

**O-799-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS. 3149287 AND 3149286  
BY i.am.plus, llc TO REGISTER THE FOLLOWING TWO TRADE MARKS**



**IN CLASSES 9 AND 14**

**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO UNDER  
NOS. 406802 AND 406803 BY DIAL GmbH**

## BACKGROUND AND PLEADINGS

1) i.am.plus, llc (hereafter “the applicant”) applied to register the following two trade marks:

**3149287**



**3149286**

DIAL

2) Both these applications share the same relevant details, namely:

Filing date: 11 February 2016

Publication date: 18 March 2016

**Class 9:** *Accessories for consumer electronics devices, namely, screen protectors for cameras, laptops, mobile phones, MP3 players, tablet computers, and televisions; protective cases and sleeves for wearable computing devices, smartphones, laptops and tablet computers; downloadable music files; multifunctional electronic devices and software for displaying, managing, measuring, and uploading fitness, health, diet, exercise, sleep, weather, tracking and navigational data to the internet; mobile and wearable digital electronic devices for sending, receiving and storage of text, data, audio, video, and image files; smart phones; mobile computing devices; ear buds; headphones; battery chargers; consumer electronic devices in the nature of wearable computing devices, mobile phones, computers and personal digital assistants for creating, editing, and displaying audio, video, audiovisual, and digital content; laptop computers; tablet computers; GPS navigation devices; cameras and camcorders; wearable computing devices; wearable phones; wearable GPS navigation devices; wearable cameras and camcorders; mobile computing devices; health and fitness devices, namely, pedometers, timers, data transmitters and receivers for recording and relaying data regarding physical exercise and health; digital media streaming devices; digital entertainment systems for watching, storing and sharing digital content on computer networks and mobile devices; wireless communication devices for voice, data, music, or image*

*transmission; electronic docking stations, keyboards, and cables for mobile phones and other mobile devices, and carrying cases specially adapted therefor; wireless adapters used to create hotspots to link mobile devices and computers to a telecommunications network; digital media hubs; wireless controllers to monitor and control the functioning and operation of other electronic devices; computer software for mobile wearable digital electronic devices; software to personalize widgets and mobile applications; software for voice and visual recognition; software for personal information management; electronic game software for use on computers and mobile devices; software for creating, editing, and displaying audio, video, audiovisual, and digital content; interactive multimedia software featuring audio, video, audiovisual, and digital content for use in recording, organizing, managing, transmitting, manipulating, and reviewing text, data, audio files, video files and electronic games in connection with computers; software and applications for platforms for consumer electronics devices for use in recording, organizing, managing, transmitting, manipulating, and reviewing text, data, audio files, video files and electronic games in connection with wearable computing devices, computers, music players, video players, and mobile digital electronic devices; operating system programs for wearable digital electronic devices.*

**Class 14:** *Wearable digital electronic devices composed primarily of a wristwatch and also featuring a wrist band and bangle for providing access to a global computer network and for sending and receiving phone calls, electronic mails and messages; wearable electronic handheld devices composed primarily of a wristwatch and also featuring a wrist band and bangle for the wireless receipt, storage and transmission of data and messages and for keeping track of and managing personal information; digital clock.*

3) DIAL GmbH (hereafter “the opponent”) opposes the trade marks. The oppositions are directed against all the goods and services. In both oppositions, the opponent relies upon the following two earlier European Union (formerly Community) trade marks:

Mark and relevant dates	List of goods and services
<p data-bbox="188 1641 547 1738">EU4195442 (“first earlier mark”)</p> <p data-bbox="236 1787 432 1839"><b>DIALux</b></p> <p data-bbox="188 1921 635 1957">Filing date: 15 December 2004</p> <p data-bbox="188 1973 580 2009">Date of entry in register: 30</p>	<p data-bbox="659 1641 1066 1680"><b>Class 9:</b> <i>Computersoftware.</i></p> <p data-bbox="659 1753 1209 1843"><b>Class 42:</b> <i>Design and development of computersoftware.</i></p>

April 2008	
EU1331818 (“second earlier mark”)  DIAL  Filing date: 1 October 1999 Date of entry in register: 22 January 2001	<b>Class 41:</b> <i>Further training initiatives in the field of software for lighting engineering and for electrotechnical and electronic building installation technology.</i>  <b>Class 42:</b> <i>Research, development and creating of software in the field of lighting engineering and electrotechnical and electronic building installation technology.</i>

4) The opponent’s two trade marks are both earlier marks within the meaning of section 6(1) of the Trade Marks Act 1994 (“the Act”) because they have filing dates earlier than the filing date of the contested applications. Both of these earlier marks completed their registration procedures more than five years before the publication date of the contested applications. As a result, they are both potentially subject to the proof of use provisions contained in section 6A of the Act.

