

O/031/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003432350
IN THE NAME OF SHENZHEN ENVICOOOL TECHNOLOGY CO., LTD.
FOR THE FOLLOWING TRADE MARK:

CyberMate

IN CLASS 11

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 419081 BY
STULZ GMBH

BACKGROUND AND PLEADINGS

1. On 28 September 2019, Shenzhen Envicool Technology Co., Ltd (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”). The applicant’s mark was published for opposition purposes on 11 October 2019 for the following goods:

Class 11: Germicidal lamps for purifying air; Air purifying apparatus and machines; Cooling appliances and installations; Refrigerating apparatus and machines; Air cooling apparatus; Coolers for furnaces; Water purification installations; Radiators, electric; Friction lighters for igniting gas; Humidifiers for central heating radiators.

2. On 13 January 2020, the applicant’s mark was opposed by Stulz GmbH (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade marks:

CyberRack

EUTM no. 13514914

Filing date 1 December 2014; registration date 17 April 2015

(“the opponent’s first mark”);

CyberLab

EUTM no. 14677835

Filing date 14 October 2015; registration date 17 February 2016

(“the opponent’s second mark”);

CyberHub

EUTM no. 15370935

Filing date 25 April 2016; registration date 10 August 2017

(“the opponent’s third mark”);



EUTM no. 15713969

Filing date 1 August 2016; registration date 7 September 2017
("the opponent's fourth mark");

CyberMDC

EUTM no. 15741358

Filing date 9 August 2016; registration date 26 December 2017
("the opponent's fifth mark"); and

CyberHandler

EUTM no. 15949555

Filing date 19 October 2016; registration date 3 March 2017
("the opponent's sixth mark").

3. The opponent relies on those goods and services for which its marks are registered as listed in the **Annex** to this decision.
4. In its statement of grounds, the opponent submits that the high degree of visual and phonetic similarity, the extremely high degree of conceptual similarity and the identity/similarity between the applicant's goods and opponent's goods and services will give rise to a likelihood of confusion, including a likelihood of association, on the part of the public.
5. The applicant filed a counterstatement denying the claims made.
6. The opponent is represented by Mewburn Ellis LLP and the applicant is represented by Trademarkit LLP. Only the opponent has filed evidence. No hearing was requested. While neither party filed written submissions in lieu of a hearing, the opponent did file submissions during the evidence rounds. I have taken these into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

PRELIMINARY ISSUE

7. Within its counterstatement, the applicant states that:

“the Opponent claims that the Opponent’s Cyber marks “constitute a family of trade marks” and this results in a likelihood that the public will believe that the Applicant’s mark is associated with the Opponent’s family of Cyber marks. The Applicant submits that there are many UK and EU trade mark registrations in different ownership that incorporate the element “Cyber”.”

8. For reasons that I will now explain, the applicant’s point regarding the presence of multiple trade marks on the register with the word ‘Cyber’ has no bearing on the outcome of this opposition. I note that in the case of *Zero Industry Srl v OHIM, Case T-400/06*, the General Court (“GC”) stated that:

“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). “

9. The fact that there are many trade marks that contain the word ‘Cyber’ is not a relevant factor to the distinctiveness of the opponent’s marks. The applicant has filed no evidence to demonstrate that any of these marks are actually in use in the market place. The outcome of this opposition will be determined after making a global assessment whilst taking into account all relevant factors and the state of the register is not relevant to that assessment.

EVIDENCE

10. As above, only the opponent has filed evidence. This was in the form of the witness statement of Mr Markus Trautwein dated 7 July 2020. While I will not reproduce the entire content of the statement in full, I will summarise the most pertinent points below.
11. Mr Trautwein is the Head of Technology Integration of the opponent, a position he has held since September 2017. Mr Trautwein has worked for the opponent for 13 years. The opponent was founded in 1947 and has become one of the world's leading system suppliers of air conditioning technology. Mr Trautwein goes on to give an overview of the opponent's business and brand.
12. The opponent has been selling its goods in the UK since 1989 and has been selling goods with the prefix 'Cyber' in the UK for nearly 20 years. The 'CyberCool' range was launched in 2002 and the 'CyberAir' range launched in 2004. Mr Trautwein then discusses an exhibit that is a scanned invoice dated 25 June 2004 which details the sale of a CyberCool unit in the UK. While evidence of the sale is noted, the 'CyberCool' mark is not one that is relied upon in these proceedings.
13. Two letters from the opponent's customers are included within the evidence.¹ I note that first letter is dated 10 June 2019 and confirms that the writer has used the opponent and directly associates the phrase 'Cyber' with the opponent's product range. The second letter is dated 12 June 2019, however, it also contains a date of 12 June 2020. The writer of the second letter also confirms that he is also a customer of the opponent and identifies the phrase 'Cyber' with the opponent.
14. Mr Trautwein proceeds to discuss use of the 'Cyber' marks. Within its notice of opposition, the opponent seeks to rely on the 'family of marks' argument. However, I note that the evidence provided shows use of the marks 'CyberAir', 'CyberCool' and 'CyberRow'. These marks are not relied upon in these proceedings and any evidence in relation to them does not assist the opponent.

