

o/0800/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003835666

BY KENTISH RESTORATION LTD

TO REGISTER THE TRADE MARK:

Hemplite

IN CLASSES 19 AND 37

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 440495

BY TARMAC BUILDING PRODUCTS LIMITED

BACKGROUND AND PLEADINGS

1. On 4 October 2022, Kentish Restoration Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 27 January 2023. The applicant seeks registration for the following goods and services:

Class 19 Lime building materials; Building materials, not of metal; Materials, not of metal, for building; Materials, not of metal, for building and construction; Building materials with soundproofing qualities, not of metal; Building and construction materials and elements, not of metal.

Class 37 Installation of insulating materials in buildings, roofs and structures; Building maintenance; Insulating (Building -); Building restoration; Building insulating; Building insulation; Building repair; Building repairs.

2. The application was opposed in full by Tarmac Building Products Limited (“the opponent”) on 27 April 2023 based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act (“the Act”). However, the opponent withdrew the section 5(3) and 5(4)(a) grounds in writing on 1 August 2023. Therefore, under section 5(2)(b), the opponent relies upon the following mark:

Hemelite

Comparable trade mark (IR) registration no. UK0000807306¹

Filing date 18 June 1960.

Registration date 18 June 1960.

Relying upon all of the goods for which the earlier mark is registered, namely:

¹ Following the end of the transition period of the UK’s withdrawal from the EU, all international (EU) trade mark designations registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (IR)’ retains the same designation date (filing date), priority date (if applicable) and registration date of the international (EU) trade mark designation.

Class 19 Clinker building blocks.

3. The opponent claims there is a likelihood of confusion because the marks are similar and the goods and services are identical or similar.

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

5. The opponent is represented by Freeths LLP and the applicant is unrepresented. Neither party requested a hearing nor filed written submissions in lieu, however, the applicant filed evidence in chief. I make this decision having taken full account of all the papers, referring to them below as necessary.

RELEVANCE OF EU LAW

6. 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.

EVIDENCE AND PRELIMINARY ISSUE

7. The applicant's evidence consists of the witness statement of Damon Mackins dated 30 October 2023. Mr Mackins is the Director of the applicant, and his statement is accompanied by 2 exhibits (HL1-HL2).

8. **Exhibit HL1** contains an explanation and depiction of the opponent's goods; that being a "lightweight medium density aggregate block suitable for a wide range of construction". **Exhibit HL2** contains an explanation and depiction of the applicant's goods; that being a "lightweight insulating lime-based plaster". However, this evidence is not relevant, and does not assist the applicant because I have to carry out a notional assessment based upon the specifications before me.

DECISION

Section 5(2)(b)

9. Section 5(2)(b) reads as follows:

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

(a)...

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

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

10. The opponent’s mark qualifies as an earlier mark in accordance with section 6(1)(ab) as its filing date is earlier than the filing date of the applicant’s mark. The opponent’s earlier mark had also completed its registration process more than five years before the relevant date (the filing date of the applicant’s mark). Accordingly, the use provisions at section 6A of the Act do apply. However, as the applicant did not request that the opponent prove use of its mark, it is entitled to rely upon all of its goods without demonstrating that it has used its mark.

Section 5(2)(b) case law

11. 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:

- (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

12. The competing goods and services are as follows:

Opponent's goods	Applicants' goods and services
<p><u>Class 19</u> Clinker building blocks.</p>	<p><u>Class 19</u> Lime building materials; Building materials, not of metal; Materials, not of metal, for building; Materials, not of metal, for building and construction; Building materials with soundproofing qualities, not of metal; Building and construction materials and elements, not of metal.</p> <p><u>Class 37</u> Installation of insulating materials in buildings, roofs and structures; Building maintenance; Insulating (Building -);</p>

	Building restoration; Building insulating; Building insulation; Building repair; Building repairs.
--	--

13. 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 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.”

14. Guidance on this issue has 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 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.

15. In *Gérard Meric v OHIM*, 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 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.”

16. 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 OHIM*, Case T-325/06, the GC 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 the responsibility for those goods lies with the same undertaking.”

17. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was) noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand: "... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

Whilst on the other hand:

"... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

Class 19

Building materials, not of metal; Materials, not of metal, for building; Materials, not of metal, for building and construction; Building and construction materials and elements, not of metal.

18. The opponent's "clinker building blocks" fall within the applicant's above broader categories. The goods are identical on the principle outlined in *Meric*.

Building materials with soundproofing qualities, not of metal.

19. I have no evidence before me to establish that the opponent's "clinker building blocks" have soundproofing qualities. However, as identified above, the opponent's goods are a type of building material, and therefore shall overlap in nature, method of use, trade channels and, to the extent that they are used in building and construction, purpose. I therefore consider that the goods are similar to between a medium and high degree.

Lime building materials.

20. The opponent's "clinker building blocks" are made from the ashes of coal, and therefore, do not overlap in nature with the applicant's above goods. However, the parties' goods are all types of building materials, which will overlap in method of use, trade channels and purpose. Consequently, the goods are similar to a medium degree.

Class 37

Installation of insulating materials in buildings, roofs and structures; Building maintenance; Insulating (Building -); Building restoration; Building insulating; Building insulation; Building repair; Building repairs.

