

O-282-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3012811
IN THE NAME OF
INTACO LIMITED**

IN RESPECT OF THE TRADE MARK

I-BALL

IN CLASS 11

AND

**THE OPPOSITION THERETO
UNDER NO 401098
BY
ALTECNIC LIMITED**

Background and pleadings

1. Intaco Limited (“the applicant”) applied to register the trade mark I-BALL (number 3012811) on 5 July 2013. The mark was accepted and published in the Trade Marks Journal on 26 July 2013 in Class 11 for the following goods:

Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components; heating components; valves, thermostatic mixing valves; radiator valves; shower valves; taps; mixer taps; chilled water installations and apparatus; central heating installations and apparatus; pressurisation units for maintaining the pressure within water systems; solar collectors; solar heating panels; solar powered heating apparatus and installations; parts and fittings for all the aforesaid goods.

2. Altecnic Limited (“the opponent”) opposes the application under section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”). This is on the basis of two earlier registered trade marks:

(i) INTABALL

2270699

Class 11: *Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components; heating components; valves, thermostatic mixing valves; radiator valves; chilled water installations and apparatus; central heating installations and apparatus; pressurisation units for maintaining the pressure within water systems.*

Filing date: 22 May 2001; completion of registration procedure: 2 November 2001.

(ii) INTABALL COMBI
Intaball Combi (series of two)

2658002

Class 11: *Apparatus and installations for heating, water circulation, water supply and sanitary purposes; plumbing fixtures, fittings and components; heating components; valves, thermostatic mixing valves; radiator valves; shower valves; taps; mixer taps; chilled water installations and apparatus; central heating installations and apparatus; pressurisation units for maintaining the pressure within water systems; solar collectors; solar heating panels; solar powered heating apparatus and installations; boilers; heat interface units; parts and fittings for all the aforesaid goods.*

Filing date: 26 March 2013; completion of registration procedure: 19 July 2013.

3. The opponent argues that there is a likelihood of confusion because the respective goods are either identical or similar and the marks are similar. Owing to the reputation in INTABALL, the opponent claims that the application would take

unfair advantage of that reputation, and would cause detriment to the distinctive character and repute of INTABALL.

4. The opponent claims that registration of the mark would be contrary to section 5(4)(a) of the Act, particularly the law of passing off. It claims that it has used the sign INTABALL in relation to a range of heating and plumbing goods since 1 June 2001. Use of the trade mark applied for would constitute misrepresentation to the public and result in damage to the opponent's goodwill.

5. Under section 3(1)(b) of the act, the opponent claims that the mark should not be registered because it is devoid of any distinctive character for ball valves. This is on the basis that the mark contains the word Ball and that the only other element is the single letter I.

6. The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of its earlier trade mark INTABALL (2270699), which had been registered for more than five years at the date on which the application was published¹.

7. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. A Hearing took place before me on 13 June 2014 by telephone conference, when the opponent was represented by Keiron Taylor of Swindell & Pearson Ltd and the applicant by Robert Sales, also of Swindell & Pearson Ltd. The submissions made during the hearing have been fully considered in reaching this decision and will be referred to as and when appropriate. I mention here that the scope of the section 5(3) and 5(4)(a) grounds was reduced at the hearing to a reliance on mark (i), INTABALL, only.

Evidence

8. The opponent's evidence comes from Alan Sherwin, who has been the opponent's managing director since August 2010 (having worked for the opponent for nine years). The main points are:

- INTABALL products are sold to distributors of heating and plumbing products;
- INTABALL has been used as a trade mark for valves since 2002 throughout the UK, including:

- Ball valves with a blue butterfly handle
- Ball valves with a red butterfly handle
- Lever ball valves with a blue handle
- Lever ball valves with a red handle
- Combi ball valves with and without drain ports
- Lever operated ball valves for gas

