

**O-619-21**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3548838  
BY DURO UK LTD  
TO REGISTER**

**RIPPA**

**AS A TRADE MARK IN CLASS 7**

**AND**

**OPPOSITION THERETO  
UNDER NO. 600001631  
BY ASPRO TOOLS LTD**

## Background and pleadings

1. On 27 October 2020, Duro UK Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision.
2. The application was published for opposition purposes on 19 February 2021.
3. Aspro Tools Ltd (“the opponent”) filed a notice of opposition on 5 March 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Following an amendment to the specification originally filed, the current application only covers cutting discs for use as parts of machines and discs for cutting for use with power tools, all in Class 7. The opposition is directed against all the goods in the application. The opponent bases its claim on the following United Kingdom (“UK”) trade mark registration:



**Mark:**

**Registration no.** 3480350

**Filing date:** 9 April 2020

**Registration date:** 10 August 2020

**Relying on all goods, namely:**

Class 8 Hand tools and implements (hand operated); Hand tools and implements (hand-operated); Hand tools and implements [hand-operated]; Hand tools and implements, hand-operated; Hand tools, hand-operated.

4. Given its date of filing, the trade mark upon which the opponent rely qualifies as an earlier trade mark in accordance with section 6 of the Act.
5. The opponent argues that there is a likelihood of confusion, including a likelihood of association, because the respective marks are similar and the goods are identical or similar. The applicant filed a counterstatement denying the grounds of opposition.

6. In fast track oppositions, parties are required to seek leave in order to file evidence other than the proof of use evidence which is filed with the notice of opposition.<sup>1</sup> No leave was sought in respect of these proceedings.
7. The opponent is represented by Birketts LLP, and the applicant is unrepresented. Neither party filed evidence. A hearing was neither requested nor considered necessary.<sup>2</sup> Only the opponent filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by the parties.

## **DECISION**

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

8. The opposition is based upon section 5(2)(b) of the Act, which read 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 of the part of the public, which includes the likelihood of association with the earlier trade mark.”

### **Case law**

9. The following principles are gleaned from the judgments 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 C3/03,

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<sup>1</sup> Rules 20(1)-(4) of the Trade Marks Rules.

<sup>2</sup> *Ibid* Rule 62(5).

*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 the 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 greater 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 to mind the earlier mark, 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**

10. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

11. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

12. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion 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 (“GC”) 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”.

13. The competing goods are as follows:

Applicant’s goods	Opponent’s goods
Class 7	Class 8  Hand tools and implements (hand operated); Hand tools and implements

Cutting discs for use as parts of machines; Discs for cutting for use with power tools.	(hand-operated); Hand tools and implements [hand-operated]; Hand tools and implements, hand-operated; Hand tools, hand-operated.
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14. In its counterstatement, the applicant states:

“...we have a situation that the RIPPER products sit comfortably in Group 8 (class 8) and the DUO Rippla products sits comfortably in Group 7 (Class 7). They are different products for different applications in different end user markets. They simply do not compete with each other – they are completely different products.”<sup>3</sup>

While the opponent submits:

“..goods operate in the tools sector, be that hand tools or power tools they are all still tools and as such hobbyists, DIY’ers, and trade people alike will have sight of respective goods and could use them interchangeably as such products are complementary in nature. In addition, depending on the task at hand, it is denied that they would not be in completion with each other as alleged by the Applicant.”<sup>4</sup>

15. The applicant’s goods cover cutting discs that are parts of a machine. On the other hand, the applicant’s goods are hand-held tools such as wood saw, spanners or screwdrivers. The nature and method of the goods, therefore, differ. However, the competing goods share purpose as both categories of goods could be used for cutting purposes. The users and channels of trade are likely to coincide. The goods compete as the customers may choose the applicant’s goods instead of hand tools, for example, to cut a log of wood. However, I do not agree with the opponent’s submissions regarding any complementarity between these goods on the basis that they are neither important nor indispensable to one another. Considering these factors, I find that the competing goods are similar to a medium degree.

<sup>3</sup> See counter statement.

<sup>4</sup> See the opponent’s written submissions dated 29 July 2021.

## The average consumer and the nature of the purchasing act

16. As the case law above indicates, I must determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer.

17. 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”.

18. Neither party has commented upon the characteristics of the average consumer or the purchasing process. I consider that the average consumer of the competing goods is likely to be a member of the general public and business users. The applicant's cutting discs appears to be mainly used for cutting heavy or hard objects. Therefore, during the selection process, the consumer is likely to consider various factors such as the nature of the material, thickness, or its compatibility with machines. The applicant's discs are parts of machines, and it appears that the machines themselves may be relatively expensive, the discs themselves are unlikely to be expensive. These factors suggest that the average consumer comprising of the general public and the business users are likely to pay a medium degree of attention.



19. Hand tools covered by the opponent's specification is broad enough to encompass a range of hand-held equipment such as wood saw or screwdrivers. The consumer is likely to select the tool depending on the job each tool is designed to do. While this creates some variance in the level of attention, I am of the view that both groups of average consumers are likely to pay a medium degree of attention to the selection process.

20. The purchases are likely to be dominated by visual considerations as the goods are most likely to be bought after visiting stores or any online equivalents or browsing through catalogues. However, I do not discount the possibility of aural considerations in the form of word of mouth recommendations or advice from sales assistants.

