

**O-027-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3071829  
BY  
HMS DECORATIVE SURFACING LIMITED  
TO REGISTER A SERIES OF TWO TRADE MARKS**

**decra  
&  
DECRA**

**IN CLASSES 1, 2, 17 AND 19**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 403566  
BY  
DEKRA E.V.**

## BACKGROUND

1. On 9 September 2014, HMS Decorative Surfacing Limited (the applicant) applied to register the above trade mark in classes 1, 2, 17 and 19 of the Nice Classification system<sup>1</sup>, as follows:

**Class 1**

Epoxy resin adhesives.

**Class 2**

Epoxy resin coatings for use in bonding to aggregates to decorate and dress exterior surfaces, namely roads, paths, driveways, walkways, cycle ways, courtyards, patios and footpaths; waterproof coatings.

**Class 17**

Thermosetting resins; synthetic resins.

**Class 19**

Exterior decorative surfacing and dressing materials, comprising aggregate, paving stone, stone, gravel, asphalt, steel, wood, concrete, screed and screed coatings; road repair materials; concrete coatings and cementitious protective coatings for roads, paths, driveways, walkways, cycle ways, courtyards, patios and footpaths.

2. The application was published on 17 October 2014, following which Dekra e.V. (the opponent) filed a notice of opposition against the application.

3. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (the Act) and is directed at all of the goods in the application. The opponent relies upon the following Community Trade Marks (CTMs) in respect of its opposition:

Mark details and relevant dates	Services relied upon
<b>CTM:</b> 2386597 DEKRA <b>Filed:</b> 25 September 2001 <b>Registered:</b> 2 September 2003	<b>Class 42</b> Technical consultancy
<b>CTM:</b> 11792066 DEKRA <b>Filed:</b> 3 May 2013 <b>Registered:</b> 19 August 2014	<b>Class 42</b> Construction and design planning and consultancy; technical consultation services

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<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

4. The applicant filed a counterstatement in which it denies the grounds on which the opposition is based.

5. Both parties filed evidence and written submissions in lieu of attendance at a hearing. Neither side asked to be heard. Both sides seek an award of costs in their favour.

6. I make this decision following a review of all of the papers before me.

### **Evidence**

7. I do not intend to summarise the evidence here but will refer to it as necessary in this decision. It consists of the following:

#### Opponent's evidence

The opponent did not file evidence during this period but reserved the right to file evidence in reply.

#### Applicant's evidence

A witness statement of Simon Green dated 23 June 2015 with 6 exhibits.

#### Opponent's evidence in reply

A witness statement of David John Newton dated 2 September 2015 with 4 exhibits.

### **DECISION**

8. The opposition is brought under section 5(2)(b) which reads as follows:

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

(a)...

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

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

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. The opponent relies on two earlier marks, CTM 2386597, which had been registered for more than five years at the date of publication of the application and CTM 11792066, which had not (meaning that the proof of use requirements set out in section 6A of the Act, do not apply to this latter mark<sup>2</sup>). Since the latter is also relied upon for a broader specification than the former, it represents the opponent’s best case and it is this mark which I will use for the purposes of determining this opposition.

### **Section 5(2)(b) case law**

11. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## Comparison of goods and services

12. The goods and services to be compared are as follows:

The opponent's services	The applicant's goods
<p><b>Class 42</b></p> <p>Construction and design planning and consultancy; technical consultation services</p>	<p><b>Class 1</b> Epoxy resin adhesives.</p> <p><b>Class 2</b> Epoxy resin coatings for use in bonding to aggregates to decorate and dress exterior surfaces, namely roads, paths, driveways, walkways, cycle ways, courtyards, patios and footpaths; waterproof coatings.</p> <p><b>Class 17</b> Thermosetting resins; synthetic resins.</p> <p><b>Class 19</b> Exterior decorative surfacing and dressing materials, comprising aggregate, paving stone, stone, gravel, asphalt, steel, wood, concrete, screed and screed coatings; road repair materials; concrete coatings and cementitious protective coatings for roads, paths, driveways, walkways, cycle ways, courtyards, patios and footpaths.</p>

13. Factors which may be considered in making this comparison include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)*<sup>3</sup>(hereafter Treat) for assessing similarity between goods and 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 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, taking into account how goods/services are classified in trade.

14. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (*Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

15. The comments of Daniel Alexander, sitting as the Appointed Person, in *LOVE*<sup>4</sup>, which dealt with similarity of goods but by analogy is relevant to similarity of services, are also to be borne in mind:

“18... the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

16. And at paragraph 20 where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers

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<sup>3</sup>[1996] R.P.C. 281

<sup>4</sup>BL O/255/13

may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

17. Where appropriate I will, for the purposes of comparison, group related services together in accordance with the decision in *Separode Trade Mark*<sup>5</sup>:

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

18. When considering the services I am mindful of the decision in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16, in which Jacob J 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 meaning attributable to the rather general phrase.”

19. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

“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 trade”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

20. I will also bear in mind Floyd, J's statement in *YouView TV Ltd v Total Ltd*:<sup>6</sup>

“...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

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<sup>5</sup> *BL O-399-10*

<sup>6</sup> [2012] EWHC 3158 (Ch) at [12]

21. 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 were 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).”

