

O-027-21

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF**  
**TRADE MARK APPLICATION NO. 3415006**  
**BY DEXTRA GROUP PLC**  
**TO REGISTER**

**ABOVE & BEYOND**

**AS A TRADE MARK IN CLASSES 9 & 11**

**AND**

**OPPOSITION THERETO**  
**UNDER NO. 418956**  
**BY LOUIS POULSEN A/S**

## Background and pleadings

1. On 18 July 2019, Dextra Group Plc (“the applicant”) applied to register the trade mark shown below under number 3415006:

Above & Beyond

2. The application was published for opposition purposes on 4 October 2019 for the following goods:

Class 9 Lighting ballasts; Lighting control apparatus; Lighting control software for use in commercial and industrial facilities; Lighting devices for taking pictures; Lighting dimmers; Electronic ballasts for lighting purposes; Lighting ballasts; Lighting control apparatus; Lighting control software for use in commercial and industrial facilities; Lighting dimmers. None of the aforesaid goods are for vehicles or in relation to vehicles or for the automotive industry.

Class 11 Apparatus and instruments for lighting; Apparatus for lighting; Arc lamps [lighting fixtures]; Architectural lighting fixtures; Lighting; Lighting and lighting reflectors; Lighting apparatus; Lighting apparatus and installations; Lighting fittings; Lighting fixtures; Lighting fixtures for commercial use; Lighting fixtures for household use; Lighting for display purposes; Lighting installations; Lighting lamps; Lighting louvres; Lighting panels; Lighting tracks [lighting apparatus]; Lighting units; Apparatus and installations for lighting; Apparatus and instruments for lighting; Apparatus for lighting; Arc lamps [lighting fixtures]; Architectural lighting fixtures; Color filters for lighting apparatus; Commercial lighting fixtures; Computer controlled lighting apparatus; Computer controlled lighting instruments; Computer-controlled lighting apparatus; Computer-controlled lighting instruments; Decorative electric lighting apparatus; Diffusers being parts of lighting

apparatus; Diffusers being parts of lighting installations; Discharge tubes, electric, for lighting; Display lighting; Electric apparatus for lighting; Electric discharge tubes for lighting; Electric indoor lighting apparatus; Electric indoor lighting installations; Electric lighting; Electric lighting apparatus; Electric lighting fixtures; Electric lighting installations; Electric track lighting units; Electrical discharge lighting fixtures; Electrical discharge tubes for lighting purposes; Electrical lamps for indoor lighting; Electrical lamps for outdoor lighting; Electrical lighting fixtures; Electrical lighting fixtures for use in hazardous locations; Emergency lighting; Emergency lighting apparatus; Emergency lighting installations; Fiber optic lighting fixtures; Fiber optic lighting installations; Fiber optic lighting fixtures; Flat panel lighting apparatus; Fluorescent lighting apparatus; Fluorescent lighting tubes; Fluorescent luminaires for architectural lighting; Fluorescent luminaires for stage lighting; HID [high-intensity discharge] architectural lighting fixtures; HID [high-intensity discharge] stage lighting fixtures; Halogen architectural lighting fixtures; Halogen stage lighting fixtures; Indoor electrical lighting fixtures; Indoor fluorescent electrical lighting fittings; Indoor fluorescent lighting fixtures; Industrial lighting fixtures; Installations for electric lighting; Installations for lighting; LED [light-emitting diode] lighting fixtures; LED lighting assemblies for illuminated signs; LED lighting fixtures; LED lighting installations; Lamps for lighting purposes; Lamps for security lighting; Lanterns for lighting; Light Emitting Diode lighting fixtures; Light-emitting diodes [LED] lighting apparatus; Luminaires for outdoor lighting; Luminous cables for lighting purposes; Luminous tubes for lighting; Magnesium filaments for lighting; Organic light emitting diodes (OLED) lighting devices; Outdoor electrical lighting fixtures; Outdoor lighting; Outdoor lighting fittings; Pendant fluorescent lighting fixtures; Photocells (Security lighting operated by -); Plasma Lighting System [PLS] lighting; Reflectors adapted for lighting apparatus; Reflectors for wide area

