O/0795/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 4005729

BY VENTOPURE LTD

TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASS 11

AND

THE OPPOSITION THERETO UNDER NUMBER 447277

BY IMI HYDRONIC ENGINEERING SWITZERLAND AG

Background and pleadings

1. On 23 January 2024, Ventopure Ltd ("the applicant") applied to register the figurative trade mark, shown on the cover page, in the UK. It was accepted and published in the Trade Marks Journal on 2 February 2024 in respect of the following goods and services:

> *Class 11: HVAC systems (heating, ventilation and air conditioning); Industrial heating furnaces; Furnace boilers; Electrical boilers; Air heating furnaces; Residential air conditioning units; Appliances for heating; Boilers for use in heating systems; Control units [thermostatic valves] for heating installations; Residential heating units; Heating, ventilating, and air conditioning and purification equipment (ambient); Air valves for steam heating installations; Window-mounted air conditioning units; Cooled panels for use with electrical furnaces; Industrial heating installations; Industrial humidifiers; Air heating installations; Heating boilers; Dampers [heating]; Boilers for heating installations; Flues for heating boilers; Industrial heaters; Industrial air purifiers; Heating furnaces for industrial use; Electric central heating boiler systems; Thermostatic valves [parts of heating installations]; Thermostatic valves as parts of heating installations; Valves (Thermostatic -) [parts of heating installations]; Heating and cooling systems for motor cars; Residential ventilating units; Tub control valves [plumbing fittings]; Heating furnaces [for industrial purposes]; Extractors [ventilation or air conditioning]; Vent covers [parts of air conditioning installations]; Refrigerant condensers; Manually-operated plumbing valves; Solar heating installations.*

2. On 2 May 2024, IMI Hydronic Engineering Switzerland AG ("the opponent") opposed the trade mark, based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its earlier UK comparable trade mark:

> **VENTO**
>
> UK registration number: UK00800843811
> Priority date: 20 September 2004
> Filing date: 4 March 2005

Registration date: 10 March 2008[1]

3. The following goods are relied on in this opposition:

Class 11: Heating apparatus; Water distribution installations as well as components of the above products included in this class.

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark in accordance with section 6 of the Act. The opponent's mark had been registered for more than five years at the filing date of the applicant's mark, and is therefore subject to the use provisions set out in section 6A of the Act. However, the applicant has not requested for the opponent to provide proof of use. As such, the opponent may rely upon all of the goods set out above, without filing evidence of use in respect of the same.

5. Under section 5(2)(b), the opponent claims that the opposed goods are identical or similar to the relied upon goods and that the marks are similar. As such, it claims that there will be a likelihood of confusion between the marks.

6. The applicant filed a counterstatement in which it states that its brand name and logo design are different to the opponent's. It states that consumers are unlikely to confuse the marks due to the substantial differences between them.

7. Both the opponent and the applicant filed written submissions in these proceedings. Neither party filed evidence in these proceedings, nor was a hearing requested. This decision is taken following a careful perusal of the papers.

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing International Registration designating the EU. As a result of the opponent's International Registration designating the EU being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original priority date.

8. The opponent is represented by Barker Brettell LLP. The applicant is a litigant in person.

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Preliminary matters

Parties operate in different market sectors

10. In its counterstatement, the applicant states that "Ventopure… provid[es] high-quality HVAC products and services to commercial and industrial clients". They further state that "VENTO… operates in a different sphere. Their brand primarily serves the industrial ventilation and HVAC industry", and that "while both brands operate within the HVAC domain, the specific market segments they address are distinct". The applicant appears to submit that there is no likelihood of confusion on the basis that the parties operate in different market sectors.

11. I remind myself of the findings of Dr Brian Whitehead sitting as the Appointed Person in the *City Storage Systems LLC v Kenmark Kitchen Limited*, where he stated (my emphasis): [2]

> "18. […] The authors of Kerly state at 11-055: "it is the goods or services covered by the specification of the marks at issue that must be considered when making this assessment, and not the goods or services actually marketed under those marks", referring to *Present-Service Ullrich GmbH & Co KG v OHIM* (T-66/11) [2013] E.T.M.R. 29. In that case, the General Court said at 45:
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> > "Secondly, the applicant's claim that it operates in a completely different commercial sector from the intervener is also irrelevant. In order to

[2] Decision BL O/0065/24

assess the similarity of the goods or services at issue for the purposes of art.8(1)(b) of Regulation 207/2009, the group of goods or services protected by the marks at issue must be taken into account, and not the goods or services actually marketed under those marks".

