular from renewable energy sources such as energy from the sun, wind, biomass, water and geothermics; apparatus and instruments for conducting, switching, transforming, accumulating, regulating, saving or controlling electricity; all for domestic and industrial end user customers; solar energy panels; solar cells for electricity generation; solar electricity installations for supplying energy to commercial, residential and industrial premises; machines and installations for collecting, processing and handling photovoltaic energy and solar power; parts and accessories for the aforesaid; information, advice and consultation in relation to the aforesaid.

Class 11: Solar panels (heating), solar collectors; heat pumps, namely air, geothermal heat, electric, gas, solar and water heat pumps; installations for using rainwater, including rainwater filtering apparatus; machines and apparatus for the conversion of waste to energy, in particular apparatus for the combustion and gasification of biomass and waste; information, advice and consultation in relation to the aforesaid.

Class 35: Business administration and management services; business administration and management support services provided to others including to owners of franchised businesses; business services including the management and running of a franchise network; advertising and promotional services; retail services in connection with the sale of electricity generating plants in particular apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating, saving or controlling electricity; all for domestic and industrial end user customers; information, advisory and consultation services in relation to the aforesaid.

Class 37: Construction, supply and installation of electricity generating plants in particular in the renewable energy sector, including the construction, installation, maintenance and servicing of apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating, saving or controlling electricity; all for domestic and industrial end user customers; information, advisory and consultation services in relation to the aforesaid.

Class 39: Supplying of renewable and non-renewable energy; distribution of energy and/or power from renewable sources; information, advisory and consultation services in relation to the aforesaid.

Class 40: Generation of energy and electricity, in particular in the field of renewable energy; provision of information and data on renewable energy generation installations; information, advice and consultation services relating to the production of energy from renewable sources.

Class 42: Design, planning and project management of installations for generating and/or distributing electricity and/or heat, in particular from renewable energy sources; design of apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating, saving or controlling electricity; technical planning and consultancy in the fields of renewable energy and photovoltaic/solar installations and electrical systems; energy audit services; all for domestic and industrial end user customers.

2) Registration of the trade mark is opposed by Halyard (M & I) Limited ("Halyard") under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). A single earlier mark is relied upon, namely: Community trade mark ("CTM") registration 8761223 for the mark PUREGEN, which was filed on 16 December 2009 and which completed its registration procedure on 28 September 2009; the mark is registered in respect of:

Class 7: Machines and machine tools; Motors and engines (except for land vehicles); Machine coupling and transmission components (except for land vehicles); Agricultural implements other than hand-operated; incubators for eggs; exhausts, exhaust filters, exhaust cleaners, exhaust scrubbers, and apparatus and instruments for removing particles, contaminants, pollutants and other materials from exhaust gasses; including all the aforesaid goods for use with engines and generators and with marine engines and generators; exhausts, exhaust filters, exhaust cleaners, exhaust scrubbers, and apparatus and instruments for removing particles, contaminants, pollutants and other materials from exhaust gasses; including all the aforesaid goods for use with vehicles, apparatus for locomotion, watercraft, engines and generators and with marine engines and generators; power and electricity generators; parts and fittings for all the aforesaid goods.

Class 12: Vehicles; apparatus for locomotion by land, air or water; engines for land vehicles; parts and fittings for all the aforesaid goods.

3) Ascertiva filed a counterstatement denying the ground of opposition. Whilst it accepts certain aspects/degrees of similarity (between the marks, and between some of the goods/services) it denies that there is a likelihood of confusion. It denies that the differences between the marks will go unnoticed. Both sides filed evidence. A hearing then took place before me at which Ascertiva was represented by Mr Geoffrey Pritchard, of Counsel, instructed by Leathes Prior; Halyard was represented by Mr Ian Bartlett of Beck Greener.

The evidence

4) Both sides' evidence focuses, essentially, on the use made of the respective marks. The use is much narrower than the specifications that have been applied for/registered. The evidence is therefore of limited assistance because it is a notional assessment of the marks the subject of the application/registration that must be made in respect of the goods/services for which they have been applied for/registered. I give a brief summary of the evidence below, but will comment further upon it when the issues that need to be determined are evidence relevant.

