

# O-608-16

## TRADE MARKS ACT 1994

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

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

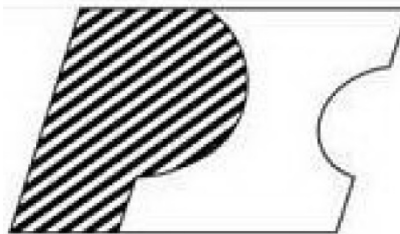
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### DECISION

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#### Introduction

1. This is an appeal against the decision of Ms Heather Harrison, acting on behalf of the Registrar, dated 6 June 2016 (O-275-16). In her Decision the hearing Officer rejected the opposition under section 5(2)(b) of the Trade Marks Act 1994.
2. 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.
3. The application was published for opposition purposes on 26 June 2015.
4. On the 25 September 2015 the application was opposed by Power Integrations Inc. (“*the Opponent*”) under the fast-track opposition procedure.
5. The opposition was based on section 5(2)(b) of the Trade Marks Act 1994 (“*the 1994 Act*”) and was directed a various goods and services in classes 9, 11, 16, 35, 41 and 42. For this purpose the Opponent relied its European Union Trade Mark registration no. 11244597 for the trade mark shown below which had been applied for on 7 October 2012 with a priority date of 9 April 2012 and for which the registration procedure was completed on 9 May 2013 (“*the EUTM*”):



6. The Opponent relied upon on the goods and services for which the EUTM was registered namely goods and services in classes 9, 41 and 42.

7. On 17 December 2015 the Applicant filed a counterstatement in which it denied the basis of the opposition.
8. In accordance to the relevant rules applicable to evidence under the fast track procedure no evidence, save for proof of use evidence which must be filed at the time of the Notice of opposition, is filed without the permission of the Registrar.
9. On 8 January 2016 the Applicant sought permission to file evidence to demonstrate that the marks had 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. By a decision dated 16 March 2016 the evidence was formally admitted to the proceedings. The Opponent was given an opportunity to file evidence in response but chose not to do so.
10. In accordance with the rules of the fast track procedure a hearing was neither requested by the parties nor considered necessary by the Registrar. In those circumstances, and again in accordance with the applicable rules, written arguments may be and were submitted by both parties to the opposition.

### **The Hearing Officer’s Decision**

11. Having set out a review of the evidence that was before her (paragraphs 8 to 19 of the Decision) the Hearing Officer then turned to the legal principles that it was necessary for her to apply in making the required assessment under section 5(2)(b) of the 1994 Act.
12. There is no suggestion on this appeal that the Hearing Officer did not correctly identify the relevant approach that was to be derived from the case law (and in particular the case law of the Court of Justice of the European Union (“*CJEU*”)) as follows:
  - (1) The general principle of the assessment that was required under section 5(2)(b) of the 1994 Act (paragraph 23 of the Decision);
  - (2) The approach to be adopted in identifying the relevant average consumer and the nature of the purchasing act (paragraph 24 of the Decision);
  - (3) The approach to be adopted to the comparison of trade marks (paragraph 28 of the Decision); and
  - (4) The approach to be adopted in assessing the distinctive character of the earlier trade mark (paragraphs 38 and 39 of the Decision).

13. The key findings of the Hearing Officer for the purposes of the present appeal are firstly her findings with regard to the comparison of the trade marks and secondly her findings and conclusion with respect to the likelihood of confusion.

14. Before turning to those particular points it is necessary to set out the approach that the Hearing Officer took to the comparison of goods and services which she identified in paragraph 27 of her Decision as follows:

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.

15. With regard to the comparison of the trade marks the Hearing Officer found as follows (footnotes excluded):

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.<sup>1</sup> I do not consider that the average consumer in the UK will understand “PI” to be the Greek letter  $\pi$ , 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)”. 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 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.

16. With regard to the findings and conclusion with respect to the likelihood of confusion the Hearing Officer stated as follows (footnotes excluded):

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. 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).

