

O-012-15

TRADE MARKS ACT 1994

**IN THE MATTER OF THE INTERNATIONAL REGISTRATION NO 1100087
DESIGNATING THE UNITED KINGDOM
BY PEKSA PROFİL SANAYİ VE TİCARET A.Ş.**



IN CLASS 11

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 400873
BY THERMO KING CORPORATION**

BACKGROUND

1) PEKSA PROFİL SANAYİ VE TİCARET A.Ş. is the holder of international registration (“IR”) 1100087 in respect of the mark shown on the front cover of this decision. Protection in the UK was requested on 12 April 2013. The request for protection was published in the United Kingdom, for opposition purposes, in the Trade Marks Journal on 19 July 2013. Protection is sought in respect of *Radiators (heating)* in Class 11.

2) On 19 September 2013, Thermo King Corporation (“the opponent”) filed notice of opposition to the granting of protection in the UK. The single ground of opposition is that the designation offends under Section 5(2)(b) of the Trade Marks Act (“the Act”) because it is in respect of a mark that is similar to three earlier marks that stand in the name of the opponent and is in respect of goods that are identical or similar to the opponent’s goods or services. As a result, it is claimed that there is a likelihood of confusion. The relevant information relating to the opponent’s earlier marks are:

Mark details	Goods relied upon
<p>817058</p> <p>THERMO-KING</p> <p>Filing date: 15 February 1961</p> <p>Date of entry in register: 15 February 1961</p>	<p>Class 11: <i>Installations and devices for space heating and/or space cooling, and parts of such goods included in Class 11.</i></p>
<p>951465</p> <p>THERMO-KING</p> <p>Filing date: 22 November 1969</p> <p>Date of entry in register: 22 November 1969</p>	<p>Class 11: <i>Installations and apparatus, all for space heating, and/or space cooling, and all for use in maintaining the temperature of goods in transit.</i></p>
<p>Community Trade Mark (“CTM”) 10791663</p> <p>THERMO KING</p> <p>Filing date: 5 April 2012</p> <p>Date of entry in register: 5 November 2012</p>	<p>Class 11: <i>Eutectic and passive refrigeration systems and devices; cryogenic cooling systems and devices; refrigeration and heating units for trucks, trailers, rail cars, ocean-going containers and other like transport vehicles; self-contained temperature control units adapted for connection to industrial enclosures such as transport vehicles, locker cabinets, food cupboards, cabinets and the like; said units being adapted to refrigerate and/or heat the space therein to preserve perishable products in transit; refrigeration units for conditioning the air of buses, vans and similar transportation vehicles; temperature</i></p>

	<p><i>control systems for mobile applications, namely, air conditioning, heating, and refrigerating appliances and installations for vehicles, truck bodies, shipboard containers and railway cars; air conditioning for buses, trains, urban mass transit and other like vehicles; heat and air conditioners for vehicles; energy conservation systems and devices, namely, cryogenic refrigeration and cold plate systems; in Class 11.</i></p> <p>Class 37: <i>Maintenance, overhaul and repair of transport heating, refrigeration and air conditioning equipment; battery jump starting; recharging service for refrigeration systems; installation and replacement service for heating, ventilating and air conditioning systems; in Class 37.</i></p>
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4) The holder subsequently filed a counterstatement denying the opponent's claims and putting it to proof of use in respect of its two UK registrations relied upon.

5) Only the opponent filed evidence in these proceedings. Both sides filed written submissions and ask for an award of costs. Neither side requested to be heard and I give my decision after careful consideration of the papers.

Evidence

6) The opponent's evidence takes the form of three witness statements by the following:

- Joseph M. Letang, registered trade mark attorney and partner at Dehns, the opponents representative in these proceedings;
- Erika Arvai, freelance translator who has provided a translation of a decision of the Hungarian Intellectual Property Office exhibited by Mr Letang;
- Donal Cox, strategic marketing & business intelligence leader of the opponent.