12. It follows that, in my assessment, I must make a notional assessment of the goods registered and applied for and it is not relevant for me to take into account the goods marketed, or the market sectors targeted by the parties. I thus disregard this submission from the applicant.

Decision

Section 5(2)(b)

13. 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".

Section 5A

14. Section 5A of the Act is as follows:

> "5A 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."

The principles

15. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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 C120/04, *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 Page 5 of 17 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

16. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the 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."

17. 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.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court ("GC") stated that:

> "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 fur 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."

19. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

20. Further, in *Kurt Hesse v OHIM*,[3] 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 OHIM*,[4] the GC stated that "complementary" means: "…there is 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."

21. The goods to be compared are shown in the table below:

The opponent's goods relied on	**The applicant's contested goods**
Class 11: Heating apparatus; Water distribution installations as well as components of the above products included in this class.	*Class 11: HVAC systems (heating, ventilation and air conditioning); Industrial heating furnaces; Furnace boilers; Electrical boilers; Air heating furnaces; Residential air conditioning units; Appliances for heating; Boilers for use in heating systems; Control units [thermostatic valves] for heating installations; Residential heating units; Heating, ventilating, and air conditioning and purification equipment (ambient); Air valves for steam heating installations; Window-mounted air conditioning units; Cooled panels for use with electrical furnaces; Industrial heating installations; Industrial humidifiers; Air heating installations; Heating boilers; Dampers [heating]; Boilers for heating installations; Flues for heating boilers; Industrial heaters; Industrial air purifiers;*

[3] Case C-50/15 P
[4] Case T-325/06

	Heating furnaces for industrial use; Electric central heating boiler systems; Thermostatic valves [parts of heating installations]; Thermostatic valves as parts of heating installations; Valves (Thermostatic -) [parts of heating installations]; Heating and cooling systems for motor cars; Residential ventilating units; Tub control valves [plumbing fittings]; Heating furnaces [for industrial purposes]; Extractors [ventilation or air conditioning]; Vent covers [parts of air conditioning installations]; Refrigerant condensers; Manually-operated plumbing valves; Solar heating installations.

22. In its TM7, the opponent pleads that the goods are identical or similar. It does not specify the level of similarity between the goods within its pleadings. In its counterstatement, the applicant states that there is market segmentation between the marks, which has been addressed above. However, it does not deny that there is similarity between the goods applied for and those registered by the opponent. I also note that the applicant's final written submissions focus on the differences between the marks themselves. I will proceed with the goods comparison with this in mind.

HVAC systems (heating, ventilation and air conditioning); Industrial heating furnaces; Furnace boilers; Electrical boilers; Air heating furnaces; Appliances for heating; Boilers for use in heating systems; Control units [thermostatic valves] for heating installations; Residential heating units; Heating […] equipment (ambient); Air valves for steam heating installations; Cooled panels for use with electrical furnaces; Industrial heating installations; Air heating installations; Heating boilers; Dampers [heating]; Boilers for heating installations; Flues for heating boilers; Industrial heaters; Heating furnaces for industrial use; Electric central heating boiler systems; Thermostatic valves [parts of

heating installations]; Thermostatic valves as parts of heating installations; Valves (Thermostatic -) [parts of heating installations]; Heating […] systems for motor cars; Heating furnaces [for industrial purposes]; Solar heating installations

23. The above goods all fall under the scope of the opponent's "heating apparatus". These goods are therefore considered identical according to the principles set out in *Meric*.[5]

Tub control values [plumbing fittings]; Manually-operated plumbing valves

24. The above goods all fall under the scope of the opponent's "water distribution installations as well as components". These goods are therefore considered identical according to the principles set out in *Meric*.[6]

Residential air conditioning units; window-mounted air conditioning units; […] air conditioning equipment (ambient)

25. The above goods all relate to air conditioning equipment. In its submissions in lieu, the opponent submits that air conditioning is not limited to cooling, it is also used for heating, and therefore the goods relating to air conditioning are encompassed by the opponent's 'heating apparatus'. The applicant does not dispute this matter. Although I consider that not all air conditioning units would have the ability to both cool and heat the air in a room, I accept the opponent's position that at least some air conditioning units do have the ability to heat air. The opponent's 'heating apparatus' therefore overlaps with the above goods. These goods are considered identical according to the principles set out in *Meric*.[7]

26. If I am wrong to find these goods identical, given the overlap in use, nature and trade channels, I nonetheless find them similar to a medium degree.