¹ Exhibit MT4

15. The marks that are being relied upon in these proceedings are then discussed in detail. I note that evidence is provided that shows examples of the various marks on the opponent's website, in brochures and via screenshots of the 'CyberHub' app.² Throughout the evidence, examples of all marks relied upon are shown. However, the evidence of websites printouts and brochures are either undated or dated after the relevant date. While evidence dated after the relevant date may be considered in opposition proceedings, I do not consider this to be the case in respect of this evidence. This is because the evidence is provided in support of the family of marks argument raised by the opponent which needs to be supported by evidence of the opponent's marks being present on the market at the relevant date, not after.

16. Mr Trautwein then proceeds to discuss a number of certificates and awards that the opponent has received over the years. While I note Mr Trautwein's comments and the print outs confirming the awards obtained, I note that they relate to 'CyberRow', 'CyberCool' and 'CyberAir'. None of these marks are relied upon in these proceedings and, therefore, this evidence does not assist the opponent.

17. In 2018, the opponent's turnover was around 450 million euros in relation to the manufacture and sale of precision air conditioning units and chillers, air conditioning and humidification systems and service and object management. The opponent's total annual sales were around 1,300 million euros. A breakdown of UK sales figures for the 'core' Cyber product range is provided. Mr Trautwein states that these figures include sales of the 'CyberAir', 'CyberRow' and 'CyberCool' units. I note that the figures shown cover up to 12 June 2020. However, the relevant date falls on 28 September 2019 so I have discounted the figures from 2020. As a result, between 2004 and 2019, the sales figures stand at £88,264,298. I acknowledge that some of the figures from 2019 will still fall after the relevant date.

18. Marketing figures are then discussed. Mr Trautwein states that the opponent has invested heavily in advertising and marketing the 'Cyber' products in the UK. The

² Exhibit MT5 – MT12

opponent has provided a breakdown of its expenditure between 2004 and 12 June 2020. For the same reason set out in paragraph 17 above, I have discounted the 2020 figures and also acknowledge some of the figures from 2019 will fall after the relevant date. Between 2004 and 2019, the opponent has spent a total of £1,293,000 on marketing. These figures relate to the 'Cyber' range of products, but no further explanation is given.

19. Mr Trautwein discusses a number of trade fairs that the opponent attends. At these events, the opponent displays the products on sale and networks with industry clients. Within the UK, the opponent attends the 'Data Centre Dynamics' and the 'Data Centre World' events. These events are attended by an annual global audience of over 20,000 attendees and these make up the largest gatherings of key decision makers, pioneers, experts and suppliers in the field of 'data centres'. Photos of the opponent's goods for sale at the London Data Centre Dynamics event in 2011 and at the London Data Centre World event in 2014, 2017, 2018 and 2019 are shown.³ Of these photos, I note that the 2011 photo does not show any of the marks relied upon. However, a sign for 'CyberHandler' is shown on the 2014, 2017 and 2018 photos. I also note that the opponent's fourth mark is shown on a photo from 2018. The 2019 photos do not show any of the marks.

20. A number of printouts in relation to large scale projects that the opponent has undertaken in the UK are shown.⁴ I have reviewed these and note that they do not mention the opponent's marks. These printouts do not, therefore, assist the opponent.

21. A significant number of online articles are provided.⁵ A number of these articles contain the opponent's marks, however, some also include marks such as 'CyberAir' and 'CyberCool', which are not relied upon in these proceedings. I note that of all these articles, only one is from a .co.uk website, with the remainder being .me, .eu or .de websites. The only article aimed at UK customers is in relation to the 'CyberHandler' mark and is undated, however, it does refer to 2017 within it.

