

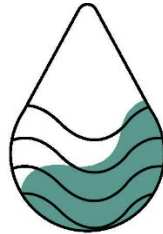
O/539/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3564527

IN THE NAME OF
ADELE WILLIAMS

TO REGISTER THE FOLLOWING TRADE
MARK:



EST.

2020

GREEN WAVE

IN CLASS 1

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 423796
BY OLEON NV

Background and pleadings

1. On 5 December 2020, Adele Williams (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. It was accepted and published in the Trade Marks Journal on 5 February 2021 in respect of the following goods:

Class 1: Chemical absorbants

2. On 6 April 2021, OLEON NV (“the opponent”) opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of the following UK Trade Mark:

GREENWAVE

UK registration no. 3612542

Relying on all goods in Class 1, namely:

Chemical preparations for use in industry; chemicals for agriculture, horticulture, and forestry namely chemical preparations for the treatment of seeds; Chemical additives For use in the manufacture of a wide variety of products, including Cosmetics and Pharmaceuticals; Industrial chemicals derived from natural and synthetic fatty substances, namely: Fatty acids, Glycerine for industrial purposes, Glycerides, Fatty alcohols and industrial derivatives thereof, in particular soap [metallic] for industrial purposes, methyl esters, isopropyl esters, polyglycerol esters of fatty acids with different carbon chain lengths, Epoxy resins, Amino compounds; Flotation chemical agents for use in mineral separation; Agrochemical goods in the form of oleochemical goods for use in agriculture, namely manure, grain treatments, for turf, golf courses and tourist equipment for mixing biocides in a vat; Adjuvants (other than for medical or veterinary purposes) for use with agricultural chemicals; Adjuvant sprays (other than for medical or veterinary purposes) for use with agricultural pesticides; Adjuvants, Not for medical or veterinary use, For use in

the manufacture of the following goods: herbicides, insecticides and Pesticides; Surfactants for use in connection with agricultural pesticides; Chemical additives for use in the manufacture of plastics and rubber.

3. By virtue of its priority date of 10 July 2020, the above registration constitutes an earlier mark within the meaning of section 6 of the Act.

4. The opponent submits that there is a likelihood of confusion because the applicant's registration is highly similar to the opponent's and the respective goods are identical or similar.

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is represented by Wynne-Jones IP Limited whereas the applicant is representing themselves. Neither party filed evidence in these proceedings, but the applicant did file written submissions. Neither party requested a hearing, so this decision is taken following a careful perusal of the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Proof of Use

8. As the opponent's mark has been registered for less than 5 years before the filing date of the application in issue, it is not subject to the proof of use provisions of section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Decision

9. Section 5(2)(b) of the Act is as follows:

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

(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”.

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

The principles:

- (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

11. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

12. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

13. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

15. The goods to be compared are as follows:

Opponent's goods	Applicant's goods
<i>Class 1: Chemical preparations for use in industry; chemicals for agriculture, horticulture, and forestry namely chemical preparations for the treatment of seeds; Chemical additives For use in</i>	<i>Class 1: Chemical absorbants.</i>

the manufacture of a wide variety of products, including Cosmetics and Pharmaceuticals; Industrial chemicals derived from natural and synthetic fatty substances, namely: Fatty acids, Glycerine for industrial purposes, Glycerides, Fatty alcohols and industrial derivatives thereof, in particular soap [metallic] for industrial purposes, methyl esters, isopropyl esters, polyglycerol esters of fatty acids with different carbon chain lengths, Epoxy resins, Amino compounds; Flotation chemical agents for use in mineral separation; Agrochemical goods in the form of oleochemical goods for use in agriculture, namely manure, grain treatments, for turf, golf courses and tourist equipment for mixing biocides in a vat; Adjuvants (other than for medical or veterinary purposes) for use with agricultural chemicals; Adjuvant sprays (other than for medical or veterinary purposes) for use with agricultural pesticides; Adjuvants, Not for medical or veterinary use, For use in the manufacture of the following goods: herbicides, insecticides and Pesticides; Surfactants for use in connection with agricultural pesticides; Chemical additives for use in the manufacture of plastics and rubber.