5) The opponent’s grounds are identical in both oppositions and are as follows:

- Registration of the contested marks would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) because the contested signs are similar to the first earlier mark, that the contested goods are identical or similar to the goods and services of the opponent’s first earlier mark and that there is a likelihood of confusion. The opponent does not rely upon its second earlier mark for the purposes of this ground;
- Use of the contested marks would offend under section 5(3) of the Act because they are similar to both of the opponent’s earlier marks that have a reputation in the UK. Use of the contested marks, without due cause, would:
  - (i) Take unfair advantage and ride on the coat tails of the reputation of the opponent’s marks by unfairly benefiting from the recognition that attaches to the opponent’s marks and the

years of investment and effort expanded in developing that reputation;

- (ii) be detrimental to the repute of the opponent's marks if the use was in respect of inferior quality goods;
- (iii) be detrimental to the distinctive character opponent's marks in that the economic behaviour of the relevant public will be affected and the opponent's marks impaired because consumers will be less inclined to associate the goods and services with the opponent.

6) The applicant filed counterstatements denying the claims made and putting the opponent to proof of use of its earlier marks.

7) The oppositions were subsequently consolidated. The opponent filed evidence. I will refer to this to the extent that I consider it necessary. Neither side requested a hearing, but both sides filed written submissions in lieu of a hearing. I will keep these submissions in mind. I make my decision after careful consideration of the papers.

8) The opponent was represented in these proceedings by Venner Shipley LLP and the applicant by Lewis Silkin LLP.

### **Opponent's Evidence**

9) This takes the form of a witness statement by Dieter Polle, Chief Executive Officer of the opponent. Mr Polle provides information and exhibits in support of claimed use, in the EU, of the opponent's DIAL mark since 1991 and its DIALux mark since 1995. This evidence can be summarised as follows:

- the opponent is involved in the lighting and automation of buildings and provides software products and services;
- it provides lighting software through its "DIALux" products. This software is used by over 680,000 lighting designers worldwide to design, calculate and

visualise light. The software is available to download from the opponent's website;

- Under its "DIAL" brand, the opponent provides training programmes in the design and automation of intelligent buildings offered through seminars, webinars, e-learning, training courses and study programmes;
- Both marks have been used in the EU and, in particular, in Germany, Austria, France, the Netherlands, United Kingdom, Spain, Ireland, Denmark and Sweden. In addition, the DIAL mark has also been used in Italy;
- DIALux brochures from 2014, 2016 and 2017 are provided<sup>1</sup> showing the capabilities of the opponent's software. The brochures are in English, the opponent's contact details are shown as being in Germany and the prices shown for training related to the software are shown in euros;
- A copy of a front cover of a DIAL brochure dated "02 2014" is provided<sup>2</sup> and is entitled "DIALacademy". It is in German;
- Copies of front sheets of "DIAL seminar programmes" dated 2015, 2016 and 2017 are provided<sup>3</sup>. These all prominently feature the mark DIAL and are also in German;
- Five invoices are provided, all dated 21 January 2014, featuring the DIAL mark, sent to TfL (Transport for London) for five of its employees attending DIAL seminars<sup>4</sup>;
- An invoice for an individual attending a DIAL seminar in London on 14 February 2014 to a UK based company called Digital Lumens;
- A copy of a seminar agenda relating to "DIALux evo user training", dated 10 February 2015, is provided<sup>5</sup> as are two invoices relating to participants at the seminar from a UK based company. The invoices prominently carry the DIAL mark and relate to "DIALux evo 4 user training"<sup>6</sup>;
- A further invoice to, and a confirmation of payment from a UK participant relating to "DIALux evo 5 training" in April 2016 are also provided<sup>7</sup>;

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<sup>1</sup> Mr Polle's Exhibit 1

<sup>2</sup> ditto

<sup>3</sup> ditto

<sup>4</sup> Ditto, page 62 - 66

<sup>5</sup> Ditto, page 70 - 72

<sup>6</sup> Ditto, page 73 - 75

<sup>7</sup> Ditto, page 76 - 77

- Several undated pages of training materials are provided carrying both the DIAL and DIALux marks<sup>8</sup>;
- Mr Polle states that the mark DIAL has been in use for “research, development and creating of software in the field of lighting engineering and electrotechnical and electronic building installation technology”. To support this assertion, he provides a testing laboratory flyer where the DIAL mark appears prominently, that introduces the opponent’s product testing and certification services and training relating to lighting design and software design relating to the same<sup>9</sup>;
- Mr Polle states that during the relevant period, DIALux has been used in the EU in respect of computer software and design and development of the same. To support this claim, he provides the following relevant evidence:
  - The DIALux brochures already referred to (Exhibit 1);
  - Twelve DIALux licensee invoices from 2011 to early 2016, nine of which are to customers in the UK, that also bear the opponent’s DIAL mark<sup>10</sup>;
  - An article discussing the launch of the opponent’s “new DIALux evo 6 software” from a publication called “LPI Sonderausgabe” and with a date of 2016<sup>11</sup>. The article appears in German and English;
  - An article from [www.lighting.co.uk](http://www.lighting.co.uk), dated March 2011, and entitled “Computerised lighting” observes that “Last year DIAL unveiled its new Dialux plug-in”<sup>12</sup>;
  - An article dated “10/2011” states that “DIAL the German lighting software specialists are best known for their DIALux lighting design programme, which was first launched in 1994 [...] Currently DIALux is free to download and is in use by around 400,000 users in 180 countries”<sup>13</sup>;

