

O-310-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2338980
BY METRIX ELECTRONICS LIMITED
TO REGISTER A TRADE MARK IN CLASS 9**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 92227 BY CHAUVIN ARNOUX**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2338980
by Metrix Electronics Limited to register a
Trade Mark in Class 9**

and

**IN THE MATTER OF Opposition thereto under
No. 92227 by Chauvin Arnoux**

BACKGROUND

1. On 26 July 2003 Metrix Electronics Limited applied to register the following trade mark:



in Class 9 of the Register for a specification of:

“Digital multimeters; analogue multimeters; air/humidity testers; airflow testers; oscilloscopes analogue and digital; clamp meters analogue and digital; power meters; panel meters analogue and digital; voltage detectors analogue and digital; thermometers; satellite field strength meters; function generators; frequency counters.”

2. The application was subsequently published in the Trade Marks Journal and on 19 December 2003 Chauvin Arnoux filed a Notice of Opposition under Section 5(2)(b) of the Act on the ground that the mark applied for is similar to the following earlier trade mark owned by the opponent which covers identical and similar goods and there exists a likelihood of confusion on the part of the public:

INTERNATIONAL TRADE MARK	MARK	EFFECTIVE DATE	SPECIFICATION OF GOODS
No 797522	MULTIMETRIX	15 January 2003	Class 9: Scientific, surveying, electric (including by wireless telegraphy), photographic, cinematographic, optic, weighing, measuring, signalling, monitoring, rescue and

			teaching apparatus and instruments; coin or token-operated automatic apparatus; speaking machines, cash registers, calculators; fire extinguishers; but not including apparatus, instruments or equipment for providing, maintaining, validating and identifying security features on items nor including optical apparatus, instruments, devices and elements.
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3. The applicant filed its Counterstatement denying the grounds of opposition stating that it and its predecessor in title had used the mark METRIX since 1995 and that it had already registered “METRIX ELECTRONICS PLC” in Class 9 under No. 2043960 dated 8 November 1995.

4. Both parties have filed evidence and ask for an award of costs in their favour. They are content for a decision to be taken without recourse to a hearing and neither party has forwarded written submission in this case.

EVIDENCE

Opponent’s Evidence

5. The opponent’s evidence consists of a declaration by Axel Arnoux dated 30 September 2004. Mr Arnoux is the General Manager of Chauvin Arnoux, the opponent company.

6. Mr Arnoux provides a history of his company which was founded in France in 1893 and he explains that in 1997 his company acquired by order of the “Tribunal de Grande Instance (Court of First Instance) of Annecy the business assets of the French company SA METRIX in receivership. At Exhibit AA2 to Mr Arnoux’s declaration is a copy of the agreement between the Official Receiver and his company, together with a translation into the English language. Mr Arnoux noted that this specifically included the assets of SA METRIX, notably the METRIX brand names in France and abroad free from security.

7. Referring to the prior history of SA METRIX, Mr Arnoux states that in about 1964 it was sold to the US corporation ITT who owned the business up to 1994 and was active selling throughout the world, including the UK., under a stylised trade mark METRIX, a range of “electric test and measurement apparatus” including in particular

‘digital multimeters, analogue multimeters, analogue oscilloscopes, champmeters, power meters, function generators, volt meters, ohmmeters, ammeters’.
 Accompanying his Declaration, as Exhibit AA3, is a bundle of brochures and leaflets issued by ITT to illustrate the range or products in respect of which they used the mark ‘metrix’ from 1983 to 1994.

8. Mr Arnoux understands that in 1994 ITT sold SA METRIX to the French company ‘General Electronic Measures’, a division of ‘Group GMME’ a subsidiary of which is the French company SEFRAM. He also understands that in 1995 ‘Group GMME’, in collaboration with the English company ‘Robin Electronics Limited’, established the English company ‘Metrix Electronics Plc’ (now known as ‘Metric Electronics Limited’, the applicant in the proceedings in suit, to act as distributor in the United Kingdom of the ‘metrix’ branded products manufactured by SA METRIX in addition to products manufactured by other ‘Group GMME’ companies such as SEFRAM. He believes that at no time since their incorporation in 1995 have Metrix Electronics themselves manufactured, or obtained from a manufacturer other than SA METRIX, products to which they themselves have applied, or caused to have applied, the trade mark ‘metrix’, metrix electronics’ or ‘metrix electronics plc’. Mr Arnoux states that the products supplied to them by SA METRIX during the years 1995 to 1997 came ready branded with ‘metrix’ for them simply to supply to UK customers.

