

O/287/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2567290

BY

OMEGA RED GROUP LIMITED

TO REGISTER THE TRADE MARK:

OMEGA

IN CLASSES 6, 9, 17 AND 37

AND

THE OPPOSITION THERETO

UNDER NO 102089

BY

OMEGA ENGINEERING, INC

1) On 17 December 2010 Omega Red Group Limited (Red) filed an application for the registration of the trade mark OMEGA. The application was published in the Trade Marks Journal on 25 March 2011 with the following specification:

fasteners, clamps, fixings, and couplings all made of metal; metal building materials; non-electric cables and wires of common metal; ironmongery, items of metal hardware; pipes and tubes of metal; parts and fittings for all the aforesaid goods;

lightning conductors; lightning arresters; lightning protection installations, parts and fittings therefor; apparatus and instruments for lightning protection; apparatus and instruments for protecting electrical and electronic apparatus and instruments against lightning; electric controls for lightning protection installations, parts and fittings therefor; fasteners, clamps, fixings, wires, cables, tape, straps and connectors, all for use in lightning protection installations and earthing systems; earthing systems, parts and fittings therefore; earthing conductors; earth rods; earth bars; earthing clamps and electrically conductive metal components for use as earthing; apparatus and instruments for earthing protection; surge protection apparatus;

rubber, gutta-percha, gum, asbestos, mica and goods made from these materials; insulating materials; electrical insulators; high tension insulators; fasteners, clamps, clips, fixings, straps and housings all made from plastic; all of the aforesaid goods being for use in lightning protection installations and earthing systems;

building construction, maintenance and installation services; constructing, erecting, installing, testing and repairing lightning conductors; installing, testing and repairing electric controls for lightning protection installations; maintenance, testing and repair of lightning protection apparatus; constructing, installing, testing and repairing earthing systems; advice and consultancy in relation to all the aforesaid services.

The above goods and services are in classes 6, 9, 17 and 37 respectively 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 22 June 2011 Omega Engineering, Inc (Inc) filed a notice of opposition to the registration of the application. The opposition is based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (the Act), which state:

“(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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

.....there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

3) Inc relies upon two earlier Community trade mark registrations of the trade mark OMEGA; nos 8376311 and 8477820. As neither of these trade marks had been registered for 5 years or more at the date of the publication of the application, they are not subject to proof of use. The trade marks are registered, respectively, for:

machines; machine tools; mechanically operated hand-held surface temperature probe tools and mechanically operated hand-held insertion temperature probe tools; mechanically operated hand-held crimping tools; mechanically operated hand-held or machine-held punches and hole saws and punch tools and saw tools; mechanically operated hand-held or machine-held wire strippers and wire stripper tools; mechanically operated controls for adhesive applying machines; fluidised sand bath machines; mechanically operated circulating bath machines; hand-held mechanically operated ammeter tools, hand-held mechanically operated current probe tools, and hand-held mechanically operated watt meter tools; blowers; air blowers; hand-held mechanically operated heat gun tools; stirring machines; pumps; pumps being parts of machines; carboy drum pumps, chemical dosing pumps, diaphragm metering pumps, drum pumps, electronic metering pumps, gear pumps, large capacity metering pumps, microprocessor based chemical metering pumps, low flow metering pumps, magnetic drive centrifugal pumps, rubber impeller pumps, fluid pumps, peristaltic pumps, metering pumps, chemical metering pumps, vacuum pumps, centrifugal pumps, gear pumps, rubber impeller pumps and hand-held portable transfer pumps, sealed magnetic centrifugal pumps, hand-held dispensing pumps, diaphragm type injector motor pumps, injection pumps, chemical dosing pumps and parts and fittings therefor; valves : valves being parts of machines, pneumatic control valves, and pneumatic valves for controlling pneumatically operated machines; hand-held mechanically operated pH/conductivity meter tools; mechanically operated electrode holders; tubing, being parts of machines; motors for machines except those for household or kitchen devices or ovens for the preparation of foodstuffs; electric motors except those for household or kitchen devices or ovens for the preparation of foodstuffs; fluid pump motors (except for land vehicles); regulation and control apparatus for electric motors (not for land vehicles) and machines; mixing machines; all the above only for use in science and/or industry and none destined for household or kitchen use and none being or relating to ovens for the preparation of foodstuffs and none being products in

