

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No. 707993
AND A REQUEST BY SUTER SPULTISCHWERK GMBH
TO PROTECT A TRADE MARK IN CLASSES 6, 11 AND 21**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 70363 BY HANSGROHE AG**

TRADE MARKS ACT 1994

**IN THE MATTER OF International Registration No. 707993
And a request by Suter Spultischwerk GmbH to protect a
Trade Mark in Classes 6, 11 and 21**

AND

**IN THE MATTER OF Opposition thereto under No. 70363
by Hansgrohe AG**

BACKGROUND

1. On 4 December 1998 Suter Spultischwerk GmbH, on the basis of a Swiss registration, requested protection in the United Kingdom of the following trade mark:



in relation to the following goods:

Class 6

Metallic construction materials for use in ventilation and air conditioning installations; non-electrical metallic cables and wires; ironmongery; small items of metal hardware; metallic tubes; valves; cocks; cocks for water pipes; and pipes for water pipes; water pipes; piping systems; ventilation and air-conditioning installation pipes; reinforcing materials for pipes; reinforcing materials and coatings for buildings; gutter pipes; branch pipes; nozzles; jets; pipe couplings; vats and containers; plugs; cornices; knobs (handles); pipe sleeves; pipe brackets; manifolds for conduits; hinges; washers; valves; sleeves; screws; nuts; fixed towel dispensers; poles; packaging containers; closures for containers; metal fittings for building and furniture fittings; metal grates; bars for railings; bottle caps; sealing caps; brackets; steel sheets; wire of base metal alloys; unwrought or semi-wrought brass; unwrought or semi-wrought steel; steel wire; cast steel; steel constructions; steel alloys; steel tubes; steel pipes.

Class 11

Sinks; ventilation hoods; ventilation apparatus and installation; steam generating apparatus and installations; water filtering apparatus; filters; laundry room boilers; hot plates; stoves for cooking; cooking apparatus and installations; electric cooking utensils; cooking rings; cookers; sanitary apparatus and installations, pipes (parts of sanitary installations); refrigerating apparatus and installations; taps for pipes; water pipe installations; mixer taps for water pipes; anti-splash tap nozzles and washers for water taps; regulating accessories for water appliances and water pipes; water heaters; wash basins; wash stands; water boilers; water filtering apparatus; water supply apparatus and installations; ice boxes; cold cabinets; fans; ventilators; evaporators.

Class 21

Household or kitchen utensils and containers, not made of or plated with precious metals; unworked or semiworked glass; glassware, chinaware and earthenware not included in other classes; dustbins; basins; cutting boards for the kitchen, bread boards; heat-insulated containers; kitchen receptacles, not of precious metal; vegetable dishes; broilers (cooking utensils); metal boxes for dispensing paper towels; soap dispensers; sifters (household implements), towel rails, sieves and dishes, not of precious metal; plate glass; earthenware; pots; feeding troughs; bowls, namely draining bowls, sink basins; baskets, namely baskets for crockery, baskets for peelings, draining grates.

2. An international priority date of 23 July 1998 is claimed.
3. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.
4. On 31 August 2000 Hansgrohe AG (previously Hans Grohe GmbH & Co KG) filed notice of opposition to the conferring of protection on this international registration. They are the proprietors of protected international registration No. 686317 for the mark SATINOX covering the following goods:

Class 11

Heating, steam generating, refrigerating, drying, ventilating apparatus, water supply and sanitary equipment, water heating systems, solar systems (not included in other classes), water treatment systems, mixing taps, taps and fittings for manual and automatic water inlet and outlet control; fixtures for wash-hand basins, bidets and kitchen sinks, bath and shower fixtures; showers shower cubicles, showers and shower fittings, shower heads and side showers, sanitary pipes, spray nozzles, shower bases; water inlet and outlet valves and fittings for sanitary basins, bathroom sinks, kitchen sinks, bidets, baths and showers; siphons, water inlet and outlet pipes; lighting apparatus; essentially metallic housings and linings as parts of shower cubicles; housings and essentially non-metallic linings as parts of shower cubicles; pipe fittings for sanitary installations; parts of the aforementioned products.