Ascertiva's evidence

5) The evidence is given by Alan Charlton who works for Ascertiva as head of the Puragen brand. Ascertiva is an off-shoot of the National Inspection Council for Electrical Installation Contracting. Various changes of structure and name took place leading to the change of name to Ascertiva in 2010. The company is described as a third party certification company. PURAGEN is its newest brand, the idea for which was first considered in late 2009. Ascertiva was operating a certification scheme in the field of installation of renewable energy systems. A gap in the market for a reliable and reputable supplier of renewable energy systems was identified. The use of the mark was to be via franchisees due to the number of installers needed to cover the UK. Ascertiva was not in a position to grant its first franchise until the end of 2011.

6) The PURAGEN service is described as a one-stop shop for renewable energy services, incorporating energy assessments, design, planning, installation, maintenance and repair. Although Ascertiva does not manufacture the renewable energy technology itself, the customer will deal only with the Puragen brand and will consider that everything provided is under that brand. Franchises were granted on 4 October 2011, 19 October 2011, 10 May 2012 and 14 June 2012. A list of towns throughout the UK is given of where the services are currently offered and marketed. To date (the evidence is given on 10 January 2013), 43 installations have taken place. The combined turnover equates to £287,384.

7) Mr Charlton states that public awareness of PURAGEN has developed rapidly due to the use of franchisees, investment in advertising (national and local, a website, exhibitions, billboard and newspaper campaigns). Each franchisee must invest 5.5% of its turnover into advertising. It is stated that purchasing a system of this type is a significant decision and customers take a more than average level of care in identifying a service provider.

8) Mr Charlton states that, as far as he knows, Puragen has never been confused with Puregen. He states that as far as he is aware Halyard's brand is not aimed at the public at large but a very small sector of it. He states that Halyard's business appears to be aimed at those who have a super yacht and wish to purchase a particular engine component for it; he adds that this is quite different from what is offered under the PURAGEN mark.

9) Evidence is also given by Mr Mark Smith, Head of Group Marketing for Ascertiva. He gives further information about the build up to the launch of the PURAGEN service. There is nothing I need to add to this evidence summary which impacts upon the substantive matters. In relation to Halyard, he states that prior to the commencement of these proceedings he was unaware of Halyard or its PUREGEN product. He states that it is a niche product unlikely to cause confusion with PURAGEN. Also provided is a Google print for PUREGEN (Halyard is the 6th listed hit, the hit is not on page 9 of the exhibit as the witness states) and prints from Halyard's website. He states that PUREGEN is a brand offered under the HALYARD brand and from information on the website only 25 products have been sold worldwide.

10) Evidence is also given by Keith Gittis who is a business development manager at Fulcrum (21) Limited. One of his jobs is to engage with potential customers to secure leads and orders for PURAGEN systems. He estimates that he engages 30-40 people per week, people who are seriously considering a renewable energy system. He states that customers see this as a major investment, similar to buying a car or new kitchen. Customers are organised in approach, often with 3 or 4 phone calls or home visits undertaken before proceeding. The purchase cost is around £6000 so decisions are not made quickly, with referral/reviews being perused.

Halyard's evidence

11) The evidence is given by Mr Richard Summers, Halyard's managing director. He explains that the business offered under the mark relates to products (and sometimes their installation) which manage engine noise, smoke and vibration in water bound vessels. The mark was first used in 2009 in relation to an exhaust system. The current product removes soot from exhaust gases. He explains that Halyard has plans to develop the product into other areas in respect of generators outside of the marine field (e.g. in hospitals, the automotive industry, infrastructure projects, cell towers etc). He states that Ascertiva's belief that there

will be no confusion does not take into account these future plans, or the closeness of the marks. He suggests that there could be an overlap as if someone can afford a £6000 renewable energy system they could also afford to own a boat.

12) Mr Summers comments upon some of Mr Charlton's points regarding the use of PUREGEN i.e. that it is sold under the HALYARD name. Mr Summers disagrees, but this is not particularly pertinent given that the earlier mark consists solely of the word PUREGEN and this is what must be compared. He states that no reference has been made to the goods as registered.

