

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos 2023032A AND B
BY LIFESCIENCE PRODUCTS LTD TO REGISTER
THE MARKS WATER KING & DEVICE AND
WATER KING IN CLASS 11**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER Nos 44732/3 BY KLEIBER (UK) LTD**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application Nos 2023032A
and B by Lifescience Products Ltd to register the
marks WATER KING & device and WATER KING
in Class 11**

10 **and**

**IN THE MATTER OF Opposition thereto under
Nos 44732/3 by Kleiber (UK) Ltd**

15

DECISION

20 On 6 June 1995 Lifescience Products Ltd of Abingdon, Oxfordshire applied under the Trade
Marks Act 1994 to register the marks WATER KING and device and WATER KING in Class
11 in respect of the following goods:-

25 “Water treatment apparatus; water conditioning apparatus; water softening apparatus;
apparatus for reducing the effects of lime scale in hard water”.

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The WATER KING and device mark applied for is in the following form:-

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40 On 12 June 1995 Kleiber (UK) Ltd opposed the applications on the following grounds:-

- 45 1. They say that they are proprietors of the mark SKALE KING as registered under No 1527716. As the marks applied for are confusingly similar to their registered mark and as the same goods are at issue, registration of the marks applied for would offend against the provisions of Section 5(2)(b) of the Act. The opponents also say, in support of their case under this ground that they have made substantial use of their mark and have a significant goodwill and reputation in it.

2. The opponents say that use of the applicants mark is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark including an action for Passing Off as specified in Section 5(4)(a) of the Act, based on their prior use and reputation in the marks SKALE KING and SKALE KING and device.

3. The opponents list a number of other grounds in their notice of opposition but I take the view that they are not relevant to these proceedings and dismiss them forthwith.

The opponents' mark as registered and used is in the following form:-



Specification

Apparatus and instruments for de-scaling; water purification, conditioning, filtration, and treatment apparatus and instruments; apparatus and instruments for the prevention and removal of scale; water softening apparatus and instruments; electronic descaling apparatus and instruments; parts and fittings for the aforesaid goods; all included in Class 11.

The applicants deny the opponents' grounds of opposition and say that the respective marks are not confusingly similar.

Both sides ask for an award of costs.

The two parties filed evidence in these proceedings and the matter came to be heard on 6 April 1998 when the applicants were represented by Mr Guy Tritton of Counsel instructed by Forrester Ketley & Co and the opponents by Ms Denise McFarland of Counsel instructed by Castle International.

Opponents' Evidence

The opponents' evidence consists of a Statutory Declaration dated 29 November 1996 by Mr David Byers who is their Managing Director.

Mr Byers refers to the fact that his firm has a registration for the trade mark SKALE KING and device and that this mark and the mark SKALE KING have both been used by his firm. Use is said to date from early 1993 and a selection of invoices is displayed under Exhibit DB2.

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Adoption and promotion of the SKALE KING marks commenced in early 1993 with the distribution of the house magazine KLEIBER NEWS to approximately 400 councils and local authorities throughout the United Kingdom. A copy of the magazine is displayed under DB3. A coloured promotional leaflet was produced in May/June 1993 and twenty thousand

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Further promotion took place in 1993 and 1994 and copies of advertisements placed in the Norfolk & Suffolk Express, The Sunday Times and The Plumbing and Heating News are provided at DB5. Promotional expenditure is estimated at £20,000 in 1993, £15,000 in 1994 and £20,000 in 1995.

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The ex-factory value of goods sold under the marks is said to have been £45,000 in 1993, £27,000 in 1994 and £73,000 in 1995.

Mr Byers says his firms SKALE KING marks are widely recognised as indicating leading products in their field and his firm have a number of high profile customers. Examples are listed. He further says that use by the applicants of their marks WATER KING and WATER KING and device in relation to the same goods as those of his company has led to deception and confusion, given the reputation of his firm's marks.

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In relation to possible confusion between the respective marks Mr Byers submits that both SKALE and WATER are wholly non-distinctive in relation to the goods at issue and, in the composite marks the devices of the two parties are very similar. This being the case the significance of KING in both marks is enhanced. Put bluntly, Mr Byers believes the

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respective marks are confusingly similar and he therefore submits that the applicants' marks should be refused registration.