Class 20

Shaving mirrors, mirrors, cupboards with mirrors and bathroom cabinets; non-metallic valves other than machine parts; non-metallic wall arms; parts of the aforementioned products.

Class 21

Soap holders, glasses, toothbrush glasses, towel holders not of precious metal, toilet paper holders and toilet brush holders, toilet brushes, toothbrush holders, stands and rests for bath and toilet utensils, dental water jets as medical appliances.

They say that the respective trade marks are similar and are protected or applied for in relation to identical or similar goods such that there exists a likelihood of confusion. They rely on Section 5(2)(b) of the Act and seek refusal of the request for protection.

5. The international registration holders (for ease of reference I will refer to them hereafter as the applicants) filed a counterstatement denying the above ground.
6. Both sides ask for an award of costs in their favour.
7. Both sides filed evidence. The papers were reviewed by a Hearing Officer who indicated that he considered a decision could be reached without the need for oral submissions at a hearing. The parties were nevertheless reminded of their right to be heard or to make written submissions. In the event neither side requested a hearing but both filed written submissions. The latter are under cover of a letter dated 18 December 2002 from Marks & Clerk on behalf of the applicants and a letter dated 20 December 2002 from WP Thompson & Co on behalf of the opponents.
8. Acting on behalf of the registrar and with the above material in mind I give this decision.

Evidence

9. The evidence filed in this case is as follows:

Opponents' evidence in chief:

Witness Statement by Jennifer Margaret Maddox with exhibit 1

Applicants' evidence in support:

Witness Statement by Pamela Alison Melling with exhibits 1 – 2

Opponents' evidence in reply:

Witness Statement by Jennifer Margaret Maddox (no exhibits)

10. Ms Maddox's first witness statement is for the purpose of confirming details of the opponents' earlier trade mark. Ms Melling's witness statement provides the results of a register search for –INOX marks and shows how the applicants use their mark. Ms Maddox, in reply, comments on the register search. I will come to this material in a little more detail in my decision below.

The Law

11. The sole ground of opposition is under Section 5(2) of the Act which reads:

“(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

Sub-paragraph (b) applies here.

The case law

12. I have been referred to and accept that I must take into account the guidance provided by the ECJ in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77.

13. In addition reference has been made to *Raleigh International Trade Mark* [2001] RPC 11, where Geoffrey Hobbs QC, sitting as the Appointed Person, dealt with the approach to determining the likelihood of confusion. I draw on these cases in the course of what follows.

Distinctive character of the opponents' earlier trade mark

14. The distinctive character of the earlier trade mark is a factor that must be taken into account, *Sabel v Puma*, paragraph 24. As no evidence has been filed bearing on use of the opponents' mark, I can only base my consideration on the inherent characteristics of the mark in the context of the goods for which it is registered.

15. It is appropriate at this point to introduce some of the considerations that the applicants submit should be taken into account in assessing the opponents' mark (and later in the comparison of marks). Ms Melling has filed listings of pending and registered marks in the UK containing the suffix –INOX. As a result she submits that –INOX is not distinctive and “may be

disregarded for the purpose of assessing confusing similarity”. Her written submissions seek to explain why this might be the case. She exhibits a Google search and dictionary extracts indicating that INOX is the French word for stainless steel.

16. There is a fundamental problem here. If a party wishes to adduce material to indicate the meaning of a foreign language word used as an element in a mark then (unless it is a word that is likely to be commonly understood) it should in my view be the subject of evidence rather than an attachment to written submissions. On that basis it is arguable that the above material should be disregarded.

17. Even if that is too harsh a view of the matter I am not persuaded that it assists the applicants. What matters is public perception of the element –INOX and in particular whether familiarity with the French word or exposure to use of the word on products in the marketplace are factors conditioning the public’s response. There is no evidence before me that the public generally understands that INOX signifies stainless steel or that that word/element is in common use in the marketplace.

18. It is also a fundamental principle in the approach to marks that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Sabel v Puma, paragraph 23). On the material before me I do not accept that the public would attempt to isolate the –INOX element of the opponents’ mark and attach less weight to it because they ascribe to it the meaning the applicants suggest.

