

O-757-18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3269429
BY ADAM HIPKINS
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 11:**

UltraVision

AND

**OPPOSITION THERETO (NO. 411800)
BY RING AUTOMOTIVE LIMITED**

Background and pleadings

1. The applicant is Adam Hipkins. On 9 November 2017 Mr Hipkins filed an application to register the trade mark “UltraVision”. The application was published in the Trade Marks Journal on 1 December 2017.
2. The opponent is Ring Automotive Limited. They are represented by Bailey Walsh & Co LLP. In this decision I will refer to the opponent as Ring Automotive Limited.
3. Ring Automotive Limited are opposing the registration of Mr Hipkins’ trade mark. They are relying on an EU trade mark EU016969115. That trade mark is “RING ULTRAVISION.” It was filed with the EU Intellectual Property Office on 11 July 2017. It was registered by the EU Intellectual Property Office on 4 December 2017.
4. To oppose Mr Hipkins’ application, Ring Automotive Limited had to file with the United Kingdom Intellectual Property Office (“UK IPO”) a notice of opposition and statement of grounds (also known as a TM7) within 2 months of the date on which Mr Hipkins’ trade mark was published. They could extend (for their benefit or the benefit of a related company) the time for filing their TM7 by a further month by first filing a TM7A. They filed a TM7A on 8 January 2018. They filed a TM7 on 1 March 2018, so meeting the extended 3 month deadline.
5. The TM7 requires the opponent to, amongst other things, set out which ground or grounds they are relying upon to oppose the trade mark application. In their TM7 filed on 1 March 2018 Ring Automotive Limited stated they were opposing the application under section 5(2)(a) of the Trade Marks Act.
6. Section 5(2)(a) states:

“A trade mark shall not be registered if because—

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.” [my emphasis]

7. That opposition ground requires the trade marks to be identical. It is self evident that “UltraVision” and “RING ULTRAVISION” are not identical¹. On 7 March 2018 the Registry wrote to Ring Automotive Limited. The Registry also sent a copy of the letter to Mr Hipkins. The letter to Ring Automotive Limited said:

*“I refer to the TM7 filed against the above application on **1 March 2018**.*

The statement of grounds has now been considered and it is the Registrar’s preliminary view that more information is required before any further action can be taken. This is in line with the Tribunal Practice Notice 4/2000 which is available on the IPO website at www.ipa.gov.uk

You are asked to reconsider, or add to, your ground of opposition under Section 5(2)(a) as it appears that your earlier mark is not identical to the applicant’s mark. Also, at Q5 the respective marks are referred to as being ‘highly similar’.

*In light of the preliminary view expressed above, you are invited to file amended grounds, on or before **21 March 2018**. If you choose not to*

¹ For completeness I should add that case law makes clear that trade marks can still be identical where the marks viewed as a whole contain differences so insignificant they may go unnoticed by an average consumer. Here the difference between UltraVision and RING ULTRAVISION, with the addition of “RING” in the earlier mark, is not so insignificant it would go unnoticed by the average consumer. See *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00 and *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch) (where “COMPASS LOGISTICS” was found to be not identical with “COMPASS.”)

amend the statement of grounds the Registrar may move to strike out any grounds which are not adequately particularised.

A copy of this letter together with the statement of grounds has been sent to the applicant. A copy of the TM7 has not been issued thus the period for filing a counter-statement has not commenced.”

8. Ring Automotive Limited therefore filed an amended TM7 on 15 March 2018. In their covering email they explained that the selection of 5(2)(a) in their earlier TM7 was a mistake and that their opposition is based on section 5(2)(b) of the Trade Marks Act. Their second, amended TM7 did properly indicate that their opposition is based on section 5(2)(b).

9. Section 5(2)(b) allows a trade mark registration to be refused where:

“(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.”

10. The amended TM7 was sent to Mr Hipkins on 16 March 2018. The letter told Mr Hipkins he now needed to complete and return his TM8 (notice of defence and counterstatement) by 16 May 2018. On 16 March 2018 Mr Hipkins emailed the UK IPO with a query. He asked whether he was correct in saying that the second TM7 was void as it was filed after the opposition period had closed.

