

O/0700/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL  
REGISTRATION NO. WO0000001677282 IN THE  
NAME OF COPA ISI SİSTEMLERİ SANAYİ VE  
TİCARET ANONİM ŞİRKETİ FOR THE FOLLOWING MARK:

The logo consists of the word "copa" in a bold, red, lowercase sans-serif font. The letters are slightly rounded and the 'a' has a small tail.

AS A TRADE MARK IN CLASS 11

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 438925 BY  
JACOPA LIMITED

## BACKGROUND AND PLEADINGS

1. ISI SİSTEMLERİ SANAYİ VE TİCARET ANONİM ŞİRKETİ (“the holder”) is the holder of the International Registration shown on the cover page of this decision (“the IR”). The IR was registered on 15 April 2022 and, with effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 3 November 2022. The holder seeks protection for the following goods:

Class 11:            Lighting installations; lights for vehicles and interior-exterior spaces, heating installations using solid, liquid or gas fuels or electricity, central heating boilers, boilers for heating installations, radiators [heating], heat exchangers, not parts of machines, stoves, kitchen stoves, solar thermal collectors [heating]; steam, gas and fog generators, steam boilers, other than parts of machines, acetylene generators, oxygen generators, nitrogen generators, installations for air-conditioning and ventilating; cooling installations and freezers; electric and gas-powered devices, installations and apparatus for cooking, drying and boiling, cookers, electric cooking pots, electric water heaters, barbecues, electric laundry driers; hair driers; hand drying apparatus; sanitary installations, taps [faucets], shower installations, toilets [water-closets], shower and bathing cubicles, bath tubs, toilet seats, sinks, wash-hand basins [parts of sanitary installations]; washers for water taps; water softening apparatus; water purification apparatus; water purification installations; waste water purification installations, electric bed warmers and electric blankets, not for medical use; electric pillow warmers; electric or non-electric footwarmers; hot water bottles; socks, electrically heated; filters for aquariums and aquarium filtration apparatus; industrial type installations for cooking, drying and cooling purposes; pasteurizers and sterilizers.

2. On 30 January 2023, the IR was opposed by Jacopa Limited (“the opponent”). The opposition is based on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under the section 5(2)(b) ground, the opponent relies on the following trade mark:



UK registration no. 900057810<sup>1</sup>

Filing date 1 April 1996; registration date 27 February 1998

Relying on all goods and services, namely:

Class 11: Installations and apparatus, all for use in treating waste water; filters for use in waste water treatments; parts and fittings for the aforesaid goods.

Class 37: Construction, installation, maintenance and repair of waste water treatment installations and apparatus; consultancy and advisory services relating to the aforementioned services.

(“the opponent’s mark”).

3. The opposition under the section 5(2)(b) ground is aimed at only the following goods of the holder:

Class 11: Lighting installations; heating installations using solid, liquid or gas fuels or electricity, central heating boilers, boilers for heating installations, radiators [heating], heat exchangers, not parts of machines; sanitary installations, taps [faucets], shower installations, toilets [water-closets], shower and bathing cubicles, bath tubs, toilet seats, sinks, wash-hand basins [parts of sanitary

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<sup>1</sup> The opponent’s mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

installations]; washers for water taps; water softening apparatus; water purification apparatus; water purification installations; waste water purification installations; filters for aquariums and aquarium filtration apparatus; pasteurizers and sterilizers.

4. Under the section 5(2)(b) ground, the opponent argues that because the marks are similar and as they cover the same and similar goods, there is a likelihood of confusion between them.
5. Turning to the section 5(4)(a) ground, I note that the sign relied upon is identical to the registered mark relied upon in the section 5(2)(b) ground, being that reproduced at paragraph two above. Under this ground, the opponent claims that it has used the sign throughout the UK since at least 1990 in respect of the following goods:

Installations, equipment and apparatus for use in the treatment of waste water, including filters for use in waste water treatment and parts and fitting for such goods; maintenance and repair services in relation to waste water treatment installations, equipment and apparatus, along with consultancy and advisory services relating to the treatment of waste water.