9. Mr Arnoux goes on to state that when his company acquired intangible assets of SA METRIX in July 1997 the supply of ‘metrix’ branded products to Metrix Electronics ceased. Instead the ‘metrix’ branded products of SA METRIX were supplied to ‘Chauvin Arnoux UK Limited’ (hereinafter referred to as ‘CA UK’), the wholly-owned subsidiary of his company, incorporated in March 1986 to distribute the products of his company in the UK. ‘CA UK’ have exclusively distributed the ‘metrix’ branded products of SA METRIX in the UK from around July 1997 continuously up to the present date. Mr Arnoux confirms that, the ‘metrix’ branded products are essentially ‘electrical test and measurement apparatus’ and include ‘analogue and/or digital multimeters, multimeter clamps, analogue and/or digital oscilloscopes, power meters, function generators, ammeters, voltmeters’.

10. Mr Arnoux states that the retail value of the ‘metrix’ branded products sold by ‘CA UK’ in the United Kingdom during the years 1997 to 2003 are as follows:

YEAR	TURNOVER BY RETAIL VALUE (£'s)
1997	160,812.00
1998	590,217.00
1999	346,648.00
2000	566,976.00
2001	607,332.00
2002	414,335.00
2003	261,410.00
TOTAL (7 years)	2,947,730.00

11. Turning to the budget for promoting and advertising the ‘metrix’ branded products in the UK Mr Arnoux declares it to be approximately 1½% to 2½% of annual turnover. Consequently, he estimates that since July 1997 some £45,000 to

£60,000 has been spent on promotion and advertising in the UK. Furthermore, the 'metrix' brand is used on the website (<http://www.chauvin-arnoux.com>) and is applied directly to the products and is also used on their packing and labels, as well as being used on stationery and invoices and appears in brochures, leaflets and other such material promoting the products. At Exhibit AA4 to Mr Arnoux's declaration is a bundle of material consisting of copies of press and magazine reviews and releases for the years 1999 and 2000 regarding the availability of 'metrix' branded products in the UK. Furthermore, at Exhibit AA5 is a selection of pages from the website of his company to illustrate a selection of 'metrix' products.

12. Next, Mr Arnoux declares that his company is the holder of International Trade Mark Registration No. 343002 for the stylised mark 'metrix' in respect of goods and services in Classes 9, 14, 35, 37, 38 and 42. That registration does not designate the United Kingdom but was first registered on 8 March 1968 to 'Compagnie Générale De Métrologie' of Annecy. Its assignment to 'Societe des Produits Industriels ITT' was registered on 8 September 1972. A change of name of that owner to 'ITT Composants et Instruments' was recorded on 9 June 1980. Subsequently, its ownership was assigned to 'Metrix' recorded on 20 March 1995. On the 4 March 1998 its assignment to its current owner 'Chauvin Arnoux' (his company) was recorded. He also draws attention to the registration of METRIX (stylised) in France, which was filed in 1947.

13. Mr Arnoux concludes by stating that since the beginning of 2003 his company has been developing and producing under the brand MULTIMETRIX a range of products similar to the METRIX products range.

Applicant's Evidence

14. The applicant's evidence consists of a statutory declaration by Peter Rummer dated 7 January 2005 and a witness statement by Sally Ann Schupke dated 5 January 2005.

15. Mr Rummer is the Managing Director of Metrix Electronics Limited, the applicant company.

16. Mr Rummer begins his Declaration by setting out the history of the company MEP, its associations and parent companies. It starts in 1995 when, Mr Rummer states, MEP/GMME opened a distribution sales office in Kingswinford in the West Midlands with new staff and a Project Sales Office within the Robin Electronics Ltd Offices in Watford. [Exhibit "PR2" to Mr Rummer's declaration is the announcement published in the weekly journal Electronics Times, dated 15 February 1996.] He adds that Metrix Electronics Plc filed a trade mark application for its name in respect of a list of Class 9 products on 8 November 1995. It was registered on the 27 September 1996 under No. 2043960. [Details are shown in the Exhibit "PR3" attached to the declaration.]

