

O-281-06

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2370057

BY

ULTRA FINISHING LIMITED

TO REGISTER THE TRADE MARK:

HELIX

IN CLASS 11

AND

THE OPPOSITION THERETO

UNDER NO 93164

BY

HANSGROHE AG

Trade Marks Act 1994

**IN THE MATTER OF Application No 2370057
by Ultra Finishing Limited
to register the trade mark:**

HELIX

in Class 11

and

**IN THE MATTER of Opposition thereto
under no 93164
by Hansgrohe AG**

BACKGROUND

1) On 6 August 2004 Ultra Finishing Limited of Rylands Street, Burnley, Lancashire BB10 1RG, whom I will refer to as Ultra, applied to register the trade mark HELIX, ('the sign'). The application was published for opposition purposes in the "Trade Marks Journal" on 5 November 2004 with the following specification:

Taps for baths, basins, bidets and showers; shower valves.

The above goods are in class 11 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 4 February 2005, Hansgrohe AG of Auestrasse 5-9, D-77761 Schiltach, Germany, which I will refer to as Hansgrohe, filed a notice of opposition. Hansgrohe is the owner of International registration number 818090 for the trade mark, HELIS, which is registered for the following goods:

Apparatus for lighting, steam generating, cooking, water supply and sanitary purposes; water storage, heat accumulators, water treatment installations, water refinement installations; apparatus and instruments for the treatment of water and refinement of grey water, apparatus for disinfection, water filtering installations, filters for water, apparatus for ultraviolet ray treatment (not for medical purposes); mixing valves, manually and automatically operated mixing valves for the supply and discharge of water; mixer taps for wash stands, bidets, sinks, bath tubs and shower tubs; sanitary tubs and basins, bath tubs, shower tubs, whirlpool tubs, bidets, showers and shower cabins; showers and shower sets, shower systems and shower combinations, overhead showers, lateral showers, sanitary hoses, spray nozzles as parts of sanitary installations, shower holders; pre-assembled multifunctional showers; complete shower cabins; supply and discharge fittings for sanitary basins, wash stands, sinks, bidets, bath tubs and shower tubs; siphons (traps), supply and discharge pipes

as parts of sanitary installations and water supply apparatus; lighting fixtures; parts of the aforesaid goods.

The above goods are in classes 11 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) The HELIS mark is also registered for

Pipes and tubes made of non-metallic materials, non-metallic construction materials.

The above goods are in Class 19 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended

4) International registration no 818090 was applied for on 18 July 2003, and has a priority date of 28 February 2003 from the original application in Germany. This is the date from which protection for this mark was available in the UK for the goods specified in the registration.

5) Hansgrohe is opposing the application from Ultra on the basis of Section 5(2)(b) of the Trade Marks Act 1994 as amended, hereafter referred to as the Act. They seek refusal of the application and an award of costs.

6) Ultra filed a counterstatement on 19 April 2005 which, while admitting that the goods covered by the application were identical to those covered by the Opponents international registration no. 818090, denied that the trade marks were similar. Ultra request dismissal of the opposition and an award of costs.

7) Hansgrohe did not file evidence in chief under Rule 13C(1) or evidence in reply under Rule 13C(5) (all references to rules or a specific rule hereafter are to the Trade Marks Rules 2000 as amended).

8) The Applicant filed evidence under Rule 13C(4).

9) Both sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing. Both sides filed written submissions on 30 May 2006. Consequently, this decision is made from the evidence and written submissions before me.

EVIDENCE

Evidence of Hansgrohe

10) As mentioned above, Hansgrohe did not file any evidence in support of their opposition. They have chosen to rely on the specification as registered.

Evidence of Ultra

Witness Statement of Keith Heys

11) This consists of a witness statement by Mr Keith Heys and associated Exhibit 1. Mr Heys is the Managing Director of Ultra and has held this position since 1 January 2000.

12) Mr Heys provides figures for sales of goods under the HELIX brands in the UK between 2001 and 2005. I reproduce below only those figures that cover sales in the period 2001-2003 (i.e. before the priority date of the registered HELIS mark).

Year	Sales (£)
2001	280,000
2002	890,000
2003	1,435,000

13) Mr Heys states that the HELIX mark has been used in the UK since May 2001 on taps, mixers and showers. Goods bearing the HELIX brand have been supplied to all parts of the UK. In the period 2001 to 2005, approximately 200 promotional display units featuring HELIX products have been distributed to retail outlets in the UK. It has not been possible for me to determine how many of these promotional display units were distributed prior to the effective date. In addition, the HELIX range of products has also been promoted on the internet by the company website at www.ultra-group.co.uk.

