

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

BETWEEN

L’AIR LIQUIDE S.A.

Holder

and

CALOR GAS LIMITED

Opponent

CONCERNING

International Trade Mark No. 803334 - CALGAZ

Background

1. L’air Liquide, Société Anonyme à Directoire et Conseil de Surveillance pour l’Etude et l’Exploitation des procédés Georges Claude, of 75 quai d’Orsay, F-75321, Paris Cedex 7, France, is the Holder of International Trade Mark Registration No. 803334 in respect of the trade mark, CALGAZ, which was registered by the International Bureau of the World Intellectual Property Organisation, pursuant to the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating thereto, as of 31 March, 2003 in respect of the following goods in Classes 1 and 6:

Class 1: *Chemicals in gaseous form and particularly air gases, chemical gases, special gases and mixes thereof*

Class 6: *Containers and bottles for pressurised gases*

2. Ireland is one of the countries designated under the International Registration and, by notification dated 26 June, 2003, the International Bureau informed the

Controller of the request for extension to the State of the protection resulting from the International Registration. By virtue of Regulation 3 of the Trade Marks (Madrid Protocol) Regulations, 2001 (S.I. 346 of 2001), the Trade Marks Act, 1996 (the Act) applies to the request for protection as it applies to an application for registration under the Act.

3. The request for protection was subsequently examined in accordance with the provisions of the Act and it was accepted and advertised accordingly in Journal No. 1977 on 17 September, 2003.
4. Notice of opposition to the granting of protection to the mark pursuant to Section 43 of the Act was filed on 16 December, 2003 by Calor Gas Limited, a British company of Athena Drive, Tachbrook Park, Warwick, CV34 6RL, United Kingdom. The Holder filed a counter-statement on 3 February, 2004 and evidence was subsequently filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
5. By notification received on 10 August, 2007, the International Bureau informed the Controller of a limitation recorded in the International Register on 31 May, 2007, whereby the goods covered by the international registration were limited, insofar as Ireland was concerned, to the following:

Class 1: *Chemicals in gaseous form, namely speciality gases and mixes thereof for use in the calibration of equipment*

Class 6: *Non-refillable containers and bottles for pressurised gases used in the calibration of equipment*

6. Following the publication of that restriction in Journal No. 2080 on 5 September, 2007, the Controller wrote to the Opponent in accordance with Rule 26(i) of the Rules informing it of the restriction and directing attention to Rule 26(ii). On 5 October, 2007 the Opponent indicated that it wished to proceed with its opposition on the basis of the notice of opposition as originally filed.

7. The opposition became the subject of a hearing before me, acting for the Controller, on 24 January, 2008. The parties were notified on 29 February, 2008 that I had decided to uphold the opposition and to refuse the request for protection of the mark. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Holder in that regard pursuant to Rule 27(2) filed on 28 March, 2008.

Scope of the opposition

8. The opposition is based on the Opponent's proprietorship and claimed use of a number of trade marks consisting of or containing the word CALOR. The marks in question are listed in the notice of opposition – see Schedule 1. The Opponent claims that there is a likelihood of confusion arising from the proposed use of the Holder's mark in relation to the goods covered by the International Registration, as restricted. That objection, which is denied by the Holder, arises under Section 10(2)(b) of the Act. The notice of opposition includes further grounds of opposition but these were not pursued by the Opponent at the hearing and I am satisfied that it is not necessary for me to consider them.