A Statutory Declaration dated 16 January 1997 is provided by Mr Colin Charles who is Managing Director of Aqua Dial Limited, a company in the water treatment industry and a competitor of the opponents. He has been in the industry since 1978.

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Mr Charles says he first became aware of SKALE KING in mid-1995 and in early 1996 encountered the WATER KING mark of the applicants. He says he was not personally confused because he was aware of, and associated the respective marks with the respective

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companies. However, he expresses the opinion that ordinary consumers in the water treatment field could readily confuse the two marks. He further says that he is familiar with the SKALE KING product and it has a good reputation and profile in the marketplace.

A Statutory Declaration dated 23 January 1997 is provided by Mr Michael Pickavance who is Managing Director of Salamander (Engineering) Ltd. He says he has been in the water treatment industry since 1978 and that his company is a competitor of the opponents.

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Mr Pickavance says he first encountered the opponents SKALE KING and crown logo mark in May 1994. He first encountered the WATER KING and crown logo mark in early 1995 and immediately assumed a connection with the opponents and the SKALE KING descaler. Mr Pickavance expresses the view that the respective marks are similar and that there is a real prospect of others, both within the trade and consumers, being confused.

Finally there is a Statutory Declaration dated 14 February 1997 from Mr Mark Goddard. Mr Goddard is the Managing Director of Silverline UK Ltd, a position he has held since 1990. Mr Goddard says that his company manufactures water filtration equipment for the water treatment industry.

Mr Goddard says that his company decided to take a stand at the Ideal Home Exhibition in March/April 1996. As his company did not manufacture water conditioners it wished to target a manufacturer to supply such goods. Consideration was being given to the purchase of the SKALE KING descaler when he saw an advertisement for the applicants WATER KING product. He says he assumed the goods were from the same source because of the crown logo device.

Mr Goddard goes on to say that he was not absolutely confused between the two marks but he thought them sufficiently similar to the extent that he assumed the respective products were in some way connected.

Applicants' Evidence

The applicants' evidence consists of a Statutory Declaration dated 29 May 1997 by Mr John Gavin Beaumont who is their Chairman, a position he has held since the incorporation of the applicants in June 1993.

Mr Beaumont explains the adoption of the mark WATER KING in 1993 and says that use commenced in September 1993. The product sold under this mark is for the treatment of water so as to reduce the effects of limescale. Examples of use are provided under Exhibit JGB1. The mark primarily used is the WATER KING and LOGO mark but there is some use of the words alone.

The WATER KING product has been promoted extensively and Mr Beaumont provides relevant details. He also says that sales of £6,822 occurred in the period October 1993 to December 1993 and gives the following additional sales and promotion figures:-

	Sales £	Promotion £
Year to 30 June 1994	40,970	12,246
Year to 30 June 1995	191,221	55,627
Year to 30 June 1996	1,206,392	341,545

Mr Beaumont says that his company's WATER KING products have been sold throughout the United Kingdom and he is not aware of a single instance of confusion between the respective marks.

5 In relation to the opponents' evidence Mr Beaumont disagrees with the claims made by Mr Byers and in particular disagrees with the view that the respective device elements are similar. He says the device element in the WATER KING mark is intended to represent a stylised image of water displaced by a water droplet landing in a body of water whereas the device element in the opponents' mark is a crown type device. He also refers to other
10 differences between the two logo marks which in his view distinguish them from each other. In relation to the word marks he says that KING has laudatory connotations and cannot therefore be regarded as a distinguishing feature.

15 The applicants' agents carried out a search of the Trade Mark Register and discovered two other marks GRIT KING and STORM KING which are registered for products for use in the water treatment industry. Thus Mr Beaumont is of the opinion that the opponents are not the only party owning a "KING" mark and this being the case the likelihood of confusion between SKALE KING and WATER KING is reduced.

20 Mr Beaumont goes on to criticise the opponents' evidence at some length during which he refers to the threat of trade mark infringement which the opponents made against his company's use of the WATER KING mark. He also refers to the fact that certain elements of the opponents mark have been disclaimed and submits that such disclaimers weaken the opponents' case.