class 7 designed specifically for use in services to the oil and gas industries relating to exploration, evaluation and monitoring of oil and gas formations, and none of the foregoing being etching machines or parts and fittings therefor;

scientific apparatus and instruments; electrical and electronic apparatus and instruments; surveying apparatus and instruments; control apparatus and instruments; apparatus and instruments for measuring distance; optical, thermal, chemical, weighing, measuring, signalling, checking (supervision), talking and teaching apparatus and instruments; apparatus for measurement of process and electrical parameters; apparatus and instruments for calculating, including calculating machines; apparatus and instruments for metering, apparatus and instruments for gauging, counting, calibrating, detecting, identifying, indicating, signal conditioning, analysing, displaying, testing, data logging, sensing and controlling variable chemical and physical parameters including temperature, acidity, concentration, humidity, pressure, strain, distance, force, tilt, radiation, speed, flow, level, pH, load, liquid levels, vibration, electrical resistance, air velocity, amperage, frequency, voltage, ion concentration, conductivity, data (acquisition, display and retrieval) and environmental technology; electric soldering irons; adapters; alarms; ammeters; amplifiers; analysers; anemometers; attenuators; barometers; barriers; battery chargers; batteries and battery monitors; blowers; cable; calibrators; pH buffer capsules; conductivity cells; resistance cells; load cells; checkers; compensators; signal conditioners; connectors; electrical connectors; plugs and clamps for connecting thermocouple sensors to instruments for measuring temperature; controllers; converters; counters; dataloggers; detectors; autodialers; telephone dialers; diodes; electrodes; electrical power supplies; power control element feedthroughs; flowmeters; gauges; hygrometers; ice-point reference units; indicating lights; indicators; interfaces; isolators; junction boxes; lasers; liquid crystal labels; temperature labels; loggers; meters, including clocking meters and counters; electrical transformers; pulse transformers; DC-DC converters; inductors; power hybrids; electrical monitors and electric machines; mixers; modules; monitors; multimeters; panels; plotters; plugs; probes; profilers; psychrometers; pyrometers; pyrometer probes; pumps; receivers; recorders; regulators; relays; rotameters; scanners; sensors; simulators; snubbers; sockets; stirrers; switches; tachometers; terminals; testers; thermistors; thermocouples; thermocouple probes; thermocouple assemblies; thermocouple wells; thermocouple blocks; thermocouple heads; thermocouple temperature sensors; thermocouple tubes; thermocouple accessories; cold-junction compensators; read-out meters; thermometers (hand-held, benchtop and panel); infra-red thermometers; thermopiles; thermostats; totalizers; transducers; test plugs; feedthrough unions; bushings; transmitters; tubing used as parts of machines and instruments; valves; voltmeters; wire; wind stations; wind tunnels; weather stations; computers; computer display terminals and monitors; computer peripherals and mouse pads; computer hardware; computer housings; computer interfacing instruments and apparatus; computer software; modems; data acquisition systems; computer interfaces; computer printers; apparatus for retrieving,

