

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2312653
IN THE NAME OF OZONE SYSTEMS LIMITED
TO REGISTER A TRADE MARK
IN CLASSES 3, 5, 7, 9 AND 11**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 91963
BY STERILOX TECHNOLOGIES INC**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST THE DECISION OF MR MIKE FOLEY
DATED 7 DECEMBER 2006**

DECISION

Background

1. This is an appeal against the decision of Mr. Mike Foley, the Hearing Officer acting for the Registrar, dated 7 December 2006, BL O/354/06. In that decision Mr. Foley allowed the opposition brought by Sterilox Technologies Inc. (“the Opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“TMA”) against UK Trade Mark Application number 2312653 *in full*, that is, against all the goods originally applied for.
2. Mr. Foley also rejected a revised specification put forward by Ozone Systems Limited (“the Applicant”) in correspondence shortly before the opposition hearing.
3. However, the Hearing Officer decided that any conflict regarding Class 7 could be resolved through a positive limitation. He indicated that the application could proceed provided the Applicant deleted Classes 3, 5, 9 and 11 and restricted the Class 7 specification accordingly.
4. The appeal is limited to the Hearing Officer’s decision to allow the application to proceed in Class 7 with an amended specification. There is no appeal against the propriety of the Hearing Officer devising a re-revised Class 7 specification, or against his failure to invite submissions from the parties on that re-revised specification.

5. At the hearing of the appeal before me, Mr. Thomas Mitcheson, of counsel, represented the Opponent. Mr. Guy Tritton, of counsel, appeared on behalf of the Applicant. I am grateful to each of them for their detailed submissions.

Application number 2312653

6. Application number 2312653, dated 9 October 2002, requests registration of the trade mark STERITROX in respect of the following goods:

Class 3

Cleaning preparations

Class 5

Sterilizing preparations; and sanitizing preparations

Class 7

Cleaning apparatus; cleaning apparatus utilizing ozone; filtering apparatus; air filtering apparatus; filtering apparatus utilising ozone; filters; sanitizing apparatus; sanitizing apparatus utilizing ozone; and parts and fittings therefor

Class 9

Ozonizers; and parts and fittings therefor

Class 11

Sterilizers; sterilizers utilizing ozone; and parts and fittings therefor

7. On 8 September 2003, the Opponent filed notice of opposition against the application. The ground of opposition under section 5(2)(b) of the TMA was based on two earlier trade marks belonging to the Opponent. But, in the event, the Opponent relied only upon UK Trade Mark number 2217154.
8. UK Trade Mark number 2217154 has a filing date of 9 December 1999 and is for the STERILOX series of three marks with the colour blue claimed as an element of the second mark. The earlier trade mark stands registered for a range of goods and services in Classes 1, 2, 5, 9, 10, 37, 38, 40 and 42 as set out in Appendix 1.
9. Both sides filed evidence, which I shall mention as appropriate.

The Hearing Officer's decision

10. The Hearing Officer began by setting out the relevant law on section 5(2)(b) (paras. 11 – 14). His exposition was in familiar terms and there is no suggestion that he got anything wrong.
11. He then went on to deal with the inherent distinctiveness of the earlier trade mark (noting that the Opponent made no claim to reputation), especially the Applicant's argument that STERI- was descriptive (paras. 16 – 17):

“16. There is no evidence that “STERI” is a recognised abbreviation, prefix or shortening form, a position confirmed by reference to Collins English Dictionary, of which I have taken judicial notice. Nor is there evidence that the term is used in a trade related to the goods covered by the respective marks, or in the common parlance of the industry concerned. The “state of the register evidence” provided by the applicants shows STERI to be a prefix to a number of trade marks that have been applied for or registered. In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 Jacob J (as he then was) said:

“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, see *e.g.* MADAME Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