11. The UK IPO wrote to Mr Hipkins on 4 April 2018. The letter from the UK IPO provided another copy of the earlier letter of 16 March 2018 and said:

“The letter sets out the current status of the opposition which is valid. Although the originally filed TM7 required amendment, as it was filed within the extended opposition period the opposition could continue,

*once an amended form was received. The form was corrected and the letter dated 16 March 2018, officially served the amended form TM7 for you to respond, in the form of the filing of a TM8. The TM8 must be filed on or before **16 May 2018**. This deadline **cannot be extended**.”*

12. Mr Hipkins filed his TM8 on 5 April 2018. Ring Automotive Limited filed written submissions on 12 June 2018 which were copied to Mr Hipkins. Mr Hipkins filed written submissions on 7 August 2018. I will return to the content of the TM7, TM8, and the written submissions at the appropriate places later in this decision.
13. Neither Mr Hipkins or Ring Automotive Limited filed any evidence or made a request for a hearing. This decision is therefore reached following a careful consideration of all the papers.

The issues raised

14. Mr Hipkins has raised the following issues in his TM8 and his written submissions:
 - (a) He considers that the second (the amended) TM7 was not filed in time and is therefore void such that Ring Automotive Limited cannot rely on their section 5(2)(b) grounds of opposition;
 - (b) He argues that if the first TM7 was filed within time it does not contain a valid basis on which to oppose the registration of his trade mark. The 5(2)(a) opposition ground relied upon depends upon the competing marks being identical and they are clearly not so;
 - (c) That Ring Automotive Limited’s EU trade mark was not added to the EU Intellectual Property Office’s Register until 4 December 2017; which was 3 days after Mr Hipkins’ UK trade mark was published;

- (d) That Ring Automotive Limited should provide proof of use of their trade mark. Mr Hipkins refers to section 32(3) of the manual of trade marks practice requiring Ring Automotive Limited's trade mark to be in use;
- (e) Mr Hipkins also questions how an EU trade mark can be enforceable in the UK when the UK will no longer be a member state of the EU from 29 March 2019;
- (f) In terms of the substantive merits of Ring Automotive Limited's opposition under section 5(2)(b) (should that be allowed to proceed), Mr Hipkins states that he denies all claims made by the opponent.

I will therefore address these issues in turn.

Issues (a) and (b): The validity of Ring Automotive Limited's first and second TM7s

- 15. Section 38(2) of the Trade Marks Act 1994 states an opponent to a trade mark application must provide a notice of opposition. It states the notice must be in writing in the prescribed manner, and must include a statement of the grounds of opposition. Rule 17 of the Trade Mark Rules 2008 then provides more detail as to exactly what is required. It requires the notice of opposition and statement of grounds of opposition to be filed on Form TM7. Rule 17(5), (6) and (7) then set out various other technical requirements that must be complied with when completing the TM7 such as, amongst other things, the registration number of any earlier mark relied upon, the details of the authority with which it is registered, and the goods and services for which it is registered.
- 16. Rule 17 also prescribes a time limit for filing a TM7. It is 2 months beginning with the date on which the application for registration was published. That period is extended to 3 months where the opponent files a TM7A (a request for an extension of time for filing Form TM7) within the primary 2 month period.

17. Rule 62 of The Trade Marks Rules 2008 states that the Registrar has the power to give directions as to the management of any proceedings as the Registrar thinks fit. This includes, at Rule 62(1)(a), the power to require a document, information, or evidence to be filed within such period as the Registrar may specify and at, Rule 62(1)(e), the power to allow a statement of case to be amended. A statement of case is a formal document that sets out a party's case. They are often also called "pleadings." A statement of case includes a TM7/notice of opposition and statement of grounds.

18. Tribunal Practice Notice 4/2000 is concerned with statements of case in opposition proceedings. It states:

"4. On receipt of a properly filed Form TM7 or TM26 and statement of case the Trade Marks Registry will conduct a preliminary examination of the grounds set out in the statement. If, in the view of the Registry, the statement is in order it will be served in accordance with the Rules, and in the usual way on the other side and the period for the filing of Form TM8 and counter-statement will be set accordingly.