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<sup>8</sup> Ditto, page 78 - 79

<sup>9</sup> Exhibit 2

<sup>10</sup> Exhibit 3, pages 1 - 12

<sup>11</sup> Ditto, page 22

<sup>12</sup> Ditto, page 24

<sup>13</sup> Ditto, page 27

10) Mr Polle also provides the following combined turnover figures for both of its marks in the EU<sup>14</sup>:

<b>Year</b>	<b>Turnover</b>
2011	€5.1 million
2012	€5.3 million
2013	€5.6 million
2014	€6.2 million
2015	€6.4 million

11) Promotion in the EU is stated as being through attendance at trade fairs and through electronic media in the form of monthly newsletters. The DIAL newsletter has “about 8 to 9 thousand subscribers” and a DIALux newsletter (in English) has “about 20 thousand subscribers” and 1.6 thousand to 2.5 thousand subscribers for German, French, Italian and Spanish language versions<sup>15</sup>. Examples of the two newsletters are provided together with customer lists of to whom they are sent<sup>16</sup>. The customer lists include many customers in the EU as well as many from elsewhere in the world. The newsletters are dated “10/2011” and “05/2012” and headed as “DIAL NEWSLETTER DIALux” and discusses subjects such as “New DIALux partners”, “New electronic catalogues for DIALux” and “DIALux training in France and Italy”. Subscriber statistics are also provided for November 2016: 37499 in England and 10955 in Germany.

12) Evidence of attendance at various trade shows, exhibitions and conferences is also provided<sup>17</sup>.

13) Mr Polle provides a list of “DIALux partners” that appear to be lighting manufacturers who utilise the opponent’s DIALux product. This list is of 178 partners including Panasonic, Phillips, Nikkon, Osram and GE Lighting<sup>18</sup>.

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<sup>14</sup> Mr Polle’s witness statement, para 12

<sup>15</sup> Ditto, para 13

<sup>16</sup> Exhibit 4

<sup>17</sup> Exhibit 5



14) Mr Polle also states that the opponent provides training programmes in lighting design and automation to a number of well-known companies and he provides a list of 18 companies outside the UK (but most appear to be within the EU) and a further 23 companies in the UK<sup>19</sup>.

15) Mr Polle further states that, as of December 2016, there were 19349 active users of DIALux in the UK, 42137 in Germany and 62223 in France<sup>20</sup> and that the DIALux software is used as a planning tool in engineering offices, installation companies, architects and lighting designers.

16) Mr Polle states that the opponent supports its user community through its website, an “app”, YouTube tutorials as well as social media, namely Twitter, Facebook and Flickr<sup>21</sup>.

## **DECISION**

### **Proof of use**

17) Unhelpfully, the applicant, in its written submissions, chose not to comment upon the evidence of use in the context of the use provisions set out below. Consequently, it is unclear whether the applicant accepts that the opponent’s evidence demonstrates the requisite genuine use of its earlier marks.

18) The proof of use provisions are set out at Section 6A of the Act:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

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<sup>18</sup> Exhibit 6

<sup>19</sup> Mr Polle’s witness statement, para 17

<sup>20</sup> Ditto, para 19 and Exhibit 7

<sup>21</sup> Ditto, para 22 and Exhibit 9

(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.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

19) Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

20) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use.* In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by

Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundesvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor.

Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

21) The relevant five-year period in which the opponent must demonstrate use of its marks is 19 March 2011 to 18 March 2016.

22) Firstly, I turn to consider the opponent’s evidence in respect of the claimed use of its DIALux mark. The evidence clearly illustrates use of this mark in both the UK and Germany, in particular, but also other countries of the EU. Whilst I agree with the opponent in its submissions that this evidence demonstrates the requisite use of DIALux, it does not do so in respect of *computer software* and *design and development of computer software* at large. The use has been restricted to such goods and services in the field of building lighting design. It is, therefore, necessary to consider what is a fair specification to reflect the use shown.

23) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

24) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the

specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

25) Taking the above guidance into account, I keep in mind that it is appropriate to consider the particular categories of goods and services that the opponent's terms realistically exemplify. It is not my task to describe the use made by the opponent in the narrowest possible terms unless that is what the average consumer would do. The evidence illustrates that the opponent's DIALux software is all for the purpose of planning lighting and electronic building installation technology. This is a specialist field and I find it correct to allow the category of goods to be couched in terms that reflect this field.