transmitting, managing and distributing information; information control and display apparatus; peripheral devices for data acquisition; data transmission equipment; apparatus for measuring, calculating, processing, printing, signalling, display and memorizing data; data carriers with and without data recording means, including magnetic tapes, magnetic discs, floppy discs and optical recording carriers; programs for data processing equipment; electronic instruments and apparatus for the measurement of process parameters and electrical parameters; microprocessor operated data processing apparatus; microprocessor operated apparatus, including indicating and display apparatus, data recording apparatus, data storing apparatus, data registering apparatus, data-measurement and process data transmitting apparatus for wireless and wired and optically-interconnected signal transference; electronic connection cards; electronic measurement indicators; electronic signal indicating panels; electrical indicating instruments; light diodes; liquid crystal indicators; picture tubes; laser scanners; electronic input keyboards; optical and magnetic data recording apparatus; data reproducing apparatus; temperature indicators; temperature measuring instruments and apparatus; moisture indicators; acidity indicators; concentration indicators; distance indicators; rotation indicators; angle indicators; speed indicators; acceleration indicators; power indicators; pressure indicators; voltage indicators; current indicators; brightness indicators; current intensity indicators; magnetic flux indicators; measuring, testing and laboratory equipment; vibration management goods; infra red sensors; lenses; filters; mirrors; beam splitters; attenuators; lamps; laser mounts; laser beam detectors; optical fibers and cables; mounting hardware; positioners; force transducers; load cells; torque measuring transducers; transducer indicators; bolt sensors; transducer simulators; setpoint controllers; digital strain gauge monitor meters; digital monitor meter/controllers; pressure test systems; temperature sensitive crayons, temperature sensitive labels and solid pellets which melt into liquid form when a specific temperature is reached; temperature test kits; pH buffer solutions; wire used for heating; slip rings; thermowells; regulation and control apparatus; video tapes; CD-ROM discs; transducers and sensors for variable parameters, including pressure, strain and flow; measuring, indicating, displaying, controlling, recording, warning, monitoring and display instruments and apparatus; computer interfacing instruments and apparatus; signal conditioning instruments and apparatus; signal amplifiers; temperature measurement products; fittings and connectors for use with temperature measuring instruments; transducers for pressure, strain, force, load, flow and level; temperature probe tools, being parts of automated remotely controlled mechanically operated temperature measuring machines; temperature control mechanisms for industrial plant; automated control machines; tipping bucket rain gauge and snow gauge machines; transducers for distance, displacement, and angular velocity; machine couplings; data acquisition devices; pH instruments; parts, fittings and components for all of the above; with the exception of the aforementioned goods as parts of mass spectrometers and radio position finders, as well as those items of apparatus themselves; all the above for use only in science and/or industry and none relating to time or timing and none destined for

household or kitchen use and none being or relating to ovens for the preparation of foodstuffs and none being computer software for processing seismic data, and related instruction manuals, all for use in services to the oil and gas industries relating to exploration, evaluation and monitoring of oil and gas formations, and other products in class 9 designed specifically for use in service to the oil and gas industries relating to exploration, evaluation and monitoring of oil and gas formations, and none of the foregoing relating to etching machines or parts and fittings therefor,

installations for lighting, heating, steam generation, cooking, refrigerating, drying, ventilating, and water supply but none of the foregoing goods relating to ovens for the food industry; temperature controlling baths; air blowers; commercial, industrial, and process heaters and furnaces; hot plates for laboratories; heating mantels; soft metal heating pots; heat guns; heating tapes; valves; electric heaters; bent tubular heaters; etched heating elements; thin plate immersion heaters; ceramic radiant heating elements; ceramic plate and ceramic ribbon heaters; heating cables; band heaters; enclosure heaters; flexible rope heaters; strip, sheath strip, finned strip and seamless strip heaters; ring heaters; cartridge and sheath cartridge heaters; electric stud heaters; tubular, finned tubular and round tubular heaters; immersion heaters; pipe insert heaters; circulation heaters; nozzle heaters; air duct heaters; infrared panel heaters; radiant ovens; forced air unit heaters; ceiling forced air unit heaters; convection heaters, wall mounted convection heaters; portable forced air heaters; portable radiant heaters; blower heaters; flexible heaters; silicone rubber fiberglass insulated heaters; insulated heaters; flexible heating blankets; drum heaters; bench top muffle furnaces; circulating baths, heating circulating baths; hot plates for the laboratory; heating mantels; high vacuum substrate heaters; compressors; all the above for use only in science and/or industry; but not including vehicle headlamps, and not including parts and fittings for vehicle headlamps and none destined for household or kitchen use and none being or relating to ovens for the preparation of foodstuffs and none being products in class 11 designed specifically for use in services to the oil and gas industries relating to exploration, evaluation, and monitoring of oil and gas formations, and none of the foregoing relating to etching machines or parts and fittings therefor,

catalogues; technical and scientific handbooks; textbooks; posters; displays; technical reference texts : for measuring, controlling, and/or regulating temperature, humidity, pressure, strain, force, flow, level, pH, load, vibration, electrical resistance, air velocity, amperage, frequency, voltage, ion concentration, conductivity, data acquisition, display and retrieval for environmental technology; all the above goods for use in science and/or industry and none relating to computer software for processing seismic data, and related instruction manuals, all for use in services to the oil and gas industries relating to exploration, evaluation and monitoring of oil and gas formations, and other products and services designed specifically for use in services to the oil and gas industries relating to exploration, evaluation and monitoring of oil and gas