The evidence filed and facts claimed

9. Evidence submitted by the Opponent under Rule 20 consisted of a Statutory Declaration (and Exhibits CLG1-CLG4) dated 28 July, 2005 of Terry Leonard, Marketing and Sales Director of Calor Teoranta, an "associate company" of the Opponent, a Statutory Declaration (undated) of James Goulding, Secretary General of the Irish Hardware and Building Materials Association and a Statutory Declaration dated 29 March, 2004 of John A. Walsh, Company Secretary of the Catering Equipment Association Limited. Evidence submitted by the Holder under Rule 21 consisted of a Statutory Declaration (and Exhibits C1-C3) dated 5 May, 2006 of Chris Street, Director, International Operations of Calgaz International, a company related to the Holder. Evidence in reply submitted by the Opponent under Rule 22 consisted of a further Statutory Declaration (and Exhibits TL1-TL4) dated 30 January, 2007 of the aforementioned Terry Leonard.
10. I would summarise the relevant facts averred to in the evidence as follows. The Opponent's trade mark CALOR has been used in the State since as early as 1936

in relation to liquefied petroleum gas for domestic, industrial, catering, horticultural, agricultural, automotive and leisure use and also in relation to gas appliances and equipment. In the period 1980-2004 sales of products in the State under the trade mark CALOR amounted to approximately €1.5billion, 90% of which related to sales of gas, and the amount spent on advertising those products during that period was approximately €2million. Advertising has taken place via the print media - local and national newspapers as well as trade and commercial journals - and on radio and television and via the distribution of various promotional items. There has also been sponsorship of television programmes including “Calor Housewife of the Year” and “Jenny Bristow’s Cook with Calor”.

11. The Holder has been selling chemicals in gaseous form, particularly air gases, chemical gases, special gases and mixes thereof, in the State under the trade mark CALGAZ since at least 1999. In the period 1999-2004 turnover under the mark amounted to approximately €135,000. The Holder supplies non-refillable cylinders and associated equipment, such as regulators and carrying cases, to the industrial hygiene and safety market and is the recognised global leader for calibration gas mixtures and related equipment. Its trade mark CALGAZ is protected in the United Kingdom, where it co-exists on the Register with the trade marks CALOR and CALOR AUTOGAS.

The hearing and arguments of the parties

12. At the hearing the Opponent was represented by Brian O’Moore, SC instructed by F.R. Kelly & Co., Trade Mark Agents and the Holder by Cliff Kennedy, Trade Mark Agent of MacLachlan & Donaldson.
13. In support of the opposition, Mr. O’Moore relied heavily on the fact, as he claimed, that the Opponent’s trade mark CALOR had become very well known in the State through long and extensive use. CALOR gas has, he claimed, become firmly established in the national consciousness in the same way as iconic brands such as TAYTO crisps and GUINNESS stout. It is, therefore, entitled to a wide measure of protection as against the use of similar trade marks. The Holder’s trade mark CALGAZ combines the distinctive element, CAL, which is evocative

of CALOR, with a descriptive element, GAZ, which simply refers to the nature of the relevant goods, i.e., gas and containers for gas. It is significant that the similarity between CALOR and CALGAZ is in their opening parts, which are generally seen as more significant in terms of the overall impressions formed by words. Although the Opponent's reputation has been built up primarily in relation to liquefied petroleum gas for use in heating and cooking, nevertheless, the specific goods covered by the Holder's International Registration, as restricted, fall within those for which CALOR is protected. It is reasonable to suggest, therefore, that consumers would assume a connection between CALGAZ gas products and the producer of the well-known CALOR gas.

14. Mr. Kennedy responded to the effect that there are clear and unmistakeable differences between the trade marks CALGAZ and CALOR, which, combined with the differences between the goods of specific interest to the respective parties, would make confusion highly unlikely. CALGAZ is derived from the term "*calibration gas*", reflecting the nature of the specialised goods for which the Holder seeks protection of the mark. Those goods are addressed to specialist equipment manufacturers and not to the members of the general public who are the Opponent's customers. The Opponent's trade mark CALOR is the Latin word for heat or warmth, again reflecting the specific nature of the goods sold under that mark. Mr. Kennedy denied that the evidence furnished by the Opponent supported its claims with regard to the widespread notoriety of the trade marks CALOR or CALOR GAS. In fact, the Opponent's evidence suggested that the trade mark it has made most use of is CALOR KOSANGAS, which is clearly distinguishable from CALGAZ.
15. Mr. Kennedy also criticised errors contained in the notice of opposition, which referred to the Holder's request for protection of its mark in relation to services rather than goods. He also asserted that certain of the evidence filed by the Opponent under Rule 22 was not confined to matters strictly in reply and should, therefore, be treated as inadmissible. As regards the first of these matters, I indicated at the hearing that I saw fit to overlook the errors in question, which did not materially affect the thrust of the notice of opposition, i.e. that the request for protection was opposed because of the existence of specified earlier conflicting

