

O/495/20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003381279
BY SPECIALIST BUILDING PRODUCTS LIMITED
TO REGISTER:**

OPTIMA BY PROFILE 22

Optima by Profile 22

(SERIES OF 2)

AS A TRADE MARK IN CLASS 19

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 417261 BY
UNLIMITED PERSPECTIVE SA**

BACKGROUND AND PLEADINGS

1. On 7 March 2019, Specialist Building Products Limited (“the applicant”) applied to register the series of trade marks shown on the cover of this decision in the UK (“the application”). The application was published for opposition purposes on 10 May 2019. The applicant seeks registration for the following goods:

Class 19: Building and construction materials and elements, not of metal; Building Structures, not of metal; Doors, windows and window coverings, not of metal; plastic window and door frames; Conservatories, not of metal; Conservatory frames, not of metal; Glass walls; Frames for glass walls, not of metal; cladding materials, not of metal; Fascias, not of metal; Soffits, not of metal; parts and fittings for any or all of the aforesaid goods.

2. On 8 August 2019, the application was opposed by Unlimited Perspective SA (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark:

OPTIMAH!

UK registration no. 3119826

Filing date 28 July 2015; registration date 14 October 2016

Relying on all goods and services namely:

Class 6: Metal building materials, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods included in this class; door knobs and locks; none of the aforementioned goods being for use in offices.

Class 19: Building materials, non-metallic, namely windows, doors, skylights, blinds, shutters, fittings and components for these

goods not included in other classes; façade claddings; none of the aforementioned goods being for use in offices.

Class 37: Building construction; building repair services; installation and repair of windows, doors, skylights, blinds, shutters, fittings and components for these goods; none of the aforementioned services being provided in offices.

("the opponent's mark")

3. In its notice of opposition, the opponent submits that as a result of the strong similarities between the marks and the identity and similarity of the goods and services, there exists a likelihood of confusion on the part of the public.
4. The applicant filed a counterstatement denying the claims made.
5. The opponent is represented by Boulton Wade Tennant LLP and the applicant is represented by Appleyard Lees IP LLP. Both parties have filed evidence in chief and the opponent has filed evidence in reply. No hearing was requested. Both parties have filed submissions in lieu of a hearing. I have taken these into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

EVIDENCE

6. Both parties filed evidence in the form of witness statements. The opponent filed the witness statement of Mr Diogo Oliveira Almeida Alves de Matos dated 5 December 2019, which is accompanied by 6 exhibits. The applicant filed the witness statement of Martin Althorpe dated 24 February 2020, which is accompanied by 13 exhibits. The opponent filed evidence in reply by way of the witness statement of Emily Frances Deniece Scott dated 15 April 2020, which is accompanied by 1 exhibit. I have read the statements in their entirety and have summarised the most pertinent points below.

The opponent's evidence

The witness statement of Mr Diogo Oliveira Almeida Alves de Matos

7. Mr de Matos is the Director-General of the opponent. Mr de Matos gave a witness statement in previous proceedings between the applicant and the opponent and attached a copy of his previous statement to his present statement.¹ His previous statement stated that it was his professional opinion that doors, windows and conservatories, and parts for doors, windows and conservatories are sold alongside each other. To demonstrate this, he exhibited a printout from a website known as www.profine-group.com wherein various products, including “PVC-U profiles for windows and doors” are discussed. Mr de Matos sets out that there have been no substantial changes in the market situation since the date of his initial statement.
8. The evidence introduces further examples of print outs from various websites that all show different items as available for sale. Firstly, I note that a printout from www.wickes.co.uk² shows items such as conservatories, windows, doors, timber cement and cladding as goods that they sell. The printout from www.diy.com³ shows items such as timber, cement and bricks together with items such as PVC windows and doors. Finally, the printouts from www.hazelmere.co.uk⁴ and www.vivaldi-conservatories.co.uk⁵ both show conservatories, orangeries and doors together as goods that both companies’ specialise in. Save for the Wickes print out (which is undated), all of these print outs are dated 13 March 2019, being after the relevant date.
9. Mr de Matos refers to previous proceedings between the parties that were dealt with by this Office on 15 May 2018 by way of decision number O-294-18 (“the previous proceedings”) and has exhibited a copy of the decision of this office in

¹ Exhibit DAM1

² Exhibit DAM2

³ Exhibit DAM3

⁴ Exhibit DAM4

⁵ Exhibit DAM5

those proceedings.⁶ I note that the application and specification in the previous proceedings differ from those in the present proceedings.