19. There is a further point. Although it is perfectly true that many of the items in the applied for specification can be made of stainless steel there are a very large number that are either clearly not made of stainless steel (glass, earthenware, chinaware etc) or need not be made of stainless steel. For this category of goods –INOX would be extremely unlikely to convey the suggested descriptive meaning.

20. I, therefore, approach the matter on the basis that SATINOX is an invented word; that it will be treated as such by consumers; and that there is no basis for assuming that consumers will attach less weight to any of its elements. In short SATINOX is to be regarded as an invented word and a very distinctive mark.

Similarity of marks

21. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by those marks bearing in mind their distinctive and dominant components, Sabel v Puma paragraph 23. The matter must be judged through the eyes of the average consumer of the goods/services in question, Sabel v Puma, paragraph 23. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant but rarely has the chance to make direct comparisons between marks. Imperfect recollection must, therefore, be allowed for, Lloyd Schuhfabrik v Klijsen Handel, paragraph 27.

22. In applying these principles it is necessary to have regard to the nature of the average consumer, the goods themselves and the purchasing process. The application in suit covers a

very wide range of goods. Some goods (household and kitchen items for example) are likely to be purchased by the public at large, others are more likely to be directed at a trade audience (metallic construction materials say) whilst others may meet either a domestic or commercial need (ventilating and air conditioning apparatus for example). Notional use will, therefore, cover a broad range of consumers. The nature of many of the items is that they are likely to be occasional purchases particularly where they are for domestic use. That reinforces the need to bear in mind sequential rather than concurrent encounters with the respective marks. Finally, by way of prefatory remarks, I regard imperfect recollection as having a particularly important part to play where invented words are concerned and consumers cannot distinguish on the basis of well understood (but different) meanings of otherwise similar words.

23. The opponents submit that:

- “3. It is well established in precedent law that, in comparing two trade marks, one must not dissect them into separate parts, but must view each mark as a whole. However, if one assumes that the purchaser will rely more heavily on the first syllable of the mark in order to identify it where the suffix is a common one, then the prefix is important in distinguishing the marks. The marks both share the same three letters SAT/STA and if one takes into account the fact that a purchaser does not generally have the benefit of comparing two marks side by side, there is a high degree of likelihood that a purchaser may mis-remember the marks. The overall impression of the marks is the same. SATINOX and STARINOX are not easy to tell apart even if one knows both marks. The addition of a device of a star in the applied for mark does not assist in distinguishing the two marks in question because stars are commonplace and are often used in relation to goods that sparkle or have a shiny surface as in the case of stainless steel goods.”

24. The applicants submit that:

- “32. A visual comparison of the trade marks shows that they share common features, namely the initial letter S and the suffix –INOX. It is submitted that this is insufficient for the marks to be held confusingly similar.
33. The attorney representing the Opponent has commented that the Applicant’s mark begins with the letters STA – whilst the Opponent’s mark begins SAT-. It is submitted that this is an artificial dissection of the marks. The judgement in the Sabel case as previously mentioned invites us to consider the “*distinctive and dominant*” components of the marks. It is submitted that the dominant part of each mark is the prefix, STAR- and either SAT- or SATIN- respectively. This leads to phonetic and conceptual differences which will be referred to further below. The Applicant submits that the prefix dominates the mark, firstly, because more emphasis is placed in speech on the initial component of the mark, and secondly, because the suffix is common in the relevant classes.”

25. Both these approaches run the risk of conducting the sort of analysis of marks that *Sabel v Puma* cautions against (*Sabel v Puma*, paragraph 23). On the other hand it is difficult to avoid some analysis in trying to articulate reasons as to why consumers will or will not approach marks in a particular way. As the Court of Appeal noted in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc*, [2002] EWCA Civ 1534:

“The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis.”

26. My own impression is that these marks create quite similar visual impressions. They are of roughly equal length, composed of three syllables and contain the same mix of letters at the beginning and ending of the marks. That visual similarity may be offset somewhat if the elements STAR or SATIN were picked out but I am disinclined to think that consumers would adopt this approach. The overall structure and appearance of the words suggests strong visual similarity. I have not lost sight of the star device which replaces the dot over the letter I in STARINOX. But it is not a visually dominant element; it is overwhelmed by the word within the overall presentation of the mark; and, as the opponents suggest, is not a particularly distinctive feature.