formations, and none of the foregoing relating to etching machines or parts and fittings therefor;

data acquisition, display and retrieval; organisation of seminars for commercial or advertising purposes; all the above services for use in science and/or industry and none being services in class 35 designed specifically for use in services to the oil and gas industries relating to exploration, evaluation and monitoring of oil and gas formations, and none of the foregoing relating to etching machines or parts and fittings therefor;

educational, information, teaching, training services and seminars; all the above services for use in science and/or industry and none being services in class 41 designed specifically for use in services to the oil and gas industries relating to exploration, evaluation and monitoring of oil and gas formations, and none of the foregoing relating to etching machines or parts and fittings therefor;

providing on line electronic data through a computer network, including various electronic publications which may be consulted, namely, catalogues, technical and scientific handbooks, textbooks, posters, displays, and technical reference texts; engineering services including scientific and industrial research services and/or making models and designs in the field of equipment for measuring, controlling and/or regulating temperature, humidity, pressure, strain, force, flow, level, distance, pH, load, vibration, electrical resistance, air velocity, amperage, frequency, voltage, ion concentration, conductivity, data acquisition, display and retrieval, and for environmental technology and services; computer software services, including computer programming services for data acquisition, data display and data retrieval, measuring, controlling and/or regulating temperature, electric heaters, flow and level technology, pH, conductivity technology, pressure, strain, force technology and environmental technology; all the above services for use only in science and/or industry; and none of the foregoing services relating to the measurement or indication of time or to timing and none of the foregoing services including services of investigation of pharmaceutical products, chemical investigations, genealogy, cosmeticology and bacteriology and not including services in class 42 designed specifically for use in services to the oil and gas industries relating to exploration, evaluation and monitoring of oil and gas formations, and none of the foregoing relating to etching machines or parts and fittings therefore.

The above goods and services are in classes 7, 9, 11,16, 35, 41 and 42 respectively 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.

scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, checking (supervision), life-saving and teaching apparatus and instruments; measuring and signalling apparatus and instruments not relating to

timing, speed, distance, height nor breadth; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, fire-extinguishing apparatus; radio frequency shielding for electrical currents; radio frequency switches; limit switches; data logging and capture devices and apparatus; ferrite elements to control stray radio frequency currents; apparatus for radio telemetry identification or tracking of animals, people, vehicles, goods or parcels; radio frequency transponders located on or within animals or parcels for identification and location and data logging; parts and fittings for all the aforementioned goods in class 9;

telecommunications; management services in the form of controlling systems of control devices by radio frequency transmission and radio frequency reception; radio frequency telecommunication services; broadcast radio frequency access control services; radio frequency signalling, counting and enumeration services; telecommunication surveying services;

temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; provision of subscriptions for users of these services; ferrite protection services to control stray radio frequency emanations; identifying the proximity of radio frequency responsive identification modules and switching electrical devices by broadcast of radio frequency signals; protection of electric circuits from radio frequency corruption.

The above goods and services are in classes 9, 38 and 42 respectively 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) Red filed a counterstatement.

5) No evidence was adduced. Both sides furnished written submissions.

Average consumer, nature of purchasing decision and standard for likelihood of confusion

6) As the trade marks are identical there is nothing to distinguish between them; consequently, the nature of the average consumer and the nature of the purchasing decision will not have an effect upon the likelihood of confusion. (In relation to section 5(1) it is a matter of fact as to whether the trade marks are identical and whether the goods are identical.)

Comparison of goods and services

7) Red refers to a practice amendment notice of the registrar, PAN 5/06, issued in relation to specifications which are too wide or too vague. In its application of this notice it conflates width with vagueness. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267, Neuberger J stated:

“The purpose of skin lightening cream is to alter and, presumably, from the point of view of the consumer, to improve the colour, and hence the appearance, of the consumer's skin. In those circumstances, it appears to me that, as a matter of ordinary language, such cream is within “cosmetics”, giving that words its ordinary meaning. As to dry skin lotion, I consider that, as a matter of ordinary language, it would probably fall within “toilet preparations” as well as “cosmetics”. I should add that I see no reason to give the word “cosmetics” and “toilet preparations” or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. **In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.**”

(emphasis added)

It is also to be noted that the earlier registrations are Community trade mark registrations. The Court of Justice of the European Union (CJEU) in *Chartered Institute of Patent Attorneys v Registrar of Trade Marks* Case C-307/10 held:

“Directive 2008/95 must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark.”

