

O-433-16

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION BY
WYKAMOL GROUP LIMITED
UNDER NO 3127524 FOR THE SERIES OF TRADE MARKS**

NeverWeather

AND

Never Weather

AND

**IN THE MATTER OF OPPOSITION NO. 405772 THERETO BY
NeverWet LLC**

THE BACKGROUND AND THE PLEADINGS

1) On 17 September 2015 Wykamol Group Limited filed application no. 3127524 to register the following series of trade marks:

Series: 1

NeverWeather

Series: 2

Never Weather

The goods for which registration is sought are as follows:

Class 1: *Damp proofing compositions [other than paints];Damp proofing preparations, except paints, for masonry;Impregnants for exterior surfaces of buildings [other than paints or oils];Impregnants for facades of buildings;Impregnating agents for brickware;Impregnating agents for concrete;Impregnating agents for mortar;Impregnating agents for plaster;Sealants [chemicals] for the sealing of surfaces;Sealing compounds for use in building [chemical];Water repellent compositions;Water repellent coatings [chemical, other than paints] for masonry;Water repellents [chemical];Water resistant protective surface coatings [chemical, other than paints];Silicone fluids;Waterproofing chemical compositions;Anti-damp insulating compositions [other than paint];Chemical compositions for injection into building structures;Chemical compositions for preserving stonework;Chemical compositions for sealing slate;Chemical compositions for use in the building industry;Chemical compositions for use in the civil engineering industry;Chemical compositions for use in the construction industry;Coating compositions [chemicals], other than paint;Coating compositions [not paint] for protection against the effects of water;Coating compositions for protection against the effects of chemicals;Compositions for preserving brickwork [except paints or oils];Compositions for preserving concrete [except paints or oils];Damp proofing compositions [other than paints].*

Class 2: *Damp proofing paints;Damp proofing preparations [paints] for masonry;Damp resisting preparations [paints;Sealant primers;Sealants in the nature of paints;Sealants [paints];Sealing liquids [preservatives] for wood;Sealing preparations for floors [paint];Sealing preparations [paint];Stabilising preparations in the nature of coatings;Substances (chemical-) [paints] for inhibiting attacks from water;Substances [paints] for inhibiting attacks from water;Substances [paints] for inhibiting damage from oil;Surface coatings in the nature of paint;Surface treatment materials in the nature of paints;Water repellent coatings [paints] for masonry;Water repellent fungicidal wood stains;Water repellent paints;Water repellents in the nature of paints;Water resistant protective surface coatings [paints];Water sealant preparations [paints];Waterproof coatings [chemical, paints];Waterproof coatings [paints];Waterproof paints;Waterproofing preparations [paint];Weather resistant coatings [paints];Weather sealing stains;Weathering preservatives [paints];Weatherproofing coatings [paints];Weatherproofing coatings [paints] for concrete;Weatherproofing coatings [paints] for masonry;Materials [paints] for damp proof treatment;Paints for protection against graffiti.*

Class 17: *Insulating buildings against moisture (Substances for -);Insulating coatings;Insulating lacquers;Insulating material;Insulating materials for building;Chemical compositions for preventing leaks;Insulating paints;Insulating paints for facades;Insulating paints for roofs;Insulating paints for walls;Insulating substances;Insulating varnish;Insulating water proofing membranes;Insulations with sealing functions for heat protection;Sealants for buildings;Sealing agents for use in the construction industry;Sealing and insulating materials;Water based insulating lacquers;Water based insulating paints.*

The application was published for opposition purposes on 2 October 2015.

2) On grounds under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) NeverWet LLC (“the Opponent”) opposes the registration of the Applicant’s mark for all the goods for which the Applicant seeks registration.