26) Therefore, I find that the opponent may retain the following specifications (that mirror the approach taken by the opponent, itself, in respect of the terms listed in its DIAL earlier mark) in respect of its DIALux mark:

**Class 9:** *Lighting design software*

**Class 42:** *Design and development of lighting design software*

27) In respect of the opponent's DIAL mark, the evidence demonstrates the mark in use both in respect of training programmes and also research, development and creating of software in the same field as identified above. Consequently, the opponent is entitled to rely upon all the services listed in its DIAL earlier mark.

28) I will consider the grounds based upon section 5(2)(b) and section 5(3) with the scope of the opponent's goods and services as defined above.

### **Section 5(2)(b)**

29) Section 5(2)(b) of the Act is 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”.

### ***Comparison of goods and services***

30) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

31) 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

32) I also keep in mind the following guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”):

“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 trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

33) I also keep in mind the following guidance of the GC in *Boston Scientific Ltd v OHIM* - T-325/06:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

34) Finally, in *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

### Similarity to the goods and services

35) The opponent’s submissions regarding the similarity of the applicant’s goods and the services of the opponent’s DIALux registration are based upon the premise that the opponent has retained the broad terms set out in the specifications. In light of my finding regarding proof of use, the scope of these specifications has been reduced. Therefore, whilst I keep the opponent’s submissions in mind, my considerations must be based upon a different premise. Firstly, I consider the similarity of the applicant’s goods with the goods and services of the opponent’s DIALux registration.

### *Class 9*

36) Firstly, the opponent submits that all of the following of the applicant’s Class 9 goods are contained within its broad term *computer software*:

*[...] multifunctional [...] software for displaying, managing, measuring, and uploading fitness, health, diet, exercise, sleep, weather, tracking and navigational data to the internet; [...] computer software for mobile wearable digital electronic devices; software to personalize widgets and mobile applications; software for voice and visual recognition; software for personal information management; electronic game software for use on computers and mobile devices; software for creating, editing, and displaying audio, video, audiovisual, and digital content; interactive multimedia software featuring audio, video, audio-visual, and digital content for use in recording, organizing, managing, transmitting, manipulating, and reviewing text, data, audio files, video files and electronic games in connection with computers; software and applications for platforms for consumer electronics devices for use in recording, organizing, managing, transmitting, manipulating, and reviewing text, data, audio files, video files and electronic games in connection with wearable computing devices, computers, music players, video players, and mobile digital electronic devices; operating system programs for wearable digital electronic devices.*

37) As the opponent’s *computer software* has been limited to its field of activity following my proof of use findings, this has resulted in the respective goods no longer being identical. I go on to consider similarity between the respective goods.

38) The opponent submits that the applicant's *computer software for mobile wearable digital electronic devices; ... software and applications for platforms for consumer electronics devices for use in recording, organizing, managing, transmitting, manipulating, and reviewing text, data, audio files, video files and electronic games in connection with wearable computing devices, computers, and mobile digital electronic devices; operating system programs for wearable digital electronic devices* comprise broad categories of software that may include the opponent's software goods. By way of example the opponent singles out *computer software for mobile wearable digital electronic devices*, submitting that this could include any sort of software, including lighting design software. As a fundamental point, I do not consider that all types of software are similar to all other types of software. This is a point made by the courts on a number of occasions (see for example, *Galileo International Technology LLC v European Union* [2011] EWHC 35 (Ch) at [47]), and the opponent's submissions amount to an argument akin to this. Whilst I accept that it is conceivable that lighting design software could be for wearable digital devices, its core function is to control lighting. The applicant's software, on the other hand, is software with a core purpose for the operation of mobile wearable devices. It is possible that their respective methods of use involve some overlap and, by the fact that both parties' goods are software, they share the same nature, but they differ in all other respects. They are unlikely to share trade channels, the purpose is different and they are not in competition and neither are they complementary in the sense expressed in *Boston Scientific*. Further, their respective consumers are likely to be different. Taking all of this into account, the similarity is only very low.

39) In respect of the following goods, the opponent also makes similar submissions:

*[...] software to personalize widgets and mobile applications; software for voice and visual recognition; software for personal information management; [...] software for creating, editing, and displaying audio, video, audiovisual, and digital content; interactive multimedia software featuring audio, video, audio-visual, and digital content for use in recording, organizing, managing, transmitting, manipulating, and reviewing text, data, audio files, video files [...] in connection with computers [...].*

40) It submits that they remain identical to the opponent's restricted scope of software because the opponent's software comprises a broad category and its purpose overlaps with the applicant's software goods. By way of example, the opponent identifies the applicant's *software for voice and visual recognition* (and others) that it submits could include any sort of software, including lighting design software. My comments in paragraph 37 and 38 apply equally here and, consequently, I find that the respective goods share only a very low level of similarity.

