O/0231/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3596726
IN THE NAME OF ENGINEERED CONTROLS INTERNATIONAL, LLC

TO REGISTER AS A TRADE MARK

PRESTO-TAP

IN CLASSES 6, 9 AND 11

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 424393
BY LES ROBINETS PRESTO

BACKGROUND AND PLEADINGS

1. On 17 February 2021, Engineered Controls International, LLC ("the applicant") applied to register **PRESTO-TAP** as a trade mark in the United Kingdom, claiming priority from US trade mark ("USTM") No. 90524805 and USTM No. 90524799, both of which have a priority date of 11 February 2021. The application was accepted and published for opposition purposes on 16 April 2021, in respect of goods in classes 6, 9 and 11.[1]

2. The application is opposed by Les Robinets Presto ("the opponent"). The opposition was filed on 12 May 2021 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application. The opponent relies upon the following mark:

PRESTO

UK trade mark registration number 1581128
Filing date: 9 August 1994
Registration date: 23 March 2001
Registered in Class 11
Relying on all goods, namely:

Class 11: *Sanitary apparatus and installations and parts and fittings for all the aforesaid goods.*

3. The opponent submits the applicant's mark is visually, phonetically and conceptually highly similar to the earlier mark and that the applicant's goods in classes 6, 9 and 11 are similar to the goods in class 11 of the earlier mark. It submits

[1] I note that on 12 June 2023, the applicant filed form TM21B to request that the class specifications in all three classes be limited to those goods listed in paragraph 41 of this decision. In an official letter, dated 5 July 2023, the opponent was requested to confirm whether the amended specification was sufficient for it to withdraw its opposition. As no response was received, in a letter dated 26 July 2023, the Registry confirmed to the parties that the opposition proceedings would continue.

that there is a likelihood of confusion on the part of the public, and it requests that the application be refused and that costs are awarded to the opponent.

4. The applicant filed a counterstatement denying the claims and putting the opponent to proof of use of its mark. It requests that the opposition be dismissed, with an award of costs made in the applicant's favour.

5. Both parties filed written submissions which will be referred to as and where appropriate during this decision; both parties filed evidence. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

6. In these proceedings, the opponent is represented by Wilson Gunn and the applicant is represented by Carpmaels & Ransford LLP.

EVIDENCE

The opponent's evidence

7. The opponent filed evidence by way of a witness statement dated 7 March 2023 in the name of Andrew Marsden, who is a Chartered Trade Mark Attorney of Wilson Gunn, being the appointed representatives of the opponent. Mr Marsden adduces six exhibits, labelled **Exhibit AM1** to **Exhibit AM6** accordingly.

8. The main purpose of the evidence is to demonstrate use of the earlier mark in relation to the goods being relied upon in the UK throughout the relevant period.

The applicant's evidence

9. The applicant filed evidence in support of the application by way of a witness statement, dated 15 June 2023, in the name of Paul A. Courson. It is accompanied by three exhibits (labelled **Annex 1** to **Annex 3** accordingly). Mr Courson is a Technical Director of the applicant, responsible for supplying training and technical assistance to distributors and propane gas marketers.

10. I have read and considered all of the evidence and I will refer to the relevant parts at the appropriate points in the decision.

DECISION

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

12. The trade mark upon which the opponent relies qualifies as an earlier trade mark under Section 6(1) of the Act. The opponent's trade mark had completed the registration process more than five years before the claimed priority date of the contested mark, and, as a result, it is, in principle, subject to the provisions on use under Section 6A of the Act. I note that on filing its Form TM8 Notice of Defence and Counterstatement, the applicant has required the opponent to provide proof of use of the mark for all the goods on which it relies, as listed under paragraph 2 of this decision.

Proof of Use

13. The relevant statutory provisions under Section 6A of the Act are as follows:

> (1) This section applies where
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

14. Section 100 of the Act states that:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it".

15. The relevant period during which genuine use must be shown is the five years ending with the claimed priority date of the contested application, which was 11 February 2021. The relevant period is therefore 12 February 2016 to 11 February 2021. As the opponent's mark is a UKTM, the territory in which use must be shown is the United Kingdom.

16. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

""105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze*

Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to

create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Evidence of use

17. Under the Section 5(2)(b) grounds, the opponent has claimed that use has been made of all of the goods on which it relies. I must consider whether, or the extent to

which, the evidence shows genuine use of the earlier mark in relation to the goods covered under class 11, being:

Sanitary apparatus and installations and parts and fittings for all the aforesaid goods.