The applicant's evidence

The witness statement of Martin Althorpe

10. Mr Althorpe is the Technical Director of the applicant. The applicant was incorporated on 14 July 1976 and is a wholly owned subsidiary of the Epwin Group PLC. Mr Althorpe explains that 'PROFILE 22' is the trading name of the applicant and that it has been in use as a trade mark since 1988. Print outs of various UK Trade Mark Registrations for the mark 'PROFILE 22' in differing classes, being class 6, 19 and 37 are also provided.⁷ I note that the earliest filing date for the three marks was 17 December 1991. These trade marks are owned by Epwin Property Holdings Limited, which Mr Althorpe explains is also a wholly owned subsidiary of the Epwin Group PLC. The applicant is authorised to use the 'PROFILE 22' marks by Epwin Property Holdings Limited.

11. Mr Althorpe goes on to refer to two trade mark searches that were conducted on the UK's Intellectual Property Office website. The first search was for live trade marks similar to the words 'OPTIMA BY PROFILE 22' in classes 9, 19 and 37 and the results show only marks belonging to the applicant.⁸ The second search was for live marks which were similar to the word 'OPTIMA' in classes 9, 19, and 37 which resulted in 113 matches.⁹ Details of a trade mark that was filed on 5 October 2007 for the word 'OPTIMA' in Classes 6, 19, 20 and 37 that is held by Optima Contracting Limited is also discussed.¹⁰ Mr Althorpe states that Optima Contracting Limited have confirmed that they believe the application to be sufficiently different to their mark and are happy for these marks to co-exist on the register and in commerce.

⁶ Exhibit DAM6

⁷ Exhibit MA2

⁸ Exhibit MA3

⁹ Exhibit MA4

¹⁰ Exhibit MA5

12. A number of examination reports are then discussed. The first one being an examination report dated 29 November 2016 in relation to the trade mark 'OPTIMA' in Class 19 (under UK application no. 3198271).¹¹ The second is an examination report dated 12 March 2019 relating to the application.¹²

13. The meaning of the word 'Optima' is also discussed and two print outs from Collins Online Dictionary are attached.¹³ These confirm that (1) optima is the plural for optimum and (2) optimum means 'a condition, degree, amount of compromise that produces the best possible result' or 'most favourable or advantageous'. Staying with the meaning of words, Mr Althorpe proceeds to explain a number of Google searches undertaken in respect of the words 'Optimah'¹⁴, 'Optima'¹⁵ and 'Optima by Profile 22'¹⁶. In respect of these searches, I note the following:

- a. The results for the definition 'Optimah' returned results for the word 'Optima' and suggested that the user meant 'Optima';
- b. The results for the search of 'Optima' were to various websites unrelated to the parties;
- c. The results for 'Optima by Profile 22' mostly direct the user to profile22.co.uk but I do note that there is also a result for glassnews.co.uk, which does relate to the applicant; and
- d. The searches are dated 23 and 24 January 2020 and are, therefore, dated after the relevant date.

14. Finally, Mr Althorpe produces two separate print outs from the opponent's website.¹⁷ Both print outs are dated 23 January 2020 and are, therefore, dated after the relevant date.

¹¹ Exhibit MA6

¹² Exhibit MA7

¹³ Exhibit MA8

¹⁴ Exhibit MA9

¹⁵ Exhibit MA10

¹⁶ Exhibit MA11

¹⁷ Exhibits MA12 and MA13

Opponent's evidence in reply

The witness statement of Emily Frances Deniece Scott

15. Ms Scott is a Chartered Trade Mark Attorney of the representative of the opponent. Ms Scott undertook a trade mark search on the UK Intellectual Property Office's website on 8 April 2020 for marks that are similar to 'OPTIMAH' in classes 6, 19 and 37. A print out of the results is included within Ms Scott's statement.¹⁸ The application is listed on page 19 of the search results.