lighting fixtures; Lighting; Lighting and lighting reflectors; Lighting apparatus; Lighting apparatus and installations; Lighting being for use with security systems; Lighting devices for showcases; Lighting elements; Lighting fittings; Lighting fixtures; Lighting fixtures for commercial use; Lighting fixtures for household use; Lighting for display purposes; Lighting installations; Lighting lamps; Lighting louvres; Lighting ornaments [fittings]; Lighting panels; Lighting tracks [lighting apparatus]; Lighting transformers; Lighting tubes; Lighting units; Sconce lighting fixtures; Security lighting incorporating a movement activated sensor; Security lighting incorporating an infra-red activated sensor; Suspension rails [not electrified] for electrical lighting fixtures; Tubes (Discharge -), electric, for lighting. None of the aforesaid goods are for vehicles or in relation to vehicles or for the automotive industry.

3. Louis Poulsen A/S (“the opponent”) filed a notice of opposition on 2 January 2020 on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods in the application. The opponent relies upon the below mentioned International Registration (“IR”) protected in the European Union (“EU”):<sup>1</sup>

Mark: ABOVE

IR registration no. 1344876

International Registration date: 11 January 2017

Date of protection granted in EU: 24 October 2017

Goods relied upon:

Class 11 Apparatus for lighting, including lighting fixtures, lighting apparatus and installations, electrical lamps, light bulbs, lamp chimneys, lamp mantles, lamp globes, overhead lamps, chandeliers, fluorescent lamps for lighting.

---

<sup>1</sup> Although the UK has now left the EU, as these proceedings were commenced before 31 December 2020, the UK’s departure from the EU does not impact upon the opponent’s ability to rely upon the IR that designates the EU.

4. The opponent argues that there is a likelihood of confusion, including a likelihood of association because the competing marks are similar, and the goods are identical or highly similar.
5. Given its date of filing, the trade mark upon which the opponent rely qualifies as an earlier trade mark in accordance with section 6 of the Act.
6. The applicant filed a counterstatement denying the grounds of opposition.
7. The opponent is represented by Potter Clarkson LLP and the applicant is a litigant in person. Only the opponent filed evidence which I will refer to later in the decision. No hearing was requested. Only the opponent filed written submissions in lieu. I make this decision after a careful reading of all the papers filed by the parties.

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

8. 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”.

### **Case law**

9. The following principles are gleaned from the judgments of the European Union (“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

*C3/03, Medion AG v Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L.Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.*

The principles:

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

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

(c) The average consumer normally perceives the 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 to mind the earlier mark, is not sufficient;

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

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

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

10. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer.

11. 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”.

12. The average consumers of the competing goods comprise of members of the general public and business customers. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural element to the purchase. The goods are unlikely to be subject to frequent purchases. Their price may vary, for example, light bulbs for domestic use are cheaper than lighting devices used for taking pictures or lighting used for industrial purpose. When making a purchase, the average consumer may consider factors such as output, compatibility and safety, as well as energy consumption or cost. These factors suggest that the average consumer consisting of the general public is likely to pay a degree of attention that is likely to vary from low to medium. A business user is likely to pay a fairly high degree of attention.

### **Comparison of goods**

13. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

14. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:



- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“[...] 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”.

16. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU 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), Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

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

17. In *Sanco SA v OHIM*, Case T-249/11, the GC 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 or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“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”.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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 T-110/01 *Vedial 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).”