marks. As to the disputed elements of the Rule 22 evidence, Mr. O'Moore did not rely on them in any significant way in presenting the Opponent's case and I have not had to rely on them at all in deciding the matter so that I do not think it necessary to make a separate ruling as to their admissibility.

Grounds of decision

16. The relevant parts of Section 10 of the Act read 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
..... 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.*

17. In *Cofresco Frischalteprodukte GmbH & Co. KG –v- The Controller of Patents, Designs and Trade Marks and Reynolds Metals Company*¹, the High Court (Finlay Geoghegan J) endorsed previous pronouncements of the European Court of Justice as to the principles of interpretation to be applied in assessing the likelihood of confusion between trade marks. In summary, those principles are that –

- (i) the likelihood of confusion must be appreciated globally, having regard to all of the relevant factors, including the degree of similarity between the marks and between the goods, the likelihood that the public will make an association between the earlier mark and the mark seeking registration, and the distinctiveness of the earlier mark;
- (ii) the similarity between the marks must be determined by reference to the degree of visual, aural and conceptual similarity between them and the importance to be attached to each of these elements must be assessed by

¹ unreported decision dated 14 June, 2007

reference to the category of goods and the circumstances in which they are marketed;

- (iii) the assessment must be made from the perspective of the average consumer of the goods in question, who must be deemed to be reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely, instead, on the imperfect picture of them that he keeps in his mind;
- (iv) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components, because the average consumer normally perceives a mark as a whole and does not analyse its various details;
- (v) the higher the distinctiveness of the earlier mark, whether inherent or acquired through use, the greater the protection granted to it, and vice versa.

The comparison of the trade marks

18. While the Opponent has cited several trade marks in its notice of opposition, I find it sufficient for present purposes to consider only the trade mark CALOR, which is registered in respect of goods in both Class 1² and Class 6³, which are the same classes in which the Holder seeks protection of CALGAZ. On a visual comparison, those marks may be said to be somewhat similar because of the shared character string, C-A-L and the fact that it appears at the start of each word and therefore makes more of an impression on the eye. They also sound somewhat alike because of the shared first syllable, which, again, is more significant in terms of the overall aural impact of each word⁴. [I should say that, in assessing the aural similarities of the marks, I have considered what I regard to be the ordinary pronunciation of the Opponent's trade mark CALOR, i.e., having

² under No. 79498 dated 19 November, 1971

³ under No. 110250 dated 14 December, 1981

a short-sounding termination as opposed to *CAL-ORE*, as it was pronounced by Mr. Kennedy at the hearing. In my view, that is not the natural pronunciation of CALOR and there is no evidence to suggest that it would be pronounced in that way by the average person in this jurisdiction.] The visual and aural similarities between the trade marks are offset to a considerable degree by the differences arising from their different terminations so that, on an overall assessment, I would say that they are visually and aurally similar but not highly similar.