3) For the purposes of its claims the Opponent relies on the following trade marks for the following respective goods:

UK trade mark no. 3055674:

NeverWet

It was filed on 15 May 2014 and registered on 29 August 2014 for the following goods and services, all of which are relied on for the purposes of the present opposition proceedings:

Class 1: *Protective compositions (chemicals) in liquid form; protective coatings in liquid form (other than paints or oils); surface coating compositions (chemicals); repellants for liquids in the form of sprays; protective hydrophobic and super-hydrophobic preparations; sealants (chemicals); substances for protection against ice.*

Class 2: *Coatings; spray coatings (anti-corrosives); protective coatings for applying to surfaces in liquid form; protective hydrophobic and super-hydrophobic coatings (paints); liquid repellant compositions in the form of spray-paint; sealants (paints); anti-corrosive preparations (paints).*

UK trade mark no. 3058005:



It was filed on 2 June 2014, claiming a priority date of 21 May 2014 stemming from a U.S. trade mark, and registered on 19 September 2014 for the following goods and services, all of which are relied on for the purposes of the present opposition proceedings:

Class 1: *Chemical preparations for coating, treating, spraying and sealing surfaces; protective compositions (chemicals) in liquid form; protective coatings in liquid form (other than paints or oils); surface coating compositions (chemicals); repellants for liquids in the form of sprays; protective hydrophobic and super-hydrophobic preparations; sealants (chemicals); substances for protection against ice.*

Class 2: *Coatings; spray coatings (anti-corrosives); protective coatings for applying to surfaces in liquid form; preparations for treating surfaces (preservatives); protective hydrophobic and super-hydrophobic coatings (paints); liquid repellent compositions in the form of spray-paint; sealants (paints); anti-corrosive preparations (paints).*

European Union Trade Mark ("EUTM") no. 12927836:



It was filed on 2 June 2014, claiming a priority date of 21 May 2014 stemming from a US trade mark, and registered on 4 November 2014 for the following goods and services, all of which are relied on for the purposes of the present opposition proceedings:

Class 1: *Chemical preparations for coating, treating, spraying and sealing surfaces; protective compositions (chemicals) in liquid form; protective coatings in liquid form (other than paints or oils); surface coating compositions (chemicals); repellants for liquids in the form of sprays; protective hydrophobic*

and super-hydrophobic preparations; sealants (chemicals); substances for protection against ice.

Class 2: *Coatings; spray coatings (anti-corrosives); protective coatings for applying to surfaces in liquid form; preparations for treating surfaces (preservatives); protective hydrophobic and super-hydrophobic coatings (paints); liquid repellent compositions in the form of spray-paint; sealants (paints); anti-corrosive preparations (paints).*

4) The significance of the above dates is that (1) all the marks relied on by the Opponent constitute “earlier marks” for the purposes of section 5(2)(b) of the Act, and (2) the proof of use provisions in section 6A of the Act do not apply in respect of any of them.

5) The Opponent claims that because of the similarity between the Applicant’s marks and goods and those of the Opponent there exists a likelihood of confusion. The Applicant filed a notice of defence and counterstatement, denying the grounds of opposition. Neither party filed evidence. The Opponent filed written submissions in the evidence rounds and both parties filed written submissions in lieu of a hearing. The Applicant is represented by HGF Limited. The Opponent is represented by Cleveland. Neither side requested a hearing. I therefore give this decision after a careful review of all the papers before me.

DECISION

The law

6) Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because – [...]

(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”.

7) I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments. The following principles are gleaned from the decisions 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:

(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 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 the goods and services

8) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their

intended purpose and their method of use and whether they are in competition with each other or are complementary”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

9) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, (“*Meric*”) the General Court (“the GC”) stated that:

“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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... 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."

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... 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.”

10) I will make the comparison with reference to the Applicant’s goods. I will go through them term by term (but grouping them when it is useful and reasonable to do so – see the comments of the Appointed Person in *Separode* BL O-399-10). The specifications of the earlier marks are identical except for two items – *Chemical preparations for coating, treating, spraying and sealing surfaces* in class 1 and – *preparations for treating surfaces (preservatives)* in class 2 – which appear in the specifications of both EUTM 12927836 and UKTM 3058005 but not in UKTM 3055674. Since I do not consider that either of these items add materially to the strength of the Opponent’s case beyond that provided by UKTM 3055674, and since UKTM 3055674 in any case facilitates a more straightforward comparison of signs, in the interests of procedural economy I shall confine my comparison of goods and marks to the Opponent’s UKTM 3055674 in my assessment of the competing marks.