5. If, however, it is the preliminary view of the Registry that the statement of case is not adequately particularised, then the Registrar will adopt the following practice under the provisions of Rule 57 of the Trade Marks Rules 2000:

- i. The Registry will write to the opponent/applicant setting out the areas of the statement of case where it believes that the statement of case has not been adequately particularised and invite the opponent/applicant to file an amended statement of case.*
- ii. A period of 21 days will usually be allowed for any amended statement to be filed. Only exceptionally will a very short extension to that period be allowed. At the same time a copy of this letter together with a copy of the statement of case as filed will be sent to the applicant/proprietor but the Registry will not copy the Form TM7 or relevant TM26, thus, the period for filing a counter-statement will not commence...*

Amendments to statements of case & counter-statements

22. *As parties will be expected to file focussed statements of case and counter-statements, the Trade Marks Registry will consider requests to amend these documents later in the proceedings. Amendments may include adding or removing a ground of opposition/revocation or invalidity or correcting information contained therein. If an amendment becomes necessary parties should seek leave to make the amendment at the earliest opportunity. When seeking leave to amend full details of the amendment together with the reasons for the amendment should be submitted. Whilst each request to amend will be considered on its merits the Registry will aim to give favourable consideration to such requests on the basis that it is likely to avoid a multiplicity of proceedings and thus help resolve the dispute between the parties quickly and at less cost. If the amendment requires the other party to file an amended counter-statement or additional evidence, an award of costs to cover this may be made.”*
19. Ring Automotive Limited filed a TM7A. This extended the time limit in which they had to file a TM7 until 1 March 2018 (a 3 month period starting from the publication of Mr Hipkins’ trade mark application on 1 December 2017). Ring Automotive Limited met that deadline as they filed the first TM7 on 1 March 2018.
20. That was a valid TM7. It was lodged within time. It met the technical requirements set out in Rule 17 of The Trade Marks Rules 2008. It included a statement of the grounds of opposition. The fact that the statement of grounds of opposition were stated to be Section 5(2)(a) and not 5(2)(b) does not mean it invalidated the TM7. They met the basic requirements of the legislation.
21. Applying Tribunal Practice Notice 4/2000 the UK IPO then conducted a preliminary examination of the TM7 and noted the potential difficulties and contradictions within Ring Automotive Limited’s TM7 in purporting to rely upon Section 5(2)(a) in opposition (which depended upon the completing marks being identical) whilst also stating that the marks were “highly similar.” The UK

IPO therefore properly followed Tribunal Practice Notice 4/2000 and invited Ring Automotive Limited to file amended grounds of opposition by 21 March 2018. Ring Automotive Limited did so, confirming there had been a drafting error in the first TM7, and amending their grounds of opposition by confirming that they were relying on Section 5(2)(b) and not relying on Section 5(2)(a).

22. That amendment was accepted by the UK IPO, again under its case management powers, and Mr Hipkins was informed of this in the letter of 16 March 2018 which then required him to file his TM8.
23. There was therefore a valid filing of the first TM7 which contained grounds of opposition. After that, and as a separate event, there was a valid amendment of the grounds of opposition relied upon by Ring Automotive Limited which took the form of the second TM7. In doing so Ring Automotive Limited were amending their grounds of opposition, but their act of filing their first TM7 still stood. These were two separate steps in the opposition process. Ring Automotive Limited's amendment was filed within the time limit allowed by the Registry of 21 March 2018. **Ring Automotive Limited's grounds of opposition, in the form of the amended TM7 are therefore valid and can be relied upon in opposition.**

Issue (c): Whether Ring Automotive Limited can rely on an earlier trade mark

24. Ring Automotive Limited's opposition under Section 5(2)(b) depends upon whether, amongst other things, Mr Hipkins' applied for trade mark is similar to their earlier trade mark.
25. Section 6 of the Trade Marks Act sets out what is meant by an "earlier trade mark." It says:

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

*(a) a registered trade mark, international trade mark (UK) **European Union 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...***

6(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..." [My emphasis]

26. It therefore follows that an earlier trade mark relied upon in opposition can be an European Union trade mark. Section 6(1) also makes clear that to qualify as an earlier trade mark the date that is important is the date **of application for registration.**
27. The EU Intellectual Property Office's register shows that Ring Automotive Limited's trade mark has a filing date, when it was applied for registration, of 11 July 2017. Mr Hipkins' own application for registration at the UK IPO was not made until 1 November 2017. It does not matter that Ring Automotive Limited's trade mark was not registered by the EU Intellectual Property Office until 4 December 2017 (which was 3 days after Mr Hipkins' trade mark was published). What counts is the date of the application for registration. **Ring Automotive Limited's EU trade mark therefore qualifies as an earlier trade mark and can be relied upon to oppose Mr Hipkins' application.**

