

**O-444-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3224513  
BY ZHEJIANG ORIENTX FIRE SAFETY EQUIPMENT CO., LTD  
TO REGISTER:**

The logo for Orientx features a stylized flame icon on the left, which is a circle with a teardrop shape inside, resembling a flame. To the right of this icon, the word "orientx" is written in a bold, lowercase, sans-serif font.

**AS A TRADE MARK IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 409838 BY ORIENT PAPER & INDUSTRIES LTD**

## BACKGROUND & PLEADINGS

1. On 12 April 2017, Zhejiang Orientx Fire Safety Equipment Co., Ltd (“the applicant”), applied to register the trade mark shown on the cover page of this decision for the goods in class 9 shown in paragraph 11 below. The application was published for opposition purposes on 21 April 2017.

2. On 21 July 2017, the application was opposed in full by Orient Paper & Industries Ltd (“the opponent”). The opposition was originally based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). However, as the opponent filed no evidence of any use it may have made of the European Union Trade Mark (“EUTM”) upon which it relies in these proceedings (see below), the opposition based upon section 5(3) of the Act (which requires such evidence to be filed) cannot possibly succeed and, as a consequence, is dismissed; I need say no more about it in this decision.

3. Insofar as the remaining objection based upon section 5(2)(b) is concerned, the opponent relies upon all of the goods (paragraph 11 refers) in the EUTM registration shown below.

No. 12317211 for the trade mark **ORIENT** which was applied for on 15 November 2013 and registered on 17 April 2014. The opponent states:

“The opposed mark is ORIENTX which differs from the opponent’s mark ORIENT only by the addition of an X and is thus highly similar. The goods are similar and there thus exists a likelihood of confusion including a likelihood of association.”

4. The applicant filed a counterstatement in which the basis of the opposition is denied.

5. In these proceedings, the opponent is represented by Appleyard Lees IP LLP (“AL”) and the applicant by Boulton Wade Tennant. Only the opponent filed evidence; it also filed written submissions during the evidence rounds. Neither party elected to attend a

hearing. Other than a confirmation from the opponent that it was maintaining its position, neither party filed substantive written submissions in lieu of attendance at a hearing.

## **DECISION**

6. 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.”

7. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), 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.”

8. In these proceedings the opponent is relying upon the EUTM shown in paragraph 3 above, which qualifies as an earlier trade mark under the above provisions. As the earlier trade mark upon which the opponent relies had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in section 6A of the Act. It can, as a consequence, rely upon its earlier trade mark in relation to all the goods claimed without having to demonstrate genuine use.

### **The opponent's evidence**

9. This consists of a witness statement from Graham Johnson, a partner at AL, accompanied by two exhibits. I will return to this evidence when I deal with the comparison of goods.

### **Section 5(2)(b) – case law**

10. The following principles are gleaned from the decisions of the courts of the European Union 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 greater 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.

**Comparison of goods**

11. The competing goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<p><b>Class 7</b> - Generators for electricity; dishwashers; Mixer Grinder, Juicer Mixer Grinder, Wet Grinder; Dust exhausting installations for cleaning purposes.</p> <p><b>Class 8</b> - Electric Iron.</p> <p><b>Class 9</b> - Switch gear products including MCB (Miniature Circuit Breaker), RCCB (Residual Current Circuit Breaker), RCBO (Residual Current Circuit Breaker with overload &amp; Short Circuit Protection), Changeover Switch; Inverters; Wires and Cables; UPS (Uninterrupted Power Supply System).</p> <p><b>Class 11</b> - All Ventilating Devices, Electrical Fans of all types; Lighting Devices including CFL (Compact Fluorescent Lamp), Fluorescent Lamp and</p>	<p><b>Class 9</b> - Fire extinguishing apparatus; Fire extinguishers; Fire beaters; Fire engines; Fire boats; Sprinkler systems for fire protection; Fire escapes; Fire hose nozzles.</p>

<p>fittings, Lighting Luminaires and accessories for lighting products; Room Heater system of all types including Convectors, Oil Filled Radiator, Heater with Blower; instant and Storage Electric Water Heater; Microwave Ovens, Oven, Toaster Grills; Electric Kettles; Water Purifiers including Mechanical and RO (Reverse Osmosis); Air Conditioners, Air Coolers, Air Cooler Kits; Refrigerators; Room Purifiers; Dust Filters; Humidifiers [office requisites] and De-humidifiers.</p>	
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12. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

15. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

17. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC stated:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

18. In its counterstatement, the applicant states:

“5. [None of its goods are listed in the opponent’s EUTM] and no similar goods are listed in [the EUTM].”