18. I note the following from the opponent's evidence:

- The opponent is a French company who has sold sanitary apparatus and installations and parts and fittings of said goods to a variety of businesses in the UK. Under point 3 of the witness statement, Mr Marsden lists the names of nine such business customers.
- Exhibit AM1 comprises copies of 23 invoices issued to the nine different UK customers within the relevant period,[2] while exhibit AM2 is an example of a product order acknowledgement sent to the customer from the opponent. The invoices all contain the sign "PRESTO" in a stylised form at the top left-hand side; each shows a UK address for delivery and billing.
- Exhibit AM3 is described by Mr Marsden as comprising "WRAS product approval certificates" for several of the opponent's products.
- Exhibit AM4 is described by Mr Marsden as comprising a technical specification document from Reliance Water Controls Ltd (being one of the opponent's listed business customers) which details a PRESTO branded product.
- Exhibit AM5 contains extracts from the English language version product brochures (2016, 2017 and 2018). However, I note that there is nothing to show that these brochures are specifically directed towards the UK consumer.
- Exhibit AM6 lists product descriptions under the product codes of some (but not all) of the items shown on the invoices at exhibit AM1.

Form of the mark

19. The mark is registered for the stylised word PRESTO.

[2] The invoice details are also summarised in a table under point 4 of Mr Marsden's witness statement.

20. Section 46(2) of the Act states that:

> "… use of a trade mark includes use in a form ("the variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it is registered…"

21. As outlined in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12,[3] the use of the mark encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

22. The mark appears at the top of the invoices contained within exhibit AM1 with the registered trade mark symbol ® next to it, alongside an additional device element:

It is similarly displayed in the technical specification documents in exhibit AM5:

23. It is also used alongside what I consider to be secondary marks, with the "PRESTO" element functioning as the 'house brand', including, inter alia, "PRESTO Touch"; "PRESTO NEO"; "PRESTO PLP"; and "PRESTO SENSAO":[4]

[3] At [31 – 35].
[4] Exhibit AM6.

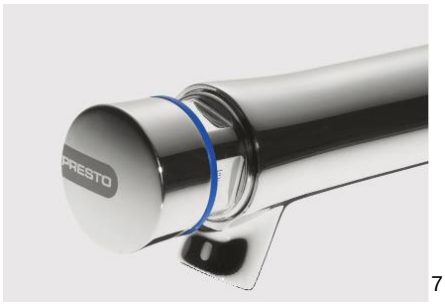
24. As outlined in *Lactalis McLelland Limited v Arla Foods AMBA,* Case O/265/22,[5] the use of the mark in a different form may also constitute use of the mark as registered.

25. Within the evidence, the mark is referred to in plain text as "PRESTO". It is shown at the top of the order acknowledgement page and the cover page of the catalogues adduced under exhibit AM5 thus:

PRESTO® and PRESTO

The mark can also be seen on the products themselves, for example

6



7

[5] At [13 – 15]. See also *Hyphen GmbH v EUIPO*, Case T-146/15, at [28-32].
[6] This is described as a urinal valve, which can be found on page 60 of 240 under exhibit AM5.
[7] See page 72 of 240 under exhibit AM5.

26. Despite the differences in presentation of the mark, and the additional device elements and secondary marks shown above, it is my view that the variances make no material difference to the distinctiveness of the mark, which continues to indicate origin and may be relied upon by the opponent.

Assessment on genuine use

27. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods and services at issue in the EU during the relevant five-year period. In making my assessment, I must consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

28. In its written submissions, the applicant submits that the use evidence is insufficient to support the earlier mark, and should be disregarded in its entirety and the opposition rejected accordingly. I do not intend to reproduce the applicant's submissions here, however, I have taken them into consideration when making my assessment on use. I also note the applicant's submissions that should the opponent's evidence be considered sufficient to support the earlier mark, that it only supports a subset of the registered goods, and therefore the scope of the mark should be narrowed.

29. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself. It is possible for an accumulation of evidence to show use, even if individual items of evidence would on their own be insufficient proof: see *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T- 415/09, paragraph 53.

