O-275-16

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3094074
BY RAAMAUDIO UK LIMITED

TO REGISTER THE TRADE MARK:

PI SUPPLY

IN CLASSES 9, 11, 16, 35, 38, 41 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600000327
BY POWER INTEGRATIONS INC.

BACKGROUND AND PLEADINGS

1. On 12 February 2015, RAAMaudio UK Limited ("the applicant") applied to register the trade mark **PI SUPPLY** for a range of goods and services in classes 9, 11, 16, 35, 38, 41 and 42 (the specification is reproduced in full in the annex to this decision).

The application was published for opposition purposes on 26 June 2015.

2. The application is opposed by Power Integrations Inc. ("the opponent") under the fast-track opposition procedure.

3. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), is directed against the following goods and services in the application:

Class 9 Measuring, signalling, checking (supervision) apparatus and instruments; magnetic data carriers, recording discs; compact discs; DVDs and other digital recording media; floppy discs; hard discs; compact discs; cd roms; laser-readable discs; data processing equipment; computers; media centre computers; media centre PC's; touch screens; computer software; computer hardware; keyboards; mice; cables; speakers; batteries; solar batteries; lithium ion batteries; lithium polymer batteries; solar powered radios; phone plugs; memory sticks; USB hubs; remote controls; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; power supplies; electronic components; electronic components for computers; semiconductors; transistors; silicon chips; ethernet controllers; home automation; circulators in the nature of electronic components; embedded electronics; embedded electronic devices; network boards; distribution boards; pc boards; digital boards; memory boards; circuit boards; electronic copy boards; multimedia accelerator boards; electrical circuit boards; connection boards [electric]; memo boards [electronic]; panel boards [electricity]; flexible circuit boards; camera boards; computer circuit boards; printed circuit boards; electrical switch boards; computer interface boards; add-on circuit boards; computer add-on boards; system boards (mother cards); printed wiring boards; integrated circuit boards; distribution panel boards [electricity]; test adapters for testing printed circuit boards; add-on circuit boards for connecting computers to networking software; circuit distributors; circuit fuses; circuit testers; circuit closers; circuit breakers; circuit cards; decision circuits; focusing circuits; analogue circuits; logic circuits; hybrid circuits; printed circuits; electrical circuit testers; integrated circuit chips; integrated circuit modules; electronic circuit cards; SD cards; electrical circuit breakers; integrated circuit memories; electric circuit interrupters; hybrid integrated circuits; printed electric circuits; computer network switches; high frequency switches; electric current switches; valves (solenoid -) [electromagnetic switches]; electronic touch sensitive switches; rotary cam limit switches; push button

switches (electrical -); push leaf switches (electrical -); temperature control apparatus [electric switches]; change-over switches [for telecommunication apparatus]; temperature control apparatus [electric switches] for machines; temperature control apparatus [electric switches] for vehicles; battery adapters; power adapters; ethernet adapters; electric plug adapters; electric extension leads and extension outlet sockets; electric conductor wires and cables; electric couplings; electric connections; electric switchboxes; electric fuses; electric sensors; electric contacts; electric cells; electric batteries; electric convertors; electric rectifiers; electric plugs; electric oscillators; electric buzzers; electric cords; electric wire; electrical sockets; electrical inductors; electrical terminators; electrical armatures; electrical capacitors; electrical receivers; electrical coils; electric leads; electrical ducts; electrical meters; electrical conduits; electrical amplifiers; electric switching apparatus; connection plugs (electric -); electric current rectifiers; electric circuit interrupters; metallic cables [electric]; switch panels [electric]; heat resistant electric cables; plastic covered electric wires; data storage devices; memory storage devices; electricity storage apparatus; junction boxes [electricity]; branch boxes [electricity]; connection boxes [electricity]; wire connectors [electricity]; computer network adapters; flash card adapters; test adapters for testing printed circuit boards; high-frequency switching power supplies; wireless computer peripherals; microcontrollers; interface software; infrared thermometers; downloadable online publications; telecommunications apparatus.

Class 11 Light emitting diodes.

Class 16 Printed matter; printed publications; books; magazines; magazines in relation to computer hardware; magazines in relation to electronic components; periodicals; printed periodicals; instructional and teaching material (except apparatus).