Section 5(2)(b) – the legislation and the leading case-law

13) Section 5(2)(b) of the Act 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.”

14) The Court of Justice of the European Union (“CJEU”) has issued a number of judgmentsⁱ which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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 or 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;

(e) 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;

(f) 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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

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

(j) 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;

(k) 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."

The earlier mark and the notional assessment

15) There is no dispute that Halyard's mark qualifies as an earlier mark, as per section 6 of the Act. Neither is it in dispute that the earlier mark is not subject to the proof of use provisions found in section 6A of the Act. The consequence of this is that the earlier mark is to be compared on the basis of its full range of goods. It is the notional use of PUREGEN for its registered goods that is to be considered against the notional use of PURAGEN for its applied for goods and services. Ascertiva has referred to an absence of confusion; I will return later to this point and indicate its pertinence, or otherwise.

Comparison of goods/services

16) When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon*

Kabushiki Kaisha v. Metro-Goldwyn-Mayer the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

17) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

18) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v*

OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

19) In relation to complementarity, I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying to rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

20) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². However, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

21) I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

22) The earlier mark is registered for the following goods:

Class 7: Machines and machine tools; Motors and engines (except for land vehicles); Machine coupling and transmission components (except for land vehicles); Agricultural implements other than hand-operated; incubators for eggs; exhausts, exhaust filters, exhaust cleaners, exhaust scrubbers, and apparatus and instruments for removing particles, contaminants, pollutants and other materials from exhaust gasses; including all the aforesaid goods for use with engines and generators and with marine engines and generators; exhausts, exhaust filters, exhaust cleaners, exhaust scrubbers, and apparatus and instruments for removing particles, contaminants, pollutants and other materials from exhaust gasses; including all the aforesaid goods for use with vehicles, apparatus for locomotion, watercraft, engines and generators and with marine engines and generators; power and electricity generators; parts and fittings for all the aforesaid goods.

Class 12: Vehicles; apparatus for locomotion by land, air or water; engines for land vehicles; parts and fittings for all the aforesaid goods

23) Although all of the above goods are borne in mind in the assessment, it is fair to say that most of the discussion at the hearing focused on the terms "machines" and "generators" in class 7. Before moving forward with the analysis, I highlight a point argued by Mr Pritchard. He argued that the term "machines" within the term "machines and machine tools" was not a term that covered every type of machine (not even every type of machine in class 7). He felt that the context of the expression (positioned alongside machine tools) meant that it would only cover types of machinery such as lathes, industrial machinery etc. It would not, he argued, cover every type of product that could be categorized as a machine. Mr Bartlett, as I do, disagreed. The inclusion of the words "and machine tools" does not taint the term "machines" with a more limited context. The term covers, in my view, anything which is a machine (in class 7) regardless of its function or purpose. Mr Pritchard also appeared to approach the term "power and electricity generators" in the earlier mark on the basis of a diesel type generator. However, this would, again, be artificially limiting the scope of the term; the term would cover a variety of generators including those with capacity for using renewable sources.

24) There was some discussion regarding part of Ascertiva's evidence which indicates (on page 52 of its paginated evidence) that certain companies in the renewable sector are starting to establish a brand reputation, one of whom is British Gas. The point was raised by Mr Bartlett as support for the proposition that traditional energy companies (such as British Gas) may also operate in the renewable sector, despite Mr Pritchard's argument that those involved with renewables were part of a distinct market. Whilst this one document is not particularly telling, it at least supports my own view that companies in the renewables sector are likely to be mixed – there will be some that focus exclusively upon renewables and some that do so in conjunction with more traditional energy provision. The same page also highlights “competitors” of Ascertiva including: B&Q, Homebase & Tesco. I do not read too much in to this evidence as what competing products these competitors sell is not detailed and, further, such companies sell such a huge range of goods that any argument in relation to overlapping trade channels is not significant on the basis of this evidence.