³ Exhibit MT14

⁴ Exhibit MT15

⁵ Exhibit MT16

22. Additional 'Cyber' marks that are registered to the opponent are then discussed. While I note the additional marks, they do not form part of these proceedings and will, therefore, not assist the opponent.

DECISION

Section 5(2)(b): legislation and case law

23. Section 5(2)(b) of the Act reads as follows:

“(2) A trade mark shall not be registered if because-

(a) ...

(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 or association with the earlier trade mark.”

24. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

25. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

26. The opponent's marks qualify as earlier trade marks under the above provisions. As the opponent's marks had not completed their registration process more than 5 years before the application date of the mark in issue, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely on all goods and services for which its marks are registered.

27. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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.

Comparison of goods and services

28. The applicant's goods are set out in **paragraph 1** of this decision. The opponent's goods and services are set out in the **Annex** to this decision.

29. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"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".

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

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

31. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“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 fur 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”.

32. I have read the detailed submissions from the opponent regarding the identity/similarity of the parties' goods and services. While I do not intend to reproduce these here, I have taken them into account in making my assessment.

33. In the absence of any evidence or submissions as to what the goods “germicidal lamps for purifying air” in the applicant's specification are, I find that they are lamps that purify the air around it by emitting ultraviolet light. The purpose of these goods will be to purify air. The goods contained within the opponent's marks relate to air conditioning, refrigeration, ventilation, heating and drying. I have no evidence to suggest that these goods are for the purpose of purifying air. I am, therefore, unable to find that there is any overlap in purpose between these goods. I also find that they do not overlap in method of use or nature. Further, I have no evidence to suggest that an undertaking producing the applicant's goods would also produce the opponent's goods meaning that I am unable to find any overlap in trade channels. While there may be an overlap in user in that someone wishing to buy air conditioning, refrigeration, ventilation, heating and drying apparatuses may want to also purchase germicidal lamps for purifying air, any overlap will be limited. I do not consider this limited overlap to be enough to warrant a finding of similarity. Therefore, I do not consider that these goods are similar to any of the goods or services within the opponent's marks' specifications.

34. For the same reasons set out in paragraph 33 above, I do not find that “air purifying apparatus and machines” in the applicant’s specification will be similar to any of the goods and services in the opponent’s marks’ specifications.
35. “Cooling appliances and installations” in the applicant’s specification will fall within the opponent’s goods, being “apparatus for cooling” in the opponent’s third and fourth marks’ specifications. These goods will, therefore, be identical under the principle outlined in *Meric*.
36. “Refrigerating apparatus” in the opponent’s second mark’s specification, “apparatus for air-conditioning, in particular cooling apparatus” in the opponent’s fifth mark’s specification and “air-conditioning installations” in the opponent’s sixth marks’ specification are all different types of cooling apparatuses. Insofar as “cooling appliances and installations” in the applicant’s specification covers these types of goods, they will be identical under the principle outlined in *Meric*. However, in relation to goods covered by the applicant’s term that are not refrigerating apparatus or air-conditioning installations, they will not be identical. However, they will overlap in purpose in that both parties’ goods will be used to keep something cool and/or refrigerated. I also consider there to be an overlap in nature in that both parties’ goods will be some form of electrical appliance with a ‘cooling’ function. When considering purchasing a cooling appliance, the user may choose to buy one that refrigerates, one that uses air-conditioning or another method of cooling. These goods will, therefore, have a competitive relationship. Overall, I consider these goods to be similar to a medium degree.
37. “Refrigerating apparatus and machines” in the applicant’s specification will fall within “refrigerating apparatus” in the opponent’s second mark’s specification, “refrigerating cabinets” in the opponent’s third and fourth marks’ specifications, “apparatus for [...] refrigerating [...] purposes” in the opponent’s fifth mark’s specification and “apparatus for refrigerating and ventilating” in the opponent’s sixth mark’s specification. These goods will, therefore, be identical under the principle outline in *Meric*.

38. “Air cooling apparatus” in the applicant’s specification will be identical with “apparatus for cooling” in the opponent’s third and fourth mark’s specifications.

39. I also find that air conditioning units are a type of air-cooling apparatus. Therefore, insofar as “air cooling apparatus” in the applicant’s specification includes air conditioning installations, it will be identical under the principle outlined in *Meric* with “air conditioning installations” in the opponent’s second and sixth marks’ specifications and “apparatus for air-conditioning, in particular cooling apparatus” in the opponent’s fifth mark’s specification. However, in relation to goods covered by the applicant’s term that are not air-conditioning installations, they will not be identical. The same reasoning that I have set out in paragraph 33 in respect of the similarity between those goods will also apply to these goods and, therefore, I find that these goods are similar to a medium degree.

