

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS  
IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for registration of Trade Mark No. 256576 and in the matter of an Opposition thereto.

**Akzo Nobel Coatings International B.V.**  
(Represented by Cruickshank & Co.)

**Applicant**

**Therma-Cote Inc.**  
(Represented by FRKelly)

**Opponent**

**The Application**

1. On 31 January, 2017 (the relevant date), Akzo Nobel Coatings International B.V., of Valperweg 76, Arnhem, The Netherlands (hereinafter “the Applicant”) made application (No. 2017/00214) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register DULUX TRADE THERMACOAT+ as a Trade Mark in respect of the following goods in Class 2:

Paints; coatings; varnishes; lacquers; thinners; colouring matters all being additives for paints, varnishes or lacquers; preservatives against rust and against deterioration of wood; priming preparations (in the nature of paints); wood stains.

2. The application was accepted for registration and advertised accordingly under No. 256576 in Journal No. 2329 dated 22 March, 2017.

3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 21 June, 2017 by Therma-Cote Inc. of 1369 Herrington Road, Lawrenceville, Georgia 30044, USA (hereinafter “the Opponent”). The Applicant filed a counter-statement on 14 September, 2017 and evidence was, in due course, filed by the parties under Rules 20 and 21 of the Trade Marks Rules, 1996 (“the Rules”).

4. The Applicant elected to file written submissions (on 16 January, 2020) in lieu of attending the Hearing. The Opponent attended the Hearing before me, acting for the Controller, on 3

March, 2020. The parties were notified on 6 May, 2020 that I had decided to dismiss the opposition and to allow the mark to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) filed on 19 May, 2020.

### **Grounds of the Opposition**

5. In its Notice of Opposition, the Opponent states it has for many years carried on business as manufacturers and merchants of a range of specified goods, including paints, varnishes, lacquers, preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metal in foil and powder form for painters, decorators, printers and artists.
6. It then refers to its proprietorship of a European Union Trade Mark (EUTM) Registration No. 6997506 THERMACOTE (details of which were attached in Schedule 1), stating it has for many years extensively used that mark in connection with the goods and services it provides. The Notice of Opposition states the mark denotes and has long denoted both to the trade and the public such goods and services as rendered by the Opponent and has long distinguished these goods and services from the like goods and services of other traders. It then goes on to state the grounds of its opposition which I summarise as follows:
  - Section 10(2)(b) – *likelihood of confusion on the part of the public, including a likelihood of association with the Opponent’s Trade Marks*
  - Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s Trade Marks,*
  - Section 10(4)(a) – *use of the mark in the State is liable to be prevented by virtue of the law of passing off;*

The Opponent stated it also objects to any application of Section 12 of the Act.

### **Counter-Statement**

7. In its Counter-Statement the Applicant denies all the grounds of opposition and states the Opponent is not entitled under the Act or Rules to object to the application of Section 12 of the Act, should the Controller decide it is appropriate to apply the provisions of that section.

## **Rule 20 Evidence**

8. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration dated 12 June 2018, and supporting evidence, by way of sixteen exhibits (marked 1 to 16), of Thomas R. Sharp Jr., President of Therma-Cote Inc. I have examined in detail the Declaration and all the accompanying Exhibits but will only refer to their particulars if and when appropriate to do so.
9. Mr Sharp provides details of the Opponent's EUTM (attached at Exhibit 1). Though the Opponent's EUTM is in respect of THERMACOTE (all in upper case), throughout his Declaration and in all the accompanying exhibits - except the copy of the EUTM registration, reference is made to the Opponent's ThermaCote trade mark and products. As the Opposition is based on the Opponent's earlier THERMACOTE EUTM and for the sake of consistency I shall refer to it in that form from hereon. Also, for the purpose of clarity, I mention that nothing rests on the Opponent's use of the mark in a form that differs from that for which it is registered.
10. He states that for over 30 years his Company has developed and produced a line of technologically-advanced weather barrier and protective coatings that add energy efficiency and safety to any substrate or structure. He says the products seal the envelope of any structure and do not pollute the indoor or outdoor environments to which they are applied and that his Company's THERMACOTE product also provides a high-performance weather barrier coating that offers superior corrosion protection for commercial and residential application, for both the interior and exterior.
11. Mr Sharp states his Company has a significant presence in the European Union (EU), having first used ThermaCote in the EU in 2012. He says THERMACOTE products have been sold throughout the EU, including in France, Romania, Malta, Greece, the United Kingdom (UK), Belgium, Portugal, Spain and that currently negotiations are underway with distributors in Ireland. These products are generally sold in a pail or bucket and he attaches at Exhibit 2A photographs of these THERMACOTE products.
12. He says the total sales value of THERMACOTE products in the EU since 2012 has been €1,843,987 and he provides a breakdown of sales figures for the years 2013-2017. He