6. In its notice of opposition, the opponent's answer to the question as to why it considered use of the IR would be contrary to the law of passing off was as follows:

"The trade mark being opposed is a stylized form of the word "COPA" and the Opponent's earlier trade mark and the name of one of its product ranges is COPA. The goods covered by the trade mark being opposed are the same as those provided by the applicant under the COPA name as they relate to water treatment and sanitation or would be used by parties engaged in water treatment and sanitation.

Please see the information in response to question 5 in section A regarding the similarity of the respective marks.

The Opponent has traded using the COPA name since at least 1990 and has built a significant reputation under that name. The applicant's sales values for the year to the end of March 2021 was £1,050,000, to March 2022 the value was £2,145,000 so far since 1 April 2022 the sales are £1,360,000.

As a result of its activities (the Opponent's business offers, awards and news about its products and business) can be viewed on its website [www.jacopa.com](http://www.jacopa.com)), the applicant has significant trading goodwill and reputation in the UK attached to the name COPA.”

7. I would not ordinarily reproduce the entirety of one party's pleadings at this stage but have done so for reasons that will be discussed further below.
8. The holder filed a counterstatement wherein it denies the claims made and has put the opponent to proof of use of the mark relied upon.
9. The opponent is represented by Gateley Legal and the holder is represented by Forresters IP LLP. Only the opponent filed evidence in chief. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken after a careful perusal of the papers.
10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **EVIDENCE**

11. The opponent's evidence came in the form of the witness statement of Mr Alex Lloyd dated 10 July 2023. Mr Lloyd is the Managing Director of the opponent and his statement has been provided to demonstrate the opponent's use of its mark

under the proof of use request by the holder and, further, to demonstrate that there exists a level of goodwill in the opponent's business. I note that it is accompanied by one exhibit.

12. I do not intend to summarise the parties' evidence or submissions in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

## **DECISION**

### **Proof of use**

13. 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 or international trade mark (UK) 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(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.”

14. Section 6A is also relevant. It reads:

“(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(aa) or (ba) in relation to which the conditions set out in section 5(1),  
(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed  
before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered,  
or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

15. Section 100 of the Act is also relevant. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. As the opponent’s mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.



(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union".

17. Given its filing date, the opponent's mark qualifies as an earlier trade mark under the above provisions. The opponent's mark had completed its registration processes over five years prior to the designation date of the IR. As set out above, the holder requested that the opponent provide proof of use in respect of the same. Therefore, the opponent's mark is subject to the proof of use assessment.

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v*

*Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not

suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. As per section 6A of the Act (cited above), the relevant period for the present assessment is the five-year period prior to the designation date of the IR, being 15 April 2022. The relevant period is, therefore, 16 April 2017 to 15 April 2022 (“the relevant period”).

20. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>2</sup> because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

#### Evidence of use

21. The opponent stated that the trading history of the ‘COPA’ brand goes back to at least 1990 and asserts that it has built a significant reputation under that name. The alleged use relates to installations, equipment and apparatus for use in the treatment of waste water, including filters for use in waste water treatment and parts and fittings for the same. The opponent also claims to provide maintenance and repair in relation to the products it sells along with consultancy and advisory services in respect of the same. A range of images of large tanks/installations are provided. I see no reason to reproduce these here but note that they all show the ‘COPA’ branding in the form of the mark relied upon.

22. The evidence includes a range of materials that the opponent refers to as flyers, leaflets, adverts and information sheets.<sup>3</sup> I see no merit in going through each one of these in detail but note that they are documents that were provided between 2015 and 2017. For the avoidance of doubt, the documents from prior to 2017 are of no assistance to the present assessment.<sup>4</sup> The documents are confirmed as being provided to a range of companies such as all end user UK water utilities,

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<sup>2</sup> *Jumpman* BL O/222/16

<sup>3</sup> See pages 1 to 10 of Exhibit 1

<sup>4</sup> They may, however, assist under the section 5(4)(a) ground.

their supply chain contractors and maintenance specialists. As an example, one of the flyers refers to products such as primary settlement tanks, humus/final settlement tanks, trickling arm filters, copasacs (being nets for filtering solid pollutants), combined sewer overflows, submerged aerated filters ("SAF") and rotating biological contractors.<sup>5</sup> The narrative evidence confirms that this flyer has been used since 2017.

