

O-153-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 803367
BY VAILLANT GMBH
TO REGISTER A TRADE MARK IN CLASSES 9, 11 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 71071
BY CALOR GAS LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 803367
by Vaillant GmbH to register a trade mark
in Classes 9, 11 and 42**

and

**IN THE MATTER OF Opposition thereto
under No. 71071 by Calor Gas Limited**

BACKGROUND

1. On 24 April 2003 Vaillant GmbH applied to protect the trade mark CALORMATIC in Classes 9, 11 and 42 under the provisions of the Madrid protocol on the basis of registration in Germany. The International Convention Priority claim on this mark is 26 November 2002.

2. Protection is sought in relation to the following goods and services:

Class 09:

Physical, electric and electronic current control and adjustment instruments, for use in apparatus for lighting, heating, steam generating, cooking, cooling, drying, ventilating, ventilation and water ducts and pipes, water heaters, bath water heaters, boilers, burners, solar thermal systems and heat pumps.

Class 11:

Apparatus for lighting, heating, steam generating, cooking, cooling, drying, ventilating, ventilation and water ducts and pipes, water heaters, bath water heaters, boilers and burners.

Class 42:

Services of an engineer, technical consultancy for heating apparatus.


3. The application was subsequently published in the Trade Marks Journal and on 14 November 2003 Calor Gas Limited filed a Notice of Opposition under Section 5(2)(b) of the Act on the grounds that the mark applied for is similar to the following earlier trade marks owned by the opponent which cover identical or similar goods and services and there exists a likelihood of confusion on the part of the public –

Trade Mark No.	Mark	Date Registration Effective	Specification of goods and services
UK Trade Mark Registration. No. 1570029	CALOR	22 April 1994	Class 01: Gases and gas mixtures; gaseous mixtures; gases and gas mixtures, all for use in dispensing liquids; all included in Class 1.

			<p>Class 04: Fuels; fuel gas; gases and gas mixtures; all included in Class 4.</p> <p>Class 07: Beer pumps; drinks dispensing apparatus; apparatus for drawing up liquids under pressure; parts and fittings for all the aforesaid goods; all included in Class 7.</p> <p>Class 11: Apparatus and installations for generation of gases and gas mixtures; apparatus and installations for the supply of gas; parts and fittings for all the aforesaid goods; all included in Class 11.</p> <p>Class 37: Installation, repair, servicing and maintenance of gas supply systems and installations and of gas utilising apparatus, equipment, systems and installations; all included in Class 37.</p>
UK Trade Mark Registration No. 1132283	CALOR	18 April 1980	<p>Class 04: Liquefied fuel gas; all included in Class 4. Converted to Schedule IV.</p> <p>Class 06: Containers of common metal for gas, and parts and fittings therefor included in Class 6.</p> <p>Class 11: Apparatus and installations, all for lighting, heating, cooking, refridgerating and drying; parts and fittings for all the aforesaid goods; all being gas operated and included in Class 11.</p> <p>.....Cookers, hotplates, fires, boiling rings, geysers, and wash boilers, all being gas appliances; gas heated flat irons, lighting brackets, lighting pendants, gas burners, bunsen</p>

			<p>burners, gas pressure regulators, and gas valves.</p> <p>Class 12: Land vehicles and motors and engines therefor; parts and fittings included in Class 12 for all the aforesaid goods. entry cancelled under section 34 (1) (d) of the trade marks act, 1938, in respect of articles made of glass.</p>
European Community Trade Mark Registration No. 1758549	CALOR	5 July 2000	<p>Class 01: Gases and gas mixtures; liquefied gases; aerosol propellants.</p> <p>Class 04: Fuels; fuel gases; liquefied fuel gases.</p> <p>Class 06: Containers for gas; valves; parts and fittings therefor.</p> <p>Class 11: Gas powered and gas utilising apparatus, equipment and installations; apparatus and installations for lighting, refrigerating, cooling and air conditioning, all being gas operated; gas pressure regulators and gas valves; parts and fittings for all the aforesaid goods.</p> <p>Class 36: Insurance services.</p> <p>Class 37: Installation, maintenance, servicing and repair of gas containers and of gas supply, gas powered, gas operated and gas utilising apparatus, installations and equipment and parts and fittings therefor.</p> <p>Class 39: Transportation and distribution of gas.</p>