¹ As per section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

- The INTABALL mark is displayed in the opponent's brochures, instruction manual, publicity material, pricelists, website and, where possible, on the goods themselves;
- A 52-page brochure² dated February 2012 which shows INTABALL valves on pages 33, and 41 to 43;
- Extracts from the opponent's website³, dated 24 May 2013 but which Mr Sherwin states are substantially unchanged from the date on which the applicant's mark was published. The extracts show the mark INTABALL (in some cases on the handle of the valves), but no other goods;
- The opponent's website has between 2000 and 2700 unique visitors per month;
- Internet archive prints⁴ show use of INTABALL from 2004 to 2011;
- A 66-page price list⁵ from January 2010 shows INTABALL valves on pages 28 to 30, 38, and 39 (but no prices).
- Copies of web pages⁶ from May 2013 showing the sale by third parties of INTABALL ball valves (Wickes, Travis Perkins and Advanced Water Company Limited. Prices of INTABALL lever ball valves range from £5.63 to £67.75, depending on the diameter of the valve;
- A selection of invoices⁷. "Intaball" appears on some (within the relevant period). Other invoices refer to red or blue lever ball valves, but the part numbers correspond to the INTABALL red and blue lever ball valves shown in the February 2012 brochure;
- UK INTABALL turnover for the five years ending in 2012 was about £2 million per year. Marketing spend is put at £5000-£1000 thousand a year;
- Mr Sherwin states that he does not know the market share of INTABALL products. He thinks that INTABALL products are the market leader, possibly with 10% of the market;
- "Relevant parties from the Applicant were in charge at Altecnic for some years".

² Exhibit AS001

³ Exhibit AS002

⁴ Exhibit AS004, from web.archive.org.

⁵ Exhibit AS005

⁶ Exhibit AS006

⁷ Exhibit AS007

Preliminary point

9. Mr Taylor (for the opponent) filed a copy of an advertisement by the applicant with his skeleton argument, which he said went to the ground under section 5(4)(a). He said that the advertisement had only recently come to light and showed how the use, in practice, of the applicant's mark would cause deception. This appeared to hinge on the adoption of the word INTA (which I understand from decision number BL O/276/14⁸ to be the subject trade mark application belonging to the applicant) with a picture of a valve beneath it and, beneath the valve, the applicant's mark I-BALL. I refused to admit the evidence as it was very late in the day; would cause the applicant to be permitted time to file rebuttal evidence; and, most of all, the opponent's concern appeared to me to be more appropriately aired as an infringement issue, which I cannot determine.

Decision

Proof of use

10. The parties have recently appeared before two other hearing officers in the Registry; their decisions are referenced as BL O/086/14 and BL O/276/14. Evidence almost identical to that filed in the present proceedings was filed in the previous two cases. Both hearing officers found that the opponent had proved genuine use in respect of "Ball valves for use in plumbing and heating", but no wider. On the evidence before me, I agree⁹. Mr Taylor referred me to the first of those decisions (the other had not been issued by the date of the hearing before me) and said that he was content to proceed on the same basis, although if I were to find that wider use had been made, he would be happy to accept such a finding. There is no evidence on anything other than ball valves and so I do not find that wider use has been made. This decision, in so far as it is affected by use issues, will be based on use of INTABALL for "Ball valves for use in plumbing and heating".

Section 5(2)(b) of the Act

11. Section 5(2)(b) of the Act states:

"(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."

⁸ A decision of another hearing officer for the Registrar.

⁹ Based upon the guidance in *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch).

12. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

Comparison of goods

13. Some of the contested goods are identical to the goods and/or services on which the opposition is based. Owing to the findings in this decision, for reasons of procedural economy, I will not undertake a full comparison of the parties' goods above. I will proceed on the assumption that all the goods (limited to ball valves for use in plumbing and heating in the case of the earlier INTABALL mark) are identical.