[5] Case T-133/05
[6] Case T-133/05
[7] Case T-133/05

Extractors [[…] air conditioning]; Vent covers [parts of air conditioning installations]; Refrigerant condensers

The above goods are all parts of air conditioning units. As above, I consider that air conditioners overlap with the opponent's 'heating apparatus'. The above goods therefore overlap with the opponents 'components of [heating apparatus]'. These goods are considered identical according to the principles set out in *Meric*.[8]

27. If I am wrong to find these goods identical, given the overlap in use, nature and trade channels, I nonetheless find them similar.to a medium degree.

[…] cooling systems for motor cars

28. Unlike air conditioning units above which can be used for heating, the above goods are specifically cooling systems and as such they do not overlap with the opponent's 'heating apparatus'. However, I note the term *heating apparatus* will include heating apparatus for motor cars. In its submissions in lieu, the opponent submits that "cooling and heating are essential for the successful control of the other" and that "they are usually part of the same system which both cools and heats, dependent on the controller". Although I accept that a car may have one system which both cools and heats, I do not accept that this is always the case. Additionally, although heating and cooling systems may work together to control the climate of a car, without further evidence on this point I do not consider that heating apparatus are essential to car cooling systems.

29. The goods overlap in user where both goods are used by the general public and car mechanics. The nature and purpose of the goods broadly overlaps in that they both can be used to control the temperature of a vehicle, but differs as the opponent's goods are used to heat air, while the above goods are used to cool air in a car. Trade channels will overlap where both goods will be sold by vehicle manufacturers, wholesalers and garages. There is no competition or complementarity. Overall, I consider the above goods to have a medium similarity to the opponent's 'heating apparatus'.

[8] Case T-133/05

Industrial humidifiers

30. The above goods are considered most similar to the opponent's 'heating apparatus'. This term includes protection for goods such as industrial heating apparatus. The users overlap as both goods are used by industrial procurement personnel and HVAC engineers. The purpose of the goods differs as the above goods are designed to humidify a room, while the opponent's goods are designed to heat a room. To an extent, there may be an element of overlap in nature in the sense that both will comprise a large machine complete with parts designed for extracting and/or expelling air into a room, but there will also be differences due to their different specific purposes. In its submissions in lieu, the opponent submits that such goods overlap in nature and purpose because both are used to "provide acceptable air quality within a particular space". I accept that this is the purpose of a humidifier, but I do not accept that heating a room could be considered to relate to the air quality of said room. That said, both will be used for the purpose of controlling the air conditions in a particular environment. There may be an overlap in trade channels, but there is no competition or complementarity. Overall, I consider the above goods to have a low similarity to the opponent's 'heating apparatus'.

Industrial air purifiers; […] purification equipment (ambient)

31. The above goods are considered most similar to the opponent's 'heating apparatus', which as mentioned above will cover *industrial heating apparatus*. I also note that the contested *purification equipment (ambient)* will include *industrial purification equipment (ambient)* and it is on this basis that I make this comparison. The users overlap as both goods are used by industrial procurement personnel. The specific purpose of the goods differs as the above goods are designed to purify air, while the opponent's goods are designed to heat a room. As above, I accept that the purpose of the above goods is to "provide acceptable air quality within a particular space", but I do not accept that heating a room could be considered to relate to the air quality of said room. However, again both will be used for the general purpose of controlling the air conditions in a particular environment. Again, to an extent, there may be an element of overlap in nature in the sense that both will comprise a large machine complete with parts designed for extracting and/or expelling air into a room, but there will also be differences due to their different specific purposes. Trade channels may

overlap, but there is no competition or complementarity. Overall, I consider the above goods to have a low similarity to the opponent's 'heating apparatus'.

Residential ventilating units; […] ventilating […] equipment (ambient)

32. The above goods are considered most similar to the opponent's 'heating apparatus'. This term includes protection for goods such as residential heating equipment. In its submissions in lieu, the opponent submits that "heating and ventilation are entirely interconnected and the successful functioning of each is dependent on the existence of the other". I accept that the goods are very generally linked in that both fall under the umbrella of HVAC, but I do not consider that this equates to complementary as, although it is possible the use of both together *may* be considered optimal, I have no evidence that the use of one is essential or important to the functioning of the other.