40. “Coolers for furnaces” in the applicant’s specification will fall within the category of “apparatus for cooling” in the opponent’s third and fourth marks’ specifications. These goods will, therefore, be identical under the principle outlined in *Meric*.

41. “Coolers for furnaces” describes a good that uses cooling technology in order to cool furnaces. This can include air-conditioning, refrigeration and liquid cooling technology. Insofar as these goods use refrigeration apparatus, they will fall within the categories of “refrigerating apparatus” and “chilled water units” in the opponent’s second mark’s specification, “apparatus for air-conditioning, in particular cooling apparatus” and “liquid cooling apparatus” in the opponent’s fifth mark’s specification and “apparatus for refrigerating and ventilating” in the opponent’s sixth mark’s specification. These goods will, therefore, be identical under the principle outlined in *Meric*. However, in relation to goods covered by the applicant’s term that do not utilise refrigerating, air-conditioning or liquid cooling technology, they will not be identical. The same reasoning that I have set out in paragraph 33 in respect of the similarity between those goods will also apply to these goods and, therefore, I find that these goods are similar to a medium degree.

42. I do not consider that the opponent's goods, being "chilled water units" in the opponent's second and third mark's specifications, "cold water sets" in the opponent's fourth mark's specification, "apparatus for [...] water supply [...] purposes" in the opponent's fifth mark's specification and "apparatus for supplying water" in the opponent's sixth mark's specification to be identical or similar to "water purification installations" in the applicant's specification. While all goods relate to water, the opponent's goods relate to either the cooling of or supply of water whereas the applicant's goods relate to the purification of water. The nature, method of use and purpose of these goods will all differ. While there may be an overlap in user base in that someone looking to purify water may also require the supply and/or cooling of water, it will be limited. Further, I have considered whether the goods have a close connection with each other in the sense that one would be indispensable or important to the other in such a way that the average consumer may think that the responsibility of them lies with the same undertaking.⁶ While the supply of water is indispensable for the purification of water, I do not consider that the average consumer will believe that goods that supply water and those that purify it will lie with the same undertaking. Therefore, I do not consider there to be any complementary relationship between the goods. Overall, I consider these goods to be dissimilar.

43. "Radiators, electric" in the applicant's specification will fall within the categories of "heating apparatus" in the opponent's fifth mark's specification and "unit heaters" in the opponent's sixth mark's specification. These goods will, therefore, be identical under the principle outlined in *Meric*.

44. "Friction lighters for igniting gas" in the applicant's specification describes a good that uses friction to generate a spark which ignites gas in order to create a flame. This good is something that is used in gas lighters, such as those used to light cigarettes, cookers or heaters. I have given consideration to whether this good is similar to "apparatus for [...] heating [and] cooking [...] purposes" in the opponent's fifth mark's specification. I acknowledge that the applicant's good may be used as

⁶ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

a part in an apparatus that is used for heating or cooking purposes. While this may be the case, it does not automatically give rise to a finding of similarity between the applicant's good and "apparatus for [...] heating [and] cooking [...] purposes" in the opponent's fifth mark's specification (see *Les Éditions Albert René v OHIM*, Case T-336/03). When assessing the purpose of the goods, I must consider the purpose of the applicant's good itself, not the apparatus it may be a part of. The purpose of the opponent's goods is to heat or cook something whereas the purpose of the applicant's good is to ignite gas. The purposes will not, therefore, overlap. The nature of the goods will differ in that an apparatus for heating and cooking will include other parts and not just the friction elements that ignite the gas. The method of use will also differ as the friction elements of the applicant's good will be struck against each other to create a spark whereas the opponent's goods will have other elements that mean it will be used differently. On the face of it, I do not consider there to be any overlap in user. However, given the wide user base of the opponent's goods, it may be possible for there to be a limited overlap. I do not consider there to be any competitive relationship between the goods. In respect of complementarity, I am of the view that it would be possible for the average consumer to see the goods as complementary to one another. For example, a friction lighter may be used as a separate component to a gas stove or heater (for example, a portable camping stove or heater). In that instance, the average consumer may consider the lighter indispensable to the gas cooker or heater and believe that the responsibility for both goods lies with the same undertaking. However, the instances where this may occur will be limited as the opponent's goods also cover goods such as electric heaters and cookers. Therefore, any complementary relationship will be limited. In light of the above, I consider these goods similar to only a low degree.