7) The sole purpose of Mr Letang's witness statement is to introduce into the proceedings a copy of a Hungarian decision. It can be seen from Ms Arvai's translation that the case number that the decision relates to is A1100085/13. The decision involves the same parties as the current proceedings and upholds an opposition against IR 1100085 in respect of an unspecified colour figurative mark featuring the words "thermoKing RADIATOR". Clearly the mark comparisons were different to that of the current proceedings, but in terms of similarity of goods and services, the decision included the conclusion that "radiators" can have the function of heating or refrigerating an enclosed space and therefore share the same function purpose and use as the opponents "independent

temperature control freezer units, which can be fitted to enclosed industrial spaces ...”

8) Mr Cox’s evidence is intended to address the issue of proof of use and can be summarised as follows:

- The THERMO KING mark has been in continuous use in the UK since at least 1972 in connection with “temperature control refrigeration units for industrial enclosures adapted to provide heat and/or cool air to control the temperature of the air within the enclosures.”
- Dealer agreements were signed with Marshall Thermo King (now called Marshall Fleet Solutions) in 1972 and with Thermo King Northern in 1976. Both dealers have continuously promoted the opponent’s THERMO KING goods in the UK;
- At Exhibit D are copies of invoices evidencing sales of Thermo King products within the UK by both dealers between 2010 and 2013. These are subject to a confidentiality order because they identify individual customers. For the purposes of this decision, it is sufficient that I record that:
 - The invoices include the mark THERMO KING appearing prominently at the top of each;
 - The majority of the 12 invoices describe the item provided as “refrigeration units”. Also listed are “parts of refrigerating/freezing equipment”. A number also relate to “Heater tanks”. These latter items are identified as being plastic fuel tanks;
 - Of the numerous companies supplied, it can be gleaned from its name, that one is in the business of renting refrigerated vehicles and from another that it is a business related to commercial vehicles. All other company names provide no clue as to the nature of their business;
 - The total value of the items covered by these invoices is in the region of €375,000.
- At Exhibit E are representative examples of literature and brochures in respect to the goods sold under the THERMO KING mark. Whilst these brochures provide detailed information about the products, none make any reference to “radiators” as being part of the product, but some do have a heating function (as well as a the primary refrigerating function) for the purposes of keeping cargo at optimal temperature “under extreme low ambient conditions”. This exhibit includes brochures for the following products:

- the THERMO KING T-Series range of “Self-Powered Truck Refrigeration” and carries a 2013 copyright notice;
 - the THERMO KING SLXe “temperature refrigeration system for trailers” and carries a 2012 copyright notice;
 - the THERMO KING V-500 Series “refrigeration series for direct drive truck” and carries a 2012 copyright notice;
 - the THERMO KING C-Series “refrigeration units” with “models available for every truck size” and carries a 2011 copyright notice;
 - the THERMO KING V-Series temperature control system for “smaller trucks and vans” and carries a 2013 copyright notice;
 - the THERMO KING B-Series refrigeration system for small trucks and vans and carries a 2013 copyright notice;
 - the THERMO KING V-700 Series of truck refrigeration units and carries a 2010 copyright notice;
 - the THERMO KING V-Series Spectrum Range of refrigeration units “to suit small vans to large trucks” and carries a 2012 copyright notice;
 - the THERMO KING V-800 Series for “fresh, frozen and deep frozen applications” and carries a 2013 copyright notice.
- The products in these brochures and sold under the THERMO KING mark are all refrigeration units specifically designed for use in road transportation of temperature sensitive cargo such as food stuff that needs to be kept refrigerated. These units all appear to be in the form of condensers;
 - Turnover and number of units sold in the UK are:

Year	Annual sales (US\$)	Units sold
2008	30,497,100	1253
2009	15,277,314	639
2010	22,935,849	1144
2011	27,187,388	1577
2012	29,716,024	1683
2013	35,247,003	2382

- Since 2008, the opponent has spent in excess of \$150,000 a year promoting its THERMO KING products. It is not stated if this figure applies only to the UK or to a wider geographical area;
- The opponent’s European website www.europe.thermoking.com and the dealers’ websites www.marshallfleetsolutions.co.uk and www.thermokingnorthern.com are targeted at customers in the UK. Sample pages from these websites are provided at Exhibit F and feature the THERMO KING mark. These pages are undated, but carry a date at the top of each page, that appears to be the date the pages were printed.