Class 35 Advertising; subscriptions to magazines; subscriptions to magazines in relation to computer hardware; subscriptions to magazines in relation to electronic components; retail and online retail services in relation to the sale of measuring, signalling, checking (supervision) apparatus and instruments, magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, floppy discs, hard discs, compact discs, cd roms, laser-readable discs, data processing equipment, computers, media centre computers, media centre PC’s, touch screens, computer software, computer hardware, keyboards, mice, cables, speakers, batteries, solar batteries, lithium ion batteries, lithium polymer batteries, solar powered radios, phone plugs, memory sticks, USB hubs, remote controls, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, power supplies, electronic components, electronic components for computers,

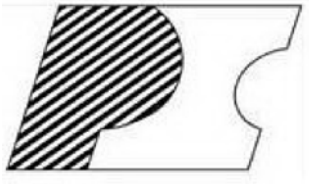
optical electronic components, semiconductors, transistors, silicon chips, ethernet controllers, home automation, circulators in the nature of electronic components, embedded electronics, embedded electronic devices, network boards, distribution boards, pc boards, digital boards, memory boards, circuit boards, electronic copy boards, multimedia accelerator boards, electrical circuit boards, connection boards [electric], memo boards [electronic], panel boards [electricity], flexible circuit boards, camera boards, computer circuit boards, printed circuit boards, electrical switch boards, computer interface boards, add-on circuit boards, computer add-on boards, system boards (mother cards), printed wiring boards, integrated circuit boards, distribution panel boards [electricity], test adapters for testing printed circuit boards, add-on circuit boards for connecting computers to networking software, circuit distributors, circuit fuses, circuit testers, circuit closers, circuit breakers, circuit cards, decision circuits, focusing circuits, analogue circuits, logic circuits, hybrid circuits, printed circuits, electrical circuit testers, integrated circuit chips, integrated circuit modules, electronic circuit cards, SD cards, electrical circuit breakers, integrated circuit memories, electric circuit interrupters, hybrid integrated circuits, printed electric circuits, computer network switches, high frequency switches, electric current switches, valves (solenoid -) [electromagnetic switches], electronic touch sensitive switches, rotary cam limit switches, push button switches (electrical -), push leaf switches (electrical -), temperature control apparatus [electric switches], change-over switches [for telecommunication apparatus], temperature control apparatus [electric switches] for machines, temperature control apparatus [electric switches] for vehicles, battery adapters, power adapters, ethernet adapters, electric plug adapters, electric extension leads and extension outlet sockets, electric conductor wires and cables, electric couplings, electric connections, electric switchboxes, electric fuses, electric sensors, electric contacts, electric cells, electric batteries, electric convertors, electric rectifiers, electric plugs, electric oscillators, electric buzzers, electric cords, electric wire, electrical sockets, electrical inductors, electrical terminators, electrical armatures, electrical capacitors, electrical receivers, electrical coils, electric leads, electrical ducts, electrical meters, electrical conduits, electrical amplifiers, electric switching apparatus, connection plugs (electric -), electric current rectifiers, electric circuit interrupters, metallic cables [electric], switch panels [electric], heat resistant electric cables, plastic covered electric wires, data storage devices, memory storage devices, electricity storage apparatus, junction boxes [electricity], branch boxes [electricity], connection boxes [electricity], wire connectors [electricity], computer network adapters, flash card adapters, test adapters for testing printed circuit boards, high-frequency switching power supplies, wireless computer peripherals, microcontrollers, interface software, infrared thermometers, online publications, non-downloadable online publications, light emitting diodes, printed matter, printed publications, books, magazines, magazines in relation to computer

hardware, magazines in relation to electronic components, periodical magazines, periodicals, printed periodicals, instructional and teaching material (except apparatus).

Class 41 Education; education services relating to computer hardware; education services relating to electronic components; education services relating to the application of computer systems; online tutorials in the field of computers; online tutorials in relation to electronic components; arranging of workshops; arranging of workshops in relation to electronic components; providing instructional videos in the field of computers; providing of training; computer training services; training services relating to the installation of computer controlled test systems; training courses relating to the study and installation of electronic components; training related to the study and installation of computer hardware; training related to computer programmes; training in electrical engineering; training in electronics; publication services; electronic publication; publication of magazines; providing online electronic information and publications (non-downloadable) relating to computers; publication of electronic journals and web logs, featuring user generated or specified content; providing webinars and podcasts in the field of computers; non-downloadable online publications.

Class 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design services; design and development of computer hardware; consultancy in the field of computer hardware; technological services relating to computers; information services relating to computers; technical project studies in the field of computer hardware; troubleshooting of computer hardware problems; development of computer hardware for the manufacturing industries; housing of digital content; web hosting services; hosting of blogs, blogs in the relation to computer hardware; computer hardware design; development of computer hardware; development of hardware for digital signal processing; design of hardware for data and multimedia content conversion from and to different protocols; computer programming; leasing of computer hardware; electronic data storage; designing of electronic components; designing of electronic systems; development of electronic systems; engineering services relating to the design of electronic systems; calibration services relating to electronic apparatus; advisory services relating to electronic components.