This judgment relates to the requirements in relation to an application, it does not relate to the terms within an existing registration; terms which may be wide but can be understood.

8) Red refers to the products available on the website of Inc and tries to distinguish between the businesses of itself and Inc. The current, or past, marketing undertaken by the parties is not relevant to the issues to be determined, as the General Court (GC) stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors – whether carried out or not – which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

The same reasoning can be seen in *Phildar SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-99/06, *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-116/06, *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 147/03, *Sadas SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-346/04 and *Daimlerchrysler AG v Office for Harmonization In the Internal Market (Trade Marks and Designs) Case T-358/00*.

9) The comparison to be made is between the goods and services of the application and the goods and services of the earlier registration, in their full gamuts.

10) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of tradeⁱ”. Consideration should be given as to how the average consumer would view the goodsⁱⁱ. In assessing the similarity of services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementaryⁱⁱⁱ. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods and services^{iv}. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^v. Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the GC explained when goods are complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

Goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application^{vi}.

11) In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97 the CJEU stated:

“22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

The court required evidence of similarity to be adduced. This finding has been reiterated by the CJEU and the GC; eg in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-316/07:

“43 Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24;

and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

The above part of the *Canon* judgment has been more recognised in the breach than in the observance in this jurisdiction. It may not always be practical to adduce evidence of similarity; it may be that the nature of the goods and/or services is so well-known that it would be a waste of effort and resources to do so. However, it is for the opponent to establish its case. In relation to the claimed identity and/or similarity of the respective goods and services, Inc has made very limited submissions and furnished no evidence.

12) The majority of the goods and services of the application are or relate to *lightning protection* or *lightning conductors*. Definitions in relation to lightning conductors are given below:

The Penguin Dictionary of Science

“An earthed, pointed, metal structure on the top of a tall building or other elevated structure that is designed to protect against lightning. An electric field in the atmosphere causes the conductor to accumulate induced charge at the point, which intensifies the field and causes the breakdown to occur there rather than on other parts of the structure.”

The Macmillan Encyclopaedia

“An earthed conducting rod placed at the top of buildings, etc., to protect them from damage by lightning. It acts by providing a low-resistance path... to earth for the lightning current.”

The Penguin English Dictionary

“a metal rod fixed to the highest point of a building or mast and connected to the earth or water below as a protection against damage by lightning.”

13) Inc submits:

“Taking for example earlier Community Trade Mark Registration No. 8477820, its class 9 list of goods includes “electric ... apparatus and instruments”, without any qualification whatsoever. The class 9 goods listed in the opposed application are all electric in nature so that all of these class 9 goods are identical to such goods of this earlier registration. Furthermore, to the extent that the class 6 and class 17 goods listed in the opposed application for such goods as are listed in class 9, they are also identical, or at least similar to such goods set out in class 9 of this earlier registration.

Furthermore, insofar as the services set out in class 37 of the opposed application are in relation to goods set out in class 9 thereof, they are similar to electric apparatus and instruments referred to in the class 9 list of goods of the earlier registration.

Similar arguments apply to the “electrical and electronic apparatus and instrument” listed in class 9 of earlier Community Registration No. 8376311 notwithstanding that these are limited to those for science and industry by virtue of the limitation towards the end of the list. This is because no restriction has been imposed on the goods and services listed in the opposed application that would exclude them for use in science and/or industry.

Some of the specific goods listed under class 9 of the earlier application have a one to one correspondence with goods listed in Community Trade Mark Registration No. 8376311. For example, “connectors” in the application correspond to “plugs” in the registration. “Wires” in the application correspond to “wire” in the registration. “Cables” in the application correspond to “cable” in the registration. “Fasteners, clamps, fixings, and couplings” in the application correspond with “fittings and connectors” (albeit for use with temperature measuring instruments) in the registration. “Parts and fittings therefor” of the application correspond with “parts, fittings and components for all of the above” in the registration.”