			<p>Class 42: Safety testing of gas containers and of gas powered, gas operated and gas utilizing apparatus, installations equipment and parts and fittings therefor.</p>
UK Trade Mark Registration No. 2313186	CALOR GAS	14 October 2002	<p>Class 01: Gases and gas mixtures; liquefied gases; aerosol propellants.</p> <p>Class 04: Fuels; fuel gases; liquefied fuel gases.</p> <p>Class 06: Containers for gas; valves; parts and fittings therefor.</p> <p>Class 11: Gas powered and gas utilising apparatus, equipment and installations; apparatus and installations for lighting, refrigerating, cooling and air conditioning, all being gas operated; gas pressure regulators and gas valves; parts and fittings for all the aforesaid goods.</p> <p>Class 37: Installation, maintenance, servicing and repair of gas containers and of gas supply, gas powered, gas operated and gas utilizing apparatus, installations and equipment and parts and fittings therefor.</p> <p>Class 39: Transportation and distribution of gas.</p> <p>Class 42: Safety testing of gas containers and of gas powered, gas operated and gas utilizing apparatus, installations equipment and parts and fittings therefor.</p>

UK Trade Mark Registration No. 1033944		12 August 1974	Class 04: Liquefied fuel gas.
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4. The applicant filed a Counterstatement denying the grounds of opposition.

5. Both parties have filed evidence and ask for an award of costs in their favour. They are content for a decision to be issued without recourse to a hearing. Written submissions have been forwarded by the opponent and applicant.

OPPONENT’S EVIDENCE

6. The opponent’s evidence consists of a witness statement by Alexander Davis dated 1 June 2004. Mr Davis is a director of Calor Gas Limited (the opponent company).

7. Mr Davis states that CALOR is the “house mark” of his company, was first used in 1935 and has been continuously used in the UK since that date. He adds that it has been used in relation to all the goods and services specified in its trade mark registrations.

8. Mr Davis sets out the following turnover figures resulting from sale of goods and services under the mark CALOR in the UK for the years shown:

Year	Turnover (£)
2002	215,626,679.83
2001	234,925,554.93
2000	209,829,768.45
1999	174,884,875.75
1998	168,171,655.02

and goes on to set out the following figures for the amount on advertising under this mark CALOR for the years shown:

Year	Amount (£)
2002	over 5 million
2001	over 5 million
2000	over 4.5 million
1999	over 6.5 million
1998	over 6.5 million

9. Mr Davis states that his company has promoted its goods and services throughout the UK by a variety of means including TV advertising, national press, magazines, local press, local radio, direct mail, trade press, exhibitions, leaflets and over the Internet. He adds that his company's website is www.calor.co.uk and that the goods and services of his company under the trade mark CALOR have been available over the Internet since January 2001.

10. Mr Davis goes on to refer to Exhibit AD1 to his statement, examples of Calor Media Information sheets showing use of the mark CALOR in the UK. These are dated between February 2000 and March 2004. This Media Information is produced by Calor Gas Limited and made available to UK journalists for national and regional media including press, TV, radio and the Internet. They refer to gas barbecues and patio heaters, gas storage systems and liquefied petroleum gas.

11. Next, Mr Davis draws attention at Exhibit AD2 to copies of various advertisements and articles appearing in various publications. He provides a detailed and lengthy list of these publications, which include the national and regional press and magazines relating to camping, caravanning, the home and the garden. These advertisements date from 2000 to April 2004.

12. Exhibit AD3 to Mr Davis' statement contains examples of various advertising leaflets and brochures produced by his company.

13. Mr Davis goes on to make a number of submissions on the similarity of marks position.

APPLICANT'S EVIDENCE

14. The applicant's evidence consists of a witness statement by David John Crouch dated 31 August 2004. Mr Crouch is a Registered Trade Mark Agent of Bromhead Johnson, the applicant's professional advisors in these proceedings.