23. An article from the Water Journal dated 20 October 2017 is provided that discusses the 25<sup>th</sup> anniversary of the provision of the first COPA submerged aerated filter system at the Dufftown wastewater treatment works.<sup>6</sup> This article confirms that, as at that date, over 180 COPA submerged aerated filters have been hired across the UK since 1990. While I note that there is reference to the company name 'Jacopa', there is reference to products under the COPA branding such as 'the CB750 Copa SAF'.

24. The evidence proceeds to discuss the opponent's social media presence. Images of the opponent's accounts are only shown in the body of the narrative evidence, as opposed to exhibited documents. The posts shown are noted but are dated from after the end of the relevant period and, further, show very limited levels of engagement. In addition, the evidence discusses the featuring of the COPA name on the Enviropro website, being an external search engine that specialises in water products. As was the case with the social media evidence discussed above, this is from after the relevant period so is of no assistance here. In any event, I have nothing before me to suggest what Enviropro is and how it relates to the use of the mark.

25. Sales figures for individual products are provided for the fiscal years 2019 to 2023. Firstly, I have nothing to suggest what the fiscal year of the opponent is. It could be 1 January to 31 December or, alternatively, it could be 1 April of one year to 31 March of the next. This is an issue here because the relevant period ends in June of 2022 so if it was the case that the 2022 figures covered January to December,

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<sup>5</sup> Page 1 of Exhibit 1

<sup>6</sup> See page 11 of Exhibit 1

a significant portion of those would inevitably be from outside the relevant period. In light of this, I have no way of determining, with any accuracy, what figures filed under 'FY2022' are relevant. This is a point I will bear in mind in making my overall assessment of the evidence. The figures (excluding the 2023 figures as they are outside the relevant period) are as follows:

<b>Copa Product</b>	<b>FY19</b>	<b>FY20</b>	<b>FY21</b>	<b>FY22</b>
Cyclone	18,254	107,301	96,863	224,908
Rake Bar Screen	26,179	184,726	83,935	5,956
SAF Capital	579,848	411,364	533,964	348,373
Scraper Bridge	468,432	509,571	2,845	73,711
<b>TOTAL</b>	<b>1,092,714</b>	<b>1,212,962</b>	<b>717,608</b>	<b>652,947</b>

26. The narrative evidence confirms that not all of the sales of the opponent's products and services are included in the above figures as they exclude aftermarket orders such as hire, spare parts, servicing and refurbishment work. While noted, I have nothing before me to suggest the level of turnover associated with any of these types of aftermarket orders.

27. In support of the above turnover figures, the opponent has provided what is referred to as a 'small selection' of proposals, price lists and purchase orders from customers regarding COPA branded products.<sup>7</sup> Having considered these documents, I note that some of them relate to purchases/hirings during the relevant period. For example, a purchase order dated 17 March 2020 (with a due delivery date of 10 April 2020) between the opponent and Scottish Water which confirms the sale of two 'SAF Units' at £70,000 each, delivery of the same and the loading and offloading at the site.<sup>8</sup> Another purchase order confirms the approval of a quotation for the refurbishment of two 'Copa CB750 SAFs' at a net cost of £15,317 at RAF Molesworth.<sup>9</sup> As for the remaining documents, they are simply quotations, price lists or proposals and there is nothing to suggest the customers to which

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<sup>7</sup> Pages 16 to 31 of Exhibit 1

<sup>8</sup> See page 24 of Exhibit 1

<sup>9</sup> See pages 26 to 31 of Exhibit 1

these were provided actually went ahead with the purchase/hire. These documents are not, in my view, relevant to the present issue.

28. Before moving to my assessment of the evidence, I wish to briefly discuss the products referred to in the turnover figures provided. I have already discussed that 'SAF' is the abbreviation for 'submerged aerated filters'. As for 'scraper bridge', the evidence dictates that this is a 'scraper' for a circular tank.<sup>10</sup> Lastly, I note that I have nothing before me to suggest what 'Cyclones' or 'Rake Bar Screens' are. That being said, it is clear from the evidence that the opponent operates in supplying large water treatment installations and their parts so I consider it reasonable to assume that they are those types of goods.