The Applicant’s goods in class 1

11) The Applicant’s *Coating compositions [chemicals], other than paint; Coating compositions [not paint] for protection against the effects of water; Coating compositions for protection against the effects of chemicals* all fall within the ambit of the Opponent’s *surface coating compositions (chemicals)*, and are thus identical.

12) There is clearly considerable overlap (and, to that extent, identity) between the Applicant’s *Compositions for preserving brickwork [except paints or oils]; Compositions for preserving concrete [except paints or oils]* and the Opponent’s *Protective compositions (chemicals) in liquid form*. Moreover, to the extent that the Applicant’s goods may include products in non-liquid form, their respective use, users, intended purpose and channels of trade in any case result in a high degree of similarity. This also applies to the comparison between the Applicant’s *Waterproofing chemical compositions* and the Opponent’s *Protective compositions (chemicals) in liquid form*; they are identical or highly similar.

13) The Applicant's *Water repellent compositions; Water repellent coatings [chemical, other than paints] for masonry; Water repellents [chemical]* all fall within the ambit of the Opponent's *protective hydrophobic and super-hydrophobic preparations*, and are thus identical. Moreover, by virtue of their respective use, users, intended purpose and channels of trade there is a high degree of similarity between the Applicant's *Damp proofing compositions [other than paints].Damp proofing compositions [other than paints]; Damp proofing preparations, except paints, for masonry; Anti-damp insulating compositions [other than paint]; Water resistant protective surface coatings [chemical, other than paints]* and the Opponent's *protective hydrophobic and super-hydrophobic preparations*.

14) The Applicant's *Impregnants for exterior surfaces of buildings [other than paints or oils]; Impregnants for facades of buildings; Impregnating agents for brickware; Impregnating agents for concrete; Impregnating agents for mortar; Impregnating agents for plaster; Silicone fluids; Chemical compositions for preserving stonework; Chemical compositions for injection into building structures* can all consist of, and thus fall within the ambit of, the Opponent's *Protective compositions (chemicals) in liquid form*, and are thus identical. Moreover, even when not supplied in liquid form, they include impregnants and compositions with a protective function, and by virtue of their respective users, intended purpose and channels of trade there is a high degree of similarity between these goods of the Applicant and the Opponent's *Protective compositions (chemicals) in liquid form*.

15) The Applicant's *Sealants [chemicals] for the sealing of surfaces; Sealing compounds for use in building [chemical]; Chemical compositions for sealing slate* fall within the ambit of the Opponent's *sealants (chemicals)*, and are thus identical.

16) The Opponent's *Protective compositions (chemicals) in liquid form; protective coatings in liquid form (other than paints or oils); surface coating compositions (chemicals); repellents for liquids in the form of sprays; protective hydrophobic and super-hydrophobic preparations; sealants (chemicals); substances for protection against ice* all fall within the ambit of, and are thus identical with, the Applicant's *Chemical compositions for use in the building industry and Chemical compositions for use in the civil engineering industry and Chemical compositions for use in the*

construction industry. Moreover, by virtue of their respective use, users, intended purpose and channels of trade these products of the Opponent also have a high degree of similarity with other products covered by the Applicant's *Chemical compositions for use in the building industry, Chemical compositions for use in the civil engineering industry and Chemical compositions for use in the construction industry.*

The Applicant's goods in class 2

17) The Applicant's *Substances (chemical-) [paints] for inhibiting attacks from water; Substances [paints] for inhibiting attacks from water; Damp proofing paints; Damp proofing preparations [paints] for masonry; Damp resisting preparations [paints; Materials [paints] for damp proof treatment; Substances [paints] for inhibiting damage from oil; Water repellent coatings [paints] for masonry; Water repellent fungicidal wood stains ;Water repellent paints; Water repellents in the nature of paints; Water resistant protective surface coatings [paints]; Paints for protection against graffiti; Weather resistant coatings [paints]; Waterproof coatings [chemical, paints]; Waterproof coatings [paints]; Waterproof paints; Waterproofing preparations [paint]; Weathering preservatives [paints]; Weatherproofing coatings [paints]; Weatherproofing coatings [paints] for concrete; Weatherproofing coatings [paints] for masonry* all fall within the ambit of the Opponent's *protective coatings for applying to surfaces in liquid form*, and are thus identical.