33. The users overlap as both goods are used by the general public and HVAC engineers. The purpose of the goods differs as the above goods are designed to ventilate a room, while the opponent's goods are designed to heat a room. To an extent, there may be an element of overlap in nature in the sense that both will comprise a large machine complete with parts designed for extracting and/or expelling air into a room, but there will also be differences due to their different specific purposes. There may be an overlap in trade channels, but there is no competition or complementarity. Overall, I consider the above goods to have a low similarity to the opponent's 'heating apparatus'.

Extractors [ventilation […]]

34. The above goods are extractors for ventilation purposes, such as those used in a bathroom to remove water vapour from the air. They are considered most similar to the opponent's 'heating apparatus'. The users overlap as both goods are used by the general public and HVAC engineers. The purpose of the goods differs as the above goods are designed to extract water vapour from a room, while the opponent's goods are designed to heat a room. To an extent, there may be an element of overlap in nature in the sense that both will comprise a large machine complete with parts designed for extracting and/or expelling air into a room, but there will also be differences due to their different specific purposes. There may be an overlap in trade

channels, but there is no competition or complementarity. Overall, I consider the above goods to have a low similarity to the opponent's 'heating apparatus'.

Comparison of marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

36. It would be wrong, therefore, to dissect the trade marks artificially, 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.

37. The respective trade marks are shown below:

The opponent's earlier marks	The applicant's contested mark
VENTO	

38. In its counterstatement, the applicant states that its mark "is a combination of 'Vento' (Italian for 'wind') and 'pure'" and the stylisation comprises a "stylised leaf within a circular emblem, symbolising purity and nature". It further states that its design approach distinctly contrasts with that of the opponent's mark, that there is no visual or conceptual similarity between the marks, and that these differences reinforce the distinctiveness of the respective brands.

39. In its submissions in lieu, the opponent submits that the 'pure' and 'air-conditioning & ventilation' elements of the applicant's contested mark are "entirely descriptive and non-distinctive in relation to the Applicant's Goods", and that "the stylisation of the mark is negligible and does not imbue the mark with any distinctive character above and beyond the words contained within the mark". It submits that the dominant and distinctive element of the contested mark is "Vento", which has no meaning in connection with the applicant's goods. It therefore submits that the marks are highly visually and aurally similar, and that neither mark has any conceptual connotations.

Overall impression

40. The opponent's mark is a word-only mark consisting of the word "VENTO". It is in this element that the overall impression of the mark resides.

41. The applicant's mark is a figurative mark consisting of the words "Vento" above the word "pure", with the phrase "air-conditioning and ventilation" underneath. The first letter of "Vento" is stylised with the righthand part of the letter comprising stripes. There is also an incomplete circle surrounding and passing through the "V", which is in an orange colour with a circle at one end and a thinner portion at the other. The phrase "air-conditioning and ventilation" is descriptive or allusive of the relevant goods. In my view, the words "Vento" and "pure" do not hang together or form a unit with a meaning that is more than the sum of its parts. As noted above, the applicant states that "Vento" is the Italian for "wind". Given that the average consumer in the UK does not speak Italian, I consider that the majority of consumers would not understand this meaning. Whilst I note that "Vento" is mildly allusive of "ventilation", the word "pure" is laudatory, especially in the context of ventilation and air conditioning. The stylisation of and around the letter "V" is quite notable, but I consider that the "Vento" element plays the greatest role in the overall impression mark.

Visual comparison

42. The earlier marks coincide visually with the contested mark through the use of the word “Vento”. However, the contested mark also comprises the words “pure” and “air-conditioning & ventilation” placed after this. The contested mark also comprises stylisation of the first letter and an orange incomplete circle around and through the “v”, and I find this stylisation to fall outside of the fair and notional use of the earlier word mark. However, given the relative sizes of the text I consider that the “Vento” element dominates the applicant’s contested mark visually, with the word “pure” being secondary, followed by the additional text. Overall, considering the visual similarity created by the use of the word “Vento” in each mark, but also considering the visual differences, I find the marks to be visually similar to a medium degree.