19. Conceptually, neither mark expresses an intelligible concept that would be immediately and intuitively understood by the average consumer. While “calor” is a Latin word and is to be found in modern languages in the same or similar form (*calor* in Spanish, *calore* in Italian, *chaleur* in French), nevertheless, there is no evidence to suggest that the average consumer in this jurisdiction understands its meaning and, in the circumstances, I think it is correct to treat the trade mark CALOR as an invented and meaningless word for the purposes of these proceedings. As to CALGAZ, I agree with the submissions of both parties at the hearing to the effect that, in the context of the goods under consideration, the GAZ element of that trade mark would be understood by the average person as referring to “gas”. I do not accept the Holder’s contention that CAL will be seen as an abbreviation of “calibration”, even in the context of the use of CALGAZ in relation to calibration gases and related equipment. As far as I am aware (and no evidence has been given to the contrary), CAL is not an established abbreviation of “calibration” as, for example, MAX is of “maximum”, BIO of “biological”, PRO of “professional”, etc. I take the view, accordingly, that the immediate conceptual impact of the trade mark CALGAZ used in relation to gas products would be of CAL (meaningless) GAZ (signifying gas); put another way, CALGAZ means “CAL gas” or “gas named CAL”. In terms of the conceptual comparison of the marks CALOR and CALGAZ, I think there is force in the Opponent’s contention that the CAL element of CALGAZ, though meaningless in itself, is evocative to some extent of CALOR, in the sense that it would cause the average person who knows the name CALOR to be reminded of it.

⁴ as noted by the High Court (Smyth J) in *Unilver PLC –v- The Controller of Patents, Designs and Trade Marks and Sunrider Corporation*, unreported decision dated 13 December, 2006

The comparison of the goods

20. The Opponent's earlier trade mark CALOR is registered in respect of *gas and gas preparations included in Class 1 for use in industry, science, photography, agriculture, horticulture and forestry and containers of common metal for gas and parts and fittings therefor included in Class 6*. The Holder's International Registration, as restricted, is in respect of *chemicals in gaseous form, namely speciality gases and mixes thereof for use in the calibration of equipment and non-refillable containers and bottles for pressurised gases used in the calibration of equipment*. The latter goods are clearly a subset of the former so that, for present purposes, it may be said that the goods in respect of which the Holder seeks protection of its trade mark are identical to those for which the Opponent's earlier trade mark is protected.
21. Even allowing for the fact, as shown by the Opponent's evidence, that the great majority of its trade under the trade mark CALOR has been in relation to liquefied petroleum gas, which has a different purpose to calibration gases, nevertheless those goods are similar to each other in the sense that they would be expected to be produced by the same kind of commercial undertaking, i.e., a manufacturer of pressurised gases. I regard that finding as consistent with the principle enunciated by the European Court of Justice in Case No. C-39/97 *Canon Kabushiki Kaisha – v- Metro-Goldwyn-Mayer Inc.* to the effect that “*there may be a likelihood of confusion ... even where the public perception is that the goods or services have different places of production; by contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings*”. There can be little doubt but that consumers might believe that a single undertaking was engaged in the manufacture of both bottled liquefied petroleum gas and bottled gases for use in the calibration of equipment as one assumes that the technology, plant and equipment required for the production of those goods would be the same or highly similar. For that reason, the respective goods must be regarded as similar for the purposes of the assessment of likelihood of confusion, notwithstanding their different uses.

The distinctiveness of the earlier trade mark

22. Having found that CALOR would be perceived as a meaningless, invented word by the average consumer in this jurisdiction, it follows that I regard it as an inherently distinctive trade mark for the goods in respect of which it stands protected. In addition, I am prepared to accept that the evidence filed by the Opponent establishes, on the balance of probabilities, that the name has acquired a factual distinctiveness in the mind of the average consumer such that it is firmly associated with the Opponent's goods and none other. The Opponent's evidence was criticised at the hearing by Mr. Kennedy for the Holder on the basis that it was vague as to which of its various registered trade marks was actually used in relation to its products and that several of the exhibits purportedly showing use of its trade marks did not demonstrate actual use on the products in question or did not date from the relevant period, i.e., prior to the registration date of the Holder's mark. In my opinion, those criticisms do not serve to dislodge the basic facts shown by the Opponent's evidence, which are that it has traded in the jurisdiction in gas products under the trade mark CALOR and marks incorporating that word for some 70 years and that the sales and promotion of those products has been on a truly massive scale. The probable effect of the longevity and scale of the Opponent's trading, which have not been disputed by the Holder, is that consumers here have been exposed to the Opponent's goods and trade marks on a sufficiently frequent basis and over a prolonged period of time to suggest that they are very familiar with those goods and trade marks. I find, therefore, that the Opponent's earlier trade mark CALOR enjoys a high degree of distinctiveness and I propose to treat it accordingly in the assessment of the likelihood of confusion.