Issue (d) – whether Ring Automotive Limited have to provide proof of use of their trade mark

28. Mr Hipkins argues that Ring Automotive Limited should be required to prove genuine use of their trade mark.

29. However, as was explained by the UK IPO in their letter to Mr Hipkins of 12 April 2018, Ring Automotive Limited is not subject to the requirement to provide proof of use. This is governed by Section 6A of the Trade Marks Act 1994. This says:

“6A(1) This section applies where—

- (a) an application for registration of a trade mark has been published,*
 - (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and*
 - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.*
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.*
- (3) The use conditions are met if—*
- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or*
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use...”*

30. This section of the Trade Marks Act 1994 means that proof of genuine use of an earlier trade mark would only be required if Ring Automotive Limited’s earlier mark has been registered for 5 years or more at the publication date of

Mr Hipkins' applied for trade mark. This is clearly not the case. Ring Automotive Limited's earlier trade mark had *not* been registered for 5 years or more when Mr Hipkins' trade mark was published. **Ring Automotive Limited are therefore not subject to the proof of use provisions contained within Section 6A of the Trade Marks Act 1994. They can rely on their earlier EU trade mark without having to provide proof of use.**

31. Mr Hipkins also refers to section 32(3) of the manual of trade marks practice requiring Ring Automotive Limited's trade mark to be in use. I believe that Mr Hipkins is referring to Section 32(3) of the Trade Marks Act 1994. This says:

“32(1) An application for registration of a trade mark shall be made to the registrar.

(2) The application shall contain—

(a) a request for registration of a trade mark,

(b) the name and address of the applicant,

(c) a statement of the goods or services in relation to which it is sought to register the trade mark, and

(d) a representation of the trade mark.

(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.”

32. An initial UK application to register a trade mark therefore requires, amongst other things, that the applicant states that their trade mark is in use or that they have a bona fide intention that it will be used.

33. That requirement does not, however, apply to Ring Automotive Limited as a criterion they must meet before they can oppose Mr Hipkins' application. Section 32(3) applied to Mr Hipkins when he was making his own application. It is not a prerequisite that an opponent has to meet to bring an opposition brought under Section 5(2)(b). Indeed, Ring Automotive Limited's earlier trade

mark relied upon is an EU trade mark and its registration would be subject to the separate EU registration and validity requirements which are not within the jurisdiction of the UK IPO or this tribunal and therefore cannot form part of the issues before me. As far as the jurisdiction of this tribunal is concerned, Ring Automotive Limited are not yet subject to the proof of use requirements within Section 6A of the Trade Marks Act 1994 and their use or intention to use their trade mark is not a relevant issue before me.

34. Mr Hipkins also comments that he has been using his trade mark for 8 years whereas Ring Automotive Limited have not used theirs in the category in question to date². I have already dealt with the fact that Ring Automotive Limited do not have to prove genuine use of their earlier mark. In relation to Mr Hipkins' comment that use of his mark pre-dates that of Ring Automotive Limited, this is not a relevant consideration before me. Tribunal Practice Notice 4/2009 states:

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark

4. *The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in Ion Associates Ltd v Philip Stainton and Another, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.*

5. *Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered*

² For completeness, I should note that Ring Automotive Limited deny this. They state they do have a bona fide intention to use their mark in respect of all the goods it is registered for and that they have used the mark on relevant goods within the UK.

its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

35. It follows that Mr Hipkins cannot defend the opposition brought by Ring Automotive Limited on the basis that he used his trade mark before they did or before they registered their trade mark. If Mr Hipkins has any earlier right which could be used to invalidate Ring Automotive Limited's EU trade mark (on which I make no comment at all) then the proper course would have been for him to bring those separate proceedings. It is not a matter before me, and I must proceed to consider Ring Automotive Limited's opposition in accordance with section 5(2)(b) and the relevant case law that relates to Section 5(2)(b).