attaches at Exhibit 2B a sample of invoices issued between 2011 and 2017 to customers in Romania, France, Malta, France, Greece, Belgium and the UK.

13. Mr Sharp states his Company has marketed its THERMACOTE product throughout the EU including Ireland. He says a sales person has visited Ireland and met with various entities to discuss the THERMACOTE products and meet with a number of businesses and contractors in Ireland with the aim of selling the THERMACOTE products. He names 9 businesses and provides further information about them at Exhibit 3. At Exhibit 4 he attaches details of his Company's marketing efforts in Ireland and the EU, as well as a list of EU companies his Company has marketed its THERMACOTE product to.
14. He states the total amount his Company spent on advertising the THERMACOTE mark since the date of first use in the EU is €400,000 and he provides a breakdown of the expenditure for the years 2013-2017 attesting to this.
15. Mr Sharp states his Company promotes its THERMACOTE product through trade events and exhibitions, sporting events, magazines, product literature, brochures and newsletters. He attaches at Exhibit 5 photographs of exhibition kits given to specified European client/partners, as well as images of promotional stands at various exhibitions held in the EU.
16. He says his Company sponsors a sail boat which prominently features the THERMACOTE mark and competes in various races around Europe including the Rolex Fastnet Race. Images of the boat, together with examples of his Company's monthly newsletter from 2018 are attached at Exhibit 6.
17. At Exhibit 7 he attaches advertisements from the period 2009-2018 which appeared in a number of trade magazines. Exhibit 8 contains marketing material used in France, while Exhibit 9 contains copies of a business card, post cards and colour charts for distribution. Exhibits 10, 11 and 12 contain technical and safety information regarding the THERMACOTE product.
18. He attached video reports (Exhibit 13) on various trade shows where THERMACOTE was exhibited, and an extract from his Company's YouTube channel (Exhibit 14).

19. Mr Sharp states there was an instance of confusion between his Company's THERMACOTE product and the Applicant's THERMACOAT+ product. He attaches at Exhibit 15 an email, dated 4 January 2018, highlighting a person was confused and believed the Applicant was related to his Company. The person attached a document (DULUX–THERMACOAT.pdf), issued by the Applicant and which caused the confusion to the email.
20. He attaches at Exhibit 16 three email notifications from 2011, 2012 and 2013 showing that the Applicant clicked on his Company's THERMACOTE advertisements. He believes this shows the Applicant was aware of his Company's THERMACOTE product before the Applicant launched its THERMACOAT+ product and applied to register the DULUX TRADE THERMACOAT+ mark.

### **Rule 21 Evidence**

21. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration and supporting evidence, by way of eleven exhibits (JO1 to JO11), dated 18 June 2019, of Joost Jan van Ooijen, Director Intellectual Property of the Applicant.
22. Mr van Ooijen provides background to his Company and the history of the trade mark DULUX. He states the trade mark DULUX was registered and first used in Ireland in 1931. He says the mark was registered in the UK in 1930, that it was used in other European countries from 1931 and was first registered as an EUTM in 1996. He attaches at Exhibit JO1 printouts of some of the Trade Mark Registrations owned by his Company which consist of or contain the term DULUX.
23. He states DULUX TRADE is his Company's product line specifically aimed at the professional painter and experienced consumer. He says DULUX TRADE has been registered as an EUTM since 2016 and prior to that was registered in Ireland in 1992.
24. Mr van Ooijen states his Company's DULUX TRADE THERMACOAT+ trade mark was first registered in the United Kingdom in 2016. He says the product sold under the mark is a revolutionary three-part coating system devised by his Company to improve thermal performance, by cutting heat loss and increasing building energy efficiency.