Average consumer and the purchasing process

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

15. In BL O/086/14, the hearing officer said:

“40. Whilst it is likely that most of the goods will be bought by professionals such as plumbers and heating engineers, many will also be bought by e.g. those members of the general public who are competent DIYers. As to the level of attention these different purchasers will pay, I note that in *Adelphoi Limited v DC Comics (a general partnership)* BL O/440/13, Professor Annand, sitting as the appointed person stated:

“21. As for the services, e.g., broadcasting, whilst I agree with Mr. Malynicz that the average consumer would include business consumers or professionals as well as the general public, the likelihood of confusion must be assessed in relation to the part of the public whose attention is lower (see e.g., Case T-448/11, *Golden Balls Ltd v OHIM*, 16 September 2013, para. 26), although in any event, the Hearing Officer relied on an average consumer (reasonably well informed and reasonably circumspect and observant) paying an average level of attention (para. 41).”

As the respective goods range from e.g. a complete central heating system to a small replacement part, they will vary widely in price. Because of the need

to ensure a part is of an appropriate fit and function within a more complex system and compatible with it or because of the need to ensure the complete system is appropriate to the location and purpose for which it is being installed, all of the goods are such as are likely to be subject to a purchasing process involving some, though not necessarily the highest, degree of care whether bought by a professional or a member of the general public. The goods are such as are sold in specialist stores such as plumbers merchants though some may also be sold in more general DIY or hardware stores, whether on line or on the high street and thus the visual aspects of the marks are likely to come into play. That is not to say the aural aspects can be ignored as it is possible that some businesses will create a job list and place orders with suppliers over the telephone for direct delivery to a specific location for its installation.”

16. I agree and add that it is my experience that plumbers call into plumbers’ merchants on their way to a job to obtain parts. That may also entail asking for the product. The level of attention of the average consumer will be linked to the cost of the product: a complete hearing installation is expensive and will be the subject of a high degree of attention. A ball valve costing about £6 will cause less attention, although still enough to ensure it is the right valve for the purpose.

Comparison of trade marks

17. The marks to be compared are:

Earlier marks	Application
<p>INTABALL</p> <p>INTABALL COMBI</p>	<p>I-BALL</p>

18. The authorities cited earlier in this decision direct that, in making a comparison between the marks, I must compare each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details, as per *Sabel BV v Puma AG*, paragraph 23:

“That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their dominant and distinctive components.”

19. The applicant’s mark naturally separates into I and BALL, although it is clear that they are linked together because that is the job of the hyphen. INTABALL shares some similarities visually with I-BALL, on account of the initial letter I and the end of the marks being BALL. However, INTABALL is a longer mark. There are more visual differences than there are similarities and, therefore, I assess the visual

similarity level as low in relation to INTABALL and very low indeed in relation to INTABALL COMBI.

20. Aurally, the differences are even more marked. The applicant's mark sounds like "eyeball". The I in I-BALL (a long I) does not sound anything like the way in which the I in INTA will be pronounced (a short I). The only similarity is the ending BALL. There is a very low degree of aural similarity in relation to INTABALL and even less similarity between I-BALL and INTABALL COMBI, where the BALL element will not even be the last element heard.

21. The marks do not have a clear meaning, other than, aurally, the applicant's mark means 'eyeball'. The BALL element will be given its natural meaning in the applicant's mark and the I does not create any concept other than it is the letter I. Although BALL is more disguised in INTABALL than it is in I-BALL, it is likely to be recognised in INTABALL, as per *Usinor SA v OHIM*, Case T-189/05:

"62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57)."

22. The common conceptual factor is BALL. However, the other elements of the marks point away from conceptual similarity, particularly because INTA is an invented part of INTABALL. I assess conceptual similarity between the marks to be at a very low level. In the case of the earlier mark INTABALL COMBI, the conceptual differences are even more pronounced because of the added meaning provided by COMBI, as in combi boiler and as a shortened version of combination.