4. The opponent relies upon its European Union Trade Mark (“EUTM”) registration no. 11244597 for the trade mark shown below, applied for on 7 October 2012 and for which the registration procedure was completed on 9 May 2013:



The trade mark has a priority date of 9 April 2012. The opponent relies upon all of the goods and services in its trade mark registration, namely:

Class 9 Apparatus and instruments for conducting, switching, transforming, commutating, accumulating, regulating or controlling electricity; apparatus for recharging electrical accumulators; electric power converters; integrated circuits; semiconductors; computer software in the field of integrated circuits and semiconductors; semiconductor devices and integrated circuits for smart power operations and power conversion.

Class 41 Training in the design, development, testing, operation and use of integrated circuits and semiconductors; publication of videos, books, manuals, work instructions, data sheets, images and texts related to integrated circuits and semiconductors and their design, development, testing, operation and use, also in electronic form; information, advice and consultancy regarding all aforementioned services.

Class 42 Scientific and technological services and research and design relating thereto in the field of integrated circuits and semiconductors; industrial analysis and research services in the field of integrated circuits and semiconductors; design, development and testing of integrated circuits and semiconductors; design, development and testing of computer software in the field of integrated circuits and semiconductors; information, advice and consultancy regarding all aforementioned services.

5. On 17 December 2015, the applicant filed a counterstatement in which it denies the basis of the opposition.

6. Rules 20(1)-(3) of the Trade Marks Rules ("TMR") (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

> "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit".

The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. On 8 January 2016, the applicant sought leave to file evidence to demonstrate that the marks have co-existed without confusion since 2013, the specialist meaning of "pi" in the sector concerned, common use of the term in other traders' trade

marks and the specialised nature of the applicant's services. Leave was granted and, following a procedural hearing, the evidence was formally admitted into proceedings in the decision dated 16 March 2016. The opponent was afforded the opportunity to file evidence in reply but chose not to do so.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Both parties filed written submissions, which I have read carefully and will refer to, as necessary, below.

The applicant's evidence

8. The evidence consists of the witness statement of Aaron Shaw, with eleven exhibits. Mr Shaw is the Director of the applicant, a position he has held since October 2009. For reasons which will become apparent, I do not intend to summarise the evidence in detail here. However, briefly, the evidence is as follows:

9. Exhibit AS1 consists of printouts from www.raspberrypi.org. They are dated 27 January 2016. The term "PI SUPPLY" is not present but "PI"/"Pi" appears throughout, chiefly in the combination "RASPBERRY PI"/"Raspberry Pi".

10. Exhibit AS2 consists of printouts from a variety of websites. The images are of poor quality and largely illegible. The term "PI SUPPLY" is not visible. The printouts are, for the most part, undated. However, at p. 7, a printout from the Raspberry Pi website indicates that the most users ever on the site was on 8 February 2013. A few pages in the exhibit show dates in 2015 (for example, pp. 10, 19, 20), all after the relevant date.

11. Exhibit AS3 shows printouts from the "Pi Supply" website, including a range of products on sale. The images are undated save for the printing date of 27 January 2016.

12. Exhibit AS4 are printouts showing PI SUPPLY products on sale on third-party websites. The images are said to date from 27 January 2016, which is after the relevant date.

13. Exhibit AS5 shows the opponent's products on sale at cpc.farnell.com, one of the distributors appearing in exhibit AS4. The images have a printing date of 27 January 2016.

14. Exhibit AS6 consists of web pages showing Pi Supply's social media presence. The earliest date is June 2013 on twitter.com (p.79); www.facebook.com shows posts from 20 August 2015 to 24 January 2016.

15. Exhibit AS7 consists of printouts from the opponent's website showing products for sale. They are said to be dated 22 January 2016.

16. Exhibit AS8 consists of printouts from the opponent's website giving details of their offices and distributors. There are also printouts from third-party websites showing the opponent's products on sale. The printouts are said to be from 22-27 January 2016 (i.e. after the relevant date).

17. Exhibit AS9 shows the opponent's products on sale via www.digikey.com. The images are said to date from 22 January 2016. It is said that the earlier mark is visible on some of the products, although the quality of the image is too poor to be certain.

18. Exhibit AS10 consists of printouts from www.digikey.co.uk. "Pi Supply" is not mentioned, though "RASPBERRYPI"/"Raspberry Pi" is. The images bear a printing date of 27 January 2016.