25. He says his Company's annual financial information is kept strictly confidential. Nonetheless, he confirms the turnover under its DULUX brand in the EU has been in excess of €500 million per year for the last seven years. Turnover under the DULUX TRADE mark has been in excess of €200 million over the same period. He states separate figures in respect of the DULUX TRADE THERMACOAT+ brand are not available.
26. Mr van Ooijen states his Company spends in excess of €35 million per year in the EU on advertising products bearing DULUX trade marks, including in Ireland. He attaches at Exhibit JO6 examples of the advertising undertaken by his Company in the past 50 years.
27. He says DULUX TRADE products are available throughout Ireland and are stocked in leading DIY stores like Woodies. He refers to his Company having a strong social media presence for its DULUX and DULUX TRADE brand ranges, including a YouTube channel for the latter with 4,500 subscribers and video content has been posted there since April 2011. He says there is a dedicated Irish page on his Company's Facebook account which has received more than 5 million 'likes' and that his Company's Facebook content has a similar number of followers. He also refers to his Company's DULUX YouTube channel with 19,000 subscribers which hosts content dating back to 2010.
28. He provides an extract (at Exhibit JO11) from a consumer awareness report showing that in 2017 97% of survey participants were aware of the DULUIX TRADE brand.
29. He speaks about packaging, in-store advertising and sales, though all of the Exhibits in respect of these elements of his declaration post-date the application date of the contested mark.
30. The Opponent choose not to file evidence in reply to the Applicant's Rule 21 evidence and elected to file written submissions in lieu of attending at the Hearing.

### **Written Submissions and Hearing**

31. Written submission filed by the Applicant were compiled by Ms Mary Rose O'Connor, Trade Mark Attorney of Cruickshank & Co. At the Hearing the Opponent was represented by Mr David Flynn, Trade Mark Attorney of FRKelly.

32. In her written submissions, Ms O'Connor dealt with the Opponent's grounds of opposition based on Section 10(4) of the Act, but at the outset of the Hearing Mr Flynn informed me he would not be pursuing the opposition on this ground. Accordingly, I will consider the matter on the remaining two grounds alone.

**Section 10(2)(b) – likelihood of confusion**

33. Both representatives identified the factors to be considered while carrying out an assessment of a likelihood of confusion, presented their assessment of the similarity existing between the marks, directed me to caselaw that is pertinent to the peculiarities of this case, and identified relevant passages from those judgments. Not surprising, each reached a conflicting position as to the outcome of their assessment of these factors.

34. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

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

*(a) .....*

*(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.*

35. Therefore, there are four basic requirements that must be met in order for an objection under it to succeed. They are: (i) there must be “an earlier trade mark”, (ii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, (iii) the mark applied for must be similar to that earlier trade mark, and, (iv) there must be a resultant likelihood of confusion on the part of the relevant consumer.

36. The first two of these conditions are clearly fulfilled in this case. The Opponent's mark was filed at the European Union Intellectual Property Office on 18 June 2008, well prior to the relevant date, and is an earlier trade mark as against the present application for the purposes

of Section 10. The goods of the application for registration are identical with or similar to the goods for which the Opponent's earlier trade mark stand is registered.

### **Comparison of the marks**

37. I have compared the respective marks of the parties on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant is seeking protection. Notwithstanding the detailed comparisons I make below I am mindful that the European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)<sup>1</sup> that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

38. In comparing the parties' marks, I find there is some visual, aural and conceptual similarity, which relates to the common THERMA element. The COTE and COAT elements of the respective marks also share aural similarity. However, clearly there are also visual, aural and conceptual differences. The Applicant's mark contains the words DULUX and TRADE, and the + (plus) symbol, which are not present in the Opponent's mark.

39. At the Hearing Mr Flynn argued the plus symbol does nothing in terms of putting distance between the two marks and can be ignored. He opined that THERMACOAT is the dominant element of the Applicant's mark and that it is visually highly similar to the Opponent's mark. His arguments for refusal of the application centred squarely on this element and he downplayed the role of all other elements of the Applicant's mark. He argued the presence of the terms DULUX and TRADE is not sufficient to outweigh the similarity between the THERMACOTE and THERACOAT elements, which are phonetically identical, because the Applicant's THERMACOTE mark retains an independent distinctive role in the Applicant's mark.