17. The applicants accepted this but argue that the Registrar can “...take into account the fact that persons in the sterilising business do not consider that STERI- belongs to any one person and that there is a genuine desire to use the prefix to indicate a product that has a sterilising function”. I believe the most that I can take from this evidence is that the prefix appears to have some attraction to these trade mark owners, and that in all probability this is because, as the applicants claim, it brings to mind the concept of something “sterile” or for “sterilising”. However, the fact that a mark may bring to mind an idea because of the use of a stem from a descriptive word does not make the mark as a whole descriptive. Trade marks are often constructed to bring to mind something about the goods, services or a characteristic of them that the trader wishes to convey to potential consumers. There are degrees of allusion, from the clever to those where the origins of the trade mark are none too hidden, but are nonetheless not directly descriptive, and it is in the latter that I would place the opponents’ mark STERILOX. However registration is not a reward for the inventive; it is a right for the distinctive, and in the absence of evidence to the contrary I must proceed on the basis that the opponents’ earlier mark is just that.”

12. The Hearing Officer found that the marks STERILOX (Opponent) and STERITROX (Applicant) were visually and aurally similar (paras. 19 – 20):

“19. In a visual comparison of long words such as STERILOX and STERITROX the number of letters in each is of less significance than the overall impact on the eye brought about by any similarities and/or differences in the sequencing and the relative strength of the letters and syllables, and whether there are elements that are discernible or more memorable to the consumer. It is also relevant to consider that it is

generally the beginnings of words that are considered to have most significance in any comparison, as is the fact that in longer words, differences may have proportionately less significance than in shorter words.

20. The mark of the application and the opponents' earlier mark both begin with the element "STERI" and also share the same ending "OX". These are strong elements that have the most significant impact upon the visual and aural impression of the respective marks. That the difference is in the body of the words surrounded by the similarities reduces their significance and makes them less obvious. The words run together creating a flow composed of three syllables. In the applicants' mark the syllable in the middle portion gives it a slightly harder sound and requires more deliberate articulation to pronounce it correctly. However, words are not usually enunciated with regard to every letter and syllable, so when spoken the differences in sound as a whole will diminish. My view on the respective marks is that they are similar in appearance and sound."

13. There was also conceptual similarity (para. 21):

"21. Whether or not "STERI" is an "officially recognised" abbreviation, shortening form (or whatever), given the nature of the goods covered by the respective marks it is not unreasonable to infer that the relevant consumer may recognise the element as an indication that the goods have a function relating to sterilising. There is no evidence, and neither side have addressed me as to whether the remaining parts of the marks, LOX and TROX have any meaning. It may well be that they are a reference to oxygen; I do not know, but whatever is the case, they are, as a whole, invented words, portmanteau or otherwise, and whichever way you look at them, the respective marks will convey a similar concept to the relevant consumer."

14. Turning to compare the goods and services, the Hearing Officer stated the imperative of looking to the full extent of the respective specifications, i.e., notional rather than actual use¹ (para. 23). Mr. Mitcheson drew my attention to two further observations (para. 28, Mr. Mitcheson's emphasis):

"28. Neither the opponents' nor the applicants' specifications contain any qualifications or restrictions that would serve to move them into separate markets. Some of the goods and services listed in the specifications of the opponents' earlier mark are clearly specialised in what they do, or where they are used. The applicants' specification is expressed in more general terms, but *notionally contains the same range from the simple to the sophisticated, and goes into the same area of trade*. I must therefore proceed on the basis that the respective goods and services are capable of being of the type *purchased by the*

¹ Application number 2312653 was published before 5 May 2004 and therefore the provisions of The Trade Marks (Proof of Use, etc) Regulations 2004 were inapplicable.

public at large with minimal care and attention, to the technical used by the trained and knowledgeable professional who will make a deliberate and informed purchase. Notionally, the channels of trade, the means by which they reach the point of sale, and the consumers of the respective goods are also the same.”

15. The Hearing Officer noted that the Opponent’s 2217154 mark did not cover Class 3. Nevertheless there was similarity between the Applicant’s Class 3 goods and the Opponent’s goods and services particularly those in Class 5 (para. 29):

“29. Class 3 of the application covers “cleaning preparations”. The opponents’ earlier mark does not cover goods in Class 3 so the question is whether the goods or services that are listed are similar. Class 5 of the opponents’ earlier mark mentions, amongst other things, “detergents for use in cleaning medical devices”. In respect of the goods there is clearly similarity in “nature” and “use”. I do not see why the users should not also be the same, or any reason why there should be a difference in the circumstances in which these goods and services are sold and obtained. They are, at the very least complementary, if not competitive, and I consider the goods covered by Class 3 of the application to be similar to the goods and/or services for which the opponents’ earlier mark is registered.”