This date is represented as “2/11/14”. As the witness statement is dated 11 April 2014, I assume the date record relates to 11 February 2014. Of relevance is:

- Thermo King Northern states that it has over “30 year’s [sic] experience as a Thermo King main dealer”;
 - The first website referred to above states “Thermo King offers a comprehensive range of product solutions specifically designed for the transport temperature control industry”;
 - The products shown in the brochures detailed earlier also feature;
- Exhibit G consists of copies of press releases in the UK, during the period 2008 to 2013. These illustrate a product range as already identified in the earlier exhibits;
 - The opponent’s THERMO KING products have attracted a number of awards, such as “best branding the cooling units category”, “Best Innovation in Transport and Logistics” and “best vehicle cooling and heating system”.

DECISION

Proof of use

9) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(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), (b) 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(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...”

10) Consideration has to be taken, also, of section 100 of the Act which states:

“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.”

Consequent upon section 100 the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit, or that there are proper reasons for non-use.

11) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case law of the Court of Justice of the European Union (“the CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in 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 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"

12) The IR being challenged was published on 19 July 2013, consequently the five year period when the opponent is required to demonstrate use is between 20 July 2008 and 19 July 2013.

13) The holder put the opponent to proof of use in respect of both its UK registrations. One of these (951465) is limited to *all for use in maintaining the temperature of goods in transit*. As a result of this limitation the goods covered by this registration appear to fall within the goods listed in Class 11 of the opponents CTM that is not subject to proof of use. Consequently, even if the opponent could rely on the full list of services of this UK registration, it would put it in no better position than if it relied upon its CTM alone. I will therefore limit my consideration of proof of use to the opponent's other UK registration, namely 817058. This registration is in respect of the following list of goods:

Installations and devices for space heating and/or space cooling, and parts of such goods included in Class 11.

14) When considering the evidence of use, I keep in mind the guidance from the courts. It is clear from such guidance that genuine use does not need to be quantitatively significant and that, when asking if the use is genuine, it is necessary to assess all surrounding circumstances.

15) Taking account of the evidence submitted by the opponent, I have little hesitation in concluding that genuine use has been made of its mark in the UK. This evidence illustrates that THERMO KING has been used in the UK since 1972. Such a conclusion is supported by the distribution agreements, invoices and brochures exhibited. Such use has been shown in respect of, what is described in these exhibits as "refrigeration units" and "parts of refrigerating/freezing equipment". They are also described as "refrigeration systems". There is nothing in the evidence to suggest that such goods are for anything other than for use in the load spaces of trucks and trailers. It is appropriate that I consider what would be fair specifications to reflect this use.

Fair specification

16) The issue of what is a fair specification has been considered by the courts and I am particularly mindful of the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

17) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a

pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

18) Finally, I am also mindful of the guidance provided by the General Court ("the GC") in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (ALADIN)* Case T-126/03:

"42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

...

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

19) Therefore, I must consider if the evidence is sufficient to permit the opponent to retain the full specifications of its earlier UK mark 817058, or if not, what would be a fair alternative.

20) The registration is in respect of, what can be described as, space heating and cooling installations. It is not restricted to being in respect of load spaces in trucks and trailers. Secondly, none of the goods illustrated in the evidence can be described as heating installations. The goods are refrigeration units and are not intended to keep a space warm. As explained in the exhibited brochures, some of these refrigeration units have a heating function to prevent the required cool temperature from becoming too cold in extremely cold ambient conditions. Consequently, to describe such goods as heating installations creates a false impression. Heating installations belong to a different category of goods to refrigerator installations. Consequently, it would not be appropriate for the opponent to retain a reference to heating installations in its specification.