15. Mr Crouch states that the applicant manufactures and sells heating equipment throughout the European Union.

16. Mr Crouch refers to Exhibit DJC1 to his statement, which are copies taken from the Community Trade Mark Register, the WIPO International Trade Mark Register and the United Kingdom Trade Mark Register showing trade marks owned by third parties, prefixed "calor". He states that, at least, Community Trade Mark No. 875377 for CALORIC and International Trade Mark No. 768846 for CALORSTAT cover goods in Class 11 which describe precisely those made and sold by the applicant.

17. Next, Mr Crouch draws attention to Exhibit DJC2 to his statement which is a copy taken from the Concise Oxford Dictionary of an extract defining the word "Caloric" as "of or relating to heat".

OPPONENT’S EVIDENCE IN REPLY

18. The opponent’s evidence in reply consists of a further witness statement by Alexander Davis. It is dated 30 November 2004.

19. Mr Davis states he does not believe there is a wide co-existence of marks in the UK with the prefix CALOR and that if his company became aware of use of marks which included the word CALOR in the UK in relation to goods and services that were similar to those of interest to it, it would take action against such use. Mr Davis states that the CALORSTAT and CALORIC marks referred to by the applicant are tolerated due to the limited nature of their specifications. He is not aware of use of the mark CALOR bloc in the UK. He adds that, in any event the comparison should only be between the marks CALOR and CALORMATIC.

20. Mr Davis goes on to say that he has reviewed the dictionary definition of “caloric” and points out that above this entry, is the entry “Calor Gas” which is noted as a trade mark in the UK. Mr Davis submits that the dictionary definition of “caloric” has no persuasive value in supporting the applicant’s case.

OPPONENT’S WRITTEN SUBMISSIONS

21. The opponent’s written submissions are in a letter dated 22 February 2005 from A.A. Thornton & Co, the opponent’s professional advisors in these proceedings.

22. In relation to similarity of marks, the opponent points out that the first five letters of the applicant’s mark are identical to the opponent’s mark and goes on to submit that the letters MATIC do nothing to distinguish the marks, particularly as the letters MATIC suggest that the goods are somehow automatic. The opponent adds that a search on a private database revealed 91 trade mark registrations with the suffix MATIC in Class 11. In the opponent’s view the CALOR element is the dominant portion of the applicant’s mark.

23. Turning to the issue of identity and similarity of goods and services, the opponent provides the following comparison summary –

Applicant’s Goods/Services	Opponent’s Goods/Services
Class 9: Physical, electric and electronic current control and adjustment instruments, for use in apparatus for lighting, heating, steam generating, cooking, cooling, drying, ventilating, ventilation and water ducts and pipes, water heaters, bath water heaters, boilers, burners, solar thermal systems and heat pumps.	Similar to goods in Class 11.
Class 11: Apparatus for lighting, heating, steam generating, cooking, cooling, drying, ventilating, ventilation and water ducts and pipes, water heaters, bath water heaters, boilers and burners.	Class 11: Gas powered and gas utilising apparatus, equipment and installations; apparatus and installations for lighting, refrigerating, cooling and air conditioning, all being gas operated; gas pressure regulators and gas

	<p>valves; parts and fittings for all the aforesaid goods.</p> <p>Apparatus and installations, all for lighting, heating, cooking, refrigerating and drying; parts and fittings for all the aforesaid goods; all being gas operated.</p>
<p>Class 42: Services of an engineer, technical consultancy for heating apparatus.</p>	<p>Class 42: Safety testing of gas containers and of gas powered, gas operated and gas utilizing apparatus, installations equipment and parts and fittings therefor.</p> <p>Class 37: Installation, maintenance, servicing and repair of gas containers and of gas supply, gas powered, gas operated and gas utilising apparatus, installations and equipment and parts and fittings therefor.</p> <p>Installations, repair, servicing and maintenance of gas supply systems and installations and of gas utilising apparatus, equipment, systems and installations.</p>