19. In its submissions, the opponent states:

“3.1...Of particular relevance are goods in class 11. The registration covers “All Ventilating Devices” and therefore covers goods such as “fire ventilators for exhausting smoke”. The registration also covers “Lighting devices including CFL (Compact Fluorescent Lamp), Fluorescent Lamp and fittings, Lighting Luminaires and accessories for lighting products” and therefore covers goods such as “emergency lighting.” Also of particular relevance are goods in class 9. The registration covers goods such as “UPS (Uninterrupted Power Supply System)” and “Wires and Cables” as well as various “Circuit Breakers”. Such goods form part of fire alarm and detector systems as well as part of emergency lighting systems.

3.3. With the exception of “fire engines” and “fire boats” [the goods of the application] are the type sold as parts of a range of goods for protecting buildings and which range of goods also include goods [covered by the opponent’s EUTM] and in particular ventilating devices (which include “fire ventilators for exhausting smoke”) and lighting devices and fluorescent lamps (which include “emergency lighting”).

3.4. Goods such as “sprinkler systems for fire protection” are often installed together with smoke and fire alarm and detector systems and emergency lighting systems and may be integrated with those systems.”

20. Exhibit GPJ1, consists of two pages downloaded from [www.swiftfireandsecurity.com](http://www.swiftfireandsecurity.com) on 20 November 2017 i.e. after the date of the application for registration. It is stated that this exhibit provides:

“3.5...an example of Emergency Lighting being offered alongside Fire Alarms, Extinguishers and Sprinklers.”

21. The first of the pages provided contains a range of entries. Under the heading “Services”, there appears, as a sub-heading, “Fire Protection” under which there appears the following entries: “Fire Alarms”, “Fire Extinguishers”, “Fire Suppression”, “Sprinklers and Risers”, “Fire Risk Assessment”, “PAT Testing”, “Fixed Wire Testing”, “Emergency Lighting”, “Off-Site Monitoring” and “Integrated Technologies”. Under the heading “Emergency Lighting”, there appears, inter alia, the following:

“A well designed, installed and maintained emergency lighting system, combined with a fit for purpose fire alarm system is an essential part of any building’s life safety system.”

22. Exhibit GPJ2 consists of a page from [www.firstalert.com](http://www.firstalert.com) also downloaded on 20 November 2017. It is stated that this exhibit provides:

“3.6...an example of Fire Extinguishers being offered alongside other goods such as Detectors and Safety Products.”

23. The page provided bears an image of a fire extinguisher, above which, under the heading, “Products”, there appears the following headings: “Detectors”, “Fire Extinguishers”, “Cameras & Security Systems”, “Safes & Cash Boxes” and “More Safety Products.” The opponent states:

“3.7 We submit that it is clear that [the goods in its EUTM] are similar to the goods [in the application]. Those goods are sold alongside one another and that the relevant public expect for example that undertakings offering for sale sprinkler systems and other fire extinguishing apparatus will also offer for sale alarm and detector systems and lighting systems and parts therefore.”

24. In its submissions, the opponent makes no mention of its goods in classes 7 and 8. That, I assume, is because like me, it is unable to identify any similarity between those goods and the applicant’s goods in class 9. In its submissions reproduced at paragraph

19 above, at paragraph 3.3, the opponent specifically states that: “with the exception of “fire engines” and “fire boats”...”. As that submission can only, in my view, be interpreted as meaning that once again the opponent is unable to identify any similarity between the named goods in the application and its goods in classes 9 and 11, the opposition to those named goods is dismissed.

25. Although I have considered the opponent’s arguments in relation to why it considers some of its goods in class 9 to be similar to the applicant’s goods, given the comments in *Les Éditions Albert René*, in my view, its best case lies with the broad terms it has identified in class 11 of its registration. In particular, the opponent submits the broad terms in class 11 include specific goods such as “fire ventilators for exhausting smoke” and “emergency lighting”; I agree with that submission.

26. Whilst the physical nature of the competing goods may share similarities, that level of generality tells one little. The specific intended purpose of the applicant’s goods is to put fires out or to facilitate egress from a building which may be on fire. The specific intended purpose of the opponent’s goods is to remove smoke when fire has broken out and to provide lighting when the normal method of lighting employed has failed.

27. Although the method of use of the competing goods differs, both sets of goods come into their own when a fire has broken out; to that extent there is a clear, albeit, more general, overlap in their intended purpose. While the users of the competing goods may also be the same, there is, at least as far as I can tell, no competitive relationship between them. Finally, insofar as complementarity between the goods is concerned, the test in *Kurt Hesse* is a two stage one i.e. one needs to ask oneself is “...there is a close connection between them, in the sense that one is indispensable or important for the use of the other?” and if so, will “customers...think that the responsibility for those goods lies with the same undertaking?”.