41) Other than a general submission that they are identical (see paragraphs 36 and 37, above), the opponent makes no other submissions regarding the similarity of the applicant's *multifunctional [...] software for displaying, managing, measuring, and uploading fitness, health, diet, exercise, sleep, weather, tracking and navigational data to the internet; [...] electronic game software for use on computers and mobile devices; [...] interactive multimedia software featuring audio, video, audio-visual, and digital content for use in [...] electronic games in connection with computers; [...] software and applications for platforms for consumer electronics devices for use in recording, organizing, managing, transmitting, manipulating, and reviewing text, data, audio files, video files and electronic games in connection with [...], computers, music players, video players, and mobile digital electronic devices; operating system programs for wearable digital electronic devices*. Once again, my comments at paragraph 38 apply here. The core function of this software is different to that of the opponent's lighting software. I find that the similarity is only very low.

42) The opponent also submits that the applicant's various descriptions of software are also similar to its Class 42 services, even where its goods and services are restricted. The applicant's goods fall into two distinct categories. Firstly, there is the software that has a different purpose to that of the software developed by the opponent and the subject of its Class 42 services. By way of example, the applicant's *software for displaying, managing, measuring, and uploading fitness, health, diet, exercise, sleep, weather, tracking and navigational data to the internet* clearly has a different purpose to the software developed by the opponent and, therefore, to its Class 42 services. In respect of such goods I find that there is no similarity. Secondly, there is software that may have some overlapping function to

the opponent's services. I use the same example as the opponent uses elsewhere; the opponent's *software for voice and visual recognition* may have some very low similarity to the opponent's *design and development of lighting design software* where such software may include voice and visual recognition, but such similarity is tenuous. I find that any similarity is only very low.

43) In respect to the applicant's electronic, mobile and computing devices, the opponent submits that the following are similar or complementary to its goods and services:

*multifunctional electronic devices [...] for displaying, managing, measuring, and uploading fitness, health, diet, exercise, sleep, weather, tracking and navigational data to the internet; mobile and wearable digital electronic devices for sending, receiving and storage of text, data, audio, video, and image files; smart phones; mobile computing devices; [...] consumer electronic devices in the nature of wearable computing devices, mobile phones, computers and personal digital assistants for creating, editing, and displaying audio, video, audiovisual, and digital content; laptop computers; tablet computers; [...] cameras and camcorders; wearable computing devices; wearable phones; [...] wearable cameras and camcorders; mobile computing devices; health and fitness devices, namely, pedometers, timers, data transmitters and receivers for recording and relaying data regarding physical exercise and health; digital media streaming devices; digital entertainment systems for watching, storing and sharing digital content on computer networks and mobile devices; wireless communication devices for voice, data, music, or image transmission; [...] wireless adapters used to create hotspots to link mobile devices and computers to a telecommunications network; digital media hubs; wireless controllers to monitor and control the functioning and operation of other electronic devices.*

44) It submits that such devices often incorporate software and software applications required for their functionality. Whilst I accept that such goods may incorporate software for their functionality, however, such software is different in purpose to that of the opponent's software. I accept that many of the applicant's devices may be used as a platform to access software applications but I do not agree that this necessarily results in similarity or complementarity. On the latter point, the respective goods are not important or essential for the opponent's services or vice versa and they are not complementary in the sense expressed in *Boston Scientific*. The respective goods and services differ in their nature, intended purpose, trade

channels and they are not in competition. Therefore, if there is any similarity, it arises only through a similar method of use, with the software being possibly operated through a number of the applicant's devices and any such similarity is only very low.

45) The opponent provides no specific submissions in respect of the remaining goods of the applicant:

*Accessories for consumer electronics devices, namely, screen protectors for cameras, laptops, mobile phones, MP3 players, tablet computers, and televisions; protective cases and sleeves for wearable computing devices, smartphones, laptops and tablet computers; downloadable music files; [...] ear buds; headphones; battery chargers; [...] GPS navigation devices; [...] wearable GPS navigation devices; [...] electronic docking stations, keyboards, and cables for mobile phones and other mobile devices, and carrying cases specially adapted therefor; [...].*

46) In the absence of any submissions and the fact that it is not obvious to me what similarity there is to the opponent's goods and services, I conclude that there is no similarity.

#### *Class 14*

47) In respect of these goods the opponent makes the same submission as to the various of the applicant's Class 9 devices as discussed in paragraphs 42 and 43, above. I found that any similarity is only very low and this is a finding that, for the same reasons, extends to the applicant's Class 14 goods.


#### **Comparison of marks**

48) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23), Case C-251/95, that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, 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.”