21. I do not consider that any of the applicant's above services are similar to the opponent's "clinker building blocks". The goods and services clearly do not overlap in nature and method of use. There may be very minimal overlap in purpose to the extent that they are all used for the construction of buildings, however, the applicant's services all have specific purposes (such as to provide insulation, or to restore and repair buildings). Furthermore, it is unlikely that the manufacturers of clinker building blocks would offer installation services for these goods, or more widely, restoration, maintenance and repair services for buildings. The goods and services are clearly not in competition, nor are they complementary. Whilst it could be arguable that the applicant's services may be facilitated using the opponent's "clinker building blocks", the average consumer would not believe that the goods and services originate from the same undertaking. The applicant's services would be provided by builders and construction companies. The opponent's goods would be sold in builders' merchants or DIY home improvement retailers, which can be bought and directly assessed by the general public. Consequently, the user would know that these goods are provided by different trade channels. The goods and services are thus dissimilar.

22. It is a prerequisite of section 5(2)(b) that the goods and services be identical or at least similar. The opposition will, therefore, fail in respect of the services that I have found to be dissimilar.²

23. The opposition under section 5(2)(b) fails for the following services:

Class 37 Installation of insulating materials in buildings, roofs and structures;
Building maintenance; Insulating (Building -); Building restoration;
Building insulating; Building insulation; Building repair; Building repairs.

² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

24. 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.”

25. The average consumer for the goods will be professionals who work in the building or construction industry, as well as members of the general public. The cost of purchase is likely to vary, and the frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. The average consumer will take various factors into consideration such as the material of the goods, cost, durability, quality and suitability for the user's needs. Consequently, I consider that at least a medium degree of attention will be paid by the average consumer when selecting the class 19 goods.

26. The goods are likely to be obtained by self-selection from the shelves of a builders' merchants or DIY home improvement retailer, and their online equivalents. Alternatively, the goods may be purchased following perusal of advertisements or inspection of a catalogue. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word-of-mouth recommendations.

Comparison of the trade marks

27. It is clear from *Sabel BV 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. 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.”

28. 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.

29. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
Hemelite	Hemplite

30. The opponent's mark consists of the 8-letter word “Hemelite”. There are no other elements to contribute to the overall impression which lies in the word itself.

31. The applicant's mark consists of the 8-letter word “Hemplite”. There are no other elements to contribute to the overall impression which lies in the word itself.

32. Visually, the opponent submits that the marks have the identical prefix “Hem” and the identical suffix “lite”. These act as visual points of similarity. The only point of visual difference is the fourth letter of both marks, being the letter E in the opponent’s and being the letter P in the applicant’s. Therefore, taking all of the above into account, the marks are visually similar to a high degree.

33. I have no submissions from either party as to the aural pronunciation of the marks. However, I consider that the opponent’s mark will most likely be pronounced as HE-ME-LITE, and the applicant’s mark will most likely be pronounced as HEMP-LITE. Therefore, the marks overlap in the “HE” element at the beginning of both marks, and they both end in the aurally identical “LITE” syllable. Therefore, as a whole, I consider that the marks are aurally similar to between a medium and high degree.

34. Conceptually, I have no submissions from either party as to what concepts would be assigned to both marks by the average consumer. However, as a whole, I consider that both marks will be seen as invented words with no conceptual meaning, and thus, they are conceptually neutral.

Distinctive character of the earlier trade mark

35. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

36. 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.

37. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

38. The average consumer will see the word “Hemelite” as an invented word with no conceptual meaning. On this basis, the opponent’s mark is inherently distinctive to a high degree.

Likelihood of confusion

39. 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. 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 vice versa. 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.

40. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to a high degree.
- I have found the marks to be aurally similar to between a medium and high degree.
- I have found the marks to be conceptually neutral.
- I have found the earlier mark to be inherently distinctive to a high degree.
- I have identified the average consumer for the goods to be professionals who work in the building or construction industry, as well as members of the general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that at least a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be identical or similar to between a medium and high degree or at least a medium degree.

41. Taking all of the above factors into account, bearing in mind that the average consumer rarely has a chance to make direct comparisons between trade marks and, instead, will encounter them in different settings at different times, and therefore must rely upon the imperfect picture of them retained in its mind, I consider that the marks are likely to be mistakenly recalled or misremembered as each other. This is particularly the case given that the parties' goods are identical or similar to between a medium and high degree, or at least a medium degree, and the high degree of visual similarity between the marks and the predominantly visual purchasing process. Even where aural considerations play a greater role, the between a medium to high degree of aural similarity between the marks will have the same result. I consider that because the marks share the prefix (Hem) and the suffix (lite), with the only difference being

the fourth letter in the middle of the marks (e vs p), these will be easily overlooked or misremembered as each other. Furthermore, both marks will be perceived as invented words with no conceptual meaning. This results in the opponent's mark being inherently distinctive to a high degree, and, in the absence of any conceptual hook in either of the marks, consumers will not have a strong conceptual message to assist in differentiating between them. This results in a likelihood of direct confusion.

CONCLUSION

42. The opposition is partially successful in respect of the following goods for which the application is refused:

Class 19 Lime building materials; Building materials, not of metal; Materials, not of metal, for building; Materials, not of metal, for building and construction; Building materials with soundproofing qualities, not of metal; Building and construction materials and elements, not of metal.

43. The application can proceed to registration in respect of the following services for which the opposition has been unsuccessful:

Class 37 Installation of insulating materials in buildings, roofs and structures; Building maintenance; Insulating (Building -); Building restoration; Building insulating; Building insulation; Building repair; Building repairs.

COSTS

44. As both parties have achieved what I regard as a roughly equal measure of success, I direct that both parties should bear their own costs.

Dated this 20th day of August 2024

L FAYTER

For the Registrar