19. Exhibit AS11 purports to show data regarding search traffic for the Pi Supply website. It is not legible.

DECISION

20. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

> "5. - (2) A trade mark shall not be registered if because -
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

21. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "6. - (1) In this Act an "earlier trade mark" means -
>
> (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered".

22. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 4, which qualifies as an earlier trade mark under the above provisions. As the opponent's earlier mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

23. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing act

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median".

25. The opponent has made no specific submissions about the average consumer or how the goods and services at issue will be purchased. The applicant, in its written submissions, states that the average consumer may be a member of the general public or a trade or professional user of computers and electronics. It argues that the trade or professional user is likely to pay a higher degree of attention. The applicant also submits that "the Contested Goods in Classes 9 and 11 are more likely to be selected and purchased only after the mark has been seen" (paragraphs 9- 10).

26. At this point of the decision, I would normally identify the average consumer of the products, their traits and the nature of the purchasing act. However, for reasons which

will become apparent, I do not propose to do that here; rather, I will return to the average consumer when I consider the likelihood of confusion.

Comparison of goods

27. Some of the contested goods and services in classes 9, 41 and 42 are identical to the goods and services on which the opposition is based. The opponent argues that the remaining goods and services are similar. For reasons of procedural economy, I will not undertake a full comparison of the goods and services listed above. The examination of the opposition will proceed on the basis that the contested goods and services are identical to those covered by the earlier trade mark. If the opposition fails even where the goods and services are identical, it follows that the opposition will also fail where the goods and services are only similar.

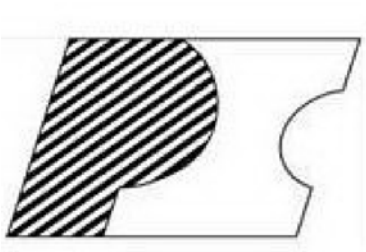
Comparison of trade marks

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

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

29. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

30. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
	PI SUPPLY

31. The opponent submits that, in terms of the visual comparison:

> "The minimal stylisation of the word PI within the Earlier Mark does not diminish the overall similarity of the marks, and neither does the inclusion of the additional verbal element SUPPLY in the Contested Mark, given its weak distinctive character.
>
> The Applicant's contention that the Earlier Mark "is a logo which does not incorporate the verbal element of 'PI'" is wholly unfounded; P and I are clearly discernible within the Earlier Mark as upper case letter, in a simple font" (p.2).

As regards aural similarity, it contends that:

> "the average English speaker would pronounce the word PI in one of two ways: as the individual letters P and I, or as a monosyllabic word PI.
>
> The first element of the Contested Mark would therefore be pronounced identically to the Earlier Mark as a whole, whether PI is pronounced as individual letters, or as a single word" (p.3).

The marks are also, according to the opponent:

> "conceptually similar to a high degree, as the additional word SUPPLY within the Contested Mark is not of sufficient distinctive character to outweigh the shared conceptual meaning of PI between the Earlier and Contested Marks" (p.3)

32. For its part, the applicant submits that:

> "the average consumer would not perceive the Earlier Mark as consisting of the two letters 'P' and 'I', but would perceive the Earlier Mark as a

> meaningless, purely figurative mark consisting of two geometric, abstract shapes pushed together in the form of a jigsaw. The word PI, being a word that is not a common word in general usage, is not discernible to the average consumer. In the premises, there is absolutely no similarity whatsoever between the meaningless figurative mark and the words PI SUPPLY, whether visual, aural or conceptual" (paragraph 12).

33. The applicant's mark consists of the words "PI SUPPLY", presented in capital letters. In relation to the opposed goods and services, "SUPPLY" is descriptive and has little or no distinctive character. The overall impression is, therefore, dominated by the element "PI".

34. The opponent's figurative mark consists of the shape of the letter "P", which is shaded with diagonal stripes of even size and spacing. Adjoining the letter "P" is a stylised capital letter "I" presented in outline form. The two elements make a roughly equal contribution to the overall impression of the mark, with neither element playing a dominant role.

35. Visually, the marks share the same letters "P" and "I". I do not, however, agree with the opponent that the stylisation of the earlier mark is minimal: in my view, the mark is fairly heavily stylised. The applicant's mark is presented in a standard typeface and there is the additional element "SUPPLY". The marks are very different to look at. Taking all of these factors into account, I find that there is a very low degree of visual similarity.

36. Aurally, both elements of the applicant's mark will vocalised. The mark will either be articulated as the dictionary words "PI SUPPLY" or by the letters "P-I" and the word "SUPPLY". The earlier mark, if it is articulated, will be pronounced either as the word "PI" or as the letters "P-I". The "PI"/"P-I" element of the marks will therefore be articulated in the same way but some difference is introduced by the word "SUPPLY" in the applicant's mark. I find that the marks are aurally similar to a high degree.