23. The dominant element in the applicant's mark is BALL (it is the longest element), although it is not distinctive for those of the applicant's goods which relate to ball valves. The dominant element in the earlier marks is INTABALL because it is an invented word which will be perceived as a whole, notwithstanding the evocation of BALL. Combi is descriptive or highly allusive to goods which relate to combi boiler systems, and allusive of 'combination' goods, so cannot be distinctive or dominant.

Distinctiveness of the earlier mark

24. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹⁰ 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

¹⁰ Case C-342/97

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)."

25. Mr Sherwin does not know what the opponent's market share is for ball valves, but considers it to be about 10%. Looking at the prices of the opponent's INTABALL valves, they range from about £6 to about £60. It was Mr Taylor's submission that the bulk of sales would come from the cheaper end of the range because smaller piping is more common than larger piping for such valves. Mr Sherwin surmises that about a third of a million valves are sold annually. I conclude that the inherent reasonably distinctive character of INTABALL for ball valves is enhanced by use to some degree.

Likelihood of confusion

26. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. Mr Taylor gave me an example of how he thought imperfect recollection might operate in this case:

"If I take an example from random out of the specification, two different taps in the same store and in the left hand is the Intaball and in the right hand the I-BALL and ask themselves, "Am I confused?" Rather the consumer may see an advert for an Intaball product extolling its virtues or half remember a conversation with a colleague when someone mentioned an Intaball product as being advantageous or even they might ask someone who is in the know and write the name down on a bit of paper and then go to their plumbing supply shop and realise they have left that bit of paper at home and then ask themselves, "It starts with 'I' and it ends with 'ball', what is it? Ah, yes, I-BALL that must be it. That is what it is."

27. I do not agree with this approach, which seems to me to be resonant of the 'moron in a hurry' rather than the reasonably well informed and reasonably observant and circumspect average consumer. As said earlier, there will be some attention paid to the purchase of the goods, even the cheaper ones. This tends to mitigate the effects of imperfect recollection.

28. But is imperfect recollection even likely? A factor which I should consider is the 'beginnings of marks' rule of thumb, which allows for the propensity of the average consumer to notice, particularly, the beginnings of marks because that is what is seen or heard first¹¹. It is a rule of thumb, and it does not always apply, such as when the beginning is meaningful or common in trade but, in this case, it does apply. INTA is completely different to I- visually, aurally and conceptually. Similarity is particularly low aurally, which is important when use by plumbing and heating engineers may entail telephoning for a part or calling into a plumber's merchant to ask for a part.

29. The assessment includes the principle of interdependency, whereby a lesser degree of similarity between the goods/services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). Even assuming that all the goods are identical, the significant differences in the marks mean that there will not be a likelihood of confusion¹². This is also the case in relation to ball valves, where the use of the earlier mark has enhanced its distinctive character. Ball will be seen as a reference to ball valves and, overall, the marks are simply too different to cause confusion. I do not even think that one will bring to mind the other. Drawing together the various aspects of the assessment, there is no likelihood of confusion. **The opposition under section 5(2)(b) of the Act fails.**

Section 5(3) of the Act

30. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

31. The conditions required for a successful opposition under section 5(3) are cumulative¹³: there must be sufficient reputation, there must be a link made between

¹¹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

¹² *MedaPharma GmbH & Co KG v OHIM*, Joined cases T492/09 and T-147/10; it is not an automatic sequitur that identity of goods/services will lead to a likelihood of confusion where the similarities between the marks are very limited.

¹³ *Intel Corporation Inc v CPM United Kingdom Ltd* [2009] RPC 15.

the marks; and one of the three heads of damage must succeed. Even if I was to find that the opponent has the requisite level of reputation, and it would not be a vast reputation on the evidence, I do not think that a link would be made, which includes a calling to mind of the opponent's mark, for the reasons given above. Without a link, there can be no damage. **The opposition under section 5(3) of the Act fails.**

Section 5(4)(a) of the Act

32. Section 5(4)(a) states:

"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, or
- (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."