### **The Appeal**

17. On 4 July 2016 an appeal was filed on behalf of the Opponent pursuant to section 76 of the 1994 Act. In the Grounds of Appeal it was accepted by the Opponent that:
- (1) The Hearing Officer had correctly found (paragraph 33 of the Decision ) that the word SUPPLY in the Applicant's mark is 'descriptive and has little or no distinctive character' in relation to the Contested Goods and services and that the overall impression of the Applicant's mark is 'dominated by the element PI' (paragraph 5);
  - (2) The Hearing Officer had correctly found (paragraph 34 of the Decision) that the Opponent's mark is a figurative mark, consisting of the 'shape of the letter P, which is shaded with diagonal stripes of even size and spacing' and that 'adjoining the letter "P" is a stylised letter "I" presented in outline form' (paragraph 6);
  - (3) The Hearing Officer correctly recognised (paragraph 36 of the Decision) that from an aural perspective the "'PI" or "P-I" element' of the respective marks would be 'articulated in the same way but some difference is introduced by the descriptive word "SUPPLY" in the applicant's mark' and accordingly that the marks are 'aurally similar to a high degree' (paragraph 7);
  - (4) The Hearing Officer was correct to find (paragraph 37 of the Decision) that some average consumers will see the word "pi" as the mathematical constant but that the presentation of the letters in the marks at issue means that the element "PI" could also be perceived as the letters "P-I", with no specific meaning attached to them. As a consequence for those average 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; and
  - (5) It was expressly accepted that the Hearing Officer has correctly set out the law that was to be applied with respect to the issues identified in paragraphs 12(2) to 12(4) (paragraph 9). There was no express acceptance of the law as set out in paragraph 23 of the Decision as identified in paragraph 12(1) above but there was no suggestion that it was incorrect and nor in my view could there have been.
18. In the skeleton of argument filed on behalf of the Opponent on the appeal it was additionally submitted that the Hearing Officer was correct to find (paragraph 43 of

the Decision) that the average consumer of the goods and services at issue will vary from a member of the general public to a tradesperson or skilled professional.

19. No criticism was made as to the assessment of the evidence filed by the Hearing Officer.
20. Against that background the substance of the appeal is that the Hearing Officer erred in the application of the case law to the facts of the present case by:
  - (1) Incorrectly assessing the degree of visual similarity between the marks; and
  - (2) Concluding that the visual similarity was of ‘particular importance, given that the purchase of the goods and services is likely to be predominately visual’ and as a result she gave insufficient weight to the aural similarity between the marksand as a result erred in her finding that there was no likelihood of confusion under section 5(2)(b) of the 1994 Act.
21. No Respondent’s Notice was filed on behalf of the Applicant.
22. At the hearing of the appeal Mr Hussey of A.A. Thornton & Co appeared on behalf of the Opponent and Mr Andrew Norris instructed by Trade Mark Wizards Limited appeared on behalf of the Applicant.

### **Standard of review**

23. As was correctly submitted by Mr Norris on behalf of the Applicant, and not disputed by Mr Hussey, this appeal is by way of review. Neither surprise at a Hearing Officer’s conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.
24. In Fine & Country Ltd v Okotoks Ltd (formerly Spicerhaart Ltd) [2013] EWCA Civ 672; [2014] FSR 11 Lewison LJ said:

50. The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant’s complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position

here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. There are many examples of statements to this effect. I take as representative Lord Hoffmann's statement in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416 , 2423:

‘Secondly, because the decision involves the application of a not altogether precise legal standard to a combination of features of varying importance, I think that this falls within the class of case in which an appellate court should not reverse a judge's decision unless he has erred in principle.’

25. This approach was reiterated by the Court of Appeal in Fage UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] and [115]. Moreover in paragraph [115] Lewison LJ said:

115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations: see *Customs and Excise Commissioners v A* [2002] EWCA Civ 1039; [2003] Fam. 55; *Bekoe v Broomes* [2005] UKPC 39; *Argos Ltd v Office of Fair Trading* [2006] EWCA Civ 1318; [2006] U.K.C.L.R. 1135.

26. The position has been more recently set out in the decision of Geoffrey Hobbs Q.C. in ALTI Trade Mark (O-169-16) at paragraphs [19] to [20] where he referred to the general applicability of the observations of Lord Neuberger PSC in *Re B (a child) (Care Order Proceedings)* [2013] UKSC 33 at paragraphs [93] and [94]:

[93] There is a danger in over-analysis, but I would add this. An appellate judge may conclude that the trial judge's conclusion on proportionality was (i) the only possible view, (ii) a view which she considers was right, (iii) a view on which she has doubts, but on balance considers was right, (iv) a view



which she cannot say was right or wrong, (v) a view on which she has doubts, but on balance considers was wrong, (vi) a view which she considers was wrong, or (vii) a view which is unsupported. The appeal must be dismissed if the appellate judge's view is in category (i) to (iv) and allowed if it is in category (vi) or (vii).