45. In the absence of any submissions or evidence to the contrary, I am of the view that "humidifiers for central heating radiators" in the applicant's specification describes a product that is filled with water and placed on a radiator so that the heat from the radiator creates a steam that introduces moisture into the air. These goods will fall within the category of "apparatus for steam generating purposes" in the opponent's fifth mark's specification and "steam generating apparatus" in the

opponent's sixth mark's specification. These goods will, therefore, be identical under the principle outlined in *Meric*.

46. As some degree of similarity between the goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition that relies upon the opponent's first mark must fail. Further, I have found the following goods in the applicant's mark to be dissimilar to any of the goods and services in the opponent's remaining marks. Therefore, the opposition against these goods must fail:

Class 11: Germicidal lamps for purifying air; air purifying apparatus and machines; water purification installations.

47. I have found the applicant's remaining goods to be either identical or similar to varying degrees with the goods in the opponent's remaining specifications. The opposition against those goods may, therefore, proceed.

The average consumer and the nature of the purchasing act

48. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

49. Some of the goods at issue are clearly goods that are purchased by business users. For example, goods such as coolers for furnaces, germicidal lamps for purifying air and refrigeration circuits. However, given that goods such as refrigerating apparatus and air conditioning/cooling units can include household items such as fridges, freezers and air conditioning units, I find that the average consumer for the goods at issue could be both a member of the general public or a business user.
50. For those goods that are likely to be purchased by general members of the public, these will be available through a range of retail shops and their online equivalents. The goods will be displayed in stores where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. The selection of the goods by members of the general public will, therefore, be primarily visual. While the visual aspect plays a greater role in the selection process, I do not discount aural consideration in the form of word of mouth recommendations and advice sought from shop assistants.
51. For those goods that are likely to be purchased by the business user, these are likely to be available either from the producer directly through their website or telephone sales or, via specialist retailers who will display their goods either online or in catalogues. The goods will be selected by the consumer having viewed an image displayed on a webpage or catalogue, or after discussion with sales representatives. I am of the view that the selection of the goods by the business user will be both visual and aural depending on the method of sale used.
52. The goods at issue will range from relatively inexpensive items such as portable air conditioning units or fridges to large-scale air-conditioning set ups, which will be relatively expensive. The goods at issue are likely to be purchased infrequently. When choosing the goods at issue, both the business user and member of the general public will bear in mind several factors such as suitability, reliability, quality, durability and the reputation of the producer. Both the business user and the member of the general public will pay a medium degree of attention during the selection process of the goods.

Distinctive character of the opponent's mark

53. 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).”

54. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, the opponent has not pleaded that its marks have acquired enhanced distinctiveness through use in the UK. However, for the sake of completeness, I note the following. While the evidence provided relates to the UK market and includes sales and marketing figures, those figures cover use of multiple marks

that are not relied upon in these proceedings. It is, therefore, unclear what portion of these figures relate to the actual marks relied upon. Further, no evidence is provided about where the mark has been used to enable me to assess the geographical spread of any use. I, therefore, do not consider that the evidence filed is sufficient to show that the opponent's marks have acquired an enhanced level of distinctive character. Consequently, I have only the inherent position to consider.

55. The opponent's second, third, fifth and sixth marks are word only marks that are 'CyberLab', 'CyberHub', 'CyberMDC' and 'CyberHandler', respectively. Save for the letters 'MDC' in the opponent's fifth mark (which will be seen as a set of initials that conveys no obvious meaning), these marks consist of two recognisable dictionary words which are conjoined. 'Cyber' will be seen by the average consumer as a reference to computing or the internet. Even on goods where there is no obvious connection to computing or the internet (such as the goods at issue), I find that the average consumer will still see it as a reference to computing and/or the internet. This is because it is increasingly common for all sorts of regular household goods to have some sort of computer/internet connectivity under the heading of the Internet of Things. As a result, I find that 'Cyber' on its own will have a low degree of inherent distinctive character. The words 'Lab', 'Hub' and 'Handler' and the letters 'MDC' cannot be said to be descriptive of the goods and services for which the marks relate. The inherent distinctive character of the marks lies in the combination of the words as a whole. Overall, I find that the opponent's second, third, fifth and sixth marks have between a low and medium degree of inherent distinctive character.