Issue (e): the impact of BREXIT

36. Mr Hipkins questions how Ring Automotive Limited's EU trade mark can be enforceable in the UK when the UK will no longer be a member state of the EU from 29 March 2019.
37. The short answer is that I must apply the law as it now stands. It is clear from Section 6(1) of the Trade Marks Act, as set out above, that Ring Automotive Limited are entitled to rely upon their EU registered trade mark as an earlier mark, and are entitled to use that earlier mark to bring their opposition under Section 5(2)(b). While the UK remains a member of the EU then EU trade marks continue to be valid in the UK. The future of EU registered trade marks once the UK has exited the EU is not an issue of relevance to the opposition before me.³

³ If of interest to the parties, recent guidance on the future of Intellectual Property laws following the decision that the UK will leave the EU issued by the UK Intellectual Property Office can be found at <https://www.gov.uk/government/news/ip-and-brex-it-the-facts>

Issue (f): Ring Automotive Limited's opposition under Section 5(2)(b) of the Trade Marks Act 1994

38. I therefore turn to the substance of Ring Automotive Limited's opposition under Section 5(2)(b) of the Trade Marks Act 1994.
39. The following principles are gleaned from the judgments 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:
- (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.

40. I must therefore assess globally the likelihood of confusion on the part of the average consumer when they are faced with the parties' competing marks used on the competing goods. Before doing so I must first assess: the similarity

between the parties' goods as set out in their trade mark specifications, who the average consumer for those goods would be, and the visual, aural and conceptual similarity between the marks assessed by reference to their overall impressions and the distinctiveness of the earlier mark. I will proceed to do so in turn.

Comparison of goods

41. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the Court of Justice of the European Union stated:

“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”.

42. Guidance on this issue was also provided in *British Sugar Plc v James Robertson & Sons Limited*⁴, where the following factors were identified as relevant for assessing similarity:

- “(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;*

⁴ [1996] R.P.C. 281

- (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.”*

43. I also remind myself of the guidance given by the courts on the correct interpretation of specifications. In *YouView TV Ltd v Total Ltd*⁵, the court 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”.

44. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*⁶, the General Court stated:

⁵ [2012] EWHC 3158 (Ch)

⁶ case T-133/05

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II- 4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 Vedral V OHIM France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

45. In *Kurt Hesse v OHIM*⁷ the Court of Justice of the European Union stated that complementarity is an autonomous criterion 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)*⁸ the General Court 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”.

46. In *Sanco SA v OHIM*⁹ the General Court indicated that goods and services may be regarded as ‘complementary’, and therefore similar to a degree, in circumstances where the nature and purpose of the respective goods and services are very different: i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking

⁷ Case C-50/15 P

⁸ Case T-325/06

⁹ Case T-249/11

or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*¹⁰:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“...it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

47. Mr Hipkins’ has applied for his trade mark specification to cover “*lighting apparatus for vehicles*” within class 11 of the Nice classification.
48. Ring Automotive Limited’s trade mark covers a specification in Nice classes 9, 11 and 12 as follows [those highlighted in **bold** typeface are my emphasis]:

9:	<i>Safety, security, protection and signalling devices; batteries, jump leads, power packs, inverters, battery chargers and electrical cables for automobiles; video games; photographic flash lamps and photographic flash bulbs; electrical control and switch gear; infrared detection and signalling apparatus; car aerials; batteries; electrical cables; capacitors for vehicles; electric cables for vehicles; signalling apparatus and instruments; apparatus and instruments for switching, regulating or controlling electricity; fittings for wall lights; beacon lights, signalling lights; flashing safety lights; warning lights; lighting controls; electric light dimmers; electric light switches; electric warning lights; helmet safety lights; motion sensitive security lights;</i>
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¹⁰ BL-0-255-13

	<i>security lights for outdoor use; starters for fluorescent lights; light pens; parts and fittings for the aforesaid goods.</i>
11:	<i>Spark plugs for vehicles; accessories for lighting fixtures.</i>
12:	<i>Parts and fittings for motor vehicles, caravans and trailers; heated car seats; towing apparatus for motor vehicles; security apparatus for motor vehicles and for caravans; alarms for motor vehicles and for caravans; wiper blades.</i>