PRELIMINARY ISSUES

16. I note that in the parties' evidence, there were various searches undertaken of the register for marks similar to 'Optima', 'Optima by Profile 22' and 'Optimah'. The applicant also referred to these in its written submissions. For reasons that I will now explain, these search results have no bearing on the outcome of this opposition.

17. I note that in the case of *Zero Industry Srl v OHIM, Case T-400/06*, the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865,

¹⁸ Exhibit ES1

paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71). “

18. The fact that there are a multitude of trade marks that contain the word ‘Optima’ with class 6, 19, 20 or 37 protection is not a relevant factor to the distinctiveness of the opponent’s mark. The applicant has filed no evidence to demonstrate that any of these marks are actually in use in the marketplace and this evidence does not, therefore, assist the applicant. I also do not consider the fact that the application appears in a search of the Register for marks similar to “Optimah” to assist the opponent; the assessment that I must undertake is based on the perception of the average consumer. The outcome of this opposition will be determined after making a global assessment whilst taking into account all relevant factors and the state of the register is not relevant to that assessment.

19. I also note that reference has been made to Google search results which, in some cases, return results relating to the parties and, in other cases, do not. The similarity of trade marks in these proceedings can only be determined after making a global assessment whilst taking into account all relevant factors. The fact that Google search results returned results that showed both parties marks (or where they did not) is not relevant to that assessment.

20. I also note that the applicant has submitted evidence that explains that a third party with the trade mark ‘Optima’ is happy for its mark and the application to co-exist on the register and in commerce. The applicant has also referred to this in its written submissions. While this may be the case, an agreement with a third party has no bearing on the outcome of this decision.

21. The applicant has also submitted evidence in respect of two examination reports conducted by this office. One dated 29 November 2016 in respect of the mark ‘OPTIMA’ which is owned by Spectus Systems Limited and the other is dated 12 March 2019 in respect of the application, which is owned by the applicant. The first report includes the opponent’s mark as a trade mark that the examiner has considered similar, whereas the second report does not. The applicant has given no explanation for the inclusion of these reports in its evidence. However, the initial

search undertaken by a UK Trade Mark Examiner is not an exhaustive search of the register for potentially similar marks. Further, opposition proceedings are not exclusively reserved for those parties identified by this office as having potentially similar marks to the applied for mark. The guidance provided by this office in relation to earlier rights, at paragraph 9, states:

“Any third party can object to your trade mark, including those not notified. Please note, if you receive a notice of threatened opposition the onus is on you to contact the earlier right holder to try and negotiate or reach an agreement before the end of the opposition period.”¹⁹

22. The applicant was informed of this within the report dated 13 May 2019, which states:

“If you proceed, your application will be published in the online Trade Marks Journal and anyone can oppose your designation should they have grounds to do so.”

23. It is within any party’s rights to oppose an application and it is not detrimental to an opponent’s case if the UK Trade Mark Examiner did not identify them within their initial search. Ultimately, the matter before me depends upon a global assessment taking into account all relevant factors and the applicant’s evidence regarding the notification process is not relevant to that assessment.

24. In its evidence and written submissions, the opponent has referred to the previous proceedings. The opponent notes that the decision in the previous proceedings found in favour of the opponent. I note that the parties in the previous proceedings are the same as the parties to these proceedings. However, the disputed mark in the previous proceedings and the application are different. The decision in the previous proceedings is, therefore, not relevant to this decision and this case must be decided on its merits.

¹⁹ <https://www.gov.uk/government/publications/trade-marks-earlier-rights/earlier-rights-fact-sheet--2>

25. I note that in the applicant's submissions, it refers to the witness statement of Martin Althorpe wherein he discussed the types of goods that are manufactured under the application. The applicant submits that:

"As per the Witness Statement of Martin Althorpe dated 24 February 2020 at point 6, the Applicant confirms that "The specific goods which SBP manufacture and sell under the "Optima by Profile 22" brand are extruded plastic profiles, being parts for assembly into external doors, windows and conservatories. These goods are generally sold through business-to-business channels. These businesses would typically be window manufacturers and/or window installers who sell finished window articles to customers. It would be rare to come across SBP's Optima by Profile 22 goods being sold to the general public in high street stores such as Wickes, B&Q etc."