---

<sup>1</sup> Paragraph 23 of decision dated 11 November, 1997



40. To support his position he informed me the Court of Justice of the European Union (CJEU) had consistently held that when an earlier mark maintains an independent distinctive role in a later composite sign such that the overall impression produced by that composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, a likelihood of confusion is established (*Medion*<sup>2</sup>, *Bimbo SA*<sup>3</sup> and *Perfetti Van Melle*<sup>4</sup>). He argued that to hold otherwise would permit third parties to circumvent the rights of trade mark proprietors by simply putting a company name before the earlier mark, which in his opinion, is what the Applicant is seeking to do.
41. The leading authority in this regard is *Medion* whereby the owner of the trade mark LIFE sought to prevent Thomson from using the sign THOMSON LIFE. Thomson had argued that THOMSON LIFE could not be confused with LIFE as it includes the element THOMSON, the name of the manufacturer, which has the same prominence as the other element present. However, the CJEU held as follows, at paragraphs 30-31 and 36:

*“30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.*

*31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.*

...

*36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”*

42. Mr Flynn stressed the crucial factor is whether the earlier mark THERMACOTE retains an independent distinctive role in the later mark, which he maintained it undoubtedly does. He also argued that for this to apply the earlier mark does not have to be reproduced in an identical fashion in the later mark. In support of this he directed me to *Aveda Corporation v*

---

<sup>2</sup> *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*. Case C-120/04

<sup>3</sup> *Bimbo SA v OHIM* (Case C-591/12 P)

*Darbur India*,<sup>5</sup> wherein Arnold J provided a useful summary of caselaw concerning earlier trade marks which retained an independent distinctive role in later marks, which includes cases where the earlier mark was similar but not identical to part of the later mark. He noted that in *Medion* the exact earlier mark was reproduced in the later mark, but nonetheless voiced his approval that the underlying logic can still apply where the later mark contains an element similar to the earlier mark, where at paragraph 44 he stated:

*“Although the decision in Medion v Thomson does not in terms extend to cases in which the composite sign incorporates a sign which is similar to, rather than identical with, the trade mark and some of the Court of Justice’s reasoning would not apply to such a case, I consider that the underlying logic is equally applicable.”*

43. He summarised the relevant cases at paragraphs 36-38 where he had this to say:

*“36. In Case T-569/10 Bimbo SA v OHIM [2012] ECR II-0000, [2013] ETMR 7, the applicant applied to register BIMBO DOUGHNUTS as a Community trade mark. The application was opposed on the basis of an earlier Spanish registration for DOGHNUTS covering identical and similar products. The opposition was successful. The applicant’s appeal to the Board of Appeal was dismissed. The applicant appealed to the General Court. The General Court agreed with the lower tribunals that there was a likelihood of confusion and dismissed the appeal.*

*37. A key part of the General Court’s reasoning was as follows:*

*“96. According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 Medion [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 Nestlé v OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe) [2010] ECR II-1177, paragraph 60).*

*97. In this case, the ‘doughnuts’ element, which is almost identical to the earlier trade mark, has an independent distinctive role in the mark applied for. Indeed, contrary to what is claimed by the applicant, that element is not devoid of distinctive character but on the contrary has average distinctive character for the part of the relevant public which is not familiar with English. Furthermore, since the ‘doughnuts’ element is wholly meaningless for that consumer, the mark applied for, BIMBO DOUGHNUTS, does not form a unitary whole or a logical unit on its own in which the ‘doughnuts’*

---

<sup>4</sup> Case C-353/09

<sup>5</sup> [2013] EWHC 589 (Ch)

*element would be merged. The part of the relevant public which is not familiar with English will not be able to understand the sign at issue as meaning that the goods concerned are doughnuts produced by the undertaking Bimbo or by the proprietor of the trade mark BIMBO."*