25 Mr Beaumont refers in some detail to the declaration of Mr Goddard and to subsequent telephone contacts with him. As a result of these discussions Mr Goddard has now filed a further Statutory Declaration explaining the background to his previous declaration. I will review it in detail later in my decision.

30 I should also mention that Mr Beaumont also criticises the information contained in the declarations of Mr Pickavance and Mr Charles and expresses concern at their selection and the questions which may have been put to them by the opponents' trade mark agents. He says he notes that Mr Charles "was not personally confused" and that Mr Pickavance says "he
35 assumed there to be a connection".

Mr Beaumont expresses the view that the views of Mr Charles and Mr Pickavance about the likelihood of confusion may be coloured by the fact that their firms are competitors of the applicants. He says he would expect them to cause as much inconvenience for his company
40 as possible.

The applicants provide a further Statutory Declaration dated 9 June 1997 by Mr Jonathan Lawrence Seccombe who is their Managing Director, a position he has held since 1994.

45 Mr Seccombe says he has reviewed the opponents' evidence and says he is astonished that Mr Pickavance and Mr Charles only became aware of his company's WATER KING

products in 1995 and 1996 respectively. He says his company started promoting its WATER KING products in September 1993 and engaged in heavy promotion throughout 1994 and beyond; including promotion at the Heating Ventilating and Air Conditioning shows at Olympia. In spring 1995 the product was promoted at the Ideal Home Exhibition. This being
5 the case Mr Seccombe says he would have expected Mr Pickavance and Mr Charles, who both claim to be familiar with the water treatment industry, to be aware of his company's products from the outset.

Mr Seccombe refers to a conversation with Mr Pickavance at the Interbuild Exhibition in
10 1995 and says that at no time during the course of that conversation was the possibility of confusion between the marks WATER KING and SKALE KING mentioned.

By way of further investigation Mr Seccombe says that he has spoken to Mr Paul Andrews who is a Senior Buyer for Heating Suppliers and a Mr Malcolm Watkins of Norwich
15 Discount Plumbing. Mr Andrews had never encountered the SKALE KING mark but Mr Watkins was aware of that product and was not personally confused between the two marks. Mr Seccombe goes on to say that he did not wish to put Mr Andrews and Mr Watkins to the trouble of providing Statutory Declarations but they could be provided if necessary.

20 In conclusion Mr Seccombe casts doubt on the motives of Mr Pickavance and Mr Charles in providing evidence in support of the opponents by claiming that their firms are competitors of his company. Mr Seccombe expresses the opinion that the marks SKALE KING and WATER KING are not confusingly similar.

25 The final Statutory Declaration filed by the applicants is by Mr Mark Goddard who filed a declaration in support of the opponents in these proceedings. His declaration is dated 13 June 1997.

Mr Goddard is a Director of Silverline UK Ltd and his firm is a manufacturer of domestic and
30 commercial filtration equipment. He says that he makes his declaration to clarify comments made in his earlier declaration of 14 February 1997. For clarity I include the following extract from his declaration:-

35 "4. It was my understanding that Kleiber (UK) Limited did not manufacture their own products but were in the habit of purchasing other companies' products and applying their own brand labels to them. This is a common practice in this industry. I purchased one of Lifescience Products Limited's WATER KING products in 1995 and, as I mentioned in my Statutory Declaration of 14 February 1997, I assumed that the products sold by reference to SKALE KING and WATER KING were in fact one
40 and the same. By way of clarification of that comment, I assumed that the SKALE KING product was in fact a product made by Lifescience Products Limited and to which SKALE KING had applied their own labels.

45 5. As I mentioned in my Declaration of 14 February 1997 used in support of Kleiber (UK) Limited's Oppositions, I was not absolutely confused between the two Marks. On inspection I appreciate that there are differences between the Marks.