37. A conceptual message is only relevant if it is capable of immediate grasp.[1] I do not consider that the average consumer in the UK will understand "PI" to be the Greek letter π, as posited by the opponent: the language is commonly neither spoken nor taught throughout the UK. Some average consumers will see the word "pi", the mathematical constant defined in the *Oxford Dictionary of English* ("*OED*") as "the numerical value of the ratio of the circumference of a circle to its diameter (approximately 3.14159)".[2] The presentation of the letters in the marks at issue means that the element "PI" may also be perceived as the letters "P-I", with no specific meaning attached to them. Whichever of these two concepts is attributed to one mark is as likely to be attributed to the other. A difference is introduced by the word "SUPPLY" in the applicant's mark but this element has little or no distinctive character. As a consequence, for those average

[1] See Case C-361/04 P *Ruiz-Picasso and Others* v *OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29.
[2] <http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0629760?rskey=bARwpv&result=12> [accessed 19 May 2016]

consumers who perceive “PI” as the mathematical pi, the marks are conceptually identical; for those who perceive “PI” as letters with no particular meaning, the conceptual position is neutral, there being neither conceptual similarity nor dissimilarity.

Distinctive character of the earlier trade mark

38. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* v *Huber and Attenberger* [1999] ECR I-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)”.

39. As no evidence has been filed by the opponent, I have only the inherent position to consider. In doing so, I am mindful of the following comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, where he pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it".

40. Invented words usually have the highest degree of inherent distinctive character; words which are descriptive of the goods and services relied upon normally have the lowest. The word "PI" is a dictionary word but has no specific meaning in relation to the goods and services relied upon. Even when considered as letters, given the propensity for undertakings to adopt letters as indicators of trade origin, the mark is not high in distinctiveness. I am of the view that, as a whole, the mark has a reasonably high degree of inherent distinctiveness, which is attributable not to the letters themselves but to their particular graphic presentation.

Likelihood of confusion

41. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

42. I have found that the parties' marks are visually similar to a very low degree, aurally similar to a high degree and (potentially) conceptually identical. I have concluded that the earlier mark has a reasonably high degree of inherent distinctive character but that this is attributable to its stylised presentation, which has no counterpart in the opposed mark. I have proceeded on the basis that the goods and services are identical.

43. Given the nature of the goods and services at issue, the average consumer will vary from a member of the general public to a tradesperson or skilled professional. The level of attention paid to the purchase will also vary considerably. For example, only a low degree of attention is likely to be paid in the purchase of goods such as "electric extension leads" but a high degree of attention will be paid to the selection of specialised educational services such as "training services relating to the installation of

computer controlled test systems". The purchase of the goods and services at issue is, however, likely to be dominated by visual considerations, though I accept that there may be an aural component.

44. I also remind myself of the comments of Iain Purvis, Q.C., sitting as the Appointed Person, in *The Royal Academy of Arts v Errea Sport S.p.A* (BL O/010/16) where, in relation to marks which have little visual similarity but which are aurally identical, he stated:

> "15. In essence [the opponent's] argument was that there was bound to be a likelihood of confusion in this case because of the aural 'identity' between the marks (if one tried to ask for goods using an aural version of the earlier mark, one would ask for 'RA' goods, just as one would ask for the applicant's goods). This argument seems to me to fly in the face of the necessary 'global' assessment, bearing in mind the visual, conceptual and aural similarities, which the tribunal must carry out. Particularly in the case of an earlier mark which is a heavily stylised device mark, taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark and is likely to lead to an erroneous result".

45. Although the marks are aurally highly similar and conceptually (potentially) identical, my finding that the marks are visually similar to only a very low degree is of particular importance, given that the purchase of the goods and/or services is likely to be predominantly visual.[3] In my view, even where the goods or services in question are identical and the purchases are made by a member of the general public paying only a low degree of attention, the marks in their totalities are sufficiently different that there is no likelihood of confusion, either directly or indirectly, in respect of any of the goods and services at issue. **The opposition fails under section 5(2)(b).**

Conclusion

46. The opposition has been unsuccessful and the application will proceed to registration.

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[3] In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:
"49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs".