The average consumer and the circumstances of product selection

23. The specific goods under consideration are those in respect of which the Holder seeks protection, namely containers of gas and gas mixtures for use in the calibration of equipment. Those goods are in the nature of component parts of complex products and the "consumers" of them would be the manufacturers of those complex products. Those persons constitute a specialised class of consumers as against the average "man in the street" and the likelihood of confusion must be assessed from the perspective of the average member of that specialised group. In selecting products of the kind under consideration, one may

assume that the average consumer in question would have regard, primarily, to considerations of quality, suitability and reliability as well as cost, with the overriding concern being the acquisition of a component part that will enhance the performance of the purchaser's complex product, thereby increasing its value and building brand value in that product. Trade marks would be likely to play an important role in the selection process of the relevant consumer as he is more likely than not to source goods from a brand that he associates with a high degree of technical quality and performance. The importance to the average consumer of choosing a suitable product for his purposes is likely to cause him to exercise a higher degree of care in making his selection than would be the case, for example, in relation to everyday consumer goods.

Likelihood of confusion, including confusion by association

24. In light of the foregoing analysis, I would summarise the question to be decided in the following terms. *Is it likely that the average purchaser of the Holder's goods, i.e., containers of gas and gas mixtures for use in the calibration of equipment, who may be assumed to be familiar with the trade mark CALOR used in relation to liquid petroleum gas, would, on encountering the former goods offered for sale under the trade mark CALGAZ, assume that those goods emanated from the makers of CALOR gas or from an economically linked undertaking?* Having regard to the various factors outlined above, I have come to the conclusion that that question may be answered in the affirmative. In my opinion, this is a case in which the principle enunciated by the European Court of Justice in Case No. C251/95, *Sabel BV –v- Puma AG and Rudolf Dassler Sport*, and mentioned in paragraph 17(v) above, to the effect that the more distinctive the earlier mark, the greater will be the likelihood of confusion, is decisive in tipping the scales in the Opponent's favour. I take the view that the degree of recognition of the Opponent's trade mark CALOR among consumers generally is such that the average consumer of the goods of present interest would be caused to recall that mark on encountering those goods marketed under the name CALGAZ. What is more, I consider it likely that, having recalled the CALOR trade mark, the average consumer would be likely to assume that CALGAZ gas products were connected to CALOR gas products, in the sense that they were put on the market by the same or a related undertaking. The likelihood of that assumption follows from the

combination of the facts that CALOR gas is so widely known and that CALGAZ creates an immediate conceptual impression of “CAL gas”. The result is that it would appear unlikely to the average consumer, on first impression, that the two were unconnected. Rather, a reasonable assumption would be that CALGAZ calibration gas products were a specialised line of products from the suppliers of the well-known CALOR gas. It may be argued that persons falling under that misapprehension may, in some cases, become disabused of it in the course of the detailed examination that the average consumer of the goods under consideration here may be expected to undertake. However, there is a real likelihood that the initial misleading impression given by the name CALGAZ will be relied upon by the average consumer as indicating a connection with the Opponent. Given the extent and longevity of the Opponent’s trading in gas and gas products under the trade mark CALOR, it is to be assumed that consumers would associate that name and, by extension, the Opponent with the characteristics of quality and reliability. Those are the very characteristics that the average consumer of the goods covered by the International Registration under consideration is apt to place most importance on in his purchasing selection. In the circumstances, it seems to me that there is a sufficient likelihood of confusion within the meaning of Section 10(2) of the Act to warrant refusal of the request for protection of the Holder’s trade mark.


