

O-174-16

TRADE MARKS ACT 1994

**IN THE MATTER OF UK REGISTRATION 3040924
IN THE NAME OF AMBASSADOR POOLS LIMITED
IN RESPECT OF THE FOLLOWING TRADE MARK IN CLASS 1:**

Aqua Klear pool and spa chemicals

AND

**AN APPLICATION FOR INVALIDITY (500885) BY
WATERSIDE LEISURE LIMITED**

Background and pleadings

1. UK trade mark 'Aqua Klear pool and spa chemicals' was filed by the opponent, Ambassador Pools Limited on 5 February 2014 in respect of the following goods in class 1: Water treatment chemicals for use in swimming pools and spas. The mark was subsequently registered on 11 November 2014.
2. The applicant for invalidity, ('the applicant'), Waterside Leisure Limited, relies upon section 5(2)(b) of the Trade Marks Act 1994 (the Act), arguing that its mark 'Aquaclear' (filed on 3 April 2013 and registered on 19 July 2013) in respect of the following goods in class 1: Swimming pool chemicals; spa and hot tub chemicals is an earlier mark which is similar to that of the opponent's mark and is for identical or similar goods.
3. The opponent filed a counterstatement on 3 September 2015 denying the claim, in which it makes the following points:
 - a) The marks differ in that the applicant's mark is the single word Aquaclear whilst the opponent's mark is several words 'Aqua Klear pool and spa chemicals', and that the opponent's mark is spelled with a K rather than a C.
 - b) The applicant does not use the mark Aquaclear on its website and instead sells products of other companies.
 - c) The opponent sells a 'complete range of pool chemicals' in contrast to the applicant.
 - d) 'Aqua' is descriptive for products related to water.
4. Point b) is not a pertinent argument. Given its date of registration, the applicant's mark had not been registered for more than five years by the date of the publication of the proprietor's application (1 August 2014). The proof of use requirements in section 6A of the Act are therefore not applicable and the applicant is not required to prove use of its mark. The effect of this is that the applicant is entitled to rely on its earlier mark in these proceedings for the goods for which it is registered without having to prove that it has been used. I need say no more about this line of argument.
5. The applicant replied to the opponent's counterstatement in the form of submissions and a witness statement filed on 9 September 2015. In these the applicant incorrectly cites section 10(2)(b) of the Act as the relevant test. This is the test for infringement, however this is an application for invalidity. The correct test is therefore found in section 5(2)(b) as raised in the application, though the wording is similar:

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 and 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.

6. The applicant addresses the opponent's claims (which I have grouped as (a) to (d) above) in its submissions which will not be summarised but dealt with at the appropriate juncture below. The applicant's witness statement is in the name of Simon Chadwick, director of Waterside Leisure Limited. Points of substance are the contention that contrary to the opponent's claim, the applicant's website does feature the Aquaclear brand, and that the applicant's goods do constitute a 'complete range' of pool and hot tub chemicals.
7. The opponent referred to evidence in its counterstatement but this was withdrawn prior to filing and was not filed subsequently. No hearing was requested and so this decision is taken on the basis of the papers before me.

DECISION

8. 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;

- (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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

9. The goods to be compared are as follows, all in class 1:

Opponent

Water treatment chemicals for use in swimming pools and spas.

Applicant

Swimming pool chemicals; spa and hot tub chemicals

10. The goods are identical. This is so notwithstanding arguments of either side as to specifically what chemicals are included in their respective portfolios. A mark is entitled to protection for any goods covered by the specification for which it is registered, and the decision must be taken on the basis of these specifications. This also addresses the opponent's argument which I list at paragraph 3(c) above.

Comparison of marks

11. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.

12. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

13. The respective trade marks are shown below:

| Applicant's Mark | Opponent's Mark |
|-------------------------|-----------------------------------|
| Aquaclear | Aqua Klear pool and spa chemicals |

14. The overall impression of the applicant's mark is based on the two conjoined words of which it is comprised, 'Aquaclear'. Aqua- is commonly understood to mean water, and the suffix -clear has its ordinary meaning. The overall impression is not materially dominated by either of the conjoined words.

15. The overall impression of the opponent's mark is based on the six words of which it comprises, and strongly dominated by the words Aqua Klear given the wholly descriptive nature of the other four words, which accordingly have limited relative weight. The words 'Aqua' and 'Klear' hang together as a unit.