Costs

47. As the applicant has been successful, it is entitled to a contribution towards its costs. Although the applicant filed evidence, the vast majority of it is from after the relevant date. It has had no bearing on my decision and I make no award in respect of the applicant's evidence. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide but bearing in mind my comments, above, I award costs to the applicant on the following basis:

Considering the Notice of Opposition and filing a counterstatement:	£200
Written submissions:	£300
Total:	£500

48. I order Power Integrations Inc**.** to pay RAAMaudio UK Limited the sum of **£500**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of June 2016

Heather Harrison
For the Registrar
The Comptroller-General

ANNEX

Trade mark application number 3094074

Class 9

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs; DVDs and other digital recording media; floppy discs; hard discs; video cassettes; audiocassettes; phonographs; compact discs; cd roms; laser-readable discs; tape recorders and tape cassette players; record players; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment; weather balloons; computers; media centre computers; media centre PC's; touch screens; computer software; computer hardware; keyboards; mice; cables; speakers; batteries; solar batteries; lithium ion batteries; lithium polymer batteries; solar powered radios; phone plugs; memory sticks; USB hubs; photographic flash lighting apparatus; cameras; flashlights [photography]; flashbulbs [photography]; screens [photography]; shutter releases [photography]; spools [photography]; remote controls; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; power supplies; electronic components; electronic components for computers; optical electronic components; semiconductors; transistors; silicon chips; ethernet controllers; home automation; circulators in the nature of electronic components; embedded electronics; embedded electronic devices; network boards; distribution boards; pc boards; digital boards; memory boards; circuit boards; electronic copy boards; multimedia accelerator boards; electrical circuit boards; connection boards [electric]; memo boards [electronic]; panel boards [electricity]; flexible circuit boards; camera boards; computer circuit boards; printed circuit boards; electrical switch boards; computer interface boards; add-on circuit boards; computer add-on boards; system boards (mother cards); printed wiring boards; integrated circuit boards; distribution panel boards [electricity]; test adapters for testing printed circuit boards; add-on circuit boards for connecting computers to networking software; circuit distributors; circuit fuses; circuit testers; circuit closers; circuit breakers; circuit cards; decision circuits; focusing circuits; analogue circuits; logic circuits; hybrid circuits; printed circuits; electrical circuit testers; integrated circuit chips; integrated circuit modules; electronic circuit cards; SD cards; electrical circuit breakers; integrated circuit memories; electric circuit interrupters; hybrid integrated circuits; printed electric circuits; computer network switches; high frequency switches; electric current switches; valves (solenoid -) [electromagnetic switches]; electronic touch sensitive switches; rotary cam limit switches; push button switches (electrical -); push leaf switches (electrical -); temperature control apparatus [electric switches]; change-over switches [for telecommunication apparatus]; temperature control apparatus [electric switches] for machines; temperature control apparatus [electric switches] for vehicles; battery adapters; power adapters; ethernet adapters; electric plug adapters; electric extension leads and extension outlet sockets; electric conductor wires and cables; electric couplings; electric connections; electric switchboxes; electric fuses; electric sensors;

electric contacts; electric cells; electric batteries; electric convertors; electric rectifiers; electric plugs; electric oscillators; electric buzzers; electric cords; electric wire; electrical sockets; electrical inductors; electrical terminators; electrical armatures; electrical capacitors; electrical receivers; electrical coils; electric leads; electrical ducts; electrical meters; electrical conduits; electrical amplifiers; electric switching apparatus; connection plugs (electric -); electric current rectifiers; electric circuit interrupters; metallic cables [electric]; switch panels [electric]; heat resistant electric cables; plastic covered electric wires; data storage devices; memory storage devices; electricity storage apparatus; junction boxes [electricity]; branch boxes [electricity]; connection boxes [electricity]; wire connectors [electricity]; computer network adapters; flash card adapters; test adapters for testing printed circuit boards; high-frequency switching power supplies; wireless computer peripherals; microcontrollers; interface software; infrared thermometers; photographic apparatus; cases adapted for computers; cases adapted for cameras; cases for photographic apparatus; cases adapted for binoculars; cases for mobile phones; cases for electronic diaries; cases for pocket calculators; notebook computer carrying cases; laptop carrying cases; computer carrying cases; downloadable online publications; fire-extinguishing apparatus; telecommunications apparatus.