16. Further, the respective Class 5 goods were overlapping (para. 30):

“30. Class 5 of the opponents’ earlier mark specifically mentions “sterilizing” and “sanitizing” preparations, the self-same goods mentioned in the application, so clearly, in respect of this class identical goods are involved.”

17. Again, the Opponent’s 2217154 mark did not cover Class 7. The issue was, therefore, one of similarity. Referring (para. 27) to the Court of Appeal’s decision in *Altechnic Ltd’s Trade Mark Application* [2002] RPC 34, the Hearing Officer considered the Applicant’s Class 7 specification in the light of, *inter alia*, the international classification system (paras. 31 – 33):

“31. The opponents’ earlier mark does not include goods in Class 7 so the question is again one of similarity. The goods in this class of the application cover “cleaning” apparatus at large, “filtering” and “sanitizing” apparatus, which are, in essence, also cleaning apparatus, and parts and fittings for such goods. Class 9 of the opponents’ earlier mark covers apparatus and devices for electro-chemical treatment of water-based solutions, a description that is capable of encompassing cleaning, and as such, the same purpose as the goods of the application. It also mentions computer software, hardware and firmware, amongst other things for monitoring and maintaining sterilisation systems, which could be a part for the applicants’ machines. However, whilst machines and apparatus for cleaning/filtration are to be found in Class 7, where the purpose is for sterilisation, such goods are, with the

exception of scientific apparatus, or for use in medical procedures, proper to Class 11. So whilst Class 10 of the earlier mark covers sterilisation and disinfection apparatus, etc., and Class 40, the service of sterilisation or disinfection, for the reasons I have given this cannot be the purpose of the applicants' machines in Class 7.

32. The opponents' specification for Class 37 covers the "cleaning ... of surgical, medical, dental, veterinary, sterilisation and disinfection apparatus and instruments". As I have said, whilst the applicants' goods in Class 7 will not be for sterilisation, disinfection, as they have not stated them to be for cleaning anything in particular, they are notionally capable of being for cleaning the surgical, medical etc., apparatus and instruments, and in my view the opponents' Class 37 specification is capable of covering the provision of a service that is the function of the applicants' goods.

33. There is also a potential similarity in "use" between the applicants' Class 7 specification, and the item "electro-chemical treatment" device/apparatus in Class 9 of the opponents' earlier mark. In Class 9 the apparatus will be either purely electrical/electronic, or for a specialised, usually scientific purpose. Even so, this still leaves a similarity in the "use" to which the respective goods may be put, and I see no reason why the users, and the circumstances by which the goods are sold and obtained could not also be the same; I have no evidence to the contrary. These goods are at least complementary and potentially in competition. In summary, I find these goods to be similar."

18. Mr. Mitcheson cautioned against construing a specification in one class by reference to other classes. However, he confirmed that he did not challenge the Hearing Officer's approach at paragraph 31. In *Altechnic*, Mummery L.J. held that the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, and that this was not dependent on the application stating: "all included in Class X", or similar (para. 42).
19. The Hearing Officer also made a finding of similarity in relation to Classes 9 and 11 of the Application (para. 34, emphasis supplied):

"Class 9 of the application covers "ozonizers" and parts for such apparatus, and Class 11, "sterilizers", in particular those that utilize ozone, and their parts and fittings. As can be seen from the description of the applicants' goods in the evidence, these are used, inter alia, for *the elimination of microbes, which to me is the act of sterilising or sanitising, in high and low care areas, or in other words, potentially hospitals and clinics*. These are goods that, if not the same as, are certainly very similar to those for which the opponents' earlier mark is registered. The services covered by Class 37 of the opponents' earlier mark include the rental, hire, leasing of apparatus, etc., for the purpose of sterilisation and disinfection, notionally goods that are of the same nature, and for the same use as the apparatus covered by Classes 9 and

11 of the application. Given this, it seems reasonable to infer that the respective goods and the service will be provided to the same end consumer, albeit one through sale and the other on the basis of hire, lease, etc. That this presents the consumer with the choice of outright purchase or temporary acquisition to my mind places the applicants' goods in Classes 9 and 11 in direct competition with the opponents' "hire" services in Class 37. I find these goods and services to be similar."