As such, the evidence filed on behalf of the Opponent (particularly Exhibits DAM1, DAM2 and DAM3) seems almost irrelevant as the Applicant has clearly acknowledged that their goods are not manufactured and sold to the public at large. It is therefore unlikely the respective goods would be sold side-by-side thus avoiding any possible risk of confusion.

Whilst the list of goods covered in Class 19 by the Applicant are slightly broader than "extruded plastic profiles, being parts for assembly into external doors, windows and conservatories", the Applicant felt that because of the significant differences between the respective marks and the specific trade channels their goods would be sold through, there would be no likelihood of confusion on the part of the relevant consumer."

26. While I note the applicant's submissions, the assessment that I must make is based upon a notional assessment of the use that might be made of the marks based upon their specifications. The specific way in which the parties have been using the marks or intend to use the marks is not relevant to that assessment.

27. The applicant has also made submissions in respect of the reputation of its 'PROFILE 22' mark, which it has used since 1988. The applicant has stated that

the reputation of 'PROFILE 22' will have an impact on how the average consumer will perceive the mark as a whole. However, the applicant has filed no evidence to support its claim to have used the mark and I see no reason to conclude that the use made of it should impact upon the average consumer's perception of it. Further and for the avoidance of doubt, the fact that the applicant claims to have used 'PROFILE 22' prior to the opponent's mark being applied for/registered, is not a defence in law to the opposition under section 5 of the Act.²⁰

DECISION

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

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

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

(a) ...

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

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

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

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

²⁰ Tribunal Practice Notice 4/2009

30. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

31. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. As the opponent’s mark had not completed its registration process more than 5 years before the date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services for which its mark is registered.

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

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

- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

33. The competing goods and services are set out as follows:

| The opponent's goods and services | The applicant's goods |
|--|--|
| <p><u>Class 6</u> Metal building materials, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods included in this class; door knobs and locks; none of the aforementioned goods being for use in offices.</p> <p><u>Class 19</u> Building materials, non-metallic, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods not included in other classes; façade claddings; none of the aforementioned goods being for use in offices.</p> <p><u>Class 37</u> Building construction; building repair services; installation and repair of</p> | <p><u>Class 19</u> Building and construction materials and elements, not of metal; Building Structures, not of metal; Doors, windows and window coverings, not of metal; plastic window and door frames; Conservatories, not of metal; Conservatory frames, not of metal; Glass walls; Frames for glass walls, not of metal; cladding materials, not of metal; Fascias, not of metal; Soffits, not of metal; parts and fittings for any or all of the aforesaid goods.</p> |

| | |
|--|--|
| windows, doors, skylights, blinds, shutters, fittings and components for these goods; none of the aforementioned services being provided in offices. | |
|--|--|

34. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

35. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

36. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

37. I have detailed submissions from both parties in respect of the comparison of goods and services that I do not intend to reproduce in full here but will refer to them below where necessary.

38. “Building construction materials and elements, not of metal” in the applicant’s specification is a broad term that can cover all types of non-metallic building materials such as bricks, concrete, sand and timber. “Building materials, non-metallic, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods not included in other classes [...] none of the aforementioned goods being for use in offices” in the opponent’s specification is limited in that it only covers the named goods within the term. I do not consider that the named goods within the opponent’s term are considered construction materials. However, these goods will overlap in user in that they will be used by tradespersons. They will also overlap in purpose in that all goods’ will be used for building and construction. These goods will differ in nature and method of use. I note that the opponent’s evidence shows an overlap in distribution channels

between these goods through general DIY stores.²¹ I also note that this evidence is either undated or dated after the relevant date. However, I consider it likely that there will be some overlap in distribution channels as all of these goods are ones that you would expect to find in general DIY stores. Therefore, I find that these goods are similar to a medium degree.

39. Save for any submissions to the contrary, I find that “building structures, not of metal” in the applicant’s specification describes non-metallic goods such as the internal frames of a building, other forms of load bearing structures or prefabricated modular buildings. These goods do not have any counterpart in the opponent’s specification. They will, however, overlap in user and purpose with “building materials, non-metallic, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods not included in other classes [...] none of the aforementioned goods being for use in offices” in the opponent’s specification in that they will be used by tradespersons for the purpose of building and construction. Although I have found an overlap in trade channels for the goods referred to in the paragraph above, I consider these goods in the applicant’s specification to be more specialist in nature and, in the absence of any evidence to assist me, I do not consider it likely that they will be available from general DIY stores. Given that there is only a limited overlap in user and purpose, these goods will be similar to a low degree.