24. The opponent submits that the goods in Class 11 of the Applicant's mark are identical and similar to the goods in Class 11 of the Opponent's marks. Additionally, the services in Class 42 of the Applicant's mark are similar to those in Class 42 and Class 37 of the Opponent's marks as safety testing and installation, maintenance and repair services are services which would be performed by an engineer and which are also similar to "technical consultancy for heating apparatus". Furthermore, the opponent contends that the goods in Class 9 of the Applicant's mark are similar to the goods of the Opponent's marks in Class 11 as they all relate to "for use in apparatus for lighting, heating, steam generating, cooking, cooling, drying, ventilating, ventilation and water ducts and pipes, water heaters, bath water heaters, boilers, burners, solar thermal systems and heat pumps".

25. The opponent concludes by stating that as there is a high degree of similarity between the trade marks and the goods and services covered by the trade marks it can only lead to a likelihood of confusion. It submits that the public on seeing the applicant's mark will be confused into believing that their goods and services are those of the opponent.

APPLICANT'S WRITTEN SUBMISSIONS

26. The applicant's written submissions are dated 22 February 2005 and submitted by its professional advisors in these proceedings, Bromhead & Co.

27. The applicant states that the marks of the opponent consist of the word "CALOR" or "CALOR GAS" and relate to fuels and gases and associated apparatus and instruments. All the marks cited by the opponent have specifications which are either explicitly directed to gas related products, or liquefied fuel gas, or have the disclaimer "all being gas operated". It

goes on to say that there currently exists on the Register various marks comprising the word “CALOR” which also directly or implicitly cover gas operated goods and services.

28. The applicant contends that the opponent has conceded use of the marks CALORBLOC, CALORIC and CALORSTAT in the UK.

29. The applicant states that the register print-out of the United Kingdom trade mark No. 1097117 for “CALOREX” (filed in Exhibit DJC1 which accompanied the witness statement of David J. Crouch dated 31st August 2004) show that the specification is in Class 11 and is directed to “Installations for heating and refrigeration; heat pumps, but not including any installations or heat pumps for use in connection with liquefied petroleum gases.” In the ‘other particulars’ section of the register print-out of this trade mark, it states that the mark proceeded to registration by consent (presumably from Calor Gas themselves). The applicant contends that the exclusion “but not including any installations or heat pumps for use in connection with liquefied petroleum gases” is very specific to liquefied petroleum gas, and does not exclude equipment for use in connection with gas in general. For example, boilers which burn natural gas, being the core product of the applicant, would not be excluded. The applicant goes on to state that as this trade mark was filed under the 1994 Act, in order to establish who requested consent, the current applicants are writing to the owners of the mark “CALOREX” for their consent to approach the Trade Marks Registry to ask for confirmation that it was Calor Gas who gave consent. The applicant contends that while the opponent refer to the “limited nature of these specifications” (referring to those of CALORSTAT and CALORIC) in the above-mentioned witness statement of Alexander Davis, the mark “CALORSTAT” is the very substance of the Class 9 goods in the present application, and a core element of the goods in Class 11 and the services in Class 42 of the present application. As for “CALORIC”, this extends for example to boilers, which is a core product of the applicant. It also extends to ovens, for example, which is to be identified with the “apparatus... For cooking ..” in the Class 11 goods of the present application. In the view of the applicant the goods of these prior marks are central to those of the present applicant’s mark, and those prior marks are admitted by the opponent to be in use in the United Kingdom. The applicant contends therefore that the opponent cannot claim a monopoly in all marks which incorporate the word “CALOR” in the field of gas related products.

30. The applicant states that the word CALOR is defined in the dictionary as being from the Latin word for heat and that the word “CALORIC” is defined as “of or relating to heat”. Therefore, the applicant contends that the opponent cannot claim rights to words which incorporate the word CALOR in the field of gas related products.