33. Given my findings under section 5(2)(b) of the Act, the opponent is in no better position under this section. In *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5, Court of Appeal, Jacob LJ said:

"16 The next point of passing off law to consider is misrepresentation. Sometimes a distinction is drawn between "mere confusion" which is not enough, and "deception," which is. I described the difference as "elusive" in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40. I said this, [111]:

"Once the position strays into misleading a substantial number of people (going from 'I wonder if there is a connection' to 'I assume there is a connection') there will be passing off, whether the use is as a business name or a trade mark on goods."

17 This of course is a question of degree—there will be some mere wonderers and some assumers—there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former.

18 The current (2005) edition of *Kerly* contains a discussion of the distinction at paras 15–043 to 15–045. It is suggested that:

"The real distinction between mere confusion and deception lies in their causative effects. Mere confusion has no causative effect (other than to confuse lawyers and their clients) whereas, if in answer to the question:

'what moves the public to buy?', the insignia complained of is identified, then it is a case of deception."

19 Although correct as far as it goes, I do not endorse that as a complete statement of the position. Clearly if the public are induced to buy by mistaking the insignia of B for that which they know to be that of A, there is deception. But there are other cases too—for instance those in the Buttercup case. A more complete test would be whether what is said to be deception rather than mere confusion is really likely to be damaging to the claimant's goodwill or divert trade from him. I emphasise the word "really."

34. The requirement for deception amongst a substantial number of persons for passing off purposes is similar to the average consumer test under trade mark law. I note that in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number" of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be partly qualitative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. However, for the avoidance of doubt, I confirm that I have applied the appropriate test for misrepresentation in coming to my decision as to whether use of the applicant's mark applicant's use would amount to a misrepresentation to the public.

35. The differences between the applicant's mark and the opponent's sign INTABALL, in which it has a good level of goodwill, are too great. Even in the case of an unusually careless customer, it is difficult to see how he will be misled into purchasing the applicant's goods in the belief that they are the opponent's goods. In any event, there is not likely to be a substantial number of such unusually careless customers. Therefore, for the same reasons that I found that there was no likelihood of confusion under s.5(2)(b), I find that there is no likelihood of misrepresentation under s.5(4)(a). **The opposition under section 5(4)(a) of the Act fails.**

Section 3(1)(b) of the Act

36. Section 3(1)(b) states:

"3.—(1) The following shall not be registered—

(a) ...

(b) trade marks which are devoid of any distinctive character".

37. Section 1(1) of the Act provides that a trade mark may "in particular, consist of words (including personal names), designs, letters, numerals or the shape of the goods or their packaging" provided that the trade mark "is capable of distinguishing

goods or services of one undertaking from those of other undertakings” (my emphasis).

38. The opponent framed its objection under section 3(1)(b) in its notice of opposition and statement of case like this:

“It is believed that the Applicant wishes to have protection for the mark I-BALL in relation to in particular BALL VALVES being goods in Class 11. It is maintained that I-BALL is devoid of distinctive character in relation to ball valves as the BALL element relates to BALL VALVES and the only other element which can provide distinctiveness is the letter I, therefore as a whole the mark I-BALL lacks distinctive character in relation to BALL VALVES.”

39. The claim is therefore predicated on the basis that the mark is objectionable because BALL is descriptive for ball valves and the letter ‘I’ cannot save it, being only the letter I. That claim is wrong in law. Single letters can constitute registrable trade marks provided they are capable of distinguishing undertakings’ goods and services. Letter marks must be assessed for distinctive character in relation to the goods/services in question, as with other types of marks. The CJEU, in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co. KG* – C-265/09 P (concerning the letter a/alpha) said:

“43 Not only is it clear from Article 4 of Regulation No 40/94 that Community trade marks may consist of letters, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings (E, paragraph 38; to that effect, see also Case T-441/05 IVG Immobilien v OHIM (I) [2007] ECR II-1937, paragraph 47), registration of a sign as a trade mark is not conditional upon a finding of a specific level of creativity or artistic imaginativeness on the part of the applicant for the trade mark (Case C-329/02 P SAT.1 v OHIM [2004] ECR I-8317, paragraph 41), but only upon the ability of the sign to distinguish the goods of the applicant from goods offered by competitors (Case T-79/00 Rewe-Zentral v OHIM (LITE) [2002] ECR II-705, paragraph 30). As it is, however, the Board of Appeal did not carry out an examination, based on the facts, of the sign at issue in that regard.