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

50) The opponent only relies upon its first earlier mark. I will consider the similarity of each of the applicant’s marks to this mark. Firstly, I will consider the similarity with the applicant’s 3149287 mark:

Opponent’s earlier mark	Applicant’s mark
<p><b>DIALux</b></p>	

51) The opponent’s first mark consists of the word DIAL and the letters “ux”. The mark is likely to be perceived as the word DIAL coalesced with the word LUX. Both these elements retain their own distinctive character within the mark, but due to its relative size and position within the mark, the word DIAL is the dominant and distinctive element of the mark. The applicant’s mark consists of a device positioned to the left of the word DIAL. Both elements are distinctive with the device being slightly more dominant because of its size and position within the mark. However, the word DIAL retains an independent distinctive role within the mark and I also keep in mind that words often “speak louder than devices”.



52) Visually, the opponent's DIALux mark and the applicant's mark share similarity because of the common occurrence of the word DIAL. In all other aspects, the respective marks are different. In the opponent's mark, the word DIAL appears at the start of the mark and is the visually most dominant element. In the applicant's mark, the word DIAL appears to the right of the mark and is slightly smaller than the device element. Taking all of this into account, I conclude that the marks share no more than a medium degree of visual similarity.

53) The device element present in the applicant's mark will not contribute to its aural character and it will be pronounced as the word DIAL with the two syllables DI and AL merging together into a single sound. The opponent's mark is likely to be pronounced as DIAL-UX. The beginning will be identical or virtually identical to the way the applicant's mark is likely to be pronounced. The UX element is absent from the applicant's mark and is a point of difference. Taking all of this into account, I conclude that the respective marks share a medium-high level of aural similarity.

54) The conceptual content of both marks resides in the respective word elements because the device present in the applicant's mark carries with it no obvious concept. The word DIAL is a common English word with a number of meanings, but is likely to be most readily understood as meaning the face of a clock or watch or a disc that is turned to select a setting on equipment such as a radio, a cooker etc<sup>22</sup>. The word "Lux" is a Latin word meaning "light"<sup>23</sup>. Whilst many consumers may not be aware of this, they are likely to, nonetheless, understand it as some vague reference to "light". I also recognise that the consumer may perceive the Lux element of the mark as a reference to "luxury", however, when the mark is seen in respect of the opponent's goods, it is likely that the former perception will predominate. Either way, the addition of the (L)ux element contributes to creating some conceptual difference between the respective marks. I conclude that these marks share a medium degree of conceptual similarity.

55) Secondly, I consider the similarity between the opponent's first mark and the applicant's 3149286 mark:

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<sup>22</sup> <https://en.oxforddictionaries.com/definition/dial>

<sup>23</sup> <https://en.oxforddictionaries.com/definition/lux>

<i>Opponent's earlier mark</i>	<i>Applicant's mark</i>
<b>DIALux</b>	DIAL

56) The applicant's mark consists of the single word DIAL, and is self-evidently its dominant and distinctive element.

57) In respect of the comparison with the opponent's first mark, the level of similarity is higher than when considering the similarity with the applicant's word and device mark. The absence of the device results in the visual similarity being medium high. The aural and conceptual considerations are identical to the earlier comparison and therefore the respective marks share a medium-high level of aural similarity and medium degree of conceptual similarity.

***Average consumer and the purchasing act***

58) 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 question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

59) 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.”

60) The respective goods and services are broad in their application and range from the applicant's devices and software for measuring and uploading fitness, health and diet data (that are very popular with the general public) to the opponent's research in the field of lighting engineering (which is a specialist service likely to be provided to other specialist businesses). In the former, the purchasing process is likely to involve a certain amount of research before purchase, resulting in the level of care and attention being paid to the purchasing process being slightly higher than average. In the latter, a greater degree of care and attention is likely because of the higher costs that are likely to be involved and the need to procure the right services for the task in hand.

61) In all cases the purchasing process is likely to be visual in nature with selection of the goods and services being made from brochures, websites or other visual media, however, I do not ignore that in some cases, promotion may be via non-visual means such as radio advertising or word of mouth.

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

62) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-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).”

63) The opponent’s DIALux mark is likely to be perceived as the words DIAL and LUX coalesced. As I have already found, the word DIAL is a common dictionary word that will be readily understood and the word LUX is likely to be understood as a vague reference to “light” (but I do not ignore that it might also be perceived as a reference to “luxury”). When coalesced they create a mark with at least an average level of inherent distinctive character.