19. The applicant submits:

“Dextra Group of Companies does not manufacture any products for the domestic/residential sector. All our products are for the industrial, commercial or retail sectors, such as; offices, education, health, warehousing, car parks and retail stores environment. We do not sell anything through retail shops in the UK. All of our sales go through the electrical wholesale route, electrical contractor route or directly to an end client in one of the industrial sectors mentioned above. We therefore feel there can be no confusion at all by the relevant public, as we operate in completely different market sectors.”<sup>2</sup>

20. For its part, the opponent submits:

“We submit that this is (the applicant’s above referred submission) irrelevant to the assessment of similarity between the respective goods

---

<sup>2</sup> See the applicant’s counterstatement.

at issue in this case, since the marks both cover lighting goods generally and the opponent's earlier mark is not subject to use requirements.

We further draw attention to the opponent's evidence, namely the Witness Statement of Mr Rosenkvist at paragraphs 4-8 which confirms that this is an artificial distinction to make in respect of lighting products. We therefore request that the assessment of likelihood of confusion is judged solely on a comparison of each party's marks and goods, judged by an average consumer of the goods in question, who will be reasonably informed and observant."<sup>3</sup>

21. The opponent's evidence consists of a witness statement from David Obel Rosenkvist together with five exhibits. The evidence contains only examples of various lightings marketed towards private customers and businesses. As rightly noted by the opponent, the applicant's actual use of the mark in the marketplace is irrelevant to the decision I must make. Irrespective of whether the applicant's goods are intended to target only the industrial or wholesale sector, I must compare the goods based on the mark's notional and fair use in all the circumstances in which the applicant may use if they were registered.<sup>4</sup> I must then assess any potential conflict of the applicant's goods as they appear in the register with the goods upon which the opponent is entitled to rely. Therefore, the opponent's evidence is of no assistance to the issues before me, though the purpose behind its filing is understandable.

### Comparison of goods

<b>Applicant's goods</b>	<b>Opponent's goods</b>
<u>Class 9</u> Lighting ballasts; Lighting control apparatus; Lighting control software for use in commercial and industrial	

<sup>3</sup> See the opponent's written submissions dated 27 October 2020 paragraphs 12 and 13.

<sup>4</sup> see *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84 and *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06) at paragraph 66.

facilities; Lighting devices for taking pictures; Lighting dimmers; Electronic ballasts for lighting purposes; Lighting ballasts; Lighting control apparatus; Lighting control software for use in commercial and industrial facilities; Lighting dimmers. None of the aforesaid goods are for vehicles or in relation to vehicles or for the automotive industry.

Class 11

Apparatus and instruments for lighting; Apparatus for lighting; Arc lamps [lighting fixtures]; Architectural lighting fixtures; Lighting; Lighting and lighting reflectors; Lighting apparatus; Lighting apparatus and installations; Lighting fittings; Lighting fixtures; Lighting fixtures for commercial use; Lighting fixtures for household use; Lighting for display purposes; Lighting installations; Lighting lamps; Lighting louvres; Lighting panels; Lighting tracks [lighting apparatus]; Lighting units; Apparatus and installations for lighting; Apparatus and instruments for lighting; Apparatus for lighting; Arc lamps [lighting fixtures]; Architectural lighting fixtures; Color filters for lighting apparatus; Commercial lighting fixtures; Computer controlled lighting apparatus; Computer

Class 11

Apparatus for lighting, including lighting fixtures, lighting apparatus and installations, electrical lamps, light bulbs, lamp chimneys, lamp mantles, lamp globes, overhead lamps, chandeliers, fluorescent lamps for lighting.

<p>controlled lighting instruments;  Computer-controlled lighting apparatus;  Computer-controlled lighting instruments;  Decorative electric lighting apparatus;  Diffusers being parts of lighting apparatus;  Diffusers being parts of lighting installations;  Discharge tubes, electric, for lighting;  Display lighting;  Electric apparatus for lighting;  Electric discharge tubes for lighting;  Electric indoor lighting apparatus;  Electric indoor lighting installations;  Electric lighting;  Electric lighting apparatus;  Electric lighting fixtures;  Electric lighting installations;  Electric track lighting units;  Electrical discharge lighting fixtures;  Electrical discharge tubes for lighting purposes;  Electrical lamps for indoor lighting;  Electrical lamps for outdoor lighting;  Electrical lighting fixtures;  Electrical lighting fixtures for use in hazardous locations;  Emergency lighting;  Emergency lighting apparatus;  Emergency lighting installations;  Fiber optic lighting fixtures;  Fiber optic lighting installations;  Fibre optic lighting fixtures;  Flat panel lighting apparatus;  Fluorescent lighting apparatus;  Fluorescent lighting tubes;  Fluorescent luminaires for architectural lighting;  Fluorescent</p>	
---	--