However, the similarity between the two Marks, in that they share common features, coupled with the known practice in this industry whereby companies which sell products made by others use Marks “cloned” from the manufacturer’s Marks, led me to believe the products were connected. I believed that Kleiber (UK) Limited would

5 not have manufactured their own descaler product since I was aware of that company’s usual practice of purchasing products from other companies and applying their own label to those products. Thus, I incorrectly assumed that the SKALE KING product was, in fact, a descaler unit manufactured by Lifescience Products Limited and to which Kleiber (UK) Limited had applied their SKALE KING Mark. This was
10 the only connection, which I had assumed to exist between the product sold under the SKALE KING Mark and Lifescience Products Ltd.”

That completes my review of the written evidence filed in the proceedings and I now turn to the grounds of opposition. The first ground to consider is under Section 5(2)(b) and the
15 relevant part reads as follows:

5(2) A trade mark shall not be registered if because -

20 (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,

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

It is common ground between the parties that the goods at issue are identical so the only matter to be decided under this heading is whether or not the respective trade marks are
30 confusingly similar. To remind readers the respective marks are as follows:-

Applicants marks



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WATER KING

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Opponents mark



20 As a first step it is useful, I think, to set down what facts have been established by the evidence in these proceedings:-

- 25
1. The opponents mark was registered on 20 February 1993 and it would appear that promotion and use, on a limited scale, commenced in late spring/early summer of 1993. It is said some £20,000 was spent promoting the mark and goods in 1993 and the value of goods sold in that year is put at £45,000.
 2. The applicants first commenced to use their marks in September 1993 and they were promoted widely. Sales in the period October 1993 to December 1993 totalled £6,822. They applied to register their marks on 6 June 1995.
 3. There is little doubt that the applicants have a bigger business than the opponents. By 1995 their sales totalled over £190,000 as compared to the opponents' sales of £73,000, and had further increased to over £1.2M in 1996.

35 These facts do not impact greatly on my comparison of the respective marks but they do serve to establish the circumstances against which I must make my decision.

40 As these are 1994 Act proceedings I could refer to the guidance of the European Court of Justice in the Puma v Sabel case C251/95 but I believe the guidance of Parker J as set down in Pianotist Co's Application (1906) 23 RPC 97 at page 777 lines 26-39 to be still relevant and comprehensive. The relevant extract reads as follows:

45 "You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must

further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

Additionally, in this case, in the context of imperfect recollection, it is relevant to take account of the judgement of Luxmore L J. which was approved by the House of Lords, in the *Aristoc Ltd v Rysta Ltd* case [1945] 62 RPC at page 72 line 46 to page 73 line 4 where he says:

"The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of Section 12 of the Trade Marks Act 1938 must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance therefore is to be obtained from meticulous comparison of the two words, letter by letter and syllable by syllable pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants."

I compare first of all the two logo marks. In relation to the goods at issue it is a fact that the words WATER and SKALE (phonetically scale) are non-distinctive, that KING is to some extent laudatory and that the devices within the marks are similar but not identical.

Phonetically the marks are different in relation to the goods at issue but they do not conjure up really distinctive images which would serve to distinguish the two marks from each other. Thus when the words are combined with a similar device in each case I am of the view that the respective marks are so similar that there is a likelihood of confusion on the part of the public as to origin of the respective goods. In relation to this view, however, I must consider all the surrounding circumstances to decide if that view should be displaced and the applicants' mark allowed to proceed to registration. At this stage it is worth considering the evidence of the trade declarants filed in these proceedings and what weight I should give to the views expressed.

I doubt very much if the evidence of Mr Charles is of much assistance to me. He appears to be merely expressing a personal view as to how consumers will react on encountering the two marks and that decision is one for the tribunal. Mr Charles was aware of the fact that the respective marks were owned by different companies and therefore he himself personally was not confused between the two marks.

The evidence of Mr Pickavance is rather more debateable. He says that upon meeting the applicants' logo mark he assumed a connection with the opponents' SKALE KING mark. Mr Pickavance has been criticised for not making clear what he meant by "a connection" but I do not think too much need be made of this point. I certainly understand "connection" to mean a relationship between the two parties and/or the sale of the same goods under different marks. As Mr Pickavance has been confused I think it is reasonable to suggest that other consumers could equally be confused.