17. Mr Rummer explains that MEP was responsible for sales, marketing and after sales support of all GMME group measurements products in the UK and Irish markets. In addition, they were free to independently source products – particularly for major distributor customers (such as RS Components and Farnell) and major

project sales (including the Ministry of Defence). Group products were initially sourced from Metrix and Sefram in France, Mueller & Weigert, Neuberger and Elditest in Germany, and B&K Precision in the USA. [Attached as Exhibit “PR4” to Mr Rummer’s declaration is the GMME history and group organisation for a Press Conference dated 13 June 1997.] He adds that most of these independently sourced products were specially branded for MEP and many were, and continue to be, branded “2Metrix Electronics”. [Attached as Exhibits “PR5” are photos and operating manual covers for the example models: MX 4900 installation tester, GX 5000 pulse generator, and MX 67 circuit tester.]

18. Mr Rummer goes on to state that this broad activity continued until 1997, when the Metrix division of GMME in France went into administration and was sold by the receiver to Chauvin Arnoux – a French organisation. This became effective in July 1997. At that time, and after meetings in the UK with Chauvin Arnoux, MEP ceased to sell the Metrix products that had transferred to Chauvin Arnoux and referred all customer enquiries to the UK office of Chauvin Arnoux.

19. Mr Rummer explains that during 1999 the shareholders of Robin Electronics completed negotiations to sell their company and Watford offices to the Danaher Corporation of the USA to be integrated with their subsidiary Fluke. To facilitate a ‘clean sale’, the MEP Kingswinford sales office was closed, its staff made redundant and the 50% Robin Electronics shareholding in Metrix Electronics Plc was converted to personal shareholdings of the Robin Electronics’ shareholders. At this time GMME also revaluated their UK shareholding in MEP. It was subsequently decided by all the shareholders that, MEP would cease trading and that Mr Rummer should form Metrix Electronics Limited (MEL) and take on the residual business in the UK and Irish markets. MEL commenced trading on 1 October 1999 from the Robin Electronics Ltd offices in Watford, and then relocated during November 1999 to offices in Basingstoke.

21. Turning to the declaration of Mr Arnoux, Mr Rummer points out that as Mr Arnoux states in his paragraph (5) of his declaration dated 30 September 2004, Metrix is a long established French company that the ITT Corporation acquired. In his experience, since 1986, the products from Metrix in France were generally dual branded “metrix” and “ITT INSTRUMENTS”. However, he states that this ceased in about 1994, following the sale by ITT of Metrix in France to GMME. With reference to Mr Arnoux’s paragraph (6) of his declaration dated 30 September 2004, Mr Rummer states that there are two errors, the second of which is significant:

- a. There is a typographical error in line 5: (now known as ‘Metric ...’). Should be (now known as ‘Metrix ...’).
- b. Mr Arnoux is wrong in his belief, starting on line 8, that at no time since their incorporation in 1995 have Metrix Electronics themselves manufactured, or obtained from a manufacturer other than SA METRIX, products to which they themselves have applied, or caused to have applied, the trade mark ‘metrix’, ‘metrix electronics’ or ‘metrix electronics plc’. In fact, significant sales of products under the subject mark “Metrix Electronics” have been made in the United Kingdom as

shown in the sales turnover figures produced with this declaration.
[See Exhibit “PR6”.]”

22. With regard to Mr Arnoux’s paragraph (9) in his declaration dated 30 September 2004, Mr Rummer notes that Chauvin Arnoux describe their sales as “turnover by retail value” – which he considered to be misleading. Mr Rummer believes that much of their business would be through wholesalers and distributors, from which he concludes that their “retail sales” value is calculated at end-user prices, and not the wholesaler or distributor purchase prices. As typical wholesaler and distributor discounts for this type of product in the UK market average around 35%. He estimates that the actual Chauvin Arnoux invoiced sales values have been enhanced by around 50% to reach the stated “retail values”. Therefore in his Exhibit “PR6” Mr Rummer had included, for comparison, “equivalent retail values” for the actual MEP and MEL turnover values – based on average resale discounts from list prices.

23. Mr Rummer states that his company’s customers are geographically spread throughout the UK and Ireland. They include the largest electrical and electronic industry distributors (RS Components and Farnell In One); many branches of electrical wholesalers; specialist industrial distributors; the Ministry of Defence and numerous direct customers in the electrical, electronic, educational, industrial control, process control, pharmaceutical, laboratory, service and maintenance market sectors.