Aural comparison

43. Both marks comprise the word “Vento”, which will be pronounced as “vent-O”. The contested mark further comprises the words “pure air-conditioning & ventilation”, which will be pronounced in the known way. The overlap of the first two syllables of the marks creates some aural similarity, but additional eleven syllables in the contested mark results in a significant aural difference between the marks.

44. I remind myself of the finding in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of marks tend to have more visual and aural impact than the ends. The court stated:

> “81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover,

reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar."

45. Considering this, the consumer will pay more attention to the identical first two syllables of the marks than they would to the additional eleven syllables of the contested mark. Overall, I consider the marks to be aurally similar to a medium degree.

Conceptual comparison

46. In considering the conceptual comparison of the marks, I remind myself of the decision of the General Court in 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)

63. In the present case, the Board of Appeal correctly found that the signs at issue have a common prefix, ‘galva’, which evokes the technique of galvanisation, that is, the act of fixing an electrolytic layer to a metal to protect it from oxidation.

64. By contrast, the Board of Appeal incorrectly took the view that a conceptual comparison of the second part of the signs was not possible, because the suffixes ‘llia’ and ‘lloy’ were meaningless.

65. That conclusion is based on an artificial division of the signs at issue, which fails to have regard to the overall perception of those signs. As stated in paragraph 59 above, the relevant public, which is French-speaking but has knowledge of the English language, will recognise in the mark applied for the presence of the English word ‘alloy’, corresponding to ‘alliage’ in French, even if the first letter of that word (‘a’) has merged with the last letter of the prefix ‘galva’, according to the usual process of haplology. That mark will therefore be perceived as referring to the concepts of galvanisation and alloy.

66. As far as the earlier mark is concerned, the suffix ‘allia’ is combined with the prefix ‘galva’ in the same way. The evocative force of the suffix ‘allia’ will enable the relevant public – on account of its knowledge and experience – to understand that that is a reference to the word ‘alliage’. That process of identification is facilitated still further by the association of the idea of ‘alliage’ (alloy) with that of galvanisation, the suffix ‘allia’ being attached to the prefix ‘galva’.

67. By breaking down the signs at issue, the relevant public will therefore interpret both signs as referring to the concepts of galvanisation and alloy.

68. Consequently, the conclusion to be drawn is, as the applicant correctly maintains, that the signs at issue are conceptually very similar, inasmuch as they both evoke the idea of galvanisation and of an alloy of metals, although that idea is conveyed more directly by the mark applied for than by the earlier mark.”

47. As noted in this case law, although the average consumer normally perceives a mark as a whole, they will also break it down into verbal elements which suggest a concrete meaning. Further, the above case demonstrates that a concept may be evoked by a mark, even where the complete word is not used (for example, in the case of “galva” above).

48. The contested mark contains the elements “Vento”, “pure” and “air-conditioning & ventilation”. The consumer will understand “pure” to mean “not mixed or adulterated; clean, clear, refined”.[9]. The consumer will understand “air-conditioning & ventilation” to refer to systems that cool the air in a room and move fresh air around a room or space, respectively.

49. Both the earlier mark and the contested mark include the word “Vento”. As noted above, I consider that the average consumer will understand this word to be at least allusive of ventilation. This is the only concept in the earlier mark.

50. The concept conveyed by the word “Vento” in both marks and “ventilation” in the contested mark acts as a point of conceptual similarity between the marks, whilst the concepts of the additional words in the contested mark acts as a point of conceptual difference. Overall, I find the marks to be conceptually similar to a medium degree.

Average consumer and the purchasing act

51. As the case law above indicates, it is necessary 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.”

52. The average consumer of the goods and services at issue will be in two groups: professionals and members of the general public purchasing goods for personal use.

[9] Oxford English Dictionary, https://www.oed.com/dictionary/pure_adj?tab=meaning_and_use#27527155, accessed 9 July 2025.

The general public consider factors such as size, quality and price. Consequently, the general public consumers will pay an average degree of attention. Professional consumers will include HVAC engineers as well as industrial procurement personnel. These consumers will consider factors such as suitability, specification, quality and price. I consider that professional consumers will pay a higher than average degree of attention during the purchasing process.

53. The goods at issue will be purchased by the general public from DIY stores or domestic appliance stores and by professionals from trade stores and wholesalers. In both cases, visual considerations will play a dominant role, although aural considerations should not be discounted as advice may be sought from salespeople and, particularly in the case of professionals, orders may be placed over the phone.