luminaires for stage lighting; HID [high-intensity discharge] architectural lighting fixtures; HID [high-intensity discharge] stage lighting fixtures; Halogen architectural lighting fixtures; Halogen stage lighting fixtures; Indoor electrical lighting fixtures; Indoor fluorescent electrical lighting fittings; Indoor fluorescent lighting fixtures; Industrial lighting fixtures; Installations for electric lighting; Installations for lighting; LED [light-emitting diode] lighting fixtures; LED lighting assemblies for illuminated signs; LED lighting fixtures; LED lighting installations; Lamps for lighting purposes; Lamps for security lighting; Lanterns for lighting; Light Emitting Diode lighting fixtures; Light-emitting diodes [LED] lighting apparatus; Luminaires for outdoor lighting; Luminous cables for lighting purposes; Luminous tubes for lighting; Magnesium filaments for lighting; Organic light emitting diodes (OLED) lighting devices; Outdoor electrical lighting fixtures; Outdoor lighting; Outdoor lighting fittings; Pendant fluorescent lighting fixtures; Photocells (Security lighting operated by - );Plasma Lighting System [PLS] lighting; Reflectors adapted for lighting apparatus; Reflectors for wide area

<p>lighting fixtures; Lighting; Lighting and lighting reflectors; Lighting apparatus; Lighting apparatus and installations; Lighting being for use with security systems; Lighting devices for showcases; Lighting elements; Lighting fittings; Lighting fixtures; Lighting fixtures for commercial use; Lighting fixtures for household use; Lighting for display purposes; Lighting installations; Lighting lamps; Lighting louvres; Lighting ornaments [fittings]; Lighting panels; Lighting tracks [lighting apparatus]; Lighting transformers; Lighting tubes; Lighting units; Sconce lighting fixtures; Security lighting incorporating a movement activated sensor; Security lighting incorporating an infra-red activated sensor; Suspension rails [not electrified] for electrical lighting fixtures; Tubes (Discharge -), electric, for lighting. None of the aforesaid goods are for vehicles or in relation to vehicles or for the automotive industry.</p>	
---	--

22. All of the applicant's goods are subject to a limitation that none of its goods are for vehicles or in relation to vehicles or for the automotive industry. Although the applicant's scope of protection is restricted, the opponent's specification is not subject to any such limitation. Instead, the opponent's registration affords protection across the full width of its specification. Therefore, the limitation does not assist the applicant.



## **Contested goods in Class 9**

### Lighting devices for taking pictures

23. Lighting devices for taking pictures are lighting equipment such as studio lighting used while capturing images. These are identical to the opponent's apparatus for lighting under the *Meric* principle.

### Lighting ballasts; Electronic ballasts for lighting purposes

24. Lighting ballasts are types of electrical resistor that supply mains power to a light bulb. Although the nature, purpose and method of use of the applicant's goods differ from an apparatus of lighting covered by the opponent's specification, the applicant's goods are indispensable for the use of the opponent's goods, and the average consumer is likely to think that the goods originate from the same undertaking. They are, therefore, complementary in the sense described by the case law. The users and the channels of trade will overlap. Considering these factors, I find that the competing goods are similar to a medium degree.