56. The opponent's fourth mark is made up of a device and word element. The word element is 'CyberHub' and this will carry the same meaning and level of distinctive character as I have found for the opponent's third mark above. To the left of 'CyberHub' is a black hexagonal shape, within which sits a white, six-pronged device. While I am of the view that 'CyberHub' will dominate the distinctive character of the opponent's fourth mark, I find that the device element will still contribute slightly. Overall, I find that the opponent's fourth mark has no more than a medium degree of inherent distinctive character.

Comparison of marks


57. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.


58. 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.”

59. 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.

60. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
<p data-bbox="320 1715 770 1809">CyberLab ("the opponent's second mark")</p> <p data-bbox="341 1883 750 1977">CyberHub ("the opponent's third mark")</p>	

 CyberHub (“the opponent’s fourth mark”)	
CyberMDC (“the opponent’s fifth mark”)	
CyberHandler (“the opponent’s sixth mark”)	

61. In respect of the comparison of marks, the opponent submits that:

“33. Both the applicant’s ‘CyberMate’ mark and each of the Cyber Marks owned by the opponent share the same prefix, namely “Cyber”. This element which gives rise to the opponent’s series of marks is reproduced without any alteration in the ‘CyberMate’ mark. Further, as is explained above, the opponent’s marks follow a very similar and consistent format. The vast majority of the opponent’s series of marks are comprised of two words which are not separated by a space, many of which contain two syllables and are either eight or nine letters in length. The ‘CyberMate’ mark follows this format in that it contains the word ‘Cyber’ followed by one other word which is not separated by a space, it contains two syllables, and it is nine letters in length. All of these similarities will increase the likelihood that consumers will mistakenly believe that the ‘CyberMate’ mark belongs to the opponent’s series of marks, and will therefore mistake the commercial origin of the goods sold under the ‘CyberMate’ mark as belonging to the opponent.”

Overall Impression

The applicant’s mark

62. The applicant’s mark consists of two recognisable dictionary words, being ‘Cyber’ and ‘Mate’. The words are displayed in a grey typeface. While the words are slightly

italicised, the typeface appears to be standard and I am of the view that any stylisation will play a very small role in the overall impression of the mark. I note that the opponent has submitted that there is no spacing between the words, however, I am of the view that there is spacing between them and that they will be seen as two separate words, although neither word dominates the other. The overall impression of the mark is dominated by the words 'Cyber Mate' themselves with the stylisation playing a very small role.

The opponent's marks

63. The opponent's second, third, fifth and sixth marks are all word only marks. While these marks are conjoined, I think it is clear that they will be perceived as two separate elements. In the opponent's second, third and sixth marks, these elements will be seen as two recognisable dictionary words. In the opponent's fifth mark, these elements will be seen as one recognisable dictionary word and a set of letters. I, therefore, consider that the overall impression of these marks lies in the combination of the two elements. The opponent's fourth mark consists of a hexagonal device element and the words 'CyberHub'. I am of the view that the average consumer will be drawn to the element of the mark that can be read. As a result, I find that the word 'CyberHub' will play a greater role in the overall impression of that mark with the device element playing a lesser role.

Visual Comparison

The opponent's second, third, fifth and sixth marks and the applicant's mark

64. The visual similarities between these marks arise from the shared element 'Cyber' at the beginning of the marks. There is a difference because the word 'Mate' is different from the second word in each of the opponent's marks. While the stylisation element of the applicant's mark only plays a very minor role in the applicant's mark, it will still constitute a visual difference. The opponent's marks are word only marks and can be used in any standard typeface and they are registered in black and white which covers use of the marks in different colours.

Overall, in each case, I find there to be a medium degree of visual similarity between the marks.

The opponent's fourth mark and the applicant's mark

65. Visually, the marks share the same similarities and differences highlights above. However, the opponent's fourth mark contains a device element that is not present in the applicant's mark. While the device element will constitute a visual difference, I have found that it plays a lesser role in the overall impression of the mark. The opponent's fourth mark is registered in black and white which covers use of the mark in different colours. Overall, I find there to be between a low and medium degree of visual similarity between the marks.

Aural Comparison

66. The device element in the opponent's fourth mark will not be pronounced and the verbal element will be pronounced identically to the opponent's third mark. Each mark will be pronounced in its entirety and conventionally. The first two syllables are identical in all of them. There is no similarity between the second word in the respective marks (i.e. "Mate", "Lab", "Hub", "MDC", "Handler"). The applicant's mark and the opponent's second, third and fourth marks all consist of three syllables and the opponent's fifth and sixth marks consist of five and four, respectively. Nonetheless, I consider that there is a medium degree of similarity between the of the opponent's marks and the applicant's mark.