*38. It should be noted that, although the General Court held that DOUGHNUTS was "almost identical" to DOGHNUTS, it did not proceed on the basis that the average consumer would perceive it as being identical. An appeal to the CJEU against the decision of the General Court is pending as Case C-591/12 P."*

44. Arnold J went further and added, at paragraphs 45-46:

*"I entirely accept the basic proposition which the Court of Justice has repeated many times, namely that the assessment of likelihood of confusion must be made by considering and comparing each of the signs as a whole. As the Court of Justice recognised in Medion v Thomson, however, there are situations in which the average consumer, while perceiving a composite sign as a whole, will recognise that it consists of two signs one or both of which has a significance which is independent of the significance of the composite whole..."*

*The essence of the Court of Justice's reasoning in Medion v Thomson is that an average consumer of leisure electronic products confronted with the composite sign THOMSON LIFE could perceive both the whole and its constituent parts to have significance and thus could be misled into believing that there was a similar kind of connection between the respective undertakings."*

45. Arnold J indicated that consumers might misperceive the "UVEDA" element of "DABUR UVEDA" as "AVEDA", where at paragraph 48 he found:

*"I think there can be little doubt that the average consumer who was familiar with AVEDA beauty products would be likely to be confused by the use of DABUR UVEDA in relation to identical goods. In particular, there would be a strong likelihood that the average consumer would think that it indicated some connection between DABUR and AVEDA. In my judgment it makes little difference that the second word in the composite mark is UVEDA rather than AVEDA. As the hearing officer rightly accepted, UVEDA is both visually and aurally very close to AVEDA. The human eye has a well-known tendency to see what it expects to see and the human ear to hear what it expects to hear. Thus, it is likely that some consumers would misread or mishear UVEDA as AVEDA."*

46. Ms O'Connor maintains in her submissions that the marks are dissimilar across all three criteria, with the only similarity being in respect of part of one of the three words that are contained in the Applicant's mark, namely THERMA. The shared common elements are very limited, and the elements that differ have a very high level of distinctiveness, and greatly outweigh the limited similarities.

47. I agree with Ms O'Connor. When comparing the marks as a whole, which I am obliged to do, I find the differences are obvious. Visually the Applicant's mark contains three words and a mathematical symbol compared with a single word in the Opponent's mark. None of the three words of the Applicant's mark is the same as the Opponent's single word mark, though the first part of the Opponent's mark is repeated in the third word of the Applicant's mark. So, there is some similarity, but in my opinion, the level of visual similarity is very low.
48. Verbally, the Opponent's mark sounds identical to the third word of the disputed mark, but this accounts for only a third of the verbal elements. Therefore, I find the marks share a low level of aural similarity.
49. The shared common element THERMA has no dictionary meaning. But this does not mean it is incomprehensible or incapable of conveying a clear message. In my opinion, the average consumer would immediately understand the term to be connected with heat, particularly heat absorption, reflection or resistance. In that regard one would not need to be a scientist to figure out what 'thermaglazing' or 'thermalayer' might refer to.
50. Furthermore, while the respective marks contain a word beginning with THERMA, the words have different endings. Though both endings sound the same, visually and conceptually they are different. The endings are real words with different meanings, and that difference is significant. On the one hand the COTE part of the Opponent's mark refers to a small building, specifically one used to house animals, in particular birds (e.g. a dovecote). On the other hand, the COAT part of the Applicant's marks refers to a garment, layer or covering. In that regard the terms THERMACOTE and THERMACOAT would be understood to refer to a heat retaining/resistant building and a heat retaining/resistant covering (but not a building) respectively.
51. Most significantly, the THERMACOAT in the Applicant's mark would be seen as being descriptive of those goods, i.e. products that have heat retention/resistance properties. The Opponent's THERMACOTE mark differs in that regard as it is not descriptive of the goods. It appears to me the Opponent may have settled on its THERMACOTE mark precisely because it differs from THERMACOAT, which could be considered totally descriptive of

the goods, lacking in inherent distinctiveness and, prima facie, incapable of acting as a trade mark.