24. Mr Rummer declares that over the last eight years the total promotional expenditure of MEP and MEL is around £177,400, based on actual management accounts. He confirms that when MEP commenced promotional and advertising activities in 1996 the expenditure was £88,500 for the year, as it was important to make customers aware of the new company name. He adds that the promotional activities of MEP and MEL have included: advertising and press promotions in trade journals; exhibitions; mail shots; e-mail shots; producing, maintaining and promoting a website; and the like. In recent years his company has focused its promotion into regular space adverts in trade journals; targeted direct mail and-mail product promotions; promotional gifts; and the development and further promotion of its website. Attached at Exhibit “PR7” are samples of some of this promotional material.

25. Mr Rummer states that his company registered its website domain name www.metrix-electronics.com on the 8 November 1999. The web pages were developed and went live in June 2000. The stylised “Metrix Electronics” Logo (the subject of this Trade Mark Application) was developed as part of the initial web page creation and was first used in June 2000. Also contained in the Exhibit marked “PR7”, are sample advertisements and an archive printout of their web page at 30 March 2001 showing use of the subject mark.

26. Mr Rummer states that the Exhibits shows that his company has been trading since 1995 initially under the name Metrix Electronics Plc and then the assets including goodwill and name transferred to him in September 1999. At that time he formed the Limited Company Metrix Electronics Limited, and although his company owned the Registered Trade Mark No. 2043960 “Metrix Electronics Plc” (words), it was no longer really suitable as there had been a name change from “plc” to “Limited”. He explains that while this is a minor difference from the public point of

view, it was felt that it would be good to develop the name “Metrix Electronics” into a stylised form, which is the subject of this application.

27. Mr Rummer is aware of the activities of the opponent but, from Mr Arnoux’s Declaration of 30 September 2004, he does not believe that their activities in the UK are extensive to such a degree that customers seeing the subject mark would be confused.

28. Turning to International Registration No. 343002, Mr Rummer states that this does not cover the UK and, therefore, can be disregarded. He also notes that they hold a French Trade Mark Registration No. 1344752 and states this can be disregarded as it does not cover any part of the territory of the United Kingdom of Great Britain and Northern Ireland.

29. Turning to some of Mr Arnoux’s exhibits marked “AA3” and “AA4”, Mr Rummer notes that some of the brochures and leaflets are in French which would not be easily understood by UK customers if these particular examples are intended to show that they were distributed to potential British consumers. Therefore he concludes that all the exhibits by Mr Arnoux have limited value as evidence as they are undated. For example, the copies of materials provided under exhibit “AA5” all appear to be dated 2004.

30. Finally Mr Rummer submits that, in view of his company’s past use, reputation and goodwill under the name “Metrix Electronics”, his company is entitled to registration in the UK of the subject application.

31. Ms Schupke is a trade mark agent employed by Chancery Trade Marks, the agents representing the applicant in these proceedings.

32. Ms Schupke states that the applicant has provided her with three names and addresses of firms that would know and recognise the mark in suit and confirm use of this mark by the applicant, these being:

Joseph Gleave & Son Limited of Manchester;

Amplicon Liveline Limited of Brighton; and

L C Automation Limited of Preston.

33. Ms Schupke attaches as Exhibit SAS 1 to her statement, copies of three letters received in reply from the companies listed above, all of whom recognise the mark in suit as belonging to the applicant company.

Opponent’s Evidence in Reply

34. The opponent’s evidence in reply consists of a witness statement by Alastair Rawlence dated 4 July 2005. Mr Rawlence is a trade mark attorney at Mewburn Ellis LLP, the opponent’s representatives in these proceedings.

35. Mr Rawlence refers to that part of Mr Rummer's declaration where it is stated that:

'.... I purchased the assets and goodwill – including the Metrix Electronics – name from Watford Liquidation'. Furthermore, the evidence attached as Exhibit PR1 to Mr Rummer's Statutory Declaration states, at Clause 5 'Watford will sell to Metrix for, the whole of its Goodwill, together with all fixed and current assets'. Furthermore, at Clause 6, the aforementioned Exhibit PR1 states 'Goodwill will comprise the former name of Watford

Mr Rawlence concludes that it is apparent from these statements that the acquired 'Goodwill' in this transaction related to the company name Metrix Electronics Plc and it appears that no trade marks were assigned with the transaction and in particular, the trade mark METRIX ELECTRONICS PLC of UK Registration No. 2338980.