Conceptual Comparison

67. I do not find that the device element in the opponent's fourth mark will carry any conceptual meaning. Therefore, the only elements that have any conceptual impact in any of the marks are the words. Each mark consists of the word 'Cyber' which will be connected to computing and/or the internet. Because the word 'Cyber' is so synonymous with computing/the internet, I find that the average consumer will make this connection regardless of whether the goods on which the marks are

displayed directly relate to computing/the internet or not. The second word in each mark will be conceptually different.

68. While I am of the view that the conceptual impacts of the marks are dominated by their reference to computing/the internet, there will be an element of conceptual difference in the second word of each mark. Overall, I find that the marks are conceptually similar to a medium degree.

Likelihood of confusion

69. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

70. I have found some goods in the applicant's specification and the opponent's second, third, fourth, fifth and sixth marks' specifications to be identical and some to be similar to varying degrees. I have also found some goods to be dissimilar. The opponent's first mark will not form part of the assessment for likelihood for confusion as I have found that there is no similarity between the applicant's goods and the goods in opponent's first mark's specification.

71. I have found that the average consumer for the goods at issue will be both members of the public and business users. For members of the general public, I have found that the average consumer will select the goods through primarily visual means, although I do not discount aural consideration. For business users, I have found that the average consumer will select the goods through both visual and aural means, depending on their method of purchase. I have concluded that the average consumer will pay a medium degree of attention during the purchasing process of the goods at issue. I have found that the opponent's second, third, fifth and sixth marks have between a low and medium degree of inherent distinctive character and the opponent's fourth mark to have no more than a medium degree of inherent distinctive character.

72. I have found the opponent's second, third, fifth and sixth marks and the applicant's mark to be visually and aurally similar to a medium degree and conceptually similar to between a medium and high degree. I have found the opponent's fourth mark and the applicant's mark to be visually similar to between a low and medium degree, aurally and conceptually similar to a medium degree. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

73. Taking all of the above factors and the principle of imperfect recollection into account, I consider that the visual and aural differences between the marks are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. Consequently, I am satisfied that there is no likelihood of direct confusion between the marks, even on goods that I have found to be identical.

74. It now falls to me to consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

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

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.). BL O/375/10 Page 15 of 16
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

75. I have borne in mind that the examples given by Mr Purvis QC are not exhaustive. Rather, they were intended to be illustrative of the general approach.⁷

⁷ L.A. *Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

76. I note that the opponent has submitted that the applicant's mark will be mistaken for being a member of its family of marks. I refer to the case of *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, wherein the CJEU stated that for a family of marks argument to succeed, the trade marks that make up the 'family' must be present on the market and that the public must be mistaken as to whether the trade mark applied for belongs to the opponent's 'family' or 'series' of marks.

77. To show that there is a likelihood of confusion as a result of the opponent's family of marks, the opponent needs to prove that there are multiple marks present on the market and that the public would see any mark with 'Cyber' in it as a part of the opponent's group of marks. While the opponent's evidence contains a number of print outs from its website, excerpts of catalogues and online articles, for the reasons set out above, these do not assist the opponent. The only evidence provided by the opponent that I consider sufficient for proving presence on the market are the sales and marketing figures. I have set out above that these figures cover a number of 'Cyber' marks, including marks that are not relied upon in these proceedings. The evidence shows 11 marks that contain the word 'Cyber'. Between 2004 and 2019, the opponent's turnover was £88,264,298. I have set out above that some of these figures fall after the relevant date, being 28 September 2019. However, the evidence is such that I am content to conclude that even if (1) the sales of the opponent's goods under the five marks relied upon (discounting the opponent's first mark) make up just under half of these total sales and (2) the 2019 figures are reduced accordingly, this is still a considerable turnover. Applying the same approach to the marketing figures, being £1,293,000, I am also satisfied that the opponent has incurred considerable expense in advertising its marks. I am satisfied that these figures, together with their longevity (in that they have been accruing since 2004), demonstrates that the opponent's marks were present on the market as at the relevant date.