16. I consider the opponent's *Chemical preparations for use in industry* to refer to a range of chemicals with a variety of uses within the field of industry such as agricultural or manufacturing purposes. The applicant's *chemical absorbants* would be used to clean up chemical spillages including that of hazardous or corrosive chemicals, and these absorbents may come in the form of granules, powders, absorbent mats or cloths. Overall, I find the nature and intended purpose of these goods would differ however, there would no doubt be an overlap in users as those working with chemical preparations may require chemical absorbents if spillages occur. Further, I consider there would be an overlap in trade channels. There is a degree of complementarity as chemical absorbents would need chemicals to absorb in order to fulfil their purpose. Consequently, the relationship between chemical preparations and chemical absorbents is such that customers may think that the responsibility for those goods lies with the same undertaking. Overall, I find these goods to be similar to at least a medium degree.

The average consumer and the nature of the purchasing act

17. 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 determine the manner in which the goods are likely to be selected by the average consumer. 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.”

18. I find that the average consumer will predominantly be professionals in a variety of fields including inter alia construction, agriculture and manufacturing though I also acknowledge that the average consumer of chemical absorbents will also consist of members of the general public such as DIY enthusiasts, or those with hobbies which will require the use of these goods. The cost of the goods may vary considerably depending on the amount of product, its availability and if the chemical preparations or absorbents are of a specialised nature. I also find that the goods will generally be an infrequent purchase. The general public selecting chemical absorbents will take into account the products compatibility with certain substances such as chemicals, oils and water, the level of absorbency and price. Taking this into consideration, I consider it likely that an above medium degree of attention will be paid during the purchasing process by these consumers. The professional public are likely to pay a higher degree of attention due to the added responsibility and liability they will face in their position. These consumers will be likely to pay at least an above medium to high degree of attention to the goods.

19. The goods are likely to be self-selected by the general public from specific retail stores or a website. Professional consumers may purchase the goods via specialised wholesale stores, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, given that advice may be sought from sale assistants, and orders may be placed over the phone, I do not discount an aural component to the purchase.


Comparison of marks

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

21. 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 trade 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.

22. The marks to be compared are as follows:

Opponent's mark	Applicant's mark
<p>GREENWAVE</p>	

Overall impression

23. The opponent's mark consists of the word "GREENWAVE". There are no other elements to contribute to the overall impression which lies in the word itself.

24. The applicant's mark consists of several elements being a figurative raindrop device marked with wavy lines and a green wave image within the raindrop, the wording "GREEN WAVE" presented in a bold, green upper-case font, the wording "EST. 2020", and a white rectangular background. Due in part to its size, positioning, in addition to it being the verbal element of the mark, I find the "GREEN WAVE"

wording plays the dominant part in the overall impression. The figurative raindrop element is mainly decorative and plays a secondary role in the overall impression. The wording “EST. 2020”, would be regarded as the descriptive meaning of “established in 2020” and I find it may well go unnoticed however, if it is noticed, its contribution towards the mark’s overall impression will be minimal. I consider the white background to be negligible.

Visual comparison

25. Visually, the marks coincide in the presence of the wording “GREENWAVE”. I note the spacing between the wording “GREEN” and “WAVE” in the applicant’s mark whereas the opponent’s mark is presented as “GREENWAVE”, however, I consider this to be only a minor difference which may go unnoticed. Further, the applicant’s “GREEN WAVE” wording is presented in a bold green font though, I accept that fair and normal use of the opponent’s word mark would permit the use of a bold green font on a white background. The most significant point difference is the presence of the raindrop device element in the applicant’s mark which has no counterpart in the opponent’s mark. I have assessed the “Est 2020” element in the applicant’s mark as playing only a minor role in the overall impression which consequently creates only a small degree of visual difference between the marks. Balancing the points of similarity and difference, together with my assessment of the overall impression of the marks, my view is that there is between a medium and high level of visual similarity between the opponent’s and applicant’s mark.