21) Further, goods specifically adapted for use in trucks and trailers are a distinct category of goods to those that may perform the same or similar functions in static spaces. Consequently, it is appropriate to limit the specification accordingly.

22) Taking account of these points, I limit the specification of registration 817058 as follows:

*Installations and devices for space heating and/or space **maintaining** cooling temperatures in load spaces of trucks and trailers, and parts of such goods included in Class 11.*

23) The opponent can rely on this limited specifications for the purposes of the opposition, but as it now places it in no better position than when it relies upon its CTM, I will restrict my consideration of the likelihood of confusion with the holder's mark to that of the opponent's CTM.

Section 5(2)(b)

24) Section 5(2)(b) reads:

“(2) A trade mark shall not be registered if because –

(a) ...

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

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

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

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent

distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of goods and services

26) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

'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.'

27) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

28) I also bear in mind the guidance of the GC in *Gérard Meric v OHIM*, T-133/05, paragraph 29, where it observed that goods can be considered identical when they are included in a more general category designated by the other mark.

29) In terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in*

the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06 where it was stated:

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Segio Rossi v OHIM - Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseño original Juan Bolanos)* [2007] ECR I-0000, paragraph 48)."

30) In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken against transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

31) Further, it is also relevant to keep in mind guidance on how to construe meanings of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

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

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

33) In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

34) Insofar as a comparison of the holder's goods with the opponent's Class 11 goods are concerned, the opponent's best case lies with its *heating units for trucks, trailers, rail cars, ocean-going containers and other like transport vehicles and temperature control systems for mobile applications, namely, ..., heating, ... appliances and installations for vehicles, truck bodies, shipboard containers and railway cars*. Other terms may provide an equally good case, but nothing else in the its Class 11 specification will provide it with a better one. Applying the above guidance, the natural meaning attributed to the holder's term *radiators (heating)* will be a device in the form of a tank that holds liquid that can be warmed for the purpose of heating a room or similar space. Such goods are associated with heating buildings and similar structures and not with the "mobile applications" listed in the opponent's Class 11 specification. The opponent's terms are likely to be understood as describing goods that circulate warmed air either generated by the goods themselves or heated by the engine of the vehicle concerned. Certainly, there is no evidence before me that radiators are used for such mobile applications. Applying the guidance from the courts, including *YouView*, I find that the ordinary meaning of the opponent's terms would not be considered to include radiators. The goods are therefore not identical as the opponent submits.

35) However, in terms of similarity, they share the same intended purpose as the holder's goods, namely to heat and their method of use may also be similar with both being operated in order to achieve a required temperature. However, there are also notable differences. Firstly, the respective goods are not in competition because one is developed for mobile applications, the other for buildings. These are quite distinct markets. Secondly, they are not complementary in the sense identified earlier. Thirdly, in light of the specialist nature of the opponent's goods,

the trade channels are likely to be different. Taking all of this into account, I conclude that these respective goods share only a moderate level of similarity.

36) In light of this finding, the opponent's best case lies with the following of its Class 37 services: *installation and replacement service for heating, ... systems*. Such services are not restricted to installation and replacement services for mobile heating systems and can, therefore, include the installation and replacement of heating radiators. Whilst there is a fundamental difference between the nature of goods and services, such services may share the same trade channel as the holder's goods with a business providing both its own radiators and their installation. Further, the holder's goods would be complementary in the sense that they are important to the very existence of the installation of the same goods. Taking all of this into account, I conclude that there is a moderately high level of similarity between the holder's goods and the opponent's *installation and replacement service for heating, ... systems*.