78. I must now move on to consider whether the public would see any mark with the word 'Cyber' in it as a part of the opponent's group of marks. The only evidence provided by the opponent in respect of this point is the letters provided by two

customers of the opponent.⁸ One of the letters is dated 10 June 2019 and the other is dated 12 June 2019 but appears to have been signed on 12 June 2020. For the purposes of this assessment, I have taken this evidence into account. Both of these customers state that they would recognise any mark with the word 'Cyber' as a part of the opponent's family of marks. However, it seems to me that these customers may have been educated to that effect as a result of their ongoing purchase of the opponent's goods and services. In any event, this evidence is limited in that it only shows that two of the opponent's customers would associate 'Cyber' with the opponent. I do not consider that the opponent has established that the public would expect any mark with the 'Cyber' prefix to be connected to the opponent. Consequently, this line of argument is dismissed.

79. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. It is not sufficient that a mark merely calls to mind another mark. This is mere association, not indirect confusion.⁹ Further, it is clear from the judgment of the CJEU in *Lloyd* (cited above), that descriptive matter should be given less weight when comparing trade marks. The common element of the marks, being 'Cyber', will be seen as descriptive of goods relating to computing/the internet, regardless of whether they actually relate to computers/ the internet or not and I do not consider this to be sufficient to cause the average consumer to believe the marks are provided by the same or an economically connected undertaking. The distinctiveness of the opponent's marks lies in the combination of the words, rather than in the word 'Cyber' by itself. It is my view that the average consumer is likely to assume that the use of the common element 'Cyber' is a coincidence due to its descriptive nature, rather than there being a connection between the undertakings responsible for the marks. Further, I do not think that the consumer would have any reason to believe that only one undertaking would use the word 'Cyber' given its widespread link to computing/the internet. Taking all of the above factors into account, I do not consider there to be a likelihood of indirect confusion between the marks, even on goods that are identical.

⁸ Exhibit MT4

⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

CONCLUSION

80. The opposition has been unsuccessful in its entirety and the application will proceed to registration.

COSTS

81. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£700** as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the opponent's statement:	£200
Considering the opponent's evidence:	£500
Total:	£700

82. I therefore order Stulz GmbH to pay Shenzhen Envicool Technology Co., Ltd the sum of £700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of January 2021

A COOPER
For the Registrar

ANNEX

The opponent's first mark

Class 11: Heat exchangers with fans for air conditioning, including for fitting to and installation in server housings, network housings, switch cabinet housings and other housings

The opponent's second mark

Class 11: Refrigerating apparatus, air conditioning installations, refrigeration circuits, chilled water units, precision air conditioning units.

The opponent's third mark

Class 11: Apparatus for cooling, Refrigerating cabinets, Air conditioning installations, Chilled water units, precision air conditioning units.

The opponent's fourth mark

Class 11: Apparatus for cooling, Refrigerating cabinets, Air conditioning installations, Refrigerating circuits, cold water sets, precision air conditioning apparatus; Coolant distribution stations and installations.

The opponent's fifth mark

Class 6: Fire safe boxes; Buildings of metal, in particular security rooms, in particular fire-proof areas; Facings of sheet metal, namely doors, walls; Door locks of metal; Positioning and movement devices of metal, namely bases and rollers; Fastening devices of metal, namely bearing angles; Common metals and their alloys; Metal building materials; Transportable buildings of metal, in particular transportable server and air conditioning installation cabinets of metal; Non-electric cables and wires of common metal; Ironmongery, small items of metal hardware; Pipes and tubes of

metal; all aforementioned products not being tool boxes or van fitting solutions.

Class 11: Apparatus for air-conditioning, in particular cooling apparatus, heat exchangers, air filters, heating apparatus, liquid cooling apparatus, in particular for switch cabinets; Devices for monitoring gas pipelines, included in class 11; Air-conditioning apparatus and air-conditioning equipment constructed therefrom, in particular for room air conditioning; Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; Air conditioning installations, including precision air conditioning installations; Temperature-controlled cabinets.

Class 37: Construction of buildings, in particular security spaces for information technology; Building construction; Repair, namely repair of air conditioning installations, server and air conditioning cabinets and components therefor, electrical switch cabinets and adapted cabinets and components therefor, components for computer control stations, housings for electrical apparatus, computer housings, parts and fittings for security rooms and cabinets; Installation work, namely installation of air conditioning installations, server and air conditioning cabinets and components therefor, electrical switch cabinets and adapted cabinets and components therefor, components for computer control stations, housings for electrical apparatus, computer housings, parts and fittings for security rooms and cabinets; Construction supervision in connection with the construction and development of data or communications sites.

The opponent's sixth mark

Class 11: Air conditioning installations; Air conditioning fans; Steam generating apparatus; Unit heaters; Apparatus for refrigerating and ventilating; Drying installations; Apparatus for supplying water.