Finally there is the evidence of Mr Goddard. In his declaration in support of the opponents Mr Goddard assumed, when he first encountered the WATER KING mark, that the WATER KING goods were from the same source as the SKALE KING goods. In his later declaration in support of the applicants he explains that he was not absolutely confused between the two marks and on closer inspection he appreciates that there are differences between the marks. However, he still sees the marks as similar in that they share common features. However, as he is aware that the applicants are manufacturers he would assume that the opponents were applying their mark to the applicants' product.

I find Mr Goddard's evidence to be useful since it in many ways reflects my view of the two marks. They are similar but can be distinguished on close inspection, particularly if one knows the industry concerned and that the two parties involved are separate legal entities. But that is not the proper test since ordinary consumers will not have such information when they encounter the respective marks or depend, perhaps on imperfect recollection to distinguish between them.

Other matters were raised at the hearing which I must consider. The first of these concerns the fact that the opponents' mark is subject to "a disclaimer to the exclusive right to the words SKALE and KING". Mr Tritton submitted that, as the wording of Section 13 makes clear, the rights conferred by registration at Section 9 are restricted accordingly. Based on the construction of the Act he argued that this must impact on my consideration under Section 5 of the Act.

I believe Mr Tritton to have an arguable case on this matter but I do not have to decide the point in this case and decline to do so. In my consideration I am comparing the respective marks as wholes and while one of the common features is disclaimed, I consider the presence of the similar devices appearing in the respective marks to be equally important in comparing the two marks.

The second matter argued before me by Mr Tritton is the descriptive nature of the opponents' mark and in his submissions he referred to the Office Cleaning Services Ltd v Westminster Window and General Cleaning Ltd case 63 RPC 39. I accept of course that the words SKALE KING appearing in the opponents marks are not particularly distinctive but the mark is presented in stylised form and also contains a device element. In my view the case quoted here does not assist the opponents.

Finally, there is the matter of other KING marks on the Trade Mark Register. It is well established, I think, that this fact would only be relevant if it was shown in the evidence that such marks are in use in the marketplace and that the public have learned to distinguish between the various KING marks. No such information is before me here.

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Having carefully considered the written evidence and the extensive submissions by Counsel I have come to the conclusion that the respective logo marks are confusingly similar and that the opponents succeed in this ground of their opposition against application No 2023032A.

10 That is not the end of the matter since I must compare the opponents' logo mark with the applicants' mark WATER KING. My first impression was that these marks are not confusingly similar and there is nothing in the evidence or in the submissions made to me at the hearing that have changed that view. All the trade declarants were clearly looking at the respective logo marks when considering the possibility of confusion and it seems to me that
15 the absence of the device element from the applicants' mark is a material factor when comparing the two marks. I realise that finding the respective logo marks confusingly similar and then finding the opponents' logo mark and the applicants' word mark, not confusingly similar is a finely balanced judgement but that in my view is the nature of trade marks.

20 In conclusion therefore I find that the opponents fail in this ground of their opposition against application No 2023032B.

The second ground of opposition is under Section 5(4)a) of the Act which reads as follows:-

25 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
30 of trade.

I have already decided these proceedings under Section 5(2)(b) of the Act and I see little point in going on to consider this ground of the opposition under Section 5(4)(a) and I decline to do so. I merely note in passing that the opponents' mark, like the applicants, consists in
35 the main of descriptive elements combined with the laudatory word KING. That being the case, there would appear to be, in the light of the Office Cleaning Services case, a significant burden on the opponents to prove their passing-off claims. I am not satisfied, absent the cross examination of declarants, that their evidence is sufficiently precise in relation to their use and reputation at the relevant dates. However, in the event of an appeal I do not say that
40 the matter is not arguable.

In conclusion, I find the opponents to be successful in their ground of opposition under Section 5(2)(b) against application No 2023032A but that they fail in their ground of opposition under Section 5(2)(b) against application No 2023032B.

In the circumstances of these consolidated opposition proceedings, I have decided to make no award of costs.

5 Dated this 30th day of April 1998

10 N A HARKNESS
Assistant Registrar
For the Registrar
the Comptroller-General