14) Mr Heys stated that the products available under the HELIX range had grown from 2 pages of a 48 page catalogue in 2001 to cover 10 pages of a 120 page catalogue in 2005. In 2001 the catalogue was A5 size and cost £23,000 to print; in 2005 the catalogue was A4 size (which corresponds to twice A5 size) and cost £126,000 to print. The 2005 catalogue has been distributed to approximately 720 retail outlets in the UK. At Exhibit 1 Mr Heys provides two photocopied pages from catalogues showing a selection of products sold under the HELIX brand. One photocopied page is dated 2001 by hand and one photocopied page is dated 2005 by hand. However all the material relating to the situation in 2005 occurred after the priority date of the HELIS mark and cannot be taken into account in reaching my decision.

15) Mr Heys states that he became aware of the HELIS trade mark in 2003 when Hansgrohe launched the 'Pharo Helis Shower Panel'. Mr Heys gives no indication when in 2003 this awareness arose. He indicates that it is his belief that the 'Pharo Helis Shower Panel' has been on continuous sale in the UK in a number of different versions since 2003.

16) He also states that Ultra decided not to challenge the registration of the HELIS trademark because in their view HELIX and HELIS are sufficiently different from a conceptual and phonetic point of view that the company believed that customers would be unlikely to confuse the two. Mr Heys states that Ultra have received no

correspondence or other feedback relating to HELIS products or from customers of the HELIX range who have experienced confusion with HELIS products.

17) This concludes my review of the evidence

DECISION

Likelihood of confusion – section 5(2)(b) of the Act

18) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

19) Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

20) In determining the question under section 5(2)(b) of the Act, I take into account the guidance provided by the European Court of Justice (ECJ) in:

- i) *Sabel BV v Puma AG* [1998] RPC 199;
- ii) *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117;
- iii) *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77;
- iv) *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723;

and

- v) *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)* (case C-106/03 P) [2005] ETMR 23.

21) It is not required that actual confusion results between the marks in order for an opposition under Section 5(2)(b) to succeed. The test is the likelihood of confusion. In the present case, there is no requirement for the opponent to prove use of the registered mark HELIS as this mark has not been subject to protection in the UK for a period of more than five years from the date of publication of the applied for mark (in

this case 5 November 2004). Also there is no requirement on the opponent to provide evidence that his earlier mark is actually being confused with the mark applied for, rather it is sufficient to show that, using the guidance laid out in the above ECJ judgment, that there is a likelihood that confusion may result.

22) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion in the mind of a consumer. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments of the European Court of Justice mentioned above. 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 different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

23) When taken together the sales figures for 2001-2003 and the catalogue evidence for 2001 provided by Mr Hey are sufficient to show that goods were available and being sold under the HELIX mark in the UK before the priority date of the HELIS mark. However, the HELIS mark is an earlier registered mark (see paragraph 19 above) and is thus entitled to protection as such.

24) Mr Hey refers to a lack of actual confusion in the market place in paragraph 10 of his witness statement, where he states:

“I believe Hansgrohe AG's failure to submit any evidence of actual confusion demonstrates no confusion is in reality occurring despite the use that is being made of both marks”

However, it has been established by case law that lack of evidence of confusion says very little. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, Millet LJ in the Court of Appeal commented (at page 291):

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

This was further expanded by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41:

“**22** It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market-place but no confusion has been caused, then there cannot exist a likelihood of confusion under Art.9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s.10(2). So, no confusion in the market-place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It

is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.

23 This is of significance in this case because, as noted above, there is no suggestion that there has been any confusion in the market place between the activities of the defendant under the sign "COMPASS LOGISTICS" and the claimant, or any other member of the Compass Group, under the mark "COMPASS". Mr Wyand relies on this as being a good indication that there is no likelihood of confusion. But in my view Mr Purvis is right when he argues that the question of infringement has to be answered by assessing the likelihood of confusion were the claimant to use the mark "COMPASS" in a normal way in respect of all services covered by the registration, including for business consultancy services in the field of logistics, that is to say the same specialist field the defendant operates in."

25) Mr Heys stated that his first knowledge of the HELIS trade mark was in 2003 when Hansgrohe launched the 'Pharo Helis Shower Panel' and that sales of this product and various HELIX products have occurred side by side without any confusion arising. However, as indicated above, absence of such confusion is not significant and is not the issue that has to be decided. The question to be answered is whether confusion is likely to arise in the minds of a consumer if the registered trademark and the sign as applied for are used in a normal way in respect of all the goods covered by the registration. Thus the comparison to be made is that between HELIS and HELIX and not that between HELIX and HELIS in combination with another Hansgrohe house mark, i.e. Pharo.

Comparison of goods

26) Ultra, in their counterstatement of 18 April 2005, admit that the goods covered by the application are identical to those covered by Hansgrohe's International registration. This agrees with my assessment.

Comparison of trade marks

27) When comparing trade marks 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 [*Sabel BV v Puma AG*]. Consequently, I must not indulge in an artificial dissection of the trade marks, although I must take into account any such distinctive and dominant components.