Inc also submits that “[t]he applicant argues that further, or alternatively, lightning conductors and so on are in any event not electric apparatus or instruments. This is plainly not true because lighting is electricity”. Electric apparatus or instruments defines products that are powered by electricity, this is not the case, for example, for a lightning conductor. The latter product would not be encompassed by the former products no more than *signalling instruments and apparatus* would include public information display apparatus because the latter product receives signals^{vii}.

14) There is nothing in the arguments of Inc to support the claim that *lightning conductors* and *lightning arresters* are identical to any of the goods of its earlier registrations. There is nothing to suggest that these goods are similar to any of the goods and services of the earlier registrations within the parameters of the case law.

15) In *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-336/03 the GC stated:

“61 The applicant’s arguments can only be rejected. It is true that computers in different forms are necessary for the proper operation of ‘instruments and installations for telecommunication’ and ‘telephone-answering service (for temporarily absent subscribers)’ may occasionally

be supplied by the body which manufactures the necessary equipment, but that is not enough to conclude that those goods and services are similar, still less „very similar”. The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

A finding reiterated by the GC in *Promat GmbH v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle) (HABM)* Rechtssache 71/08^{viii}. Consequently, an installation is not necessarily similar to the parts which make it up. *Lightning protection installations* may include parts that are covered by the earlier registrations but this does not bring about similarity. The goods are not fungible with the goods and services of the earlier registrations, they are not in competition. They do not have a close or dependent relationship with the goods and services of the earlier registrations and so are complementary. Their purpose is singular and discreet and one that is not shared by the goods and services of the earlier registrations. The end users of the goods will be defined by the purposes of the goods and will not be the same end users as those of the goods and services of the earlier registrations. There is no reason that they would share the same channel of trade. *Lightning protection installations* are not similar to the goods and services of the earlier registrations.

16) Similar considerations apply in relation to *apparatus and instruments for lightning protection, earthing systems; earthing conductors; earth rods; earth bars; earthing clamps and electrically conductive metal components for use as earthing; apparatus and instruments for earthing protection*. They are neither identical nor similar to the goods and services of the earlier registrations.

17) Various of the goods of 8376311 could also be *parts and fittings for lightning protection installations, electric controls for lightning protection installations and/or earthing systems* and so, although for a different end purpose, would be highly similar.

18) *Electric controls for lightning protection installations* are encompassed by *electric apparatus and instruments* and so are identical as are the *parts and fittings therefore. Fasteners, clamps, fixings, wires, cables, tape, straps and connectors, all for use in lightning protection installations and earthing systems* could all be included in the parts and fittings of 8477820, which are not limited, and so must be considered to be identical.

19) None of the goods of the earlier registrations would serve the same purpose as *apparatus and instruments for protecting electrical and electronic apparatus and instruments against lightning or surge protection apparatus*. The respective goods are not fungible and there is no close or dependent relationship between them, they are neither competitive nor complementary. The purpose of the

goods is different to those of the goods and services of the earlier registrations. There is nothing to suggest, and no evidence to the effect, that the respective goods and services will follow the same channels of trade or have the same nature. The aforesaid goods are neither similar nor identical to the goods and services of the earlier registrations.

20) The earlier registrations of Inc do not include goods in classes 6 or 17. Goods may be in two classes where they have a dual function eg clock radios are in classes 14 and 9; outwith this the class in which goods are placed will restrict and define them, as per *Altecnic Ltd's Trade Mark Application* [2002] RPC 34; so valves in classes 7 and 11 are not the same. Other than bald assertion, Inc has put forward no clear argument, or evidence, as to how the goods in class 6 and 17 of the application are similar to the goods of the earlier registrations. The parts and fittings in the class 9 goods of the earlier registrations must fall within class 9 and so be different to the class 6 and 17 goods of the application. The class 17 goods of the application are also all for the specific purpose of for being used in lightning protection installations and earthing systems. The class 17 goods, therefore, have a different purpose to any of the goods of the earlier registrations and will follow a different channel of trade. *Tubing, being parts of machines, thermocouple tubes, tubing used as parts of machines and instruments* and *picture tubes* appear in the earlier registrations. *Picture tubes* are not tubes in the sense of being circular metal objects. The others are all specifically designed for use in machines. The tubes of metal of the application are simply goods of metal in the form of a tube. These goods will not coincide with the tubing or tubes of the earlier registrations within the parameters of the case law. The difference between the class 6 goods and the goods of the earlier registration is typified by the way certain of them are defined ie: *non-electric cables and wires of common metal*. They are not the types of wire and cable that is found in class 9. Inc makes no explanation as to how *ironmongery* or *items of metal hardware* are similar to the goods of its earlier registrations.