28. As I mentioned above, all of the goods at issue come into their own when fire has broken out. Whilst not indispensable i.e. one can still seek to put a fire out and/or

facilitate egress from a building without ventilating equipment or emergency lighting, clearly the former task is likely to be made a good deal easier if the latter goods are deployed. In addition, and although downloaded some six months after the date of the application, as the position was likely to be much the same at the date of application, the evidence provided shows that some undertakings conduct a trade in, for example, fire extinguishing apparatus including sprinkler systems as well as emergency lighting. As a consequence, it appears to me, there is a degree of complementarity between the competing goods.

29. Weighing all these factors and keeping in mind the likely similarity in the users, intended purpose, channels of trade and complementarity, results in an overall degree of similarity I would pitch at between low to medium.

### **The average consumer and the nature of the purchasing act**

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods 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.”

31. The average consumer of the goods now remaining in the application is either a member of the general public or a professional user such as a contractor. Whilst both groups may be average consumers of most, if not all of the goods at issue, some goods are more likely to be routinely selected by a professional user, for example, “Sprinkler systems for fire protection”, “Fire escapes”, “Fire hose nozzles” (in class 9) and the specific goods identified by the opponent i.e. “fire ventilators for exhausting smoke” and “emergency lighting”.

32. As all the goods at issue are likely to be selected from physical outlets on the high street, catalogues and, as the evidence shows, from websites, visual considerations are likely to dominate the selection process. However, given the technical nature of the goods at issue, oral requests to, for example, sales assistants (both in person and by telephone) must also be kept in mind.

33. As to the degree of care the average consumer will display when selecting the goods at issue, even when considered from the perspective of a member of the general public selecting, for example, a fire extinguisher for their home (which is likely to be a not inexpensive, infrequent purchase and in relation to which they will need to satisfy themselves they are selecting the correct extinguisher to deal with the potential risk they have in mind), I would expect a high degree of attention to be paid during the selection process. That said, I accept a lower degree of care may be displayed when selecting less technical/less expensive goods such as “fire beaters”. Although a professional user is likely to select the goods at issue on a more regular basis and thus be more familiar with their various characteristics, as their selection will be commercially motivated, not insignificant sums may well be in play. That, combined with the purpose of the goods at issue, suggests to me that they too are more likely than not to pay a high degree of attention when selecting the vast majority of the goods at issue.

## Comparison of trade marks

34. 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment 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.”

35. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
ORIENT	 The logo for the applicant's trade mark, 'Orientx', features a stylized flame icon to the left of the word 'Orientx' in a bold, sans-serif font.

36. In its counterstatement, the applicant states that its trade mark has:

“2...stylisation in the initial letter, which is strong and striking, and the remainder of the mark is in lower case and in bold, whilst [the opponent's trade mark] is a pure wordmark.”

and:

“3...Besides the visual and phonetic differences, there is a significant conceptual difference: the mark is an invented word whilst the [the opponent’s trade mark] is a dictionary term.”

37. The opponent’s trade mark consists of the word “ORIENT” presented in block capital letters; this word will be well known to the average consumer as will some of its meanings. As no part of the opponent’s trade mark is highlighted or emphasised in any way, the overall impression it will convey and its distinctiveness lies in the single word of which it is composed.

38. The applicant’s trade mark consists of the letters “r-i-e-n-t-x” presented in bold in lower case. Before the letter “r” there appears a device which the opponent describes as having “minimal stylisation with a flame image included in the O” (paragraph 2.1 of its submissions refer). I note the applicant refers to the “stylisation in the initial letter”; I shall do the same. This first letter is presented in a less bold font than the letters which follow it, and although incomplete is, in my view, more likely than not to be construed as a letter “O”. When considered in the context of the purpose of the goods for which the applicant seeks registration, the device which appears within the letter “O” will be construed as an unremarkable representation of a flame. Although the letter and device component appears first and will make a clear visual impact, as it will be construed as a stylised letter “O” within which appears a device relating to the purpose of the goods at issue, it does not, in my view, play an independent and distinctive role within the trade mark. Rather, it forms part of an integrated whole. It is that integrated whole that will convey the overall impression and where the distinctiveness lies.

39. I will now compare the competing trade marks from the visual, aural and conceptual perspectives with the above conclusions in mind.

40. Although the stylisation of the initial letter “O” and flame device creates a clear point of visual difference, in my view, it will still be understood as a letter “O”. That combined with the fact that the competing trade marks share the letters “R-I-E-N-T”/”r-i-e-n-t” in the same order and notwithstanding the applicant’s trade mark also contains an additional letter “x” as the final letter, results in a fairly high degree of visual similarity between the competing trade marks.

41. It is well established that when trade marks consist of a combination of words and figurative components, it is by the word component(s) that the trade mark is most likely to be referred. The pronunciation of the opponent’s trade mark is likely to be uncontentious i.e. as the three syllable word “O-RI-ENT.” Having already concluded that the first letter in the applicant’s trade mark will be construed as a letter “O”, the applicant’s trade mark is, in my view, most likely to be articulated in the same manner i.e. as the word “O-RI-ENT” but, as the opponent suggests, with the final letter “x” pronounced as a “separate sound EX”. In my view, the competing trade marks are aurally similar to a fairly high degree.