20. The Hearing Officer's conclusion on the specification applied for was that the conditions of section 5(2)(b) were made out (para. 35):

"35. Balancing all of the factors, and particularly taking into account the possibility of confusion through "imperfect recollection", I come to the view that whilst there may be differences in the respective marks, these are outweighed by the elements in common. When other circumstances such as the identity/similarity in the goods/services, consumer and trading circumstances are factored in, it seems to me that should the applicants use their mark in relation to the goods for which they seek registration, this will lead the public to believe, and wrongly so, that the respective goods come from the same or linked undertakings. There being a likelihood of confusion, the opposition under section 5(2)(b) succeeds."

As I said, there is no appeal against that finding.

21. The opposition hearing was appointed for 22 February 2006. In a letter dated 17 February 2006, the Applicant offered to amend the Application by omitting Classes 3 and 5 and limiting the goods in Classes 7, 9 and 11 to those utilizing ozone. The Hearing Officer rejected that proposed amendment because the respective specifications still encompassed the same uses/areas of activity albeit in the case of the Applicant's goods achieved by employing ozone. There is no appeal against the Hearing Officer's rejection of the Applicant's proposed amendment.
22. Finally, moving to the contested part of the decision, the Hearing Officer proposed his own amendment for solving the conflict in Class 7 of the Application. No transcript is available² but I am told that such further amendment was not canvassed at the opposition hearing and the parties were not afforded the opportunity to comment. The latter fails to conform to rule 54 of the Trade Marks Rules 2000 as amended but neither party wished to take issue on the point.
23. The Hearing Officer's proposed amendment to the Application in Class 7 reads (para. 37, emphasis the Hearing Officer's own):

"Cleaning apparatus utilizing ozone; filtering apparatus utilizing ozone; sanitizing apparatus utilizing ozone; **all for use in the**

² No stenographer was present due to travel problems.

elimination of microbes and odours from high and low care areas, chillers, warehouses, transport containers or other defined spaces.”

24. He explained his rationale thus (para. 38):

“38. I have drawn this limitation from the evidence provided by the applicants, and it therefore reflects their actual use. To my mind it draws the clear distinction that the applicants’ goods are for use in respect of “defined spaces”, whereas the opponents’ goods and services that I considered to be in conflict are concerned with the treatment of a fluid and the cleaning of apparatus and instruments. In my view, if the specification for Class 7 were to be revised as above, this would tip the balance against there being a likelihood of confusion.”

The Hearing Officer had reminded himself (para. 37): “In respect of Class 7 of the application, I came to the view that there was similarity with the “apparatus and devices for electro-chemical treatment of water-based solutions” listed in Class 9 of the opponents’ earlier mark, and the service of cleaning surgical, medical, dental, veterinary, sterilisation and disinfection apparatus and instruments.”

25. However no such limitation worked for the other classes the Applicant maintained (para. 39):

“39. Because the applicants’ goods still notionally encompass sterilization and disinfection, limiting the specification [sic] specifications proposed for Class 9 and Class 11 would not overcome the problem. The opponents’ goods and services that relate to sterilisation and disinfection are not restricted to any particular area, and as such, notionally encompass all areas of this activity, including those mentioned in the limitation, and whether provided by ionization or whatever.”

26. In summary, the Hearing Officer was prepared to allow the Application to proceed in Class 7 provided the specification was limited as he proposed and Classes 3, 5, 9 and 11 were dropped. The re-revised Class 7 specification is the subject of the appeal, which was filed by the Opponent to an Appointed Person under section 76 of the TMA on 4 January 2007.