21) Inc has failed to establish that the class 6 and 17 goods of the application are similar to the goods of the earlier registrations. Indeed, for the most part, Inc has failed to put forward any explanation or reasoning to support the claim. The class 6 and 17 goods of the application are not similar to the goods and services of the earlier registrations.

22) Inc submits:

“Furthermore, insofar as the services set out in class 37 of the opposed application are in relation to goods set out in class 9 thereof, they are similar to electric apparatus and instruments referred to the class 9 list of goods of the earlier registration.”

The services do not relate to the goods of the class 9 registrations and so by Inc's own argument, the services are not similar. The services of the application

do not coincide with the goods and services of the earlier registrations within the parameters of the case law. The services of the application are not similar to the goods and services of the earlier registrations.

Conclusion

23) Sections 5(1) and 5(2)(a) can only come into play if the goods and services are identical or similar respectively. Where the goods are neither, the opposition of Inc must fail.

24) Red refers to the distinctiveness of Omega in its submissions. Certain of the goods are identical and so are debarred from registration under section 5(1) of the Act. In relation to the similar goods the alleged lack of distinctiveness of the earlier trade mark is not relevant. This issue of distinctiveness comes into play in the global appreciation where there are differences between trade marks. Where a trade mark has limited distinctiveness the average consumer will distinguish another trade mark by small differences. Where the trade marks are identical, there is nothing by which the average consumer can distinguish the trade marks and so the distinctiveness of the earlier trade mark will not come into play. The approach of Red disregards the identity of the trade marks and concentrates on the claimed lack of distinctiveness of the earlier trade mark (see *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-235/05 P*)

25) The application is to proceed to registration for all of the goods and services in classes 6, 17 and 37 and for the following goods in class 9:

lightning conductors and lightning arresters; lightning protection installations; apparatus and instruments for lightning protection; apparatus and instruments for protecting electrical and electronic apparatus and instruments against lightning; earthing systems; earthing conductors; earth rods; earth bars; earthing clamps and electrically conductive metal components for use as earthing; apparatus and instruments for earthing protection; surge protection apparatus.

Costs

26) Red having been successful in the most part, it is entitled to a contribution towards its costs. Costs are awarded upon the following basis:

Preparing a statement and considering the other side's statement:	£200
Written submissions:	£100
Total:	£300

Omega Engineering, Inc is to pay Omega Red Group Limited the sum of £300. 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 the 27th of July 2012

**David Landau
For the Registrar
the Comptroller-General**

ⁱ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

ⁱⁱ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

ⁱⁱⁱ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{iv} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^v He considered that the following should be taken into account when assessing the similarity of goods and/or services:

(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 service;
(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.”

^{vi} See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05 paragraph 29:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

^{vii} See *Omega SA v Omega Engineering Inc* [2003] FSR 49 at paragraph 5.

^{viii}“33 Auch wenn, wie die Klägerin in der mündlichen Verhandlung ausgeführt hat, Mineralfasern und Werg denselben Ursprung haben können, genügt dies nicht, um die Ähnlichkeit der betreffenden Waren festzustellen. Die bloße Tatsache, dass ein Produkt als Einzelteil, Zubehör oder Komponente einer anderen Ware verwendet wird, reicht nicht als Beweis dafür aus, dass die diese Komponenten enthaltenden Endprodukte einander ähnlich sind (Urteil des Gerichts vom 27. Oktober 2005, Éditions Albert René/HABM – Orange [MOBILIX], T-336/03, Slg. 2005, II-4667, Randnr. 61).”