25) It should be noted that in its counterstatement Ascertiva accepted that its goods in classes 7, 9 & 11 were similar to the class 7 goods of the earlier mark, but denied any similarity in classes 4, 35, 37, 39, 40 and 42 with any of the goods of the earlier mark. Whilst this partial acceptance is noted, it is still necessary to decide upon the level of any similarity. The applied for goods and services are lengthy and varied. I will therefore breakdown them down, grouping them together (although not necessarily in the exact order of the listed specifications) when it is useful to do so:

Class 7

Generators of electricity, including wind and photovoltaic generators; wind powered electricity generators;

26) The earlier mark includes the unqualified term *power and electricity generators*. Both sets of goods are, thus, generators that produce electricity. I do not consider that the generators covered by the earlier mark should be limited to any particular type of generator. As I have said, the term is unqualified. Therefore the generators covered by the earlier mark could be of the exact same type as the applied for terms. **The goods are considered identical.**

Apparatus, machines and installations for power, electricity or heat generation; machines for generating energy from biomass combustibles

27) To the extent that the applied for terms are described as machines, they must be considered identical to the term “machines” in the earlier mark. Furthermore, the earlier terms “power and electricity generators” would also cover the applied for terms (including the expressions which do not use the term machines) as the above expressions are simply other ways of referring to

generators. **The goods are considered identical.** The one minor wrinkle is the term “apparatus.... and installations for heat generation” which could be argued is not covered by the term “power and electricity generators” and they are not described as machines. However, if it is possible to have a machine which is used for heat generation (the applied for term includes machines for heat generation) then such goods would, even if they are not identical, be **similar to the highest possible degree** to the apparatus and installations for heat generation.

Wind turbines for power generation

28) The earlier mark covers “power generators” unqualified so it would encompass the above within its ambit. The term could also be classed as a machine. **The goods are considered identical.**

Heat pumps

29) This strikes me as some form of machine which is used for the pumping of heat. **The goods are considered identical.**

Apparatus for rainwater harvesting and filtration machines

30) In so far as filtration machines are concerned, this falls within the ambit of machines, **the goods are considered identical.** In relation to apparatus for rainwater harvesting, this would include not just pipes and storage facilities, but could include machine like apparatus for facilitating the harvesting function. **The goods are therefore identical or, if not, similar to a very high degree.**

Components of the aforesaid apparatus

31) The earlier mark also has parts and fitting for its goods, goods which I have found to be largely identical (or if not highly similar). In view of this the **components are also considered to be identical (or if not highly similar).**

Systems for using, storing and transformation of primary energy

32) Such terms appear to be related to power and electricity generators and serve a similar or at least a complementary purpose. The applied for goods could also be types of machines. **I consider the goods to be highly similar.**

Information, advice and consultation in relation to the aforesaid.

33) The above term creates something of a problem in that it is a service but it has been placed in a goods class. However, the services relate to goods which I have found to be largely identical (or if not highly similar) **and I consider the**

services to be reasonably similar on a complementary basis. I will deal with the issue of misclassification later, if it becomes necessary to do so.

Class 4

Electricity; electric energy; solar energy; biomass; fuels

34) Mr Pritchard drew a distinction between electricity and electric energy on the one hand, and solar energy, biomass and fuels on the other, albeit still arguing that none of the applied for terms were similar to the goods of the earlier mark. However, I see no great distinction. The above goods are, of course, completely different in nature to the goods of the earlier mark. However, machines (particularly those that relate to power generation) and generators serve a similar purpose in that the aim is to provide the user with energy/power of one form or another. It could be said that the goods of the earlier mark produce the goods of the applied for mark in this class, however, this would be too simplistic. The more accurate view is that the goods of the earlier mark represent an alternative to purchasing the goods in this class, either because the user is unable to obtain electricity (or other form of energy/power) due to location or, perhaps, because by using the goods of the earlier mark there will be less of an environmental impact (such goods are covered by both the term machines and generators). There is therefore a clear aspect of potential competition. There was a discussion of the route to market, however, traditional energy companies could supply all of the applied for goods and they could supply power generators as part of a renewable energy package. **The goods are reasonably similar.**

Class 9

Products and installations for the generation of electricity, in particular from renewable energy sources such as energy from the sun, wind, biomass, water and geothermics; solar energy panels; solar cells for electricity generation; solar electricity installations for supplying energy to commercial, residential and industrial premises; machines and installations for collecting, processing and handling photovoltaic energy and solar power