52. Therefore, conceptually THERMACOTE is dissimilar to THERMACAOT. When the other elements of the Applicant's mark are added to the mix, the dissimilarity increases exponentially. In my opinion, the average consumer would understand the Applicant's mark to convey the clear message that the goods are enhanced (+), heat resistant/retaining (THERMACOAT) products, from a specific undertaking (DULUX), specifically targeted towards professional tradespersons (TRADE). This is a far cry from the message conveyed by the Opponent's mark of a heat resistant/retaining (THERMA) building (COTE). I would assess the level of conceptual similarity between the marks as extremely low.

53. Taking my findings in respect of the visual, aural and conceptual similarities between the marks into account, I am satisfied the overall level of similarity between the marks is extremely low, which I would quantify as a coat of paint amount above zero.

54. Having found there is miniscule similarity between the marks, the issue does not end there. I must conduct a global assessment of the likelihood of confusion which requires me to take all relevant factors into account, including the similarity between the goods. Accordingly, I must be mindful that in *Canon Kabushiki*<sup>6</sup> the Court of Justice of the European Union (CJEU) found "*a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa*". This is very much in play as I have already found the goods at issue are either identical or highly similar.

55. I must also take into account other factors identified by the CJEU<sup>7</sup> in this area, including the following:

- (a) the more distinctive the earlier mark, the greater will be the likelihood of confusion;
- (b) in determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings;

---

<sup>6</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* Case C-39/97 at p.17

<sup>7</sup> *Sabel BV –v- Puma AG and Rudolph Dassler Sport* (Case C-251/95) [1998] 1 CMLR 445; and *Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV* (Case C-342/97) [1999] 2 CMLR 1343

- (c) in making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations;
- (d) a global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed and purchased;
- (e) the assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind,

56. In applying these criteria, I find the following:

- a) The Opponent's mark has some inherent distinctiveness, albeit to a less than average degree, as use of the term Therma for products used to cover surfaces, and to provide a thermal or heat insulation barrier, could be considered descriptive. Nonetheless, the Opponent's mark has the capacity to identify the goods for which it is registered as being those of a particular undertaking and thus to distinguish those goods from those of other undertakings.
  - b) The Opponent has not provided sufficient evidence of use throughout the European Union that would lead me to conclude the Opponent's mark has acquired additional distinctiveness through the use made of it.
  - c) The Applicant's mark is also inherently distinctive. The distinctiveness is gained predominantly through the DULUX element, which is not present in the Opponent's
-

mark. Therefore, the distinctiveness of each mark results from elements that are not shared.

- d) I find the overall impression created by the marks is that they are very different. The wording is different and the concept is different.
- e) The class of goods covered is not broad and the consumers of the goods are tradespersons and the public generally. In terms of the general public, I am satisfied they oftentimes put significant thought into selecting any of the goods at issue. This includes considering the colours available, the surface the goods are to be applied to, whether the goods are for internal or external use and, if internal, whether moisture is a factor (e.g. in the case of bathrooms), the coverage, the desired finish, whether it is washable, whether it is hardwearing, and of course, cost. Consumers will often study colour charts and obtain test pots and apply them to establish whether the finish turns out as expected and to view the overall look in relation to the fixtures and fittings already in place. Oftentimes, advice is sought from the retailer prior to settling on a particular purchase. Tradespersons would be able to make informed choices by virtue of their own experience and knowledge.
- f) There is no clear indication of market share held by the Opponent's mark, but on the evidence submitted, I consider it to be extremely low. There has not been intensive, geographically widespread or long-standing use of the mark in the EU. Based on the evidence submitted the Opponent's mark is not well-known in the EU. At best, it may be familiar to consumers in France. There is no evidence of any use of the Opponent's mark in Ireland or that Irish consumers have encountered the mark.

57. In light of the foregoing factors, I am required to make an overall assessment of the likelihood of confusion that may exist between the Opponent's earlier trade marks and the Applicant's mark. The confusion in question may be direct confusion, whereby the Applicant's product is mistaken for that of the Opponent, or indirect confusion, whereby the Applicant's product is associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. The principles set out above are very familiar to all practitioners in the field and inevitably provide a wealth of material for opposing parties to include in their submissions at hearings, which they did in this case. Nonetheless, I must