31. Turning to the Exhibit AD3 to Mr Davis’ statement on behalf of the opponent, the applicant contends that it contains brochures which relate to products which bear other trade marks than those comprising the word CALOR and does not provide accurate evidence of use of the marks on the goods and services specified in the earlier registrations.

32. The applicant contends that when assessing the likelihood of confusion between the current trade mark “CALORMATIC” and the opponent’s trade marks, taking into account the concept of global appreciation from *SABEL V PUMA*, there is no likelihood of confusion. It submits that visually, aurally and conceptually, the word “CALORMATIC” is different from those marks of the opponent. In the visual and aural senses “CALORMATIC” comprises four syllables, with greater aural emphasis on the last two syllables, with the greater aural emphasis on the first one. Furthermore, the applicant states that conceptually,

“CALORMATIC” suggests a link to the word “AUTOMATIC” by the presence of the “-MATIC” suffix and that the opponent’s marks do not share this concept.

33. This completes my summary of the evidence and submissions filed in this case. I turn now to the decision.

DECISION

34. Section 5(2) of the Act reads as follows:

“5.-(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.”

35. An earlier right is defined in Section 6, the relevant parts state:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

36. I take into account the guidance provided by the European Court of Justice (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 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

37. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & C. GmbH v. Klijsen Handel B.V.*;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) account should be taken on 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 was registered; *Lloyd*;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*

38. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection for such a mark. The opponent has filed evidence relating to the reputation of its CALOR trade mark, which is supported by the dictionary entry supplied by the applicant. I have no doubt that the applicant has a reputation in its mark in relation to liquefied gas, containers for such gas and cooking, heating and lighting apparatus powered by liquefied gas.

39. The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchen QC sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those

marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion.”

40. In its submissions the applicant casts doubt upon the distinctive nature of the word CALOR as it stems from the Latin word for heat and because the word “Caloric” is defined as “of or relating to heat”. However, it seems to me that in an inherent context, the word CALOR is perfectly capable of acting as a trade mark in relation to the goods and services for which it is registered. I very much doubt that the average consumer would be aware of the word origins or link it to the word “Caloric”. In my view CALOR would be readily perceived as a trade mark and in any event, Section 72 of the Act states:

“In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

41. In the present case it seems to me that the inherently distinctive nature of the CALOR mark has been built upon by nature and consequential reputation. It is deserving of a good penumbra of protection and I shall take this into account in my decision.

42. In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods and/or services, the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the mark in suit and the opponent’s registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and/or services within the respective specifications.

43. In its evidence and submissions the applicant has drawn attention to third party marks incorporating the prefix CALOR, which it states are in use in relation to relevant goods. The opponent has countered by stating that if it saw these marks as a commercial threat it would take action against them.

44. While I note the applicant’s arguments on the point, the marks it mentions are different from the mark applied for and I have no evidence before me to illustrate use of these marks in the UK. The applicant’s evidence and submissions on the point ultimately amount to no more than ‘state of the register’ information and I am guided on this point by the following comments of Mr Justice Jacob as he then was in *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281:

“Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the

register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, se e.g. *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

45. My decision involves a comparison of the applicant’s and opponent’s particular marks and must be made on its own merits and on a global appreciation on the particular circumstances of this case.

46. I now go on to a consideration of whether the goods and services specified in the application are identical or similar to the goods and services specified within the opponent’s earlier registrations.

47. In my determinations I take into account the guidelines formulated by Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below:

“the following factors must be relevant in considering whether there is or is not similarity:

- (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 services;
- (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.”

48. Whilst I acknowledge that in the view of the CANON-MGM judgment by the European Court of Justice (3-39/97) the *Treat* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *TREAT*) are still relevant in respect of a comparison of goods.

49. Firstly, I go to Class 11 of the application as the opponent contends that these goods are identical and similar to the Class 11 goods of the opponent.

50. The opponent’s Class 11 specifications are widely drafted, albeit limited to goods which utilise gas and gas power. In effect they cover directly, or indirectly all the functions of the

applicant's goods and share the same purpose, users or customers. Insofar as the applicant's goods may not be gas powered, they would nevertheless be closely similar in my view e.g. a gas cooker and an electric cooker only differ in their power source but they share the same purpose, trade channels and are in general, in competition as alternative purchases. Furthermore, as the opponent's specifications include "parts and fittings" at large this would encompass the applicant's "water ducts and pipes".