64) The opponent has provided evidence that illustrates that its mark has had an established presence in the EU for a number of years. This presence clearly includes the UK, but the exact scale of use is difficult to assess. Nonetheless, evidence of the running of seminars in the UK, that its DIALux newsletter has 37499 subscribers in England and 19,349 active users of its DIALux products in the UK suggest that the use is sufficient to enhance the distinctive character of its mark. However, it is difficult to identify to what degree because of the absence of information regarding market share, the geographical spread of the services in the UK and so on. However, based on the information before me, I would pitch it as a modest degree of enhancement.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

65) The following principles are gleaned from the decisions of the CJEU 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 great degree of similarity between the marks, and vice versa;

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

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

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

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

66) The applicant submits that the opponent “does not have exclusivity” of the DIAL element, even in Class 9. To support this, the applicant points to 21 other EU and UK registered marks in Class 9 that incorporate the element DIAL. I note these, but I keep in mind the following guidance of the GC in *Zero Industry Srl v OHIM*, Case T-400/06:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71). “

67) Taking this guidance into account, I find that the applicant's evidence of the current state of the register and the number of marks consisting of, or containing the word DIAL, is not persuasive and I reject this submission.

68) All the factors that I have considered need to be taken together as part of the global analysis that I am required to undertake and I also keep in mind that the consumer rarely has an opportunity to encounter marks side-by-side, but rather they must rely upon the recollection of a mark and that this recollection is often imperfect.

*Likelihood of confusion with the applicant's 3149286 DIAL word only mark*

69) My findings can be summarised as follows:

- The word DIAL is the dominant and distinctive element of the opponent's DIALux mark;
- The applicant's mark shares a medium-high level of visual and aural similarity and a medium level of conceptual similarity with the opponent's DIALux mark;
- In respect of the level of similarity with the opponent's goods and services, I concluded that this is very low or not similar at all;
- The level of care and attention being paid to the purchasing process is slightly higher than average or greater;
- the purchasing process is likely to be visual in nature, however, I do not ignore that aural considerations may play a part;
- The opponent's DIALux mark has at least an average level of inherent distinctive character. The mark benefits from a modest level of enhanced distinctive character.

70) Taking all of this into account, I find that the differences between the marks and the fact that the level of similarity is only very low is such as to negate the likelihood of confusion. The specialist nature of the parties' goods, or when not specialised, the different fields of activity are such that the trade channels and consumers are likely to be different. I am of the view that one party's mark will not bring the other to mind.

71) I find that the opposition based upon section 5(2)(b) fails.

*Likelihood of confusion with the applicant's 3149287 DIAL (and device) mark*

72) The addition of the device element, that I have found to be slightly more dominant than the word DIAL, has the effect of further reducing the similarity. Consequently, the likelihood of confusion with the opponent's earlier mark is further reduced. Therefore, in light of my finding of no likelihood of confusion in respect of the applicant's DIAL word mark, it follows that neither will there be a likelihood of confusion in respect of its word and device mark.

73) I find that the opposition based upon section 5(2)(b) relating to the applicant's DIAL and device mark also fails.

74) In summary, insofar as the oppositions are based upon section 5(2)(b) they fail in their entirety.

**Section 5(3)**

75) Section 5(3) states:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark,

(b) (repealed)

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EU) in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

76) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009]



ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

### **Reputation**

77) I must assess if the reputation of the opponent's earlier marks has been established in relation to the relevant section of the public as regards the goods and services for which the mark is registered. In assessing this, I keep in mind the following guidance of the CJEU in *Iron & Smith kft v Unilever NV, Case C-125/14* where it held:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the

relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

78) In the current case there is nothing to suggest to me that the opponent’s marks’ use (and, therefore, claimed reputation) in the EU impacts upon UK consumers. I acknowledge that a reputation in the EU is potentially relevant to my considerations here, but since the requisite link must be made by the UK consumer, if the marks have a reputation in the UK that is likely to put opponent in the strongest position so that is what you will assess. In comparison to the use in the EU, such use is less easily assessed in the evidence. That said, the evidence illustrates that:

- Nine DIALux licensee invoices from 2011 to early 2016 to licensees in the UK that bear the opponent’s DIAL mark;
- The “DIAL newsletter DIALux” had 37499 subscribers in England in November 2016, some nine months after the relevant date in these proceedings;
- Training programmes in lighting design and automation have been provided to 23 companies in the UK, but when this training was provided is unknown;
- As of December 2016 (ten months after the relevant date in these proceedings), there were 19,349 active users of DIALux in the UK.
- Five invoices all dated 21 January 2014 featuring the DIAL mark were sent to TfL (Transport for London) for five of its employees attending DIAL seminars;
- An invoice for an individual attending a DIAL seminar in London on 14 February 2014 to a company called Digital Lumens;

- A copy of a seminar agenda relating to “DIALux evo user training”, dated 10 February 2015, is provided as are three invoices to two different companies with UK addresses;
- An article from [www.lighting.co.uk](http://www.lighting.co.uk), dated March 2011, and entitled “Computerised lighting” observes that “Last year DIAL unveiled its new Dialux plug-in”

79) I note that a number of further exhibits illustrate promotional material produced in English or both English and German, but with English being the international language of business and the opponent stating that it trades widely around the world (and this could include other English-speaking territories such as the USA and Australia), I do not take this as evidence of use in the UK.