Distinctive character of the earlier trade mark

54. 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 *WindsurfingChiemsee* 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)."

55. 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.

56. There is no evidence regarding the use of the earlier mark. Consequently, I have only the inherent position to consider.

57. The opponent's earlier mark consists of the word "VENTO". The opponent submits in its submissions in lieu that this word has no meaning in relation to the goods. However, the applicant's counterstatement states that this word is the Italian word for "wind". As noted above, I do not consider that the average consumer will understand the word as the Italian for "wind". However, I do consider that they will understand the word "Vento" to be at least allusive of ventilation. Although this is not directly descriptive of the registered goods, it is allusive of them, as heating apparatus require ventilation. Consequently, although it appears to technically be a made-up word, I find that the opponent's mark possesses only an average level of inherent distinctive character for all of the opponent's goods and services.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

58. 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 (*Canon* at [17]). It is necessary to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and services and the nature of the purchasing act. 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 they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

59. 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 down to the responsible undertakings being the same or related.

60. Earlier in this decision, I found the contested goods and services to be either identical to the opponent's goods or similar to a low degree. I found the marks to have a medium level of visual, aural and conceptual similarity. I found the earlier mark to possess an average level of distinctive character. I identified the average consumer to include professionals paying a higher than average degree of attention, and members of the general public paying an average level of attention. I found that the goods would be selected by both visual and aural means.

61. I also found that the dominant element of each mark is the word "VENTO". The additional wording in the contested mark is descriptive of the goods and this, along with the stylisation, would in my view be easily forgotten, or not noticed by a consumer.

62. As noted above, 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 they have retained in their mind (*Lloyd Schuhfabrik* at [26]).

63. Taking all of the above factors into account, particularly considering the dominant element in each mark comprises the word "Vento", I am satisfied that the average consumer would likely mistake the parties' marks for each other on goods and services that are similar or identical. I therefore find there to be a likelihood of direct confusion between the parties' marks for all of the contested goods.

64. If I am incorrect in my finding of a direct likelihood of confusion, I will proceed to consider whether there is a likelihood of indirect confusion, whilst reminding myself that, as James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16], "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion".

65. In *L.A. Sugar Limited v By Back Beat Inc*, 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)."

66. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances in which indirect confusion occurs.

67. Taking the above into consideration, I consider there to be a likelihood of indirect confusion between the marks where the goods are identical or similar. The addition of the words "air-conditioning & ventilation" to later mark simply adds a non-distinctive element which is descriptive of the goods. The stylisation of the contested mark is not negligible, but if it is recalled, it would in my view likely be viewed as an element of stylisation added to the earlier "Vento" mark. The addition of the word "pure" to the contested mark is laudatory and is likely to be seen as a brand extension, perhaps used in relation to a particular subset of goods within the "Vento" range. The average consumer is therefore likely to conclude that the goods are supplied by the same, or economically linked, undertakings[10].

68. Taking all of this into account, I consider there to be a likelihood of indirect confusion in relation to all of the applicant's goods.

69. For completeness, I note at this stage that even if I am wrong to consider the marks to be conceptually similar to a medium degree (on the basis that both parties have either pleaded either that they are conceptually dissimilar or that "VENTO" has no meaning), this would in my view have no impact on my overall finding. If I were to find no concept to be conveyed by the VENTO element of each mark, I would find the earlier mark to hold a high degree of distinctive character on this basis, and I would find the points of conceptual difference to not be particularly memorable in the context of the goods. In my view, if I were to take this approach, it would only serve to strengthen the opponent's position in these proceedings. As the opponent has in any case been entirely successful, the outcome would, in these circumstances, remain the same.

Final Remarks

[10] *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10

70. The opposition under section 5(2)(b) has been successful in respect of all of the applicant's goods. Subject to any successful appeal, the application will be refused in its entirety.

COSTS

71. The opponent has been successful and is therefore entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of £700 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Preparing and filing the TM7 and statement of grounds and considering the TM8 and counterstatement:	£250
Preparing and filing written submissions: [11]	£350
Official fee:	£100
Total:	**£700**

72. I therefore order VENTOPURE LTD to pay IMI Hydronic Engineering Switzerland AG the sum of £700. 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 28th day of August 2025

K HARBACH

For the Registrar

[11] Although the opponent's submissions were filed during the evidence rounds, they are submissions rather than evidence, so I have awarded costs below the scale for filing evidence.