35) The above goods are for the generation of electricity and thus serve a similar function to the generators in the earlier mark and, also, to machines (to the extent that the machines could be used for similar purposes). The nature may not be quite the same as their classification in class 9 means that they are different in some way, although, they could still be variations on a theme, the theme being various renewable energy generating items. The users will be the same. They could easily be purchased through the same channels. **I consider there to be a high degree of similarity.**

Apparatus and instruments for conducting, switching, transforming, accumulating, regulating, saving or controlling electricity; all for domestic and industrial end user customers

36) The above goods could all be part and parcel of a renewable energy system as could the power generators of the earlier mark. They serve a related purpose of a complementary nature. **There is at least a moderate degree of similarity.** (Of course, I have borne in mind that some level of similarity had already been accepted).

Parts and accessories for the aforesaid

37) Where I have found the “aforesaid” goods to be similar to goods of the earlier mark, then it is likely that the parts and accessories for those goods are **also similar to the goods of the earlier mark, at least to a moderate level.**

Information, advice and consultation in relation to the aforesaid.

38) Subject to the point I made earlier about incorrect classification, I consider, as above, that where I have found the “aforesaid” goods to be similar to goods of the earlier mark, then it is likely that the services relating to those goods are also **similar to the goods of the earlier mark, at least to a moderate level.**

Class 11

Solar panels (heating), solar collectors

39) Such goods serve a similar function to generators (which include generators which make use of renewable sources), will have the same users, and will be competitive. Whilst the nature may not be exactly the same, this is not enough to counter the points of similarity. **The goods are reasonably similar.**

Heat pumps, namely air, geothermal heat, electric, gas, solar and water heat pumps

40) As stated earlier, heat pumps can be a type of machine proper to class 7, consequently they are likely to be similar to heat pumps in class 11, serving a similar function, having the same users, they may compete and they may be purchased through the same channels. **The goods are reasonably similar.**

Installations for using rainwater, including rainwater filtering apparatus;

41) In class 7 Ascertiva has applied for “*apparatus for rainwater harvesting and filtration machines*” which is clearly similar to the term above. That is, of course not the comparison to be made as the comparison must be made with the goods of the earlier mark. However, the breadth of the term “machines” in the earlier

mark covers machines intended for rainwater harvesting and filtration and, **consequently, they are also at least reasonably similar.**

Machines and apparatus for the conversion of waste to energy, in particular apparatus for the combustion and gasification of biomass and waste

42) The above strikes me as another form or renewable energy apparatus and, as previously expressed, is to be regarded as at least reasonably similar to generators and machines covered by the earlier mark.

Information, advice and consultation in relation to the aforesaid.

43) Subject to the point I made earlier about incorrect classification, I consider, as above, that where I have found the “aforesaid” goods to be similar to goods of the earlier mark, then it is likely that the services relating to those goods are also **similar to the goods of the earlier mark, at least to a moderate level.**

Class 35

Business administration and management services; business administration and management support services provided to others including to owners of franchised businesses; business services including the management and running of a franchise network

44) Mr Bartlett’s argument here was that the above services could relate to the goods of the earlier mark and that the same sectors/users were involved. If similarity were to be found on that basis then the above terminology would be similar to everything in every class. That cannot be right. The above services are, effectively, business to business services to assist/advise on the running or management of a business. This is, in no way shape or form, similar to a machine or a generator in terms of purpose, nature, trade channels etc. The goods/services are not in competition nor are they complementary. **There is no similarity.**

Advertising and promotional services

45) The comments made in the previous paragraph apply here also. The fact that goods can be advertised or promoted does not make those goods similar to an advertising or promotional service. **There is no similarity.**

Retail services in connection with the sale of electricity generating plants in particular apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating, saving or controlling electricity; all for domestic and industrial end user customers

46) This relates to the retail sale of electricity generating plant, the retailed goods being either identical or reasonably similar to the goods of the earlier mark. The relationship between retailing on the one hand and the retailed goods on the other has been held to give rise to a complementary relationship³. **I consider that these services should be regarded as reasonably similar to the goods of the earlier mark.**

Information, advisory and consultation services in relation to the aforesaid.