40. “Doors, windows and window coverings, not of metal” and “plastic window and door frames” in the applicant’s specification, insofar as they are not for use in an office, will fall within the category of “building materials, non-metallic, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods not included in other classes [...] none of the aforementioned goods being for use in offices” in the opponent’s specification. These goods will therefore be identical under the principle outlined in *Meric*. However, where the applicant’s term covers goods used in an office, these goods will not be identical but will overlap in user, method of use, purpose and nature. They will also overlap in trade channels as an

²¹ Exhibits DAM2 and DAM3

undertaking who produces these goods for offices will also produce them for other buildings. These goods will be similar to a high degree.

41. A conservatory is a room with glass walls and a glass roof, which is attached to a house.²² “Conservatories, not of metal” and “conservatory frames, not of metal” in the applicant’s specification do not have a counterpart in the opponent’s specification. These goods will, however, overlap in user and nature with “building materials, non-metallic, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods not included in other classes [...] none of the aforementioned goods being for use in offices” in the opponent’s specification. Given that the goods are listed in class 19, being materials for building and construction, the user will be a member of the general public or a tradesperson and it is common for an installer of windows, doors and skylights to also install conservatories. I also note that the opponent’s evidence contains printouts²³ that shows conservatories together with windows, doors, extensions and orangeries. While the evidence is either undated or dated after the relevant date, I consider it likely that there will be some overlap in distribution channels as all of these goods are ones that you would expect to find in general DIY stores. These goods will therefore be similar to a medium degree.

42. “Glass walls” and “frames for glass walls, not of metal” in the applicant’s specification will overlap in user and purpose with “building materials, non-metallic, namely windows, [...] fittings and components for these goods not included in other classes [...] none of the aforementioned goods being for use in offices.” in the opponent’s specification as both are fitted to allow light into a room and will be used by tradespeople during the construction process. There may be a degree of overlap in trade channels. There may also be a degree of competition between these goods as the average consumer may select either traditional windows or a glass wall when designing a building or extension. These goods will therefore be similar to between a medium and high degree.

²² <https://www.collinsdictionary.com/dictionary/english/conservatory>

²³ Exhibits DAM2 to DAM5

43. “Cladding materials, not of metal” in the applicant’s specification describe the material that is applied to the outer layer of a building. “Façade claddings” in the opponent’s specification falls within this broader category. These goods will, therefore, be identical on the principle outlined in *Meric*.

44. When used in terms of construction, a fascia is the term for a vertical band that is placed under the edge of a roof. A soffit is the horizontal panel that runs from the bottom of the fascia towards the building itself. I do not, therefore, consider that “fascias, not of metal” or “soffits, not of metal” to have any counterpart in the opponent’s specification. However, there will be an overlap in user and purpose with “building materials, non-metallic, namely windows, doors, skylights, blinds, shutters, fittings and components for these goods not included in other classes [...] none of the aforementioned goods being for use in offices” in the opponent’s specification in that these goods will be used by tradespeople for construction and building purposes. Further, these goods may also be made of PVCu, as will windows and doors. As a result, there may be an overlap in trade channels in that an undertaking which produces windows and doors may also produce fascias and soffits. Therefore, I consider these goods will be similar to a medium degree.

45. That leaves “parts and fittings for any or all of the aforesaid goods” in the applicant’s specification. The same undertakings are likely to sell the goods themselves and their parts and fittings. Further, they will overlap in purpose and user to the same extent as the goods to which they relate. Overall, I consider that the same findings I have made above in relation to the goods themselves will also apply in relation to their parts and fittings.

The average consumer and the nature of the purchasing act

46. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox*

Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

47. Given my findings above, the relevant average consumer is the consumer of the goods in class 19. I note that the opponent submits:

“the goods at issues [...] target both the general public and a specialised public. [...] They include mass consumption goods such as doors and conservatories, which are sold to the general public, often in high street stores and/or via outlets aimed at the general public.”