### Lighting control apparatus; light dimmers

25. The above-listed goods in the application are devices used to control the amount of light emitted from lighting apparatus such as a lamp. Their nature and method of use differ from the applicant's lighting apparatus. The goods are likely to coincide in their trade channels. The users are the same. The opponent's goods are indispensable for the applicant's goods, and the average consumer is likely to think that the goods originate from the same undertaking. Considering these factors, I find that the goods are similar to a medium degree.

### Lighting control software for use in commercial and industrial facilities

26. The applicant's software allows users to control the amount of light emitted from an apparatus for lighting such as lamp covered by the opponent's specification.

The nature of such software differs from the opponent's goods, so do their purpose and method of use. The users may overlap. Their manufacturers and channels of trade are likely to coincide. However, the goods are neither complementary in the sense described by the case law nor do they compete. Considering these factors, I find that the goods are similar to a low degree.

### **Contested goods in Class 11**

27. The opponent argues that all the contested goods in Class 11 are identical to the opponent's goods.<sup>5</sup> I agree. I find that the opponent's apparatus for lighting, including lighting fixtures and installations can be widely construed to include not only an equipment that provides source of light such as a bulb or lamp but also include any equipment that helps to improve the quality of illumination such as lighting reflectors, diffusers or colour filters. I find that all of the applicant's goods are identical to the opponent's goods because the applicant's goods are either identically contained in the opponent's specification or falls within the broad category of the opponent's goods under the *Meric* principle.

### **Distinctiveness of the earlier mark**

28. The distinctive character of the earlier mark must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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

---

<sup>5</sup> See the opponent's submissions dated 27 October 2020 paragraph 14.

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).

29. 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).”

30. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the marks. The opponent has neither claimed nor filed evidence to substantiate that its mark possesses an enhanced distinctive character. Therefore, I have only the inherent position to consider.

31. Although the word “Above” is neither allusive nor suggestive of the goods at issue, it is not particularly distinctive in relation to lighting which is usually positioned at a certain distance above floor level. I consider the mark’s inherent distinctiveness to be no more than a medium degree.

### **Comparison of marks**

32. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the 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 in 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.”

33. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the 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.

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

<b>Opponent's trade mark</b>	<b>Applicant's trade mark</b>
ABOVE	Above & Beyond

35. The opponent's mark is comprised of the word "ABOVE", and the overall impression of the mark lies in that word.

36. The applicant's mark is comprised of a combination of words "Above" and "Beyond" with an ampersand symbol between them. The components will form a unit with meaning. All the elements make an equal contribution to the overall impression of the mark.

37. The opponent makes the following submissions on comparison of the marks:

“The contested sign includes the identical word “Above” together with the symbol “&” and the word “Beyond”. It is submitted that the additional elements in the contested sign are insufficient to avoid similarity with the opponent’s mark in view of the identical shared element. Further, the

word “Beyond” does not have an independent meaning in the mark as a whole which would help to differentiate the marks but is instead tied unequivocally to the word “Above” in the mark, the phrase “Above & Beyond” being a recognisable phrase to consumers.”<sup>6</sup>

38. Visually both marks coincide in the word “Above” which is the only element in the opponent’s mark. In terms of differences, the applicant’s mark contains an ampersand symbol and the word “Beyond” both of which do not have counterparts in the opponent’s mark. I take into that the shared element opens the mark (with the attention of the average consumer tending towards the start of marks), but also note that the earlier mark is quite short, being just a single word, whereas the contested mark is more than twice its length. Weighing up the similarities and differences, I find that the marks are visually similar to – at most - a medium degree.

39. The opponent’s mark contains a single word and will be pronounced entirely conventionally. The ampersand symbol in the applicant’s mark represents the word “and”. The applicant’s mark will, therefore, be pronounced as three separate words - “above”, “and” and “beyond”. The marks coincide in the pronunciation of the word “Above”. The second and third words in the applicant’s mark, which do not have counterparts in the opponent’s mark, introduce the aural difference between the marks. Considering these factors, I find that the marks are aurally similar – again, at most - to a medium degree.