18) The Applicant's *Stabilising preparations in the nature of coatings; Surface coatings in the nature of paint* fall within the ambit of the Opponent's *Coatings*, and are thus identical. I consider that *Surface treatment materials in the nature of paints* are also covered by *protective coatings for applying to surfaces in liquid form*. In any case, however, their purpose and use, together with shared users and channels of trade, make them highly similar.

19) The Applicant's *Sealant primers; Sealants in the nature of paints; Sealants [paints]; Sealing liquids [preservatives] for wood; Sealing preparations for floors [paint]; Sealing preparations [paint]; Water sealant preparations [paints]*; fall within

the ambit of the Opponent's *sealants (paints)*, and are thus identical. I consider that *Weather sealing stains* are also covered by *sealants (paints)*. In any case, however, their sealing purpose and use, together with shared users and channels of trade, make them highly similar.

The Applicant's goods in class 17

20) Since the earlier trade marks do not cover Class 17, there can be no identity of goods between the Applicant's goods in this class and the Opponent's goods. There can, however, be similarity in accordance with the principles explained in the *Canon* and *Treat* cases. In its counterstatement the Applicant states:

"The Applicant's mark covers insulation goods in class 17, which we consider to be quite different to the goods in classes 1 and 2 of the Opponent's trade marks. These goods are different and would not be found in the same aisles of a DIY store. Such stores stock a large range of products and water-repellent sprays are not in the same aisle as insulation products. Similarly, the products are not complementary. Therefore consumers will not go to the store with the intention of buying a water-repellent spray and impulsively purchase insulation products".

In its written submissions of 2 August 2016 the Applicant adds:

" Further not all the insulting products covered by the application under opposition in Class 17 have hydrophobic properties and thus the nature and purpose of these goods are quite different to the goods covered by the earlier trade marks".

21 The Applicant's *Sealing and insulating materials; Insulations with sealing functions for heat protection; Sealants for buildings; Sealing agents for use in the construction industry; Chemical compositions for preventing leaks* can share a community of intended purpose and users and be in competition with the Opponent's *sealants (chemicals)* in class 1 and *sealants (paints)* in class 2. There is a medium degree of similarity between them.

22) The Applicant's *Insulating coatings* share general nature, method of use, users and channels of trade, and can be in competition with, both the Opponent's *protective coatings in liquid form (other than paints or oils)* in class 1 and *Coatings* in class 2. There is a medium degree of similarity between them.

23) The Applicant's *Insulating lacquers; Water based insulating lacquers; Water based insulating paints; Insulating paints; Insulating paints for facades; Insulating paints for roofs; Insulating paints for walls; Insulating varnish* share general nature, method of use, users and channels of trade, and can be in competition with, the Opponent's *Coatings* and *protective coatings for applying to surfaces in liquid form* in class 2. There is a medium degree of similarity between them.

24) Though method of use and nature may differ, there is shared purpose and users, and competition, between the Applicant's *Insulating buildings against moisture (Substances for -); Insulating water proofing membranes* and the Opponent's *protective hydrophobic and super-hydrophobic preparations; substances for protection against ice* in class 1 and *protective hydrophobic and super-hydrophobic coatings (paints)* in class 2. There is a medium degree of similarity between them. Similarly, the Applicant's *Insulating material; Insulating materials for building; Insulating substances; insulating materials* can also cover substances and materials for insulation against moisture and water. Though method of use and nature may differ, there can be shared purpose, users and competition with the Opponent's *protective hydrophobic and super-hydrophobic preparations; substances for protection against ice* in class 1 and *protective hydrophobic and super-hydrophobic coatings (paints)* in class 2. There is a medium degree of similarity between them.