Aural comparison

26. The opponent’s mark will be pronounced in two syllables using the usual English pronunciation of the words GREEN and WAVE. Owing to the size and descriptive nature of the “Est 2020” element in the applicant’s mark, I do not find it likely that this element will be verbalised. As such, I consider that the applicant’s mark will also be pronounced in two syllables as “GREEN-WAVE” rendering the marks aurally identical.

Conceptual comparison

27. In its statement of grounds, the opponent submits “Conceptually, both marks are identical as they mean a wave which is of green colour.” I find that the term “GREEN” in both marks will likely be perceived as the colour green, though I accept in some circumstances it may also convey a message to the consumer that the goods in question are environmentally friendly. The word “WAVE” has several definitions¹ including the hand gesture and a raised mass of water, especially the sea, caused by the wind or tide. Consumers are likely to see this word and immediately think of one of these definitions. I consider that the second definition will be most apparent to consumers in respect of the applicant’s mark due to the figurative raindrop element. Overall, I find the marks to be conceptually similar to a high degree.

Distinctive character of the earlier mark

28. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, 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-

¹ [Wave definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/english-english/dictionary/wave)

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).”

29. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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 that has been made of it.

30. The earlier mark consists solely of the word “GREENWAVE”. As previously stated, the term “GREEN” will likely be perceived as the colour or to indicate that the goods are environmentally friendly whereas the word “WAVE” will be considered as one of the dictionary definitions. Notwithstanding the possibility of the “GREEN” element indicating that the goods are environmentally friendly, I do not find the mark to be particularly allusive to the goods in question. As such, I find the mark to be inherently distinctive to a medium degree.

Likelihood of confusion

31. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my

assessment, I must bear in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

33. Earlier in my decision, I found the marks to be conceptually similar to a high degree, visually similar to between a medium and high degree and I found the marks to be aurally identical. I considered the goods to be similar to at least a medium degree. I found the earlier mark to have a medium degree of inherent distinctive character. I identified the average consumer to be a professional or a member of the general public who will purchase the goods predominantly by visual means, though I do not discount an aural element to the purchase. I have concluded that an above medium degree of attention will be paid during the purchasing process by the general public, but that this may be at least above medium to high in the case of professional users.

34. The respective marks share a dominant and distinctive element (GREENWAVE) and during the purchasing process, visual elements are likely to dominate though I acknowledge that aural considerations also apply, and the marks are aurally identical. I note there are several elements in the applicant's mark which do not have any counterpart in the opponent's mark however, I did not find these elements to play a dominant role in the overall impression. Taking this into consideration along with all of the relevant factors, notwithstanding the average consumers above medium level of attentiveness, the marks may be misremembered by way of imperfect recollection, and it is my view that the device in the applicant's mark may be forgotten or go unnoticed. I therefore find that it is likely that the consumer may mistake one mark for the other in respect of all of the goods, and as such I find there is a likelihood of direct confusion.

35. I now go on to consider indirect confusion.

36. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

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

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

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

37. These examples are not exhaustive but provide helpful focus.

38. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

39. I consider that the word element is the entire earlier mark, and that lack of spacing between the words is likely to go unnoticed. I consider that the identical word element is the most dominant and distinctive element in the later mark. It is my view that even if the average consumer were to recognise the differences between the marks, by way of the raindrop device and “EST 2020” wording and considering the medium level of distinctiveness in the word element, I believe they would consider the applicant’s mark to merely be a stylised version of the earlier mark and would therefore consider the goods to originate from the same undertaking. In view of this, I find there is also a likelihood of indirect confusion between the marks.

CONCLUSION

40. The opposition under section 5(2)(b) of the Act has succeeded in full. Subject to any successful appeal against my decision, the application will be refused in the UK.

COSTS

41. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (‘TPN’) 2 of 2016. Using that TPN as a guide, I award the opponent the sum of **£300** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official Fee:	£100
Preparing a statement and considering the other side’s statement:	£200

42. I therefore order Adele Williams to pay the sum of £300 to OLEON NV. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 21st day of June 2022

**Catrin Williams
For the Registrar**