40. Regarding the conceptual comparison, the word “above” in the opponent’s mark has more than one meaning; the most relevant meaning is - “if one thing is above another one, it is directly over it or higher than it”.<sup>7</sup> Although the marks coincide in the word “above”, in the applicant’s mark, this word does not retain an independent distinctiveness. Instead, it hangs together with the remainder of the words - “and (&) beyond”- to form a phrase, which, as the opponent submitted is one that will be recognised by consumers, meaning “in addition

---

<sup>6</sup> See the opponent’s submissions dated 27 October 2020 paragraph 9.

<sup>7</sup> See <https://www.collinsdictionary.com/dictionary/english/above> (accessed 5 January 2021)

to”<sup>8</sup> and suggesting an exceeding of expectations. As both marks convey different meanings to the average consumer, I find that the marks are conceptually different. I, therefore, reject the opponent’s suggestion that the word “beyond” has no differentiating significance in the marks: while the ampersand indeed ties it to the word “above”, the resultant phrase carries a distinct meaning.

## Likelihood of Confusion

41. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the trade marks (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent’s trade marks, as the more distinctive those trade marks are, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

42. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related).

43. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that

---

<sup>8</sup> See <https://www.collinsdictionary.com/dictionary/english/above-and-beyond> (accessed 5 January 2021)

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

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

45. In my view, the additional elements in the applicant’s mark are sufficiently prominent to avoid direct confusion. That leaves only the indirect confusion to be considered.

46. I have found the respective marks to be visually and aurally similar to (at most) a medium degree and conceptually different. The goods will be selected primarily by visual means, with a low to medium degree of attention paid by the general public and a fairly high degree of attention by the business users. The goods are either identical or similar to varying degrees.

47. Although the competing marks share the common word “above” at the beginning, I bear in mind that the distinctiveness of the common element is key<sup>9</sup>, and in the case before me, the distinctiveness of the shared element is limited. I have concluded that the word “above” does not retain an independent

---

<sup>9</sup> Kurt Geiger v A-List Corporate Limited, BL O/075/13

distinctive significance within the applicant's mark "Above & Beyond", instead it forms a unit with a meaning different to the meaning of the constituent parts. I also note that the opponent has acknowledged that the phrase "Above & Beyond" is a recognisable phrase to the average consumers<sup>10</sup>. In those circumstances, the average consumer is likely to recognise the different meanings the respective marks convey instantly. With the limited distinctive impact of the common element together and an (at most) medium degree of visual and aural similarity and the conceptual difference, the average consumer is unlikely to think that there is an economic connection between the undertakings which use the word "above" in their respective trade marks.

48. I have given consideration as to whether the additional elements "& beyond" may be perceived as a natural extension to the opponent's brand name "above", indicating perhaps a diversification. However, I reject that possibility as the difference in conceptual message is considerable and not consistent with a brand variation for the goods at issue. I, therefore, conclude that when encountering identical or similar goods, the average consumer who is a member of the general public is likely to distinguish between the marks without any possibility of confusion or association, even if he or she pays only a low degree of attention to the purchase process. The average consumer comprising of business users will pay a fairly high degree of attention during the purchasing process, making them less prone to confusion. I, therefore, find that for both groups of average consumers there is no likelihood of indirect confusion.

## **Conclusion**

49. The opposition is unsuccessful. The application will proceed to registration.

## **Costs**

50. Under cover of a letter dated 29 September 2020, the applicant was sent a costs proforma which the applicant was directed to complete and return by 13

---

<sup>10</sup> See the opponent's written submissions dated 27 October 2020, para 9.



October 2020 if the applicant intended to request an award of costs. The letter informed the applicant that if the proforma was not completed and returned, no costs would be awarded. The proforma has not been returned and I therefore do not make any costs award in favour of the applicant.

**Dated this 12<sup>th</sup> January 2021**

**Karol Thomas  
For the Registrar  
The Comptroller-General**