[94] As to category (iv), there will be a number of cases where an appellate court may think that there is no right answer, in the sense that reasonable judges could differ in their conclusions. As with many evaluative assessments, cases raising an issue on proportionality will include those where the answer is in a grey area, as well as those where the answer is in a black or a white area. An appellate court is much less likely to conclude that category (iv) applies in cases where the trial judge's decision was not based on his assessment of the witnesses' reliability or likely future conduct. So far as category (v) is concerned, the appellate judge should think very carefully about the benefit the trial judge had in seeing the witnesses and hearing the evidence, which are factors whose significance depends on the particular case. However, if, after such anxious consideration, an appellate judge adheres to her view that the trial judge's decision was wrong, then I think that she should allow the appeal.

27. It is necessary to bear these principles in mind on this appeal.

### **Decision**

28. As noted above the Hearing Officer found that the marks were visually similar to a low degree. On this Appeal it is submitted that the Hearing Officer should have found that the marks were in fact visually highly similar and that this was a sufficient error or principle to undermine the Decision. In this connection I note that the difference between those two assessments is a difference in outcome of a multi-factorial assessment of the type described by Lewison LJ in the case law outlined above.
29. It is said on behalf of the Opponent that the Hearing Officer was wrong to find that the EUTM was '*fairly heavily stylised*' (paragraph 35 of the Decision). I do not agree.
30. The Opponent does not appear to dispute the description of the EUTM contained in paragraph 34 of the Decision. It is clear from the Decision that the Hearing Officer regarded the EUTM as consisting of the letters 'P' and 'I' with each letter making a roughly equal contribution to the overall impression of the mark. However, the logic of the position put forward on behalf of the Opponent on this appeal is in effect to ignore the fact that the EUTM is a figurative mark and to treat it as a word mark i.e. to effectively ignore the distinctive character attributable to the stylisation. Indeed the

Opponent submitted that *'the comparison between the Marks is closer to a comparison between marks that are identical than between marks that are not confusingly similar'*. This is not correct.

31. In my view the mark is properly described as a figurative mark. It is not a word mark. The letters 'P' and 'I' do not appear in a particular font but instead are in the form of 'shapes'. The 'P' is shaded with diagonal stripes of even size and spacing – there is no 'hole' in the 'P'. Adjoining the 'P' is a stylised 'I' which appears in outline form with the left side of the 'I' created by the right side of the 'P'. In my view the figurative element of the EUTM cannot be regarded as either minimal or as secondary to its word or letter element. The degree of stylisation is highly individual.
32. In these circumstances it seems to me that the Hearing Officer was entitled to find that the particular presentation of the letters 'P' and 'I' was *'fairly heavily stylised'* and that as a whole the marks had a reasonably high degree of inherent distinctiveness on the basis that the distinctiveness was attributable to the particular graphic presentation.
33. With regard to the Hearing Officer's assessment of the mark applied for it seems to me that the reference to the standard typeface in paragraph 35 of the Decision is in this context to be taken as a reference to the fact that the mark applied for is a word mark. It is a word mark made up of two words 'PI' and 'Supply' or by the letters 'P-I' and the word 'Supply'. Any claim to distinctiveness therefore resides in the words or letters and word alone. Whilst as the Hearing Officer correctly held the word 'supply' is descriptive and has little or no distinctive character (paragraph 33 of the Decision) that is not to say that the word can be ignored for the purposes of the relevant comparison. That is the approach that the Hearing Officer adopted when making the comparison that was required.
34. Moreover, the fact that a proprietor of a word mark may use that mark in different scripts, does not encompass as the Opponent submits, use in a form which alters the distinctive character, i.e. where the distinctive character is or is partially attributable to the particular graphic representation, such that the comparison in the present case should effectively have been a comparison between 'identical' word marks. Using the degree of stylisation of the EUTM would not in my view represent normal and fair use of the mark applied for.
35. I therefore do not consider that the Hearing Officer's Decision with regards to the visual similarity is undermined by the alleged errors identified in the Grounds of Appeal.
36. With respect to the assessment of the likelihood of confusion having cited Joined Cases T-117/03 to T-171/03 New Look Ltd v. OHIM (which does not form the basis of any criticism by the Opponent) the Hearing Officer found that the purchase of the

goods and/or services is likely to be '*dominated by visual considerations*' and '*predominately visual*'. The Opponent disputes these findings (1) on the ground that there was no basis for such a finding; and (2) on the ground that such a broad finding should not have been made given the range of goods and services which were in issue.