49. Ring Automotive Limited submits that the parties' goods are identical or highly similar. Mr Hipkins has not commented on the similarity of the goods other than to put Ring Automotive Limited to proof of their opposition.
50. Neither party has provided any evidence or submissions as to the meaning of the relevant specifications. I must therefore assess and compare them applying an ordinary meaning to the terms used. "Apparatus" is defined in the Oxford Dictionary to mean: "the technical equipment or machinery needed for a particular activity or purpose". Applying a natural meaning to the words, "Lighting apparatus for vehicles" would therefore encompass the primary components for, and complete lighting systems for, vehicles. This would include, for example, the lighting shell or other fixture/fitting, bulbs or other light sources such as LEDs, reflectors, or the whole unit combined.
51. Ring Automotive Limited's Class 11 specification includes "accessories for lighting fixtures." I understand a lighting fixture to be that part of a light unit, of one form or another, that excludes the bulb/lamp. An accessory is something which can be added to something else to make it more useful or versatile.
52. Some goods which are "accessories for lighting fixtures" may therefore also be included within Ring Automotive Limited's term "lighting apparatus for vehicles." A replacement bulb, or a specialist performance enhancing bulb, for example, could be considered to be both a lighting apparatus for a vehicle and an accessory for a lighting fixture. If so, there would be identity between the two terms on *Merit* principles.

53. If I am incorrect then there would in any event be similarity between the goods.
52. “Accessories for lighting fixtures” is not a term limited to vehicles but, given its classification in Class 11, can include those designed for vehicles. In that context “accessories for lighting fixtures” and “lighting apparatus for vehicles” have a similar overall purpose in the provision of light for vehicles. The users will be the same. There will be some overlap in trade channels as, so far as vehicles are concerned, accessories for lighting fixtures and lighting apparatus are likely to come from the same sources, namely, vehicle manufacturers, garages, specialist retail shops and online. In the vehicle context, depending on the particular goods in question, there may be some degree of competitiveness between accessories for lighting fixtures and lighting apparatus for vehicles. Where the goods are not competitive many “accessories for lighting fixtures” would be complementary to “lighting apparatus for vehicles”. For example, products designed to enhance the performance of vehicular lighting apparatus would perform such a complementary role. The average consumer would also consider that responsibility for such goods lies with the same or economically linked undertakings. Overall there is a medium degree of similarity.
53. There is also a degree of similarity between “lighting apparatus for vehicles” and “flashing safety light; warning lights; parts and fittings for the aforesaid goods” within Ring Automotive Limited’s Class 9 specification. A flashing safety light would include a portable light that are sometimes stored in vehicles and, in the event of a break down, removed and placed behind the vehicle to warn other road users. There would be some similarity between such a good and “lighting apparatus for vehicles”. There is some similarity in purpose as both light apparatus for vehicles and emergency warning lighting both have road safety purposes. The users are the same and there will be some overlap in distribution channels. Such goods would not, however, generally be competitive or complementary. Overall, I would place the degree of similarity here as low.

The average consumer and the purchasing act

54. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question¹¹.
55. 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*¹², , the average consumer was described 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.”

56. Neither party has commented upon the characteristics of the average consumer or the purchasing process. The average consumer of lighting apparatus for vehicles will be commercial buyers such as vehicle manufacturers, garages, mechanics, those who run retail shops and their online equivalents. Average consumers will also include members of the public who will also buy and self-fit lighting apparatus for their vehicles. The price will vary from low for the purchase of a simple replacement bulb to more expensive for a technical, high end lighting system. Whilst this creates some variance, in general terms the average consumer is likely to pay a normal, medium degree of attention when selecting the goods as all average consumers will be seeking to ensure that the lighting

¹¹ *Lloyd Schufabrik Meyer*

¹² [2014] EWHC 439 (Ch)

apparatus has the required specification for the purpose it is being purchased for (such as the correct size, wattage or other specification and appropriateness for their particular vehicle). Where I have found similarity with the goods of the earlier mark, similar characteristics run through the goods.

57. The selection of the goods will largely be visual by way of internet searching, and perusing retail shelves, websites, advertisements and catalogues. Part of the selection process may, however, be via requesting goods from a salesperson, through word of mouth recommendations and oral ordering by telephone. I therefore do not discount aural considerations but the selection process overall is likely to be a largely visual one.
58. **In summary, the average consumer will be both commercial buyers and the general public paying a normal, medium degree of attention. The selection of the goods will largely be visual but I do not discount there also being aural considerations when the purchasing process takes place.**

Comparison of the competing trade marks

59. The case law is clear¹³ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case law also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union has stated¹⁴ 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

¹³ *Sabel BV v. Puma AG* particularly at [23]

¹⁴ *Bimbo SA v OHIM* at [34]

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.”