### **Distinctiveness of the earlier mark**

21. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

22. As the opponent filed no evidence, I have only the inherent position to consider. Invented words usually have the highest degree of distinctive character. The earlier mark is an ordinary dictionary word “Ripper”. Bearing in mind that hand tools and implements covered by the opponent’s specification include ripping tools such as chisels or hand saws, the most relevant definition of ripper according to the *Oxford English Dictionary*, is a tool intended for ripping.<sup>5</sup> In that context, I think the word “ripper” is allusive of the purpose of the opponent’s goods. The mark also contains a device element that the opponent describes as cut marks. I think that that description accords with how some average consumers are likely to consider the device element, particularly in the context of the word ripper. On that basis, I find that the mark is distinctive to a low degree. I also bear in mind that the opponent’s specification encompasses broad terms apt to include tools such as spanners and pliers, which are not used for cutting or ripping purposes. I also think that another group of average consumers may be unlikely to see the device as cut marks, perhaps as a decorative element. In any event, I do not consider that the mark’s distinctive character goes any much greater than a medium degree.

### **Comparison of marks**

23. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 between the marks must be assessed

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<sup>5</sup> <https://www.oed.com/view/Entry/166234?rskey=VrAJfL&result=1#eid> accessed 16 August 2021


by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

24. The CJEU stated in 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.”

25. It would be wrong, therefore, artificially to 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.

26. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
	<b>RIPPA</b>

27. The opponent's mark consists of the word RIPPER presented in a standard typeface. Four parallel stripes of almost identical width but varying lengths are positioned diagonally on the left side of the word. As the eye is naturally drawn to the element of the mark that can be read, the word element plays a greater role in the overall impression with the device playing a lesser role, even considering its placement at the beginning of the mark.

28. The applicant's mark is a word only mark for "RIPPA". The overall impression and the distinctiveness lie in this word.
29. Visually, four out of five letters in the applicant's mark are contained in the opponent's mark in the same order. In terms of differences, the respective marks end in different letters, "A" and "E-R". The opponent's mark contains a device element that is absent from the applicant's mark. Considering these factors, I find that the marks are visually similar to a degree that is between medium and high.
30. In an aural comparison, the only element that will be articulated in the opponent's mark is the word "RIPPER"; the device is unlikely to be verbalised when the mark is referred to orally. The word "RIPPER", being a commonly known English word, consists of two syllables that will be articulated conventionally as 'RIP-UH'. Turning to the applicant's mark, I consider the average consumer would pronounce it one of two ways. Either it will be pronounced in the same way as the opponent's mark, resulting in the marks being aurally identical or it will be pronounced 'RIP-AH'. As this sound introduces only a slight difference in the pronunciation of the last syllables, I find that the marks are aurally similar to a high degree."
31. I now turn to the conceptual comparison. The applicant's following submission concedes that its mark "RIPPER" is based on a concept intended to reinforce the ripping feature of its discs:

"The name RIPPA was derived from the fact that it is an aggressive cutting blade, heavy in weight and 'rips' through such materials as wood."

The applicant's mark, therefore, appears to be a deliberate misspelling of the word ripper. As mentioned, the word ripper is likely to convey the idea of a tool intended for ripping. I have also concluded that the device element in the opponent's mark is unlikely to add any additional concept. Considering all these factors, I find that both marks are likely to convey identical concepts to the average consumer.

## Likelihood of confusion

32. The factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). They must be considered from the perspective of the average consumer and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).
33. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertaking being the same or related).
34. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:
- “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

35. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.
36. Earlier in the decision, I concluded that the respective marks are visually similar to a degree that is between medium and high, aurally identical or similar to a high degree depending on how the mark is articulated and conceptually identical. I found that both the general public and the business users are likely to purchase the respective goods with a medium degree of attention. I also found that the goods are similar to a medium degree, and the earlier mark is distinctive to no more than a medium degree.
37. I have concluded that the goods are not selected wholly visually. In those circumstances, the aural identity or similarity between the marks is likely to lead the average consumer to think that it is the same undertaking that offers similar goods. Accordingly, I find that, from the aural perspective, there is a likelihood of direct confusion.
38. Where visual considerations are likely to dominate the selection process, I find that there is a likelihood of indirect confusion. When assessing the marks as a whole, I am of the view that the aural and conceptual identity between the marks is likely to outweigh the visual differences. Even if a medium to high degree of attention is paid during the purchase process, the consumer is likely to think that the marks are variant marks used by the same undertaking or economically linked undertakings to provide similar goods. I am also of the view that confusion is still likely where the marks are aurally similar to a high degree. The points of differences between the competing marks are insufficient to dispel the impact of conceptual identity and the visual and aural similarity between the marks.

## **Conclusion**

52. The opposition has succeeded in full. The application will be refused.

## **Costs**

53. The opponent has been successful and is entitled to an award of costs. Awards of costs in fast-track proceedings are governed by Tribunal Practice Notice (“TPN”) 2/2015. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Filing written submissions:	£100
Total:	£400

41. I order Duro UK Ltd to pay Aspro Tools Ltd the sum of £400. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 20th day of August 2021**

**Karol Thomas**  
**For the Registrar**