30. I acknowledge that, as per the principles outlined under paragraph 16 of this decision, use of the mark must be more than token, although that use need not always be quantitatively significant for it to be deemed genuine.[8] I also bear in mind that it is not for me to assess economic success or large-scale commercial use, and that there is no *de minimis* rule - even minimal use may qualify as genuine use if it is use warranted, in the economic sector concerned, to maintain or create market shares for the relevant goods.[9] Conversely, even proven commercial use may not be sufficient for a finding of genuine use.[10]

31. The evidence provided in relation to genuine use of the marks is limited; for example, aside from the invoices, the exhibits do not clearly demonstrate that the goods were available for sale during the relevant period. Although I acknowledge that the product brochures are dated within the relevant period, they do not show how or to whom the brochures were circulated, although they do contain general sales terms and conditions, as well as contact details, being a telephone number, fax number and email address for "Offers, Assistance with product requirements, Project Monitoring and After-Sales Service".[11] No sales or turnover figures have been provided, neither do I have any figures outlining marketing spend. I have no evidence relating to the size of the corresponding sanitary installations market or the percentage market share enjoyed by the opponent.

32. There are many gaps in the evidence, however, the evidence does show use of the mark on the products themselves and the invoices show repeat buyers within the UK of the "PRESTO" goods during the relevant period. I note the value of sales shown of the individual invoices range from 343.20 euros to 65,039.24 euros, with the number of units being ordered in large quantities for many goods. At point 4 of his witness statement, Mr Marsden has provided the total value in euros of each of the invoices, dated between 21 March 2017 to 19 January 2021, which add up to the overall sum of 384,680.73 euros. To my mind, the invoices indicate that there has been commercial use of the mark "PRESTO" on the goods at hand within the relevant

[8] *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].
[9] *Naazneen Investments Ltd v OHIM*, Case T-250/13 at [49].
[10] At [115(8)].
[11] See, inter alia, pages 121-122 of 240 of Exhibit AM5.

period and within the relevant territory, and that these invoices are sufficient to demonstrate more than token use.

33. Having considered the evidence as a whole, it is my view that the opponent has done enough to demonstrate commercial exploitation of the earlier mark. I consider the evidence provided to be sufficient to allow me to find that there has been genuine use of sanitary ware under the mark on which the opponent relies, within the relevant period and within the relevant territory.

Fair specification

34. The opponent relies on the broad term "*Sanitary apparatus and installations and parts and fittings for all the aforesaid goods"*. As mentioned earlier, the applicant submits that if the evidence of use is accepted, the scope of the mark should be narrowed to the subset of goods for which use is shown, and which the applicant lists accordingly under paragraph 14 of its written submissions.

35. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C.(as he then was) as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

36. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the

specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; Thomas Pink Ltd v Victoria's Secret UK Ltd [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; Thomas Pink at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in Pan World Brands v Tripp Ltd (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; Thomas Pink at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. Maier v Asos Plc [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46."

37. I consider that the opponent's various goods as shown within the evidence, including taps, soap dispensers, shower heads and panels, would be perceived by the average consumer as sanitary apparatus and installations, or the parts and fittings thereof, and as such, I find that the opponent may rely upon all goods on which the opposition is based.

Section 5(2)(b)

38. Section 5(2)(b) is relied upon, which 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".

39. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

> (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 be dominated by one or more of its components;

(f) however, it is also 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 greater 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 to mind the earlier mark, 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

40. Pursuant to section 60A of the Act, goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

41. The goods to be compared are:

Opponent's goods
Class 11 *Sanitary apparatus and installations and parts and fittings for all the aforesaid goods.*
Applicant's goods
Class 6 *Valves, namely, valves for propane systems; none of the aforementioned for use as a permanent part of the bathroom, shower, kitchen or sanitary installation.*
Class 9 *Pressure and warning gauges for propane tanks which are designed to be applied to existing systems; none of the aforementioned for use as a permanent part of bathroom, shower, kitchen or sanitary installation.*
Class 11 *Gas manifold regulators, manually operated pressure regulators and parts therefor for gases, liquified gases, and cryogenic liquids, namely, pressure gauges, high pressure regulators, low pressure regulators, multi-stage regulators, single stage regulators; none*

of the aforementioned for use as a permanent part of bathroom, shower, kitchen, bathroom or sanitary installation.

42. In *Gérard Meric v OHIM,* Case T-133/05, the General Court ("GC") stated that:

> "In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".[12]

43. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

> "In assessing the similarity of the goods or services concerned, … 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".[13]

44. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat* ") [1996] R.P.C. 281 include an assessment of the users and of the channels of trade of the respective goods or services.

45. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

[12] Paragraph 29
[13] Paragraph 23

> "...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".[14]

46. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."[15]

47. The applicant submits that the goods in the earlier mark are not similar to the applicant's goods, especially in view of the limitation (across all three classes of the applicant's mark) that "*none of the aforementioned for use as a permanent part of the bathroom, shower, kitchen or sanitary installation"*.

48. The opponent submits that the respective goods have similar uses, users, nature and purpose and are likely to be available via similar trade channels.[16]

<u>The contested goods in Class 6</u>

Valves, namely, valves for propane systems; none of the aforementioned for use as a permanent part of the bathroom, shower, kitchen or sanitary installation.

49. I note that where the term "namely", has been used in the list of goods, the scope of protection is restricted to those named goods only, rather than encompassing all

[14] Paragraph 82
[15] Paragraph 5
[16] Point 6 of the opponent's written submissions dated 14 March 2023.

goods under the preceding wider term. The applicant's "*Valves, namely, valves for propane systems"* in Class 6 are therefore very specific. Given that propane relates to a fuel (gas), I would expect any goods that are used in connection with such systems to be highly regulated to meet strict quality and safety standards. As such, although the opponent's various "*Sanitary apparatus and installations and parts and fittings"* in Class 11 may include valves, I do not consider them to be interchangeable. The purpose of such valves are different, with different users and channels of trade. In my view, although I acknowledge that hardware stores may sell all types of valves, they are likely to be grouped together according to purpose, and as such, propane valves would not be found in close proximity to sanitary valves on shelves or even in the same aisles of retail outlets. The goods are neither complementary or in competition; any overlap in trade channels, or in the basic nature and function of the goods is therefore insufficient for a finding of similarity in a trade mark sense. I find the applicant's "*Valves, namely, valves for propane systems; none of the aforementioned for use as a permanent part of the bathroom, shower, kitchen or sanitary installation"* to be dissimilar to the opponent's "*Sanitary apparatus and installations and parts and fittings for all the aforesaid goods".*

The contested goods in Class 9

Pressure and warning gauges for propane tanks which are designed to be applied to existing systems; none of the aforementioned for use as a permanent part of bathroom, shower, kitchen or sanitary installation.

50. In *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 11, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods or services are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.[17] The opponent has not provided any evidence as to how the applicant's "*Pressure and warning gauges for propane tanks …"* in Class 9 may be considered similar to its own "*Sanitary apparatus and installations and parts and fittings for all the aforesaid goods"* in class 11. In the absence of evidence to the contrary, I do not consider there to be an overlap in the users of the applicant's goods in class 9 with the users of the opponent's goods in Class 11. I find the respective

[17] Paragraph 20

goods to be different in nature, purpose and method of use, and the goods are neither in competition, nor complementary in a trade marks sense. Any overlap in channels of trade is insufficient for me to find similarity between the goods. I therefore find them to be dissimilar.

The contested goods in Class 11

Gas manifold regulators, manually operated pressure regulators and parts therefor for gases, liquified gases, and cryogenic liquids, namely, pressure gauges, high pressure regulators, low pressure regulators, multi-stage regulators, single stage regulators; none of the aforementioned for use as a permanent part of bathroom, shower, kitchen, bathroom or sanitary installation.

51. I again note the use of "namely" following the terms "*Gas manifold regulators, manually operated pressure regulators and parts therefor for gases, liquified gases, and cryogenic liquids…"*, which limits the class 11 goods to various types of pressure gauges and regulators, although all the goods are already specified as being in connection with gases and cryogenic liquids. I acknowledge the limitation to the applicant's goods as "… *none of the aforementioned for use as* ***a permanent part*** *of bathroom, shower, kitchen, bathroom or sanitary installation"* (**my emphasis**). However, the limitation does not preclude the goods as being used as a temporary part of the various installations. I have not been provided with evidence from either side to show that such pressure gauges or regulators would not or could not be used in conjunction with sanitary apparatus and installations on a temporary basis. I further note that the applicant's evidence by way of Annex 1 shows use of the goods in relation to a "universal service tech kit", described as "leak detection system diagnostics from tank pressure to domestic water column", and which includes various gauges. This seems to support a similarity between the competing goods, rather than refuting it. In my view, the applicant's goods in Class 11 are likely to be similar in nature, method of use and purpose to the opponent's "*parts and fittings"* of its "*Sanitary apparatus and installations",* or complimentary to the extent that the average consumer could reasonably expect the competing goods to be provided from the same or economically linked undertakings. Overall, I consider the competing goods in Class 11 to be similar to at least a low degree.