The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he or she has kept in their mind. He or she is deemed to be reasonably well informed and reasonably circumspect and observant [*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*]. As stated by the Court of First Instance (CFI) in *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* (case T-185/02) [2005] ETMR 22:

“53.*The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public.*”

28) The marks of the two parties are reproduced below for ease of comparison:

Applicants Sign	Opponents Registered Trademark
HELIX	HELIS

29) The sign HELIX and the mark HELIS are both words that comprise two syllables and 5 letters, the first four of which are identical. Neither is made up of a dominant element, rather the distinctiveness lies in the whole of the sign or mark. Visually HELIX differs from HELIS in only one way – the final letter X in stead of S. Aurally it would be difficult to distinguish the difference between HELIX and HELIS given that X and S produce a similar sibilant sound.

30) It is established case-law that the beginnings of words are more important than the ends of words when considering similarity [see *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-336/03); see *El Corte Ingles v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* (Joined Cases T-183/02 and T-184/02) [2004] ETMR 103 and *Tripcastroid Trade Mark* 42 [1925] RPC 264.

31) The relevant public in this case are those involved in purchasing taps and shower valves for kitchen and bathroom fittings. It will include professionals such as plumbers who purchase such equipment regularly as part of their work as well as non-professionals such as do-it-yourself enthusiasts who are redecorating their bathrooms after a number of years. It will also include people who are purchasing these items on behalf of the person who will install them.

32) Taps and shower valves are usually purchased to match a new kitchen sink, bathroom hand-basin, shower or bath unit. As such they are not every-day purchases. They will usually only be purchased after the consumer has given some thought and effort as to the type of tap or shower valve they want to use in their new or redecorated kitchen or bathroom. Stores that sell such goods usually provide display boards with one or two examples of such taps or shower valves and often one or two display bathrooms and/or kitchens showing the taps or shower valves mounted on baths, hand-basins and showers to give an idea of how they will appear in use. Such stores rarely display the full range of taps and shower valves that they can supply and often use catalogues, both paper and internet types, to display the full range that they

stock or can supply at short notice. The goods are usually purchased new and are sufficiently expensive that the consumer will exercise a reasonable level of care when searching for and purchasing these goods.

33) The average consumer will rarely be able to make a direct comparison between the marks in question and taking into account that recollection is often imperfect, I am of the opinion that there is a high degree of visual, aural and phonetic similarity between the sign HELIX and the mark HELIS.

34) From a semantic point of view, HELIX is a word found in the dictionary referring to a spiral curve or spring and to some it may also bring to mind the shape of DNA, the genetic material found in living organisms. However, I do not think that these possible meanings of the word HELIX would be familiar to the average consumer involved in purchasing taps or shower valves. The registered trade mark HELIS is a made up word and as such has no specific meaning attached to it. Thus, I consider that there is no similarity at a semantic level between the registered mark and the sign.

35) None of the possible semantic meanings of HELIX provide a conceptual meaning that can be characterised as “*a clear and specific meaning so that the relevant public are capable of grasping it immediately*”. A clear conceptual difference between the registered mark and the sign can be sufficient to counteract visual, aural and phonetic similarities. This was established by the Court of First Instance (CFI) in decision T-292/01 *Phillips-Van Heusen v OHIM - Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335 ([2004] ETMR 60) which stated:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

In this case, I do not consider that the meaning of HELIX is sufficiently clear and specific in conceptual terms to distinguish it from HELIS in the minds of the relevant public.

Distinctive character

36) As a made up word, the registered mark HELIS is highly distinctive in character. It provides a strong identity to the goods for which it is registered much in the same way that the made up word KODAK provides a strong identity for photographic goods. The conceptual meaning of HELIX does not provide the sign with a sufficiently clear and specific meaning that can be grasped immediately and so avoid the likelihood of confusion between the registered mark HELIS and the sign HELIX (see *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) (Case T-135/04) [2006] ETMR 58 at paragraph 78).

Conclusion

37) Taking into account all of the above relevant factors and adopting the 'global' approach required, I must come to a view whether a person familiar with the opponent's mark on seeing the applicant's mark in use is likely to confuse the two marks. In my view the marks in question, from a visual point of view, are highly similar and, from an aural point of view, all but indistinguishable. The semantic and conceptual differences between the marks are not sufficient to overcome these similarities. The goods in question are identical and acknowledging that the comparison will rarely be a direct one and that it will be subject to imperfect recollection, I conclude that there exists a likelihood of confusion on the part of the relevant public regarding the marks in question.

38) The ground of opposition under section 5(2)(b) of the Act is successful.

COSTS

39) Hansgrohe having been successful is entitled to a contribution towards their costs. I order Ultra to pay Hansgrohe the sum of £1000. 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 02nd day of October 2006

**Dr Lawrence Cullen
For the Registrar,
the Comptroller-General**