Class 11

Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; computer controlled lighting instruments; camera lights; digital lights; light emitting diodes; lighting apparatus; electric lamps; torches; electric lighting; electrical lighting; solar powered lamps; electric lighting fixtures for use in hazardous locations; heaters for sink water; heating rods; heating rings; heating pads; heating elements; electrical heating elements in the form of cables; electrical heating apparatus; electric heating cables; electric heating elements; heating boilers; temperature control valves [parts of central heating installations]; temperature controllers [valves] for central heating radiators; temperature control valves [parts of water supply installations]; mixer taps for the manual regulating of water temperature; temperature sensitive switches [thermostatic valves] for central heating radiators; temperature sensing apparatus [thermostatic valves] for central heating radiators; heat exchangers for the temperature control of drinks being dispensed; temperature responsive control apparatus [thermostatic valves] for central heating radiators; temperature limiters for central heating radiators [thermostatic valves] incorporating expansion rods; valves (temperature sensitive controls for automatically operating -) [parts of heating installations]; temperature limiters for central heating radiators [thermostatic valves] incorporating bi-metallic discs; heating systems composed primarily of tubes, pipes and manifolds through which warm or high temperature water circulates; temperature data logger; electrical heating pads, other than for medical [treatment] use; electrical heating elements in the form of cables; electrically heated blankets, other than for medical purposes; electrical heating elements in the form of foil closed circuit heating installations.

Class 16

Paper, cardboard; printed matter; bookbinding material; printed publications; books; magazines; magazines in relation to computer hardware; magazines in relation to

electronic components; periodical magazines; poster magazines; periodicals; printed periodicals; photographs; stationery; stickers; adhesive stickers; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; electric heat sealing apparatus, for office use; electric franking machines; electric typewriters; electric pencil sharpeners; electric stapling guns, for office use.

Class 35

Advertising; business management; business administration; office functions; subscriptions to magazines; subscriptions to magazines in relation to computer hardware; subscriptions to magazines in relation to electronic components; retail and online retail services in relation to the sale of scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, floppy discs, hard discs, video cassettes, audiocassettes, phonographs, compact discs, cd roms, laser-readable discs, tape recorders and tape cassette players, record players, mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment, weather balloons, computers, media centre computers, media centre PC's, touch screens, computer software, computer hardware, keyboards, mice, cables, speakers, batteries, solar batteries, lithium ion batteries, lithium polymer batteries, solar powered radios, phone plugs, memory sticks, USB hubs, photographic flash lighting apparatus, cameras, flashlights [photography], flashbulbs [photography], screens [photography], shutter releases [photography], spools [photography], remote controls, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, power supplies, electronic components, electronic components for computers, optical electronic components, semiconductors, transistors, silicon chips, ethernet controllers, home automation, circulators in the nature of electronic components, embedded electronics, embedded electronic devices, network boards, distribution boards, pc boards, digital boards, memory boards, circuit boards, electronic copy boards, multimedia accelerator boards, electrical circuit boards, connection boards [electric], memo boards [electronic], panel boards [electricity], flexible circuit boards, camera boards, computer circuit boards, printed circuit boards, electrical switch boards, computer interface boards, add-on circuit boards, computer add-on boards, system boards (mother cards), printed wiring boards, integrated circuit boards, distribution panel boards [electricity], test adapters for testing printed circuit boards, add-on circuit boards for connecting computers to networking software, circuit distributors, circuit fuses, circuit testers, circuit closers, circuit breakers, circuit cards, decision circuits, focusing circuits, analogue circuits, logic circuits, hybrid circuits, printed circuits, electrical circuit testers, integrated circuit chips, integrated circuit modules, electronic circuit cards, SD cards, electrical circuit breakers, integrated circuit memories, electric circuit interrupters, hybrid integrated circuits, printed electric circuits, computer network switches, high frequency switches, electric current switches,