...

45 The refusal, as a matter of definition, to accept that single letters can have any distinctive character, stated without reservation and without undertaking the examination based on the facts, mentioned in paragraph 39 above, is contrary to the wording of Article 4 of Regulation No 40/94, which ranks letters as being among the signs, capable of being represented graphically, of which a mark may consist, provided that such signs are capable of distinguishing the goods and services of one undertaking from those of other undertakings.

46 Furthermore, it is apparent from the case-law that Article 7(1)(b) of Regulation No 40/94 draws no distinction between the different categories of trade mark and that the criteria for assessment of the distinctive character of

trade marks which consist of a single letter are the same as those applicable to the other categories of trade mark (E, paragraph 34).

47 In order to have the minimum degree of distinctiveness required under that provision, the mark concerned must simply appear prima facie capable of enabling the relevant public to identify the origin of the goods or services covered by the Community trade mark application and to distinguish them, without any possibility of confusion, from those of a different origin (I, paragraph 55).”

40. In an earlier case before the GC, *IVG Immobilien AG v OHIM*, Case T-441/05, which is apposite because it concerned the single capital letter I (for financial, property, construction and transport services), the court said:

“41. The distinctive character of a trade mark required by Article 7(1)(b) of Regulation No 40/94 must be assessed by reference, first, to the goods or services in respect of which registration is sought and, second, to the perception of the relevant persons, namely the consumers of the goods or services (see, with regard to Article 3(1)(b) of Directive 89/104, the normative content of which is essentially identical to that of Article 7(1)(b) of Regulation No 40/94, Case C-218/01 Henkel [2004] ECR I-1725, paragraph 50).

42. It was therefore appropriate in the present case to examine, in the context of a specific examination of the potential capacity of the sign proposed for registration, whether there appeared to be no possibility that that sign may be capable of distinguishing, in the eyes of the public to which it is addressed, the goods or services referred to from those of a different origin (EASYBANK, paragraph 17 above, paragraph 40), since a minimum degree of distinctiveness is sufficient to prevent application of the absolute ground for refusal provided for in Article 7(1)(b) of Regulation No 40/94 (Torch shape, paragraph 17 above, paragraph 34).

52. By deducing, from the absence of notable specific graphic features in comparison to a standard character font, that the claimed mark lacked distinctiveness the Board of Appeal thus incorrectly applied Article 4 and Article 7(1)(b) of Regulation No 40/94.

...

60. The Board of Appeal was therefore incorrect to base its refusal to register the claimed mark on its lack of notable specific graphic features and significance without first examining, by taking into consideration all the relevant factors relating to the specific facts of the case, whether that sign was in fact capable of distinguishing, in the minds of the target public, the services supplied by the trade mark applicant from those of its competitors.”

41. It is therefore wrong simply to deny registration on the basis that the mark consists of (or contains in this case) a single letter without examining whether that single letter is capable of distinguishing the goods or services. The opponent’s section 3(1)(b) case, as pleaded, must therefore fail.

42. When Mr Taylor filed his skeleton argument, he said this:

“...if it is found the element BALL is descriptive of a key element of the goods of the opposed application, i.e. lever ball valves which are also sometimes called ball valves then, the only element in which distinctiveness can be shown is the letter “I”, and we maintain that the mark as a whole is devoid of distinctive character. The letter “I” and the numeral 1 are so similar it would appear to provide protection for “1 BALL” valve. It should also be noted that the letter “I” is generic for the internet (see Chapter 3 Work Manual, Addendum page 26 of 56). On this basis the mark of the application is descriptive of internet controlled ball valves. We understand that control of ones heating remotely via means of mobile telephones and the internet is a present [sic] offered practice and therefore the mark is devoid of distinctive character for the goods of the application.”