48. I agree with the opponent’s submissions. Therefore, I find that the average consumer for these goods will be a member of the general public or a tradesperson such as a window fitter, door fitter or builder.

49. Goods such as windows and doors may be purchased from bricks-and-mortar shops or builder’s merchants. Goods such as building structures will be purchased from specialist builder’s merchants. The goods may also be purchased through catalogues or online. These purchases will involve primarily visual considerations. However, I also consider that there may be an aural element to the selection of the goods in the form of advice from sales representatives or telephone orders.

50. For tradespeople, the purchase of these goods may be frequent. However, for members of the general public, the purchase of these goods will be infrequent. The goods are likely to vary greatly in price. The average consumer is likely to consider such factors as size, style, quality and durability. The average consumer is,

therefore, likely to pay a medium degree of attention during the selection process. However, I recognise that some of the goods (such as building structures) will attract a higher degree of attention given their importance to larger building projects.

Distinctive character of the opponent's mark

51. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

52. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive

character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

53. The applicant submits that:

“Attached to the Witness Statement of Martin Althorpe dated 24 February 2020 as Exhibits MA12 and MA13 are printouts from the Opponent’s website at www.panoramah.com. These printouts show other trade marks, including **panoramah!** as well as “ah12!”, “ah26!”, “ah38!” and “ah60!” in use on the opponent’s website. There is clearly a pattern with the Opponent’s trade marks, being the use of the “AH!” element. It is therefore submitted that the “AH!” element to the Opponent’s earlier mark is the dominant and more distinctive component to the earlier mark. As such, the relevant consumer will focus more on this part of the earlier mark and will associate that mark with the Opponent.”

54. While I note the applicant’s comments regarding a pattern with the opponent’s trade marks, the other marks are not relied upon in these proceedings and no evidence has been filed to demonstrate use of those marks in the marketplace. I have no submissions from the opponent in respect of its mark’s distinctive character. Further, the opponent has not claimed that its mark has acquired an enhanced distinctive character through use and has filed no evidence in this regard. I therefore only have the inherent position to consider.

55. The opponent’s mark is a stylised representation of the word ‘OPTIMAH!’ The first part, being ‘OPTIM’, is displayed in a black standard typeface and the second part, being ‘AH!’, is presented in a red, bold font with the left upright of the letter ‘H’ being extended slightly higher than the other letters. The opponent states in its notice of opposition that the word ‘OPTIMAH’ is a play on the dictionary word, optima, which is plural for optimum.²⁴ I consider it unlikely that a significant proportion of average consumers will recognise ‘optima’ as the plural for ‘optimum’. However, in any event, I consider that a significant proportion of average consumers would view the word ‘OPTIMAH’ as an invented word associated with the word ‘optimum’. Given

²⁴ <https://www.collinsdictionary.com/dictionary/english/optima>

the meaning of optimum, being ‘the most favourable, desirable or best’,²⁵ the word ‘OPTIMAH’ will be seen as allusive of the quality of the goods. I consider that the word “OPTIMAH” is inherently distinctive to between a low and medium degree. I find that the presentation of the letters ‘AH!’ will contribute to the distinctive character of the mark. Overall, I consider that the opponent’s mark has a medium degree of inherent distinctive character.

Comparison of marks

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


57. 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.”

58. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

59. The respective trade marks are shown below:

²⁵ <https://www.collinsdictionary.com/dictionary/english/optimum>

| Opponent's mark | The application |
|---|---|
|  | OPTIMA BY PROFILE 22 Optima by Profile 22 (Series of 2) |

60. I have detailed submissions from both parties in respect of the comparison of the marks that I do not intend to reproduce in full here but will refer to them below where necessary.

Overall Impression

The application

61. The opponent submits that:

“the primary, distinctive and dominant element of the sign the subject of the Application is the first word OPTIMA / Optima. It is submitted that the BY PROFILE 22 / by Profile 22 element of the sign is secondary in the overall impression created by it. This is supported by established case law, which accepts that, generally, the consumer attaches greater importance to the first part of a mark.”