36. Mr Rawlence goes on to refer to Exhibit AJR1 to his statement which consists of copies of extracts downloaded from Company's House website. He states that from these extracts the following points are clear:

“(i) Metrix Electronics Plc changed its name to Watford Liquidations Plc on 22 September 2002. Watford Liquidations Plc was dissolved on 19 June 2001.

(ii) Metrix Electronics Limited was incorporated on 22 September 2002.”

37. Mr Rawlence states that in item 1 of his Statutory Declaration, Peter Rummer states 'I have purchased the assets in goodwill – including the Metrix Electronics name – from Watford Liquidations Plc.'

38. Next, Mr Rawlence refers to references in Item 6 of the exhibit marked PR1 of the Statutory Declaration of Peter Rummer which states '*goodwill will comprise the former name of Watford*'. As we have seen from the attached Exhibit AJR1, the former name of Watford was of course, Metrix Electronics Plc. Mr Rawlence contends that if any rights were indeed acquired by Metrix Electronics Limited, it was 'unregistered rights' in the name Metrix Electronics Plc and not rights in the registered trade mark of UK Registration No. 2043960. Indeed, the lack of a suitable assignment of UK Registration No 2043960 from the original registered proprietor, Metrix Electronics Plc up to Metrix Electronics Limited is apparent from the historical details of the registration which are captured on the UK Patent Office website and which are presented for convenience as Exhibit AJR2 to Mr Rawlence's Witness statement. Mr Rawlence concludes that all there had been (a) no change of company name from Metrix Electronics Plc to Metrix Electronics Limited and (b) no obvious assignment of UK Registration No. 2043960 up to Metrix Electronics Limited, such that the latter company are clearly incorrectly entered as the registered proprietor of this registration and there is doubt as to whether they actually took an assignment of the registration in the first place.

39. Mr Rawlence states that Metrix Electronics Limited's use of the mark METRIX ELECTRONICS PLC of UK Registration No. 2043960 must be put in doubt as one in any event cannot possibly conceive of a situation whereby a limited company could

legitimately use a trade mark consisting of the name of a PLC. He adds that the mark METRIX ELECTRONICS PLC therefore cannot have been legitimately used by Metrix Electroncis Limited and the registration is arguably invalid as of either (a) 19 June 2001- the date of dissolution of Watford Liquidations Plc or (b) 22 September 1999 being the date Metrix Electronics Plc changed its name to Watford Liquidations Plc. Mr Rawlence submits that Registration No. 2043960 is not relevant to these proceedings.

40. This completes my summary of the evidence filed in this case. I turn now to the decision.

DECISION

41. Section 5(2) of the Act reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

42. An earlier right is defined in Section 6, the relevant parts state:

6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

43. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] 1999 E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & C. GmbH v. Klijsen Handel B.V.*;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (h) further, 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; *Marca Mode CV v. Adidas AG*;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*

44. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the earlier mark at issue and widen the penumbra of protection of the mark. The opponent has submitted evidence relating to goodwill and/or reputation. However, this largely relates to the mark METRIX which is a different mark to that cited in these proceedings and is accordingly not relevant to these proceedings. While the opponent claims use of the mark MULTIMETRIX since early 2003 (around six months prior to the relevant date for these proceedings), there is no evidence filed to demonstrate such use and therefore, I do not intend to give this claim weight.

45. The applicant has pointed out that it has a registration for the mark METRIX ELECTRONICS PLC in Class 9 under No. 2043960 which predates the earlier cited mark of the opponent.

46. In the light of this I must consider the effect of Registration No. 2043960 on the current opposition and in particular whether it creates a bar to the proceedings. I take the view that the existence of the applicant's earlier Registration (No. 2043960) does not debar the application. The issue for consideration under Section 5(2) of the Act, taking into account the definition of an "earlier trade mark" in Section 6(1) of the Act, is whether registration of the mark in suit should be prevented because of the likelihood of confusion with the applicant's earlier trade marks. I see nothing in the wording of the section that says I should have regard to another registration that stands in the name of the applicant and I have not been pointed to any authority in support of such a proposition. Section 72 of the Act requires me to assume that the opponent's earlier trade mark is validly registered. The applicant could have put the validity of those registrations in issue by making its own application for them to be declared invalid on the basis of its earlier registration. It has not done this. In the absence of any such application, the existence of another registration is in effect no more than a piece of the state of the register evidence. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 Mr Justice Jacob commented:

"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of work in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see eg *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence."