43. These further two objections had not been foreshadowed at any point until the skeleton argument. No request was made to amend the pleadings. No evidence was filed to back up the claims. At the hearing, Mr Taylor brought up another claim which had not been hitherto aired; that the letter I could be a reference number. However, for the sake of completeness, I will examine whether there is any substance to the belated arguments. In line with the above authorities regarding single letters, I must assess what role the letter I plays in the mark in combination with the hyphen and the word BALL. The mark must be perceived as a whole, which is how the average consumer, who is reasonably well informed and reasonably observant and circumspect, will see it.

44. In *Combi Steam Trade Mark*¹⁴, Ms Anna Carboni, sitting as the Appointed Person, described that examination in the following way:

“7. It has been said that lack of distinctive character is the essence of any objection under section 3(1)(b), (c) or (d) of the Act and that, despite its position in the list, section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other two provisions, which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd’s Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): *Case C-363/99 Koninklijke KPN Nederland BV v Benelux-Merkenbureau* (POSTKANTOOR) [2004] ETMR 57 (ECJ) at [86]. However, the converse is not true: a mark which is not descriptive may nevertheless be devoid of distinctive character for other reasons (ibid.).

8. When a trade marks examiner assesses the distinctiveness of a trade mark within the meaning of section 3(1)(b), s/he must do so firstly by reference to the goods or services listed in the specification, and secondly by reference to the perception of the mark in relation to such goods or services by the relevant public, which consists of average consumers of the goods or services

¹⁴ BL O/363/09.

in question, who are deemed to be reasonably well informed, observant and circumspect: *Joined Cases C-53/01 to C- 55/01 Linde AG, Winward Industries Inc and Radio Uhren AG* [2003] ETMR 78 at [41].

9. It is not necessary to show that a mark has a particular level of creativity or originality in order to establish distinctive character: *Case C-329/02P SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 (ECJ) at [41]. While the Court of First Instance (“CFI”) has repeatedly referred to “a minimum degree of distinctive character” as being sufficient to avoid article 7(1)(b) of the CTMR/article 3(1)(b) of the Directive (for example, *Case T-34/00 Eurocool Logistik GmbH & Co. KG v OHIM* (“EUROCOOL”) [2003] ETMR 4 at [39]; *Case T-128/01 Daimler Chrysler Corp v OHIM* [2003] ETMR 87 at [33]; *Case T-320/03 Citicorp v OHIM* (“LIVE RICHLI”) at [68]), the ECJ has not adopted this wording and has deemed it unnecessary to give any more precise definition to the possible dividing line between lack of distinctiveness and the minimum distinctiveness to which the CFI refers: *Deutsche Krankenversicherung AG v OHIM* (“COMPANYLINE”) [2002] ECR I-7561 at [20].

10. The ECJ approaches the issue of distinctiveness by reference to the underlying purpose of article 3(1)(b) of the Directive/7(1)(b) CTMR, which in the Court’s view is to preclude registration of trade marks that are incapable of performing the essential function of guaranteeing the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin: *SAT.1 v OHIM* at [23]; *Case C-37/03 P BioID AG v OHIM* [2005] ECR I-7975 (ECJ) at [27].”

45. The opponent claims that the letter I means internet and refers to the Registry’s examination practice guide, the relevant part of which is reproduced here:

“I or i

The Letter “i” is a generic abbreviation of Internet, for example, i-music and i-magazine. In addition, the letter “i” is also an abbreviation for “interactive”.