62. The applicant has submitted that:

“the “OPTIMA” element of the opposed mark is not “the primary, distinctive and dominant element”. As such, all elements to the opposed mark should be treated with at least equal weight, if not extra weight given to the “PROFILE 22” element.”

63. The application consists of a series of two marks, being the words and number ‘OPTIMA BY PROFILE 22’ in the first mark and ‘Optima by Profile 22’ in the second

mark. I consider that the overall impression of the application lies in the combination of these words as a whole.

The opponent's mark

64. The opponent's mark contains the word 'OPTIMAH!' with the first part, being 'OPTIM' displayed in a black standard typeface and the second part, being 'AH!' displayed in a red, bold and slightly stylised font. While the colour, presentation and stylisation towards the end of the mark are noticeable, I consider that the word 'OPTIMAH' itself will play a greater role in the overall impression of the opponent's mark, with the stylisation elements, use of colour and the exclamation mark playing a lesser role.

Visual Comparison

65. Given that the only difference between two marks in the application is the use of upper case and lower-case letters, the same visual comparison I make below will apply to both marks. This is because registration of a mark as a word only mark covers its use in any standard typeface.

66. Visually, the marks coincide in that they share the same first six letters, being the word 'OPTIMA', which lies at the beginning of the marks. The marks differ in that 'H!' is present at the end of the opponent's mark but absent from the application. Further, the application contains further words and numbers, being 'BY PROFILE 22'. There is a stylisation difference in that 'AH!' in the opponent's mark is presented in a bold, red font with slight stylisation to the letter 'H'. The application is in black and white and while this will cover use of the mark in different colours, it does not extend to contrived colour splits, such as putting the first part of a mark in one colour and the rest in another. While I have found the colouring and stylisation elements of the opponent's mark play a lesser role in its overall impression, they will still constitute a visual difference between the marks. As a general rule, average consumers tend to give more focus to the beginning of marks than the

ends.²⁶ Taking all of this into account, I find that the marks are visually similar to between a low and medium degree.

Aural Comparison

67. The applicant has submitted that in the opponent's mark, the consumer will "put emphasis" on the "AH!" element" and that "it would be pronounced (even shouted) "AHHH..." rather than pronounced as a short, sharp single "A" sound." I do not agree that the average consumer, when articulating the opponent's mark, would shout the last syllable due to the presence of the exclamation mark or use of colour on the "AH".

68. Aurally, the opponent's mark will consist of three syllables that will be pronounced 'OP-TIM-AH'. As above, I do not consider that the exclamation mark will alter the average consumer's pronunciation of the mark. The application consists of two marks that will be pronounced identically. They will consist of nine syllables that will be pronounced 'OP-TIM-AH-BY-PRO-FILE-TWEN-TEE-TOO'. The entire aural component of the opponent's mark is identical to the first three syllables of the application. However, the remaining six syllables of the application have no counterpart in the opponent's mark and will, therefore, be dissimilar. I bear in mind that the similarities between the pronunciation of the marks appear at the beginning. Overall, I find that the marks are aurally similar to a medium degree.

Conceptual Comparison

69. Conceptually, 'OPTIMA/OPTIMAH' in each mark will be understood to have a link to the words 'optimal' or 'optimum', which is to mean the most favourable, advantageous or best. This will be considered laudatory. I do not consider that the exclamation point in the opponent's mark will have any conceptual effect on the opponent's mark. These words will be conceptually identical or highly similar.

²⁶ *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02

70. The application also contains the words 'BY PROFILE 22' which will be perceived by the average consumer as indicating that a person or entity named 'PROFILE 22' is responsible for the goods provided under the brand 'OPTIMA'. 'PROFILE 22', will have no obvious meaning to the average consumer but it will be seen as the primary indication of the origin of the goods with the word 'OPTIMA' being seen as the secondary indication of origin.

71. The addition of the words "BY PROFILE 22" in the application will serve as a significant point of conceptual difference between the marks. However, there remains a degree of conceptual similarity, owing to the concept of 'OPTIMA/OPTIMAH'. Overall, I consider the marks to be conceptually similar to a medium degree.