42. Finally, the conceptual comparison. The word the subject of the opponent’s trade mark will be well known to the average consumer. The meanings the average consumer are most likely to attribute to this word are, in my view, either “the eastern part of Asia” or when used in, for example, a combination such as “orient yourself” as meaning to “learn about and prepare to deal with a new situation or course of action” (both references are from collinsdictionary.com). In its submissions, the opponent states:

“2.4...The applicant has not invented a word but has simply added an X to the end of an existing word. As such ORIENTX conveys no meaning other than that conveyed by the ORIENT element of the mark. The X simply suggest some derivation from ORIENT such as a model number or sub-range of ORIENT.”

43. The flame device present in the applicant’s trade mark conveys a clear conceptual message alien to the opponent’s trade mark. Whatever meaning the average consumer

attributes to the word “ORIENT”, the letter “x” in the applicant’s trade mark does nothing to modify that meaning. Consequently, the average consumer is likely, in my view, to attribute the same meaning to that part of the applicant’s trade mark that will be construed as the word “Orient”, as it does to the opponent’s trade mark. Considered overall, I find the respective trade marks are conceptually similar to a fairly high degree.

### **Distinctive character of the earlier trade mark**

44. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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 for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

45. As the opponent has filed no evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. I have already commented on the meaning of the word “ORIENT” above. It is a well known word with a number of well known meanings. Considered in the context of some of the goods upon which the opponent relies, for example, emergency lighting, it may be considered as alluding to goods which assist in orientating oneself. However, even if it is understood as referring to the eastern part of Asia, that is, in my view, far too nebulous a geographical indication for the trade mark to be regarded as lacking in distinctive character. Regardless, as a well known word with, inter alia, the meanings mentioned above, it has, absent use, no more than an average degree of inherent distinctive character.

## **Likelihood of confusion**

46. 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 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 it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods 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.

47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

48. Earlier in this decision, I concluded that the competing goods were similar to a low to medium degree and that the average consumers of such goods would select them by predominantly visual means paying a high degree of attention during that process. Having assessed the competing trade marks, I found them to be visually, aurally and conceptually similar to a fairly high degree. Finally, I found that the opponent's trade mark possessed a no more than average degree of inherent distinctive character.

49. In reaching a conclusion, I will proceed on the basis most favourable to the applicant i.e. that the goods at issue are only similar to a low degree. I also remind myself that I have concluded that the average consumer will pay a high degree of attention when selecting the goods at issue (thus making them far less prone to the effects of imperfect recollection). Although I have found the competing trade marks to be visually, aurally

and conceptually similar to a fairly high degree, the differences in the competing trade marks combined with the high degree of attention that will be paid when the goods are being selected, point away from the competing trade marks being mistaken for one another i.e. I think direct confusion is unlikely.

50. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

51. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

52. Once again, I remind myself that I am proceeding on the basis that there is a low degree of similarity in the competing goods and of the high degree of attention that will be paid to their selection. In reaching a conclusion, I will consider the position from the perspective of an average consumer who is familiar with the opponent’s trade mark and

its “fire ventilators for exhausting smoke” and “emergency lighting” goods. Having done so, although the opponent’s trade mark possesses no more than an average degree of inherent distinctive character, the fairly high degree of visual, aural and conceptual similarity between the competing trade marks is, in my view, likely to lead such an average consumer to assume that the applicant’s fire related goods are being sold, for example, under an updated or variant version of the opponent’s trade mark and emanate from the opponent or a related undertaking i.e. in my view, there will be indirect confusion.

### **Overall conclusion**

**53. The opposition has succeeded in relation to all of the goods in the application except “fire engines” and “fire boats”. Subject to any successful appeal, the application will proceed to registration in respect of “fire engines” and “fire boats” and will be refused in relation to all the other goods in the application.**

### **Costs**

54. As the opponent has been largely successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, but making a “rough and ready” reduction to reflect the measure of the applicant’s success and, as the objection based upon section 5(3) was dismissed for lack of evidence, only awarding £100 in respect of the official fee paid, I award costs to the opponent on the following basis:

Preparing the Notice of Opposition and reviewing the counterstatement:	£150
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Preparing evidence:	£250
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Written submissions:	£150
Official fee:	£100
<b>Total:</b>	<b>£650</b>

55. I order Zhejiang Orientx Fire Safety Equipment Co., Ltd to pay to Orient Paper & Industries Ltd the sum of **£650**. 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 23rd day of July 2018**

**C J BOWEN**  
**For the Registrar**