Standard of review

27. This appeal is a review of the Hearing Officer’s decision. Mr. Tritton referred me to *Sunrider Corporation T/A Sunrider International v. Vitasoy International Holdings Limited* [2007] EWHC 37 (Ch) where Warren J. accepted that the following represented the correct approach (paras. 10 – 11):

“10. The proper approach to appeals in trade mark cases is not in dispute. It was dealt with by the Court of Appeal in *REEF Trade Mark* [2002] EWCA, [2002] RPC 5. As Mr Malynicz (for Sunrider) puts it

in his skeleton argument (referring also to *El Du Pont Nemours & Co v ST Du Pont* [2003] EWCA (Civ) 1368, [2004] FSR 15):

“In essence, the Court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

... Review in this context is not to be equated with judicial review. The review engages the merits of the appeal. It accords appropriate respect of the decision of the lower court but that will be tempered by the nature of the decision of the lower court and its decision making process. There will also be a spectrum of respect depending on the nature of the decision of the lower court which is challenged. At the one end of that spectrum will be decisions on primary fact reached after an evaluation of oral evidence where credibility is in issue. Further along will be multi-factorial decisions often dependent on inferences and an analysis of documentary material.”

11. Mr Onslow, for Vitasoy, adds to the picture this passage from the judgment of Peter Gibson LJ in *Ladney and Hentry’s International Application* [1998] RPC 319 at 330:

“Even when the tribunal has a legally qualified chairman, such as is the case with an industrial tribunal, this court has repeatedly said that when giving their decisions such tribunals are not required to create elaborate products of refined legal draftsmanship, and those decisions should not be subjected to detailed legalistic analysis or gone through with a fine-tooth comb. The decisions must be read in a common-sense manner and looked at in the round. Of course the parties are entitled to know from the decision the tribunal’s basic factual conclusions and the reasons which have led the tribunal to its conclusions on those basic facts. But this court and other appellate courts read such decisions with a degree of benevolence which may not be accorded to the decisions of qualified judges.”

28. Mr. Mitcheson said he did not dissent from the above but relied more generally on the *REEF* case.

Grounds of appeal

29. The Notice of Appeal, dated 4 January 2007, sets out six grounds in relation to the re-revised Class 7 specification the Hearing Officer was prepared to allow. In the event, the Opponent relied only upon the first, namely that the Hearing Officer erred in the approach he adopted concerning the comparison of the goods specified in the Application and the goods and services specified in the Opponent’s earlier rights. Under that head, Mr. Mitcheson made six points.

30. First, none of the Opponent's goods and services in Classes 9 and 37, which the Hearing Officer found to be in conflict (i.e., apparatus, installations and devices for electro-chemical treatment of water-based solutions; computer programs, computer software, computer hardware and computer firmware [amongst other things] for monitoring and maintaining local and remote sterilisation systems; cleaning ... of surgical, medical, dental, and veterinary ... sterilisation ... disinfection apparatus and instruments) are restricted from use in any of the ways that the Hearing Officer added to the Applicant's Class 7 specification. In particular, all are capable of use in "defined spaces", whatever that might mean.
31. Second, the distinction the Hearing Officer seeks to make, i.e., effectively the use of cleaning apparatus in respect of defined spaces, is artificial as shown by the Applicant's actual use.
32. The Hearing Officer states that he draws the limitation, "all for use in the elimination of microbes and odours from high and low care areas, chillers, warehouses, transport containers or other defined spaces" from the Applicant's evidence (para. 38). Mr. Mitcheson took me to the witness statement of Keith McMurray Boden, dated 24 March 2005. Mr. Boden is a partner of Fry Heath Spence the Applicant's attorneys. The limitation comes from a passage in an article in the Birmingham Post, 18 September 2003, entitled "Steritrox headlines in bacteria destruction" (Exhibit 1). Mr. Mitcheson observes that bacteria destruction involves more than cleaning. The Steritrox product is described in the context of the Birmingham Food Technology Show as "a quantum leap forward in food preparation workspace hygiene". But the healthcare industry is also mentioned. Mr. Mitcheson highlighted references to the anti-microbial action of ozone, sterilising, sanitising and killing/inactivating bacteria and viruses. Computer controlled aspects of the Steritrox machine are pictured and described.
33. To indicate the scope of "high and low care areas" in the Hearing Officer's limitation, Mr. Mitcheson turned to the Applicant's STERITROX brochure at Exhibit 9 to Mr. Boden's witness statement. The brochure cover speaks of "all Hygiene Critical Areas". A report of tests undertaken on the Steritrox product includes the statement: "The process has great potential for use in sanitising all surfaces and equipment in the Food and Pharmaceutical Industries and Hospital environments". A list of applications for the Steritrox process ranges from food manufacturing plants to hospitals, nursing homes, and bio-terrorism clean up. There is a description of the sophisticated software in the Steritrox product, which is said to render it completely computer controlled. The brochure contrasts the Steritrox process to the use of chemicals in liquid or fogging form. Mr. Mitcheson says this shows that the average consumer would be familiar with the method of fogging.
34. Whilst addressing the evidence, Mr. Mitcheson referred me to Exhibit 10 to Mr. Boden's witness statement detailing the Opponent's STERILOX product. This is described as a disinfectant – a single-use solution that is disposed of