Tim Cleary

Acting for the Controller

2 April, 2008

Trade Marks referred to in Notice of Opposition

No.	Mark	Date	Class/Goods
41510	CALOR	27/02/1946	Class 4: Liquefied fuel gas Class 11: All gas appliances and fittings included in Class 11
79460	CALOR KOSANGAS	19/11/1971	Class 1: Gas and gas preparations included in Class 1 for use in industry, science, photography, agriculture, horticulture and forestry
79461	CALOR KOSANGAS	19/11/1971	Class 4: Combustible gases for use with or in lighting, heating, steam generating, cooking and refrigerating apparatus and for similar purposes
79498	CALOR	19/11/1971	Class 1: Gas and gas preparations included in Class 1 for use in industry, science, photography, agriculture, horticulture and forestry
81755	CALOR KOSANGAS	19/11/1971	Class 11: Gas consuming installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes and parts and fittings included in Class 11 for the aforementioned goods

90380 ⁵	CALOR AUTOBLEND	25/09/1975	Class 4: Fuel gas in liquid form for use in engines
90381	CALOR KOSANGAS AUTOBLEND	17/11/1975	Class 4: Fuel gas in liquid form for use in engines
99005	CALOR CAR GAS	07/10/1980	Class 4: Liquefied petroleum car gas
110249	CALOR KOSANGAS	14/12/1981	Class 6: Containers of common metal for gas, and parts and fittings therefor included in Class 6
110250	CALOR	14/12/1981	Class 6: Containers of common metal for gas, and parts and fittings therefor included in Class 6
218532 ⁶		20/07/2000	Class 4: Fuel; fuel gases; liquefied fuel gases Class 6: Containers for gas; valves; parts and fittings therefor
219938	CALOR GAS DIRECT (figurative, series of 2,)	15/11/2000	Class 25: T-shirts, polo shirts, jumpers, jackets, body warmers, coats, rain jackets, baseball caps, aprons and headbands; all for promotional use.

⁵ mark removed from Register on 31/10/2007 for non-payment of renewal fee

⁶ 3-dimensional mark

			<p>Class 37: Installation, maintenance, servicing and repair of gas containers and of gas supply, gas powered, gas operated and gas utilising apparatus, installations and equipment and parts and fittings therefor.</p> <p>Class 39: Transportation and distribution of gas.</p> <p>Class 42: Safety testing of gas containers and of gas supply, gas powered, gas operated and gas utilising apparatus, installations, equipment and parts and fittings thereof.</p>
220838	CALOR PATIO GAS (figurative, series of 2)	20/07/2000	<p>Class 4: Fuel; fuel gases; liquefied fuel gases.</p> <p>Class 6: Containers for gas; valves; parts and fittings therefor included in Class 6.</p>
229737	CALOR GAS	22/11/2002	<p>Class 1: Gases and gas mixtures; liquefied gases; aerosol propellants.</p> <p>Class 4: Fuels; fuel gases; liquefied fuel gases.</p> <p>Class 6: Containers for gas; valves; parts and fittings therefor.</p> <p>Class 11: Gas powered and gas utilising apparatus, equipment and installations; apparatus and installations for lighting, refrigerating, cooling and air conditioning, all being gas operated; gas pressure regulators and gas valves; parts and fittings for all the aforesaid goods.</p> <p>Class 37: Installation, maintenance, servicing and repair of gas containers and of gas supply, gas powered, gas operated and gas utilising apparatus, installations and equipment and parts and fittings therefor.</p> <p>Class 39: Transportation and</p>

distribution of gas.

Class 42: Safety testing of gas containers and of gas powered, gas operated and gas utilising apparatus, installations equipment and parts and fittings therefor.

1758549⁷

CALOR

05/07/2000

as for 229737 but also including Class 36: Insurance services

1762004⁸



11/07/2000

as for 1758549

⁷ Community Trade Mark

⁸ Community Trade Mark