#### Assessment of evidence

29. I appreciate that the turnover figures before me may, on the face of it, appear low. However, I remind myself that use need not be quantitatively significant in order for it to be deemed genuine. On this point, while I have no evidence as to the size of the market in which the opponent operates, I am satisfied that it is likely to be a relatively small and specialised market that deals with water treatment apparatus and instruments used to treat sewage. Such a market is not likely to cover a high volume of sales. In support of this point, I refer to the cost of the SAFs discussed above in that they cost £70,000 each so are, therefore, high value goods that are not likely to be selected frequently. Therefore, I am of the view that the limited level of turnover provided is sufficient to demonstrate that the opponent has made a genuine attempt to create or preserve a market share for the relevant goods during the relevant period.

30. In respect of the goods and services at issue, I do not consider it controversial to suggest that the above use would satisfactorily be categorised as covering a range of goods that are "installations and apparatus, all for use in treating waste water". Further, the most commonly referred to product, being the 'SAF' is a type of filter used in waste water treatment meaning that the use of such goods fall within the

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<sup>10</sup> See page 6 of Exhibit 1 for an explanation of the same.

term “filters for use in waste water treatments”. In respect of parts and fittings, it appears to me that several of the goods that the opponent provides are parts and fittings for larger waste water treatment apparatus, such as filters and nets for larger tanks, for example. In light of this, I am satisfied that the finding of genuine use can be said to also apply to the term “parts and fittings for the aforesaid goods” which sits at the end of the opponent’s class 11 list of goods.

31. As for the services, I accept that the opponent offers the maintenance and repair of the goods it provides. However, this is evidenced by only one proposal and quotation (the one in relation to RAF Molesworth, as discussed above). Having considered this evidence, it is under the ‘Jacopa’ branding. While the products being maintained in accordance with this proposal are set out as being ‘COPA’ branded products, the documentation relating to their maintenance appears to be under the ‘Jacopa’ branding. On this point, the quotation is headed with ‘Jacopa’ and the invoice provided refers to ‘Jacopa’ as the supplier. It is my view that this evidence points to the actual services being provided under the ‘Jacopa’ branding. I have nothing to suggest otherwise and, therefore, find that this is not use of the opponent’s mark. In respect of the installation and construction services, I note that there is no specific evidence as to use of the mark relied upon in relation to the same. On this point, I note that one purchase order (which I have discussed above) refers to the delivery and loading/off-loading of goods, however, this is not the service of installation or construction so is of no assistance here. As a result, and without anything further, I do not consider that the opponent has provided sufficient evidence in respect of the use of any installation/construction services. Lastly, I turn to consider the consultancy and advisory services covered by the opponent’s specification. In short, there is nothing sufficiently solid before me to prove that the opponent actually offers such services and, if so, what level of use can be attributed to the same. Without such, I am not willing to find that the opponent has genuinely used its mark in respect of these services.

32. In light of all that I have said above, I find that the opponent has genuinely used its mark in respect of all of its class 11 goods but not for any of its class 37 services.



## Section 5(2)(b): legislation and case law

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

“(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 or association with the earlier trade mark.”

34. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

35. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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 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

36. The competing goods are as follows:

The opponent's goods and services	The holder's goods
<u>Class 11</u> Installations and apparatus, all for use in treating waste water; filters for use in waste water treatments; parts and fittings for the aforesaid goods.	<u>Class 11</u> Lighting installations; heating installations using solid, liquid or gas fuels or electricity, central heating boilers, boilers for heating installations, radiators [heating], heat exchangers, not parts of machines; sanitary installations, taps [faucets], shower installations, toilets [water-closets], shower and bathing cubicles, bath tubs, toilet seats, sinks, wash-hand basins [parts of sanitary installations]; washers for water taps; water softening apparatus; water purification apparatus; water purification installations; waste water purification installations; filters for aquariums and aquarium filtration apparatus; pasteurizers and sterilizers.

37. In the judgment of the Court of Justice of the European Union (“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.”

38. 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 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.

39. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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.”