The average consumer and the purchasing process

25) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v*

A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

26) The average consumer of both the Opponent’s and the Applicant’s goods will consist both of members of the general public competent in DIY work and of commercial consumers, including tradesmen undertaking building and decorating work, who normally purchase the goods in DIY stores and builders’ merchants. Some purchases may be made online. Bearing in mind the intended purpose of the goods, they will be selected with due care and attention. On the other hand, in the case of members of the general public in particular, the goods will not be frequent purchases, and imperfect recollection is a factor to be borne in mind. This may also be a consideration in the case of items not frequently purchased by small tradesmen undertaking building and decorating work. The purchasing process is likely to be primarily visual, the average consumer encountering the goods and trade marks on the internet, in a catalogue or product literature, through advertising or at the point of purchase such as in store. Enquiries may be made, or advice sought, prior to, or during, the purchase of such products, and aural considerations will not be ignored in my assessment.

The distinctiveness of the earlier mark

27) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel*

BV v. Puma AG, paragraph 24). 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).”

28) The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

29) In its statement of grounds the Opponent had originally claimed enhanced distinctiveness for its “earlier NeverWet mark”; it filed no evidence of this, however, stating in its written submissions of 27 May 2016 that it considered it unnecessary to the success of its opposition under section 5(2)(b) to demonstrate enhanced distinctiveness of its earlier marks through use. I therefore have only the inherent distinctive character of the earlier marks to consider. In its written submissions of 2

August 2016 the Applicant submits that “both trade marks” (which, in context, I take to be a reference to the Applicant’s series of marks on one hand and the Opponent’s earlier marks on the other) “have average inherent distinctiveness”. I find accordingly that the Applicant’s mark has an average degree of inherent distinctiveness.

Comparison of the marks

30) 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 CJEU 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.”

It would be wrong, therefore, to dissect the trade marks artificially, 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.

31) The marks to be compared are shown below:

The contested series marks	The earlier mark (UKTM 3055674)
<p style="text-align: center;">NeverWeather Never Weather</p>	<p style="text-align: center;">NeverWet</p>

32) The earlier mark consists of the words “never” and “wet” in a plain font, both words beginning with capital letters, but run together without a space between them. The typographical and orthographical treatment does not play a significant role, except insofar as the capital letters draw attention to the fact that the mark consists of two words. I consider that the entire phrase “never wet” in itself and as a whole forms the dominant and distinctive component of the mark. Neither of the two constituent words dominates the other, but both together form a complete phrase with its own distinct meaning.

33) Both marks in the contested series also consist of two words – “never” and “weather” – presented in plain font, both words beginning with a capital letter. In the first mark of the series, as in the earlier mark, the two words are run together without a space between them. In the second mark in the series, a space is inserted. This is not a material difference. As in the earlier mark, the typographical and orthographical treatment does not play a significant role in either mark in the contested series, except insofar as it makes plain in both that the mark consists of two words. The entire phrase “never weather” in itself and as whole forms the dominant and distinctive component of both marks in the contested series. Neither of the two constituent words dominates the other, but both together form a complete phrase with its own distinct meaning.

34) From the visual point of view, the typographical treatment of the earlier mark and the first mark in the contested series – two words in plain font run together but

beginning with capitals – is the same. The insertion of a space between the words in the second mark in the series does not create a visual difference of any material significance. The overall visual impression of all the marks under consideration is created by the words themselves. All consist of two words. All begin with the word “never”. The second word in each case begins with “we”. There is a rough rule of thumb that the consumer normally attaches more importance to the beginnings of marks. This is no more than a rule of thumb. Each case must be considered on its merits. Nevertheless, in making my assessment of the overall impression created by the marks in the present case I consider it a helpful guide. On the other hand, the second word in the contested marks, consisting of seven letters, makes the contested marks noticeably longer than the earlier mark, the second word of which contains only three letters. Overall, however, I consider that there is still a medium degree of visual similarity between the earlier mark and both marks in the contested series.