16. In terms of aural similarity, the first two words of the opponent's mark and the applicant's mark will be pronounced identically. The words 'pool and spa chemicals' are not present in the applicant's mark, however given my assessment of the relative weight these words play, this difference is not significant. I also note that, although just a rule of thumb, the first parts of a mark

normally carry the greater significance (see for example *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02). I assess the aural similarity as high.

17. In terms of visual similarity, the opponent's mark is four words longer than the applicant's mark, however the first four letters of both marks are identical. There then follows a 'c' in the applicant's mark, and a 'K' in the opponent's mark separated by a space. The following four letters are also identical between the marks. Given my earlier comments regarding the limited relative weight of the words 'pool and spa chemicals', I assess the visual similarity as high.

18. In terms of conceptual similarity, the marks share the conceptual identity in the phrase 'aqua clear', being something that cleans or clarifies water, or of water that is clear or is to be used for cleaning or clarifying. They differ in the four qualifying words present in the opponent's mark 'pool and spa chemicals', but again these have little relative weight. Conceptually the marks are similar to a very high degree, if not identical.

Average consumer and the purchasing act

19. The average consumer of the relevant goods are the general public buying for private pools and hot tubs, as well as business users such as hotels, gyms and spas. The goods will be selected primarily online or over the phone where visual and aural considerations will play broadly equal parts. The goods are a frequent purchase owing to ongoing upkeep of water quality and an average degree of care and attention will be taken.

Distinctive character of the earlier trade mark

20. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant

section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).

21. The earlier mark consists solely of the conjoined words 'Aquaclear'. I have no evidence of the market share held by the mark, nor the intensity of its use or geographical range. I have evidence from Mr Chadwick that the applicant is the sole UK supplier for Shoreline Hydrotherapy, though I have no evidence as to who they are or how their relationship with the applicant is significant. Neither is it clear from Mr Chadwick's evidence how long the Aquaclear brand has been in operation. As such, the evidence does not assist and I have only the mark's inherent characteristics to consider.
22. The word 'Aquaclear' is made up of two elements: 'Aqua-', meaning 'water' in Latin, and '-clear' having its ordinary definition. As the opponent notes in its counterstatement and summarised at paragraph 3(d) above, the word 'aqua' is suggestive of water. 'Aquaclear' therefore suggests 'clear water', which is strongly allusive of the outcome sought by customers purchasing the applicant's products.
23. However, as the applicant describes in paragraph 13 of its submissions, both marks are registered, and a registered mark must be assumed to have at least some distinctive character (*Formula One Licensing BV v OHIM*, Case C-196/11P). Accordingly I find that the earlier mark is of low distinctive character.

Likelihood of Confusion

24. In assessing the likelihood of confusion, I must adopt the global approach set out in case-law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.
25. I have found that the goods are identical and will be selected by the average consumer, who may be a member of the general public as well as a business user, via a visual and aural selection process with an average degree of care and attention. The earlier mark is possessed of a low distinctive character, and the respective marks are aurally and visually similar to a high degree and conceptually similar to a very high degree.

26. I also bear in mind that a mark bearing a weak distinctive character does not necessarily preclude a likelihood of confusion, as in *L'Oreal SA v OHIM*, case C-235/05 P where it was said:

45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.

27. In the present case, bearing in mind the legislation and case law and having regard to all the relevant factors identified above, I find that there is a likelihood of direct confusion, i.e. that notwithstanding the differences between the marks, the similarities are so striking that they will lead the average consumer to mistake one mark for another. This is particularly so where the difference between the K and the C, and the fact that one mark is comprised of conjoined words whilst the other is not, may be lost to the imperfect recollection of the consumer, and where the addition to one mark of words descriptive of the goods of both marks does not serve to distinguish one mark from the other.

Conclusion

28. The applicant has been successful in its application for invalidity of the opponent's mark on the basis of section 5(2)(b) of the Act. Therefore, subject to appeal, the opponent's mark is cancelled and declared invalid.

Costs

29. The applicant has been successful and is entitled to a contribution towards its costs. I note that the applicant's submissions, whilst well-reasoned, were not based upon the correct pleadings, nor any case law. In the circumstances I take Tribunal Practice Notice 4/2007 as my starting point, but make the award of costs as below:

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|---|------|
| Preparing a statement and considering the other side's statement: | £200 |
| Preparing submissions and evidence: | £200 |
| Official fee: | £200 |
| Total: | £600 |

30. I therefore order Ambassador Pools Limited to pay Waterside Leisure Limited the sum of £600. The above sum should 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 6th day of April 2016

**Andrew Wall
For the Registrar**