51. To conclude, in relation to Class 11, I find that the respective goods of the parties are identical and/or closely similar.

52. Next, Class 9 of the application. Here the goods are control and adjustment instruments. However, they are control and adjustment instruments for goods encompassed within the opponent's Class 11 specifications, or, at least, goods which share the same basic purpose and potential customers. In my view, control and adjustment instruments for such goods would be closely associated with the goods, often forming a necessary and key component package with or to these goods.

53. In relation to Class 9 of the application I find that the applicant's goods are closely similar to the goods falling within the opponent's Class 11 specifications.

54. Finally, the services within Class 42 of the application. In relation to these services, the opponent contends that they are similar to its safety testing services in Class 42, which would include the safety testing of heating apparatus, and are also similar to its installation, maintenance and servicing services in Class 37 for gas utilising installations and equipment.

55. In my view, the services of an engineer and technical consultancy for heating apparatus would encompass safety issues and testing. Furthermore, it seems to me that those who offer the Class 42 services of the applicant could also supply associated installation, maintenance and servicing. The respective services are closely similar.

56. I now go to a comparison of the respective marks.

57. The applicant's mark consists of the invented word CALORMATIC. While the opponent's mark may possess a latin derivation, the word CALOR is not a dictionary word as such and it too, comprises an invented word.

58. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impressions. However, as recognised in *Sabel B.V. v. Puma A.G.* (mentioned earlier in this decision) in my comparison, reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how the marks would be perceived by customers in the normal course and circumstances of trade. I must bear this in mind when making the comparisons.

59. In its submissions, the opponent contends that CALOR is the dominant component of the applicant's mark and that the element MATIC is common in Class 11 and alluded to the dictionary word "automatic". I am far from convinced by these submissions which seem to me based on an overly forensic approach to the mark. I doubt that the average consumer would look to dissect the word CALORMATIC in such a way.

60. I turn to a visual and aural comparison of the respective marks. As mentioned above, both marks comprise invented words. The opponent's mark CALOR is subsumed within the applicant's mark and comprises the first five letters of the ten letter CALORMATIC mark. As the common element, the word CALOR, appears at the beginning of the applicant's mark. It seems to me that it is a dominant aspect of the applicant's mark as a whole and would be readily seen, heard, perceived and recollected as a key element of that mark. In my view there is obvious visual and aural similarity between the marks as a whole or in their totalities.

61. Next, a conceptual comparison of the marks. As both marks comprise invented words they do not possess a clearly defined conceptual identity. However, both marks share the distinctive letters CALOR, and given the position of these letters in the applicant's mark and their overall impact, it seems to me that there is some conceptual similarity overall.

62. In my considerations I must also consider the relevant customer for the goods and services. In these proceedings it seems to me that the relevant customer would be both businesses and the public at large. This is certainly not a bag of sweets case and it seems to me that the goods and services are likely to be purchased with a good degree of care.

63. I now go to a global appreciation of the likelihood of confusion. The respective goods and services are identical and/or closely similar. The opponent's CALOR mark is deserving a good penumbra of protection and given the prominence of the letters CALOR in the applicant's CALORMATIC mark, the respective marks are visually, aurally and conceptually similar as a whole. Notwithstanding that the customer for the goods and services would be relatively careful and discerning, it is my view that the applicant's mark would capture the distinctiveness of the opponent's CALOR trade mark in the market place and that there is a likelihood of confusion to the relevant public.

64. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in *Canon*:

“Accordingly the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive” (*see Sabel*).

65. The opposition under Section 5(2)(b) of the Act is successful.

COSTS

66. The opponent is entitled to a contribution toward its costs. I order the applicant to pay the opponent the sum of £1,200 which takes into account the fact that no hearing took place

in these proceedings. 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 10th day of June 2005

**JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General**