after each cycle and fresh Sterilox used for each patient to reduce the risk of cross-contamination. Exhibit 10 additionally talks of the Sterilox system producing bacteria free water, which prevents recontamination in the final decontamination cycle. There is no suggestion in Exhibit 10 that the Sterilox product is unsuitable for decontaminating defined areas.

35. Third, the Hearing Officer interprets the Applicant's Class 7 specification as effectively limited to cleaning apparatus stating that sterilisation cannot be the purpose of Class 7 because (subject to exceptions in Classes 5 and 10) that is appropriate to Class 11. Yet the Hearing Officer includes in his allowable Class 7 specification "for use in the elimination of microbes", which is sterilisation as this is the only way microbes can be eliminated as opposed to merely removed. Mr. Mitcheson highlights references in the Applicant's evidence to the bactericidal and virucidal vapour produced by its equipment that is said to "sterilise" and "sanitise" (Exhibits 1 and 9). Further, I note that the Hearing Officer himself said that "elimination of microbes" amounts to sterilisation or sanitisation in connection with Class 9 of the Application (see para. 34 reproduced at para. 19 above with relevant emphasis).
36. Fourth, the Hearing Officer says that while the Applicant's goods are for use in respect of defined spaces the Opponent's goods and services are concerned with the treatment of a fluid, and the cleaning of apparatus and instruments. The Opponent refutes that 2217154 is just concerned with the treatment of a fluid. Mr. Mitcheson concedes that part of the Classes 9 and 37 specifications are concerned with the production of a fluid for cleaning/sterilising but says that this is not merely the treatment of a fluid because the subsequent use of the fluid is relevant. Moreover his client's Class 9 specification covers computer software/hardware/firmware for monitoring and maintaining local and remote sterilisation systems and the Class 37 specification, the rental, hire, leasing of sterilisation/disinfection apparatus and instruments.
37. Fifth, similarly the Opponent's earlier registration is not simply concerned with the cleaning of apparatus and instruments. The Opponent particularly draws attention to the fact that its local and remote sterilisation system in Class 9 is not restricted in that way. Moreover the products (i.e., solutions) of its apparatus in Class 9 for the electro-chemical treatment of water-based solutions and in Class 37 for producing sterilising and disinfection solutions, super-oxidised water and rinse waters can be used to clean anything.
38. Sixth, the Hearing Officer ignored the Opponent's Class 5 specification and failed to take into account Mr. Mitcheson's argument at the hearing below that the solutions described in Classes 5, 9 and 37 of the Opponent's earlier mark can be generated by "fogging" equipment to sterilise and disinfect interior spaces and surfaces.
39. Mr. Tritton responds that the multi-factorial decision undertaken by the Hearing Officer in the global appreciation of likelihood of confusion for the purposes of section 5(2)(b) was finely balanced. The Hearing Officer did not

hold that the limitation he proposed to Class 7 of the Application meant that the respective products were no longer similar but that it tipped the balance in favour of no likelihood of confusion. Mr. Tritton argues that *sub silentio* the Hearing Officer found that the re-revised specification was similar to the Opponent's goods and services. Otherwise he would have rejected the opposition not on the ground of likelihood of confusion but because of lack of similarity of goods/services, which is a threshold requirement. As regards goods and services in 2217154 that allegedly were ignored, the Hearing Officer said that in devising the re-revised Class 7 specification, he had in mind only those goods and services in the earlier mark, which he considered to be in conflict.