60. It would be wrong, therefore, to artificially 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 created by them.

61. The trade marks to be compared are:

Applied for mark	Earlier mark
UltraVision	RING ULTRAVISION

62. Ring Automotive Limited submits that the marks are highly similar. Mr Hipkins has not commented directly on the issue other than to put Ring Automotive Limited to proof.

Overall Impressions

63. Mr Hipkins’ mark is a single, invented word, “UltraVision”, made up of two recognisable elements; Ultra and Vision. Neither of these two elements dominate the mark and the overall impression comes from the word as a whole.

64. “RING ULTRAVISION” is made up of two words: “RING” and “ULTRAVISION.” The latter is again an invented word made up of its two recognisable elements. Neither “RING” or “ULTRAVISION” dominate the other in the overall impression made (nor do either of the two components that make up “ULTRAVISION”). Both words play a roughly equal contribution to the overall impression of the earlier mark.

Visual Comparison

65. Visually, there is an obvious point of similarity due to the presence in both marks of the identical, long component “ULTRAVISION”. I appreciate that Mr Hipkins’ mark has the capitalisation of the V and the U (with the remaining letters being lower case). However, this difference cannot be a factor in my assessment because under the principle of notional and fair use the respective marks could be presented in upper case, lower case, and/or upper and lower case lettering.
66. The point of difference is therefore the addition of the word “RING” as the first word in the earlier mark. **Overall, there is a medium degree of visual similarity between the marks.**

Aural Comparison

67. Aurally the average consumer is likely to vocalise the earlier mark as “RING -- ULL-TRA-VISH-UN” and Mr Hipkins’ mark as “ULL-TRA-VISH-UN”. The last 3 syllables of both marks are pronounced identically. The aural difference lies in the earlier mark having the additional first word “RING.” As it is the first word of the earlier mark, the average consumer is likely to pronounce the “RING” when enunciating the mark and is not likely to shorten it to just “ULTRAVISION”. **The marks are therefore aurally similar to a medium degree.**

Conceptual Comparison

68. So far as the conceptual position is concerned, Mr Hipkins’ applied for mark is intended to cover “lighting apparatus for vehicles.” The average consumer normally perceives a mark as a whole and will not overly unpick trade marks to find meanings buried within them. However, when perceiving a verbal mark the average consumer will break it down into elements which suggest a concrete meaning or resemble words known to them¹⁵.

¹⁵ See *ecoblue AG v OHIM* T-281/07

69. The average consumer is therefore likely to perceive “UltraVision” as being overall a made up word but one which is formed by two recognisable elements: “Ultra” and “Vision.” The average consumer is also likely to appreciate, bearing in mind the goods that the mark has been applied for to cover, that the mark as a whole is intended to evoke a concept of being able to see, or have a line of vision, that is extremely or exceptionally good.
70. For Ring Automotive Limited’s earlier mark, the average consumer is likely to perceive and understand “ULTRAVISION” in the same way, and this is despite the fact that their specification covers a much broader range of goods. The average consumers will recognise the “RING” component as being an ordinary English language word. “RING” has a variety of meanings and some average consumers may see it as referring to something circular in shape, or the item of jewellery, or indeed the sound a telephone or a bell makes. If so, “RING” will not be seen as having any conceptual connection either to ULTRAVISION or to the goods in play. Whichever way “RING” is perceived it will not affect how “ULTRAVISION” is perceived and understood by the average consumer as the average consumer will not perceive any conceptual connection between the words.
71. The fact that “ULTRAVISION” is within both marks and will be conceptually understood in the same way in both marks therefore provides some conceptual similarity. Even with the additional wording of “RING” in the earlier mark **there is still a strong conceptual similarity between the competing marks.**

Distinctive character of the earlier trade mark

72. The degree of distinctiveness of Ring Automotive Limited’s earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion¹⁶.

¹⁶ *Sabel BV v Puma AG* at [24]

73. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* the Court of Justice of the European Union stated:

*“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-0000, 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).”*

74. Neither party has commented on this point. As no evidence has been filed, I need only consider the inherent distinctiveness of the earlier mark. It is a rough rule of thumb that invented words usually have the highest level of distinctiveness; words which are laudatory or allusive of the goods usually have the lowest.