40. The opponent's submissions in respect of the goods comparison relies on the fact that the holder's goods are sub-categories of goods that would be expected to be supplied as part of an installation or the apparatus for treating waste water. Therefore, the opponent claims that the holder's goods are within the scope of its own broader terms. While I agree that this applies to some of the holder's goods (which I will discuss below), I do not consider that it applies to all of them. I say this because there is nothing before me in evidence to suggest that there exists any overlaps between lighting and heating installations, for example, and the opponent's waste water treatment goods. On this point, if it were the case that lights and heat were used in the opponent's types of installations to clean water (by way of UV sterilisation lights or boiling water) then such a point should have been made in evidence. Without such, I am not willing to find that it is the case. Further, the holder's terms cover a range of ordinary household plumbing goods such as toilets and showers. Again, I have nothing to suggest that the opponent's submissions ring true for these goods either, namely that they are goods you would expect to find in waste water treatment facilities. Lastly, I appreciate that large waste water treatment facilities may include rooms for employees to work in which would, obviously, be lit to allow workers to see or heated to keep them warm. However, this does not mean that, in accordance with the plain reading of the terms, they are parts of the waste water treatment facilities themselves. The same can be said for the ordinary plumbing goods in that the offices may include toilets, for example, but to suggest this means they are similar to the opponent's goods is too far stretched.

41. As a result of what I have said above, I find that there exists no overlap in the natures, methods of use, purposes, trade channels or users between the below

goods and any of the goods in the opponent's specification. The following goods are, therefore, dissimilar.

*“Lighting installations; heating installations using solid, liquid or gas fuels or electricity, central heating boilers, boilers for heating installations, radiators [heating], heat exchangers, not parts of machines; taps [faucets], shower installations, toilets [water-closets], shower and bathing cubicles, bath tubs, toilet seats, sinks, wash-hand basins [parts of sanitary installations]; washers for water taps; water softening apparatus; filters for aquariums and aquarium filtration apparatus.”*

42. As far as I am aware, “sanitary installations” in the holder's specification is a term that relates to installations such as toilets and urinals, for example, and not waste water treatment installations. While such goods will flush away human waste, I am not convinced that they are used to actually treat waste water in the same way that the opponent's goods are. As a result, I find that the preceding conclusion made in respect of goods such as “toilets [water-closets]” can be said to apply here. As a result, I find that this term is dissimilar to the goods of the opponent.

43. The terms “water purification apparatus”, “water purification installations”, “waste water purification installations” and “sterilizers” in the holder's specification are either expressly defined as relating to the purification of waste water or are sufficiently broad enough so as to cover such goods. As a result, I find that they can all be said to be apparatus for treating waste water and, therefore, all fall within the broader term of the opponent, namely “installations and apparatus, all for use in treating waste water”. These goods are, therefore, identical under the principle outlined in *Meric*.

44. Lastly, I note that the holder's specification also includes the term “pasteurizers”.<sup>11</sup> This term is, as far as I am aware, used for the heating of liquid foods such as milk so as to kill harmful bacteria and give the product a longer shelf life. In this context,

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<sup>11</sup> This term is included in the holder's specification with “sterilizers” but I consider it necessary to consider them separately. As above, sterilizers can be said to be used for the sterilization of water in waste water treatment facilities whereas I do not consider that the same can be said of this term.

they cannot be said to be goods that relate to the treatment of waste water. There are no submissions or evidence to the contrary. Therefore, I find that they differ in nature, method of use, purpose, trade channels and user with the goods or services of the opponent. They are, therefore, dissimilar.

45. As some degree of similarity between goods is necessary to engage the test for likelihood of confusion,<sup>12</sup> the present ground may only proceed against the following goods:

Class 11: Water purification apparatus; water purification installations; waste water purification installations; sterilizers.

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

46. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

47. The opponent submits that the average consumer for the goods at issue is not one single class of consumer. It accepts that, for larger installations, the user will not be the general public. However, the opponent suggests that it is becoming

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<sup>12</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

increasingly common for property owners to employ their own wastewater treatment facilities on a smaller scale meaning that a member of the general public may make up the consumer base also. I disagree with the opponent's basis for this argument as there is nothing before me to suggest that it is becoming common for members of the general public to run their own waste water management systems. Clearly, the user for such goods will be business users such as large land owners, water suppliers and sewage treatment businesses. That being said, the goods at issue do cover terms that can be said to be broad enough to cover those used by members of the general public at large. For example, water purification apparatus can not only cover goods that purify waste water in the same sense as the opponent's terms, but it is also sufficiently broad to cover household goods for purifying drinking water.