27. Phonetically similar considerations apply though the likelihood that the first element of the marks will be fully articulated may swing the balance of the argument back in favour of the applicants to some small extent.

28. Conceptually, as I have already indicated, I treat both marks as invented words. As neither yields a ready meaning there is no basis for distinguishing between them on this account. Equally it might be said they share little other than their inventedness. It seems unlikely that conceptual considerations play an important part in the public’s appreciation of marks of this kind.

Similarity of goods

29. The opponents submit that:

“4. The goods in the Opponent’s earlier registration in classes 11, 20 and 21 are goods which are identical, or in the alternative, similar to the goods in the application in suit. The Applicant and the Opponent clearly trade in the same goods which increases the likelihood of there being confusion in practice.”

30. The applicants indicate that their primary submission is that the marks are not confusingly similar and that, therefore, a detailed assessment of similarity of goods is not necessary. They add that:

“..... it appears the goods of interest to the Opponent are bathroom fittings whereas the Applicant’s products are for kitchen use. There is some overlap in the goods under the respective marks, although this is confined primarily to the area of sinks and taps.

The Judgement of the Court of 29 September 1998 in Case C-39/97, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*, (paragraph 23, published in the OJ OHIM No. 12/98, page 1407 *et seq.*) assesses similarity by considering the nature of the goods, their method of use and whether their end users may also be the same. It is submitted that this test is not of particular assistance given the nature of the goods in this case. Anyone using a kitchen or bathroom is potentially an end user of these products and they cannot be held similar simply by virtue of that fact.”

31. The above passage quite properly refers me to the CANON v MGM test which offers the following guidance:

“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 end users and their method of use and whether they are in competition with each other or are complementary ...”

32. In *British Sugar Plc v James Robertson Sons Ltd*, [1996] RPC 281 (TREAT) Jacob J also considered that trade channels should be taken into account.

33. The absence of any more detailed submissions on the respective sets of goods has not made the process of comparison an easy one. In addition to the guiding principles from CANON and TREAT I approach the matter on the basis that I must consider the full range of goods in the applied for specification against the full range of goods in the opponents’ specification. Furthermore terms must be given their natural meaning (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267) but there is no reason to give words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor (also *Beautimatic v Mitchell*). Finally the need to have regard to the practical application of terms in specifications was referred to in the TREAT case:

“When it comes to 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 trade. After all, a trade mark specification is concerned with use in trade.”

34. I go on to consider the individual Classes of the application.

Class 6

The opponents’ protected registration does not cover Class 6. Nevertheless there are a number of terms in the applicants’ specification which I consider to be similar to certain of the opponents’ Class 11 goods as follows:

Applicants’ goods	Opponents’ goods
Metallic construction materials for use in ventilation and air conditioning installations	Ventilating apparatus

and
ventilation and air conditioning installation
pipes

Valves; cocks; cocks for water pipes; and
pipes for water pipes; water pipes; piping
systems; reinforcing materials for pipes;
..... branch pipes, nozzles; jets; pipe
couplings; pipe sleeves; pipe brackets;
valves; sleeves; steel pipes

Water supply and sanitary
equipment, water heating systems,
the various specific products in the
water supply field within the
opponents' Class 11 specification
and parts of the aforementioned
products

Plugs

Parts of baths, showers, handbasins

Fixed towel dispensers

Towel holders

Class 11

I note that the opponents have a very broad specification covering heating, steam generating, refrigerating, drying, ventilating apparatus, water supply and sanitary equipment etc. most of the more specific items that follow in the body of the Class 11 specification are examples of goods that would be contained within these broad terms.

I regard most of the applicants' Class 11 goods as being identical or closely similar to the opponents' goods. In many cases identical wording is used. In other cases specific items such as the applicants' ice boxes and cold cabinets would come within the broad terms (in this example refrigerating apparatus) in the opponents' specification.

There are a few exceptions. "Hot plates; stoves for cooking; cooking apparatus and installations; electric cooking utensils; cooking rings; cookers;" do not appear to be similar to any of the items in the opponents' Class 11 specification (or for that matter Classes 20 and 21). I have considered whether such goods might be said to come within the term 'heating apparatus' but concluded that that would be stretching the term well beyond its normal meaning in trade.