75. The earlier mark has two components: “RING” and “ULTRAVISION.” “ULTRAVISION” is an invented word. However, bearing in mind my finding that the average consumer will understand “ULTRAVISION” as evoking a concept

of “being able to see, or have a line of vision, that is extremely or exceptionally good”, it has an allusive character, particularly for some of the goods in play. “ULTRAVISION” is evocative of a characteristic of some of the goods or the effect that those goods are trying to achieve. It also has an element of self-praise as to the goods’ effectiveness. **Overall, the component “ULTRAVISION” therefore has a below average degree of inherent distinctiveness.**

76. “RING” is not laudatory or allusive or descriptive of the goods. It is also not an invented word, but is a standard, everyday word. It has a reasonable level of inherent distinctive character by itself. The combination with “ULTRAVISION” may give the mark, as a whole, slightly more inherent distinctive character than “ULTRAVISION” by itself. However, this is not particularly relevant because it is the distinctiveness of the common element which is key. In *Kurt Geiger v A-List Corporate Limited*¹⁷ the Appointed Person pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it rests in the element of the marks that are identical or similar. He said:

“39. It is 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.”

Likelihood of confusion

77. The factors considered above have a degree of interdependency¹⁸ so that a higher degree of similarity between the goods may offset a lower degree of similarity between the marks, and vice versa. I must make a global assessment

¹⁷ BL O-075-13

¹⁸ *Canon* at [17]

of the competing factors¹⁹, considering them from the perspective of the average consumer and deciding whether the average consumer is likely to be confused.

78. In making my assessment, I must keep in mind 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.²⁰

79. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc;* Case²¹ the Appointed Person, explained these types of confusion as follows:

“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 recognised 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.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume

¹⁹ *Sabel* at [22]

²⁰ *Lloyd Schuhfabrik* at [26]

²¹ BL O/375/10

that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

80. In *Duebros Limited v Heirler Cenovis GmbH*²² the Appointed Person stressed that a finding of indirect confusion should not be made simply 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. He also emphasised that the examples given by Mr Purvis in *L.A. Sugar* were intended to be illustrative in the context of that case, and not to impose rigid rules.²³ The categories of case where indirect confusion may be found are not closed. Each case must be assessed on its own facts, and my assessment must take account of the overall impression created by the marks.
81. Even though I do not rule out the possibility of the marks being directly confused when the effects of imperfect recollection are taken in to account, my finding is that, at the very least, the average consumer would be indirectly confused in relation to the goods at issue.

²² BL O/547/17

²³ See *Duebros Limited v Heirler Cenovis GmbH* at paragraphs [81] to [82]

82. The parties' goods are in a market in which it is conceivable that undertakings will use sub brands or variant branding. If the presence/ absence of "RING" were noticed by the average consumer, that together with the common presence of "ULTRAVISION" in the respective marks, (and even taking into account the below average degree of distinctiveness of "ULTRAVISION"), would indicate to average consumers a "same stable" product. In my view the average consumer would regard the goods covered by the two competing marks as being sub brands or variant branding or overall belonging to two ranges of products which are attributable to the same or economically linked undertaking. I would reach such a conclusion even if the competing goods were considered to have a low degree of similarity.
- 83. The opposition under section 5(2)(b) is successful and Mr Hipkins' applied for mark cannot proceed to registration.**

Conclusion

84. The opposition has been successful and Mr Hipkins' application for registration is hereby refused.

Costs

85. Ring Automotive Limited have been successful and are entitled to a contribution towards their costs. In assessing costs I take into account that the notice of opposition and the written submissions were short with little detail, particularly as to the substantive merits of the opposition. I also take into account that Ring Automotive Limited should not recover any costs associated with the amendment of their TM7. I therefore award:

- £100 official fee for filing notice of opposition;
- £200 for filing a notice of opposition;

- £300 for filing written submissions.

I therefore order Mr Hipkins to pay Ring Automotive Limited the sum of £600.
The above sum should be paid within 14 days of the expiry of the appeal period.

Dated this 26th day of November 2018

Rachel Harfield

For the Registrar

The Comptroller-General