valves (solenoid -) [electromagnetic switches], electronic touch sensitive switches, rotary cam limit switches, push button switches (electrical -), push leaf switches (electrical -), temperature control apparatus [electric switches], change-over switches [for telecommunication apparatus], temperature control apparatus [electric switches] for machines, temperature control apparatus [electric switches] for vehicles, battery adapters, power adapters, ethernet adapters, electric plug adapters, electric extension leads and extension outlet sockets, electric conductor wires and cables, electric couplings, electric connections, electric switchboxes, electric fuses, electric sensors, electric contacts, electric cells, electric batteries, electric convertors, electric rectifiers, electric plugs, electric oscillators, electric buzzers, electric cords, electric wire, electrical sockets, electrical inductors, electrical terminators, electrical armatures, electrical capacitors, electrical receivers, electrical coils, electric leads, electrical ducts, electrical meters, electrical conduits, electrical amplifiers, electric switching apparatus, connection plugs (electric -), electric current rectifiers, electric circuit interrupters, metallic cables [electric], switch panels [electric], heat resistant electric cables, plastic covered electric wires, data storage devices, memory storage devices, electricity storage apparatus, junction boxes [electricity], branch boxes [electricity], connection boxes [electricity], wire connectors [electricity], computer network adapters, flash card adapters, test adapters for testing printed circuit boards, high-frequency switching power supplies, wireless computer peripherals, microcontrollers, interface software, infrared thermometers, photographic apparatus, cases adapted for computers, cases adapted for cameras, cases for photographic apparatus, cases adapted for binoculars, cases for mobile phones, cases for electronic diaries, cases for pocket calculators, notebook computer carrying cases, laptop carrying cases, computer carrying cases, online publications, non-downloadable online publications, fire-extinguishing apparatus, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, computer controlled lighting instruments, camera lights, digital lights, light emitting diodes, lighting apparatus, electric lamps, torches, electric lighting, electrical lighting, solar powered lamps, fixtures for use in hazardous locations, heaters for sink water, heating rods, heating rings, heating pads, heating elements, electrical heating elements in the form of cables, electrical heating apparatus, electric heating cables, electric heating elements, heating boilers, temperature control valves [parts of central heating installations], temperature controllers [valves] for central heating radiators, temperature control valves [parts of water supply installations], mixer taps for the manual regulating of water temperature, temperature sensitive switches [thermostatic valves] for central heating radiators, temperature sensing apparatus [thermostatic valves] for central heating radiators, heat exchangers for the temperature control of drinks being dispensed, temperature responsive control apparatus [thermostatic valves] for central heating radiators, temperature limiters for central heating radiators [thermostatic valves] incorporating expansion rods, valves (temperature sensitive controls for automatically operating -) [parts of heating installations], temperature limiters for central heating radiators [thermostatic valves] incorporating bi-metallic discs, heating systems composed primarily of tubes, pipes and manifolds through which warm or high temperature water circulates, temperature data logger, electrical heating pads, other than for medical [treatment] use, electrical heating elements in the form of cables, electrically heated blankets, other than for medical

purposes, electrical heating elements in the form of foil closed circuit heating installations, paper, cardboard, printed matter, bookbinding material, printed publications, books, magazines, magazines in relation to computer hardware, magazines in relation to electronic components, periodical magazines, poster magazines, periodicals, printed periodicals, photographs, stationery, stickers, adhesive stickers, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging (not included in other classes), printers' type, printing blocks, electric heat sealing apparatus, for office use, electric franking machines, electric typewriters, electric pencil sharpeners, electric stapling guns, for office use.

Class 38

Telecommunications; telecommunications services; interactive telecommunications services; telecommunications gateway services; operation of telecommunications systems; cellular telecommunications services; fibre optic telecommunications services; electronic network communications; electronic data communications; electronic data transmission; electronic exchange of data stored in databases accessible via telecommunication networks; communication services, namely, electronic transmission of data and documents among users of computers; electronic message sending; electronic instructions transmissions services; wireless electronic transmissions of information; electronic transmission of images; electronic transmission of documents; electronic instructions transmissions services; communication via computer terminals; transmission of information services for computers (portable or office) via internet, television or radio broadcasting networks, by satellite or by telephone; transmission and reception of computer applications, computer aided transmission of messages and images; rental of access time to a computer database; leasing of access time to a computer database; leasing of telephone circuits; providing online forums; providing online forums in the field of computers; providing online forums in relation to electronic components; photo sharing and video sharing services.

Class 41

Education; education services relating to computer hardware; education services relating to electronic components; education services relating to the application of computer systems; online tutorials in the field of computers; online tutorials in relation to electronic components; arranging of workshops; arranging of workshops in relation to electronic components; providing instructional videos in the field of computers; providing of training; computer training services; training services relating to the installation of computer controlled test systems; training courses relating to the study and installation of electronic components; training related to the study and installation of computer hardware; training related to computer programmes; training in electrical engineering; training in electronics; training in the use of photographic equipment; entertainment; sporting and cultural activities; publication services; electronic publication; publication of magazines; providing online electronic information and publications (non-downloadable) relating to computers; publication of electronic journals and web logs, featuring user

generated or specified content; providing webinars and podcasts in the field of computers; photography; photography services; non-downloadable online publications.

Class 42

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design services; design and development of computer hardware; consultancy in the field of computer hardware; technological services relating to computers; information services relating to computers; technical project studies in the field of computer hardware; troubleshooting of computer hardware problems; development of computer hardware for the manufacturing industries; housing of digital content; web hosting services; hosting of blogs, blogs in the relation to computer hardware; computer hardware design; development of computer hardware; development of hardware for digital signal processing; design of hardware for data and multimedia content conversion from and to different protocols; computer programming; leasing of computer hardware; electronic data storage; designing of electronic components; designing of electronic systems; development of electronic systems; engineering services relating to the design of electronic systems; calibration services relating to electronic apparatus; advisory services relating to electronic components.