Class 21

The opponents' goods in this class can be broadly categorised as being bathroom equipment and accessories. But some care is needed. 'Soap holders', for instance, whilst most commonly found in the bathroom may also be found in utility rooms etc and 'glasses' can cover a range of such items for the kitchen, the dining table and the bathroom. The other general point that needs to be made about the opponents' specification is that in the main it lists types of goods but not the materials from which they are made.

With those general observations in mind I find the following goods in the respective specifications to be identical or similar:

Applicants' goods

Household or kitchen utensils and containers, not made of or plated with precious metal

Glassware, chinaware and earthenware not included in other classes

Basins

Metal Boxes for dispensing paper towels

Soap dispensers

Towel rails

Dishes, not of precious metal

Earthenware

Sink basins

Opponents' goods

Soap holders, the various types of holders and stands and rests for bath and toilet utensils

Soap holders (which can be made from a variety of materials), glasses and the various types of holders

Soap holders and the various bath fixtures and fixtures for wash hand basins in the opponents' Class 11 specification

Towel holders, toilet paper holders

Soap holders

Towel holders

Soap holders (which are often in the form of dishes)

As a general term the applicants' goods may include any of the opponents' goods which could be earthenware

Clashes with the opponents' Class 11 goods

In addition to the above I consider that there is a low level of similarity in respect of the applicants' 'kitchen receptacles, not of precious metal'. That term could conceivably include a soap holder to the extent that such an item would be found in the kitchen. I will deal with the consequences of this low level of similarity when I come on to the issue of likelihood of confusion.

Likelihood of confusion

35. The likelihood of confusion must be appreciated globally taking account of all relevant factors (*Sabel v Puma*, paragraph 22). There is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either per se or because of the use that has been made of it (*Sabel v Puma*, paragraph 24). Mere association, in the sense that the later mark

brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2) (*Sabel v Puma*, paragraph 26). But, if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the Section (*Canon v MGM*, paragraph 29).

Finally in *Raleigh International* Mr Hobbs QC said:

“Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences.”

36. I have not found it easy to reach a view on the net effect of the similarities and differences between marks and goods in this case. In the event I have decided that there is a likelihood of confusion in respect of the identical and similar goods set out above. Where I have decided that there is at the most a low level of similarity between the goods (in the case, of kitchen receptacles) or uncertainty (where general terms such as ‘containers’ are used) I take the view that the opponents have not established the necessary likelihood of confusion.

Conclusion and costs

37. The application will be allowed to proceed for a restricted range of goods if, within 28 days of the expiry of the appeal period, the applicants file a Form TM21 restricting their specification as follows:

- Class 6 - Non-electrical metallic cables and wires; ironmongery; small items of metal hardware; metallic tubes; reinforcing materials and coatings for buildings; gutter pipes; vats and containers; cornices; knobs (handles); manifolds for conduits; hinges; washers; screws; nuts; poles; packaging containers; closures for containers; metal fittings for building and furniture fittings; metal grates; bars for railings; bottle caps; sealing caps; brackets; steel sheets; wire of base metal alloys; unwrought or semi-wrought brass; unwrought or semi-wrought steel; steel wire; cast steel; steel constructions; steel alloys; steel tubes.
- Class 11 - Hot plates; stoves for cooking; cooking apparatus and installations; electric cooking utensils; cooking rings; cookers.
- Class 21 - Unworked or semi-worked glass; dustbins; cutting boards for the kitchen, bread boards; heat-insulated containers; kitchen receptacles, not of precious metal; vegetable dishes; broilers (cooking utensils); sifters (household implements), sieves not of precious metal; plate glass; pots; feeding troughs; bowls, namely draining bowls; baskets, namely baskets for crockery, baskets for peelings, draining grates.

38. If the applicants do not amend their specification in accordance with the above the application will be refused in its entirety.

39. On the basis on which I have decided the matter both parties can claim a measure of success. This being so I decline to favour either side with an award of costs.

Dated this 24 day of February 2003

**M Reynolds
For the Registrar
the Comptroller-General**