48. The goods at issue will, for business users, be available from the producer directly. Such is the specialist nature of the goods in this context, they are likely to be shown via catalogues or on lists of goods available. Again, due to the specialist nature of the goods, I suspect that they will be selected after having visited the producer directly or after detailed discussions with sales assistants (be that in person or via telephone). Therefore, I am of the view that the selection of such goods will be made after both visual and aural considerations. As for those goods selected by members of the general public, these will be available via general retailers where they will be displayed on shelves or racks. The goods may also be available online where they will be selected after having viewed an image of them. The selection process for the general public will, therefore, be primarily visual though I do not discount an aural component playing a role by way of word of mouth recommendations or advice from sales staff.

49. Where business users are concerned, the selection of the goods at issue will be very infrequent and very expensive. The selection of such goods is likely to be a specialised and highly involved process. While I have nothing in evidence to suggest what factors would be considered during such a process, I do not consider it of any real issue here. Put simply, the selection process is likely to attract a high level of attention as the goods pertain to the treatment of sewage and the cleaning



of waste water which, as far as I understand it, have health and environmental impacts. For the general public, the selection of the goods is likely to be relatively frequent and inexpensive. The factors that the general public will consider for the selection of such goods, namely a range of water purification goods such as drinking water filters, for example, will likely be materials used, longevity of the filter and whether the product has any impact on the taste. In my view, the selection process for such goods is likely to be medium.

### **Comparison of the marks**



50. It is clear from *Sabel 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 of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

51. 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.”

52. 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.

53. The respective trade marks are shown below:

The opponent's mark	The IR
	

54. I have submissions from the opponent in respect of the comparison of the marks at issue. I will not reproduce them in full here but confirm that I have taken these into consideration.

#### Overall Impression

55. The opponent's mark is a figurative mark that consists of the word 'Copa' presented in a stylised black typeface. This word is followed by a black tick device. Given that consumers are naturally drawn to parts of marks that can be read, I find that the word 'Copa' plays the greater role in the overall impression of the mark. The tick device and the stylisation used will play lesser roles.

56. As for the IR, this is also a figurative mark. It consists of the word 'copa' presented in a red, slightly stylised typeface. The word 'copa' will play the greater role in the IR and while they will not go overlooked entirely, the stylisation and colour are fairly banal and will, therefore, play a much lesser role.

#### Visual Comparison

57. Visually, both marks are the words 'COPA' presented in different ways. This word dominates both parties' marks so is, clearly, a significant point of similarity between them. As for their points of difference, the opponent's mark includes a tick device (which the IR does not) and the stylisations of both marks are different. While these elements all play lesser roles in their respective marks, they still act as points of visual difference. As for the use of colour, the opponent's mark, by being registered

in black and white, is capable of being used in red. Taking all of this into account, I am of the view that the marks are visually similar to a high degree.

### Aural Comparison

58. Aurally, both marks will be pronounced as the word 'COPA'. Regardless of whether the consumer seeks to pronounce as 'KOP-AH' or 'KOE-PAH', the marks will be pronounced the same. As such, they are aurally identical.

### Conceptual Comparison

59. The concept derived from either mark will lie solely in the word 'COPA'. I have no suggestion from either party as to what this means. In my view, it will either be understood as a foreign language word or a made-up word. Either way, it will have no obvious meaning to the majority of consumers in the UK. As a result, the marks are not capable of a conceptual comparison meaning that they are conceptually neutral.

### **Distinctive character of the opponent's mark**

60. 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)."

61. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has filed evidence of use and, therefore, it is necessary for me to consider whether this is sufficient to demonstrate that the distinctiveness of the opponent's mark has been enhanced thanks to the use made of it. Before doing so, however, I will consider the inherent position.