47. In principle I fail to see why the position should be any different where the applicant owns another mark on the register than if it was a third party mark. Section 5 is concerned with likelihood of confusion on the basis of a mark for mark comparison. What may be of assistance to the tribunal is evidence demonstrating that the relevant marks have been in use in that the effect on concurrent use could inform the tribunal's view on the issue of likelihood of confusion. Such use may shed light on how events in the market place have educated the relevant public to distinguish between the relevant services and/or goods of rival traders and thus mitigated against the likelihood of confusion arising. However, in the present case there is no evidence to demonstrate the nature or extent of the opponent's use of its MULTIMETRIX mark and I am unable to form any conclusions as to the impact of any use in the market place. I cannot mark any inference in relation to confusion on the basis of concurrent use. In any event the issue of actual confusion is not necessarily telling in relation to relative grounds – see *Compass Publishing BV v Compass Logistics Ltd* [2004] EWCA (Ch). My comparisons must take into account notional, fair use of the respective marks across the width of their respective specifications.

48. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my considerations on whether there are similarities sufficient to show a likelihood of

confusion I am guided by the recent judgments of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual; aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of services in goods and how they are marketed. I must compare the mark applied for and the opponent's earlier registration on the basis of their inherent characteristics assuming notional fair use of the marks across the width of the respective specification of goods.

49. Firstly, I go to a comparison of the respective goods. Given the width of the opponent's specification of goods it is obvious that the goods applied for are identical and/or closely similar to the goods covered by the opponent's earlier registration in Class 9.

50. I now go to compare the mark in suit with the mark comprising the opponent's earlier registration.

51. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. However, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in my comparison, reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how the marks would be perceived by customers in the normal course and circumstance of trade. I must bear this in mind when making the comparisons.

52. The mark in suit consists essentially of the words METRIX ELECTRONICS (there is some slight stylisation to the letter e in the words) and the words are imposed upon a "wavy" line. I have no doubt that the dominant, distinctive component of the mark is the word METRIX, which although possibly alluding to the obvious dictionary word METRIC, is nevertheless distinctive. The word ELECTRONICS is, of itself, not distinctive in relation to the goods, while the "wavy" line, although an integral and visually significant component of the mark, is a secondary element in relation to the words.

53. The opponent's earlier registration consists of the invented word MULTIMETRIX. While the mark comprises one word I believe it would be obvious to the average consumer that the prefix MULTI comprises a well-known combining-form and is conjoined to the invented word METRIX.

54. I turn to a visual and aural comparison of the respective marks. The dominant, distinctive component of the applicant's mark (the word METRIX) is clearly combined within the opponent's earlier registration (the word MULTIMETRIX) and given that the prefix MULTI is an obvious or well known combining form conjoined to the word METRIX, it is my view that the respective marks are as a whole closely similar.

55. Next, a conceptual comparison of the marks. As both marks contain invented words they do not possess a clearly defined conceptual identity. However, both marks share the distinctive letters METRIX and given the position of these letters in the

applicant's mark and their overall impact within the opponent's mark, it seems to me that there is some conceptual similarity overall.

56. In my considerations I must also consider the relevant customer for the goods and services. In these proceedings it seems to me that the relevant customer would be largely businesses users as opposed to the public at large. This is certainly not a bag of sweets case and it seems to me that the goods are likely to be purchased with a good degree of care.

57. I now go to a global appreciation of the likelihood of confusion. The respective goods and services are identical and/or closely similar and given the prominence of the letters METRIX in the opponent's MULTIMETRIX mark, the respective marks are visually, aurally and conceptually similar as a whole. Notwithstanding that the customer for the goods and services would be relatively careful and discerning, it is my view that the applicant's mark would capture the distinctiveness of the opponent's trade mark in the market place and that there is a likelihood of confusion to the relevant customer.

58. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in *Canon*:

“Accordingly the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive” (*see Sabel*).

59. The opposition under Section 5(2)(b) of the Act is successful.

COSTS

60. The opponent is entitled to a contribution toward its costs. I order the applicant to pay the opponent the sum of £1,200 which takes into account the fact that no hearing took place in these proceedings. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of November 2005

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General