An application for a word which describes the goods or services applied for and is prefixed with “i” may be objectionable under section 3(1)(b) and (c) of the Act and in some cases 3(1)(d) may be appropriate. When considering an application, the context of the mark and the specification is important. Much will depend on whether this is the usual way of referring to the goods or the services. The Internet will be searched where necessary, but it should be remembered that the fact a term is not already in descriptive use does not preclude an objection under section 3(1)(c) if the likelihood of normal descriptive use of the term is foreseeable at the date of application.”

46. Firstly, the opponent has provided no evidence to support its argument that heating can be controlled via the telephone and the internet. There is no evidence to suggest that the term is in use, which leaves me to assess whether such use is

foreseeable. I note that in *SAT.1 v OHIM*, the court stressed the importance of the mark as a whole:

“28. Finally, as regards a trade mark comprising words or a word and a digit, such as that which forms the subject-matter of the dispute, the distinctiveness of each of those terms or elements, taken separately, may be assessed, in part, but must, in any event, depend on an appraisal of the whole which they comprise. Indeed, the mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present a distinctive character (see, by analogy, Case C-265/00 *Campina Melkunie* [2004] ECR I-0000, paragraphs 40 and 41, and C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-0000, paragraphs 99 and 100).

...

35. It is clear from paragraphs 31 to 34 of the present judgment that the Court of First Instance assessed whether the term ‘SAT.2’ had a distinctive character essentially by means of a separate analysis of each of its elements. To that end, it based itself on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such a character instead of, as it should have done, on the overall perception of that word by the average consumer. It examined the impression as a whole produced by the term only secondarily, refusing to give any relevance to aspects such as the existence of an element of imaginativeness, which ought to be taken into account in such an analysis.”

47. In my view, even if heating can be controlled by the internet, it does not seem to me that I-BALL, as a combination, describes that function; nor does it seem to me to be a natural descriptor for a valve which is internet controlled, if such a thing could exist. The mark is not I-VALVE. This all seems to be crystal ball gazing without any firm foundation.

48. The opponent’s claim that I is close to 1 and so the mark could be seen as 1-BALL brings me back to the ‘moron in a hurry’ point made in the context of imperfect recollection. It is too far-fetched a basis on which to refuse I-BALL. That the letter I could be a reference ‘number’ also seems unlikely to me for these sorts of goods; but, even if it were, the combination of I-BALL does not look like a reference to a part. One would expect more than a single letter. Again, there is no evidence to support the point.

49. I do not say that single letters are strongly or even averagely distinctive¹⁵. However, the opponent has not identified any basis on which the mark is objectionable under section 3(1)(b) (or 3(1)(c), which some of its late arguments seemed to touch). The law does not differentiate between categories of trade mark. The criteria for assessment of the distinctive character of trade marks which consist of a single letter are the same as those applicable to the other categories of trade

¹⁵ See, to that effect, BL O/085/14 *Kunze Folien GmbH v Kartell UK Limited* (Iain Purvis QC, sitting as the Appointed Person).

mark (*Borco*). Further, it is the mark as a whole which must be assessed. **The opposition under section 3(1)(b) of the Act fails.**

Outcome

50. The opposition has failed on all four grounds. The application is to be registered.

Costs

51. The applicant has been successful and is entitled to a contribution towards its costs. Mr Sales asked for consideration to be given to the extra work caused by the opponent's attempt to introduce late evidence and that the 5(3) and 5(4)(a) grounds were not dropped until the hearing, in relation to INTABALL COMBI. The latter point would not have caused a great deal more effort than the same grounds for INTABALL solus. I will not award anything for that point. However, I will make an award for the late request to file evidence. I assess costs, according to the published scale in Tribunal Practice Notice 4/2007, to be:

Considering the opposition and preparing a counterstatement	£300
Consideration of opponent's evidence and attending a hearing	£800
Late request to file evidence	£200
Total	£1300

52. I order Altecnic Limited to pay Intaco Limited the sum of £1300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of June 2014

**Judi Pike
For the Registrar,
the Comptroller-General**