52. A degree of similarity between the goods and services is essential for there to be a finding of likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA.

53. In relation to the goods which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such goods, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

54. The average consumer is a legal construct, who is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

55. In its written submissions, the applicant submits that the average consumer and end user of its own goods will be a trained and specialist propane gas professional who will pay a high level of attention to the goods, while it submits that the average consumer of the opponent's goods will be a project manager or the general public, with the goods being installed by professional plumbers.

56. I agree with the applicant that the end user of the overlapping goods in class 11 could include the general public, and that it is likely that the goods at issue will be purchased on their behalf by a qualified professional, such as a plumber, who will also carry out the installation or replacement of those goods.

57. The goods may be purchased through general hardware stores or from specialist suppliers, either online, through tele-sales, or in bricks and mortar stores. I consider the selection of the goods will be a predominantly visual one, although aural considerations will play a part. Considerations during selection of the goods will include the quality and suitability of the product to the consumers' specific needs, based on the range of goods available, as well as the cost of the goods. Overall, I

consider the average consumer will pay at least a medium level of attention to the selection of the goods.

Comparison of marks

58. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."[18]

59. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

60. The respective trade marks are shown below:

Opponent's trade marks	**Applicant's trade mark**
PRESTO	**PRESTO-TAP**

[18] Paragraph 34

61. The opponent submits that the marks are highly similar, with the dominant and distinctive part of each mark being the word “PRESTO”, and that the word “TAP” in the applicant’s mark is secondary, and descriptive of at least some of the applicant’s goods, namely taps/valves.

62. The applicant submits that the “TAP” element of its mark does not describe the pressure and warning gauges of the application, and as such, it cannot be regarded as lacking distinctiveness.

Overall impression

63. The opponent’s mark consists of the word “PRESTO” which is presented in capital letters. Although I do not consider that the typeface deviates from a standard font, the first three letters, P R E, seem to be angled slightly higher than the last three letters, S T O, making the word as a whole appear slightly askew. To my mind, the overall impression lies in the word “PRESTO”, the stylisation of which does little to contribute to the overall impression of the mark, although it is unlikely to go completely unnoticed.

64. The applicant’s mark consists of the words “PRESTO” and “TAP”, which are presented in capital letters and conjoined by a hyphen between the two words. Although consumers are likely to identify the meaning of the word “TAP” within the composite mark, “taps” per se are not included in the specification of goods. To my mind, due to the words being hyphenated, the overall impression rests in the combined words “PRESTO-TAP” which together would be seen as a unit, with the word “PRESTO” qualifying the subsequent word “TAP”.

Visual comparison

65. The marks share visual similarity by way of the word “PRESTO”, which makes up the entirety of the earlier mark and is wholly incorporated in the applicant’s mark. However, the additional hyphen and the word “TAP” in the applicant’s mark create a visual disparity between the marks. As mentioned previously, while the presentation of the opponent’s mark is unlikely to go completely unnoticed, it does not make a huge

visual impact on the mark as a whole. The word in common is situated at the start of the applicant's mark. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. Considering the position of the identical word "PRESTO", I consider the marks to be visually similar to a medium degree.

Aural comparison

66. The common element of the competing marks is the word "PRESTO" which would be pronounced identically in both marks. The opponent's mark would therefore be voiced as two syllables, "PRESS-TOE", while the applicant's mark would be pronounced in its entirety, as three syllables, "PRESS-TOE-TAP", rendering the marks aurally similar to a medium degree.

Conceptual comparison

67. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006][19].

68. As mentioned previously, I consider that the combined words "PRESTO-TAP" would be seen as a unit, with the word "PRESTO" qualifying the subsequent word "TAP". I further consider that the word "TAP" in the applicant's mark will be recognised as a dictionary defined word, and is likely to be perceived as highly allusive of goods such as *"… manually operated pressure regulators and parts therefor…"*, which may include a form of valve or "tap". Neither party has made submissions regarding any possible meaning of the common element of the competing marks, being the word "PRESTO". While the average consumer may associate the word as part of the phrase "hey presto", suggesting that something has been done easily, as if by magic, I consider that when considered solus, it will be perceived by a significant proportion of consumers as an invented word with no clear or recognisable semantic content. As

[19] Paragraph 56.

such, a conceptual comparison of the dominant common element “PRESTO” cannot be made.