62. As I have discussed above, the opponent's mark is a figurative mark that consists of the word 'Copa' in a stylised black typeface followed by a tick device. I have also set out above that 'Copa' will either be viewed as a foreign language word or a made-up word with no obvious meaning. It has no descriptive or allusive qualities in respect of the goods in the opponent's specification. Therefore, I find that it enjoys a high degree of inherent distinctive character. While the tick device and the stylisation used will not go unnoticed, I do not consider that they will do anything to take the distinctiveness of the mark beyond that which is created by the word 'Copa'.

63. Turning to the position with regard to enhanced distinctiveness, I am of the view that I can deal with it briefly. While I accept that the evidence before me is sufficient to show that the opponent has genuinely used its mark, I remind myself that the burden for proving enhanced distinctiveness is considerably higher than that for

genuine use.<sup>13</sup> Having considered the evidence, I do not consider that it discharges this burden. In short, it demonstrates relatively low sales figures and the additional supporting evidence is not particularly compelling either. While I appreciate that the market at issue is very specialised,<sup>14</sup> I am of the view that the specialty of the market is such that more evidence as to the opponent's presence in that market is required in order to warrant a finding of enhanced distinctiveness. As a result, the inherent position applies.

### **Likelihood of confusion**

64. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

65. I have found the goods to be identical. I have found the average consumer for the goods to be both business users and members of the general public at large. The selection process for business users will involve both visual and aural considerations. Further, those consumers are likely to pay a high degree of

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<sup>13</sup> This is on the basis that, as per the case law cited above regarding genuine use, use need not be quantitatively significant in order for it to be genuine. On the contrary, enhanced distinctiveness requires a finding that a proportion of the relevant section of the public would, because of the mark, identify the goods at issue as originating from a particular undertaking.

<sup>14</sup> Which could justify a finding of enhanced distinctiveness in respect of a lower level of sales/turnover.

attention during the selection process. As for members of the general public at large, they are likely to select the goods via primarily visual considerations (though I do not discount an aural component) and are likely to select the goods after paying a medium degree of attention. In respect of the comparison of the marks, I have found them to be visually similar to a high degree, aurally identical and conceptually neutral. I have found the opponent's mark possesses a high degree of inherent distinctive character.

66. Taking all of these factors into account together with the principle of imperfect recollection, I consider that the average consumer is likely to mistake the parties' marks for one another. This finding is, in my view, supported by the fact that the marks at issue are dominated by the identical word 'COPA'. Regardless of how this is presented, the additional stylistic or device elements are not, in my view, sufficient to enable the consumer to be able to accurately recall which mark was which. For example, a consumer would look to recall either mark by using the word 'COPA' and not by the way in which they are presented or because one mark has a tick device and the other does not, especially when bearing in mind the principle of imperfect recollection. In my view, this will occur even when the consumer is paying a high degree of attention, particularly given that the marks are aurally identical and those consumers are likely to have aural considerations, thereby leading them to being directly confused as to which mark was which. Consequently, I consider that there exists a likelihood of direct confusion between the marks.

67. For the sake of completeness, I will proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, 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 recognized 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'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

68. If the consumer was to notice the differences between the marks at issue, I am of the view that the shared use of the word 'COPA' would result in consumers believing that the marks are from the same or economically linked undertakings. Firstly, I am of the view that the opponent's use of 'COPA' is sufficiently distinctive enough for consumers to believe that only one undertaking would use it, particularly in the context of the goods at issue. Secondly, I am of the view that the different elements in the marks (being the device element in the opponent's mark and the differences in stylisation between the marks) will be viewed as indicators

of alternate marks used by the same undertaking. For the same reasons as discussed above, I consider that this finding will apply in circumstances where the average consumer pays a higher degree of attention during the purchasing process. Consequently, I consider that there exists a likelihood of indirect confusion between the marks.

69. The opposition under the section 5(2)(b) ground has partially succeeded and I will now proceed to consider the section 5(4)(a) ground.

### **Section 5(4)(a)**

70. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) .....

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

71. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”



72. I have reproduced the entirety of the opponent's claim under this ground at paragraph 6 above. I do not intend to repeat those pleadings here but remind myself that the pleaded case lacks any claim of damage. On this point, I refer to the case of *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, wherein Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.” (emphasis added)

73. While there is a claim as to the existence of goodwill and the arguments as to the similarity of the marks may be construed as relating to a claim that there is a misrepresentation, the opponent has failed to claim damage. As a result, the opponent's claim under the present ground cannot succeed.