47) I consider such a term to sink or swim in accordance with the “aforesaid” services.

Class 37

Construction, supply and installation of electricity generating plants in particular in the renewable energy sector, including the construction, installation, maintenance and servicing of apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating, saving or controlling electricity; all for domestic and industrial end user customers; information, advisory and consultation services in relation to the aforesaid.

48) The earlier terms include generators (which cover those used with regard to renewable energy) and machines (which could also be for use in the renewable energy sector). Such goods could form a key part of the generating plant referred to in the applied for services. I come to the view that there is a key complementary link between the goods of the earlier mark and these services. **There is a reasonable degree of similarity.**

Class 39

Supplying of renewable and non-renewable energy; distribution of energy and/or power from renewable sources;

and in class 40

Generation of energy and electricity, in particular in the field of renewable energy

49) Energy suppliers and distributors (and electricity generators) are so closely linked with the energy that they supply that the analysis is very much akin to that already made in paragraph 34. A consumer may face a similar competitive choice between going to an energy supplier/distributor for energy or, alternatively, to purchasing a generator or machine that serves a similar purpose. **I consider there to be a reasonable degree of similarity.**

³ See, for example, *Oakley Inc v OHIM*, Case T-116/06.

Class 39

Information, advisory and consultation services in relation to the aforesaid.

50) I consider such a term to sink or swim in accordance with the “aforesaid” services.

Class 40

Provision of information and data on renewable energy generation installations; information, advice and consultation services relating to the production of energy from renewable sources.

and in class 42

Design, planning and project management of installations for generating and/or distributing electricity and/or heat, in particular from renewable energy sources; design of apparatus, instruments and equipment for conducting, switching, transforming, accumulating, regulating, saving or controlling electricity; technical planning and consultancy in the fields of renewable energy and photovoltaic/solar installations and electrical systems; energy audit services; all for domestic and industrial end user customers.

51) As I have already stated, the goods covered by the earlier mark include goods which could relate to the renewable energy sector and could be used for generating such energy. All of the above services seem to me to have a complementary relationship with such goods. To highlight the potential, I note that Ascertiva’s own evidence refers to it as providing a one-stop shop for various goods and services. The provision of the goods is likely to come following, or in conjunction with, the provision of the above services. **There is at least a moderate degree of similarity.**

The average consumer

52) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can vary, depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). Mr Bartlett accepted that for most of the goods and services (accept perhaps power supply apparatus) there would be a slightly higher than average level of care and attention. I would pitch it somewhat higher than this. The goods and services are well-considered and thought out purchases. They are not impulse or casual selections. The average consumer could be a member of the general public buying for the home, or a business buying for their premises; either way, a good deal of care will go into the purchasing/selection process. The goods and services are likely to be selected

by way of perusal of websites and brochures. They may also be selected following discussion with salespeople. Both visual and aural perspectives are important.

Comparison of the marks

53) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

PUREGEN v PURAGEN

54) The marks do not really break down into distinct and separate components. From a visual perspective, the marks are of identical length, each is made up of seven letters with 6 of those letters being shared and being shared in the same order. The only difference is the E for an A in the middle of the marks. Mr Pritchard accepted that there was a high degree of visual similarity. My conclusion on the matter is that whilst the E for an A creates a difference, the impact of this difference is not huge on the eye; I consider there to be a very high degree of visual similarity. In terms of aural similarity, a similar analysis can be made. The question arises as to what impact the E for an A has in the pronunciations. PUREGEN is likely to be pronounced as PURE-JEN. PURAGEN is likely to be pronounced as PURER-JEN (“purer” as in “more pure”.) The pronunciation of the latter is of three syllables (which I understood Mr Bartlett to accept), the former two. Mr Pritchard was keen to stress this difference and that the aural differences were noticeable. However, whilst I bear this in mind, overall, the similarities are still strong and whilst there may be slightly less aural similarity than visual similarity, I still regard there to be a reasonably high degree of aural similarity.