The re-revised Class 7 specification

40. I agree with Mr. Mitcheson that through allowing a re-revised Class 7 specification with the words "for the elimination of microbes" the Hearing Officer indulged in inconsistent reasoning. If contrary to the apparent scope of Class 7 the phrase was to have any effect, the limitation was objectionable on the same ground as in conjunction with Classes 9 and 11 (para. 39), i.e.:

"The Opponent's goods and services that relate to sterilisation and disinfection are not restricted to any particular area, and as such, notionally encompass all areas of this activity, including those mentioned in the limitation, and whether provided by ionization or whatever."

I believe the Hearing Officer may also have purported impermissibly to create an uncertain specification (Case C-363/99, *Koninklijke KPN Nederland NV v. Benelux Merkenbureau* [2004] ECR I-1619, paras.111-117) and/or to extend the original specification (s. 39 TMA). But counsel did not address me on these issues. Mr. Tritton did not seek to defend "for the elimination of microbes".

41. I am further troubled that in devising his limitation the Hearing Officer may have lost sight of the Opponent's computer software, hardware and firmware, amongst other things, for monitoring and maintaining sterilisation systems (para. 31). The parties were unable to shed light on that aspect of the Hearing Officer's reasoning, which I have had difficulty in following.
42. Assuming, despite Mr. Mitcheson's able arguments that the Opponent's goods and services are concerned with the treatment of a fluid and the cleaning of apparatus and instruments, does the Hearing Officer's limitation achieve the clear distinction he sought to draw?
43. In my judgment, it does not. The limitation "all for use in the elimination of microbes and odours from high and low care areas, chillers, warehouses, transport containers or other defined spaces" does not preclude the Applicant's apparatus from being used for cleaning surgical, medical etc. apparatus and

instruments so that the Hearing Officer's original objection ("the opponents' Class 37 specification is capable of covering the provision of a service that is the function of the applicants' goods" (para. 32)) remains. This is illustrated by the Applicant's evidence at Exhibit 10 to Mr. Boden's witness statement. The Steritrox brochure features a picture of a room (high/low care area). The room contains amongst other things motors and machinery. A caption states: "Steritrox™ sanitises both surfaces and air simultaneously". As regards the motors and machinery: "Gas diffusion process gets into impossible to reach places with full killing power". The room is equipped with an air circulation system. Pertinently, the Steritrox caption informs: "Penetrates deep into chillers and air-con", i.e., chillers are both apparatus/instruments and defined spaces and no sensible distinction can be drawn between cleaning the outside and inside of them. To further illustrate the point, Mr. Mitcheson provided the example of an MRI scanner.

44. Recognising that there may be problems, in particular, with "for use in the elimination of microbes" in the proposed limitation, Mr. Tritton sought to advance a re-re-revised Class 7 specification. As I understand it, this read:

"Cleaning apparatus using ozone in a gaseous state, filtering apparatus using ozone in a gaseous state; all for use in fumigating enclosed spaces."

45. Mr. Mitcheson objected to the re-re-revised specification. He made three points:
- (a) It was too late to propose such an amendment without prior notice at the appeal hearing.
 - (b) The Opponent was entitled to rely on the entire range of goods and services in 2217154.
 - (c) The re-re-revised specification suffers from the same deficiencies as its predecessor especially "enclosed spaces" versus "defined spaces". Moreover, the Opponent's earlier registration covers, e.g., decontamination services in Class 40.

I find each of Mr. Mitcheson's points justified. Mr. Tritton's proposed amendment is rejected.

Conclusion

46. In the result, the appeal succeeds. The parties are agreed in that event the Applicant's appeal against the Hearing Officer's costs order falls away.

Costs

47. The Hearing Officer ordered the Applicant to pay the Opponent the sum of £2,500 as a contribution towards its costs. I will order the Applicant to pay the additional sum of £700 towards the Opponent's costs of this appeal.