look at the question of likelihood of confusion from a practical perspective in the context of the marketplace and put myself in the shoes of the average consumer of the goods in question. In essence I must judge the matter of the assessment of likelihood of confusion in accordance with CJEU guidance to decision-makers, which can be summarised as follows: *Imagine a typical purchasing scenario involving the average person who already knows the product sold under the earlier trade mark and ask yourself whether it is likely that he will select and purchase a product bearing the mark put forward for registration in the mistaken belief that it is the product he knows by the earlier mark (direct confusion) or that it is related to that product (indirect confusion by association).* It is not necessary to find that every consumer would be confused and nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trade mark under the section. The question is whether it is likely or unlikely that the average person would be confused in the course of the typical purchasing scenario. In the present case, I have decided that there is no likelihood of confusion or association for the reasons stated below.

58. There is a lot more to the Applicant's mark than the word 'THERMACOAT' and, in my opinion, the word 'DULUX' contributes significantly to its distinctiveness and serves to put ample distance between the respective parties' marks. The visual, aural and conceptual differences between the marks are so obvious that, in my opinion, a person exercising normal care would be unlikely to select goods bearing the 'DULUX TRADE THERMACOAT+' mark in place of one bearing the Opponent's THERMACOTE mark. The trade marks do not look or sound sufficiently similar to make direct confusion between them a real likelihood. Even allowing for imperfect recollection, confusion is unlikely because the distinctive and dominant features of the Applicant's mark, which create its lasting impression, are not reproduced in the Opponent's mark.
59. Crucially, and contrary to Mr Flynn's urgings, I find the Opponent's mark does not play an independent distinctive role in the Applicant's mark.
60. In its evidence the Opponent claimed there has in fact been an instance of confusion and provided a copy of an email purporting to support that claim. In my opinion, this claim is fundamentally flawed in a number of aspects. While I can ignore that the email postdates the relevant date (because confusion is really only ever likely to arise when both marks are in



the marketplace), I cannot ignore other facts. The subject line is written as “DULUX – THERMACOAT.pdf” and suggests a document was attached to the email (I have no reason to doubt that the .pdf document was the one attached at Exhibit 15). The rest of the email in its entirety reads “*Is this you? M*”. The sender is recorded as mmeyer@tempcoat.com, which appears to refer to Morris Mayer, owner of Tempcoat Brand Products, LLC, an American company. The recipient is TJ Sharp, who appears to be Thomas R. Sharp Jr., President of Therma-Cote Inc and a deponent in these proceedings.

61. It appears the correspondents are the owners of two American companies in the same area of business as the Applicant and are well-known to each other (the email sign-off using a simple “M” strongly suggests this is the case) and, therefore, they would be well acquainted with each other’s business. The .pdf attachment itself contains a number of interesting elements. The document is headed with the AkzoNobel and Dulux TRADE logos. It is inconceivable that the sender, who appears to be in the same line of business as AkzoNobel, does not know who AkzoNobel (a multinational organisation and one of the world’s leading paint producers) is, and that his acquaintance’s company is not AkzoNobel.
62. Furthermore, the document exhibited is an invitation to participate in a case study in the United Kingdom being undertaken by the Applicant in conjunction with the UK Energy Saving Trust between January 2018 and May 2018. Specifically, the study was looking for homeowners located along the M4 corridor (i.e. from Slough to Bristol) with solid wall construction to test the Applicant’s new Dulux Trade Thermacoat+ product. How or why this document came into the possession of the sender of the email (an executive of an American company) is not explained. Nor is any explanation offered as to how the production of this UK-specific document, targeted at UK homeowners, constitutes confusion in the Irish marketplace. Frankly speaking, there is nothing to see here, so I shall move along.
63. In light of the above, I find there has not been any confusion between the Applicant’s and Opponent’s marks, and that there is no likelihood of confusion arising if both marks are used on their respective goods in the Irish marketplace. Accordingly, I find the application does not offend against Section 10(2)(b) and I dismiss the opposition on this ground.