80) Whilst some of this evidence falls after the relevant date in these proceedings, when taken as a whole, it illustrates an ongoing business in the UK that is likely to have resulted in the reputation required for the purposes of section 5(3). The existence of over 37000 UK subscribers to the opponent’s DIAL newsletter (that shows both earlier marks prominently) and over 19000 active UK users nine and ten months after the relevant date, respectively, are at such a level that I find it extremely unlikely that these numbers were obtained only from after the relevant date. It is likely that these are illustrative of the time nine/ten months earlier when the contested applications were filed. This points towards the existence of the necessary reputation in the UK. This is further supported by a selection of invoices to UK customers in respect of seminars held in the UK.

81) In summary, I find that the opponent has the requisite reputation in the UK, in respect of both of its earlier marks.

***Link***

82) When assessing the existence of a link, I keep in mind the following guidance of the CJEU in Case C-408/01, *Adidas-Salomon*:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

83) Therefore, the assessment of similarity between the respective marks is the same as for section 5(2). However, I also keep in mind that the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion (*Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, paragraph 72).

84) I have found:

*Similarity of the applicant’s DIAL word mark*

- This is visually and aurally similar to a medium-high degree, and;
- Conceptually similar to a medium degree

to the opponent’s DIALux mark, and:

*Similarity of the applicant’s DIAL word and device mark*

- Visually and conceptually similar to a medium degree, and;
- aurally similar to a medium high degree

to the opponent’s DIALux mark

85) I also need to consider the similarity of the applicant's two marks to the opponent's DIAL word mark. In this respect, I comment as follows:

*Similarity of the applicant's DIAL word and device mark*

- the similarity is a little higher than in respect of the comparison with the opponent's DIALux mark because of the absence of the "ux" element in that mark. This results in the word elements of the respective marks being identical. However, when factoring in the visual impact of the applicant's device element I conclude that the level of similarity is medium to high;
- aurally, the marks are identical;
- the device element present in the applicant's mark does not impact upon its conceptual identity and I find that the respective marks are also conceptually identical.

*Similarity with the opponent's DIAL word mark*

- the marks are identical.

86) This reasonably high level of similarity or identity between the parties' marks is a factor that points towards the existence of the requisite link. However, this is not the end of the matter. I keep in mind that it is possible for unfair advantage or detriment to be made out in circumstances where the respective goods and services are dissimilar. However, the level of similarity or otherwise is, nevertheless, a relevant factor to be taken into account and it remains true that the less similar the goods and services are, then the less likely that the requisite link will exist.

87) The opponent makes a single submission regarding the similarity of the applicant's goods and services to the services covered by its second earlier mark. It submits that the applicant's Class 9 and Class 14 goods are similar and/or complementary to the opponent's software training and research and development services for the same reasons as it set out in respect of similarity to the goods and

services of its DIALux registration. For most of the applicant's goods, I found no more than a very low level of similarity. It is my view that the opponent's services covered by the specifications of its DIAL mark are no more similar and, in fact, less so because its services are one step further removed by virtue of being training, research and development services. I find that there is no similarity.

88) The high point of the opponent's case rests in two different circumstances:

- (i) in respect of the applicant's DIAL word mark where it shares a medium-high level of visual and aural similarity and a medium level of conceptual similarity to the opponents DIALux mark. Here the respective goods and services, at best, share a very low level of similarity, and/or;
- (ii) in respect of the applicant's DIAL word mark that is identical to the opponent's DIAL mark. However, here I have found that there is no similarity between the respective goods and services.

89) I have found that none of the respective goods and services share anything more than a very low level of similarity because the core purpose of the respective goods and services have little, if any overlap. Consequently, the trade channels and consumers are likely to be different. When this is factored into my considerations, I find that the reputation attached to the opponent's marks is unlikely to transcend its business area or closely related business area. The applicant's goods relate to a field both distinct and distant from that of the opponent's goods and services.

90) Taking all of the above into account, I find that despite the reasonably high level of similarity/identity of the respective marks, the requisite link does not exist.

91) In light of my finding, it is not necessary for me to consider the opponent's case in respect of detriment and unfair advantage.

## **Summary**

92) The opposition fails on all grounds and the application can proceed to registration.

## Costs

93) The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. I take account that only the opponent filed evidence and that both sides filed written submissions. I award costs as follows:

Considering opponent's statements and preparing counterstatements	£350
Considering evidence	£500
Preparation of written submissions	£350
<b>TOTAL</b>	<b>£1200</b>

94) I order Dial GmbH to pay to i.am.plus, llc the sum of **£1200**. 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 13<sup>th</sup> day of December 2018**

**Mark Bryant**  
**For the Registrar**  
**The Comptroller-General**