37. In the written materials that were before the Hearing Officer, the Opponent made no submissions as to the relevant weight that should be given by to the visual, aural and conceptual similarities with regard to the marks in suit. Nor did it seek to draw any distinction, for these purposes, between the different goods and services the subject of the present Opposition. That that was the position is noted by the Hearing Officer in paragraph 25 of her Decision.
38. By contrast the Applicant submitted, again as noted by the Hearing Officer in paragraph 25 of the Decision, with respect to the contested goods in classes 9 and 11 that such goods '*are more likely to be selected and purchased only after the mark had been seen*' and went on to submit that for that reason '*visual similarity ought to be given greater weight*' although it was '*accepted that aural and conceptual considerations will also play a part*'.
39. It is to be further noted that on this Appeal the Opponent has not identified any particular goods or services and/or any categories of goods or services which it says should be assessed by reference to different criteria on the basis that the average consumer is different and/or that the manner in which the goods or services are purchased may be distinguished.
40. In these circumstances it seems to me that the Hearing Officer was entitled to take the view that that the purchases of the goods and services in issue was likely to be predominately visual.
41. Turning more generally to the assessment of the likelihood of confusion it is clear from the findings in the Decision that the Hearing Officer had in mind not only the visual similarities but also that the purchase of the goods and services in issue might include an aural component (paragraph 43 of the Decision) and that whilst she regarded the visual similarity of particular importance she did not discount the aural and conceptual similarity (paragraph 45 of her Decision).
42. In addition, it is apparent that the Hearing Officer having identified that the average consumer of the goods and services in issue would vary and that the level of attention would therefore vary accordingly (paragraph 43 of the Decision) went on to made her findings on the basis of the average consumer being '*a member of the general public paying only a low degree of attention*' (paragraph 45 of the Decision) i.e. from the perspective of the category of average consumer whose perspective would be most favourable to the Opponent.

43. Moreover, the Hearing Officer was also proceeding on the basis as indicated in paragraph 27 of her Decision that all the contested goods and services were identical to those covered by the EUTM. Again the position that was most favourable to the Opponent.
44. Further, it seems to me that the Hearing Officer was right when considering the likelihood of confusion to have regard to the observations of Iain Purvis QC, sitting as the Appointed Person, in The Royal Academy of Arts v. Errea Sport SpA (O-010-16) and in particular ‘. . .*in the case of an earlier mark which is heavily stylised device mark, taking the aural similarities alone tends to ignore the real substance and distinctive character of the mark*’. This is particularly the case in circumstances where the Hearing Officer had found, in my view correctly, that the EUTM possessed a ‘*reasonably high degree of inherent distinctiveness, which is attributable not to the letters themselves but to their particular graphic presentation*’ (paragraph 40 of the Decision). Such particular graphic presentation being no part of the mark applied for.
45. In the premises, given the basis upon which the findings were made by the Hearing Officer i.e. in the context most favourable to the Opponent and where the Opponent has not sought to identify different categories of goods and/or services from which a different perspective should be applied, it does not seem to me that the Opponents criticisms are valid.
46. It seems to me that it was open to the Hearing Officer on the basis of the materials before her to find that ‘*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*’.

### **Conclusion**

47. In the circumstances, I have come to the view that the Opponent has not identified any material error of principle in the Hearing Officer’s analysis or that the Hearing Officer was wrong. I have decided that the Hearing Officer was entitled to find that there was no conflict under section 5(2)(b) of the 1994 Act between the mark applied for and the EUTM.
48. In the result the appeal fails.

49. Neither side has asked for any special order as to costs. Since the appeal has been dismissed the Applicant is entitled to its costs. I order Power Integrations Inc to pay a contribution towards RAAMaudio UK Limited's costs of £1000 within 14 days of the date of this decision, together with the £500 costs awarded by the Hearing Officer below.

Emma Himsworth Q.C.

Appointed Person

19 December 2016