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Professor Ruth Annand, 16 July 2007

Mr. Thomas Mitcheson of counsel instructed by David Keltie Associates appeared on behalf of Sterilox Technologies Inc

Mr. Guy Tritton of counsel instructed by Fry Heath Spence LLP appeared on behalf of Ozone Systems Limited

APPENDIX 1

Class 1

Chemicals used in industry, agricultural and science; unprocessed artificial resins; tempering and soldering preparations; chemical substances for preserving foodstuffs; adhesives used in industry; polyurethane coatings; medical-grade polyurethane coatings; medical-grade polyurethane coatings for use in long term implants; medical-grade polyurethane for coating medical devices; detergents; detergents for use in manufacturing operations; degreasing agents and materials

Class 2

Preservatives against corrosion; anti-corrosive coatings, preparations and products; anti-corrosive coatings, preparations and products for use in relation to sterilisation apparatus and medical devices

Class 5

Pharmaceutical, veterinary and sanitary preparations; dietic substances adapted for medical use; preparations for destroying vermin; fungicides; herbicides; sterilising and disinfectant solutions; rinse waters; disinfectants; super-oxidised water; biocidal solutions; biocides for the sterilisation of instruments; sterilisation and disinfection chemicals for use with medical devices; detergents for use in cleaning medical devices; lubricating agents for medical use; lubricating agents for coating medical devices; chemicals used in decontamination; but not including sanitary tampons, sanitary napkins, cotton wool for medical and surgical purposes, plasters, materials for dressing, compresses, swabs, bandages and bands for medical use, filled first aid kits or filled first-aid boxes

Class 9

Computer programs, computer software, computer hardware and computer firmware; computer programs, computer software, computer hardware and computer firmware for monitoring and maintaining local and remote sterilisation systems; scientific, measuring and checking apparatus and instruments; scientific, measuring and checking apparatus and instruments for monitoring and maintaining local and remote sterilisation systems; telecommunication apparatus; modems; telephone cable connection apparatus; computer software and telecommunications apparatus to enable connection to database and the Internet; computer software to enable searching of data; apparatus, installations and devices for electro-chemical treatment of water-based solutions; parts and fittings for all of the aforesaid

Class 10

Surgical, medical, dental and veterinary apparatus and instruments; sterilisation and disinfection apparatus and instruments; apparatus and instruments for producing sterilising and disinfection solutions, super-oxidised water and rinse water; parts and fittings for all of the aforesaid goods

Class 37

Cleaning, repair and maintenance of surgical, medical, dental and veterinary apparatus and instruments; cleaning, repair and maintenance of sterilisation apparatus and instruments, disinfection apparatus and instruments and apparatus and instruments for producing sterilising and disinfection solutions, super oxidised water and rinse water; cleaning, repair and maintenance of apparatus, installations and devices for electro-chemical treatment of water-based solutions; rental, hire leasing of surgical, medical, dental and veterinary apparatus and instruments; rental, hire leasing of sterilisation apparatus and instruments, disinfection apparatus and instruments and apparatus and instruments for producing sterilising and disinfection solutions, super-oxidised water and rinse water; cleaning and degreasing of materials; cleaning and degreasing of implants and medical devices; consultancy, information and advisory services relating to all of the aforesaid

Class 38

Telecommunication of information; telecommunication of information relating to the performance of local and remote sterilisation systems; provision of telecommunication access and links to computer database and the Internet; consultancy, information and advisory services relating to all of the aforesaid

Class 40

Treatment of water; sterilisation and disinfection of materials; decontamination services; treatment of materials with anti-corrosive coatings, preparations and products; treatment of sterilisation apparatus and medical devices with anti-corrosive coatings, preparations and products; treatment of implants and medical devices; coating of implants and medical devices with medical-grade polyurethane coatings; rental, hire and leasing of apparatus, installations and devices for electro-chemical treatment of water-based solutions; consultancy, information and advisory services relating to all of the aforesaid

Class 42

Providing access to and leasing access time to computer data bases; providing access to and leasing access time to computer data bases relating to the performance of local and remote sterilisation systems; consultancy, information and advisory services relating to all of the aforesaid