The average consumer and nature of the purchasing act

37) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

38) I have identified the opponent's best case being in respect of its *installation and replacement service for heating, ... systems*. The average consumer for such services can equally be members of the public looking to replace their central heating systems or part thereof or businesses such as building contractors who may require that such services are provided as part of the fitting out of new properties or renovation of existing buildings. The same average consumer will also, on occasions select the holder's heating radiators directly with a view to self-installation. Such services and goods are not regular purchases and are likely to be reasonably costly, consequently, the degree of care and attention paid during the purchasing process is likely to be higher than for more everyday goods and services, but not of the highest level.


Comparison of marks

39) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and

dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

40) It would be wrong, therefore, to artificially dissect the 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. The marks are:

Opponent's mark	Holder's mark
THERMO-KING and THERMO KING	

41) The opponent's two marks differ by the presence of a hyphen between the two words. I consider this difference to be immaterial in my considerations and I will refer to the opponent's two marks as a one.

42) The holder's mark readily divides into the components "thermo", "Queen" and "Radiator". The last of these is merely the name of the goods and adds nothing by way of distinctive character to the mark. Rather, the distinctive character resides in the words "thermoQueen" and the stylisation of the mark. The distinctive character of the opponent's mark resides in its totality, namely the combination of the two words THERMO KING.

43) Visually, the marks share a moderate level of similarity because of the word THERMO appearing at the beginning of both marks, but in all other respects they are different. Aural considerations are similar with the two syllables THER-MO being common to the beginning of both marks. Further, they both comprise of three syllables, but this third syllable is different in each mark.

44) Conceptually, the word THERMO creates a message of temperature or heat, and this is common to both marks. As the opponent points out, the presence of the words KING and QUEEN respectively both describe royal heads of state and both carry very similar laudatory connotations. Taking all of this together, I conclude there is a good level of conceptual similarity.

45) Taking all of the above into account, I conclude that the marks share a reasonable level of distinctive character overall.

Distinctive character of the earlier trade mark

46) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier mark must be assessed by reference to the goods and services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

47) The opponent's marks consist of the words THERMO KING. This creates the impression that the goods sold under the marks are the best and that they relate, in some way, to temperature or heat. Consequently, the marks are not endowed with the highest level of distinctive character, but nonetheless, they have a normal level.

48) The turnover figures for the UK appear impressive, averaging in the region of \$26 million a year in the six years up to 2013. Such turnover is in respect of *installations and devices for maintaining cool temperatures in load spaces of trucks and trailers, and parts of such goods*. However, there is no information regarding the scale of use, if any, in respect of *installation and replacement service for heating, ... systems* that provide the opponent with its best case. For such services, it is only the inherent level of distinctive character that I will take into account.

Likelihood of confusion

49) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

50) As the opponent has submitted, the earlier marks are inherently distinctive in respect of all the goods and services for which they are registered. Further, I have found that the respective goods and services identified at paragraph 36 share a moderately high level of similarity and that the respective marks share a reasonable level of similarity, including the fact that, conceptually, there is a good deal of similarity. I also found that the purchasing process involved a higher level of care than in respect of everyday goods. Balancing all of these conclusions, I find that the similarities are such as to outweigh the differences. The average consumer may notice the differences between the marks because of the

stylisation of the holder's mark and because of the visual difference between the words KING and QUEEN. However, because of the similarities, in particular, the conceptual similarity there is a likelihood of confusion, I find that the consumer is likely to assume that the respective marks identify goods and services from the same or linked undertakings.

51) Therefore, there is a likelihood of indirect confusion and the opposition therefore succeeds.

COSTS

52) The opponent has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that the opponent filed evidence and written submissions. I make the following award:

Preparing a statement and considering the counterstatement	£300
Opposition fee	£200
Evidence	£400
Written submissions	£250
Total:	£1150

53) I order PEKSA PROFİL SANAYİ VE TİCARET A.Ş. to pay Thermo King Corporation the sum of £1150 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 13th day of January 2015

**Mark Bryant
For the Registrar,
the Comptroller-General**