Distinctive character of the earlier marks

69. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

> “23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

70. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

71. The earlier mark comprises the word “PRESTO”, which as mentioned earlier, is likely to be perceived as an invented word. The word does not describe the goods to which the mark is applied, and neither do I consider the mark to hold any allusive qualities in relation to such goods. Therefore I find it to possess a high degree of inherent distinctiveness.

72. Earlier in this decision I considered the evidence filed by the opponent to support genuine use of the mark, however, I found that evidence to be somewhat lacking. As a result, I do not consider that the earlier mark can be said to enjoy an enhanced degree of distinctive character by virtue of the use made of it.

Likelihood of confusion

73. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

74. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is

something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

75. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

76. Earlier in this decision, I found:

- Only the contested goods in class 11 to be similar (to at least a low degree) to the opponent’s goods, with the contested goods in class 6 and class 9 being considered dissimilar;

- The level of attention of the average consumer of the overlapping goods would be at least medium, with the goods being selected by predominantly visual means, although I did not discount aural considerations;

- The competing trade marks to be visually and aurally similar to a medium degree, while conceptually, the dominant element "PRESTO" would be seen solus as an invented word with no clear or recognisable semantic content, and therefore, a conceptual comparison of the word in common could not be made;

- The earlier mark to possess a high degree of inherent distinctiveness, although the evidence of use provided was insufficient to show enhanced distinctiveness through use.

77. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. I acknowledge the medium degree of visual and aural similarity between the marks, however, it is my view that the average consumer, being reasonably well informed and reasonably circumspect, will notice and recall the differences between the marks, particularly given that in the applicant's mark, the word in common "PRESTO" is hyphenated with the additional word "TAP". Consequently, even given any allusive or descriptive qualities attached to the "-TAP" element, I do not consider there to be a likelihood of direct confusion between the marks.

78. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion.

79. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

80. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold referred to the comments of James Mellor QC (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said (at [16]) that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Lord Justice Arnold added that there must be “a proper basis” for concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

81. I keep in mind the global assessment of the competing factors in my decision, and in particular the high degree of inherent distinctive character of the earlier mark, and the identity of the element “PRESTO” which is common to both marks. It is my view that it would not be unreasonable for the average consumer to perceive the addition of the hyphen and the word “TAP” in the applicant’s mark as being consistent with a sub-brand or brand extension of the opponent’s mark, or that they would assume that there is an economic connection between the undertakings. Consequently, I consider there to be a likelihood of indirect confusion in relation to all goods for which I found similarity.

82. The opposition under section 5(2)(b) of the Act succeeds in relation to the following goods only, being class 11 in its entirety:

Gas manifold regulators, manually operated pressure regulators and parts therefor for gases, liquified gases, and cryogenic liquids, namely, pressure gauges, high pressure regulators, low pressure regulators, multi-stage regulators, single stage regulators; none of the aforementioned for use as a permanent part of bathroom, shower, kitchen, bathroom or sanitary installation.

CONCLUSION

83. The opponent has been partially successful under Section 5(2)(b) of the Act in relation to the class 11 goods only, as listed under paragraph 82 of this decision. Subject to any successful appeal, the application by Engineered Controls

International, LLC may proceed to registration in respect of the remaining goods in class 6 and class 9, as follows:

Class 6

Valves, namely, valves for propane systems; none of the aforementioned for use as a permanent part of the bathroom, shower, kitchen or sanitary installation.

Class 9

Pressure and warning gauges for propane tanks which are designed to be applied to existing systems; none of the aforementioned for use as a permanent part of bathroom, shower, kitchen or sanitary installation.

COSTS

84. In these proceedings, both parties have enjoyed a share of success, with the greater part going to the applicant, who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 2/2016. I do not consider that the evidence submitted by the applicant in support of its defence had any positive bearing on my decision; further, the evidence provided by the opponent to show genuine use of the earlier mark was considered sufficient. Therefore, I make no award to the applicant for either preparing its evidence or for considering the opponent's evidence. Taking into account the partial extent of the success of the applicant, I have made a reduction to the costs to reflect this, and as such, I consider the following to be reasonable:

Considering the notice of opposition and filing a counterstatement:	£200
Preparing written submissions:	£200
Total:	**£400**

85. I therefore order Les Robinets Presto to pay Engineered Controls International, LLC the sum of £400. The above sum should be paid within twenty-one days of the

expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 19th day of March 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General