35) The earlier mark will be pronounced as three syllables: NE-VER-WET. Both marks in the contested series will be pronounced as four syllables – NE-VER-WE-THER. The first two syllables, and the beginning of the third, are identical, but the fourth syllable of the contested marks creates a noticeable difference in the sound and length of the competing marks. Overall, however, I consider that there is still a medium degree of aural similarity between the earlier mark and both marks in the contested series.

36) With regard to conceptual similarity the Applicant submits:

“As made clear in the counter-statement although the trade marks share the same prefix ‘NEVER’ the differing endings of the trade marks mean they are conceptually different. Although the marks share this conceptual similarity at the start of the marks, this similarity is descriptive and would be given little conceptual weight by the relevant average consumer. More emphasis would be placed on the endings ‘WET’ and WEATHER’ which do not share a similar conceptual meaning. ‘WET’ has a defined conceptual meaning. Whereas ‘WEATHER’ in the specific context of the Applicant’s trade mark means the appearance of something has been worn away or changed by long term

exposure to the atmosphere. Thus in this context 'WEATHER' does not refer to 'weather conditions' or indeed 'wet weather' conditions but how, and the prevention thereof [sic], of the weathering of brick walls and the like to which the Applicant's product has been applied. The words 'WET' and 'WEATHER' are not interchangeable in meaning. Indeed if one were to accept both trade marks are allusive in meaning they actually have specific and distinct meanings which are different. 'To wet' and 'to weather' have different meanings".

37) I have already found that neither of the two respective words in either the earlier mark or the marks of the contested series dominates the other, but that in each case both respective words together form a complete phrase with its own distinct meaning. Accordingly, my task is to compare the conceptual content of the phrase "never wet" in the earlier mark with that of the phrase "never weather" in the marks of the contested series, as seen through the eyes of the average consumer of the competing products. In this context the words "never wet" will be seen by the average consumer of goods in these classes as a reference to products that "never get wet" – and thus, as being allusive of water- and damp-proofing qualities. The words "never weather" will be seen as a reference to products which "do not weather" – and thus as alluding to qualities of resistance to the detrimental effects of long-term exposure to the environment. Strictly, of course, the concepts of water-resistance and of resistance to weathering are not identical; they are, however, very closely bound up with one another, and they overlap to a substantial extent. Oxidation and corrosive elements in the atmosphere may account for part of the weathering effect, but a primary agent in the process will be the action of water penetration and damp, particularly where exacerbated, for example, by cold, causing frost damage. I have also found that it is not only in respect of the competing goods in classes 1 and 2, but also those in class 17, where attributes of resistance to water and damp may be sought by the average consumer. In the perception of the consumer the competing marks will share a high degree of conceptual similarity.

Likelihood of confusion

38) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

39) I have found a medium degree of visual and aural similarity and a high degree of conceptual similarity between the competing marks, and identity or high or medium similarity respectively between their competing goods. I have also found the earlier mark to have an average degree of inherent distinctive character. Bearing in mind my findings on the average consumer, the purchasing process and the degree of care and attention with which purchases will be made, given in particular the high degree of conceptual similarity between the competing marks, the effects of imperfect recollection, and the fact that consumers may not have the opportunity to compare the marks side by side, I nevertheless consider it likely that the differences in the competing marks will go unnoticed by a significant proportion of the relevant public, who will thus directly confuse them. This will be so even in respect of goods which I have found to be of only medium similarity with those of the Opponent. It follows that there is a likelihood of confusion in respect of all of the goods of the Applicant's specification. Accordingly, the opposition succeeds in its entirety.

OUTCOME

40) **The opposition succeeds in its entirety.**

COSTS

41) NeverWet LLC has been successful and is entitled to a contribution towards its costs. I have taken into account that the Opponent filed written submissions both in the evidence rounds and in lieu of attendance at a hearing. I hereby order Wykamol

Group Limited to pay NeverWet LLC the sum of £1,000. This sum is calculated as follows:

<i>Opposition fee</i>	£100
<i>Preparing a statement and considering the other side's statement</i>	£400
<i>Written submissions</i>	£500

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 12th day of September 2016

Martin Boyle
For the Registrar,
The Comptroller-General