Likelihood of confusion

72. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

73. I have found some of the goods to be identical and some to be similar to varying degrees. I have found the average consumer to be a tradesperson or a member of

the general public who will purchase the goods primarily by visual means, although I find that an aural component will factor into the process. I have concluded that a medium degree of attention is likely to be paid in the purchasing process although I recognise that for some of the goods, a higher degree of attention may be paid. I have found the opponent's mark to have a medium degree of inherent distinctive character overall, with the word OPTIMAH itself having between a low and medium degree of inherent distinctive character. In making my decision, I have borne in mind that it is the distinctiveness of the common element which is key.²⁷ I have found the marks to be visually similar to between a low and medium degree and aurally and conceptually similar to a medium degree. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

74. Notwithstanding the principle of imperfect recollection and taking all of the above factors into account, I consider that the visual and aural differences between the marks will be sufficient to enable the average consumer to differentiate between them, particularly the presence of the words "BY PROFILE 22" in the application. Consequently, I do not consider there to be a likelihood of direct confusion between the marks, even when they are used on goods that are identical.

75. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the

²⁷ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.). 9 BL O/375/10 Page 15 of 16

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

76. I have borne in mind that the examples given by Mr Purvis QC are not exhaustive. Rather, they were intended to be illustrative of the general approach.²⁸

77. I must now consider the possibility of indirect confusion and whether average consumers would believe that there is an economic connection between the marks or that they are alternative marks from the same undertaking as a result of the shared common elements of the marks. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. It is not sufficient that a mark merely calls to mind another mark. This is mere association, not indirect confusion.²⁹

²⁸ *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

²⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

78. In my view, the presence of the letter “H” at the end of the opponent’s mark is likely to be overlooked or mistakenly recalled by the average consumer, particularly given the conceptual overlap between the words OPTIMAH/OPTIMA. The words “BY PROFILE 22” in the application are likely to be seen as indicating an entity that produces a product or range called OPTIMA. I find that the word ‘OPTIMA’ in the application will be seen as an indication of a sub-brand produced by the entity ‘PROFILE 22’. When a trader uses a sub-brand, it can use it jointly and autonomously, with or without the name of the entity that produced it. Therefore, it is possible that the average consumer will see the goods sold under the earlier mark (overlooking the presence of the additional “H!”) and assume that the responsible entity sometimes uses ‘OPTIMA’ with ‘BY PROFILE 22’, and sometimes without it. The use of colour/stylisation is likely to be seen as just a different presentation being used by the same or economically linked undertakings. In that event, it is plausible that the average consumer would think that the user of the opponent’s mark and the application were one and the same undertaking, or economically related undertakings. I consider there to be a likelihood of indirect confusion.

79. I consider that this finding will apply to those goods that I have found to be identical or similar to at least a medium degree. However, I consider that the similarities between the marks will be offset by the differences between the goods that I have found to be similar to only a low degree.

CONCLUSION

80. The opposition has succeeded in respect of the majority of goods for which the applicant applied for. The application is, therefore, refused in the respect of the following goods:

Class 19: Building and construction materials and elements, not of metal; Doors, windows and window coverings, not of metal; plastic window and door frames; Conservatories, not of metal; Conservatory frames, not of metal; Glass walls; Fascias, not of

metal; Soffits, not of metal; Frames for glass walls, not of metal; cladding materials, not of metal; parts and fittings for any or all of the aforesaid goods.

81. The application can proceed to registration for the following goods which I have found to be similar to a low degree:

Class 19: Building Structures, not of metal; parts and fittings for any or all of the aforesaid goods.

COSTS

82. As the opponent has enjoyed a greater degree of success, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Given that the opposition failed against only one of the goods against which it was directed, I do not consider this enough to warrant a reduction in the amount of costs awarded.

83. In the circumstances, I award the opponent the sum of **£1,100** as a contribution towards its costs. The sum is calculated as follows:

| | |
|---|---------------|
| Preparing a statement and considering the applicant's statement: | £200 |
| Preparing evidence and considering and commenting on the other side's evidence: | £500 |
| Preparing written submissions in lieu: | £300 |
| Official fees: | £100 |
| Total: | £1,100 |

84. I therefore order Specialist Building Products Limited to pay Unlimited Perspective SA the sum of £1,100. This sum is to be paid within twenty-one days of the expiry

of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of October 2020

A COOPER

For the Registrar