74. Even if I were to ignore the above, I do not consider that the present ground would offer anything beyond the section 5(2)(b) ground. Firstly, I accept that the evidence is sufficient to demonstrate that the opponent's business enjoys a protectable level of goodwill and that the sign relied upon is distinctive and/or associated with the same. My finding in this regard relates to a goodwill only in those same goods for which I have found use under my genuine use assessment above. While the test for misrepresentation under the present ground is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely that the difference between the legal tests will produce different outcomes.<sup>15</sup> In the present case, I am of the view that a finding of misrepresentation can be said to apply to

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<sup>15</sup> See *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

those same goods for which there was confusion under the section 5(2)(b) ground. For the sake of completeness, those goods are as follows:

Class 11: Water purification apparatus; water purification installations; waste water purification installations; sterilizers.

75. Turning to the remaining goods, I do not consider that the present ground would garner the opponent any success for these. I say this because the remaining goods of the holder all exist in fields of activity that are distinct from the field of activity that the opponent operates in. I do not intend to reproduce them all but they include goods such as “electric cooking pots”, “hair driers”, “toilet seats” “electric bed warmers and electric blankets, not for medical use”, “hot water bottles” and “filters for aquariums”. I appreciate that claims of passing off may succeed where parties operate in different fields of activity, however, I remind myself of the case of *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) wherein Millet L.J. stated that:

“Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one.”

76. In addition, I refer to the case of *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 wherein Slade L.J. stated, at page 545 of his judgement, that:

“Even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

77. In my view, the opponent's evidence does not come close to discharging the heavy burden described in the case law above. As a result, I am of the view that the claim of passing off against the remaining goods in the holder's specification fails.

## **CONCLUSION**

78. The opposition succeeds in part and the IR is hereby, subject to any successful appeal of my decision, refused protection in the UK for the following goods:

Class 11: Water purification apparatus; water purification installations; waste water purification installations; sterilizers.

79. The IR may, again subject to any successful appeal of my decision, proceed to protection in the UK for the following goods:

Class 11: Lighting installations; lights for vehicles and interior-exterior spaces, heating installations using solid, liquid or gas fuels or electricity, central heating boilers, boilers for heating installations, radiators [heating], heat exchangers, not parts of machines, stoves, kitchen stoves, solar thermal collectors [heating]; steam, gas and fog generators, steam boilers, other than parts of machines, acetylene generators, oxygen generators, nitrogen generators, installations for air-conditioning and ventilating; cooling installations and freezers; electric and gas-powered devices, installations and apparatus for cooking, drying and boiling, cookers, electric cooking pots, electric water heaters, barbecues, electric laundry driers; hair driers; hand drying apparatus; sanitary installations, taps [faucets], shower installations, toilets [water-closets], shower and bathing cubicles, bath tubs, toilet seats, sinks, wash-hand basins [parts of sanitary installations]; washers for water taps; water softening apparatus; electric bed warmers and electric blankets, not for medical use; electric pillow warmers; electric or non-electric footwarmers; hot

water bottles; socks, electrically heated; filters for aquariums and aquarium filtration apparatus; industrial type installations for cooking, drying and cooling purposes; pasteurizers.

## **COSTS**

80. While the opposition has succeeded in part, I am of the view the holder enjoyed the greater degree of success. As a result, I consider that it is the holder that is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the present case, I am of the view that any cost award should be reduced to a slight degree in order to reflect the partial success of the opponent. In the circumstances, I award the holder the sum of £500 as a contribution towards its costs. The sum is calculated as follows:

Preparing a counterstatement:	£200
Considering the opponent's evidence:	£500
<u>Sub-total:</u>	<u>£700</u>
<i>Reduction:</i>	<i>-£200</i>
<b>Total:</b>	<b>£500</b>

90. I hereby order Jacopa Limited to pay ISI SİSTEMLERİ SANAYİ VE TİCARET ANONİM ŞİRKETİ the sum of £500. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 24<sup>th</sup> day of July 2024**

**A COOPER**

**For the Registrar**