### Section 10(3)

64. Section 10(3) of the Act provides as follows:

*“A trade mark which –*

*(c) is identical with or similar to an earlier trade mark, and*

*(d) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,*

*shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.*

65. The purpose and effect of that provision is to afford an extra level of protection to marks that have a reputation over and above that which is given to other trade marks. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue; secondly, there must be a dissimilarity between the respective goods<sup>8</sup>; thirdly, the earlier mark (or marks, as in this case) must have a reputation in the State; fourthly, the use of the later trade mark must be without due cause; and fifthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

66. I have already found that the first two conditions have being met – there is a level of similarity (albeit extremely low) with the Opponent’s mark and there is the required dissimilarity or similarity (following the CJEU decision) in respect of many of the goods applied for.

67. The third condition is the Opponent’s earlier European Union Trade Mark must enjoy a reputation in EU. At the Hearing Mr Flynn argued that due to the Opponent’s European sales figures, widespread marketing throughout the EU, advertising and attendance at trade events and exhibitions, sporting event sponsorship, magazine advertisements, dissemination

---

<sup>8</sup> In the light of the ECJ decision in Case C-292/00 *Davidoff* [2003] ECR I-389, it is now more correct to say that there is not a requirement that the goods be similar (although the provision is equally applicable in the case of similar goods).

of product literature, brochures and newsletters, YouTube videos and meetings with contractors that the Opponent's mark has earned a reputation in the EU.

68. I have looked closely at this evidence, and in my opinion, it does support the Opponent's claim to a reputation in the EU. The invoices exhibited in support of claimed sales figures show actual sales to only 1 customer in Romania, 1 customer in Greece, 1 customer in Belgium and 2 customers in France.
69. There are two other invoices – one to an address in the UK and the other to an address in Malta. But neither of these two invoices relate to the sale of goods. Both mention goods at zero cost, with the total invoice amount being in respect of freight charges. It is clear to me these invoices relate to free samples, provided on the basis that the associated transport costs would be met by the recipient. Therefore, the invoices exhibited show there was actual sales to only four of the then twenty-eight EU Member States, which do not include four of the five most populated EU countries, namely Germany, the United Kingdom, Italy and Spain.
70. The evidence exhibited in respect of magazine advertising all relate to publications in the United States of America. All marketing material exhibited in respect of the EU relates solely to France. Material distributed for promotional purposes (e.g. pens bearing the THERMACOTE mark) all relate to activities in France. Sponsorship of sporting events/boats relates solely to France. The exhibited innovation pass and reaction to fire classification documents are in French. The product safety sheet exhibited is in French. The Opponent's YouTube channel is in French and the YouTube videos available on that channel are in respect of exhibitions held in France.
71. Therefore, at best the Opponent's evidence would appear to support a claim of a reputation in France. But the type of reputation that Section 10(3) seeks to protect is one that extends throughout the EU and beyond the limited class of consumers of the Opponent's goods to the extent that it penetrates the consciousness of the wider public such that a substantial number of people would know and recognise the mark even if they had never used the Opponent's goods. In my opinion, the reputation earned by the Opponent's mark falls way short of the reputation required in order to succeed under Section 10(3).
72. Having found the Opponent's mark does not possess the required reputation, I do not have to consider whether or not the Applicant had due cause to use its mark and whether use of it

would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark. But, for completeness sake, I shall do so.

73. The Applicant's mark conveys a clear message that the goods on which it is placed are from DULUX and are specifically developed to provide thermal protection. The only part of the Applicant's mark that is in dispute concerns the term THERMCOAT, that will instantly be understood by consumers as referring to a characteristic of the goods. Therefore, its function is descriptive, and on that basis, I find the Applicant has due cause to use the term.

74. No evidence or convincing argument had been adduced or advanced as to how the Applicant's use of its mark might tarnish the reputation of the Opponent's mark or undermine its capacity to identify exclusively the Opponent's goods. I have already found that there is no likelihood of confusion or association between the respective marks and that the Opponent's mark do not enjoy the reputation required. It follows that I cannot accept the Opponent's claim that the use of the Applicant's mark would result in the damage or unfair advantage that Section 10(3) seeks to avoid. Therefore, the opposition under that Section must fail also.

75. For these reasons, I have decided that the prior registration and use of the Opponent's trade mark does not constitute grounds for refusal of the application to register DULUX TRADE THERMACOAT+. Therefore, I have decided to dismiss the opposition and to allow the mark to proceed to registration.

Dermot Doyle

Acting for the Controller

18 August 2020