55) From a conceptual perspective, when the context of the (conflicting) goods/services is borne in mind, the average consumer is likely to see a suggestive meaning behind both marks – the concept is of PURE or PURER energy generation. Both marks incorporate this similar context in a similar way, producing marks of similar conceptual construction. I consider that there is a high degree of conceptual similarity. Mr Pritchard accepted that there was a “relatively high degree of conceptual similarity”, albeit it in a weak concept. I should add that even if the average consumer does not see a suggestive meaning, then the marks would be seen as invented words and there would not, therefore, be any conceptual difference to counteract the visual and aural similarity.

The distinctiveness of the earlier mark

56) The more distinctive the earlier mark, the greater the likelihood of confusion. Distinctiveness can come from the mark's inherent characteristics or from the use that has been made of it. The use made is limited, I did not understand Mr Bartlett to argue that the use made enhanced the earlier mark's distinctiveness. In terms of inherent qualities, I have already indicated the suggestive meaning behind the mark. Mr Pritchard considered the degree of distinctiveness to be weak. Whilst the suggestive meaning that I have described rules out the mark from being highly distinctive, it does not follow that the mark is low in inherent distinctive character. The contraction of the word GENERATION to GEN, together with the conjoining of the word GEN to the word PURE creates, in my view, a mark of average distinctive character.

Likelihood of confusion

57) The factors assessed have a degree of interdependency. A global assessment of them must be made when determining whether there exists a likelihood of confusion. There is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

58) Ascertiva mentioned in its evidence that no confusion has arisen between the respective marks in the marketplace. The point was picked up by Mr Pritchard in his skeleton argument. Such claims are not often helpful⁴. In this case, that there has been no confusion is not surprising given that the actuality of the trade (at least Halyard's trade) is limited in nature and has occurred in respect of a very niche product (which removes exhaust soot from the engine of a yacht). As this does little to represent the notional assessment that must be made, this argument does not assist.

59) The degree of care and consideration used when selecting the goods/services is an important factor because the greater the level of attention used by the average consumer then the less likely it is that confusion will arise – this is because the average consumer, through their level of attention, is more likely to notice differences between marks and that they will be less susceptible to the effects of imperfect recollection. However, I must bear in mind that many of the goods and services are identical or highly similar and that there is a very high degree of visual similarity, a reasonably high degree of aural similarity and a high degree of conceptual similarity. The earlier mark also has an average degree of distinctiveness. The latter point deals with Mr Pritchard's submission that when weak marks are involved, smaller differences are more important; I do not consider that weak marks are involved. In any event, even if the marks were considered weak, the degree of similarity between them is high. Having weighed

⁴ See, for example, *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283

the relevant facts, I come to the view that in relation to those goods and services I have identified as being identical or highly similar, there is a likelihood of confusion. Put simply, the marks are too close to avoid confusion even when the degree of care and attention is factored in.

60) In relation to the less similar goods and services, I come to the view that there is still a likelihood of confusion. The goods and services will be seen as some form of ancillary product or service offered on a complementary basis and the average consumer will believe that the goods and services come from the same undertaking given the closeness of the marks. The goods/services will be seen as part of a range of goods/services offered by one undertaking to meet, for example, the average consumer's renewable energy needs. In relation to the services that I found not to be similar, there is no likelihood of confusion⁵.

Outcome

61) The opposition succeeds in respect of all of the goods and services save for:

Business administration and management services; business administration and management support services provided to others including to owners of franchised businesses; business services including the management and running of a franchise network; advertising and promotional services; all for domestic and industrial end user customers; information, advisory and consultation services in relation to the aforesaid.

62) Given the outcome, there is no need to deal with the issue of the misclassification of certain services because I have refused registration in respect of them.

Costs

63) Halyard having been (largely) successful, it is entitled to a contribution towards its costs. Although the opposition failed on some of the services in the class 35 specification, this is but a small part of the conflict. My assessment of costs is as follows:

Preparing a statement and considering the other side's statement:	£300
Filing evidence	£500
Attending the hearing	£600
Opposition fee	£200

⁵ See, for example, *Waterford Wedgwood Plc v OHIM* case C-398/07.

Total:

£1600

64) The Ascertiva Group Limited is to pay Halyard (M & I) Limited the sum of £1600. 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 30th day of October 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**

ⁱ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [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 + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).