22. In its submissions the applicant draws my attention to the decisions in *Avnet* and *You View* and concludes that, *“the respective specifications as filed have no common element that would cause a likelihood of confusion”*.

23. In its submissions, dated 21 October 2015, the opponent states:

*“13. It is clear from the Applicant’s evidence and counterstatement, that its main contention as to why the contested goods should not be considered as similar to the Opponent’s services is based on the assertion that the Opponent’s commercial interests are distinct from those of the Applicant. However, the comparison of the goods and services must be based on the wording indicated in the respective lists of goods and/or services. The actual goods and/or services being marketed is not relevant for the assessment of the likelihood of confusion (see Judgment of the General Court of 16/06/2010, T-487/08, ‘Kremezin’, para. 71).*

*14. There can be no doubting that the contested goods are similar to the Opponent’s services on an ordinary reading of the respective lists of goods and services. Technical consultancy, and technical consultation services, covered by the earlier marks are broad categories which could readily include technical consultation in relation to all the contested goods, i.e. technical consultancy in relation to epoxy resin adhesives, or technical consultancy in relation to waterproof coatings. Further, even though it is not required, the Opponent has provided evidence at Exhibit DJN-04 showing that the earlier marks have been used for technical consultancy in relation to some of the contested goods, namely, epoxy resin adhesives.*

*15. Further, technical consultancy; construction and design planning and consultancy; technical consultation services are very broad categories which could all readily include such services related to the contested goods. By its own admission the Applicant “is known commercially as the ‘Highways Maintenance Specialist surfacing contractor,’ offering high quality surface finishes of roadways, pathways, walkways etc” (paragraph*



14 of Simon Green's Witness Statement) and in order to perform these services using combinations of various items of the contested goods it will be necessary to carry out a technical consultation of the surface to be covered prior to the design and construction planning. Consequently, the users of the Opponent's services would be persons who require surface finishes using the contested goods; the users of the contested goods could be persons who might be planning and/or designing the surface finishes for themselves or for others. Thus, the services and goods serve the same purpose and have the same users.

16. The contested goods are necessary for the provision of those services of the Opponent related to such goods. As such, the contested goods are similar to the services covered by the earlier marks, at the very least on account of being complementary.

17. As it is possible for the user to purchase the contested goods independently and cover exteriors and the like for themselves, rather than employ a contractor, the contested goods are at least to some degree in competition with the Opponent's services."

24. As the opponent correctly states, the comparison I must make is a notional one based on the goods and services relied on by the parties in their respective specifications. I note that the opponent refers, at paragraph 15 of its submissions, to the way in which the applicant markets its business. This argument does not assist for the reasons outlined in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-147/03*, in which the Court of First Instance (now the General Court) said:

"104. Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim 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, whether carried out or not, and naturally subjective, of the trade mark proprietors."

25. The applicant's goods in class 1 are *epoxy resin adhesives*. There are goods used in a wide range of applications by those who need to bond something, whether to itself or to something else. Whilst some such adhesives are for general use and will be used by the general public, others may have a particularly technical purpose and be used by those in trade such as e.g. boat builders or model makers who use them to bond fibreglass or civil engineers who use them in the construction of bridges. For the more technical applications it may be that the user seeks advice from a technical consultant as to the best product to use to suit his purpose or he may approach things from a slightly different angle and seek advice as to whether a

particular product is suitable for use to which he intends it to be put. That advice may be sought from someone who supplies *technical consultation services*. *Construction and design planning and consultancy services* may also include giving advice as to what products are suitable for particular applications. To this extent there may be some overlap in the users of the respective goods and services, however the core meaning of the consultancy services is the giving of advice whereas the goods are a product for bonding. The natures of the respective goods and services differ greatly as do the respective uses. I have no evidence that it is usual practice for those providing technical advice, which could be on any number of issues, also to provide goods (though they may provide advice on where such goods can be obtained) and thus there is no overlap in the channels of trade nor is the service indispensable for the use of the goods or vice versa. Taking all matters into account, I find that the respective goods and services are dissimilar.

26. The remainder of the applicant's goods are coatings, resins or materials for use as decorative surfacing and dressing or the repair of roads. For the reasons given above, whilst they may also be used by those who seek technical advice, they are dissimilar goods to the planning and consultation services as relied upon by the opponent as the natures of the respective goods and services differ greatly and there is no overlap in the respective uses or channels of trade nor is one indispensable to the use of the other.

### **Likelihood of confusion**

27. I have found that the respective goods and services are dissimilar. I note the decision in *Waterford Wedgwood plc v OHIM*<sup>7</sup>, in which the CJEU stated:

“35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

28. In view of my finding that the goods and services are dissimilar, there is no need for me to go on to consider the likelihood of confusion. The opposition fails.

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<sup>7</sup> Case C-398/07

## **CONCLUSION**

**29. The opposition fails under section 5(2)(b) of the Act.**

## **COSTS**

30. The opposition having failed, the applicant is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£300
Preparing evidence and considering the other side's evidence:	£300
Written submissions:	£200
<b>Total:</b>	<b>£800</b>

31. I order Dekra e.V. to pay HMS Decorative Surfacing Limited the sum of £800. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19<sup>th</sup> day of January 2016**

**Ms Al Skilton  
For the Registrar,  
The Comptroller General**